

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORMFACTOR, INC.,
Petitioner,

v.

TECHNOPROBE S.P.A.,
Patent Owner.

IPR2024-00933
Patent 11,035,885 B2

Before MICHELLE N. WORMMEESTER, JULIA HEANEY, and
ANDREW L. NALVEN, *Administrative Patent Judges*.

NALVEN, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion for Admission
Pro Hac Vice of Ari Nakamoto
37 C.F.R. § 42.10

On June 28, 2024, FormFactor, Inc. (“Petitioner”) filed a motion requesting *pro hac vice* admission of Anri Nakamoto. Paper 3 (“Motion”). Petitioner submitted a Declaration from Anri Nakamoto in support of the Motion. Ex. 1019 (“Declaration”). Patent Owner has not opposed the Motion. For the reasons provided below, Petitioner’s Motion is *granted*.

In accordance with 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. 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*, IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

“The time for filing *pro hac vice* motions . . . [is] no sooner than twenty one (21) days after service of the petition, which is the time for filing patent owner mandatory notices.” *Unified Patents*, Paper 7 at 2–3. Here, Petitioner filed the Motion sooner than twenty one days after service of the Petition, and before filing of Patent Owner Mandatory Notices. The Motion’s certificate of service (Paper 3, 4) indicates, however, that Petitioner served the Motion on the lead counsel later identified in Patent Owner’s Mandatory Notices (Paper 4), and sufficient time has elapsed since the Motion was filed to allow Patent Owner the opportunity to respond. We therefore excuse the timing of the Motion.

Based on the facts set forth in the Motion and the accompanying Declaration, we conclude that Anri Nakamoto has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Anri

Nakamoto demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, that Anri Nakamoto meets all other requirements for admission *pro hac vice*. See Ex. 1019 ¶¶ 1– 8.

Accordingly, Petitioner established good cause for *pro hac vice* admission of Anri Nakamoto.

We note that Petitioner filed a Power of Attorney including Anri Nakamoto in accordance with 37 C.F.R. § 42.10(b). Paper 2. Petitioner also included a Mandatory Notice in the Petition, identifying Anri Nakamoto as back-up counsel, as required by 37 C.F.R. § 42.8(b)(3). Paper 1, 3.

In consideration of the foregoing, it is hereby

ORDERED that Petitioner’s Motion seeking admission *pro hac vice* for Anri Nakamoto is *granted*;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that Anri Nakamoto is authorized to represent Petitioner as back-up counsel only in this proceeding;

FURTHER ORDERED that Anri Nakamoto comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide¹ (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; and

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

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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