

Filed on behalf of: Sumitomo Dainippon Pharma Co., Ltd.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner

v.

SUMITOMO DAINIPPON PHARMA CO., LTD.,
Patent Owner

Case IPR2017-01292
U.S. Patent No. 9,555,027

**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
JOSEPH M. O'MALLEY, JR.**

I. INTRODUCTION AND PRECISE RELIEF REQUESTED

Sumitomo Dainippon Pharma Co., Ltd. (“Patent Owner”) requests that the Board recognize Joseph M. O’Malley as counsel *pro hac vice* during this proceeding. This motion was authorized in the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response. Paper No. 3 at 2. Because this motion meets all of the Board’s requirements, Patent Owner requests that the Board grant this motion.

II. STATEMENT OF FACTS

Patent Owner has been authorized to file motions seeking admission *pro hac vice* under 37 C.F.R. §42.10(c). *See* Paper 3 at 2. Patent Owner’s lead counsel and two back-up counsel are registered practitioners. Paper 4 at 2. As set forth in the accompanying declaration, Mr. O’Malley is an attorney at Paul Hastings LLP. Ex. 2001 at ¶ 2. He is an experienced litigating attorney with more than twenty-four years of experience and has served as lead counsel in numerous patent infringement lawsuits before the district courts and the Court of Appeals for the Federal Circuit. *Id.*

Mr. O’Malley has an established familiarity with the subject matter at issue in this proceeding. *Id.* at ¶ 9. Mr. O’Malley has reviewed U.S. Patent No. 9,555,027 (“the ’027 patent”), the patent-at-issue, and other papers associated with this matter. *Id.*

In addition, Mr. O'Malley is a member in good standing of the Bar for the State of New York. *Id.* at ¶ 1. He has never been suspended or disbarred from practice before any court or administrative body. *Id.* at ¶ 3. He has never had an application for admission to practice before any court or administrative body denied. *Id.* at ¶ 4. He has never had sanctions or contempt citations imposed by any court or administrative body. *Id.* at ¶ 5. He 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 title 37 of the Code of Federal Regulations. *Id.* at ¶ 6. He agrees to 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.* at ¶ 7. He has not applied to appear *pro hac vice* in any other proceeding before the Office in the last three years. *Id.* at ¶ 8.

III. REASONS FOR GRANTING THE MOTION

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.” 37 C.F.R. § 42.10(c). For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon showing that counsel who is seeking *pro hac vice* admission is “an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.* The

motion for *pro hac vice* admission must contain a statement of facts showing good cause and be accompanied by a declaration of the individual who is seeking admission. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper No. 7 at 3-4 (P.T.A.B. Oct. 15, 2013). The declaration in turn must contain certain attestations. *Id.*

This motion and the accompanying declaration meet all of the Board's requirements. The lead counsel in this proceeding, Preston K. Ratliff II, is a registered practitioner. Paper 4 at 2. Mr. O'Malley is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. *See Ex. 2001* at ¶¶ 2, 9. For example, Mr. O'Malley has handled patent litigation matters involving lurasidone, an ingredient in the oral preparations claimed in the '027 patent. *See, e.g., id.* at ¶ 9. Mr. O'Malley's declaration makes the necessary attestations. *Id.* at ¶ 10.

IV. CONCLUSION

For the foregoing reasons, Patent Owner submits that there is good cause for the Board to recognize Mr. O'Malley as counsel *pro hac vice* in this proceeding.

Respectfully submitted,

Date: May 10, 2017

/Preston K. Ratliff II/

Preston K. Ratliff II, Reg. No. 43,034

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