

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 8,121,904

Filed: October 11, 2009

IPR2013-00176

Issued: February 21, 2012

Attorney Docket No.: 105263.00021

Inventor(s): Johnson, Jerome D.

Assignee: Clear With Computers, LLC

Title: ELECTRONIC PROPOSAL PREPARATION SYSTEM

Mail Stop PATENT BOARD, PTAB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITIONER'S UNOPPOSED MOTION FOR ADMISSION *PRO HAC*
VICE OF GENE C. SCHAERR PURSUANT TO 37 C.F.R. §42.10**

Pursuant to 37 C.F.R. §42.10 and in accordance with the Board's "Order -- Authorizing Motion for Pro Hac Vice Admission," in Case IPR2013-00010 (MPT) (the "Authorizing Order"), Petitioner Hyundai Motor America, Inc. ("Hyundai") requests that the Board recognize Gene C. Schaerr as counsel *pro hac vice* for the above-captioned proceeding. Petitioner has conferred with counsel for Patent Owner and Patent Owner does not oppose this motion.

I. STATEMENT OF FACTS

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. 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.

37 C.F.R. §42.10(c). As required by the Authorizing Order, the following statement of facts shows there is good cause for the Board to recognize Gene C. Schaerr *pro hac vice*.

Mr. Schaerr is an experienced litigating attorney with over 20 years of experience. His biography is attached (Exhibit 1) to his accompanying declaration (Exhibit A). He has been litigating patent infringement matters in the

United States District Courts as well as related appeals at the United States Court of Appeals for the Federal Circuit for at least the past 7 years. *See* Exh. A, ¶ 2.

Mr. Schaerr received his J.D. in 1985, an M.A. (economics) in 1985, and an M.Phil. (economics) in 1986 from Yale University, and then served as a law clerk to the Hon. Kenneth W. Starr of the U.S. Court of Appeals for the D.C. Circuit. *Id.*, ¶ 4. He then served as a law clerk to both United States Supreme Court Chief Justice Warren E. Burger and Justice Antonin Scalia. *Id.* He entered private practice at Sidley Austin Brown & Wood in 1987 and remained there until leaving to serve for two years as associate counsel to President George H.W. Bush from 1991-1993. *Id.* He then returned to Sidley Austin Brown & Wood where he practiced until 2005 when he joined Winston & Strawn. *Id.*

Mr. Schaerr is a member in good standing of the District of Columbia Bar, with no suspensions or disbarments from practice, nor any application for admission to practice denied, or any sanctions or contempt citations. *Id.*, ¶¶ 6-8. He is admitted to practice before every United States Court of Appeals including the Federal Circuit, the U.S. Supreme Court, and the United States District Court for the Southern District of New York. *Id.*, ¶ 3.

Mr. Schaerr has intimate familiarity with the subject matter at issue in this proceeding based on his work over the past 4 years as counsel to Petitioner in the pending district court case *Clear with Computers LLC v. Hyundai Motor America*,

Inc., C.A. No. 6:09-cv-00479 (E.D. Tex), which involves the immediate parent to the patent-at-issue in this proceeding. Mr. Schaerr has been actively involved in all aspects of that district court case, including the issue of validity of that patent. Further, Mr. Schaerr is counsel to Petitioner in the pending district court case *Clear with Computers LLC v. Hyundai Motor America, Inc.*, C.A. No. 6:12-cv-00077 (E.D. Tex), which involves the patent-at-issue in this proceeding. *Id.*, ¶ 11.

Mr. Schaerr has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of the C.F.R, and he agrees to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§10.20 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. §11.19(a). *Id.*, ¶¶ 12-13. Mr. Schaerr has not applied to appear *pro hac vice* in any other proceedings before the Office in the last three (3) years. *Id.*, ¶ 14. Finally, Petitioner will be concurrently represented by registered practitioners Michael J. Scheer and Matthew B. Weinstein, who each have extensive experience with PTO practice and procedure.

II. ANALYSIS

The facts contained in the Statement of Facts above, and contained in Mr. Schaerr's Declaration, establish that there is good cause to recognize Mr. Schaerr *pro hac vice* in this proceeding under 37 C.F.R. §42.10. Lead and backup counsel are registered practitioners, Mr. Schaerr is an experienced litigating attorney, and

Mr. Schaerr has an established familiarity with the subject matter at issue in the proceeding.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board recognize Gene C. Schaerr as counsel *pro hac vice* in this proceeding.

