

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IMIRACLE HK LIMITED,
PETITIONER,

v.

VPR BRANDS, LP,
PATENT OWNER.

Case IPR2023-01255

U.S. Patent No. 8,205,622

Motion To Admit Lyle B. Vander Schaaf
***Pro Hac Vice* Pursuant To 37 C.F.R. § 42.10(C)**

Pursuant to 37 C.F.R. § 42.10(c), Petitioner iMiracle HK Limited (“Petitioner”), by and through its undersigned counsel, hereby moves for Lyle B. Vander Schaaf to appear *pro hac vice* on its behalf. In support of this motion, Petitioner submits a declaration made by Mr. Vander Schaaf pursuant to the guidelines set forth in IPR2013-00639, Paper 7, entered October 15, 2013. Ex. 1027.

I. Timing of Petitioner’s Request is Appropriate

Petitioner is filing this motion no sooner than 21 days after the service of the petition.

II. There is Good Cause for the Board to Recognize Mr. Vander Schaaf *Pro Hac Vice* During This Proceeding

Petitioner has already designated a registered practitioner, David P. Lindner (Reg. No. 53,222), as lead counsel, and Petitioner intends to designate Mr. Vander Schaaf as one of its back-up counsels. The following statement of facts shows that there is good cause for the Board to recognize Mr. Vander Schaaf *pro hac vice* during this proceeding.

Mr. Vander Schaaf is a patent litigator with over 30 years of experience in litigating patent cases, and thus, Mr. Vander Schaaf has significant experience in the area of patent validity and invalidity. Mr. Vander Schaaf is currently acting or has acted as lead counsel in more than 20 patent litigations before various district

courts across the country and the International Trade Commission (“ITC”). Ex. 1027, ¶9. Accordingly, Mr. Vander Schaaf has worked extensively on issues relating to 35 U.S.C. §§ 102 and 103. He has also reviewed and analyzed countless prosecution histories and prior art references, including those related to the pending action, developed many validity and invalidity arguments in both district court actions and ITC proceedings, briefed many motions and appeals, worked closely with experts, conducted discovery, taken many depositions, and prepared numerous arguments for trial.

Mr. Vander Schaaf is familiar with the subject matter at issue in this proceeding. *Id.* ¶10. Mr. Vander Schaaf represented a proceeding before the ITC, *Certain Oil Vaping Cartridges, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-1286, filed October 4, 2021, which involved multiple U.S. patents directed to the same subject matter, *i.e.*, electronic cigarettes, as the patent-at-issue in the current proceeding. *Id.* Therefore, Mr. Vander Schaaf is familiar with the technology claimed in the patent-at-issue such as the atomizer. *Id.* Further, Mr. Vander Schaaf spent time preparing and reviewing the Petition in this proceeding. *Id.*

Mr. Vander Schaaf is a member in good Standing of the District of Columbia Bar. *Id.*, ¶2. He has never been subject to any suspensions or

disbarments from practice before any court or administrative body, and has never had any applications for admission to practice before any court or administrative body denied. *Id.*, ¶¶3-4. Mr. Vander Schaaf has also never been sanctioned nor had contempt citations imposed by any court or administrative body. *Id.*, ¶5. Mr. Vander Schaaf also indicates in his declaration that he has read and has agreed to 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. *Id.*, ¶6. He has agreed to 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.*, ¶7.

III. Conclusion

In view of Mr. Vander Schaaf’s familiarity with the patent-at-issue, the subject matter at issue in this proceeding, and the prior art, Petitioner respectfully requests that the Board grant this motion to afford Petitioner and its lead counsel the benefit of having an additional, experienced attorney authorized on this matter, which will promote timely completion of the trial proceeding.

Dated: September 11, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of **Motion To Admit Lyle B. Vander Schaaf *Pro Hac Vice* Pursuant To 37 C.F.R. § 42.10(C) and Declaration Of Lyle B. Vander Schaaf In Support Of Petitioner's Motion For *Pro Hac Vice* Admission** (Ex. 1027) were served via email on Patent Owner's counsel of Record listed below, pursuant to its Mandatory Notices on August 31, 2023:

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