

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01811 (Patent 8,527,640 B2)
Case IPR2016-01813 (Patent 8,689,273 B2)¹

Before JAMESON LEE, KEN BARRETT, and
JOHN F. HORVATH, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
*Petitioner's Motion for
Pro Hac Vice Admission of Matthew C. Bernstein
37 C.F.R. § 42.10*

¹ This Decision will be entered in each case. The parties are not authorized to use this caption style. For purposes of deciding this motion, we understand the pertinent papers filed in the two cases to be substantively similar and we refer specifically to the papers filed in IPR2016-01811.

IPR2016-01811 (Patent 8,527,640 B2)

IPR2016-01813 (Patent 8,689,273 B2)

I. INTRODUCTION

On March 1, 2017, Petitioner filed a motion for *pro hac vice* admission of Mr. Matthew C. Bernstein. Paper 6. Patent Owner did not file an opposition. The motion is *granted*.

II. DISCUSSION

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel is a registered practitioner. 37 C.F.R. § 42.10(c). If 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.” *Id.*

In this proceeding, lead counsel for Petitioner is Chun M. Ng, a registered practitioner. Paper 1, 2. Petitioner’s motion relies on a declaration of Matthew C. Bernstein. Paper 6, 1–3; *see also* Ex. 1039. Mr. Bernstein declares that he is a member in good standing of the state Bar of California. Ex. 1039 ¶ 1. Mr. Bernstein declares that he has never been suspended, disbarred, sanctioned or cited for contempt by any court or administrative body, and that he has never had an application for admission to practice denied by any court or administrative body. *Id.* ¶¶ 2–4. Mr. Bernstein declares that he is an experienced litigation attorney who is familiar with the subject matter at issue in this proceeding based on his work as lead counsel for Petitioner in the related district court litigation between the parties: *Convergent Media Solutions, LLC v. AT&T, Inc.*, 3:15-cv-2156-M (N.D. Tex.). *Id.* ¶¶ 8–10. Lastly, Mr. Bernstein declares that he has read and will comply with the Office Patent Trial Practice Guide and the Board’s

IPR2016-01811 (Patent 8,527,640 B2)

IPR2016-01813 (Patent 8,689,273 B2)

Rules of Practice for Trials set forth in 37 C.F.R. Part 42, and agrees to be subject to the United States Patent and Trademark Office Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶¶ 5–6.

Accordingly, based on the foregoing, we determine that Petitioner has established good cause for the admission, *pro hac vice*, of Mr. Matthew C. Bernstein.

III. ORDER

It is:

ORDERED that Petitioner's motion for *pro hac vice* admission of Matthew C. Bernstein for these proceedings is *granted*;

FURTHER ORDERED that Mr. Bernstein is authorized to represent Petitioner as back-up counsel, but not lead counsel, in these proceedings;

FURTHER ORDERED that Mr. Bernstein will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in 37 C.F.R. Part 42, and will be subject to the Office's 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); and

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel in these proceedings.

IPR2016-01811 (Patent 8,527,640 B2)

IPR2016-01813 (Patent 8,689,273 B2)

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