

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

v.

NANOCO TECHNOLOGIES LIMITED,  
Patent Owner

**U.S. PATENT NO. 8,524,365**

Case IPR2021-00186

**PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION OF  
STEPHEN C. DESALVO**

Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) hereby move under 37 C.F.R § 42.10(c) for the admission *pro hac vice* of Stephen C. DeSalvo in the present *inter partes* review so that he may be appointed back up counsel for Samsung.

## **I. INTRODUCTION AND BACKGROUND**

Authorization for this motion was provided by the PTAB in the Notice of Filing Date Accorded to Petition (Paper No. 4). Counsel for Samsung contacted counsel for Patent Owner Nanoco Technologies, Limited (“Nanoco”) twice by email regarding the present motion for *pro hac vice* admission of Mr. DeSalvo, and as of the filing of the present motion, counsel for Nanoco has not provided any response. Therefore, the present motion is proper at this time. As explained further below, Mr. DeSalvo is an experienced litigating attorney with an established familiarity with the subject matter at issue in this *inter partes* review.

“[W]here the 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 showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c).

A motion for *pro hac vice* admission must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.

- b. Be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:
- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
  - ii. No suspensions or disbarments from practice before any court or administrative body;
  - iii. No application for admission to practice before any court or administrative body ever denied;
  - iv. No sanctions or contempt citations imposed by any court or administrative body;
  - v. The individual seeking to appear 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.;
  - vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et. seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a);
  - vii. All other proceedings before the Office for which the individual has applied to appear pro hac vice in the last three (3) years; and
  - viii. Familiarity with the subject matter at issue in the proceeding.

*Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, 2013 WL 8700556 (PTAB Oct. 15, 2013).

## II. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE PRESENT MOTION

Samsung's lead counsel is a registered practitioner. (Paper No. 1 at 43.)

Mr. DeSalvo is a member in good standing of the State Bar of New York and the District of Columbia Bar, is admitted to practice before the U.S. Courts of Appeals for the Third Circuit, Federal Circuit, and District of Columbia Circuit, and

has practiced patent litigation since 2019. DeSalvo Decl. at ¶ 2. Mr. DeSalvo litigates patent cases before various federal courts and the United States International Trade Commission. DeSalvo Decl. at ¶ 3. Through his years of practice, Mr. DeSalvo has gained substantial experience in discovery, *Markman* hearings, and appeals. *Id.* Mr. DeSalvo is familiar with IPR proceedings. DeSalvo Decl. at ¶ 3.

Mr. DeSalvo has never been suspended or disbarred from practice before any court or administrative body. DeSalvo Decl. at ¶ 4.

Mr. DeSalvo has never had any applications for admission to practice before any court or administrative body denied. DeSalvo Decl. at ¶ 5.

Mr. DeSalvo has never had sanctions or contempt citations imposed by any court or administrative body. DeSalvo Decl. at ¶ 6.

Mr. DeSalvo has read and will comply with the Official Patent Trial Practice Guide and the Board's Rules of Practice for trials set forth in part 42 of 37 C.F.R. DeSalvo Decl. at ¶ 7.

Mr. DeSalvo will be subject to USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. §11.19(a). DeSalvo Decl. at ¶ 8.

Mr. DeSalvo is very familiar with the subject matter at issue in this *inter partes* review. DeSalvo Decl. at ¶ 9. Mr. DeSalvo is counsel to Samsung, and has been providing legal advice to Samsung in connection with the related district court

litigation between the parties to this IPR involving the same patent at issue in this proceeding, U.S. Patent No. 8,524,365 (“the ’365 Patent”). *Id.* During this representation, Mr. DeSalvo was substantively involved in developing and refining Samsung’s invalidity and non-infringement positions. *Id.* Mr. DeSalvo has also specifically reviewed the papers and evidence filed by the parties in this IPR, as well as the orders of the Board. *Id.* Therefore, Mr. DeSalvo, as a result of his representation of Samsung, is uniquely positioned to represent Samsung in this IPR.

### **III. CONCLUSION**

For all the foregoing reasons, there is good cause to admit Mr. DeSalvo on a *pro hac vice* basis to serve as back up counsel for Samsung. Therefore, Samsung respectfully requests that this Motion for *Pro Hac Vice* Admission of Stephen C. DeSalvo be granted.

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