

Filed On Behalf Of:

Alnylam Pharmaceuticals, Inc.

By:

Scott K. Reed
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALNYLAM PHARMACEUTICALS, INC.,
Petitioner,
v.
SILENCE THERAPEUTICS GMBH,
Patent Owner.

Case PGR2018-00089
U.S. Patent No. 9,790,501

**PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
ROBERT S. SCHWARTZ UNDER 37 C.F.R. § 42.10**

I. RELIEF

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Alnylam Pharmaceuticals, Inc. (“Petitioner”) respectfully requests the *pro hac vice* admission of Robert S. Schwartz in this proceeding.

This motion is being filed more than twenty one (21) days after service of the Petition.

II. THE GOVERNING LAW, RULES, AND PRECEDENT

37 C.F.R. § 42.10(c) concerns motions for *pro hac vice* admission and states as follows:

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.

The Board has stated that motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c) should be filed in accordance with the “Order – Authorizing Motion for *Pro Hac Vice* Admission” entered in Case IPR2013-00639 (Paper 7) (Representative Opinion).

In that Order, the Board stated that motions for *pro hac vice* admission must “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding,” and must “[b]e accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear 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 37 C.F.R.;

- vi. The individual 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);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.”

III. STATEMENT OF MATERIAL FACTS

Based on the following facts, which are supported by the Declaration of Robert S. Schwartz (Exh. 1092) filed concurrently with this motion, Petitioner requests that Robert S. Schwartz be admitted *pro hac vice* in this proceeding:

1. Petitioner’s lead counsel, Scott K. Reed, is a registered practitioner (Reg. No. 32,433).
2. Mr. Schwartz is a partner at the law firm of Venable LLP. (Exh. 1092 at ¶ 3.)
3. Mr. Schwartz is an experienced patent litigation attorney. Mr. Schwartz has been a patent litigation attorney for more than 14 years. (*Id.* at ¶ 4.) Mr. Schwartz has been litigating patent cases during this entire time period and has been involved in numerous cases involving

patent validity and infringement in District Courts across the country.

(*Id.*) He has extensive experience in bench trials. (*Id.*)

4. Mr. Schwartz is a member in good standing of the bar of the State of New York. He is also admitted to the bars of the United States District Courts for the Southern and Western Districts of New York, and United States Court of Appeals for the Federal Circuit. (*Id.* at ¶ 5.)
5. Mr. Schwartz has never been suspended or disbarred from practice before any court or administrative body. (*Id.*)
6. No application of Mr. Schwartz for admission to practice before any court or administrative body has ever been denied. (*Id.* at ¶ 6.)
7. No sanctions or contempt citations have ever been imposed against Mr. Schwartz by any court or administrative body. (*Id.* at ¶ 7.)
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 37 C.F.R. (*Id.* at ¶ 8.)
9. Mr. Schwartz understands that he will be subject to the Office's 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). (*Id.* at ¶ 9.)
10. Mr. Schwartz has applied to appear and was admitted *pro hac vice* in eight other proceedings before the Office in the last three (3) years:

IPR2017-01712, IPR2017-01753, IPR2017-02005, IPR2018-00291,
IPR2018-00318, IPR2018-00322, IPR2018-00385, and IPR2018-
00797. (*Id.* at ¶ 10.)

IV. GOOD CAUSE EXISTS FOR THE *PRO HAC VICE* ADMISSION OF MR. SCHWARTZ IN THIS PROCEEDING

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. 37 C.F.R. § 42.10(c). Petitioner's lead counsel, Scott K. Reed, is a registered practitioner. Based on the facts set forth in this motion, as supported by Mr. Schwartz's Declaration (Exh. 1092), there is good cause to admit Mr. Schwartz *pro hac vice* in this proceeding.

Mr. Schwartz has an established familiarity with the subject matter at issue in this proceeding. (Exh. 1092 at ¶¶ 11-13.) He has been involved consistently and substantively in this matter since its inception in July 2018. (*Id.* at ¶ 11.) Additionally, Mr. Schwartz has engaged in extensive strategic and substantive discussions regarding this proceeding with Scott K. Reed, who is the lead counsel for Petitioner; Prajakta A. Sonalker, who is designated as back-up counsel for Petitioner; and Ha Kung Wong and Melinda R. Roberts, who are concurrently seeking *pro hac vice* admission to appear in this proceeding. (*Id.* at ¶ 12.) Mr.

Schwartz has engaged in extensive substantive discussions with Petitioner's expert concerning issues relevant to this proceeding. (*Id.*)

Thus, Mr. Schwartz has an established familiarity with the subject matter at issue in this proceeding as well as significant litigation experience and expertise. For these reasons, good cause exists to admit Mr. Schwartz *pro hac vice* in this proceeding.

Dated: November 20, 2018

Respectfully submitted,

/s/ Scott K. Reed

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PETITIONER'S
MOTION FOR PRO HAC VICE ADMISSION OF ROBERT S.
SCHWARTZ UNDER 37 C.F.R. § 42.10** was served electronically via email on
November 20, 2018 at the following addresses of record:

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Patent Owner has consented to service by electronic mail to
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Dated: November 20, 2018

Respectfully submitted,

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