

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner

v.

PI-NET INTERNATIONAL, INC.
Patent Owner

Case CBM2013-00013
Patent 8,037,158

Before, KARL D. EASTHOM, WILLIAM V. SAINDON and
BRIAN J. McNAMARA, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER GRANTING MOTION FOR ADMISSION PRO HAC VICE OF
COLBY B. SPRINGER

37 C.F.R. § 42.10

In this proceeding, which concerns U.S. Patent No. 8,037,158 (“the subject patent”), Pi-Net International, Inc. (“Patent Owner”) moves for the *pro hac vice* admission of attorney Colby B. Springer in accordance with 37 CFR § 42.10 Motion, Paper 43. SAP America, Inc. (“Petitioner”) does not oppose the Motion. We grant the Motion.

I. Discussion

As set forth in 37 C.F.R. § 42.10(c), 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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, the Board also requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. (*See*, Paper 7, “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00639, entered October 15, 2013).

Coly B. Springer provides uncontroverted testimony that he:

- i. is a membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. has not been subject to any suspensions or disbarments from practice before any court or administrative body;
- iii. has never been denied any application for admission to practice before any court or administrative body ever denied;

- iv. has not been subject to sanctions or contempt citations imposed by any court or administrative body;
- v. 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 37 C.F.R.;
- vi. 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);
- vii. has listed all other proceedings before the Office for which he has applied to appear *pro hac vice* in the last three (3) years; and
- viii. has familiarity with the subject matter at issue in the proceeding.

Counsel for Patent Owner, Bryan Boyle, who is a registered to practice at the USPTO has provided a statement of facts stating that the CEO of the Patent Owner has worked with Mr. Springer on a number of matters, including the technical subject matter of the subject patent and believes that Mr. Springer's technical experience will aid the Patent Owner in this proceeding. With the Motion, counsel for Patent Owner has also submitted a declaration from the CEO of Patent Owner. Thus, Patent Owner has shown good cause why Colby B. Springer should be recognized *pro hac vice* for purposes of this proceeding. Mr. Springer has provided the requisite affidavit or declaration. Therefore, Colby B. Springer has complied with the requirements for admission *pro hac vice* in this proceeding.

II. Order

In consideration of the above, it is:

ORDERED that the Motion seeking admission *pro hac vice* for Colby B. Springer is GRANTED;

FURTHER ORDERED that Colby B. Springer may not act as lead counsel in the proceeding;

FURTHER ORDERED that a registered practitioner must remain as lead counsel throughout the proceeding; and

FURTHER ORDERED that Colby B. Springer is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R.; and

FURTHER ORDERED that Colby B. Springer is to be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*, which took effect on May 3, 2013.

PETITIONER:

Lori A. Gordon
Lgordon-PTAB@skgf.vom

Michael Q. Lee
Mlee-PTAB@skgf.com

PATENT OWNER:

Bryan Boyle
bboyle@carrferrell.com

Lawrence B. Goodwin
LawrenceGoodwinPC@gmail.com

Gerald Dodson
jdodson@carrferrell.com