

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEPTUNE GENERICS, LLC,
Petitioner,

v.

CORCEPT THERAPEUTICS, INC.,
Patent Owner.

Case IPR2018-01494
Patent 8,921,348 B2

Before ROBERT A. POLLOCK, and DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

ORDER

Conditionally Granting Patent Owner's Motion for *Pro Hac Vice*
Admission of Michelle L. Ernst
37 C.F.R. § 42.10

Corcept Therapeutics Inc. (“Patent Owner”) filed a motion for *pro hac vice* admission of Michelle L. Ernst (“Motion”) (Paper 10), accompanied by a Declaration of Ms. Ernst in support of the Motion (“Declaration”) (Ex. 2008). Petitioner has not opposed the Motion. For the reasons provided below, Patent Owner’s Motion is *conditionally granted*.

Under 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide 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 the proceeding. *See* Paper 4, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

In this proceeding, lead counsel for Patent Owner, Robert Steinberg, a registered practitioner, filed the Motion. Mot. 4. In the Motion, Patent Owner states there is good cause for the Board to recognize Ms. Ernst *pro hac vice* during this proceeding because she is “an experienced and technically-trained litigation attorney with an established familiarity with the subject matter at issue in this proceeding.” *Id.*

In her Declaration, Ms. Ernst attests that she has never been suspended or disbarred by any court or administrative body, has not been denied for admission to practice before any court or administrative body, and has not been sanctioned or cited for contempt by any court or administrative body (Dec. ¶ 3). Ms. Ernst also states that she has read and will comply with the Office Patent Trial Practice Guide and the Board’s rules as set for in 37 C.F.R. § 42, and agrees to be subject to the

USPTO Rules of Professional Conduct and disciplinary jurisdiction under 37 C.F.R. § 11.19(a) (*id.* ¶ 4).

Based on the facts set forth in the Motion and the accompanying Declaration, Patent Owner would have established good cause for *pro hac vice* admission of Ms. Ernst. However, the Declaration of Ms. Ernst has not been properly executed under 37 C.F.R. § 1.68 or under 28 U.S.C. 1746. Although the Declaration states Ms. Ernst has “personal knowledge of the facts set forth in this declaration” (Dec. ¶ 1), 37 C.F.R. § 1.68 requires the “declarant must set forth in the body of the declaration that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.” Nor does the Declaration verify that the declarations are “true under penalty of perjury” under 28 U.S.C. § 1746. Accordingly, Patent Owner’s Motion is *conditionally granted* upon Patent Owner filing a properly executed declaration in accordance with 37 C.F.R. § 1.68 or under 28 U.S.C. § 1746 for Ms. Ernst within ten (10) business days.

We also note that Patent Owner should update its mandatory notices, as required by 37 C.F.R. § 42.8, and update its counsel information in the PTAB E2E filing system. We further note, a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has not been submitted for Ms. Ernst in this proceeding. Therefore, Patent Owner must submit a Power of Attorney within ten (10) business days.

Accordingly, it is

ORDERED that the Patent Owner’s Motion for *pro hac vice* for Michelle L. Ernst is *conditionally granted*;

FURTHER ORDERED that Patent Owner shall submit, before Ms. Ernst takes any actions in this proceeding, a properly executed declaration in accordance with 37 C.F.R. § 1.68 or under 28 U.S.C. § 1746 within ten (10) business days;

FURTHER ORDERED that Patent Owner shall file updated Mandatory Notices in accordance with 37 C.F.R. § 42.8(b)(3), identifying Ms. Ernst as backup counsel;

FURTHER ORDERED that, within ten (10) business days of the issuance of this Order, Patent Owner shall submit a Power of Attorney for Ms. Ernst in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Patent Owner shall continue to have a registered practitioner represent it as lead counsel for this proceeding, but that Ms. Ernst is authorized to represent Patent Owner only as back-up counsel;

FURTHER ORDERED that Ms. Ernst shall comply with the Office Patent Trial Practice Guide, as updated by the Office Patent Trial Practice Guide August 2018 Update, 83 Federal Register 39,989 (Aug. 13, 2018), and the Board's Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R.; and

FURTHER ORDERED that Ms. Ernst is 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.

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