Respectfully submitted,

Date: May 7, 2013

____/Michael J. Scheer/_____
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EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**DECLARATION OF GENE C. SCHAERR IN SUPPORT OF
PETITIONER HYUNDAI MOTOR AMERICA, INC.'S MOTION
FOR ADMISSION *PRO HAC VICE* OF GENE C. SCHAERR
PURSUANT TO 37 C.F.R. §42.10**

I, Gene C. Schaerr, declare as follows:

1. I am an experienced litigating attorney with more than 20 years of experience.
2. I have been litigating patent cases for at least 7 years
3. I am a member in good standing of the District of Columbia Bar and am admitted to practice before every United States Court of Appeals including

the Federal Circuit, the U.S. Supreme Court, and the United States District Court for the Southern District of New York.

4. I received my J.D. in 1985, an M.A. (economics) in 1985, and an M.Phil. (economics) in 1986 from Yale University, and then served as a law clerk to the Hon. Kenneth W. Starr of the U.S. Court of Appeals for the D.C. Circuit. I then served as a law clerk to both United States Supreme Court Chief Justice Warren E. Burger and Justice Antonin Scalia. In addition, I served for two years as associate counsel to President George H.W. Bush. I entered private practice at Sidley Austin Brown & Wood in 1987 and remained there until leaving to serve for two years as associate counsel to President George H.W. Bush from 1991-1993. I then returned to Sidley Austin Brown & Wood where I practiced until 2005 when I joined Winston & Strawn.

5. A copy of my firm biography is attached as Exhibit 1.

6. I have never been suspended or disbarred from practice before any court or administrative body.

7. I have never had an application for admission to practice before any court or administrative body denied.

8. I have had no sanctions or contempt citations imposed against me by any court or administrative body.

9. I am familiar with the subject matter at issue in this proceeding, including the patent-at-issue.

10. I am counsel for Petitioner in the pending district court case *Clear with Computers LLC v. Hyundai Motor America, Inc.*, C.A. No. 6:09-cv-00479 (E.D. Tex), which involves the immediate parent to the patent-at-issue in this proceeding. I have been actively involved in all aspects of that district court case, including the issue of validity of that patent. That case remains on appeal.

11. I am also counsel to Petitioner in the pending district court case *Clear with Computers LLC v. Hyundai Motor America, Inc.*, C.A. No. 6:12-cv-00077 (E.D. Tex), which involves the patent-at-issue in this proceeding.

12. I have 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 the C.F.R.

13. I agree to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§10.20 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. §11.19(a).

14. I have not applied to appear *pro hac vice* in any proceeding before the Office in the last three (3) years.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are

believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: May 7, 2013

By: ____/Gene C. Schaerr/_____

Gene C. Schaerr

EXHIBIT 1



Gene C. Schaerr, Partner

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Related Legal Services

Antitrust Litigation
Appellate and Critical Motions
Class Actions
Patent Litigation
Trademark Litigation
ERISA Litigation
Banking Litigation
Complex Commercial Litigation
Insurance Coverage
Product Liability
Professional Liability
Technology Litigation

Related Industries

Automotive and Transportation
Education
Manufacturing
Pharmaceuticals and Medical
Devices

Law School

Yale
JD, 1985

Admissions

District of Columbia

Court Admissions

USCA - 1st Circuit
USCA - 2nd Circuit
USCA - 3rd Circuit
USCA - 4th Circuit
USCA - 5th Circuit
USCA - 6th Circuit
USCA - 7th Circuit
USCA - 8th Circuit
USCA - 9th Circuit
USCA - 10th Circuit
USCA - 11th Circuit

Gene Schaerr is a litigation partner in the firm's Washington, D.C. office and chair of the firm's nationwide appellate, critical motions, and constitutional litigation practice. He focuses his practice on appellate proceedings of all kinds; on the preparation of high-risk cases for an eventual appeal; and on motions that may prove critical to the outcome of a case at the trial court or agency level.

Mr. Schaerr has handled more than 100 cases in federal and state appellate courts, including cases before the Supreme Courts (or equivalent) of the United States, California, Illinois, West Virginia, Maryland, Oklahoma, Washington, and Washington, D.C.; the intermediate appellate courts of New York, California, and Illinois; and every federal circuit court. He has handled numerous appeals challenging or defending decisions of trial courts as well as federal regulatory agencies. He has personally argued six cases before the United States Supreme Court and dozens of cases in federal courts of appeal and state appellate courts.

