

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AGILTRON, INC.,
Petitioner

v.

MEMSCAP S.A.,
Patent Owner

Patent 6,262,512
Issue Date: July 17, 2001

Title: THERMALLY ACTUATED MICROELECTROMECHANICAL
SYSTEMS INCLUDING THERMAL ISOLATION STRUCTURES

Case IPR: IPR2016-01683

**PATENT OWNER'S MOTION FOR *PRO HAC VICE*
ADMISSION OF BENJAMIN T. HORTON**

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I. Requested Relief

Pursuant to 37 C.F.R. § 42.10 and the Board's "Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response," (Paper No. 3), dated September 7, 2016, the Patent Owner requests the Board to admit Benjamin T. Horton *pro hac vice* in this proceeding to serve as backup counsel for MEMSCAP S.A. in this *inter partes* review.

II. Statement of Facts Showing Good Cause for the Requested Relief

The Board may recognize counsel *pro hac vice* during an *inter partes* review proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose. *See* 37 C.F.R. § 42.10(c). Where "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 Patent Owner respectfully submits that the following facts establish good cause for the Board to recognize Mr. Horton *pro hac vice* during this proceeding.

Further, the Board requires that a motion for *pro hac vice* admission be filed in accordance with the "Order – Authorizing Motion for Pro Hac Vice Admission" in Case IPR2013-00639, Paper 7 ("Representative Order"). The Representative

Order states that the motion must “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel pro hac vice during the proceedings,” and “[b]e accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:”

1. Lead counsel, Michael P. Furmanek, is a registered practitioner (Registration No. 58,495).
2. Back-up counsel, Ryan N. Phelan, is a registered practitioner (Registration No. 60,674).
3. Mr. Horton is a partner at the law firm of Marshall, Gerstein & Borun LLP. (See Exh. 2001 (Horton Declaration) at ¶ 1.)
4. Mr. Horton has been practicing in the field intellectual property, and particularly patent litigation, for approximately eleven years. (*Id.* at ¶ 2.)
5. Mr. Horton is a member in good standing of the Bar of the State of Illinois, as well as the United States District Court for the Northern District of Illinois, including the Trial Bar for the Northern District of Illinois, and has also been admitted to practice *pro hac vice* in a number of other Federal District courts. (*Id.* at ¶ 3.)
6. Mr. Horton has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶ 4.)

7. Mr. Horton has never had an application for admission to practice before any court or administrative body denied. (*Id.* at ¶ 5.)
8. Mr. Horton has never had sanctions or contempt citations imposed upon him by any court or administrative body. (*Id.* at ¶ 6.)
9. Mr. Horton 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 the Code of Federal Regulations. (*Id.* at ¶ 7.)
10. Mr. Horton has read and will abide by and be subject to the U.S. Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. § 11.101 *et. seq.* and the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.* at ¶ 8.)
11. Mr. Horton has been admitted in proceedings before the Office in the past three years, specifically IPR2014-01536. (*Id.* at ¶ 9.)
12. Mr. Horton is lead counsel for MEMSCAP S.A. in related litigation involving the '512 patent, *MEMSCAP, S.A. v. Agiltron, Inc.*, C.A. 1:15-cv-00796-RGA (D. Del.). (*Id.* at ¶ 10.)
13. Mr. Horton is an experienced litigation attorney and he is familiar with the subject matter at issue in the proceeding. He has spent substantial time reviewing and analyzing the patent at issue in this proceeding, its file history, the Petition and the references cited therein. (*Id.* at ¶ 11.) As a

result, Mr. Horton has acquired substantial understanding of the underlying legal and technological issues at stake in this proceeding. Patent Owner has spent time and resources consulting with Mr. Horton as counsel in this and other matters involving the patent at issue in this proceeding and wishes to continue using Mr. Horton as counsel in this proceeding. (*Id.*)

14. Further, in his declaration, Mr. Horton attests to each of the listed items required by 37 C.F.R. § 42.10(c). (*See Id.* at ¶¶ 1-12.)

III. Conclusion

For the foregoing reasons, Patent Owner respectfully requests the Board to admit Benjamin T. Horton *pro hac vice* in this proceeding to serve as backup counsel for MEMSCAP S.A. in this *inter partes* review.

Respectfully submitted,

September 20, 2016

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