

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIERRA WIRELESS AMERICA, INC., SIERRA WIRELESS, INC.;  
and RPX CORP.

Petitioner

v.

M2M SOLUTIONS LLC  
Patent Owner

Patent No. 8,648,717

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**PETITIONER'S MOTION FOR SUBSTITUTION OF COUNSEL  
AND *PRO HAC VICE* ADMISSION OF RONALD F. LOPEZ  
UNDER 37 C.F.R. § 42.10**

### **I. Relief Requested**

Pursuant to 37 C.F.R. § 42.10(c), Petitioner respectfully moves the Board to recognize counsel Ronald F. Lopez (“Mr. Lopez”) *pro hac vice* for purposes of the above-captioned *inter partes* review. Pursuant to 37 C.F.R. § 42.10(e), Petitioners respectfully request that Mr. Robert E. Krebs withdraw as counsel for Petitioners and substitute Mr. Lopez as back-up counsel for Mr. Krebs.

Patent Owner does not oppose the Motion.

### **II. Authorization for This Motion**

The Board authorized Petitioners to file this Motion on May 6, 2016.

### **III. Statement Showing Good Cause to Recognize Mr. Lopez *pro hac vice***

Good cause exists to recognize Mr. Lopez *pro hac vice*. The undersigned lead counsel, Jennifer Hayes, is a registered practitioner. As set forth in the accompanying Affidavit In Support Of Motion for *Pro Hac Vice* Admission of Ronald F. Lopez (Ex. A), Mr. Lopez is an experienced patent litigation attorney with an established familiarity with the subject matter at issue in this *inter partes* review. (Ex A at ¶¶ 10-11.) U.S. Patent No. 8,648,717 is currently asserted against Petitioners Sierra Wireless and Sierra Wireless America, Inc. in a co-pending litigation, M2M SOLUTIONS LLC v. SIERRA WIRELESS AMERICA, INC., et al., C.A. No. 1:14-cv-01102-RGA. The co-pending litigation is currently

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stayed. Mr. Lopez is lead counsel for Sierra Wireless and Sierra Wireless America in the co-pending litigation and, as such, has an established familiarity with the subject matter at issue in this proceeding. In the co-pending litigation, Mr. Lopez reviewed prior art references and claim charts for invalidity contentions and was involved in forming claim construction positions. Mr. Lopez is also lead counsel for Sierra Wireless and Sierra Wireless America in a co-pending litigation involving two patents related to the patent at issue, M2M SOLUTIONS LLC v. SIERRA WIRELESS AMERICA, INC., et al., C.A. No. 1:12-cv-00030-RGA. In that co-pending litigation of the two related patents, Mr. Lopez reviewed prior art references and claim charts for invalidity contentions, was involved in forming claim construction positions and drafting claim construction briefs, and was involved in drafting summary judgment motions relating to invalidity and non-infringement.

Mr. Lopez is a member in good standing of the bar of the state of California. (Ex A at ¶ 3.) Mr. Lopez has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials (Ex A at ¶ 7), and further understands that he will be subject to the USPTO Code of Professional Responsibility. (Ex A at ¶ 8.)

Petitioner respectfully submits that there is good cause for the Board to recognize Mr. Lopez as counsel *pro hac vice* during this proceeding.

**IV. Statement Showing Good Cause for the Board to Authorize Withdrawal and Substitution of Counsel**

Mr. Robert E. Krebs is currently designated as back-up counsel on behalf of Petitioners. Mr. Krebs passed away unexpectedly last month. Accordingly, for good cause, Petitioners request that the current designed back-up counsel, Mr. Krebs, be deemed withdrawn from the present proceeding. There is no change to lead counsel for Petitioners.

As set forth above, good cause exists to recognize Mr. Lopez *pro hac vice* during this proceeding. For good cause, Petitioners request the Board to substitute Mr. Lopez as back-up counsel for Petitioners.

**VI. Conclusion**

Petitioners respectfully request that the Board grant its motion to recognize Mr. Lopez *pro hac vice* during this proceeding and authorize withdrawal of back-up counsel and permit substitution of Mr. Lopez as back-up counsel. Upon grant of this motion, Petitioners will promptly file Substitute Powers of Attorney.

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Respectfully submitted,

Dated: May 9, 2016

By: /Jennifer Hayes/

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