UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

PIRANHA MEDIA DISTRIBUTION, LLC,
Patent Owner.

Case IPR2024-01253
Patent 11,463,768

PATENT OWNER PIRANHA MEDIA DISTRIBUTION LLC'S NOTICE OF INTENT TO DESIGNATE PROVISIONALLY RECOGNIZED PTAB ATTORNEY ZACHARIAH HIGGINS AS BACKUP COUNSEL UNDER 37 C.F.R. § 42.10(c)(2)

EXHIBIT LIST	
2001	Declaration of Zachariah Higgins in Support of Patent Owner's Notice of Intent to Designate Provisionally Recognized PTAB Attorney Zachariah Higgins as Backup Counsel Under 37 C.F.R. § 42.10(c)
2002	US Patent No. 10,986,403 (Donian) ['403 Patent]
2003	US Patent Publication No. 2002/0144262 [Eldering-'262]
2004	US Patent No. 6,615,039 [Eldering-'039]
2005	*AviaGames, Inc. v. Skillz Platform Inc.*, IPR2022-00530, Paper 12 (Aug. 9, 2022)
2006	*AviaGames, Inc. v. Skillz Platform Inc.*, IPR2022-00530, Paper 14 (Dir. Rvw. Mar. 2, 2023)
2007	*AviaGames, Inc. v. Skillz Platform Inc.*, IPR2022-00530, Paper 15 (Mar. 22, 2023)
2008	Excerpts from Prosecution History of USPTO Application No. 09/742,852, Decision on Appeal (Mar. 26, 2009)
2009	Request for Ex Parte Reexamination No. 90/019,699 of US Patent No. 11,463,768
2010	*Piranha Media Distribution, LLC v. Hulu, LLC*, 2:24-cv-00498-JLS-KS, Dkt. 23, "Order Granting Defendant's Motion To Dismiss" (Sept. 11, 2024) [Sep. 11, 2024 final judgment of invalidity].
2011	*Piranha Media Distribution LLC v. Hulu, LLC,* Appeal No. 25-1038, Dkt. 5, "Hulu LLC Docketing Statement" (Oct. 22, 2024) [Petitioner's Ct. App. dktg. stmt.]
2012	USPTO, Director Memo re Interim Procedure For Discretionary Denials In AIA Post-Grant Prcdgs. With Parallel Dist. Ct. Litig. (June 21, 2022) [Interim Denial Memo]

2013	*Netflix, Inc. v. DivX, LLC*, IPR2020-00052, Paper 42 (May 14, 2020) (Public Version)

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.10(c)(2), Patent Owner Piranha Media Distribution LLC ("Patent Owner") files this notice of its intent to designate provisionally recognized PTAB attorney Zachariah Higgins (Mr. Higgins) as backup counsel. The facts set forth below and the accompanying Declaration of Mr. Higgins, Ex. 2001 (Higgins Decl."), support his *pro hac vice* admission.

II. GOVERNING LAW, RULES, AND PRECEDENT

Section 42.10(c), 37 C.F.R., provides that:

> (i) Any counsel who is not a registered practitioner, who has been previously recognized pro hac vice in a Board proceeding, and who has not subsequently been denied permission to appear pro hac vice in a Board proceeding shall be considered a provisionally recognized PTAB attorney. Provisionally recognized PTAB attorneys shall be eligible for automatic pro hac vice admission in subsequent proceedings, subject to the following conditions.
>
> (ii) If a party seeks to be represented in a proceeding by a provisionally recognized PTAB attorney, that party may file a notice of intent to designate a provisionally recognized PTAB attorney as back-up counsel. No fee is required for such a notice. The notice shall:
>
> (A) Identify a registered practitioner who will serve as lead counsel, and

(B) Be accompanied by a certification in the form of a declaration or affidavit in which the provisionally recognized PTAB attorney attests to satisfying all requirements set forth by the Board for pro hac vice recognition of a provisionally recognized PTAB attorney and agrees to be subject to the USPTO Rules of Professional Conduct set forth in §§ 11.101 et seq. of this chapter and disciplinary jurisdiction under § 11.19(a) of this chapter.

As enumerated in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (P.T.A.B. Oct. 15, 2013) ("*Unified Patents* Order"), the Board has further required that counsel seeking to appear *pro hac vice* submit an affidavit or declaration 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 U.S.P.T.O. 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.

III. STATEMENT OF FACTS

Based on the following statement of facts, and supported by the Declaration of Zachariah Higgins, submitted herewith as Exhibit 2001, Patent Owner requests the automatic *pro hac vice* admission of Zachariah Higgins in this proceeding:

1. Patent Owner's lead counsel, David Alberti is a registered practitioner (Reg. No. 43,465). Patent Owner's first back-up counsel, Kenneth J. Weatherwax (the undersigned), is also a registered practitioner (Reg. No. 54,528).

