

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sawai USA Inc., and Sawai Pharmaceutical Co., Ltd,
Petitioners,

v.

Nissan Chemical Industries, Ltd.,
Patent Owner

U.S. Patent No. 5,856,336

Issue Date: January 5, 1999

Title: Quinoline Type Mevalonolactones

Inter Partes Review No. IPR2015-01647

MOTION OF NISSAN CHEMICAL INDUSTRIES, LTD.,
FOR PRO HAC VICE ADMISSION OF THOMAS H. WINTNER

I. Statement of Precise Relief Requested

Patent Owner Nissan Chemical Industries, Ltd. (“NCI”) respectfully requests that the Board admit Thomas H. Wintner *pro hac vice* in this proceeding under 37 C.F.R. § 42.10(c).

II. Statement of Facts Showing Good Cause for the Board to Recognize Counsel *Pro Hac Vice* during the Proceeding

Pursuant to 37 C.F.R. § 42.10(c), the Board may admit counsel *pro hac vice* for good cause, subject to any other conditions that the Board may require, so long as lead counsel is a registered practitioner. Good cause includes when “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).

This application satisfies the requirements of Section 42.10(c):

1. Lead counsel, David G. Conlin, the undersigned, is a registered Practitioner. Back up counsel, Kathleen B. Carr, is a registered practitioner.
2. *Pro Hac Vice* Applicant, Mr. Thomas H. Wintner, is an experienced litigator and has an established familiarity with the subject matter at issue in this proceeding, as shown in his accompanying Declaration dated October 13, 2015 (“Wintner Decl.”), Exhibit 2001. That declaration shows that Mr. Wintner possesses a legal and technical background directly related to the subject matter of this proceeding, including undergraduate and graduate degrees in chemistry and

bioorganic chemistry, respectively. Wintner Decl. ¶ 4. He is also directly familiar with U.S. Patent No. 5,856,336 (“the ‘336 patent”), its prosecution history, the prior art references that are the subject of this *inter partes* review proceeding, and the FDA-approved drug product (Livalo[®]) for which the ‘336 patent is listed in the Orange Book. *Id.* ¶¶ 5-7. Mr. Wintner is trial counsel in the co-pending district court litigation involving Patent Owner NCI and the Petitioners Sawai USA Inc. and Sawai Pharmaceutical Co., Ltd (“Sawai”). That litigation involves the ‘336 patent, and Mr. Wintner has been actively involved in all aspects of the case, including investigating and analyzing infringement and validity issues raised by Sawai in connection with that litigation. Mr. Wintner has experience and expertise relevant to this proceeding. *Id.* ¶ 8. Mr. Wintner was substantially involved with the preparation of the Patent Owner’s Preliminary Response in connection with this IPR 2015-01647 proceeding.

3. Mr. Wintner is a member in good standing of the Bar of the Commonwealth of Massachusetts. *Id.* ¶ 2. He is admitted to practice before the Supreme Court of the United States, the United States Courts of Appeals for the Federal, First, Fourth, Sixth, and Ninth Circuits, and the United States District Court for the District of Massachusetts. *Id.*

4. In his declaration, Mr. Wintner also attests to each of the items referenced in the “Order – Authorizing Motion for *Pro Hac Vice* Admission – 37 C.F.R. § 42.10” in IPR2013-00639 (Paper No. 7).

For the foregoing reasons, Patent Owner Nissan Chemical Industries, Ltd. respectfully requests that the Board admit Thomas H. Wintner *pro hac vice* in this proceeding.

Respectfully submitted,

NISSAN CHEMICAL INDUSTRIES,
LTD.,

By its attorneys,

/David G. Conlin/

David G. Conlin, Reg. No. 27,026

Kathleen B. Carr, Reg. No. 41,658

Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo, P.C.

One Financial Center

Boston, MA 02111

617-542-6000

617-542-2241 fax

DGConlin@mintz.com

KBCarr@mintz.com

Dated: October 13, 2015

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Motion of Nissan Chemical Industries, Ltd., for *Pro Hac* Vice Admission of Thomas H. Wintner was served on October 13, 2015 by sending a copy by overnight courier and by email to:

Kenneth J. Burchfiel
Travis B. Ribar
Chidambaram S. Iyer
Michael R. Dzwonczyk
Azy S. Kokabi
SUGHRUE MION, PLLC
2100 Pennsylvania Ave., NW
Washington, DC 20037
kburchfiel@sughrue.com
tribar@sughrue.com
ciyer@sughrue.com
mdzwonczyk@sughrue.com
akokabi@sughrue.com

/David G. Conlin/
David G. Conlin
Reg. No. 27,026