

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 IPR2014-01126
Patent RE 38,551 E

Before FRANCISCO C. PRATS, JACQUELINE WRIGHT BONILLA, and
ZHENYU YANG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

DECISION
Petitioners' Motion for *Pro Hac Vice*
Admission of James F. Hurst
37 C.F.R. § 42.10

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”) filed a Motion for *Pro Hac Vice* Admission of James F. Hurst. Paper 11 (“Motion”). Petitioners also filed Motions for *Pro Hac Vice* Admission of Charles B. Klein (Paper 12) and Maureen L. Rurka (Paper 13). Petitioners filed Declarations from Mr. Hurst (Ex. 1037), as well as the other two attorneys (Exs. 1038 and 1039), in support of the Motions. Research Corporation Technologies, Inc., (“Patent Owner”) filed an Opposition to Petitioners’ Motions for *Pro Hac Vice* Admission of all three attorneys. Paper 15 (“Opposition”). For the reasons provided below, the Motion for *Pro Hac Vice* Admission of James F. Hurst is *granted*.

As set forth in 37 C.F.R. § 42.10(c), we 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, we also require a statement of facts showing there is good cause for us to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. *See* Paper 8 at 2; *see also* “Order—Authorizing Motion for *Pro Hac Vice* Admission” in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (expanded panel) (superseding IPR2013-00010, Paper 8).

In their Motion, Petitioners state that there is good cause for Mr. Hurst's *pro hac vice* admission because he: (1) is an experienced litigation attorney, who has been involved in numerous patent cases; (2) has familiarity with relevant subject matter because he "is lead trial counsel for Petitioners in patent litigation against Patent Owner concerning the patent challenged in the Petition (*UCB, Inc., et al. v. Accord Healthcare, Inc., et al.*, C.A. No. 13-1206-LPS (D. Del.))"; and (3) "has obtained familiarity with the involved patent, the prior art, and the various issues raised in this proceeding." Motion, 2-3. In support of the Motion, Mr. Hurst attests to these facts in his Declaration with sufficient explanations. Ex. 1037.

In its Opposition, Patent Owner states that Petitioners have filed "three virtually identical" Motions for *Pro Hac Vice* Admission of three trial attorneys, including Mr. Hurst. Opposition 2. Patent Owner contends that Petitioners have not shown good cause for admission of all three when the "admission of *one* qualified trial counsel" is reasonable and "furthers the just, speedy, and inexpensive resolution of this proceeding." *Id.* (citing 37 C.F.R. § 42.1(b)). Patent Owner also contends that the Motion presents "no attribute, knowledge, or experience that distinguishes one counsel over another," except to acknowledge the designation of Mr. Hurst as "lead" trial counsel. *Id.* at 3. Patent Owner further asserts that we should deny *pro hac vice* admission of all three attorneys because none have "any particular expertise in *inter partes* review," pointing out that none have applied to appear *pro hac vice* before the Board in the last three years. *Id.*

Based on the facts set forth above, we conclude that Mr. Hurst has sufficient legal and technical qualifications to represent Petitioners in this proceeding. Accordingly, Petitioners have established good cause for Mr. Hurst's *pro hac vice* admission.

We note that Petitioners do not fail to establish good cause by virtue of requesting *pro hac vice* admission of three trial attorneys rather than just one. There are legitimate reasons why a party may wish to have more than one trial attorney involved in an *inter partes* review as back-up counsel, especially when a number of parties act collectively as one party in relation to single Petition, as is the case for Petitioners here. Three additional attorneys acting as back-up counsel in this proceeding are not excessive, and counsel for Petitioners will speak as one collective voice before the Board in any event. Petitioners also do not fail to establish good cause because none of the three attorneys have applied to appear *pro hac vice* before the Board in the last three years. Even assuming those attorneys have no expertise in proceedings before the Board prior to now, Petitioners' lead counsel, Samuel S. Park, is a registered practitioner. Motion 2.

Mr. Hurst 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 forgoing reasons, it is

ORDERED that Petitioners' Motion for *Pro Hac Vice* Admission of Mr. Hurst for this proceeding is GRANTED;

FURTHER ORDERED that Petitioners are to continue to have a registered practitioner represent it as lead counsel for this proceeding; and

FURTHER ORDERED that Mr. Hurst is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R., and to be subject to the Office's 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).

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