

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC
Petitioner

v.

CEPHALON, INC.
Patent Owner

Case IPR2016-00111
Patent No. 8,895,756

***PRO HAC VICE* MOTION TO ADMIT
AARON STIEFEL PURSUANT TO 37 C.F.R. § 42.10(c)**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.10(c), Patent Owner, Cephalon, Inc. (“Cephalon”), hereby files this motion for Aaron Stiefel to appear *pro hac vice* on its behalf before the Patent Trial and Appeal Board in this proceeding. This motion is being filed with the Board’s authorization (see Paper 3) and in accordance with the Board’s order in IPR2013-00639 (Paper 7) (setting forth the requirements for *pro hac vice* admission).

I. STATEMENT OF FACTS

The following facts along with the attached Declaration of Aaron Stiefel (“Stiefel Decl.”) support admission of Mr. Stiefel *pro hac vice* in this proceeding:

1. Lead counsel Soumitra (Sam) Deka is a registered attorney (Reg. No. 70,252) and is experienced in *inter partes* proceedings in the USPTO.
2. Aaron Stiefel is an experienced litigation attorney. Mr. Stiefel has been a litigator for more than 30 years and has been a litigator of patent cases for more than 20 years. He is a partner at the firm of Kaye Scholer LLP. (Ex. 2001, Stiefel Decl. ¶ 2). Mr. Stiefel has litigated numerous pharmaceutical-related patent cases, and has regularly been counsel of record in patent cases during this time. (*Id.* ¶ 2). Mr. Stiefel is a member in good standing of the New York and New Jersey State Bars, and is admitted to practice in the United States Supreme Court, the United States Courts of Appeals for the Federal, Second and Third Circuits, and

the United States District Courts for the Southern and Eastern Districts of New York, the Northern District of California and the District of New Jersey, with no suspensions or disbarments from practice before any court or administrative body, nor any application for admission to practice before any court or administrative body ever denied. (*Id.* ¶¶ 1, 3, 4). Mr. Stiefel has never had any sanctions or contempt citations imposed against him by any court or administrative body. (*Id.* ¶ 5).

3. Mr. Stiefel has significant familiarity with the subject matter at issue in this proceeding based on his work as lead counsel in the pending district court case *Cephalon, Inc. v. Fresenius Kabi USA, LLC*, 1:15-cv-00536-LPS (D. Del.), which involves bendamustine, the same active pharmaceutical ingredient that is at issue in this proceeding. (*Id.* ¶¶ 9, 10). Mr. Stiefel has been actively involved in all aspects of this pending district court case, including regarding the validity of the patent-in-suit, and accordingly, has gained substantive knowledge of the patent-at-issue in this proceeding, its prosecution, and the cited prior art. (*Id.* ¶ 11). Mr. Stiefel also has substantive knowledge of the patent-at-issue in this proceeding by virtue of his preparation for this proceeding as well as two proceedings before the Office (IPR2016-00026 and IPR2016-00098) that involve the same active ingredient. (*Id.* ¶ 11).

4. Mr. Stiefel has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in 37 C.F.R. § 42, and he agrees to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a). (*Id.* ¶¶ 6, 7).

5. Mr. Stiefel has not applied to appear *pro hac vice* in any other proceedings before the Office in the last three (3) years. (*Id.* ¶ 8). As noted above, Mr. Stiefel is concurrently applying to appear *pro hac vice* in IPR2016-00026 and IPR2016-00098.

II. 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). 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 (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.

As set forth above, the lead counsel in this proceeding, Soumitra (Sam) Deka, is a registered practitioner. Mr. Stiefel is an experienced patent litigation attorney and has an established familiarity with the subject matter at issue in the proceeding. (*See Exhibit 2001 at ¶¶ 9-11.*) Mr. Stiefel is lead counsel in the pending district court case *Cephalon, Inc. v. Fresenius Kabi USA, LLC*, 1:15-cv-00536-LPS (D. Del.), which involves bendamustine, the same active pharmaceutical ingredient that is at issue in this proceeding. (*Id.* ¶¶ 9, 10). Mr. Stiefel has been actively involved in all aspects of this pending district court case, including the validity of the patent-in-suit, and accordingly, has gained substantive knowledge of the patent-at-issue in this proceeding, its prosecution, and the cited prior art. (*Id.* ¶ 11). In his declaration, Mr. Stiefel makes the necessary attestations. His admission *pro hac vice* will enable the Patent Owner to avoid unnecessary expense and duplication of work between this proceeding, other related IPR proceedings, and the co-pending litigation.

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DECLARATION OF AARON STIEFEL

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P.O. Box 1450
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I, Aaron Stiefel, do hereby declare as follows:

1. I am a member in good standing of the New York and New Jersey State Bars, and I am admitted to practice in the United States Supreme Court, the United States Courts of Appeals for the Federal, Second and Third Circuits, and the United States District Courts for the Southern and Eastern Districts of New York, the Northern District of California and the District of New Jersey,

2. I am a partner at the firm of Kaye Scholer LLP. I have been a litigator for more than 30 years, and I have handled patent litigations for more than 20. I have litigated numerous pharmaceutical-related patent cases and have regularly been counsel of record in patent cases during this time.

3. I have never been suspended or disbarred from practice before any court or administrative body.

4. I have never had an application to practice before any court or administrative body denied.

5. I have had no sanctions or concept citations imposed against me by any court or administrative body.

6. 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 37 C.F.R. § 42.

7. I agree to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

8. I have not applied to appear *pro hac vice* in any other proceedings before the Office in the last three (3) years. I am concurrently applying to appear *pro hac vice* in IPR2016-00026 and IPR2016-00098.

9. I have significant familiarity with the subject matter at issue in this proceeding and, in particular, with bendamustine, the active pharmaceutical ingredient that is the subject matter of the patent-at-issue in this proceeding.

10. I am currently lead counsel in the pending district court case *Cephalon, Inc. v. Fresenius Kabi USA, LLC*, 1:15-cv-00536-LPS (D. Del.), which involves the same active ingredient at issue in this proceeding.

11. As lead counsel, I am actively involved in all aspects of this pending district court case, including the validity of the patent-in-suit, and accordingly, I have substantive knowledge of the patent-at-issue in this proceeding, its prosecution, and the cited prior art. I also have substantive knowledge of the patent-at-issue in this proceeding by virtue of my preparation for this proceeding as well as two proceedings before the Office (IPR2016-00026 and IPR2016-00098) that involve the same active ingredient.

12. I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true. I understand that willful false statements are punishable by fine or imprisonment or both. *See* 18 U.S.C. § 1001.

Dated: November 24, 2015

By: 

