

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICHIA CORPORATION,

Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,

Patent Owner.

CASE NO. IPR2018-00965

U.S. Patent No. 7,919,787

**PETITIONER'S UNOPPOSED MOTION FOR
PRO HAC VICE ADMISSION OF THOMAS R. MAKIN
PURSUANT TO 37 C.F.R. § 42.10(c)**

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Nichia Corporation respectfully requests that the Patent Trial and Appeal Board (“the Board”) admit Thomas R. Makin *pro hac vice* as back-up counsel in this proceeding. Patent Owner Document Security Systems, Inc. has confirmed that it does not oppose this motion.

I. Statement of Facts Showing There is a Good Cause for the Board to Admit Counsel *Pro Hac Vice*

“The Board may recognize counsel *pro hac vice* in 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.” 37 C.F.R. § 42.10(c). “[W]here 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.” *Id.* The facts here establish good cause for the Board to admit Thomas R. Makin *pro hac vice* during this proceeding, so that he may participate in, *inter alia*, oral hearings, depositions, and conferences with the Board.

1. Lead Counsel, Patrick R. Colsher, is a registered practitioner.
2. As set forth in the accompanying Declaration of Thomas R. Makin in Support of Petitioner’s Unopposed Motion for Admission *Pro Hac Vice* (“Makin Decl.”), Mr. Makin is admitted to practice law in New York, and in the United

States District Court for the Eastern District of New York, the United States District Court for the Southern District of New York, the United States District Court for the Eastern District of Michigan, and the United States Court of Appeals for the Federal Circuit. Makin Decl., ¶ 3.

3. Mr. Makin has not been suspended or disbarred from practice before any court or administrative body; denied admission to practice before any court or administrative body; or sanctioned or cited for contempt by any court or administrative body. Makin Decl., ¶¶ 6–8.

4. Mr. Makin is an experienced litigating attorney. More specifically, he has more than 17 years of litigation experience with a focus on patent infringement proceedings in federal court. Makin Decl., ¶ 4.

5. Mr. Makin has an established familiarity with the subject matter at issue in this proceeding, having represented Petitioner as a defendant in the related case in the United States District Court for the Central District of California, Case No. 2:17-cv-08849-JVS. In this related case, Patent Owner has asserted U.S. Patent No. 7,919,787 against Petitioner. Mr. Makin's experience representing Petitioner in the related case over the same patent against the same Patent Owner provides him with an established familiarity with the subject matter at issue in the current proceeding. Makin Decl., ¶ 5.

6. Mr. Makin has attested 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 Part 42 of 37 C.F.R.; and will be subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct as set forth in Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013). Makin Decl., ¶¶ 9–10.

7. Mr. Makin is also applying to appear *pro hac vice* in the following *inter partes* review proceedings involving patents owned by Patent Owner and asserted against Petitioner in the above-referenced district court case: IPR2018-00966, IPR2018-01165, IPR2018-01166, and IPR2018-01167; and has been admitted *pro hac vice* in the following *inter partes* review proceedings: IPR2015-01087, IPR2016-01750, IPR2016-01751, IPR2016-01753, IPR2016-01754, and IPR2016-01755. Makin Decl., ¶ 11.

II. Conclusion

The requirement for admission *pro hac vice* being hereby established, Petitioner respectfully requests that the Board admit Thomas R. Makin *pro hac vice* as backup counsel in this proceeding.

Dated: June 1, 2018

/Patrick R. Colsher/

Patrick R. Colsher (Reg. No. 74,955)

Shearman & Sterling LLP

599 Lexington Ave

New York, NY 10022

Tel: (212) 848-7708

Fax: (646) 848-7708

Email: patrick.colsher@shearman.com

Lead Counsel for Petitioner

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.