

Filed on behalf of: Corcept Therapeutics, Inc.

Entered: November 21, 2018

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
U.S. Patent No. 8,921,348

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

I. RELIEF REQUESTED

Under 37 C.F.R. § 42.10(c) and the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3), Patent Owner Corcept Therapeutics, Inc. ("Patent Owner") respectfully requests the *pro hac vice* admission of attorney Michelle L. Ernst, Esq. of Latham & Watkins LLP in this proceeding.

II. LEGAL STANDARD

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, 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.

The Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 3) further instructs:

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the "Order -- Authorizing Motion for *Pro Hac Vice* Admission" in Case

IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under "Representative Orders, Decisions, and Notices."

(*Id.* at 2.) The above referenced "Order - - Authorizing Motion for *Pro Hac Vice* Admission" further provides:

A motion for *pro hac vice* admission must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.
- b. Be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:
 - i. Membership in good standing of the Bar of at least one State or the District of Columbia;
 - ii. No suspensions or disbarments from practice before any court or administrative body;
 - iii. No application for admission to practice before any court or administrative body ever denied;
 - iv. No sanctions or contempt citations imposed by any court or administrative body;
 - v. The individual seeking to appear has read and will comply with the Office Patent Trial Practice Guide and Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R.;

- vi. The individual 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);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

(IPR2013-00639, Paper No. 7 at 3.) As set forth below, and in the accompanying Declaration of Michelle L. Ernst (Ex. 2008, "Ernst Decl."), each of these requirements is satisfied here.

III. STATEMENT OF FACTS SHOWING GOOD CAUSE FOR THE BOARD TO RECOGNIZE MICHELLE L. ERNST *PRO HAC VICE* IN THIS PROCEEDING

Ms. Ernst is a member in good standing of the State Bar of New York (Bar No. 5053483) and the State Bar of New Jersey (Bar. No. 039342011). (Ernst Decl. ¶ 2.) Ms. Ernst has never been suspended or disbarred from practice before any court or administrative body. (*Id.* ¶ 3.) No application of Ms. Ernst for admission to practice before any court or administrative body has ever been denied. (*Id.*) Nor has any court or administrative body imposed sanctions or contempt citations against Ms. Ernst. (*Id.*) Ms. Ernst has read, fully understands, 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 C.F.R. (*Id.* ¶ 4.) Ms. Ernst acknowledges and

agrees that she 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). (*Id.*)

Patent Owner's lead counsel in this proceeding, Robert Steinberg, is a registered practitioner (Reg. No. 33,144). Backup counsel, David P. Frazier, is also a registered practitioner (Reg. No. 47,576). Moreover, as set forth below (and in her accompanying declaration), Ms. Ernst is both an experienced and technically-trained litigation attorney with an established familiarity with the subject matter at issue in this proceeding.

Ms. Ernst received a Bachelor of Science from the University of Connecticut in 2005, and a law degree from Benjamin N. Cardozo School of Law, Yeshiva University in 2011. (*Id.* ¶ 5.) Ms. Ernst is currently a member of Latham & Watkins' intellectual property group, with a focus on patent litigation. (*Id.* ¶ 6.) Ms. Ernst has practiced in this group for over one year, and prior to joining Latham & Watkins, practiced intellectual property and patent litigation at other large law firms for approximately six years. (*Id.*)

Ms. Ernst also has an established familiarity with the subject matter at issue in this proceeding. Ms. Ernst has been actively involved in analyzing and assisting with the Petition for *Inter Partes* Review concerning U.S. Patent No. 8,921,348 ("348 patent") submitted in this proceeding. (*Id.* at ¶ 7.) She has not appeared *pro*

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