

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION AND ZTE (USA) INC.
Petitioners,

v.

HITACHI MAXELL, LTD.,
Patent Owner

Case: IPR2018-00236

U.S. Patent No. 8,339,493

**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
JAMIE B. BEABER PURSUANT TO 37 C.F.R. § 42.10(c)**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Case IPR2018-00236

Patent No. 8,339,493

Patent Owner's Motion for *Pro Hac Vice* Admission

PATENT OWNER'S EXHIBIT LIST

| Description | Exhibit # |
|---|------------------|
| Claim Construction Memorandum and Order (Dkt. 175), Case 5:16-cv-178 (E.D. Tex.) | 2001 |
| Declaration of Jamie B. Beaber in Support of Motion for <i>Pro Hac Vice</i> Admission | 2002 |

Pursuant to 37 C.F.R. § 42.10(c) and in response 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 (Paper Number 3, entered December 5, 2017) ("Notice"), Patent Owner Maxell ("Patent Owner") hereby files this motion for Jamie B. Beaber to appear *pro hac vice* on its behalf, as back-up counsel, before the Board in IPR2018-00236.¹ This motion follows the guidelines set forth in IPR2013-00639, Paper 7, entered October 15, 2013 ("Order").

I. TIME FOR FILING

Pursuant to 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 there is good cause for the Board to recognize Mr. Beaber *pro hac vice*.

Lead counsel for this proceeding, Robert G. Pluta, is a registered practitioner (Registration No. 50,970).

¹ Corresponding motions for *pro hac vice* admission are being concurrently filed in co-pending cases IPR2018-00235, IPR2018-00238, IPR2018-00239 and IPR2018-00240.

Mr. Beaber is an experienced litigation attorney, and has been involved in numerous patent infringement cases in the U.S. International Trade Commission and in federal District Courts across the country. He has experience in various aspects of patent infringement matters including trials, Markman hearings, and summary judgment hearings. Mr. Beaber is a member in good standing of the District of Columbia Bar and the Michigan Bar, and is admitted to practice before the United States Court of Appeals for the Federal Circuit, the District of Columbia Court of Appeals, and the United States District Courts for the Eastern District of Texas and the District of Columbia. Mr. Beaber has not been suspended or disbarred from practice, never had any application for admission to practice denied, nor had any sanctions or contempt citations imposed against him.

Mr. Beaber is lead counsel for the plaintiff, which includes Patent Owner, in a co-pending litigation, *Maxell, Ltd. v. ZTE Corporation, et al.*, Case No. 5:16-cv-00179-RWS, pending in the United States District Court for the Eastern District of Texas. That litigation involves U.S. Patent No. 8,339,493 (“the ’493 Patent”), the same patent at issue in this proceeding. In his role as lead counsel in the co-pending litigation, Mr. Beaber has reviewed and is familiar with the ’493 Patent, the infringement theories, asserted prior art references, and invalidity claim charts. Further, Mr. Beaber has been involved and is familiar with the factual and legal

arguments at issue in that case. As such, Mr. Beaber has established familiarity with the subject matter at issue in this proceeding.

Mr. Beaber has 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., and he 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). Mr. Beaber is concurrently applying to appear *pro hac vice* in IPR2018-00235, IPR2018-00238, IPR2018-00239 and IPR2018-00240. In the last three years, Mr. Beaber has applied to appear *pro hac vice* before the Board in connection with IPR2018-00209, IPR2018-00210 and IPR2018-00233 on February 28, 2018.

Patent Owner has expended significant financial resources in the co-pending litigation with Mr. Beaber as counsel, and Patent Owner wishes to continue using Mr. Beaber in this proceeding.

As such, Patent Owner respectfully submits that there is good cause for the Board to recognize Mr. Beaber as counsel *pro hac vice* during this proceeding.

III. AFFIDAVIT OR DECLARATION OF INDIVIDUAL SEEKING TO APPEAR

This Motion for *pro hac vice* admission is accompanied by a Declaration of Mr. Beaber as required by the Order (Ex. 2002).

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