

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

J KYLE BASS and ERICH SPANGENBERG ,

Petitioner

v.

FRESENIUS KABI USA, LLC.

Patent Owner

Case No. IPR2016-00254

Patent No. 8,476,010 B2

**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
SAMUEL E. SHERRY UNDER 37 C.F.R. § 42.10(c)**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the Board’s “Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response,” dated December 10, 2015 (Paper No. 3), authorizing the parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c), Patent Owner Fresenius Kabi USA, LLC. respectfully requests that the Board allow Samuel E. Sherry to appear *pro hac vice* on its behalf in this proceeding. Petitioner consents to this motion.

II. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

As set forth in the Statement of Material Facts below, and as required by 37 C.F.R. § 42.10(c), Patent Owner has demonstrated good cause to admit Mr. Sherry *pro hac vice* in this proceeding. In particular, Patent Owner’s lead counsel is a registered practitioner, and Mr. Sherry is an experienced litigating attorney having an established familiarity with the subject matter at issue in this proceeding.

Furthermore, this motion is being filed more than twenty one days after service of the petition; includes a statement of facts showing good cause for the Board to recognize Mr. Sherry *pro hac vice*; and is being filed concurrently with Exhibit 2032, the Declaration of Samuel E. Sherry in Support of Patent Owner’s Motion for *Pro Hac Vice* Admission of Samuel E. Sherry (“Sherry Decl.”), all in accordance with the “Order Authorizing Motion for *Pro Hac Vice* Admission” in

Unified Patents, Inc. v. Parallel Iron, LLC, IPR2013-00639, Paper 7 at 3 (P.T.A.B. Oct. 15, 2013).

III. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he 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.”
2. Eleanor M. Yost, lead counsel for Patent Owner Fresenius Kabi USA, LLC in this proceeding, is a registered practitioner holding Registration No. 58,013.
3. As set forth in the Sherry Decl., Mr. Sherry is an experienced litigating attorney. Specifically, Mr. Sherry has nearly 10 years of experience representing clients in patent litigations in United States district courts and the Court of Appeals for the Federal Circuit. (Sherry Decl., ¶¶ 2-3). Mr. Sherry also has years of experience litigating cases on behalf of the Patent Owner, both generally and in litigations related to Diprivan. (Sherry Decl., ¶¶ 5-7).

4. Mr. Sherry also has an established familiarity with the precise subject matter at issue in this proceeding. Patent Owner was recently involved in district court litigation involving U.S. Patent No. 8,476,010 B2 (“the ’010 patent”), the patent at issue in this proceeding, in *Fresenius Kabi USA, LLC. v. Watson Laboratories Inc. et al.*, Civil Action No. 1:14-cv-00161RGA (D.Del.), *Fresenius Kabi USA, LLC. v. Dr. Reddy’s Laboratories Ltd. et al.*, Civil Action No. 1:14-cv-00160-RGA (D.Del.), and *Fresenius Kabi USA, LLC v. B. Braun Medical Inc.* Civil Action No. 1:16-cv-00250 (D.Del.). Mr. Sherry was also involved in district court litigation involving other patents concerning Diprivan in *Fresenius Kabi USA LLC v. Dr. Reddy's Laboratories Ltd. et al.*, Civil Action No. 1:13-cv-00925-RGA (D.Del.). Mr. Sherry was litigation counsel for *Fresenius Kabi USA LLC* in these litigations. In the course of this representation, he has developed a strong familiarity with the ’010 patent, its prosecution history, the general subject matter to which the ’010 patent is directed, and the prior art references relied upon by Petitioner in support of its invalidity grounds in this proceeding. (Sherry Decl., ¶ 8). Additionally, Mr. Sherry has thoroughly reviewed the Petition and accompanying Exhibits submitted in this proceeding. (*Id.*).

5. Mr. Sherry has attested to the each of the requirements set forth in paragraph 2(b)(i)-(viii) of the “Order Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7 at 3. (Sherry Decl., ¶¶ 3, 4, 6-8, 9-13).

IV. CONCLUSION

In view of the foregoing, Patent Owner respectfully submits that the requirements of 37 C.F.R. § 42.10(c) have been satisfied, and requests an Order permitting Samuel E. Sherry to appear *pro hac vice* on its behalf in this proceeding.

Dated: August 4, 2016

Respectfully submitted,

/ Eleanor M. Yost /

(Reg. No. 58,013)

901 New York Avenue NW

Washington, DC 20001

Tel: 202-346-4000

Fax: 202-346-4444

eyost@goodwinprocter.com

*Counsel for Patent Owner Fresenius Kabi
USA, LLC.*

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.