

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
PETITIONER,

V.

IMMERSION CORPORATION,
PATENT OWNER.

CASE IPR2016-01381
PATENT NO. 8,773,356

**IMMERSION CORPORATION'S UNOPPOSED MOTION FOR *PRO HAC*
VICE ADMISSION OF RICHARD BIRNHOLZ UNDER 37 C.F.R. § 42.10(c)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c) and with the Board's authorization (Paper No. 3, dated July 12, 2016), Patent Owner, Immersion Corporation ("Immersion"), by and through its attorneys, respectfully requests the *pro hac vice* admission of Richard Birnholz in this proceeding.

II. GOVERNING LAW, RULES AND PRECEDENT

Section 42.10(c) states:

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.

Further, motions for *pro hac vice* admission must comply with the "Order -- Authorizing Motion for *Pro Hac Vice* Admission" in Case IPR2013-00639, Paper 7 ("Representative Order"). The Representative Order explains that the motion must "[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding" and "[b]e

accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear 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 37 C.F.R.;
- vi. The individual will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a);

- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.”

III. STATEMENT OF FACTS SHOWING GOOD CAUSE

Based on the following statement of facts, and supported by the Declaration of Richard Birnholz (Exhibit 2010), Immersion submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Richard Birnholz in this proceeding:

1. Lead counsel, Michael R. Fleming, is a registered practitioner (Reg. No. 67,933).
2. Mr. Birnholz is an experienced litigation attorney and has been litigating patent cases in the United States District Courts and United States Court of Appeals for over 20 years. Mr. Birnholz has not appeared *pro hac vice* before the Patent Trial and Appeal Board in the past three years. On even date herewith, Mr. Birnholz is applying to appear *pro hac vice* in IPR2016-01372, involving the '571 patent.

3. Mr. Birnholz is counsel for Immersion in the following co-pending litigation: *Immersion Corp. v. Apple Inc., et al.*, Nos. 1-16-cv-00077 and 1:16-cv-00325 (D. Del.) (stayed); *In the Matter of: Certain Mobile and Portable Electronic Devices Incorporating Haptics (Including Smartphones and Laptops) and Components Thereof*, ITC Investigation Nos. 337-TA-990 and -1004 (consolidated). These cases involve litigation concerning Immersion's U.S. Patent Nos. 8,773,356 (the "'356 patent"), 8,659,571 (the "'571 patent"), 7,808,488 (the "'488 patent"), 8,619,051 (the "'051 patent"), 8,581,710 (the "'710 patent"), 8,749,507 (the "'507 patent") and 7,336,260 (the "'260 patent"). The aforementioned patents relate to haptic feedback technology in electronic devices.

4. Mr. Birnholz has been deeply involved in the co-pending cases and has an established familiarity with the subject matter at issue in those proceedings, including the '356 patent. Mr. Birnholz has been involved in reviewing prior art and forming claim construction positions with respect to the '356 patent. This gives Mr. Birnholz a substantial and established understanding of the underlying legal and technological issues at stake in this proceeding. Immersion has expended significant time and resources with Mr. Birnholz as counsel in the co-pending litigation, and wishes to continue using him as counsel in this proceeding.

5. Further, counsel for Petitioner does not oppose Mr. Birnholz appearing *pro had vice* in this proceeding.

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