UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SRAM, LLC,

Petitioner,

v.

FOX Factory, Inc.,

Patent Owner.

Case No. IPR2023-01301
U.S. Patent No. 9,739,331 B2

**PETITIONER SRAM, LLC'S
MOTION FOR *PRO HAC VICE* ADMISSION
OF RICHARD B. WALSH, JR. UNDER 37 C.F.R. § 42.10(c)**

APPENDIX OF EXHIBITS

Exhibit	Description
Ex. 1001	U.S. Patent No. 9,739,331 B2 to Becker ("the '331 patent")
Ex. 1002	Declaration of Eric Wang, Ph.D.
Ex. 1003	Declaration of Kevin Wesling
Ex. 1004	File History of the '331 patent
Ex. 1005	Japanese Patent App. Pub. No. JP2004345366A to Kojima ("*Kojima*")
Ex. 1006	U.S. Patent No. 1,174,168 to Kraft ("*Kraft*")
Ex. 1007	U.S. Patent No. 7,624,752 B2 to Huang ("*Huang*")
Ex. 1008	U.S. Patent No. 6,592,136 B2 to Becker ("*Becker*")
Ex. 1009	U.S. Patent No. 7,231,939 B2 to Bruckbauer ("*Bruckbauer*")
Ex. 1010	European Patent App. Pub. No. EP0979772A2 to Danter ("*Danter*")
Ex. 1011	U.S. Patent Pub. No. 2012/0080279 A1 to Galasso ("*Galasso*")
Ex. 1012	Fox Factory, Inc.'s Disclosure of Asserted Claims and Infringement Contentions Related to U.S. Patent Nos. 9,739,331 and 8,550,223, dated Dec. 23, 2022 (including Attachment A), *Fox Factory, Inc. v. SRAM, LLC*, Case No. 1:23-cv-00313-RM-KLM
Ex. 1013	Fox Factory, Inc.'s Amended Disclosure of Asserted Claims and Infringement Contentions Related to U.S. Patent Nos. 9,739,331 and 8,550,223, dated Mar.16, 2023 (including Attachment A), *Fox Factory, Inc. v. SRAM, LLC*, Case No. 1:23-cv-00313-RM-KLM

Exhibit	Description
Ex. 1014	Notice of Filing of Joint Disputed Claim Terms Chart, dated Aug. 3, 2023, *Fox Factory, Inc. v. SRAM, LLC*, Case No. 1:23-cv-00313-RM-KLM
Ex. 1015	Declaration of Michael Hickey
Ex. 1016	Declaration of Richard B. Walsh, Jr. in Support of Petitioner SRAM, LLC's Motion For Admission *Pro Hac Vice*

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c) and the authorization to file motions for *pro hac vice* admission in the Notice of Filing Date (Paper 4), Petitioner SRAM, LLC ("SRAM") requests that the Board admit Richard B. Walsh, Jr. *pro hac vice* in this proceeding for the limited purpose of participating in depositions, participating in calls with the Board, participating in briefing, and participating in oral hearings.

II. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE BACK-UP COUNSEL *PRO HAC VICE* DURING THE PROCEEDING

In accordance with 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* subject to the condition that lead counsel be a registered practitioner and to any other conditions that the Board may impose. Section 42.10(c) provides that "where the lead counsel is a registered practitioner, 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." *See also Unified Patents v. Parallel Iron*, IPR2013-00639, Paper 7 (Oct. 15, 2013). The following facts establish good cause for the Board to recognize Richard B. Walsh, Jr. *pro hac vice* in this proceeding:

1. This motion for *Pro Hac Vice* Admission is supported by a Declaration of Mr. Walsh (Ex. 1016).

2. As a Member and Chairman of Lewis Rice LLC, Mr. Walsh has over 40 years' experience as a litigator, with experience in numerous patent infringement litigations in federal district courts. Ex. 1016, ¶¶1, 6. His experience includes fact and expert document and deposition discovery, claim construction, *Markman* hearings, motion practice, and trials and hearings. *Id.*, ¶6. He has litigated intellectual property matters and patents for several decades. *Id.*

