

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY, INC.
Petitioner

v.

PAICE LLC & THE ABELL FOUNDATION, INC.
Patent Owner

Case IPR2014-00579
Patent 7,104,347

**PATENT OWNER PAICE LLC & THE ABELL FOUNDATION, INC.
MOTION FOR *PRO HAC VICE* ADMISSION
UNDER 37 C.F.R. § 42.10(c)**

Pursuant to 37 C.F.R. § 42.10(c), the Patent Owner (“Paice LLC & the Abell Foundation, Inc., hereinafter PAICE & ABELL”) respectfully requests that the Board recognize William Peter Guarnieri as counsel *pro hac vice* in this proceeding. Patent Owner seeks the counsel of William Peter Guarnieri due to his experience in representing PAICE & ABELL in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on April 11, 2014.

Statement of Facts

Mr. Guarnieri is an attorney whose practice focuses on patent litigation in Federal District Courts and Section 337 proceedings before the International Trade Commission. He has been involved in cases covering a broad range of technologies, including complex software applications, 3D graphics accelerators, portable audio docks, consumer digital cameras, hybrid-electric vehicles, and photonic integrated circuits. Through his practice in such cases, Mr. Guarnieri has gained substantial experience in trials, discovery procedures, depositions, Markman hearings, and briefing pleadings on various aspects of patent law. Mr. Guarnieri received his J.D. from Georgetown University Law Center in 2011, where he was on the Executive Board of the American Criminal Law Review. He

received his B.A. in Computer Science from Duke University in 2004. Prior to practicing law, Mr. Guarnieri was a software consultant/developer for a software company in the DC area. Mr. Guarnieri was involved in developing enterprise software systems for a number of clients, including the U.S. Army's Army Knowledge Online portal. PAICE & ABELL provides Exhibit A, as evidence, Mr. Guarnieri's biography.

Mr. Guarnieri also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. Mr. Guarnieri represents PAICE & ABELL in two related matters: *Paice LLC, et. al. v. Hyundai Motor Co., et. al.*, No. CIV. WDQ-12-0499 (D. Md.) and *Paice LLC, et. al. v. Ford Motor Company*, No. CIV. WDQ-14-cv-00492 (D. Md.). Both cases are currently pending in the U.S. District Court for the District of Maryland, and both involve U.S. Patent 7,104,347, as well as other patents in the same family. In particular, Mr. Guarnieri has been intimately involved in every aspect of *Paice v. Hyundai*, which has been ongoing since early 2012. PAICE & ABELL have invested significant financial resources in each of these related matters in which Mr. Guarnieri is serving as counsel. Moreover, through his representation in the related matters, PAICE & ABELL has developed a particular relationship with Mr. Guarnieri such that PAICE & ABELL desires to continue the relationship with Mr. Guarnieri for the purpose of this proceeding.

1. Declaration of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of William Peter Guarnieri as required by the Order Authorizing Motion for *Pro Hac Vice* mailed April 11, 2014.

Accordingly, PAICE & ABELL submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize William Peter Guarnieri as counsel *pro hac vice* during this proceeding.

Respectfully submitted,

Date: April 3, 2015

/Timothy W. Riffe/

Timothy W. Riffe

Reg. No. 43,881

Counsel for Patent Owner

Customer Number 26171
Fish & Richardson P.C.
Telephone: (202) 626-6429
Facsimile: (202) 783-2331

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on April 3, 2015, a complete and entire copy of this Patent Owner's Motion for *Pro Hac Vice* and Declaration of William Peter Guarnieri was provided via electronic mail to Counsel for Petitioner by serving the correspondence address of record as follows:

Frank A. Angileri
John Nemazi, John Rondini
Brooks Kushman P.C.
1000 Town Center
Twenty-Second Floor
Southfield, Michigan 48075
Email: FPGP0101IPR3@brookskushman.com

Lissi Mojica
Kevin Greenleaf
Dentons US LLP
1530 Page Mill Road
Suite 200
Palo Alto, California 94304-11251
Email: lissi.mojica@dentons.com
Email: kevin.greenleaf@dentons.com
Email: iptdocketchi@dentons.com

/Susan C. Johnson/
Susan C. Johnson
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(214) 292-4086