

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZYXEL COMMUNICATIONS CORPORATION,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

IPR2021-00734
Patent No. 8,265,096

**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
HENNING SCHMIDT**

Patent Owner UNM Rainforest Innovations (“UNM” or “Patent Owner”) respectfully requests that the Board recognize and admit Henning Schmidt as counsel *pro hac vice* to represent UNM during the above-captioned proceeding. The bases and support for UNM’s requests are as follows.

1. Timing of UNM’s Request

UNM’s motion is being filed no sooner than twenty-one (21) days after the service of the petition.

2. Good Cause Bases for UNM’s Request

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel is a registered practitioner and a declaration of the party seeking admission is included with the Request. 37 C.F.R. § 42.10(c). Good cause has been shown where, for example, the attorney for which *pro hac vice* admission is sought is an experienced patent litigator and has a familiarity with the subject matter at issue in the proceeding, and the admission of the party’s counsel will facilitate the party’s ability to effectively participate in the proceeding. UNM respectfully submits that all of these conditions have been met here.

UNM’s lead counsel, Jay P. Kesan, is a registered practitioner. As demonstrated by his declaration, Mr. Schmidt is an experienced litigator who has litigated patent infringement cases for various parties in federal district courts

throughout the United States and before the Court of Appeals for the Federal Circuit. *Id.* at ¶¶ 3-7. Mr. Schmidt's legal career spans over fifteen (15) years. *See Id.* at ¶ 2. Mr. Schmidt has extensive experience in litigating patent infringement cases and has served as lead counsel in such cases. *Id.* at ¶ 6. Mr. Schmidt has been previously admitted to practice *pro hac vice* before the Board and has participated in trials before the Board. *Id.* at ¶ 11.

Mr. Schmidt has read and is familiar with the patent at issue in this proceeding and its file history, as well as the prior art and other arguments that have been asserted by Petitioner.

UNM submits that Mr. Schmidt's participation will assist it and its lead counsel in effectively participating in this proceeding and will facilitate timely completion of the trial proceeding.

Mr. Schmidt has never been suspended, disbarred, sanctioned, or cited for contempt by any court or administrative body, and has never had an application for admission to practice before a court or agency denied. *Id.* at ¶¶ 7-8. Mr. Schmidt is a member in good standing of the Bar of Texas. *Id.* at ¶ 2. Mr. Schmidt agrees to be subject to the Office Patent Trial Practice Guide, the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R., and the USPTO's Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*, and submit to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* at ¶¶ 9-10.

3. Conclusion

For the foregoing reasons, UNM respectfully requests that the PTAB recognize Henning Schmidt as its counsel, *pro hac vice*, in this proceeding.

Respectfully submitted,

Dated: June 2, 2021

/Jay P. Kesan/

Jay P. Kesan Reg. No. 37,488

Counsel for Patent Owner

UNM Rainforest Innovations

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.25(b), the undersigned certifies that on April 29, 2021, a complete copy of *Patent Owner's Motion for Pro Hac Vice Admission of Henning Schmidt* was filed electronically through the Patent Trial and Appeal Board's PTABE2E System and provided, via electronic service, to the Petitioner by serving the correspondence address of record as follows:

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Dated: June 2, 2021

/Jay P. Kesan /

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