

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT &
BMW OF NORTH AMERICA, LLC,**
Petitioners

v.

PAICE LLC & THE ABELL FOUNDATION, INC.
Patent Owners

Inter Partes Review No.: IPR2020-01299
U.S. Patent No. 8,630,761

**DECLARATION OF JACOB Z. ZAMBRZYCKI IN SUPPORT OF
MOTION FOR *PRO HAC VICE* ADMISSION UNDER 37 C.F.R. § 42.10**

BMW v. Paice, IPR2020-01299

Zambrzycki *Pro Hac Vice* Declaration

I, Jacob Z. Zambrzycki, do hereby declare as follows:

1. I am a member in good standing of the Bar of the State of New York, the Bar of the State of California, the Bar of the State of North Carolina, as well as the following federal courts:
 - a. U.S. Court of Appeals for the Federal Circuit;
 - b. U.S. District Courts for the Southern District of New York;
 - c. U.S. District Court for the Central District of California; and
 - d. U.S. District Court for the Northern District of California;
2. I have never been suspended, disbarred, sanctioned, or cited for contempt by any court or administrative body.
3. I have never had a court or administrative body deny my application for admission to practice.
4. 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 Title 37 of the Code of Federal Regulations.
5. I agree to be subject to the United States Patent and Trademark Office 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).
6. Within the past three (3) years, I have applied to appear *pro hac vice* before the Office, and was granted permission to do so, in IPR2017-00981,

IPR2017-01263, IPR2017-01533, IPR2017-01866, IPR2019-00569, IPR2019-00570, and in the related IPR2020-00994. I am presently submitting this application for admission *pro hac vice* simultaneously in the related IPR2020-01299 and IPR2020-01386 proceedings.

7. I have substantial familiarity with the subject matter at issue in this *inter partes* review proceeding, specifically the challenged patent, and the various prior art references cited in the Petition. I was involved in preparing the Petition in this proceeding; indeed, I was involved in preparing the Petition cited in each of the related IPR2020-00994, IPR2020-01299, and IPR2020-01386 proceedings.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

9. A copy of my biography is enclosed herein.

Zambrzycki *Pro Hac Vice* Declaration

Respectfully submitted,

Dated: March 31, 2020

/Jacob Z. Zambrzycki/
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BMW v. Bisc. JPB2020-01200



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Practices

- Intellectual Property Litigation
- Litigation & Trial
- Blockchain / Distributed Ledger Technology (DLT)
- Digital Transformation
- Emerging Companies & Venture Capital
- IP Strategy, Prosecution & Portfolio Management
- Appellate
- U.S. International Trade Commission Section 337 Unfair Import Investigations
- Digital Health/MedTech
- Intellectual Property

Jacob Z. Zambrzycki is a partner in Crowell & Moring's New York office with a background in computer science. Jacob focuses his practice on intellectual property litigation and counseling, and on regulatory counseling with respect to blockchain-based technologies. He has been recognized as an intellectual property Rising Star every year since 2017 by *Super Lawyers* magazine.

Jacob has litigated and tried numerous intellectual property actions in federal district courts around the country and litigated numerous *inter partes* review proceedings before the U.S. Patent and Trademark Office, Section 337 Investigations at the U.S. International Trade Commission, and appeals at the U.S. Court of Appeals for the Federal Circuit. In his consulting practice, Jacob advises clients regarding protection and enforcement of their intellectual property, and provides regulatory and other legal advice to companies involved with blockchain technology and digital assets. His clients comprise both emerging and Fortune 500 companies spanning various industries, including consumer electronics, automotive technologies, railroads, medical devices, financial services, cryptocurrencies, electrical fittings, pharmaceuticals, and internet technologies.

Jacob earned a bachelor's degree in computer science from Boston College, where he focused on software development, and a juris doctor from Brooklyn Law School, where he was a Fellow at the Center for the Study of International Business Law.

He is a native Polish speaker.

Representative Engagements:

- Represented Respondent DuPont in an ITC Section 337 Investigation related to synthetic roof underlayment products in which the Complainant was forced to withdraw its Complaint and to move to terminate the Investigation mere days after the ALJ issued a claim construction order fatal to Complainant's

BMW v. Price, IPR2020-01200

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