

MICRO LABS LIMITED AND MICRO LABS USA INC.
Petitioners,

v.

SANTEN PHARMACEUTICAL CO., LTD. AND
ASAHI GLASS CO., LTD.
Patent Owners.

Case IPR2017-01434
U.S. Patent No. 5,886,035

**PATENT OWNERS' MOTION FOR *PRO HAC VICE* ADMISSION OF
ERIC J. LOBENFELD, ESQ., UNDER 37 C.F.R. § 42.10(c)**

Eric J. Lobenfeld, Esq., as counsel *pro hac vice* on behalf of Patent Owners during this proceeding.

In an *Inter Partes* Review (“IPR”), the Board has discretion under 37 C.F.R. § 42.10(c) to recognize counsel *pro hac vice*. 37 C.F.R. § 42.10(c) provides that:

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.

In support of this motion, a declaration of Eric J. Lobenfeld is submitted herewith (Exhibit 1) showing that Mr. Lobenfeld satisfies the requirements for *pro*

of the petition.

II. Statement of Facts

Based on the following facts, and supported by the Declaration of Eric J. Lobenfeld (Exhibit 1) submitted herewith, Patent Owners have established good cause for the Board to recognize Mr. Lobenfeld *pro hac vice* in this matter:

1. Lead counsel, Ms. Arlene L. Chow, is a registered practitioner.
2. Mr. Lobenfeld is a Partner with the law firm Hogan Lovells U.S. LLP.

See Lobenfeld Declaration, ¶1.

3. Mr. Lobenfeld is a member in good standing of the State Bar of New York and numerous United States District Courts, Circuit Courts of Appeals, and the United States Supreme Court. *See* Lobenfeld Declaration, ¶2.

4. Mr. Lobenfeld has been a litigating attorney for more than forty (40) years. *See* Lobenfeld Declaration, ¶3. He has been litigating patents for the past twenty-five (25) years and has been lead counsel on dozens of patent cases. *Id.*

5. Mr. Lobenfeld has never been suspended from, disbarred from, or denied admission to practice before any court or administrative body. *See*

7. Mr. Lobenfeld 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 the 37 C.F.R. See Lobenfeld Declaration, ¶7.

8. Mr. Lobenfeld understands that he 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). See Lobenfeld Declaration, ¶8.

9. In the past three (3) years, Mr. Lobenfeld has not applied to appear *pro hac vice* before the United States Patent and Trademark Office. See Lobenfeld Declaration, ¶9. Prior to that, Mr. Lobenfeld appeared *pro hac vice* in the following proceedings: IPR2014-00651, IPR2014-00652, IPR2014-00653, IPR2014-00654, IPR2014-00655, and IPR2014-00656. *Id.*

10. Mr. Lobenfeld is Patent Owners' trial counsel in the concurrent litigations *Santen Pharmaceutical Co., Ltd., Asahi Glass Co., Ltd. and Oak Pharmaceuticals, Inc. v. Micro Labs Limited and Micro Labs USA Inc.*, Case No. 16-cv-00353, and *Santen Pharmaceutical Co., Ltd., Asahi Glass Co., Ltd. and Oak*

See Lobenfeld Declaration, ¶ 16.

III. Good Cause Exists for *Pro Hac Vice* Admission

In accordance with 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other condition the Board may impose. 37 C.F.R. § 42.10(c). Patent Owners' lead counsel, Ms. Arlene L. Chow, is a registered practitioner. Furthermore, as supported by his Declaration, for the past 25 years, Mr. Lobenfeld has been litigating patent cases and has been lead counsel on dozens of patent cases. Mr. Lobenfeld also has developed an established familiarity with the subject matter at issue in this proceeding; he is Patent Owners' trial counsel in their concurrent district court litigation against the Petitioners (*Santen Pharmaceutical Co., Ltd., Asahi Glass Co., Ltd. and Oak Pharmaceuticals, Inc. v. Micro Labs Limited and Micro Labs USA Inc.*, Case No. 16-cv-00353 (D. Del.)) and district court litigation against Sandoz Inc. (*Santen Pharmaceutical Co., Ltd., Asahi Glass Co., Ltd. and Oak Pharmaceuticals, Inc. v. Sandoz Inc.*, Case No. 16-cv-00354 (D. Del.)). This proceeding involves the same patent (*i.e.*, U.S. Patent No. 5,886,035) at issue in

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