

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Patent Owner,

v.

APPLE INC.,
Patent Owner

Case IPR2023-00949
U.S. Patent 10,866,619

**PATENT OWNER'S UNOPPOSED MOTION FOR *PRO HAC VICE*
ADMISSION OF MICHAEL AMON UNDER 37 C.F.R. § 42.10(c)**

EXHIBIT LIST

- | | |
|------------|--|
| APPLE-2001 | Memorandum: Interim Procedure for Discretionary Denials in AIA Post - Grant Proceedings with Parallel District Court Litigation (June 21, 2022) |
| APPLE-2002 | Plaintiff Apple Inc.'s Disclosure of Asserted Claims and Infringement Contentions, <i>Apple Inc. v. AliveCor, Inc.</i> , 22-CV-07608-HSG (N.D.Cal Jul. 25, 2023) |
| APPLE-2003 | Declaration of Michael Amon |

Pursuant to 37 C.F.R. § 42.10(c), Apple Inc. (“Patent Owner”), respectfully requests that the Board recognize Michael Amon as counsel *pro hac vice* in this proceeding. Patent Owner seeks the counsel of Michael Amon due to his experience in representing Patent Owner in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. 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 July 12, 2023.

I. Statement of Facts

Michael Amon is a patent litigation attorney with more than 19 years of experience representing clients in cases involving medical devices, computer software, chemical formulations, and electrical products. Mr. Amon regularly litigates patent cases before the United States Court of Appeals for the Federal Circuit, various federal district courts, and the International Trade Commission. Through his practice in such cases, Mr. Amon has gained substantial experience in jury trials, bench trials, discovery, Markman hearings, and appeals. Mr. Amon began his legal career as a law clerk for the Honorable James F. Stiven at the United States District Court for the Southern District of California. Mr. Amon subsequently served as a law clerk for Honorable Rudi M. Brewster, also at the

United States District Court for the Southern District of California, where he was involved in numerous patent cases. Mr. Amon's biography is attached as Appendix A.

Mr. Amon also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. For instance, Mr. Amon serves as trial counsel for Patent Owner in litigation that involves technology related to the '619 patent, and, as a result, has gained familiarity with the patent, the prior art references at issue, and general technology related to the '619 patent. Patent Owner has invested significant financial resources in each of these proceedings, and Mr. Amon will be taking a leading role with respect to the patent that is the subject of the present proceeding. Moreover, through his representation in litigation and other IPR matters, Patent Owner has developed a particular relationship with Mr. Amon such that Patent Owner desires to continue the relationship with Mr. Amon for the purpose of this proceeding.

II. Affidavit of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by an Affidavit of Michael Amon. Accordingly, Patent Owner submits that there is good cause

under 37 C.F.R. § 42.10(c) for the Board to recognize Michael Amon as counsel
pro hac vice during this proceeding.

Respectfully submitted,

Dated: 2024-02-01

/Ryan Chowdhury/

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Jeremy Monaldo, Reg. No. 58,680

Ryan Chowdhury, Reg. No. 74,466

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Attorneys for Patent Owners

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.8(b), the undersigned certifies that on February 1, 2024, a complete and entire copy of this Patent Owner's Motion for *Pro Hac Vice* and Accompanying Exhibit were provided via email to the Petitioner by serving the correspondence email addresses of record as follows:

Christopher TL Douglas, Reg. No. 56,950
Scott M. Stevens, Reg. No. 54,762
Philip Ducker, *Pro Hac Vice*
J. Ravindra Fernando, Reg. No. 73,762
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APPENDIX A



Michael A. Amon

Principal

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Overview

About Michael

Michael A. Amon is the vice office managing principal of the Southern California office of Fish & Richardson P.C. His practice emphasizes intellectual property litigation, including patent infringement and business litigation. Mr. Amon previously clerked for the Honorable James F. Stiven (2002-2003) and the Honorable Rudi M. Brewster (2003-2004) of the U.S District Court for the Southern District of California.

Focus Areas

Services

- Litigation
- Commercial Litigation
- ITC Litigation
- Patent Litigation

Industries

- Cleantech

Education

J.D. *cum laude*, University of San Diego School of Law (2002)

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

B.S., Biology, Trinity University (1995)

Experience

Warsaw Orthopedic v. NuVasive, Inc. – Represented NuVasive, Inc. in a series of patent infringement lawsuits filed by Warsaw and its Medtronic affiliate related to spinal access systems, spinal implants, fixation, and biologics. Mr. Amon was part of the team that successfully petitioned the Federal Circuit to vacate the \$101 million damages verdict Warsaw obtained at trial. In addition, Mr. Amon was involved in a series of *inter partes* review petitions that succeeded in invalidating several of Warsaw's asserted patents.

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.

Insights

Publications

Mr. Amon is a contributing author to Fish's IP Law Essentials.

- "Patent Local Rules: Knowing Them Well Can Make Litigating Your Case Smoother," *Fish IP Law Essentials Blog* (April 2020)
- "Injunction Denied, Sandoz Clear to Launch" *Fish Litigation Blog* (September 2015).
- "BPCIA Dance Partners Request En Banc Rehearing and Amgen Seeks Temporary Injunction" *Fish Litigation Blog* (August 2015)
- "Amgen v. Sandoz: Federal Circuit Weighs In on the BPCIA Riddle" *Fish Litigation Blog* (July 2015)
- "Hot Topics Related to Biosimilars and the BPCIA" *Fish Litigation Blog* (June 2015)
- "Patent Dance Takes Center Stage in Amgen V. Sandoz Appeal" *Law360* (June 2015)
- "The Dangers of Having Your Expert Not Devote Sufficient Time to Your Case" *Fish Litigation Blog* (February 2015).

Presentations

- "Patent Developments at the Supreme Court" and "Ethics: Common and Emerging Challenges," *San Diego Office CLE Event* (January 2018)
- "Short and Long-Term IP Strategies to Consider in Light of Trends and Pending Decisions," *Association of Corporate Counsel – San Diego Chapter* (December 2017)
- "Inter Partes Reviews: What Have We Really Learned?" *Daily Journal Patent Disputes Forum – South*, Beverly Hills, CA (December 2017)
- "Biosimilars – A Mid-Year Review," *Fish & Richardson Webinar*, (August 2017)

Teaching Positions

Adjunct Professor of Law, University of San Diego School of Law 2009-present.

Recognition

- Finalist, "Leaders in Law Award," *San Diego Business Journal* (2021)
- Named to *The Best Lawyers in America* (2022)
- Named one of San Diego's Top Attorneys by *SD Metro Magazine* (2020)
- Named to *Best Lawyers* Litigation – Patent (2018-2021)

Clerkships

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

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

Memberships & Affiliations

J. Clifford Wallace American Inn of Court

American Bar Association

Board member, San Diego Volunteer Lawyers Project

Languages

- English
- Italian
- Spanish