

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RPX CORPORATION and  
PROTECTION ONE, INC.,  
Petitioner,

v.

MD SECURITY SOLUTIONS, LLC,  
Patent Owner.

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Case IPR2016-00285<sup>1</sup>  
Patent 7,864,983 B2

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Before SALLY C. MEDLEY, KARL D. EASTHOM, and  
WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Admission *Pro Hac Vice* and  
Excusing Lead Counsel from the Oral Hearing  
*37 C.F.R. §§ 42.5, 42.10*

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<sup>1</sup> Protection One, Inc., who filed a Petition in IPR2016-01235, has been joined as a party to the petitioner in this proceeding.

Patent Owner MD Security Solutions LLC filed a Motion for Admission *Pro Hac Vice* of Daniel J. Weinberg, accompanied by a declaration of Daniel J. Weinberg. *See* Paper 24; Paper 25.<sup>2</sup> Petitioner indicated by email that it does not oppose the Motion.

Pursuant to 37 C.F.R. § 42.10(c), we 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. Upon review of Patent Owner's Motion and supporting evidence, we determine that Patent Owner has demonstrated that Mr. Weinberg has sufficient legal and technical qualifications to represent Patent Owner in the above-identified proceeding.

Accordingly, Patent Owner has established that there is good cause for admitting Daniel J. Weinberg.

Separately, in email communications to the Board, Patent Owner requested that lead counsel be excused from the oral hearing in this proceeding and that Mr. Weinberg be permitted to represent Patent Owner. Patent Owner represents that lead counsel has a court appearance in another matter on the day of the hearing. In its own email communication to the Board, Petitioner did not object to lead counsel for Patent Owner being excused from the hearing.

Our Office Patent Trial Practice Guide provides that lead counsel will participate in all hearings. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012). Likewise, the Trial Hearing Order in this proceeding also provides that lead counsel is expected to "be present at the

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<sup>2</sup> This declaration should have been filed as an exhibit. 37 C.F.R. § 42.63.

hearings, although any back-up counsel may make the actual presentation, in whole or in part.” Paper 21, 3.

Nonetheless, while not ideal, our Trial Hearing Order contemplates situations in which lead counsel may not be required to attend hearings by requiring lead counsel to notify the Board at least two days in advance. *See id.* Given the circumstances here, including lead counsel’s scheduling conflict, Petitioner’s non-opposition to the request, and our observation that Mr. Weinberg, admitted as back-up counsel herein, has participated previously in hearings before the Board (*see* Paper 25 ¶ 8), we excuse lead counsel from the February 15, 2017 hearing in this proceeding.

It is

ORDERED that Patent Owner’s Motion for *Pro Hac Vice* Admission of Daniel J. Weinberg is granted; Mr. Weinberg is authorized to represent Patent Owner as back-up counsel in the above-identified proceeding;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for the proceeding, however, lead counsel is excused from the February 15, 2017 hearing;

FURTHER ORDERED that Daniel J. Weinberg is to comply with the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 (Aug. 14, 2012), and the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations, and 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.*

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