

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEQUENOM, INC.
Petitioner,

v.

THE BOARD OF TRUSTEES OF
THE LELAND STANFORD JUNIOR UNIVERSITY
Patent Owner.

Case IPR2013-00390
Patent 8,195,415 B2

Before LORA M. GREEN, FRANCISCO C. PRATS, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION

Sequenom's Motion for *Pro Hac Vice* Admission of
MICHAEL J. MALECEK
37 C.F.R. § 42.10

Petitioner, Sequenom, Inc. (“Sequenom”) filed a motion requesting *pro hac vice* admission of Michael J. Malecek (Paper 11), accompanied by a declaration of Mr. Malecek in support of the motion (Ex. 1012). The motion is unopposed. For the reasons provided below, Sequenom’s motion is *granted*.

As set forth in 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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “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). In authorizing motions for *pro hac vice* admission, the Board also requires 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 this proceeding. Paper 4 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 6 in IPR2013-00010 at 3-4).

In its motion, Sequenom asserts that there is a good cause for Mr. Malecek’s *pro hac vice* admission because: (1) Mr. Malecek is an experienced litigating attorney and has experience litigating patent cases; and (2) as counsel for Sequenom in the co-pending litigation that involves the same patent challenged in this proceeding, Mr. Malecek has an established familiarity with the subject matter at issue in the proceeding. Paper 11 at 3-5. In support of the motion, Mr. Malecek attests to these facts in his declaration with sufficient explanations. Ex. 1012. In addition, Sequenom’s lead counsel, Steven P. O’Connor, is a registered practitioner. Paper 11 at 3.

Based on the facts set forth above, we conclude that Mr. Malecek has sufficient legal and technical qualifications to represent Sequenom in this proceeding, and that there is a need for Sequenom to have counsel involved in the related district court litigation involved in this proceeding. *See* IPR2013-00639, Paper 7, dated October 15, 2013 (superseding IPR2013-00010, Paper 6, dated October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under “Representative Orders, Decisions, and Notices”). Accordingly, Sequenom has established good cause for Mr. Malecek’s *pro hac vice* admission. Mr. Malecek will be permitted to appear *pro hac vice* in the instant proceeding as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Sequenom’s motion for *pro hac vice* admission of Mr. Malecek for the instant proceeding is granted; Mr. Malecek is authorized to represent Sequenom as back-up counsel in the instant proceeding;

FURTHER ORDERED that Sequenom is to continue to have a registered practitioner as lead counsel in the instant proceeding;

FURTHER ORDERED that Mr. Malecek is to comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

FURTHER ORDERED that Mr. Malecek is to be 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.*

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