

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owners.

Case IPR2016-01373
U.S. Patent 6,331,415

**PATENT OWNERS' UNOPPOSED MOTION FOR ADMISSION *PRO HAC*
VICE OF DARALYN J. DURIE UNDER 37 C.F.R. § 42.10(c)**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c), Patent Owners Genentech, Inc.

("Genentech") and City of Hope, by and through its attorneys, respectfully request that the Board admit Daralyn J. Durie *pro hac vice* in this proceeding, IPR2016-01373. Petitioner Merck Sharp & Dohme Corp. has indicated that it does not oppose this motion.

II. GOVERNING LAW, RULES, AND PRECEDENT

Section 42.10(c) of 37 C.F.R. provides as follows:

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 Board has specified that a motion for *pro hac vice* admission shall be filed in accordance with the "ORDER-AUTHORIZING MOTION FOR PRO HAC VICE ADMISSION – 37 C.F.R. § 42.10" in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case No. IPR2013-00639 ("Representative Order"). The Representative Order states that the motion must "[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the

proceeding,” and “[b]e accompanied by an affidavit or declaration of the individual seeking to appear” which attests to a number of facts concerning the counsel seeking admission *pro hac vice* specified in the Representative Order.

Accompanying this motion as Exhibit 2002 is the Declaration of Daralyn J. Durie in Support of this Motion for Admission *Pro Hac Vice* (“Durie Decl.”).

III. STATEMENT OF FACTS

1. Patent Owners' lead counsel, David L. Cavanaugh, is a registered practitioner (Reg. No. 36,476).
2. Ms. Durie is a Partner at the law firm Durie Tangri LLP. (Durie Decl. ¶ 2, Ex. 2002).
3. Ms. Durie is an experienced litigating attorney and has been litigating cases relating to patents for over 20 years. (*Id.* ¶ 2)
4. Ms. Durie is a member in good standing of the California State Bar, and among other courts, the United States Court of Appeals for the Federal Circuit (*Id.* ¶ 3).
5. Ms. Durie has never been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 5).
6. No application filed under Ms. Durie for admission to practice before any court or administrative body has ever been denied. (*Id.* ¶ 6).
7. No sanctions or contempt citations have been imposed against Ms.

Durie by any court or administrative body. (*Id.* ¶ 7).

8. Ms. Durie has read and agrees to 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.* ¶ 8).

9. Ms. Durie understands that she will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.* ¶ 9).

10. In the last three (3) years, Ms. Durie has appeared *Pro Hac Vice* before the Patent Trial and Appeal Board in the following cases: *Sanofi-Aventis U.S. LLC and Regeneron Pharmaceuticals, Inc. v. Genentech, Inc. and City of Hope*, IPR2015-01624; *Genzyme Corporation v. Genentech, Inc. and City of Hope*, IPR2016-00460 (*pro hac vice* motion filed) (joined with IPR2015-01624); *Genzyme Corporation v. Genentech, Inc. and City of Hope*, IPR2016-00383 (*pro hac vice* motion filed) (not instituted). (*Id.* ¶ 10).

11. Ms. Durie has an established familiarity with the subject matter at issue in this proceeding. She has handled patent cases relating to recombinant antibodies for more than twelve years, including six litigations in which U.S. Patent No. 6,331,415 (“the ’415 patent”) was a patent-in-suit. (*Id.* ¶ 11). In all of these cases involving the ’415 patent, she has represented Genentech and in several of these cases, she also represented City of Hope. During these litigations, she has

worked closely with Adam R. Brausa, counsel for Genentech and City of Hope in this matter. (*Id.*).

12. Additionally, Ms. Durie has carefully reviewed and has developed extensive familiarity with the matters involved in and implicated by these proceedings, including the '415 patent and its file history, the prior art presented in the petition, and the legal and factual issues raised by the Petitioner in this proceeding. As a result, Ms. Durie has acquired substantial understanding of the underlying legal and technological issues at stake in this proceeding. (*Id.* ¶ 12).

IV. GOOD CAUSE EXISTS FOR *PRO HAC VICE* ADMISSION OF DARALYN J. DURIE

The facts outlined above in the Statement of Facts, supported by the Declaration of Daralyn J. Durie (Ex. 2002), establish there is good cause to admit Ms. Durie *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Patent Owners' lead counsel, David L. Cavanaugh, is a registered practitioner in good standing before the Board. Ms. Durie is an attorney in good standing in the State Bar of California and the United States Court of Appeals for the Federal Circuit. Ms. Durie has extensive experience litigating patents, including the '415 patent, which is the subject of this proceeding. As a result, Ms. Durie is familiar with the subject matter at issue in this proceeding. Furthermore, Ms. Durie has carefully reviewed the '415 patent at issue in this proceeding, its prosecution history, the

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