

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. IPR2018-01166

U.S. Patent No. 7, 256,486

**DECLARATION OF THOMAS R. MAKIN
IN SUPPORT OF PETITIONER'S UNOPPOSED MOTION
FOR ADMISSION *PRO HAC VICE***

I, Thomas R. Makin, declare as follows:

1. I am a partner at the law firm of Shearman & Sterling LLP, located at 599 Lexington Ave., New York, NY 10022.

2. I make this declaration in support of Petitioner Nichia Corporation's Motion for my admission *pro hac vice*.

3. I am a member in good standing of the Bar of New York. I am also duly admitted and authorized to practice law before the United States District Court for the Eastern District of New York, United States District Court for the Southern District of New York, United States District Court for the Eastern District of Michigan, and United States Court of Appeals for the Federal Circuit.

4. I have been practicing law and litigating cases for over 17 years. During this time, my practice has focused on patent infringement matters in federal court.

5. I am counsel for Petitioner Nichia Corporation in a patent infringement action pending in the United States District Court for the Central District of California involving the same subject matter and patent at issue in this proceeding, captioned *Document Security Systems, Inc. v. Nichia Corporation, et al.*, Case No. 2:17-cv-08849-JVS. In the district court action, Patent Owner asserted patents directed to light emitting diode products, including U.S. Patent No.

7,256,486 (“the ’486 patent”), the patent at issue in this *inter partes* review proceeding. I have spent a substantial amount of time becoming familiar with the ’087 patent, the underlying light emitting diode products and pertinent prior art. As a result, I have become extremely familiar with the subject matter at issue in this proceeding.

6. I have never been suspended or disbarred from practice before any court or administrative body.

7. I have not been denied admission to practice before any court or administrative body.

8. I have never been sanctioned or cited for contempt by any court or administrative body.

9. I have 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.

10. I 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). I also will be subject to the USPTO Rules of Professional Conduct as set forth in Changes to Representation of

Others Before the United States and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013).

11. I am 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: IPR2018-01165 and IPR2018-01167. In the past three years, I have also 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. I also sought *pro hac vice* admission in IPR2018-00965 and IPR2018-00966 and waiting for the motions for my *pro hac vice* admission to be decided.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code.

Dated: July 3, 2018



Thomas R. Makin
Back-up Counsel for Petitioner
Shearman & Sterling LLP
599 Lexington Ave.
New York, NY 10022
212.848.7698
Thomas.Makin@Shearman.com