

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 IPR2015-00891

U.S. Patent No. 8,573,210 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 DAVID K. CALLAHAN
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 David K. Callahan, 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 David K. Callahan ("Callahan Decl."), attached as Exhibit 2008, each of these requirements is satisfied here.

III. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE DAVID K. CALLAHAN *PRO HAC VICE* IN THIS PROCEEDING

Mr. Callahan is a member in good standing of the Illinois State Bar (Bar No. 6206671) and the District of Columbia Bar (Bar No. 494657). He is also admitted to practice before the U.S. District Courts for the District of Colorado, Eastern District of Michigan, Eastern District of Texas, Northern District of California, Northern District of Illinois (General and Trial Bars), Southern District of Indiana,

and Western District of Wisconsin, the U.S. Courts of Appeals for the Fourth, Fifth, Seventh, Ninth, and Federal Circuits, and the U.S. Supreme Court. (Callahan Decl. at ¶ 2.) Mr. Callahan has never been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 3.) No application of Mr. Callahan 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. Callahan. (*Id.*) Mr. Callahan 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. Callahan 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. Callahan is both an experienced and technically-trained litigation attorney with an established familiarity with the subject matter at issue in this proceeding.

Mr. Callahan received an A.B. in Political Science with honors from the University of Chicago in 1987 and a law degree from the University of Michigan Law School in 1991. (*Id.* ¶ 5.) After graduating law school, Mr. Callahan joined

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