UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOURSQUARE LABS, INC.,

Petitioner,

v.

BOARDACTIVE CORPORATION,

Patent Owner.

U.S. PATENT NO. 10,621,620 B1

IPR2023-00918

PATENT OWNER'S UNOPPOSED MOTION FOR ADMISSION *PRO HAC VICE* OF BENJAMIN M. CAPPEL

August 16, 2024

I. Relief Requested

Pursuant to 37 C.F.R. § 42.10, Patent Owner ("BoardActive") requests that the Board admit Benjamin M. Cappel pro hac vice in this proceeding to serve as backup counsel.

II. Governing Rule sand Precedent

The Board is authorized to recognize counsel pro hac vice pursuant to 37 C.F.R. § 42.10(c), which provides that:

> The 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.

Motion for pro hac vice admission must be filed in accordance with Unified *Patents v. Parallel Iron*, IPR 2013-00639, Paper No. 7 (P.T.A.B. Oct. 15, 2013) (the

"*Unified Patents Order*"). The *Unified Patents* Order requires that a pro hac vice motion "[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel pro hac vice during the proceeding." *Unified Patents* Order at 3. A motion for pro hac vice admission should also be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:

i. Membership in good standing of the Bar of at least one State or the District of Columbia;

ii. No suspensions or disbarments from practice before any court or administrative body;

iii. No application for admission to practice before any court or administrative body ever denied;

iv. No sanctions or contempt citations imposed by any court or administrative body;

v. The individual seeking to appear 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.;

vi. The individual 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);

vii. All other proceedings before the Office for which the individual has applied to appear pro hac vice in the last three (3) years; and

viii. Familiarity with the subject matter at issue in the proceeding.

Unified Patents Order at 3–4.

III. Statement of Facts

Based on the following facts, and supported by the Declaration of Mr. Cappel (Ex. 2003) submitted herewith, Patent Owner requests the pro hac vice admission of Benjamin M. Cappel in this proceeding:

1. BoardActive's counsel, Meredith Martin Addy, Robert Hart and Gregory B. Gulliver are registered practioners (Addy, Reg. No. 37,883, Hart, Reg. No. 35,184, Gulliver, Reg No. 44,138).
2. Mr. Cappel is a partner at ADDYHART P.C. and an experienced litigation attorney. Mr. Cappel has more than eight (8) years of litigation experience. (Ex. 2003 ¶2)
3. Mr. Cappel has established familiarity with the subject matter at issue in this proceeding. Mr. Cappel has engaged in extensive strategic discussions with Patent Owner's lead and backup counsel regarding the matters at issue in this proceeding. (Ex. 2003 ¶10)

4. Mr. Cappel is a member in good standing of the bar of New Jersey (Ex. 2003 ¶3)

5. Mr. Cappel has never been suspended or disbarred from practice before any court or administrative body. (Ex. 2003 ¶4)

6. No court or administrative body has ever denied Mr. Cappel's application for admission to practice before it. (Ex. 2003 ¶ 5)

7. No court or administrative body has ever imposed sanctions or contempt citations on Mr. Cappel. (Ex. 2003 ¶6)

8. Mr. Cappel has read and will comply with the Office of Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R. (Ex. 2003 ¶7)

9. Mr. Cappel understands that he will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 et seq. and will be subject to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (Ex. 2003 ¶8.)

10. Mr. Cappel has not been admitted to appear pro hac vice before the Board in the last three years. (Ex. 2003 ¶9)

IV. Good Cause Exists for the Pro Hac Vice Admission of Mr. Cappel In This Proceeding

The 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. 37 C.F.R. § 42.10(c). The Patent Owner's lead counsel, Meredith Martin Addy, is a registered practitioner before the Board. Based on the facts contained herein, as supported by Mr. Cappel's declaration, good cause exists to admit Mr. Cappel pro hac vice in this proceeding.

As set forth in his declaration, Mr. Cappel has established familiarity with the subject matter at issue in the proceeding. As counsel for BoardActive has also engaged in strategic discussions with Patent Owner's counsel Mr. Cappel's admission pro hac vice will permit him to participate in hearing preparation and in the hearing in this matter. For these reasons, BoardActive has a substantial need for Mr. Cappel's pro hac vice admission and his involvement in the prosecution of this proceeding.

V. Conclusion

For the foregoing reasons, Patent Owner respectfully request that Mr. Cappel be admitted pro hac vice in this proceeding.

August 16, 2024

Respectfully submitted,

/Meredith Martin Addy /

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Counsel for Patent Owner BoardActive Corporation

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a true and correct copy of the foregoing was served on August 16, 2024, by delivering a copy via electronic mail on the following counsel of record for Petitioner Foursquare Labs, Inc. and by filing this document through the P-TACTS.

Michael.Carrillo@btlaw.com

Steven.Shipe@btlaw.com

Date: August 16, 2024

By: / *Meredith Martin Addy* /
Meredith Martin Addy