

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND TRIAL APPEAL BOARD

Mercedes-Benz USA, LLC and
Mercedes-Benz U.S. International, Inc.,
Petitioner
v.
Velocity Patent LLC
Patent Owner

Inter Partes Review No.: 2014-01247
Patent No.: 5,954,781

**MOTION FOR *PRO HAC VICE* ADMISSION OF
JAMES A. SHIMOTA
UNDER 37 C.F.R § 42.10**

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Velocity Patent LLC respectfully requests that the Board recognize Mr. James A. Shimota as counsel *pro hac vice* during this proceeding.

1. Time for Filing

Per Paper No. 3, this Motion is being filed no sooner than twenty-one (21) days after service of the Petition, as required by the Order Authorizing Motion for *Pro Hac Vice* Admission entered October 15, 2013 in Case IPR2013-00639, Paper 7 (the “**PHV Order**”).

2. Statement of Facts

As dictated by the PHV Order, the following statement of facts illustrates that there is good cause for the Board to recognize Mr. Shimota *pro hac vice*.

Mr. Shimota is an experienced litigator, who has been involved in numerous litigations involving patent infringement in various District Courts throughout the United States. He has experience litigating patent disputes before judges, juries, the International Trade Commission, and international arbitrators. Mr. Shimota’s biography is attached hereto as Exhibit A.

Mr. Shimota is intimately familiar with the subject matter in question in this proceeding, as he is is lead counsel for the Patent Owner in the co-

pending litigation, *Velocity Patent LLC v. Mercedes-Benz USA, LLC, et al.*, No. 1:13-cv-08413 (N.D. Ill. 2013) (the “**Pending Litigation**”).

In the Pending Litigation, Mr. Shimota has been involved in, *inter alia*, crafting case strategy and infringement contentions, all of which are relevant to the pending *inter partes* review of U.S. Patent No. 5,954,781. The Patent Owner wishes to apply Mr. Shimota’s knowledge of the patent by employing him as counsel in this proceeding.

Further, counsel for the Petitioner does not oppose Mr. Shimota appearing *pro hac vice* during this proceeding.

The Patent Owner’s lead and backup counsel are registered practitioners and Mr. Shimota is an experienced litigation attorney having familiarity with the subject matter at issue in this proceeding. Therefore, the Patent Owner respectfully submits that there is good cause for the Board to recognize Mr. Shimota as counsel *pro hac vice* during this proceeding.

3. Affidavit or Declaration of Individual Seeking to Appear

This Motion is accompanied by an Affidavit of Mr. James A. Shimota, as required by the PHV Order.

Dated: December 2, 2014

Respectfully submitted,

/Patrick D. Richards/

Patrick Richards (Reg. No. 48,905)

Richards Patent Law P.C.

Willis (Sears) Tower

233 S. Wacker Dr., 84th Floor

Chicago, IL 60606

Telephone: (312) 283-8555

Counsel for Patent Owner

**AFFADAVIT OF MR. JAMES A. SHIMOTA
IN SUPPORT OF
MOTION FOR *PRO HAC VICE* ADMISSION**

I, James A. Shimota, being duly sworn and upon oath, hereby attest to the following:

- 1) I am a member in good standing of the Bar of the state of Illinois (Bar # 6270603), as well as the following Federal Courts:
 - a) U.S. Court of Appeals for the Federal Circuit;
 - b) United States Court of Appeals for the Sixth Circuit
 - c) U.S. District Court for the Northern District of Illinois;
- 2) I have not been suspended or disbarred from practice before any court or administrative body;
- 3) I have never had an application for admission to practice before any court or administrative body denied;
- 4) No sanction or contempt citation has been imposed against me by any court or administrative body;
- 5) I have 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.;

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