

Case IPR2016-00822  
U.S. Patent No. 7,064,197

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

HOLOGIC, INC.,  
Petitioner

v.

ENZO LIFE SCIENCES, INC.,  
Patent Owner

---

Case IPR2016-00822

U.S. Patent No. 7,064,197  
TITLE: SYSTEM, ARRAY AND NON-POROUS SOLID SUPPORT  
COMPRISING FIXED OR IMMOBILIZED NUCLEIC ACIDS  
Issue Date: June 20, 2006

---

**ENZO'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF  
JUSTIN P.D. WILCOX**

Mail Stop Patent Board  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PATENT OWNER'S EXHIBIT LIST**

<b>Enzo Exhibit No.</b>	<b>DESCRIPTION</b>
2101	Declaration of Gregory Buck, Ph.D.
2102	Declaration of Dollie M.W. Kirtikar, Ph.D., submitted in U.S. Patent App. No. 08/486,070 (Oct. 28, 2003).
2103	Robberson, D. L. and Davidson, N., <i>Biochemistry</i> 11, 533 (1972).
2104	Schott, Herbert, "Special Methods for the Immobilization of RNA and Polyribonucleotides," in <i>Affinity Chromatography</i> , Chromatographic Science Series, Vol. 27 (allegedly 1984).
2105	Petitioner's Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,064,197 in Case IPR2016-00822.
2106	Anish Desai, Christopher Marando, & Amanda Do Couto, <i>PTAB Approaches To Accessibility Of Printed Publication</i> , LAW360 (Oct. 3, 2016), <a href="http://www.law360.com/articles/845934/print?section=ip">http://www.law360.com/articles/845934/print?section=ip</a> .
2107	Michael R. Weiner, <i>APJs Dispute Requirements for a Reference to Qualify as a Printed Publication</i> , PTABWATCH (Oct. 15, 2015), <a href="http://www.ptabwatch.com/2015/10/apjs-dispute-requirements-for-a-reference-to-qualify-as-a-printed-publication">http://www.ptabwatch.com/2015/10/apjs-dispute-requirements-for-a-reference-to-qualify-as-a-printed-publication</a> .
2108	Affidavit of Michael P. Stadnick.
2109	Affidavit of Justin P.D. Wilcox.

## I. RELIEF REQUESTED

Patent Owner Enzo Life Sciences, Inc. (“Enzo”) hereby respectfully moves the Patent Trial and Appeal Board for the *pro hac vice* admission of Justin P.D. Wilcox as back-up counsel for Enzo in Case IPR2016-00822. Enzo has conferred with counsel for Petitioner, who confirmed that Petitioner does not oppose this motion.

## II. GOVERNING LAW, RULES, AND PRECEDENT

Under 37 C.F.R. § 42.10(c),

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.

The Patent Trial and Appeal Board established its current procedure for moving for *pro hac vice* admission in *inter partes* reviews in *Unified Patents, Inc. v. Parallel Iron LLC*, Case IPR2013-00639, Paper 7 (“Order – Authorizing Motion For *Pro Hac Vice* Admission – 37 C.F.R. § 42.10”) (PTAB Oct. 15, 2013). Specifically, a motion for *pro hac vice* admission must 1) be filed no sooner than

twenty-one (21) days after the service of the petition; 2) “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding;” and 3) “[b]e accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:”

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear 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.;
- vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. § 11.101 *et seq.* and subject to the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and

- viii. Familiarity with the subject matter at issue in the proceeding.

### III. STATEMENT OF MATERIAL FACTS

Supported by the Affidavit of Justin P.D. Wilcox filed concurrently herewith (Ex. 2109), Enzo respectfully shows the following facts:

1. Enzo filed this motion on November 15, 2016, no sooner than 21 days after service of Hologic, Inc.'s petition on March 30, 2016.
2. Enzo's lead counsel, Kevin K. McNish, is a registered practitioner (Reg. No. 65,047).
3. Mr. Wilcox is a partner at the law firm of Desmarais LLP, an intellectual property litigation firm. (Ex. 2109 ¶ 3.)
4. Mr. Wilcox is an experienced patent litigation attorney. He has practiced patent litigation for approximately twelve (12) years. (*Id.* ¶ 4.)
5. Mr. Wilcox has an established familiarity with the subject matter at issue in this proceeding. The patent involved in this proceeding is U.S. Patent No. 7,064,197, and Mr. Wilcox has reviewed U.S. Patent No. 7,064,197 and its prosecution file history. (*Id.* ¶ 5.)
6. Mr. Wilcox has also reviewed the Petition, Institution Decision, and the exhibits in this proceeding. (*Id.*) Mr. Wilcox also worked on the

# 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.