

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

THE TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK
Patent Owner.

Case IPR2018-00322
Patent 9,708,358

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

I. Relief Requested

Pursuant to 37 C.F.R. § 42.10(c), Patent Owner The Trustees of Columbia University In The City of New York respectfully requests that the Patent Trial and Appeal Board (“the Board”) recognizes Zachary L. Garrett as counsel *pro hac vice* on behalf of Patent Owner during this proceeding.

In an *inter partes* review (“IPR”), the Board has discretion under 37 C.F.R. § 42.10(c) to recognize counsel *pro hac vice*. 37 C.F.R. § 42.10(c) 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.

In support of this motion, a Declaration of Zachary L. Garrett is submitted herewith (Exhibit 2050) showing that Mr. Garrett satisfies the requirements for *pro hac vice* admission as set forth in IPR2013-00639, Paper 7, dated October 15, 2013.

II. Time for Filing

This Motion for Admission is being filed with the Board’s authorization provided in the Notice of Filing Date Accorded to Petition (Paper No. 5, dated

January 10, 2018), and in accordance with the guidelines therein. This motion is being filed no sooner than 21 days after service of the Petition.

III. Statement of Facts

Based on the following facts, and supported by the Declaration of Zachary L. Garrett (Exhibit 2050), submitted herewith, Patent Owner has established good cause for the Board to recognize Mr. Garrett *pro hac vice* in this matter:

1. Lead counsel in this IPR proceeding is John P. White. John P. White is Of Counsel at the law firm of Cooper & Dunham LLP and is registered to practice before the United States Patent and Trademark Office (“USPTO”) (Reg. No. 28,678).

2. Mr. Garrett is an associate at the law firm of Fitzpatrick, Cella, Harper & Scinto. Garrett Declaration, ¶ 1.

3. Mr. Garrett is an experienced litigating attorney. Mr. Garrett has been a litigating attorney for over 5 years. Mr. Garrett has been litigating patent cases during that entire time period. *Id.*, ¶ 2.

4. Mr. Garrett is a member in good standing of the State Bar of New York. *Id.*, ¶ 3.

5. Mr. Garrett has never been suspended or disbarred from practice before any court or administrative body. *Id.*, ¶ 4.

6. No other application by Mr. Garrett for admission to practice before any court or administrative body has been denied. *Id.*, ¶ 5.

7. No sanctions or contempt citations have ever been imposed against Mr. Garrett by any court or administrative body. *Id.*, ¶ 6.

8. Mr. Garrett 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 37 C.F.R. *Id.*, ¶ 7.

9. Mr. Garrett understands and agrees that he will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.*, ¶ 8.

10. Mr. Garrett is concurrently applying to appear *pro hac vice* in *Illumina, Inc. v. Trustees Of Columbia University In The City of New York*, IPR2018-00291, IPR2018-00318, and IPR2018-00385. *Id.*, ¶ 9. Mr. Garrett has not applied to appear *pro hac vice* in any other proceedings before the USPTO in the last three years. *Id.*

11. Mr. Garrett has established familiarity with the subject matter at issue in this proceeding. He began representing and advising the Patent Owner in matters relating to U.S. Patent No. 9,708,358 ("the '358 patent") no later than September 2017. *Id.*, ¶ 10. Since that time, Mr. Garrett has become very familiar

Case IPR2018-00322

Patent No. 9,708,358

with the '358 patent, its prosecution file history, and the prior art and other papers cited in the Petition. *Id.*

IV. Good Cause Exists for *Pro Hac Vice* Admission

In accordance with 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other condition the Board may impose. 37 C.F.R. § 42.10(c). Patent Owner's lead counsel, John P. White, is a registered practitioner. Furthermore, as supported by his Declaration, Mr. Garrett has been a litigating attorney for over 5 years. He has been litigating patent cases during that entire time period. Mr. Garrett also has developed an established familiarity with the subject matter at issue in this proceeding.

Given his knowledge of the subject matter at issue in this proceeding, Patent Owner would benefit from Mr. Garrett's expertise and involvement in this proceeding.

V. Conclusion

Patent Owner respectfully requests that, in light of the foregoing, there is good cause for the Board to recognize Mr. Garrett as counsel *pro hac vice* for Patent Owner during this proceeding. This Motion for *Pro Hac Vice* Admission is accompanied by the Declaration of Zachary L. Garrett (Exhibit 2050).

Case IPR2018-00322
Patent No. 9,708,358

Dated: June 21, 2018

Respectfully submitted,

By: /John P. White/
John P. White (Reg. No. 28,678)
Customer No. 23432

Lead Counsel for Patent Owner
Cooper & Dunham LLP
30 Rockefeller Plaza
20th Floor
New York, New York 10112
Telephone: (212) 278-0400
Facsimile: (212) 391-0525
jwhite@cooperdunham.com

Case IPR2018-00322
Patent No. 9,708,358

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S MOTION FOR ADMISSION *PRO HAC VICE* OF ZACHARY L. GARRETT UNDER 37 C.F.R. § 42.10(c)** is being served on June 21, 2018, via email to Counsel for Petitioner, Kerry Taylor and Michael L. Fuller, at:

BoxIllumina@knobbe.com

Dated: June 21, 2018

By: /Brittany N. Internoscia/
Brittany N. Internoscia
Law Clerk
Cooper & Dunham LLP