

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIMPSON STRONG-TIE COMPANY INC.,  
Petitioner

v.

COLUMBIA INSURANCE COMPANY,  
Patent Owner

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Case PGR2024-00050  
U.S. Patent No. 11,920,339

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**PETITIONER SIMPSON STRONG-TIE COMPANY INC.'S  
MOTION FOR *PRO HAC VICE* ADMISSION OF ERICK C. HOWARD  
UNDER 37 C.F.R. § 42.10(c)**

***Mail Stop "PATENT BOARD"***

Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITIONER’S UPDATED EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                           |
|--------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>1001</b>        | U.S. Patent No. 11,920,339 to Brekke et al. (“the Patent-at-Issue”)                                                                                                          |
| <b>1002</b>        | Prosecution History of the Patent-at-Issue                                                                                                                                   |
| <b>1003</b>        | Declaration of W. Andrew Fennell in Support of Petition for Post-Grant Review of U.S. Patent No. 11,920,339                                                                  |
| <b>1004</b>        | GB Patent App. Pub. No. 2,451,853A (Cullen)                                                                                                                                  |
| <b>1005</b>        | U.S. Patent No. 9,394,680 to Bundy et al. (“Bundy”)                                                                                                                          |
| <b>1006</b>        | U.S. Patent No. 4,827,684 to Allan (“Allan”)                                                                                                                                 |
| <b>1007</b>        | Japanese Design Patent No. D1213894 to Yamaguchi (Yamaguchi) with attached certified English-language translation                                                            |
| <b>1008</b>        | Japanese Application No. 19991014482 to Tsukamoto (“Tsukamoto”)                                                                                                              |
| <b>1009</b>        | U.S. Patent No. 4,696,113 to Rice (“Rice”)                                                                                                                                   |
| <b>1010</b>        | U.S. Patent App. Pub. No., 2011/0047806 to Harrison (“Harrison”)                                                                                                             |
| <b>1011</b>        | GB Patent App. Pub. No. 2,433,522 to Robinson (“Robinson”)                                                                                                                   |
| <b>1012</b>        | “Technical Bulletin: Top Flange Joist Hangers Installed on Walls Over Wood Structural Patent Sheathing or Drywall”, Simpson Strong-Tie Company, Inc., published August 2013. |
| <b>1013</b>        | U.S. Patent No. 4,196,556 to Russo (“Russo”)                                                                                                                                 |
| <b>1014</b>        | U.S. Patent No. 9,151,058 to Leathe (“Leathe”)                                                                                                                               |
| <b>1015</b>        | U.S. Publication No. 2001/0054270 to Rice (“Rice”)                                                                                                                           |
| <b>1016</b>        | <i>Fire-Rated Assemblies in Commercial Construction (“The Purple Book”)</i> , National Gypsum Properties, LLC (November 5, 2013)                                             |
| <b>1017</b>        | <i>GA-600-2012 Fire Resistance Design Manual, 20<sup>th</sup> Ed.</i> , Gypsum Association (June 2012).                                                                      |
| <b>1018</b>        | <i>2012 International Building Code</i> , International Code Council, June 2011 (“IBC-2012”)                                                                                 |

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                 |
|--------------------|------------------------------------------------------------------------------------------------------------------------------------|
| <b>1019</b>        | WoodWorks, Four-story Wood-frame Structure over Podium Slab (2010) (“WoodWorks”).                                                  |
| <b>1020</b>        | ASTM C1396 Standard Specification for Gypsum Board (2001).                                                                         |
| <b>1021</b>        | U.S. Patent Application Publication No. 2012/0219785 to Yu et al. (“Yu”).                                                          |
| <b>1022</b>        | U.S. Patent No. 3,601,428 to Gilb                                                                                                  |
| <b>1023</b>        | U.S. Patent No. 3,633,950 to Gilb                                                                                                  |
| <b>1024</b>        | U.S. Patent No. 3,752,512 to Gilb                                                                                                  |
| <b>1025</b>        | U.S. Patent No. 4,480,941 to Gilb                                                                                                  |
| <b>1026</b>        | EP Patent No. 0210744 B1 to Adams (“Adams”)                                                                                        |
| <b>1027</b>        | U.S. Patent Application Pub. No. 2008/0134620 to Contasti (“Contasti”)                                                             |
| <b>1028</b>        | <i>Curriculum Vitae</i> of Andrew Fennell                                                                                          |
| <b>1029</b>        | Ferguson, Drywall: Professional Techniques for Great Results, Taunton Press, 2012                                                  |
| <b>1030</b>        | U.S. Patent No. 4,261,155 to Gilb (“Gilb’155”)                                                                                     |
| <b>1031</b>        | “Mass Timber and Wood Framing,” Architectural Record Magazine, McGraw Hill Construction, November 2012, pp. 165-169 (“ArchRecord”) |
| <b>1032</b>        | U.S. Patent No. 4,714,372 to Commins (“Commins”)                                                                                   |
| <b>1033</b>        | ASTM C840 Standard Specification for Application and Finishing of Gypsum Board (2001)                                              |
| <b>1034</b>        | 2012 International Building Code                                                                                                   |

