

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

I.M.L. SLU,

Petitioner,

v.

WAG ACQUISITION, LLC,

Patent Owner.

Case IPR2016-01656

Patent 8,122,141

**PETITIONER I.M.L. SLU'S UNOPPOSED MOTION FOR *PRO HAC VICE*
ADMISSION OF BETH D. JACOB UNDER 37 C.F.R. § 42.10**

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Pursuant to 37 C.F.R. § 42.10, and pursuant 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 and Time for Filing Patent Owner Preliminary Response (Paper Number 3, September 1, 2016) (“the Notice”), Petitioner I.M.L. SLU submits this motion for Beth D. Jacob to appear *pro hac vice*. Petitioner respectfully requests the Board to recognize Ms. Jacob as counsel *pro hac vice* during this proceeding, and demonstrate good cause for doing so as shown below.

I. TIME FOR FILING

Pursuant to the authorization provided in the Notice, as well as the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (Oct. 15, 2013) (“the Order”), this motion for *pro hac vice* admission is being filed no sooner than twenty-one (21) days after service of the Petition.

II. STATEMENT OF FACTS

Pursuant to the Order, the following statement of facts shows that good cause exists for the Board to recognize Ms. Jacob *pro hac vice*.

Lead counsel for this proceeding, David R. Yohannan, is a registered practitioner (Reg. No. 37,480).

Ms. Jacob is an experienced litigation attorney with three decades of litigation experience. Ex. 1013 ¶ 8. She has been involved in numerous patent infringement cases in federal district courts across the country. *Id.* She has experience in various aspects of patent infringement matters, including trials, *Markman* hearings, and summary judgment hearings. *Id.* She has argued in multiple patent cases in federal courts. *Id.*

Ms. Jacob is a member in good standing of the New York State Bar and is admitted to practice before the United States Supreme Court, the United States Court of Appeals for the Federal Circuit, the United States Court of Appeals for the Second Circuit, and the United States District Courts for the Southern and Eastern Districts of New York. *Id.* ¶ 1.

Ms. Jacob has not been suspended or disbarred from practice, has never had any application for admission to practice denied, and has never had any sanctions or contempt citations imposed against her. *Id.* ¶¶ 2-4.

Ms. Jacob is trial counsel for the Petitioner in the patent litigation against Patent Owner concerning the patent challenged in the Petition (*WAG Acquisition, LLC v. Sobonito Investments, Ltd. et al.*, Case No. 2:14-cv-1661-ES-JAD (D.N.J.)). *Id.* ¶ 8. As a result of Ms. Jacob's involvement as trial counsel for the Petitioner in co-pending district court litigation over the involved patent, Ms. Jacob has obtained substantial familiarity with the involved patent, the prior art, and the

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various issues raised in this proceeding. Moreover, Ms. Jacob has reviewed the involved patent, the Petition, the prior art, and other cited materials. *Id.* Given her patent litigation experience—including patent litigation on behalf of Petitioner—and her familiarity with the instant Petition, the cited materials, and the patented technology, Ms. Jacob has established familiarity with the subject matter at issue in this proceeding. *Id.*

Ms. Jacob 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 she agrees to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶¶ 5-6. Ms. Jacob has not applied to appear *pro hac vice* in the last three years in any other matter before the Board. *Id.*

Given that Ms. Jacob is a trusted advisor to Petitioner on matters involving the litigation of patent disputes—including patent litigation concerning the patent at issue here—and her familiarity with the subject matter at issue in this proceeding, Petitioner respectfully submits that it has shown good cause for the Board to recognize Ms. Jacob as counsel *pro hac vice* during this proceeding.

III. AFFIDAVIT OR DECLARATION OF INDIVIDUAL SEEKING TO APPEAR

This Motion is accompanied by a Declaration of Ms. Jacob as required by the Order.

Dated: October 26, 2016

Respectfully submitted,

/David R. Yohannan/

David R. Yohannan

Reg. No. 37,480

Lead Counsel for Petitioner

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