

Filed on behalf of: INO Therapeutics, LLC

Entered: November 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRAXAIR DISTRIBUTION, INC.
Petitioner

v.

INO THERAPEUTICS LLC,
Patent Owner

Case IPR2015-00889
U.S. Patent No. 8,573,209 B2

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

**PATENT OWNER INO THERAPEUTICS LLC'S MOTION FOR
PRO HAC VICE ADMISSION OF KENNETH G. SCHULER
UNDER 37 C.F.R. § 42.10(c)**

I. RELIEF REQUESTED

Under 37 C.F.R. § 42.10(c) and the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3), Patent Owner INO Therapeutics LLC (“Patent Owner”) respectfully requests the *pro hac vice* admission of attorney Kenneth G. Schuler, Esq. in this proceeding. Patent Owner has conferred with counsel for Praxair Distribution, Inc. (“Petitioner”), and Petitioner does not oppose this motion.

II. LEGAL STANDARD

Under 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 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.

The Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3) further instructs:

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of

counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under “Representative Orders, Decisions, and Notices.”

(*Id.* at 2.) The above referenced “Order - - Authorizing Motion for *Pro Hac Vice* Admission” further provides:

A motion for *pro hac vice* admission must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.
- b. Be 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 Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R.;
- vi. The individual will 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);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

(IPR2013-00639, Paper No. 7 at 3.) As set forth below, and in the accompanying Declaration of Kenneth G. Schuler ("Schuler Decl."), attached as Exhibit 2005, each of these requirements is satisfied here.

III. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE KENNETH G. SCHULER *PRO HAC VICE* IN THIS PROCEEDING

Mr. Schuler is a member in good standing of the Illinois State Bar (Bar No. 6226036). He is also admitted to practice before the U.S. District Courts for the Eastern District of Michigan, Eastern District of Wisconsin, Northern District of Illinois (General and Trial Bars), Southern District of Illinois, and the U.S. Courts of Appeals for the Sixth, Seventh, and Federal Circuits. (Schuler Decl. at ¶ 2.)

Mr. Schuler has never been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 3.) No application of Mr. Schuler for admission to practice before any court or administrative body has ever been denied. (*Id.*) Nor has any court or administrative body imposed sanctions or contempt citations against Mr. Schuler. (*Id.*) Mr. Schuler has read, fully understands, 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. (*Id.* ¶ 4.) Mr. Schuler acknowledges and agrees that he will 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). (*Id.*)

Patent Owner's lead counsel in this proceeding, Robert Steinberg, is a registered practitioner (Reg. No. 33144). Moreover, as set forth below (and in his accompanying declaration), Mr. Schuler is both an experienced and technically-trained litigation attorney with an established familiarity with the subject matter at issue in this proceeding.

Mr. Schuler received a Bachelor of Arts degree from the University of Northern Iowa in 1990 and a law degree from the University of Michigan Law School in 1993. (*Id.* ¶ 5.) Mr. Schuler clerked for the Honorable James B. Loken of the U.S. Court of Appeals for the Eighth Circuit from 1993 to 1994 and joined Latham & Watkins LLP as an associate thereafter. He was named a partner of the

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