

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUEBIRD BIO, INC.,
Petitioner,

v.

SLOAN KETTERING INSTITUTE FOR CANCER RESEARCH,
Patent Owner.

Case No. IPR2023-00074
Patent No. 8,058,061

**SAN ROCCO THERAPEUTICS LLC'S
MOTION FOR ADMISSION *PRO HAC VICE*
OF JAMES H. MCCONNELL**

Sloan Kettering Institute for Cancer Research (“SKI”) is the owner by assignment of U.S. Patent No. 8,058,061 (“the ’061 Patent”). SKI has granted San Rocco Therapeutics LLC (“SRT”) an exclusive but assignable license to—and for the entire term of—the ’061 Patent, entitling SRT to all substantial rights and “sole responsibility” to defend any challenge to the validity of the ’061 Patent. *See* Paper 5 at 1, Ex. 2001 at 1-3. SKI and SRT have entered into a joint defense agreement in connection with the present IPR proceeding. *See* Paper 5 at 1, Ex. 2005 at 1. Therefore, SRT is responding on behalf of Patent Owner SKI in this proceeding. *See* Paper 5 at 1, Paper 8 at 2.

Pursuant to 37 C.F.R. § 42.10 and the Board’s authorization to file motions for *pro hac vice* admission in Inter Partes Review Case No. IPR2023-00074, (see Paper 3 at 2), SRT requests that the Board admit James H. McConnell *pro hac vice* in this proceeding.

The Board may recognize counsel *pro hac vice* during a proceeding on a showing of good cause. “[W]here lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigation attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c).

Here, lead counsel Lukas D. Toft is a registered practitioner (Reg. No. 75,311), and first backup Joe Chen is also a registered practitioner (Reg. No.

70,066). Both Mr. Toft and Mr. Chen practice in the same firm as Mr. McConnell. Mr. McConnell has years of patent litigation experience, and he is substantially familiar with the subject matter at issue in this proceeding. Accompanying this motion is the Declaration of James H. McConnell, where Mr. McConnell attests to his experience and familiarity. *See generally* McConnell Decl. (Ex. 2046). Specifically, Mr. McConnell attests that:

- He has been practicing law in the field of patent litigation for over 10 years.
- He has been counsel on several patent litigation cases.
- He is a senior member of the team representing SRT, the exclusive licensee of the '061 Patent and U.S. Patent No. 7,541,179 (“the '179 Patent”). SKI granted SRT an exclusive but assignable license to — and for the entire term of — the '179 and '061 Patents, entitling SRT to all substantial rights and the “sole responsibility” to defend any challenge to the validity of the '179 and '061 Patents. SKI and SRT have entered into a joint defense agreement in connection with the following IPR proceedings: IPR2023-00070 ('179 Patent) and IPR2023-00074 ('061 Patent).
- He is also a senior member of the team representing SRT in the following related district court cases: *San Rocco Therapeutics, LLC v.*

bluebird bio, Inc., et al., No. 1-21-cv-01478 (D. Del.); *San Rocco Therapeutics, LLC v. Memorial Sloan-Kettering Cancer Center and Sloan Kettering Institute of Cancer Research*, No. 1-21-cv-08206 (S.D.N.Y.) (pending appearance); and *San Rocco Therapeutics, LLC v. Leschly, et al.*, No. 1:23-cv-10919 (D. Mass) (pending *pro hac vice*).

Good cause exists because (1) the Parties anticipate numerous calls with the Board in which Mr. McConnell may have insight to provide or argument to assert, (2) the Parties have multiple depositions to take across the country, some of which may need two days to take, and (3) SRT anticipates additional discovery or motion practice that would necessitate Mr. McConnell's involvement. Mr. McConnell's involvement in these proceedings ensures the full team representing SRT can appear before the Board. Additionally, this motion and Mr. McConnell's declaration meet the other requirements for *pro hac vice* admission in this matter. Moreover, Petitioner has indicated that it will not oppose this motion. Accordingly, these facts establish good cause to recognize Mr. McConnell in this proceeding. Thus, SRT requests that the Board admit Mr. McConnell *pro hac vice* in this proceeding.

Case IPR2023-00074
Patent 8,058,061

Dated: May 23, 2023

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