

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT &
BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

PAICE LLC & THE ABELL FOUNDATION, INC.,
Patent Owner.

IPR2020-01299 (Patent 8,630,761 B2)
IPR2020-01386 (Patent 7,237,634 B2)

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.¹

PESLAK, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motions
for *Pro Hac Vice* Admission of Jacob Z. Zambrzycki
37 C.F.R. § 42.10

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

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Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC (collectively “Petitioner”) filed a motion for *pro hac vice* admission of Jacob Z. Zambrzycki in each of the above-captioned proceedings. Paper 16 (“Mot.,” “Motion”).² Petitioner states in each Motion that “Patent Owners have indicated that they do not oppose this motion.” Mot. 2. The Motions are *granted*.

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* Paper 4, 2 (citing *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”)) (“Notice”).

In each Motion, Petitioner states that there is good cause for the Board to recognize Jacob Z. Zambrzycki *pro hac vice* during these proceedings because “Mr. Zambrzycki is an experienced litigation attorney,” “has been involved in numerous litigations involving patent infringement in U.S. District Courts across the country, the U.S. Court of Appeals for the Federal Circuit, and the International Trade Commission,” and “has been a litigation attorney for over 10 years, and has represented a wide range of clients in patent litigation matters.” Mot. 2. Petitioner further states that “Mr.

² We cite to Papers in IPR2020-01299. Similar items were filed in IPR2020-01386.

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Zambrzycki is extremely familiar with the subject matter at issue in this proceeding” because he “was involved in preparing the Petition in this proceeding[] and in the related [IPRs],” in which he is applying for or has been granted permission to appear *pro hac vice*, and, “[t]hroughout this process, Mr. Zambrzycki 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 3.

Each Motion is supported by a Declaration (including a biography) of Mr. Zambrzycki (Ex. 1087, “Decl.”) that attests to the statements above and complies with the requirements set forth in the Notice. *See* Decl. ¶¶ 1–9.

Upon consideration, Petitioner has demonstrated that Mr. Zambrzycki has sufficient legal and technical qualifications and familiarity with the subject matter at issue, and that there is a need for Petitioner to have counsel with his experience. *See, e.g.*, Decl. ¶¶ 1, 7, 9; Mot. 2–4. Petitioner therefore has established good cause for admitting Mr. Zambrzycki *pro hac vice* in each of the above-captioned proceedings.

Accordingly, it is

ORDERED that Petitioner’s Motions for *pro hac vice* admission of Jacob Z. Zambrzycki in the above-captioned proceedings are *granted*; Mr. Zambrzycki is authorized to act as back-up counsel in these proceedings only;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for these proceedings;

FURTHER ORDERED that Mr. Zambrzycki shall comply with the Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019), and

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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 Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq.

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