

DOCKET NO.: 0107945.00235US5

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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 IPR2015-01368

**PETITIONERS' MOTION FOR ADMISSION *PRO HAC VICE* OF
JAMES M. DOWD**

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 James M. Dowd *pro hac vice* in this proceeding, IPR2015-01368. 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 James M. Dowd *pro hac vice* in this proceeding.

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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, James M. Dowd, is an experienced litigator and has an established familiarity with the subject matter at issue in the proceeding.

Accompanying this motion as Exhibit 1027 is the Declaration of James M. Dowd in Support of this Motion for Admission *Pro Hac Vice* ("Dowd Decl."). In his declaration, Mr. Dowd asserts:

I am a member in good standing of the Virginia State Bar, the District of Columbia Bar, and the State Bar of California, and am admitted to practice before the Supreme Court of the United States, the U.S. Courts of Appeals for the Federal Circuit, the Ninth Circuit, and the Fourth Circuit, and U.S. District Courts for the Central District of California, the Northern District of California, the Southern District of California, the Eastern District of California, and the Eastern District of Virginia.

Dowd Decl. ¶ 2 (Ex. 1027). Mr. Dowd also states that he has a long-standing relationship with real-party-in-interest ASML Netherlands B.V. ("ASML") and has represented ASML in numerous patent cases:

Beginning in 2002 and continuing until the present, I have represented ASML Netherlands B.V., a real-party-in-interest in this proceeding, in several patent and patent-related litigations and arbitrations. Patent

and patent-related cases in which I represent or have represented ASML Netherlands B.V. or its affiliates include: *Certain Microlithographic Machines and Components Thereof*, Inv. No. 337-TA-468 (USITC 2003), *Nikon Corp. v. ASML Netherlands B.V.*, Civ. No.: 3:02-cv-05081 (N.D. Cal. 2004), and *ASML Netherlands B.V. v. Nikon Corp.*, Civ. No.: 3:02-cv-05601 (N.D. Cal. 2004).

Dowd Decl. ¶ 11 (Ex. 1027). Mr. Dowd also asserts 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.) (the “Energetiq litigation”, which is a related matter to this proceeding); *Cal. Inst. Of Tech. v. Hughes Communs., Inc.*, Civ. No: 2:13-cv-07245 (C.D. Cal. 2014); *ASML Netherlands B.V. v. Nikon Corp.*, Civ. No.: 3:02-cv-05601 (N.D. Cal. 2004); *SanDisk Corp. v. STMicroelectronics, Inc.*, Civ. No.: 5:06-cv-00194 (N.D. Cal. 2006); *In the Matter of Certain NAND Flash Memory Circuits and Products Containing Same*, Inv. No. 337-TA-526 (USITC 2006); and *In the Matter of Certain NOR and NAND Flash Memory Devices and Products Containing Same*, Inv. No. 337-TA-560 (USITC 2006). In addition, the Energetiq litigation also

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concerned Patent Office rules and regulations embodied in 37 C.F.R.

§ 1.27 regarding the definition and treatment of small entities.

Dowd Decl. ¶ 4 (Ex. 1027). Furthermore, Mr. Dowd also demonstrates that he has a detailed working knowledge of the relevant subject matter:

I am familiar with the subject matter at issue in this proceeding. I have reviewed U.S. Patent No. 8,525,138 (the “’138 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 the Energetiq litigation, which is a related matter to this proceeding. The validity of the ’138 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 ’138 patent over some of the prior art raised in this proceeding are also contested issues in the Energetiq litigation.

Dowd Decl. ¶ 12 (Ex. 1027).

3. In his declaration, Mr. Dowd 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 Dowd Decl. ¶¶ 2-12 (Ex. 1027). Mr. Dowd 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. Dowd further attests that he agrees to be subject to the United States Patent and

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