

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

NANOCO TECHNOLOGIES LTD.,
Patent Owner.

IPR2021-00182 (Patent 9,680,068 B2)
IPR2021-00183 (Patent 7,588,828 B2)
IPR2021-00184 (Patent 7,803,423 B2)
IPR2021-00185 (Patent 7,867,557 B2)
IPR2021-00186 (Patent 8,524,365 B2)¹

Before ERICA A. FRANKLIN, GRACE KARAFFA OBERMANN, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motions for *Pro Hac Vice*
Admission of Stephen C. DeSalvo,
37 C.F.R. § 42.10

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

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Petitioner filed motions for *pro hac vice* admission of Stephen C. DeSalvo in the above-identified proceedings (collectively, “Motions”). Paper 30.² Petitioner also filed declarations from Mr. DeSalvo in support of the Motions (collectively, “Declarations”). Ex. 1042.³ Patent Owner has not filed an opposition to the motion.

In accordance with 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear in the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

Lead counsel for Petitioner, F. Christopher Mizzo, a registered practitioner, filed the Motions. Paper 30, 5. In the Motions, Petitioner states there is good cause for the Board to recognize Mr. DeSalvo *pro hac vice* during these proceedings because he is an experienced litigating attorney, and has an established familiarity with the subject matter at issue in these proceedings, as well as the parallel litigation involving the patents at issue in

² All citations are to IPR2021-00182, unless otherwise noted. Petitioner filed similar motions in IPR2021-00183, IPR2021-00184, IPR2021-00185, and IPR2021-00186.

³ Petitioner filed similar declarations in IPR2021-00183, IPR2021-00184, IPR2021-00185, and IPR2021-00186.

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these proceedings. Paper 30, 1–4. The Declarations of Mr. DeSalvo also comply with the requirements for *pro hac vice* admission. Ex. 1042 ¶¶1–9; *see Unified Patents*, slip op. at 3–4.

Based on the information presented in the Motions and Declarations, and in view of the fact that Patent Owner has not filed an opposition to Petitioner’s Motions, we find that good cause exists for *granting* the Motions and permitting the *pro hac vice* admission of Mr. DeSalvo. Petitioner must submit a Power of Attorney for Mr. DeSalvo in accordance with 37 C.F.R. § 42.10(b) and must update its mandatory notices in accordance with 37 C.F.R. § 42.8(b)(3).

It is

ORDERED that the Motions are *granted*, and Stephen C. DeSalvo is authorized to represent Petitioner as back-up counsel in each proceeding identified in the heading;

FURTHER ORDERED that a registered practitioner will continue to represent Petitioner as lead counsel in the above-identified proceedings;

FURTHER ORDERED that Mr. DeSalvo shall comply with the Office Patent Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;

FURTHER ORDERED that Mr. DeSalvo is subject to the USPTO’s Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and to the USPTO’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a);

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FURTHER ORDERED that, within ten (10) business days of the date of this order, Petitioner must submit a Power of Attorney for Mr. DeSalvo, in accordance with 37 C.F.R. § 42.10(b); and

FURTHER ORDERED that, within ten (10) business days of the date of this order, Petitioner must update its mandatory notices identifying Mr. DeSalvo as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

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