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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASML NETHERLANDS B.V., EXCELITAS TECHNOLOGIES CORP., AND QIOPTIQ
PHOTONICS GMBH & Co. KG,
Petitioners

v.

ENERGETIQ TECHNOLOGY, INC.,
Patent Owner.

Case IPR2015-01277

**PETITIONERS' MOTION FOR ADMISSION *PRO HAC VICE* OF KEVIN
S. PRUSSIA**

I. Statement of Precise Relief Requested

Pursuant to 37 C.F.R. § 42.10(c) and Paper No. 6 authorizing the parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c), Petitioners ASML Netherlands B.V., Excelitas Technologies Corp., and Qioptiq Photonics GmbH & Co., KG (“Petitioners”) request that the Patent Trial and Appeal Board (the “Board”) admit Kevin S. Prussia *pro hac vice* in this proceeding, IPR2015-01277. Patent Owner Energetiq Technology, Inc. (“Patent Owner”) does not oppose this motion.

II. Statement of Facts Showing Good Cause for the Board to Recognize 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* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. Section 42.10(c) indicates that “where 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 a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” The facts here establish good cause for the Board to recognize Kevin S. Prussia *pro hac vice* in this proceeding.

1. Lead counsel, Donald R. Steinberg, is a registered practitioner. Backup counsel, David L. Cavanaugh and Michael H. Smith, are also registered practitioners.

2. Counsel, Kevin S. Prussia, is an experienced litigator and has an established familiarity with the subject matter at issue in the proceeding. Accompanying this motion as Exhibit 1017 is the Declaration of Kevin S. Prussia in Support of this Motion for Admission *Pro Hac Vice* (“Prussia Decl.”). In his declaration, Mr. Prussia asserts:

I am a member in good standing of the Bar of Massachusetts and the Bar of New York, and am admitted to practice before the U.S. District Court for the District of Massachusetts, the U.S. Court of Appeals for the First Circuit, and the U.S. Court of Appeals for the Federal Circuit. I am also admitted to practice before the Supreme Judicial Court for Suffolk County, Massachusetts, and the State of New York Supreme Court Appellate Division, Third Judicial Dept.

Prussia Decl. ¶ 2 (Ex. 1017). Mr. Prussia also states that he has been a part of numerous patent litigations that have concerned PTO rules and regulations:

Over the course of my career, I have been counsel in dozens of patent litigations. Several of these cases have concerned Patent Office rules and regulations. For example, I have litigated a number of cases concerning the duty of candor to the Patent Office embodied in 37 C.F.R. § 1.56. Cases that I have been

involved in which implicate this rule include *Energetiq Tech., Inc. v. ASML Netherlands B.V. et al.*, Civ. No.: 1:15-cv-10240-LTS (D. Mass.); *In the Matter of Certain Laser-Driven Light Sources, Subsystems Containing Laser-Driven Light Sources, and Products Containing Same*, Inv. No. 337-TA-983 (U.S. International Trade Commission); *Summit 6 LLC v. Apple Inc.*, Civ. No.: 7:14-cv-00106 (N.D. Tex.); and *St. Clair Intellectual Property Consultants Inc. v. Research in Motion Ltd. et al.*, Civ. No: 1:08-cv-00371 (D. Del.). In addition, *Energetiq Tech., Inc. v. ASML Netherlands B.V. et al.*, Civ. No.: 1:15-cv-10240-LTS (D. Mass.) also concerned Patent Office rules and regulations embodied in 37 C.F.R. § 1.27 regarding the definition and treatment of small entities.

Prussia Decl. ¶ 4 (Ex. 1017). Mr. Prussia also asserts:

I am familiar with the subject matter at issue in this proceeding. I have reviewed U.S. Patent No. 8,309,943 (the “’943 patent”), which is being challenged in this proceeding, and I have reviewed the relevant prior art. Beginning in 2015 and continuing until the present, I have represented Petitioners ASML Netherlands B.V., Excelitas Technologies Corp., and Qioptiq Photonics GmbH & Co. KG in *Energetiq Tech., Inc. v. ASML Netherlands B.V. et al.*, Civ. No.: 1:15-cv-10240-LTS (D. Mass.) (the “Energetiq litigation”), which is a related matter to this proceeding. The validity of the ’943 patent over the prior art raised in this proceeding is a contested issue in the Energetiq litigation. The validity of other patents in the same patent

family as the '943 patent over some of the prior art raised in this proceeding are also contested issues in the Energetiq litigation.

Prussia Decl. ¶ 11 (Ex. 1017).

3. In his declaration, Mr. Prussia also attests to each of the listed items required by the Order – Authorizing Motion for *Pro Hac Vice* Admission – 37 C.F.R. § 42.10 in IPR2013-00639. See Prussia Decl. ¶¶ 2-11 (Ex. 1017). Mr. Prussia attests that he has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in 35 C.F.R. § 42. Mr. Prussia further attests that he agrees to be subject to the United States Patent and Trademark Office's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). See *id.* ¶ 9.

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