

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTAVIS, INC., ACTAVIS LABORATORIES FL, INC., ACTAVIS PHARMA,
INC., AMNEAL PHARMACEUTICALS, LLC, AMNEAL
PHARMACEUTICALS OF NEW YORK, LLC, AUROBINDO PHARMA LTD.,
AUROBINDO PHARMA USA, INC., BRECKENRIDGE PHARMACEUTICAL,
INC., VENNOOT PHARMACEUTICALS, LLC, SANDOZ INC., SUN
PHARMA GLOBAL FZE, AND SUN PHARMACEUTICAL INDUSTRIES,
LTD.,
Petitioners,

v.

RESEARCH CORPORATION TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2014-01126
Patent No. RE 38,551

**PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTIONS FOR
PRO HAC VICE ADMISSION OF JAMES F. HURST, CHARLES B. KLEIN,
AND MAUREEN L. RURKA UNDER 37 C.F.R. § 42.10**

Petitioners have filed three virtually identical Motions for *Pro Hac Vice* Admission Under 37 C.F.R. § 42.10 of three trial counsel, Messrs. Hurst and Klein, and Ms. Rurka (collectively “Motions”; Papers 11, 12, and 13, respectively, filed August 19, 2014). Because Petitioners have not established good cause for the admission of *three* trial counsel into the present proceeding, the Motions should be denied. Patent Owner submits that the admission of *one* qualified trial counsel into the proceeding is reasonable for both parties, and furthers the just, speedy, and inexpensive resolution of this proceeding. 37 C.F.R. § 42.1(b). Patent Owner is willing to stipulate that it will not seek to admit more than one trial counsel into the present proceeding, if Petitioners are likewise limited to one. This paper is timely filed no later than one week after the filing of the Motions. *See* IPR2013-00639, Paper 7, p. 3.

Each of the Motions avers that the individual is “trial counsel for Petitioners in patent litigation against Patent Owner concerning the patent challenged in the Petition,” with Mr. Hurst being denoted as “lead” trial counsel. Paper 11, p. 3, Paper 12, p. 3, and Paper 13, p. 3. The Motions merely provide a general statement about each counsel’s role, stating that “as a result of [counsel’s] involvement as trial counsel for Petitioners in co-pending district court litigation over the involved patent, [counsel] has obtained familiarity with the involved patent, the prior art, and the various issues raised in this proceeding.” *Id.* The Motions ascribe no

different or particular expertise, role, responsibility or knowledge to the trial counsel individually. Aside from the designation of Mr. Hurst as “lead” trial counsel, the Motions present no attribute, knowledge, or experience that distinguishes one counsel over another. Therefore, the Motions provide no reason, much less “good cause,” why all **three** counsel are needed in the present proceeding. Since the contributions of each as described in the Motions are virtually identical, Petitioners have, at best, provided “good cause” for admission of one trial counsel, not all three.

Moreover, each of the Motions notes that the trial counsel “has not applied to appear *pro hac vice* in the last three years in any matter before the Board.” Paper 11, p. 4, Paper 12, p. 4, and Paper 13, p 3. Therefore, none of the trial counsel has any particularized expertise in *inter partes* review or other proceedings before the Patent Trial and Appeal Board that would provide a unique reason why that counsel should be admitted into the present proceeding.

The recognition of counsel *pro hac vice* during a proceeding is within the discretion of the Board, based upon a showing of good cause. 37 C.F.R. § 42.10(c). Here, Petitioners have not established good cause for admission of **three** trial counsel whose individual contributions would be virtually the same. Therefore, the Motions should be denied, or, in the alternative, Petitioners should be limited to one qualified trial counsel.

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Date: August 22, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on this 22nd day of August 2014, the foregoing PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTIONS FOR *PRO HAC VICE* ADMISSION OF JAMES F. HURST, CHARLES B. KLEIN, AND MAUREEN L. RURKA was served via electronic mail by agreement of the parties on the following counsel of record for Petitioners.

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Andrew R. Sommer (asommer@winston.com)
Winston & Strawn LLP

Date: August 22, 2014



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