

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC,
Petitioner,

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

Case No. IPR2020-00040
U.S. Patent No. 7,326,708

**UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF BRUCE R.
GENDERSON PURSUANT TO 37 C.F.R. § 42.10(c)**

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c) and the Board's Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, which authorizes the parties to file motions for *pro hac vice* admission, Paper 4 at 2, Patent Owner Merck Sharp & Dohme Corp. submits the following motion for admission *pro hac vice* of Bruce R. Genderson of Williams & Connolly LLP, 725 Twelfth Street, N.W., Washington, DC 20005 in the above-captioned matter.

II. GOVERNING LAW, RULES, AND PRECEDENT

The Board is authorized to recognize counsel *pro hac vice* pursuant to 37 C.F.R. § 42.10(c), which 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.

The *Unified Patents* Order requires that a *pro hac vice* motion “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.” Order – Authorizing Motion for *Pro Hac Vice* Admission – 37 C.F.R. § 42.10, IPR2013-00639, Paper 7 at 3. A motion for *pro hac vice* admission should also 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 the 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 three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

Id.

III. STATEMENT OF FACTS

Based on the following facts, and supported by the Declaration of Mr. Genderson (Ex. 2001) submitted herewith, Patent Owner Merck Sharp & Dohme Corp. requests the *pro hac vice* admission of Bruce R. Genderson in this proceeding:

1. Patent Owner's lead counsel, Stanley E. Fisher (Reg. No. 55,820), is a registered practitioner before the Board.
2. Mr. Genderson is a partner at Williams & Connolly LLP and an experienced litigation attorney. Mr. Genderson has more than thirty (30) years of litigation experience. Ex. 2001 ¶ 2.
3. Mr. Genderson has established familiarity with the subject matter at issue in this proceeding. As detailed below, Mr. Genderson has reviewed in detail the pleadings, patent, and exhibits relied upon by Petitioner, as well as engaged in extensive strategic and substantive

discussions regarding this proceeding with Stanley E. Fisher, the lead counsel for Patent Owner Merck Sharp & Dohme Corp. Ex. 2001 ¶ 10. Mr. Genderson has engaged in the representation of Patent Owner Merck Sharp & Dohme Corp. in related matters in federal district court, including the assertion of U.S. Patent No. 7,326,708 in *Merck Sharp & Dohme Corp. v. Mylan Pharmaceuticals Inc.*, C.A. No. 19-cv-101-IMK (N.D.W.V.) and *In Re: Sitagliptin Patent Litigation*, MDL No. 19-2902-RGA (D. Del.) (consolidated). Ex. 2001 ¶ 10.

4. Mr. Genderson has also reviewed in detail relevant case law and legal authority related to the allegations made in the Petition. Ex. 2001 ¶ 11.

5. Mr. Genderson is a member in good standing of the bars of Maryland and the District of Columbia. Ex. 2001 ¶ 3.

6. Mr. Genderson has never been suspended or disbarred from practice before any court or administrative body. Ex. 2001 ¶ 4.

7. No court or administrative body has ever denied Mr. Genderson's application for admission to practice before it. Ex. 2001 ¶ 5.

8. No court or administrative body has ever imposed sanctions or contempt citations on Mr. Genderson. Ex. 2001 ¶ 6.

9. Mr. Genderson 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. Ex. 2001 ¶ 7.

10. Mr. Genderson understands that he will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 et seq. and will be subject to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Ex. 2001 ¶ 8.

11. Mr. Genderson is seeking *pro hac vice* admission to appear in the Petitioner's *inter partes* challenge to U.S. Patent No. 7,326,708. That proceeding has been designated Case No.

IPR2020-00040. Mr. Genderson has not applied to appear *pro hac vice* in other proceedings before the Office in the last three (3) years. Ex. 2001 ¶ 9.

IV. GOOD CAUSE EXISTS FOR THE PRO HAC VICE ADMISSION OF MR. GENDERSON IN THIS PROCEEDING

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. 37 C.F.R. § 42.10(c). Patent Owner's lead counsel, Stanley E. Fisher, is a registered practitioner before the Board. Based on the facts contained herein, as supported by Mr. Genderson's declaration, good cause exists to admit Mr. Genderson *pro hac vice* in this proceeding.

As set forth in his declaration, Mr. Genderson is a partner at Williams & Connolly LLP and an experienced litigator with more than thirty (30) years of litigation experience. Ex. 2001 ¶ 2.

Mr. Genderson has established familiarity with the subject matter at issue in the proceeding. Ex. 2001 ¶ 10. Mr. Genderson has reviewed in detail the pleadings submitted by Petitioner in this proceeding. Ex. 2001 ¶ 10. Mr. Genderson has reviewed in detail the challenged patent. Ex. 2001 ¶ 10. Mr. Genderson has also reviewed in detail exhibits relied upon by Petitioner, such as Exhibit1002 (Declaration of Dr. Mukund Chorghade, Ph.D.). Ex. 2001 ¶ 10.

Mr. Genderson has engaged in extensive strategic and substantive discussions regarding this proceeding with Stanley E. Fisher, who is the lead counsel for the Patent Owner in this case. Ex. 2001 ¶ 10. Mr. Genderson has engaged in the representation of Patent Owner Merck Sharp & Dohme Corp. in related matters in federal district court, including the assertion of U.S. Patent No. 7,326,708 in *Merck Sharp & Dohme Corp. v. Mylan Pharmaceuticals Inc.*, C.A. No. 19-cv-

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