

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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CANFIELD SCIENTIFIC, INC.,  
Petitioner,

v.

MELANOSCAN, LLC,  
Patent Owner.

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Case IPR2017-02125  
Patent 7,359,748 B1

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**PETITIONER'S MOTION FOR *PRO HAC VICE*  
ADMISSION OF THOMAS L. DUSTON**

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**I. Requested Relief**

Petitioner presents this motion, pursuant to 37 C.F.R. § 42.10, for Thomas L. Duston to appear *pro hac vice* on its behalf in this proceeding. This motion is presented in accordance with the Board's September 27, 2017, "Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response" (Paper No. 5).

**II. Statement of Facts**

The Petitioner respectfully submits that the following facts, supported by the Declaration of Thomas L. Duston (Exh. 1017), establish good cause for Mr. Duston's admission *pro hac vice* in this proceeding:

1. The undersigned Lead Counsel for the Petitioner is a registered practitioner.
2. Mr. Duston is a partner at the same law firm as the Petitioner's Lead Counsel, Marshall, Gerstein & Borun LLP. Exh. 1017, at ¶ 1.
3. Mr. Duston has been practicing in the field intellectual property law, and particularly patent litigation, for thirty years. Exh. 1017, at ¶ 2.
4. Mr. Duston is a member in good standing of the Bar of the State of Illinois; he is admitted to practice before the United States Court of Appeals for the Federal Circuit, the United States Court of Appeals for the Seventh Circuit,

the United States District Court for the Northern District of Illinois (Trial Bar Member), and the United States District Court for the Eastern District of Texas; and, he is also admitted to practice *pro hac vice* in a number of other Federal District courts. Exh. 1017, at ¶ 3.

5. Mr. Duston has never been suspended or disbarred from practice before any court or administrative body. Exh. 1017, at ¶ 4.
6. Mr. Duston has never had an application for admission to practice before any court or administrative body denied. Exh. 1017, at ¶ 5.
7. Mr. Duston has never had sanctions or contempt citations imposed upon him by any court or administrative body. Exh. 1017, at ¶ 6.
8. Mr. Duston is a member of the American Bar Association, the Intellectual Property Owners Association, the Chicago Bar Association, the Eastern District of Texas Bar Association, and the Seventh Circuit Bar Association. Exh. 1017, at ¶ 7.
9. Mr. Duston 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 the Code of Federal Regulations. Exh. 1017, at ¶ 8.
10. Mr. Duston has read and will abide by and be subject to the U.S. Patent and Trademark Office Code of Professional Responsibility set forth in 37 C.F.R.

§ 11.101 *et. seq.* and the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Exh. 1017, at ¶ 9.

11. Mr. Duston has been admitted *pro hac vice* before the Office during the past three years in the following inter partes review proceedings: (1) *ACCO Brands v Think Products, Inc.*, Case IPR2015-01167, -01168 regarding U.S. Patent Nos. 8,717,758 and 8,837,144, respectively; and (2) *Groupon, Inc. v. Online News Link LLC*, Case IPR2014-01326 regarding U.S. Patent No. 7,181,758, Case IPR2014-01327 regarding U.S. Patent No. 8,457,545, and Case IPR2014-01328 regarding U.S. Patent No. 7,508,789. Exh. 1017, at ¶ 10.
12. Mr. Duston is an experienced litigating attorney and is familiar with the subject matter at issue in the proceeding. He is lead counsel in concurrent litigation involving the same patent as that challenged in this proceeding. That litigation is captioned *Canfield Scientific. v. Melanoscan LLC and Dr. Rhett Drugge*, Case No. 2:16-cv-04636-JMV-JBC (D. N. J.). He has read the patent-at-issue, its file history, and the Petition in this proceeding. Exh. 1017, at ¶ 11.
13. Further, in his declaration, Mr. Duston attests to each of the items required by 37 C.F.R. § 42.10(c) and the Board's order in *Unified Patents, Inc. v.*

*Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013). *See* Exh. 1017, at ¶¶ 1–12.

### **III. Reasons for Granting this Motion**

The Board may recognize counsel *pro hac vice* during an *inter partes* review proceeding “upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose.” 37 C.F.R. § 42.10(c). “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.” *Id.*

A grantable motion for *pro hac vice* admission must be accompanied by a declaration of the individual who is seeking admission, and the motion must contain a statement of facts showing there is good cause for the Board to recognize the individual *pro hac vice* during the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013). The individual’s declaration must contain certain attestations. *Id.*

This motion and Mr. Duston’s accompanying declaration meet all of the Board’s requirements. Specifically, and as set forth above, the Petitioner’s Lead Counsel in this proceeding is a registered practitioner. Mr. Duston is an

experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. In his declaration, Mr. Duston makes the attestations set forth in the Board's order in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7, at 3–4 (P.T.A.B. Oct. 15, 2013).

#### **IV. Conclusion**

For the foregoing reasons, the Petitioner respectfully requests the Board to admit Mr. Duston *pro hac vice* in this proceeding.

Respectfully submitted,

October 18, 2017

/ Julianne M. Hartzell, #44,748 /  
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Lead Counsel for Petitioner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a copy of the foregoing “PETITIONER’S MOTION FOR PRO HAC VICE ADMISSION OF THOMAS L. DUSTON” is being served today, **October 18, 2017**, by electronic mail on counsel for the Patent Owner:

**mgarratana@mccarter.com**

**kreiner@mccarter.com**

/ Julianne M. Hartzell, #44,748 /

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