UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

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IPR2024-00287
U.S. Patent No. 11,611,520

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**PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF TODD C. ZUBLER PURSUANT TO 37 C.F.R. § 42.10(c)**

## I. STATEMENT OF RELIEF REQUESTED

Petitioner Dropbox, Inc. respectfully requests that the Patent Trial and Appeal Board ("Board") enter an order granting the *pro hac vice* admission of Todd C. Zubler as back-up counsel for Petitioner in this proceeding, IPR2024-00287.[1] Petitioner have conferred with counsel for Patent Owner, and Patent Owner does not oppose this motion.

## II. APPLICABLE RULES

Pursuant to 37 C.F.R. § 42.10(c), 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." "[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." *Id.*

The Board set forth requirements for filing motions for *pro hac vice* admission in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 ("Order –

[1] Petitioner is concurrently filing an unopposed motion to admit Todd C. Zubler as back-up counsel for Petitioner in IPR2024-00286.

Authorizing Motion For Pro Hac Vice Admission – 37 C.F.R. §42.10") (P.T.A.B. Oct. 15, 2013). A motion seeking *pro hac vice* admission must be filed no sooner than twenty-one (21) days after service of the petition, must contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding, and must be accompanied by a declaration or affidavit of the individual seeking *pro hac vice* admission. *Id.* at 2–3. The affidavit or declaration must attest to: (1) membership in good standing of the Bar of at least one State or the District of Columbia; (2) no suspensions or disbarments from any practice before any court or administrative body; (3) no application for admission to practice before any court or administrative body ever denied; (4) no sanctions or contempt citations imposed by any court or administrative body; (5) 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.; (6) 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); (7) all other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and (8) familiarity with the subject matter at issue in the proceeding. *Id.*

## III. FACTS DEMONSTRATING GOOD CAUSE FOR THE BOARD TO RECOGNIZE TODD C. ZUBLER *PRO HAC VICE* DURING THIS PROCEEDING

On January 22, 2024, Petitioner filed a petition for *inter partes* review in IPR2024-00287 directed to U.S. Patent No. 11,611,520 (the "'520 patent"). Petitioner' lead counsel, Trishan Esram, is a registered practitioner (Registration No. 74,075). Todd C. Zubler, a partner at Wilmer Cutler Pickering Hale and Dorr LLP, seeks *pro hac vice* admission in this proceeding. Accompanying this motion as Exhibit 1126 is the Declaration of Todd C. Zubler in Support of Motion for Admission *Pro Hac Vice* ("Zubler Decl.").

Mr. Zubler is a member of good standing of the Bar of the District of Columbia. *See* Zubler Decl. (EX1126), ¶¶3–4. He has never been suspended or disbarred from practice before any court or administrative body, and he has never been denied admission to practice before any court or administrative body. *See* Zubler Decl. (EX1126), ¶¶5–6. No court or administrative body has ever imposed sanctions or contempt citations on Mr. Zubler. *See* Zubler Decl. (EX1126), ¶7.

Mr. Zubler 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. *See* Zubler Decl. (EX1126), ¶8. Mr. Zubler understands that he 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). *See* Zubler Decl. (EX1126), ¶9.

Mr. Zubler has appeared *pro hac vice* in the following proceeding before the United States Patent and Trademark Office in the last three years: IPR2021-00346 (*Intel Corp. v. ParkerVision Inc.*). *See* Zubler Decl. (EX1126), ¶10. Mr. Zubler has also appeared *pro hac vice* in the following proceedings before the United States Patent and Trademark Office: IPR2020-01265 (*Intel Corp. v. ParkerVision, Inc.*), IPR2020-01302 (*Intel Corp. v. ParkerVision, Inc.*), IPR2018-01326 (*Intel Corp. v. Qualcomm Inc.*), IPR2018-01327 (*Intel Corp. v. Qualcomm Inc.*), IPR2018-01328 (*Intel Corp. v. Qualcomm Inc.*), IPR2018-01329 (*Intel Corp. v. Qualcomm Inc.*), IPR2018-01330 (*Intel Corp. v. Qualcomm Inc.*), IPR2018-01340 (*Intel Corp. v. Qualcomm Inc.*). *See* Zubler Decl. (EX1126), ¶11.

As his accompanying declaration demonstrates, Mr. Zubler has an established familiarity with the subject matter at issue in this proceeding. *See* Zubler Decl. (EX1126), ¶14. Mr. Zubler is an experienced patent litigator with 28 years of experience. *See* Zubler Decl. (EX1126), ¶2. Mr. Zubler has reviewed the '520 patent and its file history, as well as the Petition, Institution Decision, Patent Owner's Response, and the other filings and exhibits in this proceeding. *See* Zubler Decl. (EX1126), ¶14. Mr. Zubler has been involved in numerous patent litigations

and has extensive experience with the USPTO's rules and regulations. *See* Zubler Decl. (EX1126), ¶¶12–13.

## IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board admit Todd C. Zubler *pro hac vice* in this proceeding.

Respectfully Submitted,

Date: December 24, 2024

/Trishan Esram/

Trishan Esram
Registration No. 74,075
Counsel for Petitioner

## UPDATED TABLE OF EXHIBITS

| Exhibit | Description |
|---|---|
| 1101 | U.S. Patent No. 11,611,520 |
| 1102 | Declaration of Dr. Todd Mowry |
| 1103 | U.S. Patent No. 8,825,597 ("Houston") |
| 1104 | U.S. Patent No. 9,633,125 ("Garcia") |
| 1105 | U.S. Patent Application Publication No. 2010/0005138 ("Manzano") |
| 1106 | U.S. Patent Application Publication No. 2007/0011246 ("Wu") |
| 1107 | U.S. Patent Application Publication No. 2013/0046833 ("Riepling") |
| 1108 | U.S. Patent Application Publication No. 2012/0278404 ("Meisels") |
| 1109 | U.S. Patent Application Publication No. 2013/0067303 ("Kantor") |
| 1110 | [Reserved] |
| 1111 | [Reserved] |
| 1112 | [Reserved] |
| 1113 | *Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251, Jury Verdict Form, May 19, 2023, Dkt. 382 |
| 1114 | '520 Patent File History |
| 1115 | U.S. Patent No. 6,351,776 ("O'Brien") |
| 1116 | U.S. Patent Application Publication No. 2008/0320397 ("Do") |

| Exhibit | Description |
|---|---|
| 1117 | [Reserved] |
| 1118 | *Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:23-cv-00303, First Amended Complaint for Patent Infringement, July 26, 2023, Dkt. 22 |
| 1119 | U.S. Patent Application Publication No. 2004/0267705 ("Lemus") |
| 1120 | U.S. Patent No. 6,304,948 ("Motoyama") |
| 1121 | U.S. Patent No. 7,559,088 ("Cohen") |
| 1122 | U.S. Patent Application Publication No. 2003/0182332 ("McBrearty") |
| 1123 | *Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:23-cv-00303, Plaintiff's Disclosure of Preliminary Infringement Contentions, September 20, 2023 |
| 1124 | Declaration of Gregory H. Lantier |
| 1125 | Declaration of Liv L. Herriot |
| 1126 | Declaration of Todd C. Zubler |

**CERTIFICATE OF SERVICE**

I hereby certify that, on December 24, 2024, I caused a true and correct copy of the foregoing materials:

- Petitioner's Unopposed Motion for *Pro Hac Vice* Admission of Todd C. Zubler Pursuant to 37 C.F.R. § 42.10(c)
- Petitioner's Updated Table of Exhibits
- EX1126

to be served via electronic mail by consent on counsel of record at:

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Respectfully Submitted

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