

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT and
BMW OF NORTH AMERICA, LLC,
Petitioners,

v.

PAICE LLC and
THE ABELL FOUNDATION, INC.,
Patent Owners.

IPR2020-00994
Patent 7,104,347 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION
Granting Petitioners' Motion for
Pro Hac Vice Admission of Jacob Z. Zambrzycki
37 C.F.R. § 42.10

Petitioner filed a motion for *pro hac vice* admission of Jacob Z. Zambrzycki (Paper 7 (“Motion” or “Mot.”)) in the above-identified proceeding. A supporting Declaration from Mr. Zambrzycki was included as part of the Motion. Ex. 1059 (“Declaration”). Petitioner represents that Patent Owner does not object to Mr. Zambrzycki being admitted *pro hac vice* in this proceeding. Mot. 2.

In accordance with 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear in the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

In this proceeding, lead counsel for Petitioner, Jeffrey D. Sanok, a registered practitioner, filed the Motion. Mot. 4. In the Motion, Petitioner contends there is good cause for the Board to recognize Mr. Zambrzycki *pro hac vice* during this proceeding because he “is an experienced litigation attorney,” “is extremely familiar with the subject matter at issue in these proceedings,” and “has gained relevant technical knowledge and experience in the field of electric hybrid vehicles and the various prior art references cited in the Petition.” *Id.* at 2–3; *see* Ex. 1059 ¶ 7.

Mr. Zambrzycki’s Declaration complies with the requirements for *pro hac vice* admission. Ex. 1059 ¶¶ 1–7; *see Unified Patents*, slip op. at 3–4. In particular, Mr. Zambrzycki states, *inter alia*, the he is a member in good

standing of the Bars of the States of New York and California, has never been suspended, disbarred, sanctioned, or cited for contempt by any court or administrative body, and has never had a court or administrative body deny his application for admission to practice. Ex. 1059 ¶¶ 1–3.

Having reviewed the Motion and supporting Declaration, we determine good cause exists for granting admission *pro hac vice* to Mr. Zambrzycki.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Motion is *granted*, and Jacob Z. Zambrzycki is authorized to represent Petitioner only as back-up counsel in the above-identified proceeding;

FURTHER ORDERED that a registered practitioner will continue to represent Petitioner as lead counsel in the above-identified proceeding;

FURTHER ORDERED that Mr. Zambrzycki shall comply with the November 2019 PTAB Consolidated Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Mr. Zambrzycki is subject to the USPTO's Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and to the USPTO's disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

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