

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.

Petitioner

v.

ALCON RESEARCH, LTD.

Patent Owner

CASE IPR2013-00428

U.S. Patent No. 8,268,299

**AFFIDAVIT IN SUPPORT OF MOTION FOR *PRO HAC VICE* ADMISSION
OF PAULA A. AINSWORTH UNDER 37 C.F.R. § 42.10(c)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Apotex 1017
Apotex v. Alcon
IPR2013-000428

1. I, Paul A. Ainsworth, am more than twenty-one years of age, am competent to present this affidavit, and have personal knowledge of the facts set forth herein.

2. This affidavit is given in support of the Petitioner Apotex Corp.'s Motion for *Pro Hac Vice* Admission.

3. I am a director at the law firm of Sterne, Kessler, Goldstein and Fox P.L.L.C.

4. I have been a patent litigation attorney for more than nine years. I have been litigating patent cases during that entire time period. A significant portion of my work has involved biological and chemical arts, with particular emphasis in pharmaceuticals. I am, therefore, an experienced litigating attorney.

5. I am a member in good standing of the State Bar of Maryland and the Bar of the District of Columbia. I have never been suspended or disbarred from practice before any court or administrative body.

6. No court or administrative body has ever denied my application for admission to practice before it.

7. No court or administrative body has ever imposed sanctions or contempt citations on me.

8. I have 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 the C.F.R.

9. I understand that I will be subject to the Office's 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).

10. I am concurrently seeking *pro hac vice* admission to appear in Petitioner's co-pending related matters against Patent Owner, Case IPR2013-00429¹ and Case IPR2013-00430.² I have applied to appear *pro hac vice* in seven other

¹ Case IPR2013-00429 challenges claims of U.S. Patent No. 8,323,630 ("the '630 patent"), which is in the same patent family as the patent at issue in this proceeding.

² Case IPR2013-00430 challenges claims of U.S. Patent No. 8,388,941 ("the '941 patent"), which concerns the same subject matter as the patent at issue in this proceeding.

proceedings before the Office in the last three (3) years: Case IPR2013-00012, Case IPR2013-00015, Case IPR2013-00214, Case IPR2013-00215, Case IPR2013-00368, Case IPR2013-00371, and Case IPR2013-00372. I was admitted *pro hac vice* in all seven cases.

11. I have an established familiarity with the subject matter at issue in this proceeding. I have read and understand the pleadings submitted by Petitioner and Patent Owner in this proceeding and in Cases IPR2013-00429 and IPR2013-00430. I have engaged in strategic and substantive discussions regarding this proceeding with Eldora L. Ellison, Ph.D., who is the lead counsel for Petitioner in this proceeding and in Case IPR2013-00429 and Case IPR2013-00430. Through my nine years of patent litigation experience, I am very familiar with the legal theories advanced in this case.

12. I have reviewed in detail U.S. Patent No. 8,268,299 ("the '299 patent"), which is the patent challenged in this proceeding. I have also reviewed Exhibits submitted by Petitioner in this proceeding, such as Exhibit 1002 (Declaration of Michael J. Miller, Ph.D.); Exhibit 1003 (Xia *et al.*, WO 2005/097067, "Zinc Preservative Composition and Method of Use"); Exhibit 1004 (Chowhan *et al.*, U.S. Patent No. 6,143,799, "Use of Borate-Polyol Complexes in Ophthalmic Compositions"); Exhibit 1005 (Gadd *et al.*, "Microorganisms and Heavy Metal

Toxicity," *Microbial Ecology*, 4:303-317 (1978)); and Exhibit 1006 (FDA Approved Drug Label "TRAVATAN® (travoprost ophthalmic solution) 0.004% Sterile" (2001)).

13. Through previous litigation involving similar products, I have significant familiarity with ophthalmic formulations such as those claimed by the '299 patent. I served as Petitioner's trial counsel in *Alcon Pharms. Ltd. v. Apotex Inc.*, Case no. 1:12-cv-00960-UNA (D. Delaware), which concerned U.S. Patent Nos. 6,716,830 and 7,671,070 (directed to ophthalmic drug formulations and methods of use). I also represented Petitioner in the *inter partes* review proceedings concerning the same patents: Case IPR2013-00012 and Case IPR2013-00015.

14. Therefore, I have an established familiarity with the subject matter at issue in this proceeding.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.