

Paper No. \_\_\_\_  
Filed: May 31, 2018

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 IPR2018-00739  
Patent 9,364,435

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**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION UNDER  
37 C.F.R. § 42.10(c)**

**I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Pursuant to the Board's March 14, 2018 Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 5) and 37 C.F.R. § 42.10(c), Patent Owner Protiva Biotherapeutics, Inc. ("Protiva") respectfully requests that the Board recognize Edward Reines of Weil, Gotshal & Manges LLP as counsel *pro hac vice* in this proceeding.

Protiva has conferred with Petitioner Moderna Therapeutics, Inc. ("Moderna") who has stated it does not oppose this motion.

**II. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED**

As set forth below in the Statement of Material Facts, Protiva has made all of the showings required under 37 C.F.R. § 42.10(c) for recognizing Mr. Reines *pro hac vice*. In particular, Mr. Reines is an experienced litigating attorney who has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit, including technically and legally complex matters such as will be present in this proceeding. Mr. Reines has previously appeared *pro hac vice* in IPR proceedings related to biotechnology patents, which are at issue here. *See, e.g., Ariosa Diagnostics, Inc. v. Illumina, Inc.*, IPR2014-01093, Paper No. 29 (March 16, 2015). Accordingly, allowing Mr. Reines to appear *pro hac vice* on behalf of Protiva is appropriate in this proceeding.

### III. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he 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.”

2. Lead counsel in this *inter partes* review proceeding is Michael T. Rosato. Mr. Rosato is registered to practice before the United States Patent and Trademark Office and holds Registration No. 52,182.

3. As set forth in the Declaration of Edward R. Reines (Ex. 2001), Mr. Reines is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding. Ex. 2001, ¶¶ 1-2. In particular, Mr. Reines has 25 years of experience as a patent litigator and has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit. *Id.* ¶1.

4. Further, Mr. Reines is experienced with technically and legally complex matters in the life sciences, including life sciences-related technologies, including the following representative matters:

- *Verinata Health, Inc. et al. v. Sequenom, Inc. et al.* (N.D. Cal. 2012) — Lead trial counsel for Verinata Health in patent litigation related to prenatal diagnostics based on cell free fetal DNA.
- *The Trustees of Columbia University in the City of New York v. Illumina, Inc.* (Fed. Cir. 2014) — Appellate counsel for Illumina in Federal Circuit appeals of IPR proceedings related to DNA sequencing nucleotides.
- *Promega Corp. v. Life Techs. Corp. et al.* (2014) — District court and appellate counsel for Life Technologies in litigation related to DNA testing kits.
- *Helicos Corp. v. Pacific Biosciences of California, Inc.* (D. Del. 2010) — Lead trial counsel for Pacific Biosciences in patent litigation related to single molecule real time DNA sequencing.
- *Applera Corp. and Roche Molecular Sys. v. MJ Research, Inc.* (D. Conn. 2005) — Trial counsel for Applera in six patent litigation involving foundational PCR intellectual property.

*Id.* ¶ 2. Mr. Reines has previously appeared *pro hac vice* in IPR proceedings related to biotechnology patents, which are at issue here. *See, e.g., Ariosa Diagnostics, Inc. v. Illumina, Inc.*, IPR2014-01093, Paper No. 29 (March 16, 2015). *Id.*

5. Mr. Reines 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 37 C.F.R. *Id.* ¶ 9. Mr. Reines also agrees to be subject to the United States Patent and Trademark Office 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.* ¶10.

6. Finally, Mr. Reines has attested to the remaining elements of Paragraph 2(b) of the representative “Order – Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639, Paper 7, Oct. 15, 2013. *Id.* ¶¶ 3-12; *see* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 5) at 2. Regarding the required element in Paragraph 2(b)(iv) of the aforementioned representative order, Mr. Reines in his declaration at ¶ 6 has provided an explanation of the circumstances relating to the Federal Circuit reprimand of November 5, 2014, as required under Paragraph 2(c) of the aforementioned representative order. Also submitted with his declaration is the explanation of circumstances that Mr. Reines submitted to the Federal Circuit. Exhibit 2003.

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