He also has extensive experience handling critical motions and strategic issues in trial courts across the country. For example, he has represented pharmaceutical and automotive industry clients in numerous major class action, product liability, and patent cases in which he has had responsibility for developing and executing the client's strategy on class certification; Daubert and Lone Pine issues; punitive damages defense; dismissal, summary judgment, and directed verdict motions; jury instructions; and preparing high-exposure cases for eventual appeal. Substantively, he has extensive experience with patent law, product liability law, breach of warranty, class certification, product disparagement, preemption, First Amendment law, and most other areas of federal constitutional law. He also has extensive experience in federal administrative law and practice.

Mr. Schaerr served as a law clerk to United States Supreme Court Chief Justice Warren E. Burger and Justice Antonin Scalia. He also served as a law clerk to the Hon. Kenneth W. Starr of the U.S. Court of Appeals for the D.C. Circuit. In addition, he served for two years as associate counsel to President George H.W. Bush.

Mr. Schaerr's representative clients include the Alliance of Automobile Manufacturers, AT&T Corp., Bayer Corporation, Exxon U.S.A., Inc., the Financial Services Roundtable, Honda North America, Hyundai Motors, the National Association of Manufacturers, Mobil Oil Co., the Pharmaceutical Research and Manufacturers Association, Suzuki Motor Corp.,

USCA - D.C. Circuit
USCA - Federal Circuit
Southern District of New York
U.S. Supreme Court

Clerkships

Kenneth W. Starr, USCA - D.C. Circuit (1985 - 1986)
Antonin Scalia, U.S. Supreme Court (1986 - 1987)
Warren E. Burger, U.S. Supreme Court (1986 - 1987)
President George H.W. Bush, White House Associate Counsel (1991-1993)

and U.S. Senators Orrin Hatch and Ted Kennedy.

Honors and Awards

Under Mr. Schaerr's leadership, Winston's appellate practice was named to the *National Law Journal's* "Appellate Hot List" in 2009 and 2010. He was also named in *Best Lawyers in America* in the specialty of appellate law in 2009-2011. Mr. Schaerr was recognized as a Washington, D.C. Super Lawyer for his appellate practice in 2007-2010.

Activities

Mr. Schaerr is chair of the firmwide appellate, critical motions, and constitutional litigation practice. He also serves on the firm's Executive Committee.

Education

Mr. Schaerr received a B.A. from Brigham Young University in 1981. He received a J.D. in 1985, an M.A. (economics) in 1985, and an M.Phil. (economics) in 1986 from Yale University.

Speeches and Publications

Some of Mr. Schaerr's recent speeches and publications include:

- "Patented Advertising in an Advertising Age," *BNA's Patent, Trademark, and Copyright Journal*, September 2010
- "Business and Jury Trials: The Framers' Vision Versus Modern Reality," *Ohio State Law Journal*, 2010 (with Jed Brinton)
- "Litigating Punitive Damage Claims After *State Farm v. Campbell*," presented at the Food and Drug Law Institute in January 2005
- "Religious Institutions and Public Benefits: How Far Can The Government Go?" presented at the National Association of College and University Attorneys in Vancouver in June 2004
- "Policy Issues Posed By Consumer Class Actions," National Association of Manufacturers' Conference on Class Action Reform, July 2002
- "How to Reduce Your Company's Exposure to Punitive Damages," IHOKEN (Corporate Lawyers Association of the Japanese Pharmaceutical Industry), Tokyo and Osaka, Japan, December 2002 (lecture published in *Legal Mind*)
- "Coordination and Appellate Strategies in Mass Injury Litigation," IHOKEN, Tokyo and Osaka, Japan, December 2001 (lecture published at 216 *Legal Mind* 51-56, April 2002)
- "U.S. Product Liability Law: Topics of Interest for Japanese Pharmaceutical Manufacturers," IHOKEN, Tokyo, Japan, November 1995 (lecture published at 143 *Legal Mind* 91-114, February 1996)
- Author, "Rescuing Multidistrict Litigation from the Altar of Expediency," 1997 *B.Y.U. L. J.* 821 (1997) (with Carter Phillips and Anil Abraham)

**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.6(e)**

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on the 7th day of May 2013 a complete and entire copy of the foregoing MOTION FOR ADMISSION PRO HAC VICE OF GENE C. SCHAEER PURSUANT TO 37 C.F.R. §42.10 and supporting exhibits were provided, per the parties' agreement, via electronic means to the Patent Owner by serving Patent Owner's counsel of record.

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Respectfully submitted,

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