

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVI NETWORKS, INC.,
Petitioner,

v.

CITRIX SYSTEMS, INC.,
Patent Owner.

Case IPR2019-00844 (Patent 8,631,120 B2)
Case IPR2019-00845 (Patent 9,148,493 B2)¹

Before JUSTIN T. ARBES, PATRICK M. BOUCHER, and
FREDERICK C. LANEY, *Administrative Patent Judges.*

LANEY, *Administrative Patent Judge.*

DECISION
Granting Petitioner's Motions for
Pro Hac Vice Admission of Brian A. Rosenthal
37 C.F.R. § 42.10(c)

¹ This Decision addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2019-00844 (Patent 8,631,120 B2)

IPR2019-00845 (Patent 9,148,493 B2)

In each of the instant proceedings, Petitioner filed a motion requesting *pro hac vice* admission of Brian A. Rosenthal, a supporting declaration from Mr. Rosenthal, and an updated power of attorney.² Patent Owner did not file an opposition to either motion. For the reasons stated below, Petitioner’s motions are *granted*.

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). 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.” *Id.* In authorizing motions for *pro hac vice* admission, the Board requires the moving party to provide 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. Paper 5, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (“Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

In the motions, Petitioner asserts that there is good cause for *pro hac vice* admission because (1) Mr. Rosenthal is an experienced litigation

² Petitioner filed similar papers and declarations in each of the instant proceedings. See IPR2019-00844, Papers 14 (“Mot.”), 3; IPR2019-00845, Papers 14, 3. We refer to those filed in Case IPR2019-00844 for convenience. Petitioner also filed each motion and declaration as a single paper in the Patent Trial and Appeal Board End to End (PTAB E2E) system. The parties are reminded that declarations must be filed as exhibits, rather than papers, and referenced by exhibit number. See 37 C.F.R. § 42.63.

IPR2019-00844 (Patent 8,631,120 B2)

IPR2019-00845 (Patent 9,148,493 B2)

attorney with experience in numerous patent infringement litigations, and (2) Mr. Rosenthal is counsel for Patent Owner in co-pending litigation, *Citrix Systems, Inc. v. Avi Networks, Inc.*, Case No. 17-1843-LPS (D. Del.), and, as such, has an established familiarity with the subject matter at issue in these proceedings. *See* Mot. 2–3. Mr. Rosenthal attests to these facts in his declarations with sufficient explanations. *See id.* 5–6.

Based on the facts set forth above, we conclude that Mr. Rosenthal has sufficient legal and technical qualifications to represent Petitioner in these proceedings and that there is a need for Petitioner to have its counsel in the related litigation involved in these proceedings. *See* IPR2013-00639, Paper 7 (setting forth the requirements for *pro hac vice* admission). Accordingly, Petitioner has established good cause for the *pro hac vice* admission of Mr. Rosenthal. Mr. Rosenthal will be permitted to appear *pro hac vice* in the instant proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s motions for *pro hac vice* admission of Mr. Rosenthal in the instant proceedings are granted, and Mr. Rosenthal is authorized to represent Petitioner as back-up counsel only in the instant proceedings;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner as lead counsel in the instant proceedings;

FURTHER ORDERED that Mr. Rosenthal is to 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

IPR2019-00844 (Patent 8,631,120 B2)

IPR2019-00845 (Patent 9,148,493 B2)

FURTHER ORDERED that Mr. Rosenthal is subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101–11.901 and the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

IPR2019-00844 (Patent 8,631,120 B2)

IPR2019-00845 (Patent 9,148,493 B2)

PETITIONER:

Y. Ernest Hsin

EHsin@gibsondunn.com

Ryan Iwahashi

RIwahashi@gibsondunn.com

PATENT OWNER:

Stephen J. Tytran

stephen.tytran@citrix.com

Lesley A. Hamlin

lesley.hamlin@citrix.com