

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner

v.

VELOCITY PATENT, LLC,
Patent Owner

Case IPR2017-01723
U.S. Patent 5,954,781

PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
JAMES A. SHIMOTA

Pursuant to 37 C.F.R. § 42.10 and the Notice authorizing leave to file this motion (Paper No. 3), Patent Owner Velocity Patent, LLC (“Patent Owner”) requests that the Board admit James A. Shimota *pro hac vice* in this proceeding.

**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 a 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. Section 42.10(c) indicates 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 established familiarity with the subject matter at issue in the proceeding.” The facts here establish good cause for the Board to recognize James A. Shimota *pro hac vice* during this proceeding.

1. Lead Counsel, Howard E. Levin, is a registered practitioner.
2. James A. Shimota is an experienced litigator and has an established familiarity with the subject matter at issue in the proceeding.
3. Attached to this motion as Exhibit 2001 is the Declaration of James A.

Shimota, where he attests, *inter alia*, that he is a member of good standing of the Bar for the State of Illinois, the U.S. Court of Appeals for the Federal Circuit, U.S. Court of Appeals for the Sixth Circuit, and U.S. District Court for the Northern District of Illinois.

4. Mr. Shimota further attests that he has been litigating patent cases for eighteen years, and has litigated patent proceedings in the Northern District of Illinois, Eastern District of Texas, Eastern District of Virginia, Northern and Central Districts of California, Eastern District of Wisconsin, Northern District of Ohio, Eastern District of Pennsylvania, Districts of Delaware and Massachusetts, and the International Trade Commission, including arguing motions for summary judgment on validity issues and disputed claim terms at Markman hearings.
5. Mr. Shimota further attests that he is familiar with the subject matter at issue in this proceeding. He is lead counsel for Patent Owner in the underlying district court proceedings: *Velocity Patent LLC v. Mercedes-Benz USA, LLC*, *Mercedes-Benz U.S. International, Inc.*, No. 1:13-cv-08413 (N.D. Ill. 2013) and *Velocity Patent LLC v. FCA US LLC*, No. 1:13-cv-08419 (N.D. Ill. 2013). He was also lead counsel in three related cases involving the challenged patent that have settled: *Velocity Patent LLC v. Audi of America, Inc., et al.*, No. 1:13-cv-08418 (N.D. Ill. 2013), as well as litigation in the

Northern District of Illinois against BMW (Case No. 1:13-cv-08416), and Jaguar Land Rover (Case No. 1:13-cv-08421). Mr. Shimota attested in his Declaration that he has appeared before the judges in the above-identified district court proceedings for conferences and motion hearings, and in the Audi, Mercedes, and FCA cases for summary judgment of invalidity and claim construction hearings for U.S. Patent 5,954,781. In connection with these matters, he has familiarized himself with the patent at issue, its underlying file history, the background technology, and the prior art references at issue.

6. In his Declaration, Mr. Shimota also attests to each of the listed items required by 37 C.F.R. § 42.10(c).

Conclusion

For the foregoing reasons, Patent Owner respectfully requests that the Board admit James A. Shimota *pro hac vice* in this proceeding

Date: August 15, 2017

Respectfully submitted

/Howard Levin/

Howard Levin

Registration No. 50,480

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of August, 2017, a copy of the Patent Owner's Motion For *Pro Hac Vice* Admission of James A. Shimota, including the Declaration of James A. Shimota In Support Of Patent Owner's Motion For Admission *Pro Hac Vice* attached as Exhibit 2001, has been served in its entirety by electronic mail on counsel of record for the Petitioner:

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Respectfully submitted

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