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

PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF JAMES M. DOWD PURSUANT TO 37 C.F.R § 42.10(c)

I. STATEMENT OF RELIEF REQUESTED

Petitioner Apple Inc. ("Petitioner" or "Apple") respectfully requests that the Patent Trial and Appeal Board ("Board") enter an order granting the *pro hac vice* admission of James M. Dowd as back-up counsel for Apple in Case IPR2017-00210. Apple has conferred with counsel for Patent Owner, who does not oppose this motion.

II. APPLICABLE RULE

Pursuant to 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 as the Board may impose." "[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."

The Board set forth requirements for filing motions for *pro hac vice* admission in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7 ("Order – Authorizing Motion For *Pro Hac Vice* Admission – 37 C.F.R. §42.10") (PTAB Oct. 15, 2013). A motion seeking *pro hac vice* must be filed no sooner than twenty-one (21) days after service of the petition, "must contain a statement of facts showing there is good cause for the Board to recognize counsel

pro hac vice during the proceeding [,]" and must be accompanied by a declaration or affidavit of the individual seeking *pro hac vice* admission." *Id.* at 2-3. The affidavit or declaration must attest to: (1) membership in good standing of the Bar of at least one State or the District of Columbia; (2) no suspensions or disbarments from any practice before any court or administrative body; (3) no application for admission to practice before any court or administrative body ever denied; (4) no sanctions or contempt citations imposed by any court or administrative body; (5) 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.; (6) the individual 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) all other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and (8) familiarity with the subject matter at issue in the proceeding."

III. FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE COUNSEL *PRO HAC VICE* DURING THE PROCEEDING

On November 15, 2016, Petitioner filed three *inter partes* review petitions in IPR2017-00210, -00211, and -0219 directed to U.S. Patent No. 7,116,710 ("'710 patent"). Patent Owner was served on the same day. Petitioner's lead counsel, Richard Goldenberg is a registered practitioner (Registration No. 38,095). James

M. Dowd, a partner at Wilmer Cutler Pickering Hale and Dorr LLP, seeks *pro hac vice* admission in this proceeding. Accompanying this motion as Exhibit 1027 is the Declaration of James M. Dowd in Support of Motion for Admission *Pro Hac Vice* ("Dowd Decl.").

Mr. Dowd is a member of good standing of the State Bar of California, the District of Columbia Bar, and the Virginia State Bar. Dowd Decl. ¶ 2 (Ex. 1027). He has never been suspended or disbarred from practice before any court or administrative body, and has never been denied admission to practice before any court or administrative body. Dowd Decl. ¶¶ 5-6 (Ex. 1027). No court or administrative body has ever imposed sanctions or contempt citations on Mr. Dowd. Dowd Decl. ¶ 7 (Ex. 1027).

Mr. Dowd 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. Dowd Decl. ¶ 8 (Ex. 1027). Mr. Dowd 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). Dowd Decl. ¶ 9 (Ex. 1027).

Within the last three years, Mr. Dowd has applied to appear *pro hac vice* in the following proceedings:

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

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