

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX CORP.
Petitioner

v.

ALCON RESEARCH, LTD
Patent Owner.

Cases IPR2013-00428 (Patent 8,268,299 B2)
IPR2013-00429 (Patent 8,323,630 B2)
IPR2013-00430 (Patent 8,388,941 B2)¹

Before LORA M. GREEN, FRANCISCO C. PRATS, and RAMA G. ELLURU,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECISION

Alcon Research Ltd.'s Motion for *Pro Hac Vice* Admission of
Adam L. Perlman
37 C.F.R. § 42.10

¹ This order addresses issues that are the same in all three cases. We, therefore, exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

Cases IPR2013-00428 (Patent 8,268,299 B2)

IPR2013-00429 (Patent 8,323,630 B2)

IPR2013-00430 (Patent 8,388,941 B2)

Patent Owner, Alcon Research, Ltd. (“Alcon”), filed a motion requesting *pro hac vice* admission of Adam L. Perlman (Papers 13, 11, and 12),² accompanied by the Declaration of Mr. Perlman in support of the motion (Ex. 2001 in each proceeding). The motion is unopposed. For the reasons provided below, Alcon’s motion is *granted*.

As set forth in 37 C.F.R. § 42.10(c), 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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “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). In authorizing motions for *pro hac vice* admission, the Board also requires 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 this proceeding. Paper 4 in each proceeding (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 6 in IPR2013-00010 at 3-4).

In its motion, Alcon asserts that there is a good cause for Mr. Perlman’s *pro hac vice* admission because: (1) Mr. Perlman is an experienced litigating attorney, and (2) Mr. Perlman has familiarity with the subject matter at issue in the instant proceeding, as he is trial counsel to Alcon in various proceedings in which the claims of the ’299, ’630, and ’941 patents are at issue. Papers 13, 11, and 12 at 4.

² All references to the papers refer to the three proceedings in numerical order; *i.e.*, the first paper number refers to the paper number in IPR2013-00428, the second paper number refers to the paper number in IPR2013-00429, and the third paper number refers to the paper number in IPR2013-00430.

Cases IPR2013-00428 (Patent 8,268,299 B2)

IPR2013-00429 (Patent 8,323,630 B2)

IPR2013-00430 (Patent 8,388,941 B2)

In support of the motion, Mr. Perlman attests to these facts in his declaration with sufficient explanations. Ex. 2001. Moreover, Alcon's lead counsel, Stanley E. Fisher, is a registered practitioner. Papers 13, 11, and 12 at 4.

Based on the facts set forth above, we conclude that Mr. Perlman has sufficient legal and technical qualifications to represent Alcon in this proceeding and that there is a need for Alcon to have its trial counsel involved in these proceedings. *See* IPR2013-00639, Paper 7, dated October 15, 2013 (superseding IPR2013-00010, Paper 6, dated October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under "Representative Orders, Decisions, and Notices"). Accordingly, Alcon has established good cause for Mr. Perlman's *pro hac vice* admission. Mr. Perlman will be permitted to appear *pro hac vice* in the instant proceeding as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Alcon's motion for *pro hac vice* admission of Mr. Perlman for the instant proceeding is granted; Mr. Perlman is authorized to represent Alcon as back-up counsel in the instant proceedings;

FURTHER ORDERED that Alcon is to continue to have a registered practitioner as lead counsel in the instant proceedings;

FURTHER ORDERED that Mr. Perlman is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

Cases IPR2013-00428 (Patent 8,268,299 B2)

IPR2013-00429 (Patent 8,323,630 B2)

IPR2013-00430 (Patent 8,388,941 B2)

FURTHER ORDERED that Mr. Perlman is to be 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.*

For PETITIONER:

Eldora L. Ellison

Ralph W. Powers, II

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

eellison-PTAB@skgf.com

tpowers-PTAB@skgf.com

For PATENT OWNER:

Stanley E. Fisher

WILLIAMS & CONNOLLY LLP

sfisher@wc.com