

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

B.E. TECHNOLOGY, L.L.C.
Patent Owner

Case IPR2014-00040
Patent 6,771,290

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

**B.E. Technology's Motion for *Pro Hac Vice* Admission of Daniel J. Weinberg
Pursuant to 37 C.F.R. § 42.10**

Mail Stop Patent Board
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner respectfully requests the Board to recognize Daniel J. Weinberg as counsel *pro hac vice* during this proceeding.¹ Pursuant to 37 C.F.R. § 42.10 and in response to the authorization provided by the United States Patent and Trademark Office’s Patent Trial and Appeal Board (“Board”) in the Notice of Filing Date Accorded to Petition (Paper Number 4, entered October 24, 2013) (“Notice”), Patent Owner B.E. Technology, L.L.C. (“Patent Owner”) submits this motion for Mr. Weinberg to appear *pro hac vice*.

I. *Time for Filing*

Pursuant to the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639² (“Order”), this motion for *pro hac vice* admission is being filed no sooner than twenty-one (21) days after service of the petition.

II. *Good Cause for Additional Back-Up Counsel*

Patent Owner respectfully requests admission of Mr. Weinberg as additional back-up counsel³ to promote attorney availability for the discovery period and trial.

¹ Corresponding motions for *Pro Hac Vice* admission are being concurrently filed in co-pending cases IPR2014-00029, IPR2014-00031, IPR2014-00033, IPR2014-00038, IPR2014-00039, IPR2014-00044, IPR2014-00052, IPR2014-00053, IPR2014-00698, and IPR2014-00699.

² Patent Owner notes that while the Notice references the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00010 (MPT), the Order in Case IPR2013-00639 states that the Final Rule regarding Changes to Representation of Others Before the United States Patent and Trademark Office removes part 10 of title 37 C.F.R. referred to in the Order in Case IPR2013-00010 (MPT). Accordingly, for purpose of this proceeding, Patent Owner will refer to the Order in Case IPR2013-00639.

³ Patent Owner is concurrently filing corresponding motions for *Pro Hac Vice* admission for Jessica N. Leal as additional back-up counsel.

Patent Owner has a sufficient need for the admission of additional back-up counsel. The Board has instituted nine separate *inter partes* review (“IPR”) trials against two B.E. Technology, L.L.C. patents. Five more IPR petitions have been filed with motions for joinder, bringing the total to fourteen IPRs. Patent Owner has to conduct discovery, including deposing five experts, three of whom have offered opinions on both patents. In order to efficiently and effectively cover the ground necessary in these IPRs, Patent Owner seeks the *pro hac vice* admission of additional back-up counsel. This request is accompanied by the attached Power of Attorney.

III. *Statement of Facts*

Pursuant to the Order, the following statement of facts, supported by the attached Declaration of Mr. Weinberg, shows that there is good cause for the Board to recognize Mr. Weinberg *pro hac vice*.

Lead counsel for this proceeding, Jason S. Angell, is a registered practitioner (Reg. No. 51408).

Mr. Weinberg is an experienced litigation attorney, and has served as counsel in numerous complex cases and patent infringement litigations in various district courts. Mr. Weinberg has not been suspended or disbarred from practice, and he has not had any application for admission to practice denied, or had any sanctions or contempt citations imposed against him. Mr. Weinberg is an active

member in good standing of the California Bar and is admitted to practice before the United States Court of Appeals for the Ninth Circuit, the United States Court of Appeals for the Federal Circuit, the U.S. District Court for the Northern District of California, the United States District Court for the Central District of California, and the U.S. District Court for the Western District of Tennessee. Mr. Weinberg's mailing address is Freitas Angell & Weinberg LLP, 350 Marine Parkway, Suite 200, Redwood Shores, California 94065; his email address is dweinberg@fawlaw.com, and his direct dial telephone number is (650) 730-5501.

Mr. Weinberg is a member of the litigation team for Patent Owner in *B.E. Technology, L.L.C. v. Microsoft Corporation*, No. 2:12-cv-02829, a co-pending litigation in the U.S. District Court for the Western District of Tennessee. That action involves U.S. Patent No. 6,771,290 ("’290 Patent"), the patent at issue in this proceeding. In his role as counsel in the co-pending case, Mr. Weinberg is knowledgeable about the ’290 Patent and assertions regarding the invalidity of the ’290 patent. Further, Mr. Weinberg is familiar with the factual and legal matters at issue in that case, including the claim construction issues likely to be presented there. Mr. Weinberg has thus established familiarity with the subject matter at issue in this proceeding.

Mr. Weinberg has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of the

C.F.R., and he agrees to be subject to the USPTO 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). Mr. Weinberg has not applied *pro hac vice* in any other proceeding before the United States Patent and Trademark Office in the last three years, other than in co-pending *inter partes* review proceedings involving B.E. Technology patents.

Patent Owner has expended significant resources in the co-pending litigation with Mr. Weinberg as counsel, and Patent Owner wishes Mr. Weinberg to represent it in this proceeding.

IV. *Affidavit or Declaration of Individual Seeking to Appear*

This motion for *pro hac vice* admission is accompanied by a Declaration of Mr. Weinberg as required by the Order.

V. *Conclusion*

The facts contained in the Statement of Facts above, and contained in the Declaration of Mr. Weinberg, establish that there is good cause to admit Mr. Weinberg *pro hac vice* in this proceeding under 37 C.F.R. § 42.10(c).

Date: May 29, 2014

Respectfully submitted,

By: /s/ Jason S. Angell
Jason S. Angell
Reg. No. 51408
Counsel for Patent Owner

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