

Case No. IPR2016-00460
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. IPR2016-00460
U. S. Patent No. 6,331,415

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

**Genzyme Exhibit 1059
Genzyme v. Genentech, et al
IPR2016-00460**

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I, Lisa M. Ferri, do hereby declare:

1. I am a partner in the law firm of Mayer Brown LLP and the head of the Intellectual Property group for the New York Office. I have over 20 years of experience as a patent litigator and trial lawyer, appearing and acting as lead counsel in numerous patent litigation matters before various United States District Courts and the U.S. International Trade Commission. I have also appeared on behalf of litigants before the U.S. Court of Appeals for the Federal Circuit, including as lead counsel. *See* Genzyme Exhibit 1060. The majority of these cases have been in the technical field of the pharmaceutical and chemical arts.

2. I am also an adjunct professor of law at Fordham University School of Law, where I teach Patent Litigation. Subsequent to graduating from law school I served as law clerk to Chief Judge Edward D. Re, U.S. Court of International Trade, who sat by designation on a number of courts of appeal, including the Federal Circuit.

3. I am familiar with the subject matter at issue in this proceeding, and U.S. Patent No. 6,331,415 (“the ’415 patent”). Specifically, I served as lead counsel for GlaxoSmithKline, Human Genome Sciences and Bristol-Myers Squibb in litigations involving the ’415 patent in *Glaxo Group Ltd, et al., v. Genentech, Inc., et al.*, Case No. 10-cv-02764 (C.D. Cal.); *Human Genome Sciences Inc. v.*

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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. I also currently serve as lead counsel in litigations that involve a continuation of the challenged '415 patent—U.S. Patent No. 7,923,221, which also involve the same recombinant antibody technology claimed in the challenged '415 patent. Specifically, I am lead counsel for Sanofi Aventis U.S. LLC (“Sanofi”) and Regeneron Pharmaceuticals, Inc. (“Regeneron”) in a matter entitled *Sanofi Aventis U.S. LLC and Regeneron Pharmaceuticals, Inc. v. Genentech, Inc. and City of Hope*, Case No. 15-cv-05685 (C.D. Cal.), filed on July 27, 2015; and I am lead counsel for Petitioner, Genzyme Corporation (“Genzyme”), in a matter entitled *Genzyme Corp. v. Genentech, Inc. and City of Hope*, Case No. 15-cv-09991 (C.D. Cal.), filed on December 30, 2015.

4. Given my involvement in *Glaxo Group Ltd, et al., v. Genentech, Inc., et al.*, *Human Genome Sciences Inc. v. Genentech, Inc. et al.*, and *Bristol Myers Squibb Co. v. Genentech, Inc., et al.*, I am familiar not only with the '415 patent and file history, but also with the legal, technical, and prior art subject matter discussed in Genzyme’s request for *inter partes* review of the '415 patent, which forms the basis for this proceeding.

5. I am a member in good standing of the Bar of the State of New York and the Bar of the State of New Jersey. I am admitted to practice before the United States Supreme Court, the United States Court of Appeals for the Federal Circuit, and several other appellate and district courts including the United States District Court for the District of New Jersey, the United States District Court for the Southern District of New York, and the United States Court of International Trade.

6. I have never been suspended, disbarred or sanctioned by any court or administrative body.

7. I have never had a court or administrative body deny my application for admission to practice.

8. I have never been sanctioned or cited for contempt by any court or administrative body.

9. I have 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.

10. I agree 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).

11. In the past three (3) years, I have applied for and been admitted *pro hac vice* in three *inter partes* review proceedings before the United States Patent

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and Trademark Office: *Sanofi-Aventis U.S. LLC, et al., v. Genentech, Inc., et al.*,

Case No. IPR2015-01624 (U.S. Patent No. 6,331,415); *Ranbaxy Laboratories Ltd.*

et al., v. Vertex Pharmaceuticals Incorporated, Case No. IPR2013-00024 (U.S.

Patent No. 6,436,989); and *Lupin Ltd. v. Vertex Pharmaceuticals Incorporated*,

Case No. IPR2015-00405 (U.S. Patent No. 6,436,989). Also, today, February 16,

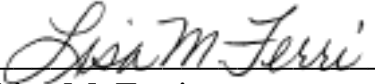
2018, I filed an application for admission *pro hac vice* in *Genzyme Corp. v.*

Genentech, Inc., and City of Hope, Case No. IPR2016-00383, which is currently pending.

* * *

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of U.S. Patent No. 6,331,415.

Dated: February 18, 2016

By: 
Lisa M. Ferri