

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEVA PHARMACEUTICALS USA, INC. AND WATSON
LABORATORIES, INC.,
Petitioner

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

IPR2020-01045
Patent 7,326,708 B2

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Motion
for *Pro Hac Vice* Admission of Emily L. Rapalino
37 C.F.R. § 42.10

On July 27, 2020, Teva Pharmaceuticals USA, Inc. and Watson Laboratories, Inc. (collectively “Petitioner”) filed a motion for *pro hac vice* admission of Emily L. Rapalino in the above-identified proceeding (“Motion” or “Mot.”). Paper 11.¹ Petitioner states that “Patent Owner consents to this Motion.” Mot. 1. The Motion is *granted*.

In accordance with 37 C.F.R. § 42.10(c), we 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 6, 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”)) (“Notice”).

In its Motion, Petitioner states that there is good cause for the Board to recognize Emily L. Rapalino *pro hac vice* during this proceeding because she is an experienced litigating attorney and has an established familiarity with the precise subject matter at issue in this proceeding. Mot. 2–3.

The Motion is supported by a Declaration (Ex. 1018) (“Decl.”) of Emily L. Rapalino, attesting to the Motion’s statement of material facts and complying with the requirements set forth in the Notice. *See* Decl. ¶¶ 1–11.

Upon consideration, Petitioner has demonstrated that Ms. Rapalino has sufficient legal and technical qualifications and familiarity with the subject matter at issue, and that there is a need for Petitioner to have counsel

¹ We cite to Papers and Exhibits (“Ex.”) in IPR2020-01045.

with her experience. *See id.* ¶¶ 1–5; Mot. 2–3. Petitioner therefore has established good cause for admitting Ms. Rapalino *pro hac vice* in this proceeding.

Accordingly, it is

ORDERED that Petitioner’s Motion for *pro hac vice* admission of Emily L. Rapalino for this proceeding is *granted*; Ms. Rapalino is authorized to act as back-up counsel in this proceeding only;

FURTHER ORDERED that Petitioner must file, within ten (10) business days, updated mandatory notices in this proceeding, identifying Ms. Rapalino as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Petitioner must file, within ten (10) business days, a power of attorney in this proceeding for Ms. Rapalino in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that Ms. Rapalino is to comply with the Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019), and the Board’s Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

FURTHER ORDERED that Ms. Rapalino 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.*

IPR2020-01045
Patent 7,326,708 B2

FOR PETITIONER:

Keith A. Zullo
Sarah J. Fischer
GOODWIN PROCTER LLP
kzullo@goodwinprocter.com
sfischer@goodwinprocter.com

FOR PATENT OWNER:

Stanley E. Fisher
Jessamyn S. Berniker
Shaun P. Mahaffy
Anthony H. Sheh
WILLIAMS & CONNOLLY LLP
sfisher@wc.com
jberniker@wc.com
smahaffy@wc.com
asheh@wc.com