

Case No. IPR2019-00514
Patent No. 5,904,172

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN NATIONAL MANUFACTURING INC.,
Petitioner,

v.

SLEEP NUMBER CORPORATION
f/k/a SELECT COMFORT CORPORATION,
Patent Owner.

Case No. IPR2019-00514

Patent No. 5,904,172

**PETITIONER'S UNOPPOSED MOTION FOR
PRO HAC VICE ADMISSION OF
MARK A. THORNHILL UNDER 37 C.F.R. § 42.10(c)**

Pursuant to 37 C.F.R. § 42.10, American National Manufacturing, Inc. (“Petitioner”) respectfully requests the *pro hac vice* admission of Mark A. Thornhill into the present proceeding (IPR2019-00514).

I. Introduction

This motion is filed further to the Notice of Filing Date Accorded to Petition and Time for filing Patent Owner Preliminary Response, Paper No. 4 (the “Notice”), which authorizes motions for *pro hac vice* admission under 37 C.F.R. § 42.10. Further to the Notice, this motion is filed in accordance with the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7 (the “Order”) and no sooner than twenty-one (21) days after service of the petition. In accordance with the Order, this motion includes the following Statement of Facts, as well as a Declaration of Mark A. Thornhill in Support of Motion for *Pro Hac Vice* Admission, attached hereto and made part of hereof (the “Thornhill Declaration”).

II. No Opposition to this Motion

The parties met and conferred on this issue November 7, 2019, and Patent Owner counsel does not oppose the *pro hac vice* admission request of Mr. Mark A. Thornhill.

III. Statement of the Facts

Lead counsel for Petitioner, Kyle L. Elliott, is a patent attorney registered to practice before the USPTO. Mr. Elliott will remain as lead counsel. Mr. Thornhill will become a back-up counsel.

Mr. Thornhill is an experienced litigator, and patent litigator with an established familiarity with the subject matter at issue in this proceeding, e.g., U.S. Patent No. 5,904,172 (the “‘172 Patent”), at least by virtue of Mr. Thornhill’s active role as co-counsel in the matter of *Select Comfort Corporation v. American National Manufacturing, et al.* (337-ITC-971) before the International Trade Commission. Thornhill was substantially involved with that litigation and is familiar with all facets of the dispute, including but not limited to, the subject matter of the ‘172 Patent and its relationship with the prior art.

Mr. Thornhill works closely with the undersigned lead and back-up counsel in this matter. Mr. Thornhill has reviewed, and is familiar with, the Petition for *Inter Partes Review* of the ‘172 Patent (Paper No. 1), the prior art cited in the petition, the arguments and factual assertions made by this petition, the file history of the ‘172 Patent, and the papers filed in this proceeding to date.

Patent Owner has identified eight (8) declarants as part of its Response. Due to the volume of adverse declarants, Mr. Thornhill’s entry of appearance is necessary to assist in the conducting of the depositions of these declarants.

IV. Argument

Upon a showing of good cause, the Board may admit counsel who are not registered practitioners to appear *pro hac vice* in IPR and other Board proceedings.

The applicable rule provides as follows:

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. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

37 C.F.R. § 42.10(c).

As seen in the Statement of Facts above and in the accompanying declaration, the conditions for admission *pro hac vice* have been satisfied. In particular, Mr. Thornhill is an experienced litigator and has ample familiarity with the subject matter at issue in this IPR proceeding. Mr. Thornhill has never been censured, disciplined, suspended, nor denied admission by any court or administrative body. Further, Mr. Thornhill agrees to comply with or be subject to all relevant procedural and ethical rules. Finally, a registered practitioner, the undersigned Mr. Elliott, will

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remain lead counsel, and Mr. Tuttle and Mr. Hare, registered practitioners, shall remain back-up counsel.

V. Conclusion

In view of the foregoing and the attached Thornhill Declaration, Petitioner most respectfully submits that there is good cause for the Board to recognize Mr. Thornhill *pro hac vice* as additional back-up counsel in this IPR.

Date: November 21, 2019

Respectfully Submitted,
SPENCER FANE LLP

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