

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS TRAVEL
RELATED SERVICES COMPANY, INC., COMPASS BANK, DISCOVER
FINANCIAL SERVICES, DISCOVER BANK, DISCOVER PRODUCTS INC.,
AND STATE FARM MUTUAL AUTOMOBILE INSURANCE COMPANY,

Petitioners

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner

Case CBM2015-000102
Patent 6,237,095

**PATENT OWNER MAXIM INTEGRATED PRODUCTS, INC.'S
MOTION FOR *PRO HAC VICE* ADMISSION OF NATHAN LOWENSTEIN
UNDER 37 C.F.R. § 42.10(c)**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c) and the Notice of Filing Date in this proceeding (Paper 3 at 2), Patent Owner Maxim Integrated Products, Inc. (“Patent Owner”) respectfully requests that the Board admit Nathan Lowenstein *pro hac vice* in this proceeding as back-up counsel.¹

II. GOVERNING LAW, RULES, AND PRECEDENT

Section 42.10(c), 37 C.F.R., provides that:

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. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that

¹ For the convenience of the Board, it is noted that this Motion is identical in its substance to the motions for *pro hac vice* admission of Mr. Lowenstein filed concurrently today in related proceedings CBM2015-00098 and 2015-00101.

counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

The Board has further required that a motion for *pro hac vice* admission be filed in accordance with the “Order - Authorizing Motion for *Pro Hac Vice* Admission” entered in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (P.T.A.B. Oct. 15, 2013) (“*United Patents* Order”).

The *United Patents* Order requires that such motions (1) “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding[,]” and (2) “[b]e accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:”

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;

- v. The individual seeking to appear 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. The individual will be subject to the U.S.P.T.O. 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. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

III. STATEMENT OF FACTS

Based on the following statement of facts, and supported by the Declaration of Nathan Lowenstein, submitted herewith as Exhibit 2009, Patent Owner requests the *pro hac vice* admission of Nathan Lowenstein in this proceeding:

1. Patent Owner's lead counsel, Kenneth J. Weatherwax (the undersigned), is a registered practitioner (Reg. No. 54,528).
2. Mr. Lowenstein is a partner at the law firm of Lowenstein & Weatherwax LLP (Ex. 2009 ¶ 10). Formerly, Mr. Lowenstein was an attorney at the law firm of Irell & Manella LLP. *Id.*

3. Mr. Lowenstein is an experienced litigator, and the majority of his practice has consisted of patent litigation and other patent related matters. *Id.* ¶ 11. Representative patent litigations where Mr. Lowenstein has been actively involved as patent litigation counsel include *Tessera, Inc. v. Micron Technology, Inc. et al.*, 2:05-cv-00094-JDL (E.D. Tex.); *St. Jude Medical, Inc., et al. v. Access Closure, Inc.*, 4:08-cv-04101 (W.D. Ark.); *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 8:08-cv-01123 (C.D. Cal.); *Quantum World Corp. v. Atmel Corp. et al.*, 2:07-cv-00024 (E.D. Tex.). *Id.*
4. Mr. Lowenstein has an established familiarity with the subject matter at issue in this proceeding. *Id.* ¶ 12. He has reviewed the Patent at issue, U.S. Patent No. 6,237,095, as well as two other related patents for which Petitioners have filed a Petition for *Covered Business Method* Review (U.S. Patent Nos. 6,105,013 and 5,940,510). *Id.* He has also reviewed the Petitions and the relevant art in the three proceedings. *Id.* In addition, he participated in drafting of the Patent Owner Preliminary Responses in all three proceedings and, is therefore, intimately familiar with the factual and legal issues in this matter. *Id.*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.