

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC., NEST LABS, INC., and DROPCAM, INC.,
Petitioner,

v.

E. DIGITAL CORPORATION,
Patent Owner.

Case IPR2015-01470 (Patent 8,311,522)
Case IPR2015-01471 (Patent 8,315,618)
Case IPR2015-01472 (Patent 8,306,514)
Case IPR2015-01473 (Patent 8,311,523)
Case IPR2015-01474 (Patent 8,311,524)
Case IPR2015-01475 (Patent 8,315,619)¹

Before KEVIN F. TURNER, HYUN J. JUNG, and BARBARA A. PARVIS,
Administrative Patent Judges.

PARVIS, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding and Determinations Regarding Patent Owner's
Motions for Admission *Pro Hac Vice* of Anton Nasri Handal
37 C.F.R. § 42.5

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475

A conference call in the above proceedings was held on March 15, 2016, among respective counsel for Petitioner and Patent Owner, and Judges Jung and Parvis. The purpose of the call was to discuss a request by Patent Owner, for the *pro hac vice* admission of Mr. Anton Nasri Handal.

As background, Patent Owner filed a motion for *pro hac vice* admission of Mr. Handal on July 14, 2015 in each of IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475. *See, e.g.*, IPR2015-01471, Paper 7. Patent Owner submitted the Declaration of Mr. Handal as part of its motion (*id.*), rather than as a separately numbered exhibit. *See* 37 C.F.R. § 42.63.

During the March 15, 2016 call, Patent Owner requested that a decision be made that day regarding Patent Owner's motions because Mr. Handal was conducting an in-progress deposition on behalf of Patent Owner. Patent Owner represented that each of the motions pending in IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475 are identical to Paper 7 in IPR2015-01471 (with attached declaration). Petitioner indicated that it first learned that Mr. Handal would be conducting the deposition at the beginning of the deposition. At that time, Petitioner objected to Mr. Handal's representation of Patent Owner without first being admitted.

We alerted the parties that the current pending motions for the *pro hac vice* admission of Mr. Handal are accompanied by defective declarations. *See, e.g.*, IPR2015-01471, Paper 7. In particular, in the Notices of Filing Date Accorded Petition entered in each of the present proceedings, the parties were authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c), in accordance with the 'Order -- Authorizing Motion for *Pro Hac Vice* Admission' in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under 'Representative Orders, Decisions, and Notices.'" *See, e.g.*, IPR2015-01471,

IPR2015-01470, IPR2015-01471, IPR2015-01472,
IPR2015-01473, IPR2015-01474, and IPR2015-01475

Paper 3, 2. In the present proceedings, the declarations are defective because they do not include a statement that “[t]he individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a),” as is required. *See* IPR2013-00639, Paper 7, 3. Instead, the declarations refer to an incorrect section of the Code of Federal Regulations with respect to the disciplinary jurisdiction.

During the call, the parties agreed to Patent Owner’s filing of corrected papers in each of the present proceedings within three (3) business days, and if the papers are not defective, Petitioner agreed not to oppose the *pro hac vice* admission of Mr. Handal and not to object to Mr. Handal’s conducting the on-going deposition on behalf of the Patent Owner.

On March 16, 2016, Patent Owner filed a revised motion for *pro hac vice* admission of Mr. Handal in each of IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475. *See, e.g.*, IPR2015-01471, Paper 14. Each revised motion includes as part of the motion Mr. Handal’s declaration dated March 16, 2016, which refers to the correct section of the Code of Federal Regulations with respect to the disciplinary jurisdiction. *Id.* Petitioner has not opposed Patent Owner’s motions. Additionally, on March 30, 2016, in each of IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475, Patent Owner filed a power of attorney (*see, e.g.*, IPR2015-01471, Paper 16) and updated mandatory notice, under 37 C.F.R. § 42.8(a)(2). Each of the updated notices identifies a registered practitioner as lead counsel.

In view of Patent Owner’s revised and unopposed motions, we determine that Patent Owner has established good cause for the *pro hac vice* admission of Mr. Handal and, on the basis that Patent Owner continues to have a registered practitioner as lead counsel in these cases, we grant Patent Owner’s motions

IPR2015-01470, IPR2015-01471, IPR2015-01472, IPR2015-01473, IPR2015-01474, and IPR2015-01475 retroactively such that Mr. Handal's date of admission is the date of the filing of the original motions, which was July 14, 2015.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's motions for *pro hac vice* admission of Mr. Anton Nasri Handal, IPR2015-01470 (Paper 7), IPR2015-01471 (Paper 7), IPR2015-01472 (Paper 7), IPR2015-01473 (Paper 7), IPR2015-01474 (Paper 7), and IPR2015-01475 (Paper 7) are *denied*, without prejudice to Patent Owner's re-filing its motions accompanied by corrected declarations;

FURTHER ORDERED that Patent Owner's motions for *pro hac vice* admission of Mr. Anton Nasri Handal, IPR2015-01470 (Paper 14), IPR2015-01471 (Paper 14), IPR2015-01472 (Paper 14), IPR2015-01473 (Paper 14), IPR2015-01474 (Paper 14), and IPR2015-01475 (Paper 14) are *granted* retroactively beginning on July 14, 2015;

FURTHER ORDERED that Patent Owner continue to have a registered practitioner as lead counsel in these cases;

FURTHER ORDERED that Mr. Handal comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

FURTHER ORDERED that Mr. Handal is subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*

IPR2015-01470, IPR2015-01471, IPR2015-01472,
IPR2015-01473, IPR2015-01474, and IPR2015-01475

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