

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.

Case No. IPR2023-00693

Patent No. 9,064,376

**PATENT OWNER'S MOTION FOR ERIC W. BENISEK TO APPEAR *PRO*
HACE VICE PURSUANT TO 37 C.F.R. § 42.10(c)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the Board’s “NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE” (Paper No. 3, March 16, 2023), authorizing the filing of this motion for *pro hac vice* admission under 37 C.F.R. § 42.10(c), Aviel D. Rubin (“Patent Owner”) respectfully moves the Patent Trial and Appeal Board to recognize counsel Eric W. Benisek *pro hac vice* for the purposes of the above-captioned *inter partes* review.

II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION

- Patent Owner Exhibit 2003 - Declaration of Eric W. Benisek In Support Of Motion To Appear *Pro Hac Vice* (“Benisek Decl.”).

III. STATEMENT OF MATERIAL FACTS - GOOD CAUSE EXISTS FOR RECOGNIZING MR. BENISEK *PRO HAC VICE* IN THIS *INTER PARTES* PROCEEDING

Good cause exists to recognize Mr. Benisek *pro hac vice*. Pursuant to 37 C.F.R. § 42.10(c), “[t]he Board may recognize counsel *pro hac vice* during 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. For example, where the 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 showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” The undersigned lead counsel, Robert S. McArthur, is a registered practitioner and holds Registration Number 45,674. Further facts supporting this motion are set forth in the accompanying Declaration In Support Of Motion For Pro Hac Vice Admission of Eric W. Benisek (Ex. 2003). The Patent Owner has made all of the required showings under 37 C.F.R. § 42.10(c), and there is good cause for recognizing Mr. Benisek *pro hac vice*.

A. Bar Membership

Mr. Benisek is admitted to practice in California and is a member in good standing with the California Bar. (Ex. 2003, ¶3.)

B. No Suspensions or Disbarments

Mr. Benisek not been suspended or disbarred from practice before any court or administrative body. (*Id.*, ¶4.)

C. No Denied Applications

Mr. Benisek has had no application for admission to practice before any court or administrative body ever denied. (*Id.*, ¶5.)

D. No Sanctions

Mr. Benisek has had no sanctions or contempt citations imposed by any court or administrative body. (*Id.*, ¶6.)

E. Board Guide and Rules

Mr. Benisek 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.*, ¶7.)

F. USPTO Rule of Professional Conduct

Mr. Benisek will be subject to the United States Patent and Trademark Office 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.*, ¶11.)

G. *Pro Hac Vice* Appearances

Mr. Benisek has not applied to appear *pro hac vice* in any proceedings before the Office in the last three (3) years. (*Id.*, ¶12.)

H. Familiarity With Subject Matter

Mr. Benisek has twenty years of experience as a practicing litigation and intellectual property attorney, which includes extensive involvement with complex patent litigation matters as lead counsel in the U.S. District Courts and the Federal Circuit Court of Appeals. In addition, Mr. Benisek has established specific

familiarity with the legal subject matter, technical subject matter, state of the art and prior art involved with U.S. Patent No. 9,064,376 B1 (the “’376 patent”). Mr. Benisek is counsel of record for the Patent Owner in a U.S. District Court proceeding involving the infringement of claims of the ’376 patent and the defense of the validity of claims of the ’376 patent. He has also worked with the Patent Owner and technical expert engaged by the Patent Owner to learn and understand the inventions disclosed and claimed in the ’376 patent. Accordingly, Mr. Benisek has extensive litigation experience and has familiarity with the subject matter at issue in this proceeding. (*Id.*, ¶¶ 2, 8-10.)

V. CONCLUSION

Based on the above, and having satisfied the requirements of 37 C.F.R. §42.10(c), the Patent Owner hereby moves for an Order permitting Eric W. Benisek to appear *pro hac vice* on behalf of the Patent Owner in this proceeding.

Respectfully submitted,

Dated: October 18, 2023

/Robert S. McArthur/

Robert S. McArthur, Esq.

Registration No. 45,674

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U.S. Patent No. 9,064,376

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Counsel for Patent Owner

CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S
MOTION FOR ERIC W. BENISEK TO APPEAR PRO HAC VICE
PURSUANT TO 37 C.F.R. § 42.8. is being filed electronically via P-TACTS and
served on counsel for Petitioner by electronic mail this 17th day of October 2023
as follows:

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