

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ILLUMINA, INC.,  
Petitioner,

v.

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

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Case IPR2018-00322  
Patent 9,708,358

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PATENT OWNER'S MOTION FOR ADMISSION  
*PRO HAC VICE* OF  
ROBERT S. SCHWARTZ 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 Robert S. Schwartz 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 Robert S. Schwartz is submitted herewith (Exhibit 2001) showing that Mr. Schwartz 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 Robert S. Schwartz (Exhibit 2001), submitted herewith, Patent Owner has established good cause for the Board to recognize Mr. Schwartz *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. Schwartz is a partner at the law firm of Fitzpatrick, Cella, Harper & Scinto. Schwartz Declaration, ¶ 1.

3. Mr. Schwartz is an experienced litigating attorney. Mr. Schwartz has been a litigating attorney for almost 14 years. Mr. Schwartz has been litigating patent cases during that entire time period. *Id.*, ¶ 2.

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

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

6. No other application by Mr. Schwartz 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. Schwartz by any court or administrative body. *Id.*, ¶ 6.

8. Mr. Schwartz 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. Schwartz 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. In the last three years, Mr. Schwartz has applied to appear *pro hac vice* in the following proceedings before the USPTO: *Gilead Sciences, Inc. v. Regents of the University of Minnesota*, IPR2017-01712 (Paper 9, Sep. 11, 2017), IPR2017-01753 (Paper 9, Sep. 11, 2017), IPR2017-02004 (Paper 9, Oct. 3, 2017), IPR2017-02005 (Paper 9, Oct. 3, 2017). Mr. Schwartz has also applied to appear *pro hac vice* in *Illumina, Inc. v. Trustees Of Columbia University In The City of New York*, IPR2018-00291 (motion pending), and is concurrently applying to appear *pro hac vice* in *Illumina, Inc. v. Trustees Of Columbia University In The City of New York*, IPR2018-00318. *Id.*, ¶ 9.

11. Mr. Schwartz 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 July 18, 2017. *Id.*, ¶ 10. Since that time, Mr. Schwartz has become very familiar with the ’358 patent, its prosecution file history, and the prior art and other papers cited in the Petition. *Id.*

12. Mr. Schwartz is also counsel for Patent Owner in the concurrent litigation *Trustees Of Columbia University In The City of New York v. Illumina, Inc.*, Civil Action No. 17-cv-00973-GMS, in the United States District Court for the District of Delaware, involving the same patent. *Id.*, ¶ 11.

#### **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. Schwartz has been a litigating attorney for almost 14 years. He has been litigating patent cases during that entire time period. Mr. Schwartz 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. Schwartz'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. Schwartz as counsel *pro hac vice* for Patent Owner during this proceeding. This Motion for *Pro Hac Vice* Admission is accompanied by the Declaration of Robert S. Schwartz (Exhibit 2001).

Respectfully submitted,

Dated: January 16, 2018

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

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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 ROBERT S. SCHWARTZ UNDER 37 C.F.R. § 42.10(c)** is being served on January 16, 2018, via email to Counsel for Petitioner, Kerry Taylor and Michael L. Fuller, at:

BoxIllumina@knobbe.com

Dated: January 16, 2018

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