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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAMAHA CORPORATION OF AMERICA
Petitioner

v.

BLACK HILLS MEDIA, LLC
Patent Owner

Case No. IPR2013-00594
U.S. Patent 8,050,652

***Patent Owner's Motion for Pro Hac Vice Admission of
Thomas Engellenner Under 37 C.F.R. § 42.10(c)***

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c) and the Board's authorization to file motions for *pro hac vice* admission in the Order issued September 26, 2013, Patent Owner Black Hills Media ("Patent Owner"), by and through its attorneys, respectfully requests that the Board admit Thomas Engellenner *pro hac vice* in this proceeding.

II. GOVERNING LAW, RULES, AND PRECEDENT

Pursuant to 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 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 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 the Order issued September 26, 2013, the Board requires that a motion for *pro hac vice* admission be filed in accordance with the "Order -- Authorizing Motion for *Pro Hac Vice* Admission" in Case IPR2013-00010 (MPT) ("Representative Order"). The Representative Order states that the motion must "[c]ontain a statement of facts showing there is good cause for the Board to

recognize counsel *pro hac vice* during the proceeding,” and “[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 the C.F.R.; vi) the individual will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.*¹ 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

The following statement of facts, supported by the attached Declaration of Thomas Engellenner in Support of Admission *Pro Hac Vice* (“Engellenner Decl.”), establishes good cause to admit Mr. Engellenner *pro hac vice* in this proceeding.

¹ The USPTO Code of Professional Responsibility in 37 C.F.R. § 10.20 *et seq.* was replaced by the USPTO Rules of Professional Conduct in 37 C.F.R. § 11.101 *et seq.*, effective May 3, 2013.

1. Patent Owner's current lead counsel, Theodosios Thomas, is a registered practitioner (Reg. No. 45,159).
2. Mr. Engellenner is an experienced patent prosecution and patent litigation attorney with more than 30 years of experience. Mr. Engellenner is a partner at the law firm of Pepper Hamilton LLP and is a member of the state bars of Massachusetts and New York. (Engellenner Decl. ¶¶ 1, 8.) Mr. Engellenner is also a registered practitioner before the United States Patent and Trademark Office (Reg. No. 28,711), and is admitted to practice before the U.S. District Court for the District of Massachusetts and the Court of Appeals for the Federal Circuit. (*Id.* ¶ 1.) Mr. Engellenner is a member in good standing in all jurisdictions where he has been admitted to practice. (*Id.*) Mr. Engellenner has neither been suspended nor disbarred from practice before any court or administrative body, nor had an application denied for admission before any court or administrative body. (*Id.* ¶¶ 2-3.) Mr. Engellenner has also never had any sanctions or contempt citations imposed by any court or administrative body. (*Id.* ¶ 4.)
3. Mr. Engellenner has read and agrees to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set

forth in part 42 of the C.F.R. (*Id.* ¶ 5.) As a registered practitioner before the USPTO, Mr. Engellenner understands that he is subject to the USPTO Rules of Professional Conduct 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and affirms that he is subject to the same. (*Id.* ¶ 6.)

4. Mr. Engellenner is currently seeking *pro hac vice* admission in the co-pending, related matters filed by Petitioner, Case Nos. IPR2013-00593, IPR2013-00597, and IPR2013-00598. (*Id.* ¶ 7.) Though Mr. Engellenner has not applied to appear *pro hac vice* in any other proceedings before the USPTO in the last three (3) years, Mr. Engellenner commonly appears before the USPTO in proceedings as a registered USPTO practitioner. (*Id.*)
5. Mr. Engellenner has been engaged by the Patent Owner to represent the Patent Owner before the Board in light of his experience in proceedings before the USPTO. (*Id.* ¶ 9.) Mr. Engellenner has familiarity with the subject matter at issue in this proceeding as well as in co-pending litigations initiated by the Patent Owner against the Petitioner and other entities in various jurisdictions. (*Id.*) Based on his previous experience and study of the particulars of the subject matter raised in the Petition, Mr. Engellenner has acquired a

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