

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

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

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Alere Inc. (“Petitioner”) respectfully requests the *pro hac vice* admission of J. Anthony Downs in this proceeding, IPR2016-01498, concerning U.S. Patent No. 8,623,291 (“the ‘291 patent”), pursuant to 37 C.F.R. § 42.10(c).

I. THE REQUEST IS TIMELY

As stated in the Patent Trial and Appeal Board’s (“Board”) August 15, 2016 Notice of Filing Date Accorded to Petition And Time For Filing Patent Owner Preliminary Response, any motion for *pro hac vice* admission must be filed in accordance with the guidance specified in Case IPR2013-00639 (Paper 7) (“PHV Admission Order”). According to that guidance, *pro hac vice* motions can be filed no sooner than (21) days after service of the Petition. This *pro hac vice* motion is filed more than 21 days after the service of the Petition and is therefore timely.

II. STATEMENT OF FACTS

As required by the PHV Admission Order, the following statement of facts show that there is good cause for the Board to recognize Mr. Downs *pro hac vice*. An affidavit by Mr. Downs containing the required statements and information is submitted herewith. (Ex. 1015).

1. Douglas J. Kline, lead counsel for Petitioner Alere Inc. in this proceedings, is a registered practitioner holding Registration No. 35,574.
2. Mr. Downs is a partner with Goodwin Procter LLP.

3. Mr. Downs has an established familiarity with the subject matter at issue in this proceeding. Mr. Downs has represented and continues 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.

4. Mr. Downs represents that he has 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, he represents that in the district court litigation, he developed invalidity, non-infringement, and claim construction positions concerning the patent at issue here. He therefore has extensive knowledge of this patent and of the cited prior art.

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

6. Mr. Downs' 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. Mr. Downs has also represented clients in appeals before the Court of Appeals for the Federal Circuit and the U.S. Supreme Court.

7. Mr. Downs has 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	MAD	January 8, 2010
<i>Inverness Medical Innovations, Inc. et al. v. Orasure Technologies, Inc.</i>	3-08-cv-01856	NJD	April 15, 2008
<i>Abbott Laboratories et al v. Church & Dwight, Inc.</i>	1-07-cv-03428	ILND	June 18, 2007
<i>Inverness Medical, et al v. Quidel Corporation</i>	3-04-cv-00489	CASD	March 9, 2004
<i>Quidel Corporation v. Inverness Medical, et al.</i>	3-04-cv-00378	CASD	February 20, 2004
<i>Inverness Medical Switzerland GmbH et al v. Acon Laboratories, Inc.</i>	1-03-cv-11323	MAD	July 15, 2003
<i>Inverness Medical, et al v. Acon Laboratories, Inc.</i>	1-02-cv-12303	MAD	November 26, 2002
<i>Inverness Medical SW, et al. v. Pfizer Inc., et al.</i>	2-02-cv-01029	NJD	March 7, 2002

Name	Number	District	Filed
<i>Inverness Medical, et al v. Pfizer, Inc., et al.</i>	2-01-cv-05516	NJD	November 29, 2001

8. Mr. Downs is a member in good standing of the Bar of the State of Massachusetts and 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. Mr. Downs has never been suspended or disbarred from practice before any court or administrative body.

10. No application of Mr. Downs 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 Mr. Downs by any court or administrative body.

12. Mr. Downs represents that he has read 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.

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