

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORMFACTOR, INC.,
Petitioner,

v.

TECHNOPROBE S.P.A.,
Patent Owner.

U.S. Patent No. 11,035,885

Issue Date: June 15, 2021

Title: TESTING HEAD HAVING IMPROVED FREQUENCY PROPERTIES

Case No. IPR2024-00933

**PETITIONER'S MOTION FOR ADMISSION *PRO HAC VICE* OF
ANRI NAKAMOTO PURSUANT TO 37 C.F.R. § 42.10**

LISTING OF EXHIBITS

Exhibit	Description
Ex. 1001	U.S. Pat. No. 11,035,885 (the “’885 patent”)
Ex. 1002	The ’885 Patent Prosecution History
Ex. 1003	Declaration of Frederick L. Taber
Ex. 1004	Korea Patent No. 10-1384714 (“Kim KR”)
Ex. 1005	Certified English Translation of Kim KR
Ex. 1006	U.S. Pub. No. 2015/0198632 A1 (“Kim”)
Ex. 1007	Japanese Patent Pub. No. H11-352182 (“Tezuka”)
Ex. 1008	Certified English Translation of Tezuka
Ex. 1009	U.S. Pat. No. 6,417,684 (“Schmid”)
Ex. 1010	U.S. Pat. No. 5,225,777 (“Bross”)
Ex. 1011	U.S. Pat. No. 9,470,715 (“Fan”)
Ex. 1012	U.S. Pub. No. 2014/0197860 (“Hsu”)
Ex. 1013	Introduction to Probe Cards, by Rod Schwartz (1998 SWTest Conference)
Ex. 1014	U.S. Pat. No. 4,622,514 (“Lewis”)
Ex. 1015	U.S. Pat. No. 10,281,491 (“McQuade”)
Ex. 1016	EP3555638A1 Prosecution History
Ex. 1017	Excerpt of JP2019-531897 Prosecution History
Ex. 1018	Certified English Translation of Excerpt of JP2019-531897 Prosecution History
Ex. 1019	Nakamoto Decl ISO Motion for Admission <i>Pro Hac Vice</i>
Ex. 1020	Scheduling Order in <i>Technoprobe S.p.A. v. FormFactor, Inc.</i> , Case No. 1:23-cv-00842-JCG (D. Del.)
Ex. 1021	Patent Owner’s Amended Complaint in <i>Technoprobe S.p.A. v. FormFactor, Inc.</i> , Case No. 1:23-cv-00842-JCG (D. Del.)
Ex. 1022	United States District Courts — National Judicial Caseload Profile, <i>available at</i> https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf (last accessed May 9, 2024)
Ex. 1023	Curriculum Vitae of Frederick L. Taber
Ex. 1024	[Reserved]
Ex. 1025	[Reserved]
Ex. 1026	USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
Ex. 1027	Cover Pleading of Patent Owner’s Infringement Contentions

Ex. 1028	SWTest Willtechnology Presentation
Ex. 1029	SWTest Willtechnology Presentation – WayBack June 3, 2016
Ex. 1030	SWTest Willtechnology Presentation – WayBack December 6, 2016
Ex. 1031	SWTest Willtechnology Presentation – June 7, 2016 Podium Proceedings

Pursuant to 37 C.F.R. § 42.10, Petitioner FormFactor, Inc. (“FormFactor” or “Petitioner”) respectfully requests that the Board admit Anri Nakamoto *pro hac vice* in this proceeding.

I. STATEMENT OF FACTS

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.

The facts, supported by the accompanying Declaration of Anri Nakamoto in Support of Petitioner’s Motion for Admission *Pro Hac Vice* (Ex. 1019, “Nakamoto Declaration”), establish good cause to admit Mr. Nakamoto *pro hac vice* in this proceeding.

Lead counsel T. Vann Pearce, Jr. is a registered practitioner.

Anri Nakamoto is an experienced litigation attorney. Mr. Nakamoto has been a litigating attorney for more than 8 years. Nakamoto Declaration ¶ 1. Mr. Nakamoto has been litigating patent cases for over 8 of those years. *Id.* Mr. Nakamoto is a member in good standing of the California State Bar and the District of Columbia 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 Northern District of California. *Id.* ¶¶ 1-4.

Mr. Nakamoto has familiarity with the subject matter at issue in this proceeding and in *Technoprobe S.p.A. v. FormFactor, Inc.*, Case No. 1:23-cv-00842-JCG (Del., filed August 4, 2023), in which U.S. Patent No. 11,035,885 was asserted by the Patent Owner. Nakamoto Declaration ¶ 8.

Mr. Nakamoto has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of the C.F.R., and he agrees to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Nakamoto Declaration ¶¶ 5-6.

II. ANALYSIS

The facts contained in the Statement of Facts above, and contained in the Nakamoto Declaration, establish that there is good cause to admit Mr. Nakamoto *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Lead counsel is a registered

practitioner, Mr. Nakamoto is an experienced patent litigation attorney, and Mr. Nakamoto has familiarity with the subject matter at issue in this proceeding.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board admit Anri Nakamoto *pro hac vice* in this proceeding.

Respectfully submitted,

Dated: June 28, 2024

By /T. Vann Pearce, Jr./

T. Vann Pearce, Jr., Reg. No. 58,945

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing PETITION FOR IPR and associated exhibits were caused to be served on June 28, 2024 via overnight courier upon the following counsel of record for Patent Owner:

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Courtesy copies were also served via electronic mail on Patent Owner's counsel of record in a related district court litigation:

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