3. Mr. Walsh has an established familiarity with the subject matter of this *inter partes* review, specifically U.S. Patent No. 9,739,331 B2 ("the '331 patent"). Mr. Walsh is lead counsel for SRAM in the co-pending district court litigation involving the '331 patent, namely *FOX Factory, Inc. v. SRAM, LLC*, Case No. 23-cv-00313-RM-KAS, pending in the United States District Court for the District of Colorado ("the FOX Factory Patent Suit"). *Id.*, ¶¶7-8.

4. Mr. Walsh has been actively involved in the FOX Factory Patent Suit. *Id.*, ¶8. He has closely studied and is thoroughly familiar with the '331 patent, the prior art asserted against the '331 patent (as identified in this IPR proceeding and the FOX Factory Patent Suit), and the vehicle forks with air bleeds at issue in these proceedings. *Id.* For example, he has been heavily involved in preparing SRAM's

non-infringement and invalidity positions in the district court, analyzing the terms of the '331 patent, and reviewing the '331 patent and technical aspects of the air bleed products with a retained expert, as well as experienced engineers. *Id.*

5. Mr. Walsh is a member in good standing of the bars of the State of Missouri (Bar No. 33523MO), the State of Illinois (Bar No. 6187007IL) and the bars of the U.S. Supreme Court, the U.S. Court of Appeals for the Federal, Fifth, Seventh, Eighth and Ninth Circuits, the U.S. Tax Court, the U.S. District Courts for the Eastern and Western Districts of Missouri, and the Southern and Northern Districts of Illinois. Mr. Walsh has never been suspended or disbarred from practice before any court or administrative body, has never had a court or administrative body deny his application for admission to practice, and has never had an court or administrative body impose sanctions, deny an application for admission to practice, or contempt citations against him. *Id.*, ¶¶2-3. Mr. Walsh has read and will comply with the Office Patent Trial Guide and the Board's Rules for Practice for Trials, as set forth in 37 C.F.R. Part 42, and agrees to 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). *Id.*, ¶5.

6. Mr. Walsh's applications to appear *pro hac vice* in six prior cases before the Board on behalf of SRAM (IPR2016-01876, IPR2017-00118, IPR2017-00472,

IPR2017-01440, IPR2022-00078, and IPR2022-00082) were each granted by the Board. *Id.*, ¶4. Two of those granted *pro hac vice* applications occurred within the last three years (IPR2022-00078 and IPR2022-00082). *Id.*

7. Petitioner SRAM's lead counsel, Michael J. Hickey, is a registered practitioner, and Mr. Walsh is an experienced litigation attorney having established familiarity with the subject matter at issue in this proceeding. Therefore, Petitioner SRAM respectfully submits that there is good cause for the Board to recognize Mr. Walsh as counsel *pro hac vice* during this proceeding.

8. Counsel for Patent Owner Fox has confirmed in writing that Fox does not oppose Mr. Walsh appearing *pro hac vice* during this proceeding for the limited purposes described above.

III. CONCLUSION

For the foregoing reasons, Petitioner SRAM, LLC respectfully requests that the Board admit Richard B. Walsh, Jr. *pro hac vice* in this proceeding.

Dated: October 3, 2023 Respectfully submitted,

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Lead Counsel for Petitioner
SRAM, LLC

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner SRAM, LLC's Motion for *Pro Hac Vice* Admission of Richard B. Walsh, Jr. Under 37 C.F.R. §42.10(c),** and **Declaration of Richard B. Walsh, Jr. in Support of Petitioner SRAM, LLC's Motion for Admission *Pro Hac Vice* (Ex. 1016),** were served by email at the following address of record for Counsel for Patent Owner on October 3, 2023.

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