

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**ScentAir** Technologies, Inc.  
Petitioner

v.

**Prolitec**, Inc.  
Patent Owner

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Case IPR2013-00179 (JL)  
Patent 7,712,683

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Before JAMESON LEE, MICHAEL J. FITZPATRICK, and  
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER

Denying Authorization to File Motion to Disqualify Counsel  
37 C.F.R. § 42.20

Introduction

On April 12, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee, Fitzpatrick, and Crumbley. ScentAir was represented by Mr. Walter Renner and Mr. Kevin Greene; Prolitec was represented

by Ms. Jennifer Gregor. ScentAir initiated the conference call to seek authorization to file a motion to disqualify Prolitec's lead counsel Jennifer Gregor and backup counsel James Peterson (Motion for Admission *pro hac vice* pending (Paper 5)) from representing Prolitec in this proceeding.

During the conference call, counsel for ScentAir (Mr. Walter Renner) explained that:

(A) in related district court litigation [*Prolitec, Inc. v. ScentAir Technologies, Inc.*, Docket No. 2:12-cv-483-RTR (E.D. Wis.)] involving the same patent and between the same parties, there is a protective order barring litigation counsel including Jennifer Gregor and James Peterson from using confidential information obtained in the course of that litigation outside of that litigation, and

(B) ScentAir does not believe Ms. Gregor and Mr. Peterson can be counsel to Prolitec in this trial without revealing confidential information in violation of the protective order of the U.S. District Court for the Eastern District of Wisconsin.

Upon inquiry from the judges:

1. Mr. Renner indicated that nothing in the district court's protective order expressly bars counsel from being counsel of record in an *inter partes* review before the Patent Trial and Appeal Board, although there is a "prosecution bar" in the protective order prohibiting litigation counsel from drafting or amending claims while prosecuting an application before the U.S. Patent and Trademark Office.

2. Mr. Renner indicated that he has no reason to believe that either Ms. Gregor or Mr. Peterson is currently in violation of the district court's protective order but is concerned that they will be if allowed to remain counsel in this proceeding.

3. Mr. Renner indicated that ScentAir will be filing a motion before the U.S. District Court, either today after the conference call, or on the next day, to seek an order from the district court barring litigation counsel from being counsel of record in this *inter partes* review proceeding.

4. Mr. Renner confirmed that ScentAir did not file an opposition to Prolitec's motion to admit James Peterson, *pro hac vice*, in this proceeding.

5. Mr. Renner clarified that if the Board desires to wait for a decision from the U.S. District Court clarifying whether Jennifer Gregor and James Peterson are barred from being counsel of record in this proceeding, then ScentAir requests that in the meantime the Board instruct Ms. Gregor and Mr. Peterson not to work on this proceeding, for instance, in preparing for the patent owner's preliminary response which is currently due on June 14, 2013.

6. Mr. Renner indicated that there are other attorneys in the law firm which employs Jennifer Gregor and James Peterson who should be able to represent Prolitec in this proceeding.

7. Ms. Gregor indicated her belief that she can properly represent Prolitec without violating the District Court's protective order provision about not revealing confidential information acquired during the related litigation.

8. Ms. Gregor indicated that she or Mr. Peterson has already filed a motion before the U.S. District Court for the Eastern District of Wisconsin to seek clarification on the issue of the protective order, *i.e.*, whether it bars litigation counsel from being counsel of record in this proceeding.

9. Ms. Gregor indicated that an expedited decision from the U.S. District Court is likely to be forthcoming on the subject at issue within three weeks to one month of the filing of a motion.

10. Ms. Gregor represents that she and Mr. Peterson have agreed with opposing counsel that they will abide by the clarification to be provided by the U.S. District Court for the Eastern District of Wisconsin on the question of whether litigation counsel are barred from being counsel of record in this proceeding.

#### Discussion

The Board finds informational and key that the protective order at issue specifically bars litigation counsel from prosecution activities without mentioning litigation or trials before the Patent Trial and Appeal Board. An *inter partes* review is not original examination, continued examination, or reexamination of the involved patent. Rather, it is a trial, adjudicatory in nature and constituting litigation. It is also important to note that counsel are subject to sanctions from the U.S. District Court for the Eastern District of Wisconsin for any violation of that court's protective order. We do not presume that either Ms. Gregor or Mr. Peterson will violate the order. ScentAir's assertions in that regard are highly speculative. The Board presumes that counsel will not violate the protective order, and that if it becomes impossible for counsel to represent Prolitec properly without violating the protective order, counsel promptly will bring that issue to the attention of the Board.

ScentAir is not without recourse before the U.S. District Court to address its concerns. It is free to seek any kind of relief it desires before the U.S. District Court insofar as how the protective order should be applied to Ms. Gregor and Mr. Peterson, including seeking an expansion of the order to expressly bar participation in an *inter partes* review. Counsel for ScentAir has represented that ScentAir will be filing such a motion within a day. Even if the normal time period for a decision on an expedited motion is between three weeks to one month, if the matter is of

sufficient importance as ScentAir suggests, ScentAir is not restricted from seeking a more expedited decision from the U.S. District Court.

On the information presented by respective counsel during the conference call, we see no reason to authorize a motion to disqualify Jennifer Gregor or James Peterson from being counsel of record in this proceeding. We therefore deny ScentAir's request for authorization to file such a motion. We also decline to limit the activities of counsel pending clarification by the U.S. District Court of the subject protective order. Note, however, that Prolitec's motion to admit James Peterson *pro hac vice*, dated March 28, 2013 (Paper 5), is still pending, but will be acted on shortly.

#### Order

It is

**ORDERED** that ScentAir is not authorized to file a motion to disqualify Jennifer Gregor or James Peterson from being counsel of record in this proceeding; and

**FURTHER ORDERED** that ScentAir may initiate another telephone conference call with the Board to renew its request, upon receiving indication from the U.S. District Court for the Eastern District of Wisconsin that any protective order entered in that case bars litigation counsel from being counsel of record in an *inter partes* review before the Patent Trial and Appeal Board.

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