

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAHOOT! ASA & KAHOOT EDU, INC.,
Petitioner

v.

AVIEL D. RUBIN,
Patent Owner

Inter Partes Review Case No. IPR2023-00693

Patent No. 9,064,376

**PETITIONERS' MOTION FOR *PRO HAC VICE* ADMISSION OF BRIAN C.
BANNER PURSUANT TO 37 C.F.R. § 42.10(c)**

Mail Stop Patent Board
Patent Trial and Appeal Board
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.10(c), Petitioner respectfully moves the Patent Trial and Appeal Board to recognize counsel Brian C. Banner *pro hac vice* for purposes of the above-captioned *inter partes* review.

I. AUTHORIZATION FOR THIS MOTION

This motion was authorized pursuant to the Board's notice according a filing date to the petition. (Paper No. 3, March 16, 2023.)

II. STATEMENT OF FACTS - GOOD CAUSE EXISTS TO GRANT THIS MOTION

Good cause exists to recognize Mr. Banner *pro hac vice*. The undersigned lead counsel, R. William Beard Jr., is a registered practitioner. Further, facts supporting this motion are set forth in the accompanying Declaration In Support Of Motion For *Pro Hac Vice* Admission of Brian C. Banner (Ex. 1022).

a. Bar Membership.

Mr. Banner is admitted to practice in Texas and is a member in good standing of the Texas State Bar. (Ex. 1022 ¶ 2.)

b. No Suspensions or Disbarments.

Mr. Banner has not been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 3.)

c. No Denied Applications.

Mr. Banner has never been denied an application for admission to practice before any court or administrative body. (*Id.* ¶ 4.)

d. No Sanctions.

Mr. Banner has never been sanctioned or cited for contempt by any court or administrative body. (*Id.* ¶ 5.)

e. Board Guide and Rules.

Mr. Banner 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. (*Id.* ¶ 6.)

f. USPTO Rules of Professional Conduct.

Mr. Banner will be subject to the USPTO 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). (*Id.* ¶ 7.)

g. Pro Hac Vice Appearances.

Mr. Banner has applied to appear *pro hac vice* before the Office in the last three (3) years in the following proceedings:

Patent Quality Assurance, LLC v. VLSI Technology LLC, IPR2021-01229 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00123 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00147 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00148 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00168 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00177 (PTAB);

Microchip Technology Incorporated et al. v. Bell Semiconductor, LLC,
IPR2021-00191 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR2020-00367 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR 2020-00374 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR2020-00383 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR2020-00386 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR2020-00390 (PTAB);

Nuvoton Technology Corporation v. Microchip Technology Incorporated,
IPR2020-00394 (PTAB). (*Id.* ¶ 8.)

h. Familiarity with Subject Matter.

Mr. Banner is an experienced litigation attorney with an established familiarity with the subject matter at issue in this *inter partes* review. Mr. Banner has reviewed the patent at issue and the relevant art and played a significant role in drafting the Petition. Mr. Banner's practice consists mainly of patent litigation and other patent related matters such as PTAB litigations and matters before the United States Court of Appeals for the Federal Circuit. (*Id.* ¶ 9.) Mr. Banner received his B.S. from Carnegie Mellon University and his J.D. from the University of Texas School of Law. (*Id.* ¶ 10.)

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board admit Mr. Banner *pro hac vice* in this proceeding.

Dated: October 17, 2023

Respectfully submitted,

/s/ R. William Beard, Jr.

R. William Beard, Jr. (Reg. No. 39,903)

Brian C. Banner (*Pro Hac Vice*)

Petitioners' Motion for *Pro Hac Vice* Admission

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Attorneys for Petitioner

LIST OF EXHIBITS

1001	Rubin, U.S. Patent 9,064,376 (“the ’376 patent”)
1002	Declaration of Sigurd Meldal, Dr.Scient.
1003	Prosecution History File Wrapper of the ’376 patent (excerpts)
1004	U.S. Patent 9,497,565 (“Zha”)
1005	CN 2013/10674692 (“Zha-Priority-Application”)
1006	Certified English translation of the <i>Zha-Priority-Application</i>
1007	U.S. Patent Pub. 2015/0011318 (“Takahashi”)
1008	PCT/JP2012/007595 (“Takahashi-Priority-Application”)
1009	Certified English translation of <i>Takahashi-Priority-Application</i>
1010	U.S. Patent Pub. 2014/0006485 (“Tsushima”)
1011	U.S. Patent 9,591,083 (“Gumbula”)
1012	U.S. Patent Pub. 2012/0017236 (“Stafford”)
1013	U.S. Patent 9,330,531 (“Wakeford”)
1014	Patent Owner’s Preliminary Infringement Contentions in <i>Rubin v. Kahoot! ASA et al.</i> , Civil Action No. 6:22-cv-00236 (W.D. Tex.) (Sept. 28, 2022)
1015	U.S. Patent Pub. 2012/0253841 (“’841 Application”)
1016	U.S. Patent Pub. 2012/0209770 (“’770 Application”)
1017	U.S. Patent Pub. 2014/0121015 (“Massing”)
1018	U.S. Patent Pub. 2006/0058088 (“Crawford”)
1019	March 10, 2023 Email from W.Beard (Petitioner) to E.Benisek (PO)
1020	FedEx Proof of Delivery of Service Copy of Petition
1021	March 14, 2023 Email from E.Benisek (PO) to D.Adams (Petitioner)
1022	Declaration in Support of Motion for <i>Pro Hac Vice</i> Admission (Brian C. Banner)

CERTIFICATE OF SERVICE

The undersigned hereby certifies the above-captioned Petitioner's Motion for *Pro Hac Vice* Admission of Brian C. Banner Pursuant to 37 C.F.R. § 42.10(c) was served in its entirety on October 17, 2023, upon the following parties by sending a copy via email to the following addresses:

Robert S. McArthur (mcarthur@vblaw.com)

Eric W. Benisek (ebenisek@vblaw.com)

Respectfully submitted,

/s/ R. William Beard, Jr.

R. William Beard, Jr. (Reg. No. 39,903)

Brian C. Banner (*Pro Hac Vice*)

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