

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
JOHN T. BENNETT 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 John T. Bennett 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. Bennett *pro hac vice* in this proceeding. In particular, Patent Owner’s lead counsel is a registered practitioner, and Mr. Bennett 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. Bennett *pro hac vice*; and is being filed concurrently with Exhibit 2034, the Declaration of John T. Bennett in Support of Patent Owner’s Motion for *Pro Hac Vice* Admission of John T. Bennett (“Bennett 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 Bennett Decl., Mr. Bennett is an experienced litigating attorney. Specifically, Mr. Bennett has more than 15 years of experience representing clients in patent litigations, primarily in the chemical arts, in United States district courts and the Court of Appeals for the Federal Circuit. (Bennett Decl., ¶¶ 2-3). Mr. Bennett also has years of experience litigating cases on behalf of the Patent Owner, both generally and in litigations related to Diprivan. (Bennett Decl., ¶¶ 5-7).

4. Mr. Bennett 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.), *Fresenius Kabi USA, LLC. v. Emcure Pharmaceuticals Inc. et al.*, Civil Action No. 14-cv-5584 (DNJ), *Fresenius Kabi USA, LLC. v. Mylan Laboratories. et al.*, Civil Action No. 1:14-cv-1438-RGA (D.Del.), *Fresenius Kabi USA, LLC. v. Claris Life Sciences Ltd. et al.*, Civil Action No. 1:14-cv-07953 (DNJ) and *Fresenius Kabi USA, LLC v. B. Braun Medical Inc.* Civil Action No. 1:16-cv-00250 (D.Del.). Mr. Bennett 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. Bennett 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. (Bennett Decl., ¶ 8). Additionally, Mr.

Bennett has thoroughly reviewed the Petition and accompanying Exhibits submitted in this proceeding. (*Id.*).

5. Mr. Bennett 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. (Bennett 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 John T. Bennett to appear *pro hac vice* on its behalf in this proceeding.

Dated: August 4, 2016

Respectfully submitted,

/ Eleanor M. Yost /

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