

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALERE INC.

Petitioner

v.

REMBRANDT DIAGNOSTICS, LP

Patent Owner

Case No. IPR2016-01498

Patent No. 8,623,291

**AFFIDAVIT OF J. ANTHONY DOWNS IN SUPPORT OF PATENT
OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF J. ANTHONY
DOWNS UNDER 37 C.F.R. § 42.10(c)**

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

ALERE EX. 1015

1. I, J. Anthony Downs, am more than twenty-one years of age, am competent to present this affidavit, and have personal knowledge of the facts set forth herein.

2. This affidavit is given in support of Petitioner's Motion for *Pro Hac Vice* Admission of J. Anthony Downs.

3. I am a partner with the law firm Goodwin Procter LLP.

4. I have an established familiarity with the subject matter at issue in this proceeding. I have represented and continue to represent petitioner Alere Inc. and its subsidiaries Alere Toxicology Services, Inc., America Biotech, Inc., Ameditech, Inc., Innovacon, Inc., Instant Technologies, Inc., Instant Tech Subsidiary Acquisition Inc. d/b/a US Diagnostics, and Branan Medical Corp. as their lead counsel in co-pending litigation in the Southern District of California, captioned *Rembrandt Diagnostics, LP v. Alere Inc., et al.*, No. 3:16-cv-698-CAB-NLS ("the district court litigation") since shortly after it was filed on March 23, 2016. Among other things, the district court litigation asserts infringement of the same patent at issue here, U.S. Patent No. 8,623,291.

5. I have reviewed and analyzed the patent at issue in this proceeding, the Petition and accompanying exhibits filed in this proceeding, and all other papers associated with this proceeding. Moreover, in the district court litigation, I

developed invalidity, non-infringement, and claim construction positions concerning the patent at issue here.

6. I am an experienced litigation attorney. I have been practicing law since 1986, and have been litigating patent cases for more than 15 years. I have extensive experience litigating patent infringement cases in many different courts across the United States.

7. My experience in patent litigation matters includes serving as lead counsel in patent jury trials, including making opening and closing statements, presentation of non-expert and expert-testimony, arguing *Markman* hearings, patent summary judgment proceedings, and other patent-related hearings and preparation of pleadings concerning, *inter alia*, patent validity and infringement issues. I have also represented clients in appeals before the Court of Appeals for the Federal Circuit and the U.S. Supreme Court.

8. I have represented petitioner Alere Inc. and/or its affiliates in many patent litigation matters since 2002, including:

Name	Number	District	Filed
<i>Alere Inc., et. al. v. Church & Dwight Co., Inc.</i>	1-10-cv-10027	MA	January 8, 2010
<i>Inverness Medical Innovations, Inc. et al. v. Orasure Technologies, Inc.</i>	3-08-cv-01856	NJ	April 15, 2008
<i>Abbott Laboratories et al v. Church & Dwight, Inc.</i>	1-07-cv-03428	IL ND	June 18, 2007

Name	Number	District	Filed
<i>Inverness Medical, et al v. Quidel Corporation</i>	3-04-cv-00489	CA SD	March 9, 2004
<i>Quidel Corporation v. Inverness Medical, et al.</i>	3-04-cv-00378	CA SD	February 20, 2004
<i>Inverness Medical Switzerland GmbH et al v. Acon Laboratories, Inc.</i>	1-03-cv-11323	MA	July 15, 2003
<i>Inverness Medical, et al v. Acon Laboratories, Inc.</i>	1-02-cv-12303	MA	November 26, 2002
<i>Inverness Medical SW, et al. v. Pfizer Inc., et al.</i>	2-02-cv-01029	NJ	March 7, 2002
<i>Inverness Medical, et al v. Pfizer, Inc., et al.</i>	2-01-cv-05516	NJ	November 29, 2001

8. I am a member in good standing of the Bar of the State of Massachusetts and am admitted to practice before the U.S. Supreme Court, the U.S. Court of Appeals for the First, Second, and Federal Circuits, the District Court for the District of Massachusetts, the District Court for the Eastern District of Texas, the District Court for the Northern District of Illinois, the Massachusetts Supreme Judicial Court, and the International Trade Commission.

9. I have never been suspended or disbarred from practice before any court or administrative body.

10. No application of mine for admission to practice before any court or administrative body has ever been denied.

11. No sanctions or contempt citations have ever been imposed against me by any court or administrative body.

12. 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.

13. I understand that I will be subject to the U.S.P.T.O. Code of Professional Conduct set forth in 37 C.P.R. §§ 10.101 *et seq.* and disciplinary jurisdiction under 37 C.P.R. §§ 11.19(a).

14. I am also applying for *pro hac vice* admission in Case IPR2016-01502, in a concurrently filed motion, which involves a patent related to the patent at issue in the instant proceeding. I have not applied for *pro hac vice* admission in any other proceedings before the Office in the last three years.

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