

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner

v.

STRATOSAUDIO, INC.,
Patent Owner

Case No. IPR2021-00716

U.S. Patent No. 8,688,028

**PETITIONER VOLKSWAGEN GROUP OF AMERICA, INC.'S
UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF
THOMAS R. MAKIN PURSUANT TO 37 C.F.R. § 42.10(c)**

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Volkswagen Group of America, Inc. respectfully requests that the Patent Trial and Appeal Board (“the Board”) admit Thomas R. Makin *pro hac vice* as back-up counsel in this proceeding. Petitioner understands Patent Owner StratosAudio, Inc. to not oppose this motion.

I. Statement of Facts Showing There is a Good Cause for the Board to Admit Counsel *Pro Hac Vice*

“The Board may recognize counsel *pro hac vice* in 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.” 37 C.F.R. § 42.10(c). “[W]here 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 a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.* The facts here establish good cause for the Board to admit Thomas R. Makin *pro hac vice* during this proceeding, so that he may participate in, *inter alia*, oral hearings, depositions, and conferences with the Board.

1. Lead Counsel, Eric S. Lucas, is a registered practitioner.
2. As set forth in the accompanying Declaration of Thomas R. Makin in Support of Petitioner’s Unopposed Motion for Admission *Pro Hac Vice* (“Makin Decl.”), Mr. Makin is admitted to practice law in New York, and in the United States District Court for the Eastern District of New York, the United States

District Court for the Southern District of New York, the United States District Court for the Eastern District of Michigan, and the United States Court of Appeals for the Federal Circuit. Makin Decl., ¶ 3.

3. Mr. Makin has not been suspended or disbarred from practice before any court or administrative body, denied admission to practice before any court or administrative body, or sanctioned or cited for contempt by any court or administrative body. Makin Decl., ¶¶ 6–8.

4. Mr. Makin is an experienced litigating attorney. More specifically, he has more than 20 years of litigation experience, with a focus on patent infringement proceedings in federal court. Makin Decl., ¶ 4.

5. Mr. Makin has an established familiarity with the subject matter at issue in this proceeding, having represented Petitioner, Volkswagen Group of America, Inc., as a defendant in a related litigation in the United States District Court for the Western District of Texas, Case No. 6:20-cv-01131-ADA. In the related litigation, Patent Owner has asserted U.S. Patent No. 8,688,028 against Petitioner. Mr. Makin's experience representing Petitioner in the related litigation involving the same patent brought by the same Patent Owner provides him with an established familiarity with the subject matter at issue in the current proceeding. Makin Decl., ¶ 5.

6. Mr. Makin has attested that he has 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., and that he will be subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and the USPTO Rules of Professional Conduct as set forth in Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013). Makin Decl., ¶¶ 9–10.

7. Mr. Makin is also applying to appear *pro hac vice* in the following *inter partes* review proceedings involving patents owned by Patent Owner and asserted against Petitioner in the above-referenced district court case: IPR2021-00712, IPR2021-00720, and IPR2021-00721; and he has been admitted *pro hac vice* in the following *inter partes* review and covered business method review proceedings in the past three years: IPR2019-00397, IPR2019-00398, CBM2019-00019, CBM2019-00020, CBM2019-00022, CBM2019-00023, CBM2019-00024, IPR2019-01259, IPR2019-01260, IPR2019-01261, IPR2019-01487, IPR2019-01488, and IPR2020-00908. Makin Decl., ¶ 11.

II. Conclusion

The requirement for admission *pro hac vice* being hereby established, Petitioner respectfully requests that the Board admit Thomas R. Makin *pro hac vice* as backup counsel in this proceeding.

Dated: December 23, 2021

/Eric S. Lucas/

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