

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT

Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,

Patent Owner.

Case No. IPR2024-00193

U.S. Patent No. 10,143,868

**PETITIONER'S MOTION FOR ADMISSION
PRO HAC VICE OF W. COOK ALCIATI**

LIST OF EXHIBITS

1001	U.S. Patent No. 10,143,868 to Lopes et al.
1002	File History of U.S. Patent No. 10,143,868
1003	Declaration of Milosh Puchovsky
1004	WO2013/160776 to Ramorino et al.
1005	U.S. Patent No. 8,739,482 to Feil, III et al.
1006	3M Fire Protection Products Publication
1007	STI's Opening Claim Construction Brief
1008	STI's Supplemental Infringement Contentions
1009	STI's EZDR Product Data Sheet
1010	U.S. Patent Publication No. 2015/0251028 to Klein et al.
1011	U.S. Patent Publication No. 2014/0318064 to Reinhardt
1012	WO2012/009211 to Zernach
1013	GB2490598 to Rigollet et al.
1014	GB2349189 to Gardner
1015	U.S. Patent No. 4,373,235 to Korgaonkar
1016	Declaration of Michael A. Dorfman
1017	U.S. Patent No. 8,069,623 to Colwell et al.
1018	U.S. Patent Publication No. 2012/0242083 to Blocher et al.
1019	Declaration of Sebastian Simon
1020	STI's Objections and Responses to Hilti's Second Set of Interrogatories
1021	<i>Sotera</i> Stipulation

- 1022 Screen capture of The Wayback Machine Archive of the below URL:
<https://web.archive.org/web/20151123164531/http://multimedia.3m.com/mws/media/446191O/3mtm-fire-barrier-pass-through-device.pdf>
- 1023 Declaration of W. Cook Alciati in Support of Motion for Admission
Pro Hac Vice

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10, Petitioner Hilti Aktiengesellschaft requests that the Board admit W. Cook Alciati *pro hac vice* in this proceeding. Patent Owner has indicated that they will not oppose this motion.

II. GOVERNING RULE

Pursuant to 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. For example, where 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.

III. SHOWING UNDER 37 C.F.R. §42.10(c)

The undersigned is a registered practitioner and is experienced in *inter partes* proceedings before the Board. W. Cook Alciati is a member in good standing of the New York State Bar, with no suspensions or disbarments from practice, nor any application for admission to practice denied, nor any sanctions or contempt citations, and is admitted to practice in the United States District Court for the Western District of New York, the United States District Court for the Western District of Wisconsin, the United States District Court for the District of Colorado, and the United States Court of Appeals for the Federal Circuit. (Ex.

1023 at ¶¶2-5). Mr. Alciati has been litigating patent cases for approximately thirteen years and has been involved in several *inter partes* reviews and reexamination proceedings. (*Id.* at ¶1).

Mr. Alciati has familiarity with the subject matter at issue in the proceeding. Mr. Alciati has reviewed U.S. Patent No. 10,143,868. Mr. Alciati is also counsel for Plaintiff in the related district court litigation *Hilti Aktiengesellschaft v. Specified Technologies Inc.*, No. 1:22-cv-01248-CJB (D. Del). Moreover, Mr. Alciati has reviewed the Petition for *Inter Partes* review, the declaration of Milosh Puchovsky, the declaration of Sebastian Simon, as well as the primary references at issue in the Petition – Ramorino, Feil, Rigollet, and 3M Publication. (*Id.* at ¶8). Therefore, Mr. Alciati has familiarity with the subject matter at issue in the proceeding. Mr. Alciati has also been admitted *pro hac vice* before the Board in IPR2014-01235, IPR2015-00249, IPR2017-01809, IPR2017-01810, IPR2019-00405, IPR2019-00408, IPR2019-00409, IPR2022-00527, IPR2022-00528, IPR2022-00574, IPR2022-00757, IPR2022-00758, IPR2022-01566, and IPR2023-00852. (*Id.* at ¶7).

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board admit W. Cook Alciati *pro hac vice* as back-up counsel in this proceeding.

Dated: February 13, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONER'S MOTION FOR ADMISSION PRO HAC VICE OF W. COOK ALCIATI and EXHIBIT 1023 were served in their entireties by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as providing courtesy copies via e-mail to the following attorneys of record for the Petitioner listed below:

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