

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

3M Company, Merck & Co., Inc., and Merck Sharp & Dohme Corp.

Petitioners,

v.

AptarFrance S.A.S.,

Patent Owner.

Case IPR2018-01055
Patent No. 9,370,631 B2

**PETITIONERS' MOTION FOR *PRO HAC VICE* ADMISSION OF
RON N. SKLAR UNDER 37 C.F.R. § 42.10(c)**

In accordance with 37 C.F.R. § 42.10(c) and the authorization granted in the Board's Notice of Filing Date issued May 15, 2018 (Paper 5), Petitioners 3M Company, Merck & Co., Inc., and Merck Sharp & Dohme Corp. (collectively, "Petitioners") hereby request that the Board recognize Ron N. Sklar as counsel *pro hac vice* during this proceeding. Petitioners seek Mr. Sklar's assistance because he is an experienced litigation attorney and is counsel representing Petitioners in a related district court litigation *AptarGroup, Inc. and Aptar France S.A.S. v. 3M Co., Merck & Co., Inc., and Merck, Sharp & Dohme Corp.*, Case No. 1:17-cv-06294 (N.D. Ill.) (the "District Court Litigation"), and as such has an established familiarity with the substantive and technical issues involved in this proceeding.

I. TIME FOR FILING

This Motion for *Pro Hac Vice* Admission is being filed not sooner than twenty one (21) days after service of the Petition (Paper 1) as required by the Order Authorizing Motion for *Pro Hac Vice* Admission in Case IPR2013-00639 as directed in the Notice of Filing Date (Paper 5 at 2).

II. STATEMENT OF FACTS

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 as 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.*

As set forth below and in the accompanying Declaration of Ron N. Sklar in Support of Motion for *Pro Hac Vice* Admission (Exhibit 1050), the facts establish good cause for the Board to recognize Mr. Sklar *pro hac vice*.

1. Lead counsel, Steven D. Maslowski is a registered practitioner (Reg. No. 46,905).

2. Mr. Sklar is a member in good standing of the Bar of Illinois (Bar No. 6304022). See Ex. 1050, ¶ 2.

3. Mr. Sklar has not been suspended or disbarred from practice before any court or administrative body. See Ex. 1050, ¶ 3.

4. Mr. Sklar has never had an application for admission to practice before any court or administrative body denied. See Ex. 1050, ¶ 4.

5. Mr. Sklar has never had a sanction or contempt citation imposed against him by any court or administrative body. See Ex. 1050, ¶ 5.

6. Mr. Sklar has read and will comply with the Office Patent Trial Practice Guide and the Board's Rule of Practice for Trials set forth in part 42 of 37 C.F.R. See Ex. 1050, ¶ 6.

7. Mr. Sklar will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). See Ex. 1050, ¶ 7.

8. In the last three years, Mr. Sklar has applied to appear pro hac vice before the Office in the following proceedings: IPR2018-00741, IPR2018-00742, IPR2018-00743, and IPR2018-00744. All of these motions were granted. Mr. Sklar is also applying to appear pro hac vice in IPR2018-01054. See Ex. 1050, ¶ 8.

9. Mr. Sklar is an experienced litigation attorney, and has been involved in numerous patent infringement litigations in District Courts across the country, and at the International Trade Commission. He has experience in jury trials and has participated in numerous *Markman* hearings. See Ex. 1050, ¶ 9. Mr. Sklar's biography is attached hereto as Exhibit 1051.

10. U.S. Patent No. 9,370,631 is currently asserted against Petitioners in the co-pending District Court Litigation. Mr. Sklar is counsel for Petitioners in the co-pending District Court Litigation. Mr. Sklar also reviewed U.S. Patent No. 9,370,631, participated in the drafting of the Petition filed in this proceeding, and has reviewed the Patent Owner's Preliminary Response and the Board's Institution Decision. As a result of these efforts, Mr. Sklar has an established familiarity with the subject matter at issue in this proceeding. Petitioners have expended significant financial resources in the District Court Litigation with Mr. Sklar as

counsel and Petitioners wish to continue using Mr. Sklar as counsel in this proceeding. See Ex. 1050, ¶ 9.

Petitioners hereby submit that there is good cause for the Board to recognize Mr. Sklar as counsel *pro hac vice* during this proceeding.

III. AFFIDAVIT OR DECLARATION OF INDIVIDUAL SEEKING TO APPEAR

This Motion for *Pro Hac Vice* Admission is accompanied by the required Declaration of Ron N. Sklar, which is attached hereto as Exhibit 1050.

Dated: December 11, 2018

Respectfully submitted,

/Steven D. Maslowski/

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Co., Inc., and Merck, Sharp & Dohme Corp.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of PETITIONERS' MOTION FOR PRO HAC VICE ADMISSION OF RON N. SKLAR UNDER 37 C.F.R. § 42.10(c) on the counsel of record for the Patent Owner by filing this document through the End-to-End System as well as delivering a copy via electronic mail to the following address:

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