

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

**PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION
OF MAX H. YUSEM**

I. INTRODUCTION AND PRECISE RELIEF REQUESTED

Petitioner requests that the Board recognize Max H. Yusem as counsel *pro hac vice* during this proceeding. This motion was authorized in the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response filed on October 25, 2022. (Paper 3.) Because this motion meets all of the Board's requirements, Petitioner requests that the Board grant this motion. Prior to filing this motion, Petitioner conferred with Patent Owner, and Patent Owner indicated that it does not intend to oppose this motion.

II. STATEMENT OF FACTS

Petitioner has been authorized to file motions seeking admission *pro hac vice* under 37 C.F.R. §42.10(c). Petitioner's lead counsel and back-up counsel are registered practitioners. (Paper 1 at 3.) As set forth in the accompanying declaration, Mr. Yusem is an attorney at Paul Hastings LLP. (Ex. 1049 at ¶ 2.) He is an experienced litigating attorney with more than five years of experience and has served as counsel in several patent infringement lawsuits before the district courts. (*Id.*)

Mr. Yusem has an established familiarity with the subject matter at issue in this proceeding. (*Id.* at ¶ 8.) Mr. Yusem has reviewed U.S. Patent No. 8,058,061, the patent-at-issue, and other papers associated with this matter. (*Id.*)

In addition, Mr. Yusem is a member in good standing of the Bar of the State of New York. (*Id.* at ¶ 1.) He has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶ 3.) He has never had an application for admission to practice before any court or administrative body denied. (*Id.* at ¶ 4.) He has never had sanctions or contempt citations imposed by any court or administrative body. (*Id.* at ¶ 5.) He 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 title 37 of the Code of Federal Regulations. (*Id.* at ¶ 6.) He agrees to 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). (*Id.* at ¶ 7.) In the last three years, Mr. Yusem has applied to appear *pro hac vice* in the following proceedings, and not any other proceedings. (*Id.* at ¶ 9.) These applications were granted. (*Id.*)

- *Illumina, Inc. v. Ravgen, Inc.*, IPR2021-01271, IPR2021-01272
- *Berkeley Lights, Inc. v. The Univ. of British Columbia*, IPR2021-01249

III. REASONS FOR GRANTING THE MOTION

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). For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon showing that counsel who is seeking *pro*

hac vice admission is “an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” (*Id.*) The motion for *pro hac vice* admission must contain a statement of facts showing good cause and be accompanied by a declaration of the individual who is seeking admission. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper No. 7 at 3-4 (P.T.A.B. Oct. 15, 2013). The declaration in turn must contain certain attestations. (*Id.*)

This motion and the accompanying declaration meet all of the Board’s requirements. The lead counsel in this proceeding, Naveen Modi, is a registered practitioner. (Paper 1 at 3.) Mr. Yusem is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. (*See Ex. 1049 at ¶¶ 2, 8.*) Mr. Yusem’s declaration makes the necessary attestations. (*Id.* at ¶ 10.)

IV. CONCLUSION

For the foregoing reasons, Petitioner submits that there is good cause for the Board to recognize Mr. Yusem as counsel *pro hac vice* in this proceeding.

Respectfully submitted,

Dated: June 8, 2023

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Petitioner's Motion for *Pro Hac Vice* Admission of Max H. Yusem by electronic means on June 8, 2023:

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