

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED STATES DEPARTMENT OF HOMELAND SECURITY,
Petitioner,

v.

LARRY GOLDEN,
Patent Owner.

Case IPR2014-00714
Patent RE 3,990 E

Before LORA M. GREEN, JON B. TORNQUIST, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

An initial conference was held on Wednesday, November 5, 2014,
among Lavanya Ratnam and William Washington, representing Petitioner;
Anthony Zupcic, Ha Kung Wong, and Diana Danca, representing Patent
Owner; and Judges Green, Tornquist, and Cherry.

Patent Owner, Mr. Larry Golden was unable to be on the call. Counsel for Patent Owner stated that they and Mr. Golden were still in disagreement, and that Mr. Golden was still in the process of finding new counsel. *See, e.g.*, Paper 11 (discussing counsel for Patent Owner's request to withdraw from representation of Patent Owner, Mr. Larry Golden). In that regard, counsel for Patent Owner noted that they have discussed the risks of proceeding *pro se* with Mr. Golden and have directed Mr. Golden to a state bar association that may be able to aid him in finding new counsel.

We urge Mr. Golden to find and retain new counsel as soon as possible. Mr. Golden, in his personal capacity, is the owner of the patent at issue, and thus may proceed *pro se*. As we previously explained to Mr. Golden, given the complexity and very technical nature of these proceedings, *pro se* representation carries significant risk.

In that regard, we note that IPR proceedings are conducted according to a statutorily mandated time frame, with a final decision rendered one year from institution. The Due Date for Patent Owner's Response is January 8, 2015. Paper 13. Patent Owner's discovery period is ongoing and only approximately two months remain. Petitioner relied on the Declaration of Dr. Sriram Vishwanath (Ex. 1005), and thus this would be the period where Patent Owner may wish to depose that witness in preparation for filing the Patent Owner Response.

We noted further during the call that counsel for Patent Owner is authorized to file a motion to withdraw as counsel. Under the Office's current disciplinary rules, "a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice

to his or her client, [and] allowing time for employment of another practitioner.” 37 C.F.R. § 10.40(a). Furthermore, in deciding a motion to withdraw, the Board will consider the effect of granting such a motion “on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” *See* 35 U.S.C. § 316(b).

Although counsel for Patent Owner represented during the conference call that they have explained to Mr. Golden the technical nature of these proceedings, and the possible consequences Mr. Golden may face if he proceeds *pro se*, the motion to withdraw needs to include (1) a statement representing that they have explained to Mr. Golden the possible consequences of the withdrawal of counsel without replacement counsel; and (2) a statement signed by Mr. Golden that he understands those possible consequences.

In addition, we note that the following subjects were discussed during the conference call:

Scheduling Order

Both parties confirmed that they seek no changes to the current Scheduling Order. The parties are reminded that they may stipulate to different dates for DUE DATES 1–5, as provided in the Scheduling Order (Paper 13), by filing an appropriate notice with the Board. The parties are requested to file the request for oral hearing, if desired, by original DUE DATE 4 as set forth in the Scheduling Order, that is, by May 29, 2015.

Protective Order

We noted that a default protective order has not been entered in this case. If the parties file a motion to seal, and no protective order has been

entered, a protective order must accompany the motion as an exhibit. The panel recommended the default protective order in the Office Trial Practice Guide. 77 Fed. Reg. 48,756, Appendix B (Aug. 14, 2012). If the parties choose to deviate from the default protective order, we suggested that the parties schedule a conference with the Board for guidance. Moreover, if the parties deviate from the default protective order, the modifications should be indicated in “redline” when the modified default protective order is submitted to the Board.

Motions to Seal

We reminded the parties that the Board has a strong interest in the public availability of the proceedings. Any motion to seal must be narrowly tailored to the confidential information. The parties are encouraged to stipulate to facts or use other means to present the evidence without the need for a motion to seal. The parties are reminded that information subject to a protective order will become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012).

Deposition Testimony

The panel requested that, if deposition testimony is submitted as an exhibit, the parties should file the full transcript of the deposition rather than excerpts of only those portions being cited by the parties.

Motions

Neither party filed a list of anticipated motions before the initial conference call. In an e-mail dated November 5, 2014, counsel for Patent

Owner included an e-mail that they had sent to Mr. Golden listing the following motions: 1) Motion to Amend Claims; 2) Motion to Exclude Evidence; 3) Motion to Proceed *Pro Se*; and 4) Motion to Substitute Counsel. As to the Motion to Amend claims, while Patent Owner is statutorily authorized to file one such motion, 35 U.S.C. § 316(d), Patent Owner is reminded that before filing the motion he is required to confer with the Board. 37 C.F.R. § 42.121. The Motion to Exclude Evidence is already authorized by the Scheduling Order, and we authorize Patent Owner to file a Motion to Substitute Counsel or Motion to Proceed *Pro Se* in this order.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a non-preauthorized motion should request a conference to obtain authorization to file the motion.

Accordingly, it is

ORDERED that Counsel for Patent Owner is authorized to file a motion to withdraw from representation of Patent Owner;

FURTHER ORDERED that If Mr. Golden should obtain new counsel, counsel for Patent Owner is authorized to file a motion to substitute counsel; and

FURTHER ORDERED that if Mr. Golden is unable to obtain new counsel, Mr. Golden is authorized to file a motion to proceed *pro se*.

Case IPR2014-00714
Patent RE 43,990 E

For PETITIONER:

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