

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG SEMICONDUCTOR INC., and
SAMSUNG AUSTIN SEMICONDUCTOR LLC,
Petitioner,

v.

HOME SEMICONDUCTOR CORPORATION,
Patent Owner

Case IPR2015-00460
Patent 6,146,997

**PATENT OWNER HOME SEMICONDUCTOR CORPORATION'S
MOTION FOR *PRO HAC VICE* ADMISSION OF JERRY CHEN
UNDER 37 C.F.R. § 42.10(c)**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c), Patent Owner, by and through its attorneys, respectfully requests that the Board admit Jerry Chen, *pro hac vice* in this proceeding as back-up counsel only. Petitioner has stated that it does not oppose this motion.

II. GOVERNING LAW, RULES, AND PRECEDENT

Section 42.10(c) states as follows:

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.

In addition, the Board has required that a motion for *pro hac vice* admission be filed in accordance with the “Order – Authorizing Motion for Pro Hac Vice Admission” in case IPR2013-00639, Paper 7 (“Representative Order”). The Representative Order states that the motion must “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding[,]” and “[b]e 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 the C.F.R.;
- vi. The individual will be subject to the U.S.P.T.O. Code of Professional Responsibility 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.

Patent Owner respectfully notes that the enumerated list cited above, which is provided in IPR2013-00639, merely requires "familiarity" with the subject

matter at issue and does not set forth specific requirements. Mr. Chen meets the standard of “familiarity,” as demonstrated below. *See* Section IV, *infra*.

III. STATEMENT OF FACTS

Based on the following statement of facts, and supported by the Declaration of Jerry Chen, submitted herewith, Patent Owner submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Jerry Chen, in this proceeding:

1. Patent Owner’s lead counsel, Craig R. Kaufman, is a registered practitioner (Reg. No. 34,636).
2. Mr. Chen is a Partner at the law firm of TechKnowledge Law Group LLP. (Declaration of Jerry Chen in Support of Patent Owner’s Motion for *Pro Hac Vice* Admission in IPR2015-00460).
3. Mr. Chen is an experienced litigating attorney, and nearly the entirety of his practice has consisted of patent litigation and related business litigation. (*Id.*) Mr. Chen has been involved as counsel in a number of litigation matters involving intellectual property. (*Id.*) Among those matters, Mr. Chen was involved in a number of litigation matters related to semiconductor technology, including *In re Certain Semiconductor Chips with DRAM Circuitry* (337-TA-819); *In re Certain Semiconductor*

Chips with Minimized Chip Package Size (337-TA-630); and *United Microelectronics Corp. v. LSI Corp.* (09-cv-00105). (*Id.*)

4. Mr. Chen is a member in good standing of the Bar of California. (*Id.*)
5. Mr. Chen has never been suspended or disbarred from practice before any court or administrative body. (*Id.*)
6. No application filed by Mr. Chen for admission to practice before any court or administrative body has ever been denied. (*Id.*)
7. No sanctions or contempt citations have been imposed against Mr. Chen by any court or administrative body. (*Id.*)
8. Mr. Chen has read and agrees to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the C.F.R. (*Id.*)
9. Mr. Chen understands that he will be subject to the U.S.P.T.O. Rules of Professional Conduct 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.*)
10. Mr. Chen has not applied to appear *pro hac vice* in any other proceedings before the U.S.P.T.O. in the last three (3) years. (*Id.*)
11. Mr. Chen has an established familiarity with the subject matter at issue in this proceeding. Mr. Chen has acquired substantial understanding of the underlying legal and technological issues at stake in this proceeding. (*Id.*)

In particular, Mr. Chen has spent considerable time reviewing the patent-at-issue (U.S. Patent No. 6,146,997), the file history, the Petition, and all exhibits which accompanied the Petition, and all documents filed in this action. Furthermore, Mr. Chen has actively been involved with and worked on issues related to the '997 Patent in connection with the district court case *Home Semiconductor Corporation v. Samsung Electronics Co., Ltd., et al*, Case No. 1:13-cv-02033-RGA (D. Del.). (*Id.*)

IV. GOOD CAUSE EXISTS FOR *PRO HAC VICE* ADMISSION OF JERRY CHEN

The facts outlined above in the Statement of Facts, and contained in the Declaration of Jerry Chen, establish that there is good cause to admit Mr. Chen *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Patent Owner's lead and backup counsel are registered practitioners. As supported by Mr. Chen's Declaration, Mr. Chen has an established familiarity with the subject matter at issue.

V. CONCLUSION

For at least the reasons set forth above, Patent Owner respectfully requests that the Board admit Jerry Chen, *pro hac vice* in this proceeding.

Case No. IPR2015-00460

Patent No. 6,146,997

Dated: August 11, 2015

By: /s/ Craig R. Kaufman
Registration No. 34,636
Lead Counsel for Patent Owner
TechKnowledge Law Group LLP
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CERTIFICATE OF SERVICE

I hereby certify that on August 11, 2015, a true and correct copy of the foregoing **PATENT OWNER HOME SEMICONDUCTOR CORPORATION'S MOTION FOR *PRO HAC VICE* ADMISSION OF JERRY CHEN UNDER 37 C.F.R. § 42.10(c)** was served electronically via email to the Petitioners by serving the correspondence email addresses of record as follows:

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