2. Mr. Higgins is a partner at the law firm of Kramer Alberti Lim & Tonkovich LLP. Ex. 2001 ¶ 8.

3. Mr. Higgins is an experienced litigator, and the majority of his practice has consisted of patent litigation and other patent related matters such as PTAB litigations and matters before multiple federal district courts. *Id.* ¶ 9. Representative patent litigations where Mr. Higgins has been actively involved as patent litigation counsel include:

- *Medtronic, Inc. v. Guidant Corporation, et al.*, 4-01-cv-02494 (N.D. Cal.).
- *Echostar Communicati, et al v. Gemstar-TV Guide, et al*, 1-01-cv-02426 (N.D. Ga.).
- *Medtronic, Inc. v. Endoscopic Technologies, Inc.*, 4-03-cv-03337 (N.D. Cal.).
- *TiVO Inc. v. Echostar Comm. et al,* 2-04-cv-00001 (E.D. Tex.).
- *Teleshuttle Technologies, LLC et al v. Microsoft Corporation et al*, 5-04-cv-02928 (N.D. Cal.).
- *Antor Media Corporation v. Nokia, Inc. et al*, 2-05-cv-00186 (E.D. Tex.).
- *Creative Technology Ltd. v. Apple Computer, Inc.*, 4-06-cv-03218 (N.D. Cal.).
- *The Receivership Estate of AudienceScience Inc. et al v. Google LLC et al*, 6-21-cv-01209 (W.D. Tex.).
- *Wildseed Mobile LLC v. Google LLC et al*, 6-21-cv-01245 (W.D. Tex.).
- *Wildseed Mobile LLC v. Google LLC et al*, 6-22-cv-000357 (W.D. Tex.).

- *Certain Digital Set-Top Boxes and Systems and Services Including the Same*, Inv. No. 337-TA-1315 (I.T.C.).
- *The Receivership Estate of AudienceScience Inc. et al v. Google LLC et al*, 5-22-cv-04756 (N.D. Cal.).
- *Wildseed Mobile LLC v. Google LLC et al*, 3-22-cv-04928 (N.D. Cal.).
- *Piranha Media Distribution LLC v. Hulu LLC*, 2-24-cv-00498 (C.D. Cal.).
- *Keyless Licensing LLC v. Samsung Electronics America, Inc. et al*, 2-24-cv-00464 (E.D. Tex.).

Ex. 2001 ¶ 9.

4. Mr. Higgins' experience in post-grant patent proceedings includes drafting patent owner responses, taking depositions, and presenting oral arguments before the Board. *Id*. ¶ 10. Representative matters where Mr. Higgins is or was actively involved include:

- *Google LLC f/k/a Google Inc. v. Wildseed Mobile LLC*, IPR2023-00248 (P.T.A.B.).
- *Google LLC f/k/a Google Inc. v. Wildseed Mobile LLC*, IPR2023-00247 (P.T.A.B.).

- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2024-01252 (P.T.A.B.).
- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2025-00081 (P.T.A.B.).
- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2025-00082 (P.T.A.B.).

Ex. 2001 ¶ 10.

5. Mr. Higgins has an established familiarity with the subject matter at issue in this proceeding. *Id*. ¶ 14. Mr. Higgins has reviewed the Patent at issue as well as the Petition and the relevant art. *Id*.

6. Mr. Higgins is a member in good standing of the State Bar of California. *Id*. ¶¶ 1, 2.

7. Mr. Higgins has never been suspended or disbarred from practice before any court or administrative body. *Id*. ¶ 3.

8. No application of Mr. Higgins for admission to practice before any court or administrative body has ever been denied. *Id*. ¶ 4.

9. No sanctions or contempt citations have ever been imposed against Mr. Higgins by any court or administrative body. *Id*. ¶ 5.

10. Mr. Higgins 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. Ex. 2001 ¶ 6.

11. Mr. Higgins understands that he will be subject to the U.S.P.T.O. 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). Ex. 2001 ¶ 7.

12. Mr. Higgins has previously been admitted to appear, *pro hac vice*, in the following matters before the U.S.P.T.O.:

- *Google LLC f/k/a Google Inc. v. Wildseed Mobile LLC*, IPR2023-00248 (P.T.A.B.).
- *Google LLC f/k/a Google Inc. v. Wildseed Mobile LLC*, IPR2023-00247 (P.T.A.B.).

Ex. 2001 ¶ 11.

13. Mr. Higgins is concurrently applying for *pro hac vice* admission in the following matters:

- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2024-01252 (P.T.A.B.).
- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2025-00081 (P.T.A.B.).

- *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2025-00082 (P.T.A.B.).

Id. ¶ 12.

14. Other than the matters identified in ¶¶ 12-13, *supra*, Mr. Higgins has not applied to appear *pro hac vice* in any other proceedings before the U.S.P.T.O. in the last three years.

IV. CONCLUSION

Upon being deemed admitted pro hac vice under 37 C.F.R. § 42.10(2)(iii), Patent Owner will file updated mandatory notices accordingly. And Mr. Higgins will keep the Board informed of sanctions, changes to good standing at a bar, or any other event that renders materially inaccurate or incomplete any representation that he made to the Board in connection with this request for pro hac vice notice. Ex. 2001 ¶ 15.

Respectfully submitted,

/ Kenneth J. Weatherwax /
David Alberti, Reg. No. 43,465
KRAMER ALBERTI LIM & TONKOVICH LLP
Kenneth J. Weatherwax (Reg. No. 54,528)
LOWENSTEIN & WEATHERWAX LLP

Date: February 18, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on the date signed below:

PATENT OWNER PIRANHA MEDIA DISTRIBUTION LLC'S NOTICE OF INTENT TO DESIGNATE PROVISIONALLY RECOGNIZED PTAB ATTORNEY ZACHARIAH HIGGINS AS BACKUP COUNSEL UNDER 37 C.F.R. § 42.10(c)(2)

EXHIBIT 2001

The names and address of the parties being served are as follows:

Harper Batts	HBatts@sheppardmullin.com
Chris Ponder	CPonder@sheppardmullin.com
Jeffrey Liang	JLiang@sheppardmullin.com
Fangzhou Qiu	FQiu@sheppardmullin.com
	LegalTM-Piranha-CDCA@sheppardmullin.com

Respectfully submitted,

/ Abbie Neufeld /

Date: February 18, 2025