

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple, Inc.,
Petitioner

v.

California Institute of Technology
Patent Owner

IPR2017-00210
U.S. Patent No. 7,116,710

**DECLARATION OF JAMES M. DOWD IN SUPPORT OF MOTION FOR
ADMISSION *PRO HAC VICE***

I, James M. Dowd, declare as follows:

1. I was admitted to the Virginia State Bar in 1997 and have been practicing law for 20 years. During the entire time that I have been practicing law, my practice has focused on the field of intellectual property, and particularly, patent litigation.

2. I am a member in good standing of the Virginia State Bar, the District of Columbia Bar, and the State Bar of California, and am admitted to practice before the Supreme Court of the United States, the United States Court of Appeals for the Federal Circuit, the Ninth Circuit, and the Fourth Circuit, and the United States District Courts for the Central District of California, the Northern District of California, the Southern District of California, the Eastern District of California, and the Eastern District of Virginia.

3. My Virginia State Bar membership number is 41406. My District of Columbia Bar membership number is 465230. My State Bar of California membership number is 259576.

4. Over the course of my career, I have been counsel in dozens of patent litigations. Several of these cases have concerned patent office rules and regulations. For example, I litigated a number of cases concerning the duty of candor to the patent office embodied in 37 C.F.R. §1.56. Cases that I have been

involved in which implicate this rule include *Cal. Inst. of Tech. v. Broadcom Ltd., et al.*, Civ. No. 2:16-cv-3714-GW (AGRx) (C.D. Cal. 2017) (the “Caltech litigation”, which is a related matter to this proceeding); *Energetiq Tech., Inc. v. ASML Netherlands B.V. et al.*, Civ. No. 1:15-cv-10240-LTS (D. Mass. 2016); *Cal. Inst. of Tech. v. Hughes Commc’ns, Inc.*, Civ. No. 2:13-cv-02745 (C.D. Cal. 2014) (the “Hughes litigation”); *ASML Netherlands B.V. v. Nikon Corp.*, Civ. No. 3:02-cv-05601 (N.D. Cal. 2004); *SanDisk Corp. v. STMicroelectronics, Inc.*, Civ. No. 5:06-cv-00194 (N.D. Cal. 2006); *In the Matter of Certain NAND Flash Memory Circuits and Products Containing Same*, Inv. No. 337-TA-526 (USITC 2006); and *In the Matter of Certain NOR and NAND Flash Memory Devices and Products Containing Same*, Inv. No. 337-TA-560 (USTIC 2006).

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

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

7. I have never had any sanctions or contempt citations imposed on me by any court or administrative body.

8. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in 37 C.F.R. Part 42.

9. I agree to be subject to the United States Patent and Trademark Office 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).

10. Within the last three years, I have been admitted to appear *pro hac vice* in the following proceedings before the United States Patent and Trademark Office:

- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-00130;
- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01279;
- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01277;
- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01377;
- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01362;
- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01375; and

- *ASML Netherlands B.V., ASML U.S., Inc., Excelitas Technologies Corp., and Qioptic Photonics GmbH & Co. KG v. Energetiq Technology, Inc.*, Case IPR2015-01368.

11. I am familiar with the subject matter at issue in this proceeding. I have reviewed U. S. Patent No. 7,116,710 (the “’710 patent”), which is being challenged in this proceeding, as well as its file history, the Petition, the Institution Decision, and the exhibits in this proceeding. I have also reviewed and am familiar with the relevant prior art.

12. Beginning in 2016 and continuing until the present, I have represented Petitioner Apple Inc. in the Caltech litigation, which is a related matter to this proceeding. The validity of the ’710 patent is a contested issue in the Caltech litigation. The validity of other patents in the same patent family as the ’710 patent over some of the prior art raised in this proceeding are also contested issues in the Caltech litigation.

13. I previously litigated the validity of the ’710 patent and other patents in the same family as the ’710 patent in the Hughes litigation. While representing Hughes Communications in the Hughes litigation, I participated in the drafting of briefing regarding claim construction for, and the validity of, the ’710 patent. I also took and defended expert depositions regarding the invalidity of the ’710 patent in the Hughes litigation.

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