

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APOTEX CORP.,  
Petitioner

v.

ALCON RESEARCH, LTD.,  
Patent Owner.

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Case IPR2013-00428  
U.S. Patent No. 8,268,299 B2

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**ALCON RESEARCH, LTD.'S MOTION FOR  
*PRO HAC VICE* ADMISSION OF CHRISTOPHER J. MANDERNACH  
PURSUANT TO 37 C.F.R. § 42.10(c)**

## I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c), the Board's Notice of Filing Date Accorded to Petition and Time for Filing Patent Order Preliminary Response (Paper 4, dated July 10, 2013) (hereinafter "Authorizing Order"), and the Board's "Order—Authorizing Motion for *Pro Hac Vice* Admission" in Case IPR2013-00639 (hereinafter "*Unified Patents* Order"), Patent Owner Alcon Research, Ltd. ("Alcon") respectfully requests *pro hac vice* admission of Christopher J. Mandernach in this proceeding. Petitioner Apotex Corp. does not object to the relief requested herein.

## II. GOVERNING LAW, RULES, AND PRECEDENT

The Board is authorized to recognize counsel *pro hac vice* pursuant to 37 C.F.R. § 42.10(c), which provides that:

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. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

The Authorizing Order requires that any motion for *pro hac vice* admission be filed in accordance with the "Order – Authorizing Motion for *Pro Hac Vice*

Admission” in Case IPR 2013-00010 (MPT) (“Prior Order”). *See* Authorizing Order at 2. However, the Prior Order was issued prior to publication of the Final Rule adopting new Rules of Professional Conduct. *See Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule*, 78 Fed. Reg. 20,180 (Apr. 3, 2013); *see also Unified Patents* Order at 2. The Final Rule removes part 10 of title 37, Code of Federal Regulations (C.F.R.), referred to in the Prior Order. *See Unified Patents* Order at 2. As a result, the Board has determined that its *Unified Patents* Order “updates and supersedes” the Prior Order. *Unified Patents* Order at 2. Accordingly, Alcon assumes that the Board wishes counsel to follow as a representative order the *Unified Patents* Order and has done so in this motion.

The *Unified Patents* Order requires that a *pro hac vice* motion “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding.” *Unified Patents* Order at 3. A motion for *pro hac vice* admission should also be accompanied by an affidavit or declaration of the individuals seeking to appear attesting to the following:

- i. Membership in good standing of the Bar of at least one State or the District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;

- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear 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 37 C.F.R.;
- vi. The individual will 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);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

*Unified Patents* Order at 3–4.

In its Authorizing Order, the Board gave Alcon permission to file motions for *pro hac vice* admission. (See Paper 4 at 2.) Pursuant to that Order, Alcon hereby files a motion for *pro hac vice* admission of Christopher J. Mandernach.

### III. STATEMENT OF FACTS

Based on the following facts, and supported by the Declaration of Mr. Mandernach (AL 2075) submitted herewith, Alcon requests the *pro hac vice* admission of Christopher J. Mandernach in this proceeding:

1. Alcon's lead counsel, Stanley E. Fisher, and back-up counsel, David M. Krinsky and Barry L. Copeland, are registered practitioners (Fisher, Reg. No. 55,820); (Copeland, Reg. No. 34,801); (Krinsky, Reg. No. 72,339).
2. Mr. Mandernach has established familiarity with the subject matter at issue in this proceeding. As detailed below, Mr. Mandernach is trial counsel to Alcon in various related proceedings in which the claims of the '299 patent are at issue. (AL 2075 ¶ 10.) Mr. Mandernach has worked directly with Alcon's expert witnesses on the matters at issue in this proceeding. (*Id.*)
3. Mr. Mandernach is a member in good standing of the bars of the State of Minnesota and the District of Columbia. (AL 2075 ¶ 3.)
4. Mr. Mandernach has never been suspended or disbarred from practice before any court or administrative body. (AL 2075 ¶ 4.)
5. No court or administrative body has ever denied Mr. Mandernach's application for admission to practice before it. (AL 2075 ¶ 5.)

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