

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOX Factory, Inc.,

Petitioner,

v.

SRAM, LLC,

Patent Owner.

U.S. Patent No. 10,328,993 B2

Filing Date: December 30, 2014

Issue Date: June 25, 2019

Title: BICYCLE STEERER TUBE WITH VARIANT STIFFNESS

Case No. IPR2024-00491

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

TABLE OF EXHIBITS

Exhibit	Description
Ex. 2001	Order Denying Fox Factory, Inc.’s Motion to Transfer to the Northern District of California and Order to Show Cause as to Why Sanctions Are Not Appropriate, dated March 6, 2024, <i>SRAM, LLC v. FOX Factory, Inc.</i> , Case No. 1:23-cv-00492-SCJ (United States District Court – N.D. Georgia)
Ex. 2002	Thomson Reuters’ Westlaw Litigation Analytics Report (United States District Court – N.D. Georgia)
Ex. 2003	LexisNexis Analytics (United States District Court – N.D. Georgia)
Ex. 2004	United States Department of Justice District Court Caseload Statistics
Ex. 2005	Scheduling Order, dated May 31, 2023, <i>SRAM, LLC v. FOX Factory, Inc.</i> , Case No. 1:23-cv-00492-SCJ (United States District Court – N.D. Georgia)
Ex. 2006	Fox Factory, Inc.’s Brief in Opposition to SRAM’s Motion to Stay, dated Jan. 8, 2024, <i>FOX Factory, Inc. v. SRAM, LLC</i> , Case No. 1:23-cv-00313-RM-KAS (United States District Court – D. Colorado)
Ex. 2007	Fox Factory, Inc.’s Preliminary Invalidity Contentions, dated June 16, 2023 (including Exhibits 4 and 5), <i>SRAM, LLC v. FOX Factory, Inc.</i> , Case No. 1:23-cv-00492-SCJ (United States District Court – N.D. Georgia)
Ex. 2008	Website capture for Santa Cruz NOMAD bicycle featuring RockShox Zeb fork
Ex. 2009	Declaration of Michael Durbin
Ex. 2010	Thomson Reuters’ Westlaw Litigation Analytics Report (Honorable Steve C. Jones Case Statistics)

Exhibit	Description
Ex. 2011	Joint Preliminary Report and Discovery Plan dated April 17, 2023, <i>SRAM, LLC v. FOX Factory, Inc.</i> , Case No. 1:23-cv-00492-SCJ (United States District Court – N.D. Georgia)
Ex. 2012	March 7, 2024 Through March 15, 2024 Email Exchange Between Counsel for Patent Owner and Counsel for Petitioner
Ex. 2013	June 4, 2024 Through June 14, 2024 Email Exchange Between Counsel for Patent Owner and Counsel for Petitioner
Ex. 2014	Second Declaration of Michael Durbin
Ex. 2015	Declaration of Richard B. Walsh, Jr.

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 3), Patent Owner 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*, Case No. 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. 2015).

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. 2015, ¶¶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. 10,328,993 B2 ("the '993 Patent"). Mr. Walsh is lead counsel for SRAM in the co-pending district court litigation involving the '993 Patent, namely *SRAM, LLC v. Fox Factory, Inc.*, Case No. 1:23-cv-00492-SCJ, pending in the United States District Court for the Northern District of Georgia ("the SRAM Patent Suit"). *Id.*, ¶¶7-8.

4. Mr. Walsh has been actively involved in the SRAM Patent Suit. *Id.*, ¶8. He has closely studied and is thoroughly familiar with the '993 Patent, the purported prior art asserted against the '993 Patent (as identified in this IPR proceeding and the SRAM Patent Suit), and the steerer tubes at issue in these proceedings. *Id.* For example, he has been heavily involved in preparing SRAM's infringement and validity positions in the district court, analyzing the terms of the '993 Patent, and reviewing the '993 Patent and technical aspects of the steerer tube 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 a 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 nine prior cases before the Board on behalf of SRAM (IPR2016-01876, IPR2017-00118, IPR2017-00472, IPR2017-01440, IPR2022-00078, IPR2022-00082, IPR2023-01301, IPR2023-01302, and IPR2024-00216) were each granted by the Board. *Id.*, ¶4. Five of those granted *pro hac vice* applications occurred within the

last three years (IPR2022-00078, IPR2022-00082, IPR2023-01301, IPR2023-01302, and IPR2024-00216). *Id.*

7. Patent Owner 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, Patent Owner 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 Petitioner Fox Factory, Inc. 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, Patent Owner SRAM, LLC respectfully requests that the Board admit Richard B. Walsh, Jr. *pro hac vice* in this proceeding.

Dated: September 20, 2024

Respectfully submitted,

/s/Michael J. Hickey

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Patent Owner 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 Patent Owner SRAM, LLC's Motion for Admission *Pro Hac Vice* (Ex. 2015)**, were served by email at the following address of record for Counsel for Petitioner on September 20, 2024.

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