

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEPTUNE GENERICS, LLC,
Petitioner,

v.

CORCEPT THERAPEUTICS, INC.,
Patent Owner.

Case IPR2018-01494
Patent 8,921,348 B2

Before ROBERT A. POLLOCK, and DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

ORDER

Conditionally Granting Petitioner's Motion for *Pro Hac Vice*
Admission of Leonard A. Gail
37 C.F.R. § 42.10

Petitioner Neptune Generics, LLC (“Petitioner”) filed a motion for *pro hac vice* admission of Leonard A. Gail (“Motion”) (Paper 14), accompanied by a Declaration of Mr. Gail in support of the Motion (“Declaration”) (Ex. 1035). Patent Owner has not opposed the Motion. For the reasons provided below, Petitioner’s Motion is *conditionally granted*.

Under 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in the proceeding. *See* Paper 4, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

In this proceeding, lead counsel for Petitioner, Kenneth M. Goldman, a registered practitioner, filed the Motion. Mot. 6. In the Motion, Petitioner states there is good cause for the Board to recognize Mr. Gail *pro hac vice* during this proceeding because he is “an experienced litigation attorney” and “has a familiarity with the subject matter at issue in this proceeding.” *Id.* at 4–5.

In his Declaration, Mr. Gail attests that he has never been suspended or disbarred by any court or administrative body, has not been denied for admission to practice before any court or administrative body, and has not been sanctioned or cited for contempt by any court or administrative body (Dec. ¶ 3). Mr. Gail also states that he has read and will comply with the Office Patent Trial Practice Guide and the Board’s rules as set for in 37 C.F.R. § 42, and agrees to be subject to the USPTO Rules of Professional Conduct and disciplinary jurisdiction under 37 C.F.R. § 11.19(a) (*id.* ¶ 4).

Based on the facts set forth in the Motion and the accompanying Declaration, Petitioner has would have established good cause for *pro hac vice* admission of Mr. Gail. However, the Declaration of Mr. Gail has not been properly executed under 37 C.F.R. § 1.68 or under 28 U.S.C. § 1746. Although the Declaration states Mr. Gail has “personal knowledge of the facts set forth in this declaration” (Dec. ¶ 1), 37 C.F.R. § 1.68 requires the “declarant must set forth in the body of the declaration that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.” Nor does the Declaration verify that the declarations are “true under penalty of perjury” under 28 U.S.C. § 1746. Accordingly, Petitioner’s Motion is *conditionally granted* upon Petitioner filing a properly executed declaration in accordance with 37 C.F.R. § 1.68 or under 28 U.S.C. § 1746 for Mr. Gail within ten (10) business days.

We also note that Petitioner should update its mandatory notices, as required by 37 C.F.R. § 42.8, and update its counsel information in the PTAB E2E filing system. We further note, a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has not been submitted for Mr. Gail in this proceeding. Therefore, Petitioner must submit a Power of Attorney within ten (10) business days.

Accordingly, it is

ORDERED that the Petitioner’s Motion for *pro hac vice* for Leonard A. Gail is *conditionally granted*;

FURTHER ORDERED that Petitioner shall submit, before Mr. Gail takes any actions in this proceeding, a properly executed declaration in accordance with 37 C.F.R. § 1.68 or under 28 U.S.C. § 1746 within ten (10) business days;

FURTHER ORDERED that Petitioner shall file updated Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3), identifying Mr. Gail as backup counsel;

FURTHER ORDERED that, within ten (10) business days of the issuance of this Order, Petitioner shall submit a Power of Attorney for Mr. Gail in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner shall continue to have a registered practitioner represent it as lead counsel for this proceeding, but that Mr. Gail is authorized to represent Petitioner only as back-up counsel;

FURTHER ORDERED that Mr. Gail shall comply with the Office Patent Trial Practice Guide, as updated by the Office Patent Trial Practice Guide August 2018 Update, 83 Federal Register 39,989 (Aug. 13, 2018), and the Board's Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R.; and

FURTHER ORDERED that Mr. Gail is subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq.

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