

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner,

v.

VERSATA DEVELOPMENT GROUP, INC.
Patent Owner.

Case CBM2012-00001 (MPT)
Patent 6,553,350

Before MICHAEL P. TIERNEY, *Lead Administrative Patent Judge*, and SALLY C. MEDLEY and RAMA G. ELLURU, *Administrative Patent Judges*.

TIERNEY, *Lead Administrative Patent Judge*.

DECISION
Versata Motion for *Pro Hac Vice* Admission
37 C.F.R. § 42.10

Versata requests *pro hac vice* admission for Mr. Scott L. Cole.¹ SAP opposes Versata's request.²

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice*, the Board required the parties 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.³

Versata represents that good cause exists for Mr. Cole's admission as Mr. Cole is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. Paper 12, ¶ 2. In particular, Versata directs the Board to Mr. Cole's declaration⁴ where Mr. Cole attests to the fact that he represented Versata as "lead counsel in the Versata v. SAP patent infringement litigation (Civil Action No. 07-cv-00153), which involved the same patent at issue in this proceeding." *Id.* Mr. Cole's declaration, in addition to identifying his role as lead counsel in the related litigation, also states that he is a member of the Texas Bar in good standing and that no sanctions or contempt

¹ Versata Motion for Admission *Pro Hac Vice*, Paper 12.

² SAP Opposition to Motion for *Pro Hac Vice* Admission, Paper 15.

³ Order Authorizing *Pro Hac Vice* Motions, Paper 9.

⁴ Declaration of Scott L. Cole in Support of Motion for *Pro Hac Vice* Admission, Paper 13. As explained during a conference call, this paper should have been filed as a separate exhibit and labeled correctly. 37 C.F.R. § 42.63.

citations have ever been imposed against him by any court or administrative body.

Paper 13, ¶¶ 1, 4, and 8.

SAP opposes Mr. Cole's admission stating that his participation could effectively circumvent the restrictions of the underlying district court's protective order. Paper 15, 3. During a conference call, it also became apparent that SAP opposes Versata's reliance on expert witnesses that received access to SAP confidential information in the related litigation, again raising the issue of compliance with the protective order. Order, Paper 16, 6.

To better understand what, if any, impact the district court's protective order has upon this proceeding, the Board requested additional information regarding the protective order. Specifically, the Board required the parties to file any district court rulings related to the protective order, including but not limited to, rulings concerning the scope of the protective order, revisions to the protective order and any violations and enforcement of the protective order. Paper 16, 7.

The parties have filed copies of rulings relating to the district court's protective order. Specifically, Versata has filed a copy of the protective order and a revision to the protective order, Versata exhibits 2001, and 2002. SAP however, filed several additional rulings, including a transcript of a May 14, 2009 motions hearing concerning Versata's protective order violations, with Mr. Cole

representing Versata at the hearing⁵. SAP exhibit, 1024. SAP also provided a Memorandum Opinion and Order that states:

Pending before the Court is Defendant's motion to strike Versata's equitable claims as sanction for Versata's violation of the March 6, 2008 Protective Order and February 26, 2008 Order. (Dkt. No. 144.) The Court held an evidentiary hearing on this issue on May 14, 2009. *The Court finds that Versata breached the plain language of the Protective Order through a pattern of violations involving several members of its litigation team and discovery vendor.* Given Versata's violation of the Court's order, it is fair to stay the injunction the Court has issued in this case. As a result, the Court exercises its equitable discretion in a manner adverse to Versata and stays the injunction pending the disposition of any appeal.

SAP exhibit 1022, 13, emphasis added.

Versata's motion for *pro hac vice* admission of Mr. Cole and Mr. Cole's declaration in support thereof are premised in part on Mr. Cole's position as lead counsel in the related Versata v. SAP litigation. Versata's motion and Mr. Cole's declaration do not address or mention the district court's finding of a pattern of protective order violations in the related litigation for which Mr. Cole was lead counsel.

Versata, as the party moving for *pro hac vice* admission, bears the burden of showing there is good cause for the Board to recognize counsel *pro hac vice* during

⁵ On pages 3-4 of SAP's Submission of Exhibits paper (Paper 19), SAP presents additional arguments why Mr. Cole should not be admitted *pro hac vice* for this proceeding. SAP was not authorized to present such arguments and therefore, those arguments concerning Section I.c. of the Board's Order, Paper 16, will not be considered by the Board.

the proceeding. Based upon the facts presented, the Board concludes that Versata has failed to meet its burden.

It is:

Ordered that Versata's motion for *pro hac vice* admission of Mr. Scott L. Cole is *denied*.

PETITIONER:

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