

Case No. IPR2016-00383
U. S. Patent No. 6,331,415
Filed on behalf of: Genzyme Corporation

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENZYME CORPORATION,
Petitioner

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owners

Case No. IPR2016-00383
U. S. Patent No. 6,331,415

**MOTION FOR LISA M. FERRI TO APPEAR *PRO HAC VICE* ON BEHALF
OF PETITIONER GENZYME CORPORATION**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the Board’s January 7, 2016 Notice authorizing motions for *pro hac vice* admission (Paper No. 3), and 37 C.F.R. §§ 42.10(c) and 42.22, Petitioner Genzyme Corporation (“Genzyme”) hereby moves for an Order authorizing Lisa M. Ferri of Mayer Brown LLP to appear *pro hac vice* on behalf of Genzyme Corporation in the above-captioned case.

II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION

For this motion, Petitioner relies on Genzyme Exhibit 1059 – Declaration of Lisa M. Ferri in Support of Motion to Appear *Pro Hac Vice* on Behalf of Petitioner Genzyme Corporation, and Genzyme Exhibit 1060 – Mayer Brown Professional Profile of Lisa M. Ferri.

III. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

As set forth below in the Statement of Material Facts, Genzyme has made the showings required under 37 C.F.R. § 42.10(c) for recognizing Ms. Ferri *pro hac vice* in this case. Ms. Ferri is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the above-captioned proceeding.

Ms. Ferri has been involved in numerous patent litigations in various U.S. District Courts and has been admitted *pro hac vice* in three previous *inter partes*

review proceedings before the United States Patent and Trademark Office.

(Genzyme Exhibit 1059, Declaration of Lisa M. Ferri). In particular, Ms. Ferri has appeared as lead counsel in several previous litigations involving the challenged '415 patent in the U.S. District Court for the Central District of California. Thus, Ms. Ferri has an established familiarity and expertise with the subject matter at issue in this proceeding, including the patent, file history, technology and prior art. In light of the facts presented in detail below and in Ms. Ferri's accompanying Declaration and Professional Profile, good cause exists for the *pro hac vice* admission of Ms. Ferri in this proceeding under 37 C.F.R. § 42.10(c).

IV. STATEMENT OF MATERIAL FACTS

37 C.F.R. § 42.10(c) states

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.

Lead counsel in the instant *inter partes* review proceeding is Richard J.

McCormick. Mr. McCormick is registered to practice before the United States

Patent and Trademark Office and holds Registration No. 55,902. The following

statement of facts demonstrates that Ms. Ferri is an experienced litigating attorney

and has an established familiarity with the subject matter at issue in this proceeding. Accordingly, there is good cause for the Board to recognize Ms. Ferri *pro hac vice*.

As set forth in Genzyme Exhibit 1059, Ms. Ferri is a partner in the Intellectual Property group of Mayer Brown LLP and is the head of the New York IP group. Genzyme Exhibit 1059, ¶ 1. Ms. Ferri is an experienced litigation attorney and has an established familiarity with the subject matter at issue in this proceeding. In particular, Ms. Ferri has over 20 years of experience as a patent litigator, including numerous cases in the pharmaceutical and biotechnology fields. 1059, ¶ 1. She has appeared as lead trial counsel before the United States District Courts and the U.S. International Trade Commission. *Id.* Furthermore, she has represented clients before the United States Court of Appeals for the Federal Circuit, including as lead counsel. *Id.*; Genzyme Exhibit 1060. Ms. Ferri is an adjunct professor of law at Fordham University School of Law, where she teaches patent litigation. Genzyme Exhibit 1059, ¶2.

Ms. Ferri has expertise with the technology and file history of the patent challenged in the instant proceeding, having served as counsel for GlaxoSmithKline, Human Genome Sciences, and Bristol-Myers Squibb in previous litigations concerning the '415 patent: *Glaxo Group Ltd., et al., v. Genentech, Inc., et al.*, Case No. 10-cv-02764 (C.D. Cal.), *Human Genome*

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Sciences Inc. v. Genentech, Inc., et al., Case No. 11-cv-06594 (C.D. Cal.), and *Bristol-Myers Squibb Co. v. Genentech, Inc., et al.*, Case No. 13-cv-05400 (C.D. Cal.), respectively. *Id.*, ¶ 3.

Ms. Ferri also presently serves as lead counsel in patent litigations involving U.S. Patent No. 7,923,221, which is a continuation of the presently-challenged '415 patent and involves the same recombinant antibody technology claimed in the '415 patent. These cases are *Genzyme Corp. v. Genentech, Inc. and City of Hope*, Case No. 15-cv-09991 (C.D. Cal.), and *Sanofi Aventis U.S. LLC and Regeneron Pharmaceuticals, Inc. v. Genentech, Inc. and City of Hope*, Case No. 15-cv-05685 (C.D. Cal.). *Id.*

Ms. Ferri therefore is familiar with the '415 patent at issue in this proceeding as well as the legal, technical, and prior art subject matter discussed in Genzyme's Petition for *inter partes* review of the '415 patent, which forms the basis of this proceeding. *Id.*, ¶ 4.

Ms. Ferri has read 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 37 C.F.R. *Id.*, ¶ 9. Ms Ferri also agrees to be subject to the United States Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.*, ¶ 10.

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