

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORP., EDWARDS LIFESCIENCES LLC, AND
EDWARDS LIFESCIENCES AG,

Petitioners,

v.

BOSTON SCIENTIFIC SCIMED, INC.,

Patent Owner.

Case IPR2017-00060

Patent 8,992,608

Before the Honorable NEIL T. POWELL, JAMES A. TARTAL, and ROBERT L.
KINDER, *Administrative Patent Judges.*

MOTION FOR *PRO HAC VICE* ADMISSION OF MARC A. COHN

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c), and as authorized in the Patent Trial and Appeal Board's ("Board") Notice of Filing Date Accorded to Petition (Paper 3), Patent Owner Boston Scientific Scimed, Inc. ("Patent Owner") respectfully requests *pro hac vice* admission of Marc A. Cohn as counsel in this proceeding.

II. GOVERNING LAW, RULES, AND PRECEDENT

37 C.F.R. § 42.10(c) states:

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.

(37 C.F.R. § 42.10(c).)

Further, the Board's Notice of Filing Date Accorded to Petition (Paper 3) states that a motion for *pro hac vice* admission under 37 C.F.R. § 42.10(c) "shall be filed in accordance with the 'Order -- Authorizing Motion for *Pro Hac Vice* Admission' in Case IPR2013-00639" ("IPR2013-00639 Order"). (Paper 3 at 2.) IPR2013-00639 Order requires the *pro hac vice* motion to (a) be filed "no sooner than twenty one (21) days after service of the petition," (b) "contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice*

during the proceeding,” and (c) be accompanied by a 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.

(*Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7, at 2-3 (Oct. 15, 2013).)

III. STATEMENT OF MATERIAL FACTS

Based on the following facts and accompanying Declaration of Marc A. Cohn in Support of Motion for *Pro Hac Vice* Admission (Ex. 2009), Patent Owner submits that a showing of good cause has been made and respectfully requests *pro hac vice* admission of Marc A. Cohn as counsel in this proceeding.

1. On October 12, 2016, Petitioners Edwards Lifesciences Corporation, Edwards Lifesciences LLC, and Edwards Lifesciences AG (“Petitioners”) filed and served its Petition for *Inter Partes* Review of U.S. Patent No. 8,992,608 (“Petition”). (Paper 1.)

2. On January 23, 2017, Patent Owner filed and served its Preliminary Response. (Paper 6.)

3. On March 29, 2017, the Board issued its Decision Instituting *Inter Partes* Review. (Paper 7.)

4. Patent Owner’s lead counsel, Jennifer A. Sklenar, is a registered practitioner (Reg. No. 40,205). (Paper 4 at 2.)

5. Patent Owner’s back-up counsel, Wallace Wu, is a registered practitioner (Reg. No. 45,380). (*Id.*)

6. Mr. Cohn is a partner at the law firm of Arnold & Porter Kaye Scholer LLP. (Ex. 2009 at ¶ 1.)

7. Mr. Cohn is an experienced litigation attorney. (*Id.* at ¶ 10.) Mr. Cohn has been practicing law since 2000 and has extensive experience litigating patent infringement cases in United States District Courts and the United States Court of Appeals for the Federal Circuit. (*Id.*)

8. Mr. Cohn has participated in numerous patent infringement cases, wherein he has presented claim construction arguments during *Markman* hearings,

argued motions for summary judgment and motions *in limine*, conducted depositions of expert witnesses regarding validity and infringement, and participated in multiple jury trials. (*Id.*) By virtue of his patent litigation experience, Mr. Cohn is well versed in the law regarding claim construction and obviousness, which are at issue in this proceeding. (*Id.*)

9. Mr. Cohn is a member in good standing of the District of Columbia Bar. (*Id.* at ¶ 2.)

10. Mr. Cohn is also admitted to practice and in good standing in the following United States courts:

- United States Court of Appeals for the First Circuit
- United States Court of Appeals for the Seventh Circuit
- United States Court of Appeals for the Federal Circuit

(*Id.* at ¶ 3.)

11. Mr. Cohn has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶ 4.)

12. Mr. Cohn has never had an application for admission to practice before any court or administrative body denied. (*Id.* at ¶ 5.)

13. No sanctions or contempt citations have ever been imposed against Mr. Cohn by any court or administrative body. (*Id.* at ¶ 6.)

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