

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

Case No. IPR2025-00299
U.S. Patent No. 7,716,217

**PETITIONER'S UNOPPOSED MOTION FOR
PRO HAC VICE ADMISSION ETHAN L. PLAIL
UNDER 37 C.F.R. § 42.10(c)**

EXHIBIT LIST

No.	Short Name	Reference
1001	217 Patent	Certified Copy of U.S. Patent 7,716,217
1002	217 File History	Certified File History of 7,716,217
1003	828 Provisional	Certified United States Provisional Patent Application No. 60/758,828.
1004	Houh Decl.	Expert Declaration of Dr. Henry Houh
1005	Houh CV	Curriculum Vitae of Dr. Henry Houh
1006	<u>Dumais</u>	U.S. Patent Application Publication 2007/0016553A1
1007	<u>Kircher</u>	U.S. Patent Application Publication 2003/0195937A1
1008	<u>Krug</u>	Certified Translation of WIPO Patent 2003/023650A2
1009	Sch. Order	Order 32 (Scheduling Order) in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024)
1010	Sch. Hr. Tr.	Oct. 21, 2024, Transcript of Initial Pretrial (Scheduling) Conference in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024).
1011	Goldberg	David Goldberg, et al., <i>Using Collaborative Filtering To Weave An Information Tapestry</i> , COMMUNICATIONS OF THE ACM, 35:12 (Dec. 1992).
1012	Kennedy	U.S. Patent 6,134,582
1013	Mailk	U.S. Patent Application Publication 2004/0078447
1014	587 Application	International Application PCT/US07/60587
1015	587 File History	File History of PCT/US07/60587
1016	RESERVED	
1017	118 File History	File History of 11/426,118

1018	605 Provisional	Provisional Patent Application No. 60/693,605.
1019	Shaw	U.S. Patent 6,249,807
1020	Karamchedu	U.S. Patent Application Publication 2004/0054744
1021	Fitzpatrick	U.S. Patent Application Publication 2006/0168029
1022	Yao	U.S. Patent Application Publication 2003/0187937
1023	Segal	Richard Segal, et al., <i>SpamGuru: An Enterprise Anti-Spam Filtering System</i> , CEAS 2004, FIRST CONFERENCE ON EMAIL AND ANTI-SPAM, (July, 2004).
1024	Carlson	U.S. Patent Application Publication 2005/0267973
1025	Sood	U.S. Patent 7,941,491
1026	Kirsch	U.S. Patent Application Publication 2005/0091319
1027	Boykin	P. Oscar Boykin, et al., <i>Personal Email Networks: An Effective Anti-Spam Tool</i> , ARXIV.ORG, 4 (Feb. 2004)
1028	Horvitz	International PCT Application WO2001/069432
1029	Lui	Andrew K. Lui, et al., <i>An Advanced Organizer for Asynchronous Discussion Forums</i> , IEEE (2005).
1030	Claypool	Mark Claypool, et al., <i>Combining Content-Based and Collaborative Filters in an Online Newspaper</i> , ACM SIGIR WORKSHOP ON RECOMMENDER SYSTEMS (Aug. 1999).
1031	Brun	U.S. Patent Application Publication 2007/0168430
1032	Linden	Greg Linden, et al., <i>Amazon.com Recommendations Item-to-Item Collaborative Filtering</i> , IEEE INTERNET COMPUTING (2003).
1033	Frankowski	International PCT Application WO2001/53973
1034	Dabbish	Laura A. Dabbish, et al., <i>Understanding Email Use: Predicting Action on a Message</i> , CHI (2005).
1035	Basu	Chumki Basu, et al., <i>Recommendation as Classification: Using Social and Content-Based</i>

		<i>Information in Recommendation</i> , AAAI-98 PROCEEDINGS (1998).
1036	Melville	Prem Melville, et al., <i>Content-Boosted Collaborative Filtering for Improved Recommendations</i> , PROCEEDINGS OF THE EIGHTEENTH NATIONAL CONFERENCE ON ARTIFICIAL INTELLIGENCE (Jul. 2002).
1037	Alspector	Joshua Alspector, et al., <i>Comparing Feature-Based and Clique-Based User Models for Movie Selection</i> , PROCEEDINGS OF THE THIRD ACM CONFERENCE ON DIGITAL LIBRARIES (1998).
1038	Balabanovic	Marko Balabanovic, et al., <i>Content-Based Collaborative Recommendation</i> , COMMUNICATIONS OF THE ACM (Mar. 1997).
1039	Kussmaul	U.S. Patent 7,860,933
1040	Rose	U.S. Patent 6,202,058
1041	MSFT Comp.	Microsoft Computer Dictionary, 3ed (1997).
1042	Levenshtein	Jan 2005 – Levenshtein Distance – Wikipedia
1043	<u>Marston</u>	U.S. Patent Application Publication 2004/0260710
1044	EX2010 Markup	EX2010 with comments and redlines enabled
1045	EX2010 metadata	System metadata for EX2010
1046 (NEW)	Plail Decl.	Declaration of Ethan L. Plail in Support of Petitioner's Unopposed Motion for <i>Pro Hac Vice</i> Admission Under 37 C.F.R. § 42.10(c)

Under 37 C.F.R. § 42.10(c) and the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3), Petitioner X Corp. (“Petitioner”) respectfully requests the *pro hac vice* admission of attorney Ethan L. Plail, Esq. in this proceeding. Petitioner’s have conferred with counsel for Sterling Computers Corporation (“Patent Owner”), and Patent Owner does not oppose this motion.

