

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

QUALCOMM INCORPORATED,
Patent Owner

Case IPR2018-01250
Patent 8,447,132

**DECLARATION OF MICHAEL A. AMON IN SUPPORT OF
PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION**

I, Michael A. Amon, hereby declare to the following:

1. I am a member in good standing of the state Bar of California (SBN: 226221), as well as the United States Court of Appeals for the Federal Circuit, and the Supreme Court of the United States.
2. I have not been suspended or disbarred from practice before any court or administrative body.
3. I have never had an application for admission to practice before any court or administrative body denied.
4. No sanction or contempt citation has been imposed against me by any court or administrative body.
5. I have 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 the Code of Federal Regulations.
6. I 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. In the past three years, I have not applied for admission *pro hac vice*. I am currently applying for pro hac vice admission in: IPR2018-01251.
8. I am an experienced patent litigation attorney with nearly 15 years of experience representing clients in cases involving medical devices, computer

software, chemical formulations, and electrical products. I regularly litigate patent cases before the United States Court of Appeals for the Federal Circuit and various federal district courts.

9. I am serving as counsel for Apple Inc. in a related matter, *Qualcomm Incorporated v. Apple Inc.*, Case No. 3:17-cv-02402-CAB-MDD, pending in the United States District Court for the Southern District of California. This related litigation involves the patent at issue in this inter partes review proceeding.

10. My biography is attached hereto as Appendix A.

11. I have read and analyzed the patent-at-issue in this proceeding, the petition, the institution decision, and cited portions of the accompanying exhibits.

12. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Respectfully submitted,

Date: March 26, 2019

/Michael A. Amon/

MICHAEL A. AMON

Fish & Richardson P.C.

Email: Amon@fr.com

APPENDIX A



Michael A. Amon

Principal

📍 San Diego, CA 📞 858-678-5070 ✉️ amon@fr.com

Background

Michael A. Amon is the Co-Managing Principal of Fish & Richardson's Southern California office. His practice emphasizes intellectual property litigation, including patent infringement, and business litigation. Mr. Amon previously clerked for the Hon. James F. Stiven (2002-2003) and the Hon. Rudi M. Brewster (2003-2004) at the United States District Court for the Southern District of California.

Services

- Litigation
- Commercial Litigation
- ITC Litigation
- Patent Litigation

Industries

- Cleantech

Education

J.D., University of San Diego School of Law 2002

cum laude

M.A., University of San Diego 2001
International Business Administration

B.S., Trinity University 1995
Biology

Admissions

- California 2003

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- U.S. District Court for the Southern District of California

Language

- English
- Italian
- Spanish

Clerkships

United States District Court for the Southern District of California, The Honorable James F. Stiven, 2002 - 2003

United States District Court for the Southern District of California, The Honorable Rudi M. Brewster (deceased), 2003 - 2004

Memberships & Affiliations

Adjunct Professor of Law, University of San Diego School of Law 2009-Present;
J. Clifford Wallace American Inn of Court;
American Bar Association

Other Distinctions

Named to *Best Lawyers* Litigation – Patent, (2018-2019)

Publications

“[Injunction Denied, Sandoz Clear to Launch](#)” *Fish Litigation Blog* (September 2, 2015).

“[BPCIA Dance Partners Request En Banc Rehearing and Amgen Seeks Temporary Injunction](#)” *Fish Litigation Blog* (August 28, 2015).

“[Amgen v. Sandoz: Federal Circuit Weighs In on the BPCIA Riddle](#)” *Fish Litigation Blog* (July 22, 2015).

“[Hot Topics Related to Biosimilars and the BPCIA](#)” *Fish Litigation Blog* (June 18, 2015).

“[Patent Dance Takes Center Stage in Amgen V. Sandoz Appeal](#)” *Law360* (June 4, 2015).

“[The Dangers of Having Your Expert Not Devote Sufficient Time to Your Case](#)” *Fish Litigation Blog* (February 9, 2015).

Presentations

“Patent Developments at the Supreme Court” and “Ethics: Common and Emerging Challenges,” Speaker, San Diego Office CLE Event, January 24, 2018.

“Short and Long-Term IP Strategies to Consider in Light of Trends and Pending Decisions,” Association of Corporate Counsel – San Diego Chapter presentation, December 14, 2017.

Moderator, “*Inter Partes* Reviews: What Have We Really Learned?” Daily Journal Patent Disputes Forum – South, Beverly Hills, December 6, 2017.

“[Biosimilars – A Mid-Year Review](#),” Speaker, Fish & Richardson Webinar, August 16, 2017.

Experience

Warsaw Orthopedic v. NuVasive, Inc. – Represented NuVasive, Inc. in a series of patent infringement lawsuits filed by Warsaw and its

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NuVasive, Inc. v. Globus Medical, Inc. – Represented NuVasive, Inc. against Globus regarding Globus's infringement of NuVasive patents related to medical devices and methods for spine surgery. Mr. Amon argued claim construction and summary judgment, and was instrumental in positioning NuVasive to negotiate a favorable settlement with Globus.

St. Jude Medical, et al. v. Volcano Corp. – Defended Volcano Corp. in patent litigation and jury trial related to pressure sensing guide wires used to diagnose heart problems. At trial, jury found two St. Jude patents invalid, two not infringed; a fifth patent was declared not infringed by the court on the eve of trial.

Nicholas Colucci v. Callaway Golf Co. – No. 08-CV-288 (E.D. TX.) Successfully defended Callaway Golf at trial against claims of patent and trade dress infringement as to certain golf club products manufactured and sold by Callaway Golf. Tried to a jury in March 2010. The jury found for Callaway Golf on no literal infringement of plaintiff's asserted patent, and no infringement of plaintiff's alleged trade dress rights. Post trial motions pending.

Baxter Healthcare Corp and DEKA Prods. Ltd. Partnership v. Fresenius USA, Inc. et al. – (07-1359 (N.D. Cal.) Successfully represented Fresenius at trial against claims of patent infringement related to peritoneal dialysis automated cyclers manufactured and used by Fresenius in the United States. The case was tried to a jury in July 2010. The jury returned a verdict of no infringement in Fresenius's favor.

Callaway Golf Co. v. Acushnet Co. – No. 06-91 (D. Del.) – Represented Callaway Golf in two-week trial asserting that Acushnet's popular Titleist Pro V1 and Pro V1x golf balls infringe four Callaway Golf patents on golf ball construction. Tried to jury verdict in December 2007. Acushnet conceded infringement; jury found for Callaway Golf on validity of all four patents. Published at 523 F. Supp 2d 388 (D. Del. 2007).

Data Encryption Corporation v. Microsoft Corp. – No. CV 05-05531 (C.D. Cal.). Part of the team that defended Microsoft against patent infringement allegations related to data encryption technology. Obtained favorable ruling of non-infringement on summary judgment.

AVID Identification Sys., Inc. v. Philips Semiconductors Inc. – No. 2:04-cv-183 (E.D. Tex.). Part of the trial team that represented AVID in two-week trial asserting patent infringement (3 patents) and Lanham Act claims relating to RFID transponders and readers. Obtained favorable mid-trial settlement from two defendants and a complete jury victory against the other two defendants, including a finding of willful infringement and a damages award of over \$6 million.

Stonebreaker v. Medical Management Int'l, Inc. – No. GIC 830293 (Cal. Sup. Ct.). Part of the trial team that represented Stonebreaker and AVID in trial asserting unfair competition under California Code Section 17200 and the Lanham Act. Obtained very favorable mid-trial settlement that included recovery of damages and a stipulated permanent injunction against the defendant.