

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORTINET INC.
Petitioner

v.

SOPHOS INC.
Patent Owner

Case IPR2015-00618
Patent 8,261,344 B2

PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
JORDAN R. JAFFE

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P.O. Box 1450
Alexandria, VA 22313-1450

EXHIBIT LIST

No.	Exhibit
Ex. 1001	U.S. Patent No. 8,261,344 to Godwood et al.
Ex. 1002	The prosecution history of U.S. Patent No. 8,261,344
Ex. 1003	U.S. Patent No. 7,913,305 to Bodorin et al. (“Bodorin”)
Ex. 1004	U.S. Patent No. 7,373,644 to Kissel (“Kissel”)
Ex. 1005	U.S. Patent No. 5,951,698 to Chen et al. (“Chen”)
Ex. 1006	U.S. Patent No. 7,448,084 to Apap et al. (“Apap”)
Ex. 1007	Expert Declaration of Seth Nielson
Ex. 1008	Joint Claim Construction and Prehearing Statement in <i>Fortinet, Inc. v. Sophos, Inc.</i> , Case No. 3:13-cv-05831-EMC (N.D. Cal.)
Ex. 1009	Exhibit E to Sophos Inc. and Sophos LTD’s Disclosure Of Asserted Claims and Infringement Contentions and Document Production Pursuant to Patent L.R. 3-1 And 3-2 in <i>Fortinet, Inc. v. Sophos, Inc.</i> , Case No. 3:13-cv-05831-EMC (N.D. Cal.)
Ex. 1010	U.S. Patent No. 8,713,686 to Kane (“Kane”)
Ex. 1011	December 15, 2014 Transcript of Claim Construction Hearing in <i>Fortinet, Inc. v. Sophos, Inc.</i> , Case No. 3:13-cv-05831-EMC (N.D. Cal.)
Ex. 1012	Fred Cohen, Computer Viruses, Theory and Experiments, Computers & Security 6, at 22-35 (1986).
Ex. 1013	David M. Chess and Steve R. White, An Undetectable Computer Virus, IBM Thomas J. Watson Research Center, 2000.
Ex. 1014	Virus Bulletin, March 1991.
Ex. 1015	Thomas M. Chen, The Evolution of Viruses and Worms, Dept. of Electrical Engineering, SMU, 2004.
Ex. 1016	Virus Bulletin, November 1991.
Ex. 1017	Virus Bulletin, December 1991.

Ex. 1018	Virus Bulletin, November 1993.
Ex. 1019	Dmitry O. Gryaznov, Scanners of the Year 2000: Heuristics, Virus Bulletin Conference, at 225-234, Sept. 1995.
Ex. 1020	Virus Bulletin, September 1995.
Ex. 1021	Virus Bulletin, April 1990.
Ex. 1022	Virus Bulletin, February 2000.
Ex. 1023	Affidavit of Jordan R. Jaffe in Support of <i>Pro Hac Vice</i> motion

I. Relief Requested

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Fortinet, Inc. respectfully requests *pro hac vice* admission of Jordan R. Jaffe in this proceeding.

II. Governing Laws, Rules, And Precedent

Section 42.10(c) states as follows:

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

As stated in the Board's Notice of Filing Date, any motion for *pro hac vice* admission under 37 C.F.R. § 42.10(c) must be filed in accordance with the guidance specified in the "Order -- Authorizing Motion for *Pro Hac Vice* Admission" entered in Case IPR2013-00639 (Paper 7) ("Unified Patents Order").

According to that guidance, *pro hac vice* motions can be filed “no sooner than (21) days after service of the petition.”

III. Statement of Facts

Based on the following facts, and supported by the Affidavit of Mr. Jaffe (Ex. 1023) submitted herewith, Petitioner requests the *pro hac vice* admission of Jordan R. Jaffe in this proceeding:

