

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELEKTA INC.
Petitioner,

v.

VARIAN MEDICAL SYSTEMS, INC.
Patent Owner.

Case No. IPR2016-00476
Patent 8,116,430 B1

Before GARTH D. BAER, *Administrative Patent Judge*.

ORDER GRANTING MOTION FOR ADMISSION PRO HAC VICE OF
SARAH B. WHITNEY
37 C.F.R. § 42.10

Patent Owner moves for the *pro hac vice* admission of Sarah B. Whitney (Paper 22) in accordance with 37 C.F.R. § 42.10. Petitioner has not opposed the Motion. We grant the Motion.

I. Discussion

As set forth in 37 C.F.R. § 42.10(c), 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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, the Board also requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. *See* Paper 7, “Order – Authorizing Motion for *Pro Hac Vice* Admission” in IPR2013-00639, entered October 15, 2013.

Ms. Whitney provides uncontroverted testimony that she:

- i. is a member in good standing of the Bar of at least one state or the District of Columbia;
- ii. has not been subject to any suspensions or disbarments from practice before any court or administrative body;
- iii. has never been denied any application for admission to practice before any court or administrative body;
- iv. has not been subject to sanctions or contempt citations imposed by any court or administrative body;

- v. 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. 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. has listed all other proceedings before the Office for which Mr. Chen has applied to appear *pro hac vice* in the last three (3) years; and
- viii. has familiarity with the subject matter at issue in the proceeding.

Ex. 2008, 1–2.

Patent Owner's lead counsel, Heidi L. Keefe, who is a registered to practice before the USPTO, asserts that there is good cause for Ms. Whitney's *pro hac vice* admission as follows: (1) Ms. Whitney is experienced litigation attorney and has been involved in numerous complex litigations; and (2) Ms. Whitney is familiar with the pending litigation between the parties and, as such, is familiar with the subject matter at issue in this proceeding. Paper 22, 1–2. Thus, Patent Owner has shown good cause why Ms. Whitney should be recognized *pro hac vice* for purposes of this proceeding and Ms. Whitney has provided the requisite affidavits or declarations. Therefore, Ms. Whitney has complied with the requirements for admission *pro hac vice* in this proceeding.

II. Order

It is

ORDERED that the motion seeking admission *pro hac vice* for Sarah B. Whitney is GRANTED;

FURTHER ORDERED that Sarah B. Whitney may not act as lead counsel in the proceeding;

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FURTHER ORDERED that a registered practitioner must remain as lead counsel throughout the proceeding; and

FURTHER ORDERED that Sarah B. Whitney is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of the C.F.R.; and

FURTHER ORDERED that Sarah B. Whitney is to be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*, which took effect on May 3, 2013.

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