

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE JEWELRY CHANNEL, INC. USA d/b/a Liquidation Channel  
Petitioner

v.

AMERICA'S COLLECTIBLES NETWORK, INC.  
Patent Owner

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Case CBM2014-00119  
Patent 8,370,211

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Before LINDA M. GAUDETTE, BRIAN J. McNAMARA, and  
DAVID C. McKONE, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER DENYING WITHOUT PREJUDICE MOTION FOR ADMISSION OF  
STEPHEN E. ROTH PRO HAC VICE  
*Conduct of the Proceeding*  
37C.F.R. § 42.10

America Collectibles Network, Inc. (“Patent Owner”) moves for the *pro hac vice* admission of attorney Stephen E. Roth in accordance with 37 C.F.R. § 42.10. Paper 6 (“Motion”), filed May 13, 2014. The Jewelry Channel, Inc. USA d/b/a Liquidation Channel (“Petitioner”) has not opposed the Motion. Patent Owner also seeks to designate Mr. Roth as back-up counsel in this proceeding. Paper 5 (“Mandatory Notice”), filed May 9, 2014. For the reasons discussed below, we deny the Motion without prejudice.

### **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. 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).

Stephen E. Roth provides uncontroverted testimony that he:

- i. is a membership in good standing of the Tennessee State Bar and the United States District Court for the Eastern District of Tennessee;
- ii. has not been subject to any discipline, 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;

- 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, i.e., he has never appeared before the Office; and
- viii. has familiarity with the subject matter at issue in the proceeding and directs all activities with regard to this proceeding for the Patent Owner.

Lead counsel for Patent Owner, Neil C. Jones, who is registered to practice before the USPTO, has stated that Mr. Roth personally directs all activities with regard to U.S. Patent No. 8,370,211 ("the '211 Patent") and through his involvement with and direction of the '211 Patent, has an established familiarity with the subject matter at issue in this proceeding.

Neither lead counsel's statement of facts, nor Mr. Roth's declaration, sufficiently addresses the scope of Mr. Roth's familiarity with the subject matter at issue in this proceeding. The subject matter of this proceeding is the patentability of the claims under 35 U.S.C. § 101. Petition, 12, 26-44.

The Motion states only that Mr. Roth is General Counsel for the Patent Owner, personally directs all activities with regard to the subject '211 Patent and will direct all matters with regard to the proceeding. Mr. Roth's declaration states

only that he is familiar with the subject matter of the proceeding and directs all activities with regard to this proceeding for the Patent Owner. Neither the Motion nor Mr. Roth's declaration provides any further information concerning the scope of Mr. Roth's familiarity with the subject matter of the proceeding. For example, neither the Motion nor Mr. Roth's declaration represents that Mr. Roth has read the '211 Patent or the Petition. Neither the Motion nor Mr. Roth's declaration states that he is familiar with the prosecution history of the '211 Patent, or has any technical background or particular experience related to the technology covered by the '211 Patent. Neither the Motion nor Mr. Roth's declaration states that Mr. Roth has played any substantive role in the co-pending litigation identified in the Mandatory Notice.

In view of the lack of specific information in the Motion or Mr. Roth's declaration indicating that Mr. Roth has an established familiarity with the subject matter at issue in this proceeding, we deny the Motion without prejudice.

In consideration of the above, it is

ORDERED that the Motion is DENIED without prejudice.

Case CBM2014-00119  
Patent 8,730,211

PETITIONER

Jeffrey Ginsberg  
Michael Turner  
Kenyon & Kenyon LLP  
[jginsberg@kenyon.com](mailto:jginsberg@kenyon.com)  
[mturner@kenyon.com](mailto:mturner@kenyon.com)  
[ptab@kenyon.com](mailto:ptab@kenyon.com)

PATENT OWNER

Neil C. Jones  
Nelson Mullins Riley & Scarborough, LLP  
[neil.jones@nelsonmullins.com](mailto:neil.jones@nelsonmullins.com)