

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TWI PHARMACEUTICALS, INC.,
Petitioner,

v.

MERCK SERONO SA,
Patent Owner.

Case IPR2023-00050
U.S. Patent 8,377,903

**PATENT OWNER'S MOTION FOR
ADMISSION *PRO HAC VICE* OF
MARY PHENG**

I. Statement of Precise Relief Requested

Pursuant to 37 C.F.R. § 42.10(c) and Paper No. 3 authorizing the parties to file motions for *pro hac vice* admissions under 37 C.F.R. § 42.10(c), Patent Owner Merck Serono SA requests that the Patent Trial and Appeal Board (the “Board”) admit Mary Pheng *pro hac vice* in this proceeding, IPR2023-00050. The parties have met and conferred, and Petitioner does not oppose this motion.

II. Statement of Facts Showing Good Cause for the Board to Recognize Counsel *Pro Hac Vice* During the Proceeding

In accordance with 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. Section 42.10(c) indicates that “where 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 a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” The facts here establish good cause for the Board to recognize Ms. Pheng *pro hac vice* in this proceeding.

Lead counsel, Emily R. Whelan, is a registered practitioner. Backup counsel, Deric Geng and Cindy Kan, are also registered practitioners. Ms. Pheng is an experienced litigator and has established familiarity with the subject matter at

issue in the proceeding.

Accompanying this motion as Exhibit 2003 is the February 8, 2024, Declaration of Mary Pheng in Support of this Motion for Admission *Pro Hac Vice* (“Pheng Decl.”). In her declaration, Ms. Pheng asserts:

I am a member in good standing of the Bars of Minnesota and New York and am admitted to practice before the U.S. District Court for the District of Minnesota.

Pheng Decl. ¶ 2 (Ex. 2003).

Ms. Pheng demonstrates that she has a detailed working knowledge of the relevant subject matter through her participation in the *inter partes* review matters challenging U.S. Patent No. 7,713,947 and U.S. Patent No. 8,377,903 and in consolidated district court litigations. *Id.* ¶ 10 (Ex. 2003). Ms. Pheng also has significant experience with patent litigation in a variety of jurisdictions, including in *inter partes* review proceedings, district court litigation, and international trade commission investigations. *Id.* ¶ 1 (Ex. 2003). Ms. Pheng will work in coordination and association with the designated lead counsel for this proceeding, Emily R. Whelan. *Id.* ¶ 11 (Ex. 2003).

In her declaration, Ms. Pheng also attests to each of the listed items required by the “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case

IPR2013-00639, Paper 7. *See* Pheng Decl. ¶¶ 1-12 (Ex. 2003). Ms. Pheng attests that she has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in 37 C.F.R. § 42. *See id.* ¶ 7 (Ex. 2003). Ms. Pheng further attests that she agrees to be subject to the United States Patent and Trademark Office's Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *See id.* ¶ 8 (Ex. 2003).

III. Conclusion

For the foregoing reasons, Patent Owner respectfully requests that the Board admit Ms. Pheng *pro hac vice* in this proceeding. The undersigned authorizes the Office to charge \$250 to Deposit Account No.08-0219 for the fees set forth in 37 C.F.R. § 42.15(e) for this *pro hac vice* motion. Please charge any shortage of fees or credit any overpayments to the above Deposit Account.

Dated: February 9, 2024

Respectfully Submitted,

/Emily R. Whelan/

Emily R. Whelan, Reg. No. 50,391
Counsel for Patent Owner

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of David B. Bassett in Support of Motion for Admission <i>Pro Hac Vice</i>
2002	Declaration of Vinita Ferrera in Support of Motion for Admission <i>Pro Hac Vice</i>
2003	Declaration of Mary Pheng in Support of Motion for Admission <i>Pro Hac Vice</i>

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