

IPR2016-01159
U.S. Pat. No. 8,694,657

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK INC.
Petitioner
v.

WINDY CITY INNOVATIONS, LLC
Patent Owner

U.S. Pat. No. 8,694,657
Issue Date: April 8, 2014
Title: REAL TIME COMMUNICATIONS SYSTEM

**WINDY CITY INNOVATIONS, LLC'S MOTION FOR *PRO HAC VICE*
ADMISSION OF ALFRED R. FABRICANT PURSUANT TO 37 C.F.R. §
42.10**

Case No. IPR2016-01159

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10 and Patent Owner's Request for Authorization to file for *Pro Hac Vice* admission filed concurrently herewith and dated January 17, 2017, Patent Owner, Windy City Innovations, LLC, requests that the Board admit Alfred R. Fabricant *pro hac vice* in this proceeding.

II. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE COUNSEL PRO HAC VICE DURING THE PROCEEDING

In accordance with 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon 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. 37 C.F.R. § 42.10(c) states that, "where lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding." The facts here establish good cause for the Board to recognize Alfred R. Fabricant *pro hac vice* during this proceeding:

1. Lead counsel, Vincent J. Rubino, III, is a registered practitioner.
2. Counsel, Alfred R. Fabricant, is an experienced patent litigator and has an established familiarity with the subject matter at issue in the proceeding.

Accompanying this motion is the Declaration of Alfred R. Fabricant in Support of

this Motion for Admission *Pro Hac Vice* of Alfred R. Fabricant (“Fabricant Decl.”) In his declaration, Mr. Fabricant attests that he is a member in good standing of the Bar of the States of New York and Arizona, and is also admitted to practice in the United States District Courts for the Southern District of New York, the Eastern District of New York, the District of Arizona, and the Eastern District of Texas; the United States Courts of Appeal for the Federal Circuit, the Second Circuit, and the Fourth Circuit; and the United States Supreme Court. Fabricant Decl. ¶2.

3. Mr. Fabricant is an experienced litigating attorney. He has over 20 year of patent litigation experience. Fabricant Decl. ¶1. Mr. Fabricant has been a first-chair litigator in over 30 patent infringement cases. Fabricant Decl. ¶1.

4. Mr. Fabricant also attests that he is familiar with the subject matter and patent-at-issue in this proceeding. He has spent a substantial amount of time becoming familiar with the subject matter of the patent-at-issue, including reviewing the patent itself, the patent’s file history, the pertinent prior art, the Petition, and the accompanying exhibits. He has spent a substantial amount of time becoming similarly familiar with the subject matter of the patents-at-issue in related IPR proceedings. Mr. Fabricant has spent a substantial amount of time becoming familiar with the papers and exhibits filed in the instant proceeding and the related proceedings involving Windy City Innovations, LLC, which include:

IPR2016-01067 (U.S. Pat. No. 8,407,356), IPR2016-01137 (U.S. Pat. No. 8,473,552), IPR2016-01138 (U.S. Pat. No. 8,473,552), IPR2016-01141 (U.S. Pat. No. 8,458,245), IPR2016-01146 (U.S. Pat. No. 8,473,552), IPR2016-01147 (U.S. Pat. No. 8,473,552), IPR2016-01155 (U.S. Pat. No. 8,694,657), IPR2016-01156 (U.S. Pat. No. 8,458,245), IPR2016-01157 (U.S. Pat. No. 8,407,356), IPR2016-01158 (U.S. Pat. No. 8,473,552), and IPR2016-01159 (U.S. Pat. No. 8,694,657). Fabricant Decl. ¶7.

5. Mr. Fabricant attests to each of the *pro hac vice* declaration requirements listed in the Board’s Order in Case No. IPR2013-00639 (Paper 7). Fabricant Decl., ¶¶ 1–10.

6. Mr. Fabricant has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R. Fabricant Decl., ¶ 5.

7. Mr. Fabricant 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) and to be subject to the USPTO Rules of Professional Conduct as set forth in Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013). Fabricant Decl., ¶ 6.

8. Mr. Fabricant attests that, in the last three years, he has applied to

appear *pro hac vice* in the following proceedings before the Office: IPR2016-0018 (granted, Paper 23 entered May 4, 2016); IPR2016-00418 (granted, Paper 11 entered May 3, 2016); IPR2016-00419 (granted, Paper 10 entered May 3, 2016); IPR2016-00421 (granted, Paper 11 entered May 19, 2016); and IPR2016-00422 (granted, Paper 10 entered May 19, 2016). Fabricant Decl., ¶ 8.

III. CONCLUSION

The requirements for admission *pro hac vice* being hereby established, Patent Owner respectfully requests that the Board admit Alfred R. Fabricant *pro hac vice* as back-up counsel in this proceeding.

Respectfully submitted,

Dated January 17, 2017

/Vincent J. Rubino, III /
Lead Counsel for Petitioner

Vincent J. Rubino, III (Reg. No. 68,504)
Lead Counsel for Petitioner
Brown Rudnick LLP
7 Times Square
New York, NY 10036
Tel: 212-209-4800
Fax: 212-209-4801
Email: vrubino@brownrudnick.com

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