

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

OPENTV, INC.,
Patent Owner.

Case IPR2015-00969
Patent 5,884,033

**PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION
PURSUANT TO 37 C.F.R. §42.10(C)**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Apple Inc. (“Petitioner” or “Apple”) respectfully requests that the Board recognize Luann L. Simmons as counsel *pro hac vice* in this proceeding. Petitioner’s lead counsel in this proceeding is a registered practitioner and, as illustrated below, Ms. Simmons is an experienced litigator with an established familiarity with this proceeding’s subject matter. Thus, there is good cause for the Board to recognize Ms. Simmons *pro hac vice* in this proceeding.

II. TIME FOR FILING

This Motion for *Pro Hac Vice* Admission is being filed no sooner than twenty one (21) days after service of the petition. *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper No. 7 (P.T.A.B. Oct. 15, 2013).

III. STATEMENT OF FACTS

This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on April 1, 2015 (Paper No. 3). Petitioner’s lead and back-up counsel are registered practitioners.

Where lead counsel is a registered practitioner, the Board may permit a non-registered practitioner to appear *pro hac vice* “upon a showing that counsel is an experienced litigating attorney and has established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. §42.10(c); *Unified Patents*, Case IPR2013-00639, Paper 7 (setting forth requirements for *pro hac vice* admission). As set forth in her

Declaration submitted herewith (Apple 1012), Ms. Simmons is an experienced litigator. She is a Partner with O'Melveny & Myers LLP with over 16 years of experience representing clients in patent and technology related litigation, including matters involving similar technology to that at issue in this proceeding. Ms. Simmons has litigated patent matters through trial and appeal and has argued complex claim construction and invalidity issues in numerous district court proceedings.

Ms. Simmons is also familiar with the subject matter of this proceeding. She is a lead counsel for Petitioner in the related district court litigation on the patent at issue in this *inter partes* review, U.S. Patent No. 5,884,033 ("033 Patent"). As such, she has reviewed and analyzed the '033 Patent, the patent holder's infringement contentions, and the prior art at issue in this proceeding. Ms. Simmons was involved in the preparation of Petitioner's invalidity contentions in the district court litigation, which include the same references and grounds asserted in this proceeding. She was also involved in the claim construction briefing and oral arguments for the '033 Patent in the district court litigation.

Based on her work in the co-pending district court litigation, involvement with the petition in this proceeding, and the other facts detailed in his declaration, Ms. Simmons has significant familiarity with the subject matter in this proceeding. Petitioner wishes to apply Ms. Simmons' knowledge of the patent and litigation experience by employing her as counsel in this proceeding. Admission of Ms. Simmons *pro hac vice* will enable Petitioner to avoid unnecessary expense and

duplication of work in this proceeding and between it and the co-pending litigation. Because Ms. Simmons is an experienced practitioner with an established familiarity with the subject matter of this proceeding, Petitioner respectfully submits that there is good cause under 37 C.F.R. § 42.10(c) to recognize Ms. Simmons as counsel *pro hac vice* during this proceeding.

IV. DECLARATION OF INDIVIDUAL SEEKING TO APPEAR

This motion for *Pro Hac Vice* Admission is supported by the accompanying Declaration of Luann L. Simmons (Apple 1012), as required by *Unified Patents*, Case IPR2013-00639, Paper 7.

October 2, 2015

Respectfully submitted,

/s/ Xin-Yi Zhou
Xin-Yi Zhou (Reg. No. 63,366)

PETITIONER’S UPDATED EXHIBIT LIST

Apple 1001 -- U.S. Patent No. 5,884,033	(“the ’033 Patent”)
Apple 1002 -- U.S. Patent No. 5,961,645	(“Baker ’645”)
Apple 1003 -- U.S. Patent No. 5,696,898	(“Baker ’898”)
Apple 1004 -- U.S. Provisional App. No. 60/004,670	(“Baker ’645 Provisional”)
Apple 1005 -- U.S. Patent No. 5,790,554	(“Pitcher ’554”)
Apple 1006 -- U.S. Patent No. 5,706,507	(“Schloss ’507”)
Apple 1007 -- Prosecution File History for Application No. 08/645,636, which later issued as U.S. Patent No. 5,883,033	(“’033 File History”)
Apple 1008 -- OpenTV’s Infringement Contentions directed to Mac OS X Products	(“Mac OS Contentions”)
Apple 1009 -- OpenTV’s Infringement Contentions directed to AppleTV Products	(“AppleTV Contentions”)
Apple 1010 -- Declaration of Dr. Charles D. Knutson	(“Knutson Decl.”)
Apple 1011 -- Curriculum Vitae of Dr. Charles D. Knutson	
Apple 1012 -- Declaration of Luann L. Simmons In Support of Motion for <i>Pro Hac</i> <i>Vice</i> Admission	

CERTIFICATE OF SERVICE

I hereby certify that on October 2, 2015, I caused a true and correct copy of the foregoing materials:

- Petitioner's Motion For *Pro Hac Vice* Admission Pursuant To 37 C.F.R. §42.10(c), and
- Exhibit Apple 1012, Declaration of Luann L. Simmons In Support of Petitioner's Motion For *Pro Hac Vice* Admission

to be served via electronic mail and Express Mail or an equivalent service on the following attorney of record per the Patent Owner's Mandatory Notices and Power of Attorney:

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October 2, 2015

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