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                         |
|--------------------|----------------------------------------------------------------------------------------------------------------------------|
| <b>1035</b>        | Definitions of “plate” and “bounding,” Merriam Webster’s Collegiate Dictionary, Tenth Edition, Merriam-Webster, Inc., 1993 |
| <b>1036</b>        | U.S. Patent App. Pub. No. 2005/0155307 to Timony (“Timony”)                                                                |
| <b>1037</b>        | U.S. Patent Provisional App. No. 61/922,531 to Brekke et al. (’339 Prov”)                                                  |
| <b>1038</b>        | The Gypsum Construction Handbook, Sixth Edition, USG Corporation, Published by John Wiley & Sons, Inc. 2009                |
| <b>1039</b>        | Declaration of Sylvia D. Hall-Ellis, Ph.D.                                                                                 |
| <b>1040</b>        | Curriculum Vitae of Sylvia D. Hall-Ellis, Ph.D.                                                                            |
| <b>1041</b>        | Wayback Machine Screenshot of Architectural Record website (November 12, 2012)                                             |
| <b>1042</b>        | Wayback Machine Screenshot of Architectural Record Continuing Education Website (January 23, 2013)                         |
| <b>1043</b>        | Wayback Machine Screenshot of Wikipedia Architectural Record Entry (December 5, 2012)                                      |
| <b>1044</b>        | Declaration of Joseph V. Mauch in support of Motion for <i>Pro Hac Vice</i> Admission                                      |
| <b>1045</b>        | Declaration of Lindsay A. van Keulen in support of Motion for <i>Pro Hac Vice</i> Admission                                |
| <b>1046</b>        | Declaration of Erick C. Howard in support of Motion for <i>Pro Hac Vice</i> Admission                                      |

## I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Simpson Strong-Tie Company Inc. (“Petitioner”) respectfully requests that the Board recognize Erick C. Howard as counsel *pro hac vice* in this proceeding. Where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon a showing that counsel is an experienced litigating attorney and has established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c); *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (P.T.A.B. Oct. 15, 2013) (setting forth requirements for *pro hac vice* admission).

As set forth in his Declaration submitted herewith (EX1046), Mr. Howard is a Partner at Shartsis Frieze LLP and a patent litigation attorney with significant experience advising clients regarding patent matters. Mr. Howard also represents Petitioner in connection with the underlying district court litigations involving the ’339 patent and related U.S. Patent Nos. U.S. Patent No. 10,316,510 (“the ’510 patent”), 11,021,867 (“the ’867 patent”), and 11,649,626 (“the ’626 patent”). Accordingly, Mr. Howard has significant familiarity with the particular subject matter in this proceeding. This motion is authorized by the Notice of Filing Date Accorded that was mailed on September 23, 2024 (Paper No. 6).

## **II. STATEMENT OF FACTS**

As detailed in his declaration, Mr. Howard practices patent litigation, and has done so throughout his career as an attorney. Mr. Howard has litigated numerous patent cases across the country and been actively involved in the present post-grant review proceeding regarding the '339 patent. Mr. Howard has reviewed and developed an understanding of the '339 patent, its corresponding file history, the Petition for Post-Grant Review, the Petition's accompanying Declaration of W. Andrew Fennell, Patent Owner's Response, Patent Owner's Contingent Motion to Amend, and Patent Owner's accompanying declarations (Exhibits 2050-2060). Mr. Howard has advised Petitioner on strategy regarding Petitioner's arguments, and worked with Petitioner and with lead counsel and back-up counsel named in this proceeding to identify and analyze the references relied upon herein.

## **III. DECLARATION OF INDIVIDUAL SEEKING TO APPEAR**

This Motion for *Pro Hac Vice* Admission is accompanied by the Declaration of Erick C. Howard (EX1046), as required by the "Order Authorizing Motion for *Pro Hac Vice* Admission" in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under "Representative Orders, Decisions, and Notices."

As Mr. Howard states in his accompanying Declaration, he has read, will comply with, and agrees to be subject to the Office Patent Trial Practice Guide and

the Board's Rules of Practice for Trials set forth in part 42 of Title 37, Code of Federal Regulations. He is very familiar with these rules as part of his preparation and work in preparing the petition in this proceeding. As also set forth in his Declaration, Mr. Howard is a member in good standing of the Bar of the State of California and is admitted to practice in numerous federal courts, including the U.S. District Court for the Northern, Eastern, and Central Districts of California, the Northern District of Illinois, the Eastern District of Texas, and the Ninth Circuit Court of Appeals. He has litigated numerous patent cases across the country. Mr. Howard's complete biography is attached to his Declaration (EX1046) as Appendix A.

Petitioner submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Erick C. Howard as counsel *pro hac vice* during this proceeding.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Michelle K. Holoubek, Reg. # 54,179/

Michelle K. Holoubek  
Registration No. 54,179  
Attorney for Petitioner  
Simpson Strong-Tie Company Inc.

Date: July 16, 2025

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Washington, DC 20005  
(202) 371-2600

**CERTIFICATION OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that the above-captioned **PETITIONER  
SIMPSON STRONG-TIE COMPANY INC.'S MOTION FOR *PRO HAC*  
*VICE* ADMISSION OF ERICK C. HOWARD UNDER 37 C.F.R. § 42.10(c)**  
and Exhibit 1046 were served electronically via e-mail on July 16, 2025 in their  
entireties on the following counsel of record for Patent Owner:

Kurt F. James (Lead Counsel) [kurt.james@stinson.com](mailto:kurt.james@stinson.com)  
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Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

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Date: July 16, 2025

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