

Filed on behalf of Valencell, Inc.

By: Justin B. Kimble (JKimble-IPR@bcpc-law.com)
Nicholas C Kliewer (nkliewer@bcpc-law.com)
Jonathan H. Rastegar (jrastegar@bcpc-law.com)
Bragalone Conroy PC
2200 Ross Ave.
Suite 4500 – West
Dallas, TX 75201
Tel: 214.785.6670
Fax: 214.786.6680

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00318
U.S. Patent No. 8,886,269

***PRO HAC VICE* MOTION TO ADMIT ATTORNEY
T. WILLIAM KENNEDY PURSUANT TO 37 C.F.R. § 42.10(c)**

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

Patent Owner Valencell, Inc. (“Valencell”) hereby files this motion pursuant to 37 C.F.R. § 42.10(c) for T. William Kennedy to appear *pro hac vice* on its behalf before the Patent Trial and Appeal Board in IPR2017-00318. This motion follows the guidelines set forth in IPR2013-00639, Paper 7, entered October 15, 2013.

This motion is filed concurrently with nearly identical motions in IPR2017-00315, -00317, -00319, and -00321, all of which are set for oral argument together on February 27, 2018.

A. Lead Counsel is a Registered Practitioner.

Valencell has already designated a registered practitioner, Justin B. Kimble (Reg. No. 58,591) as lead counsel, and Valencell intends to designate Mr. Kennedy as one of its back-up counsel, pending the Board granting this motion.

B. There is Good Cause for the Board to Recognize T. William Kennedy *pro hac vice* during this proceeding.

Mr. Kennedy is a patent litigator with over ten years’ experience, including significant experience in the area of patent validity. In the many patent litigations in which he has been counsel, he was worked extensively on issues relating to 35 U.S.C. §§ 102, 103, and 112 challenges to patent validity including things such as working closely with experts on validity and invalidity reports, preparing invalidity arguments for trial, developing invalidity and validity arguments, and reviewing and analyzing numerous prosecution histories and prior art references. Mr. Kennedy has

also spent significant time learning the procedure of *inter partes* review since its inception, and has participated in many *inter partes* review procedures as shown in the following section.

Mr. Kennedy currently represents the Patent Owner Valencell, Inc. in its assertion of the patent at issue in this proceeding and related patents in two cases in the Eastern District of North Carolina. *See, e.g., Valencell, Inc. v. Apple, Inc.*, No. 5:16-cv-00001 (E.D. N.C., filed Jan. 4, 2016); *see also Valencell, Inc. v. Fitbit, Inc.*, No. 5:16-cv-00002 (E.D. N.C., filed Jan. 4, 2016). As counsel in those actions, Mr. Kennedy has become very familiar with the subject matter at issue in this proceeding, *e.g.*, physiological monitoring technology. Furthermore, in those lawsuits Mr. Kennedy has developed infringement allegations that assert the patent-at-issue in this petition against various products, including, for example watches with heart rate monitoring functionality. Mr. Kennedy has also taken and defended several depositions in those matters. In his role as counsel in those litigations, Mr. Kennedy has spent significant time learning about physiological monitoring technology such as that found in the patent-at-issue in this proceeding. Moreover, Mr. Kennedy has analyzed the prior art involved in this petition as well as in the petitions for related patents.

C. Mr. Kennedy has Submitted Herewith a Declaration¹ Attesting the Following Facts.

1. Mr. Kennedy is a member in good standing of the Texas State Bar.
2. Mr. Kennedy has never been subject to any suspensions or disbarments from practice before any court or administrative body.
3. None of Mr. Kennedy's applications for admission to practice before any court or administrative body has ever been denied.
4. Mr. Kennedy has never been sanctioned nor had contempt citations imposed by any court or administrative body.
5. Mr. Kennedy 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. Mr. Kennedy 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. During the past three years, Mr. Kennedy has applied to appear *pro hac vice* before the PTAB in fourteen other proceedings, six of which have been granted, two of which involved IPRs that were joined with those for which Mr. Kennedy's *pro hac vice* motion had been already granted,

¹ See Declaration of T. William Kennedy, attached hereto as Exhibit 2005.

and two remained pending throughout the life of the IPR. Each of these IPRs involved patent owner Innovative Display Technologies LLC or Delaware Display Group LLC. The other four remain pending and each involve the patent owner Valencell, Inc.

- i. IPR2014-01096 (*granted*);
- ii. IPR2014-01097 (*pending – final decision issued*);
- iii. IPR2014-01362 (*pending – final decision issued*);
- iv. IPR2015-00487 (*granted*);
- v. IPR2015-00506 (*granted*);
- vi. IPR2015-01666 (*joined with IPR2015-00506 above*);
- vii. IPR2015-01717 (*joined with IPR2015-00487 above*);
- viii. IPR2015-01866 (*granted*);
- ix. IPR2015-01867 (*granted*);
- x. IPR2015-01868 (*granted*);
- xi. IPR2017-00315 (*pending, filed concurrently herewith*);
- xii. IPR2017-00317 (*pending, filed concurrently herewith*);
- xiii. IPR2017-00319 (*pending, filed concurrently herewith*); and
- xiv. IPR2017-00321 (*pending, filed concurrently herewith*).

Mr. Kennedy has not applied to appear *pro hac vice* in any other proceeding before the PTAB.

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