UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERRILL COMMUNICATIONS LLC d/b/a MERRILL CORPORATION,

Petitioner,

v.

E-NUMERATE SOLUTIONS, INC.,

Patent Owner.

Patent No. 9,262,383

Issue Date: February 16, 2016

Case: **IPR2018-01391**

Title:
SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR PROCESSING A MARKUP DOCUMENT

MOTION FOR *PRO HAC VICE* ADMISSION
37 C.F.R. § 42.10

This Motion for *Pro Hac Vice* Admission is being filed by Merrill Communications LLC d/b/a Merrill Corporation ("Merrill") in the IPR proceeding captioned in the title page of this submission. Petitioner requests the admission of Adam R. Steinert *pro hac vice* in the IPR proceeding captioned above. Petitioner submits herewith a Declaration of Adam R. Steinert in Support of this Motion for *Pro Hac Vice* Admission.

Mr. Steinert is well-versed in the technical and legal issues raised in the IPR Petition, and is especially qualified to serve as backup counsel for Merrill in this matter. As explained in the attached declaration, Mr. Steinert has an undergraduate degree in physics from Harvard University, and has specialized in patent litigation for the past 14 years. (*See* Steinert Decl. ¶¶ 9-10.) Mr. Steinert has experience with a wide range of technologies relevant to this IPR proceeding, including computer software and hardware, markup languages, and data manipulation programs. (*See id.* ¶¶ 11-12.)

Mr. Steinert is also particularly well versed in the subject matter and procedural history of the challenged '383 patent. He is counsel of record for Merrill in the pending district court patent litigation over the '383 patent. (*See id.* ¶¶ 12-13.) Mr. Steinert was intimately involved in the drafting of the Petitions for IPR in this proceeding and the companion proceedings challenging U.S. Patent No. 7,650,355 (case no. IPR 2018-01394), U.S. Patent No. 8,185,816 (case no.

IPR2018-01392), and U.S. Patent No. 9,268,748 (case no. IPR2018-01389). (*See id.* ¶ 14.)

In the course of his representation of Merrill, Mr. Steinert has reviewed and analyzed the '383 patent and its prosecution history in detail. (*See id.* ¶¶ 13-15.) He has also reviewed and analyzed the referenced prior art, all of the papers filed in the district court lawsuit, all of the exhibits to the IPR Petition, and, of course, the Petition itself. (*See id.*) Mr. Steinert has a particularly high level of knowledge regarding Merrill's prior art contentions raised in this Petition, the companion IPR2018-01394, IPR2018-01392, and IPR2018-01389 petitions, and the district court litigation, because Mr. Steinert assisted in drafting Merrill's submissions. (*See id.*)

Pursuant to 37 C.F.R. § 42.10(c) and IPR2013-00639, Paper No. 7, Merrill further notes that Mr. Steinert is a member in good standing of the state bars of Minnesota and New York, and is admitted to practice before multiple federal courts. (*See* Steinert Decl. ¶ 2.) No court or administrative body has ever (a) suspended or disbarred him from practice; (b) denied his application to practice; or (c) sanctioned him or cited him for contempt. (*See id.* ¶¶ 3-5.) Mr. Steinert has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials. (*See id.* ¶ 6.) He has also acknowledged that he will 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). (*See id.* ¶ 7.) Mr. Steinert has previously applied to appear *pro hac vice* before the Board in five cases within the last three (3) years, IPR2015-00482, IPR2015-00491, IPR2016-01460, IPR2016-01463, and IPR2017-00202. (*See id.* ¶ 8.) The Board granted all of those applications, and Mr. Steinert argued on behalf of the petitioner at the oral hearing in all five cases. (*See id.*)

For the foregoing reasons, Petitioner Merrill respectfully requests that this Motion for *Pro Hac Vice* Admission be granted, and that Adam R. Steinert be admitted to appear *pro hac vice* in the IPR proceeding captioned above.

Respectfully submitted,

/ Katherine J. Rahlin /
Katherine J. Rahlin
krahlin@fredlaw.com
Attorney for the Petitioner
Registration No. 75,181

Fredrikson & Byron, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402-1425

Dated: August 14, 2018

Declaration of Adam R. Steinert in Support of

Motion for *Pro Hac Vice* Admission

I, Adam R. Steinert, declare as follows:

1. I am a shareholder with Fredrikson & Byron, P.A., and am one of the lawyers representing Petitioner Merrill Communications LLC d/b/a Merrill Corporation ("Merrill") in connection with the IPR Proceeding captioned on the title page of this submission and related proceedings in federal district court.

2. I am a member in good standing of the following Bars: State of Minnesota, State of New York, U.S. Court of Appeals for the Federal Circuit, U.S. Court of Appeals for the Eighth Circuit, U.S. District Court for the District of Minnesota, U.S. District Court for the Northern District of Illinois, and U.S. District Courts for the Southern and Eastern Districts of New York.

3. I have never received a suspension or disbarment from practice before any court or administrative body.

4. I have never been denied any application or admission to practice before any court or administrative body.

5. I have never been sanctioned by or received contempt citations from any court or administrative body.

6. I have 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.

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