

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner

v.

AT&T INTELLECTUAL PROPERTY I, L.P.
Patent Owner

Case IPR2015-01227

Patent 7,907,714

Title: PROFILE MANAGEMENT SYSTEM INCLUDING USER INTERFACE
FOR ACCESSING AND MAINTAINING PROFILE DATA OF USER
SUBSCRIBED TELEPHONY SERVICES

Declaration of James A. Shimota
In Support of Motion for Admission *Pro Hac Vice*

I, James A. Shimota, declare as follows:

1. I am an attorney licensed to practice law in the State of Illinois. I am also a member in good standing of the United States Court of Appeals for the Federal Circuit and Sixth Circuit and the United States District Court for the Northern District of Illinois. My practice focuses on the litigation of intellectual property related disputes.

2. I have never been suspended or disbarred from practice before any state or administrative body.

3. I have never been denied admission to practice before any court or administrative body.

4. I have never been subject to sanctions or contempt citations imposed by any court or administrative body.

5. 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 37 C.F.R.

6. I understand that by participating in this proceeding I 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. In addition to my application to appear *pro hac vice* in this proceeding, I applied and was admitted to appear *pro hac vice* before the Office in IPR2014-01247. That proceeding is unrelated to this matter and has since been

terminated. I have not applied to appear *pro hac vice* before the Office in any other matters in the last three years.

8. I am an experienced litigation attorney, with experience in numerous litigations involving patent infringement in District Courts throughout the United States, including experience with fact and expert document and deposition discovery, claim construction, Markman hearings, motion practice, trials and hearings, and investigations before the International Trade Commission. These matters involved technologies relevant to the '714 Patent, and I am familiar with the subject matter at issue in this proceeding and the subject matter of this IPR. My biography is attached hereto as Exhibit A.

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 and that such willful false statements may jeopardize the outcome of this proceeding.

Executed on June 8, 2016

A handwritten signature in black ink, appearing to read "James A. Shimota", is written over a horizontal line. The signature is stylized and cursive.

James A. Shimota

Exhibit A



JAMES A. SHIMOTA

Partner

jim.shimota@haynesboone.com

PRACTICES: Intellectual Property, Patent Office Trials, Patent Litigation, Patents, International Trade Commission Section 337 Proceedings, Trade Secret Litigation

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EDUCATION AND CLERKSHIPS

- J.D., University of Michigan Law School, 1999, *magna cum laude*
- B.S.E., Chemical Engineering, University of Michigan, 1996, *magna cum laude*
- Law Clerk to the Honorable James L. Ryan, U.S. Court of Appeals for the Sixth Circuit

BAR ADMISSIONS

- Illinois, 1996

COURT ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Sixth Circuit
- U.S. District Court for the Northern District of Illinois

James Shimota concentrates his practice on all aspects of post-issuance patent practice. He has extensive experience before judges and juries in federal courts across the country as well as the United States International Trade Commission and arbitration panels. Representative technologies with which Jim has worked include financial services products, multiple aspects of cellular and smartphone technology, semiconductor manufacturing, fiber optic amplifiers, DNA arrays, HIV drugs, alkaline batteries, wireless networking products, power supplies, cleaning systems for portable shavers, memory image sensors, portable music players, and automated tissue staining instruments.

Jim also counsels clients on building patent portfolios inorganically through strategic acquisitions. Jim provides advice to technology companies in industries such as consumer electronics, electronic commerce and pharmaceutical regarding what patent assets do and don't complement existing organic patent assets and how much those assets are worth. For example, Jim assisted an international client in completing a multi-billion dollar patent portfolio acquisition involving thousands of patents.

Jim further focuses on advising venture capitalists and startups on patent strategy.

Jim was selected for inclusion in *Illinois Super Lawyers* − Rising Stars Edition, Thomson Reuters, 2013-2014.

Selected Client Representations

- *Voxiva, Inc. v. MyHealth, Inc.* (D. Del.)
- *FarmedHere, LLC et al v. Just Greens, LLC d/b/a AeroFarm Systems, LLC* (Arbitration)
- *Velocity Patent LLC v. Chrysler, BMW, Mercedes, Jaguar Land Rover and Audi* (N.D. Ill.)
- *UMF Corp. v. Tadgreen, Inc.* (N.D. Ill.)
- *General Components, Inc. v. Mott Corp. et al.* (E.D. Va.)
- *General Components, Inc. v. Fujikin, Inc.* (International Arbitration)
- *Intel Corp. v. Wi-LAN Inc.* (N.D. Cal.)
- *Eastman Chemical Co. v. AlphaPet Inc.* (D. Del.)
- *Masonite Corporation v. CraftMaster, Inc.* (N.D. Ill.)
- *Every Penny Counts, Inc. v. Bank of America* (M.D. Fla.)
- *Mosaid Technologies, Inc. v. Micron Technology, Inc.* (E.D. Tex.)

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- *Litton Systems, Inc. v. Lucent Technologies Inc.* (C.D. Cal.)
 - *CytoLogix Corp. v. Ventana Medical Systems, Inc.* (D. Mass.)
 - *Braun v. Spectrum Brands, Inc.* (D. Mass.)
 - *Mosaid v. Infineon* (E.D. Tex.)
 - *Illinois Tool Works Inc. v. Thermal Dynamics* (E.D. Wis.)
 - *Agere Systems, Inc. v. Broadcom* (E.D. Pa.)
 - *Medline Indus., Inc. v. Maersk Med. Ltd., Giltech Ltd., and Tyco Healthcare Group LP* (N.D. Ill.)
 - *Eveready Battery Company v. Rayovac Corporation* (N.D. Ohio)