

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRAXAIR DISTRIBUTION, INC.,
Petitioner

v.

INO THERAPEUTICS LLC,
Patent Owner

Case IPR No.: IPR2015-00889
Patent 8,573,209 B2

Before KEN B. BARRETT, MICHAEL J. FITZPATRICK, AND SCOTT A.
DANIELS, *Administrative Patent Judges*

PRAXAIR DISTRIBUTION, INC.'S
MOTION FOR PRO HAC VICE ADMISSION OF
MICHAEL J. ABERNATHY PURSUANT TO 37 C.F.R. § 42.10

Pursuant to 37 C.F.R. § 42.10, Praxair Distribution, Inc. (“Petitioner”) respectfully requests the Board to recognize Michael J. Abernathy as *pro hac vice* counsel for this proceeding.

I. Time for Filing

Pursuant to Paper 7, “Order Authorizing Motion *for Pro Hac Vice* Admission,” in Case IPR2013-00639 (“Order”) and Paper 3, “Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response,” in the present case (IPR2015-00889) (“Notice”), this motion for *pro hac vice* admission is authorized and is being filed no sooner than twenty-one (21) days after service of the petition.

II. Good Cause for Additional Back-Up Counsel

Petitioner respectfully requests admission of Mr. Abernathy as additional back-up counsel to promote attorney availability for the discovery period and trial and to provide additional expertise in the discovery process. The Petition involves 7 claims and an expert declarant, and it is expected that the Patent Owner will also use expert declarations requiring depositions. In order to facilitate an efficient proceeding, Petitioner respectfully submits that there is a need for the admission of a second back up counsel.

III. Statement of Facts

Pursuant to the Order, the following statement of facts, supported by the attached Declaration of Mr. Abernathy, shows that there is good cause for the Board to recognize Mr. Abernathy *pro hac vice*.

Lead counsel for this proceeding, Sanjay K. Murthy, is a registered practitioner (Reg. No. 45,976).

Mr. Abernathy is an experienced litigation attorney, and has served as first chair trial counsel in numerous complex cases and patent infringement litigations in various district and appellate courts, including the Supreme Court of the United States. Mr. Abernathy has not been suspended or disbarred from practice, and he has not had any application for admission to practice denied, or had any sanctions or contempt citations imposed against him.

Mr. Abernathy is an active member in good standing of the bar of Illinois and is admitted to practice before the United States Supreme Court, the United States Court of Appeals for the Federal Circuit, as well as the First, Third, Fifth, Seventh, Ninth, and Eleventh Circuits. He is also admitted to practice before the United States District Court for the Eastern District of Michigan, the United States District Court for the Eastern District of Wisconsin, and the United States District Court for the Northern District of Illinois.

Mr. Abernathy's mailing address is K&L Gates LLP, 70 W. Madison St.,

Suite 3100, Chicago Illinois, 60602. His email address is michael.abernathy@klgates.com and his direct dial phone number is 312-807-4257. He is listed on the Power of Attorney that was filed by the Petitioner as Paper 2 on March 16, 2015.

Mr. Abernathy is extremely familiar with the technology at issue in the petition. He is familiar with the patent at issue and has extensive knowledge of the assertions regarding the invalidity of the patent. Additionally, he is actively involved in the currently pending litigation in the United States District Court for the District of Delaware (1:15-cv-00170), which also involves the patent at issue. He is also familiar with the Petitioner's overall legal strategies and has in-depth knowledge of issues that may arise over the course of the proceeding. Mr. Abernathy has thus established familiarity with the subject matter at issue in this proceeding.

Mr. Abernathy 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 37 C.F.R., and he agrees to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Mr. Abernathy applied to appear *pro hac vice* in IPR2014-00899 on January 22, 2015, and the Board granted this motion on January 30, 2015.

Petitioner relies on Mr. Abernathy in the development of its legal strategy with respect to this patent, and Petitioner wishes Mr. Abernathy to represent it in this proceeding.

IV. Affidavit or Declaration of Individual Seeking to Appear

This motion for *pro hac vice* admission is accompanied by a Declaration of Mr. Abernathy as required by the Order.

V. Conclusion

The facts contained in the Statement of Facts above, and contained in the Declaration of Mr. Abernathy, establish that there is good cause to admit Mr. Abernathy *pro hac vice* in this proceeding under 37 C.F.R. § 42.10(c).

Respectfully submitted by

K&L Gates LLP,

Date: October 1, 2015

/Sanjay K. Murthy/

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