

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MODERNA THERAPEUTICS, INC.,  
Petitioner,

v.

PROTIVA BIOTHERAPEUTICS, INC.,  
Patent Owner.

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Case No. IPR2018-00739  
Patent No. 9,364,435

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**MODERNA THERAPEUTICS, INC.'S UNOPPOSED MOTION  
FOR *PRO HAC VICE* ADMISSION OF MORGAN CHU  
UNDER 37 C.F.R. § 42.10**

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## **I. RELIEF REQUESTED**

Pursuant to 37 C.F.R. § 42.10(c) and the Board’s “Notice of Filing Date Accorded to the Petition and Time for Filing Patent Owner’s Preliminary Response” entered February 14, 2018, Paper 5, granting authorization to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c), Petitioner Moderna Therapeutics, Inc. requests that the Board admit Morgan Chu *pro hac vice* in this proceeding.

## **II. STATEMENT OF FACTS**

Pursuant to 37 C.F.R. § 42.10(c), 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.

37 C.F.R. § 42.10(c). The facts, supported by the Declaration of Morgan Chu in Support of Motion for Admission *Pro Hac Vice* (“Chu Decl.”, Ex. 1027) establish good cause to admit Morgan Chu *pro hac vice* in this proceeding.

1. Lead counsel Michael R. Fleming is a registered practitioner, experienced in *inter partes* proceedings before the USPTO.

2. Backup counsel Maclain Wells is a registered practitioner, experienced in *inter partes* proceedings before the USPTO.

3. Morgan Chu is an experienced litigating attorney. Mr. Chu has extensive experience in patent law and has been litigating patent cases for forty (40) years. Chu Decl. ¶ 10. Mr. Chu is a member in good standing of the California State Bar, with no suspensions or disbarments from practice, nor any application for admission to practice denied, nor any sanctions or contempt citations. Chu Decl. ¶¶ 1-6. Mr. Chu is also admitted to practice before the United States Supreme Court, the United States Courts of Appeals for the Federal, Second, Fifth, Ninth, and Eleventh Circuits, and the United States District Courts for the Central District of California, Northern District of California, Southern District of California, Eastern District of California, United States District Court for District of Colorado, United States District Court for the Western District of Wisconsin, and United States District Court for the Eastern District of Texas. Chu Decl. ¶ 2.

4. Mr. Chu has familiarity with the subject matter at issue in this proceeding and has engaged closely in issues related to the '435 patent. Chu Decl. ¶ 11.

5. Mr. Chu has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in Title 42 of the C.F.R., and he agrees to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Chu Decl. ¶¶ 7-8.

6. Mr. Chu has appeared *pro hac vice* before the Patent Trial and Appeal Board in connection with IPR Nos. IPR2013-00004, IPR2013-00007, IPR2014-00727, IPR2014-01510, IPR2014-01511, IPR2014-01513, IPR2015-01719, IPR2015-01764, IPR2015-01767, IPR2015-01768, IPR2017-00607, IPR2017-00608, IPR2017-00617, IPR2017-00619, IPR2017-00620, IPR2017-00621 and IPR2017-00623. Mr. Chu is concurrently applying for *pro hac vice* admission in IPR2018-00680. Chu Decl. ¶ 9.

### III. ANALYSIS

The facts contained in the Statement of Facts above, and contained in the Chu Declaration, establish that there is good cause to admit Morgan Chu *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Lead and backup counsel are registered practitioners, Mr. Chu is an experienced litigating attorney, and Mr. Chu has an established familiarity with the subject matter at issue in the proceeding.

#### IV. NO OPPOSITION TO THIS MOTION

Patent Owner has confirmed with Patent Owner that Patent Owner does not oppose the present motion.

#### V. CONCLUSION

For the foregoing reasons, Moderna respectfully requests that the Board admit Morgan Chu *pro hac vice* in this proceeding.

Dated: May 15, 2019

Respectfully submitted,

/Michael R. Fleming/

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