I. Legal Standard

Under 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. 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 Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3) further instructs:

Once a party has designated a registered practitioner as lead counsel pursuant to 37 C.F.R. § 42.10(a) and filed a power of attorney for lead counsel if required by 37 C.F.R. § 42.10(b), that party is also authorized to file one or more motions for *pro hac vice* recognition of back-up counsel pursuant to 37 C.F.R. § 42.10(c)(1).

A motion for pro hac vice recognition filed pursuant to 37 C.F.R. § 42.10(c)(1) shall be accompanied by the fee set forth in 37 C.F.R. § 42.15(e). Such motion must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding; and
- b. Be accompanied by an affidavit or declaration in which the individual seeking *pro hac vice* recognition attests 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 Board's Rules of Practice for Trials set forth in 37 CFR part 42;
 - 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 years; and
 - viii. Familiarity with the subject matter at issue in the proceeding.

As set forth below, and in the accompanying Declaration of Ethan L. Plail (Ex. 1046, “Plail Declaration”), each of these requirements is satisfied here.

II. Statement Of Facts Showing Good Cause For The Board To Recognize Ethan L. Plail Pro Hac Vice In This Proceeding

Mr. Plail is a member in good standing of the New York State Bar (Bar No. 5719299) and District of Colombia Bar (Bar No. 1686513). (Plail Declaration. ¶ 2.) Mr. Plail has never been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 3.) No application of Mr. Plail for admission to practice before any court or administrative body has ever been denied. (*Id.*) Nor has any court or administrative body imposed sanctions or contempt citations against Mr. Plail. (*Id.*) Mr. Plail has read, fully understands, 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 Title 37 of the C.F.R. (*Id.* ¶ 4.) Mr. Plail acknowledges and agrees 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). (*Id.*)

Petitioner’s lead counsel in this proceeding, David Okano, is a registered practitioner (Reg. No. 66,657). Moreover, as set forth below (and in his accompanying declaration), Mr. Okano is both an experienced and technically-trained litigation attorney with an established familiarity with the subject matter at issue in this proceeding.

Mr. Plail received a Bachelor of Science degree in Chemical Engineering from the University of Florida in 2015. (*Id.* ¶ 5.) Mr. Plail earned a law degree from Georgetown University Law Center in 2018. (*Id.*)

Mr. Plail is currently a member of White & Case’s intellectual property group, with a focus on patent litigation. (*Id.* ¶ 6.) Mr. Plail has practiced in this group for over one year. (*Id.*)

Mr. Plail also has an established familiarity with the subject matter at issue in this proceeding. Mr. Plail has been actively involved in the related district court litigation between the Petitioner and Patent Owner, *Sterling Computers Corporation v. X Corp.*, Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024) (*Id.* at ¶ 7.) U.S. Patent No. 7,716,217 (“’217 patent”), which is at issue in this proceeding, was one of the patents asserted by the Patent Owner in the district court litigation. (*Id.* at ¶ 8.) Mr. Plail has been actively involved in all aspects of the litigation (*Id.*)

In the last three years, Mr. Plail has applied to appear *pro hac vice* before the Office in the following proceedings: *Peloton Interactive, Inc. v. Mad Dogg Athletics, Inc.* IPR2022-00016; *Peloton Interactive, Inc. v. Mad Dogg Athletics, Inc.* IPR2022-00017. (*Id.* at ¶ 9.) Mr. Plail has been actively involved in analyzing and assisting with the Petition for *Inter Partes* Review submitted in this proceeding. (*Id.* at ¶ 10.)

In view of Mr. Plail's extensive knowledge of the subject matter at issue in this proceeding, and in view of the interrelatedness of this proceeding and the related district court litigation, Petitioner's have a substantial need for Mr. Plail's *pro hac vice* admission and his involvement in the continued prosecution of this proceeding. In addition, admission of Mr. Plail *pro hac vice* will enable Petitioner's to avoid unnecessary expense and duplication of work between this proceeding and the district court litigation. *See* 77 Fed. Reg. 48,612, 48,661 (Aug. 14, 2012) (Office's comment on final rule discussing concerns about efficiency and costs where an entity has already engaged counsel for parallel district court litigation).

III. CONCLUSION

For the foregoing reasons, Petitioner's respectfully requests that Mr. Plail be admitted *pro hac vice* in this proceeding.

Dated: November 4, 2025

Respectfully Submitted,

/s/David Okano

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on this 30th day of October, 2025, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by e-mail on the following counsel:

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