

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

EP FAMILY CORP.,
Petitioner,

v.

OFFICE KICK, INC.
Patent Owner.

IPR2025-00471
Patent 11,849,843 B1

Petition Filing Date: January 23, 2025

**PETITIONER EP FAMILY CORP.'S MOTION FOR *PRO HAC VICE*
ADMISSION OF JOSHUA G. SIMON**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10 and Patent Owner's Request for Authorization to file for *Pro Hac Vice* admission filed concurrently herewith and dated January 29, 2025, petitioner EP Family Corp. (Petitioner) requests that the Board admit Joshua G. Simon *pro hac vice* in this proceeding.

II. STATEMENT OF FACTS SHOWING GOOD CAUSE TO BE ADMITTED *PRO HAC VICE*

In accordance with 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 the board may impose. 37 C.F.R. § 42.10(c); *Apple Inc. Petitioner v. Sightsound Techs., LLC Pat. Owner*, (2014 WL 1440355, at *1 (P.T.A.B. Apr. 2, 2014) (granting *pro hac vice* admission to an attorney barred in California that had was "heavily involved with forming invalidity positions against" the challenged patents). Further, Section 42.10(c) also indicates that, "where lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding." *Id.*

The facts here establish good cause pursuant to 37 C.F.R. § 42.10 to allow the Board to recognize Joshua G. Simon *pro hac vice* during this proceeding. Lead counsel during this proceeding will be Kevin Terrazas of Terrazas, PLLC located at 1001 S Capital of Texas Hwy, Building L, Suite 250, Austin TX 78746. Back-up

counsel during the proceeding will be Joshua G. Simon of Call & Jensen located at 610 Newport Center Dr UNIT 700, Newport Beach, CA 92660.

Accompanying this motion is the Declaration of Joshua G. Simon in Support of the Motion for Admission *Pro Hac Vice* of Joshua G. Simon (“Simon Dec.”). As referenced in the Simon Dec., Joshua G. Simon is an experienced litigator and a shareholder at Call & Jensen licensed to practice law in the State of California since 2009. *See* Simon Dec., at ¶ 1. Joshua G. Simon is also licensed to practice before the Courts of Appeal for the First and Ninth Circuits, and United States District Courts for the Central, Northern, Southern, and Eastern Districts of California. *Id.* Further, Joshua G. Simon has established familiarity with the subject matter at issue in the proceeding by being “heavily involved in forming the invalidity positions” for U.S. Patent No. 11,849,843 (“843 Patent”) that is at issue in this proceeding. *Id.* at ¶ 3. In forming the invalidity positions at issue in this proceeding, Joshua G. Simon has gained familiarity with the expert declaration of Nathan MacDonald that was filed concurrently with the Inter Partes Review petition for the 843 Patent. *Id.* at ¶ 4. Additionally, Joshua G. Simon has also heavily consulted on the underlying litigation of *EP Family Corp. v. Office Kick, Inc.*; Case No.: 2:24-cv-00667 AB (PVCx) in the Central District of California. *Id.* at ¶ 5.

Additionally, Joshua G. Simon has 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 [title 37 of] the Code of Federal Regulations. *Id.* at ¶ 7. Accordingly, Joshua G. Simon understands 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) should the Board grant him admission *pro hac vice*. *Id.* at ¶ 10. Joshua G. Simon has also never been suspended or disbarred from practice before any court or administrative body and has never had sanctions or contempt citations issued against him. *Id.* at ¶¶ 6—8.

Based on the above, and pursuant to the requirements of 37 C.F.R. § 42.10, Joshua G. Simon has established that there is good cause for the Board to admit him *pro hac vice* in this proceeding.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board admit Joshua G. Simon *pro hac vice* in this proceeding.

Respectfully Submitted,

Dated: March 3, 2025

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COUNSEL FOR PETITIONER

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**DECLARATION OF JOSHUA G. SIMON IN SUPPORT OF MOTION
FOR ADMISSION *PRO HAC VICE***

DECLARATION OF JOSHUA G. SIMON

I, Joshua G. Simon, declare as follows:

1. I am a member in good standing of the Bar of the State of California and am admitted to practice before all California state courts as well as the Courts of Appeal for the First and Ninth Circuits, and United States District Courts for the Central, Northern, Southern, and Eastern Districts of California.

2. I have been practicing law since 2009 and have extensive experience litigating patent infringement cases.

3. I have familiarity with the subject matter at issue in these proceedings because I was heavily involved with forming invalidity positions against U.S. Patent No. 11,849,843 which is at issue in this proceeding.

4. In forming the invalidity positions at issue in this proceeding, I have gained familiarity with the expert declaration of Nathan MacDonald that was filed concurrently with the Inter Partes Review petition for the 843 Patent.

5. I have also heavily consulted on the underlying litigation of *EP Family Corp. v. Office Kick, Inc.*; Case No.: 2:24-cv-00667 AB (PVCx) in the Central District of California.

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

7. There has been no sanction or contempt citation imposed against me by any court or administrative body.

8. I have never had a court or administrative body deny my application for admission to practice.

9. I have read and will comply with Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set for in Part 42 of the C.F.R.

10. I agree to be subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.* and disciplinary jurisdiction under 37 C.F.R § 11.19(a).

11. In the past three (3) years, I have not appeared *pro hac vice* in any proceedings before the United States Patent and Trademark Office.

12. I declare under penalty of perjury under the laws of the United States of America and the State of California that the foregoing is true and correct.

Executed on February 27, 2025.

/s/ Joshua G. Simon
Joshua G. Simon