1. Petitioner’s lead counsel, Jason Liu, is a registered practitioner (Reg. No. 51,955).
2. Mr. Jaffe is an associate at the San Francisco office of the law firm of Quinn Emanuel Urquhart & Sullivan, LLP. (Ex. 1023, ¶3.)
3. Mr. Jaffe is an experienced patent litigator and has been practicing in the field of intellectual property, and particularly, patent litigation, for over 7 years. He has been in private practice and litigating patent cases since 2007, and has been counsel on over 20 different patent cases. (*Id.* at ¶4.)
5. Mr. Jaffe has an established familiarity with the subject matter at issue in this proceeding. (*Id.* at ¶12.) Mr. Jaffe has reviewed the Petition and accompanying exhibits filed in this matter, Board decisions, and all other papers associated with this proceeding. (*Id.*) Mr. Jaffe is Petitioner Fortinet Inc.’s trial counsel in its co-pending

district court litigation against the Patent Owner, *Fortinet Inc. v. Sophos, Inc.*, Case No. 3:13-cv-05831 (Northern District of California), which involves the same patent at issue in this proceeding (U.S. Patent No. 8,261,344). (*Id.*) As trial counsel for Petitioner, Mr. Jaffe has been actively involved in all aspects of its district court litigation, including Petitioner's factual investigation and development of its noninfringement and invalidity positions regarding the claims of the '344 patent being challenged in this proceeding. (*Id.* at ¶13.)

6. Mr. Jaffe is a member in good standing of the State Bar of California. (*Id.* at ¶5.)
7. Mr. Jaffe has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶6.)
8. No application of Mr. Jaffe for admission to practice before any court or administrative body has ever been denied. (*Id.* at ¶7.)
9. No sanctions or contempt citations have been imposed against Mr. Jaffe by any court or administrative body. (*Id.* at ¶8.)
10. Mr. Jaffe has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations. (*Id.* at ¶9.)

11. Mr. Jaffe understands that he will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.* at ¶10.)
12. Mr. Jaffe has not applied to appear *pro hac vice* in any other proceedings before the Office in the last three (3) years. (*Id.* at ¶11.)
13. This motion was filed no sooner than 21 days after service of the Petition in this proceeding.

IV. Good Cause Exists For The *Pro Hac Vice* Admission Of Mr. Jaffe In This Proceeding

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. 37 C.F.R. § 42.10(c). Based on the facts contained herein, as supported by Mr. Jaffe's affidavit (Ex. 1023), good cause exists to admit Mr. Jaffe *pro hac vice* in this proceeding.

As supported by his affidavit, Mr. Jaffe is an experienced patent litigation attorney. Mr. Jaffe also has a deep and established familiarity with the subject matter at issue in this proceeding as he is Petitioner Fortinet Inc.'s trial counsel in its co-pending district court litigation against the Patent Owner, *Fortinet Inc. v. Sophos, Inc.*, Case No. 3:13-cv-05831 (Northern District of California). This proceeding involves the same '344 patent that is at issue in that co-pending litigation.

As trial counsel for Petitioner, Mr. Jaffe has been actively involved in all aspects of its district court litigation, including Petitioner's factual investigation and development of its invalidity positions regarding the claims of the '344 patent being challenged in this proceeding. In view of Mr. Jaffe's extensive knowledge of the precise subject matter at issue in this proceeding, and in view of the interrelatedness of this proceeding and the co-pending district court litigation, Petitioner has a substantial need for Mr. Jaffe's *pro hac vice* admission and his involvement in depositions and the continued prosecution of this proceeding. Though Mr. Jaffe has been involved throughout this IPR in an advisory capacity, and has stayed up-to-date regarding the documents filed and actions taken, there is now a need for Mr. Jaffe to be added as backup counsel. Admission of Mr. Jaffe *pro hac vice* will enable Petitioner to avoid unnecessary expense and duplication of work between this proceeding and its district court litigation. *See* 77 Fed. Reg. 157 (Aug. 14, 2012), at 48661 (Office's comment on final rule discussing concerns about efficiency and costs where an entity has already engaged counsel for parallel district court litigation). Admission of Mr. Jaffe will also ease the burden on Petitioner's existing lead and backup counsel in upcoming actions.

V. Conclusion

For the foregoing reasons, Fortinet Inc. respectfully requests that the Board admit Jordan R. Jaffe as counsel *pro hac vice* in this proceeding.

Respectfully submitted,

Date: September 23, 2015

/ Jason Liu /

Jason Liu

Reg. No. 51,955

jasonliu@quinnemanuel.com

Attorney for Petitioner Fortinet, Inc.