

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN LABORATORIES LIMITED,  
Petitioner

v.

AVENTIS PHARMA S.A.,  
Patent Owner.

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Case IPR2016-00712  
Patent 8,927,592 B2

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Before BRIAN P. MURPHY, TINA E. HULSE, and  
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION  
Patent Owner's Motion for *Pro Hac Vice* Admission of  
Joshua I. Rothman  
*37 C.F.R. § 42.10*

On February 1, 2017, Patent Owner filed a motion for *pro hac vice* admission of Joshua I. Rothman. Paper 29 (“Motion” or “Mot.”). A “Declaration In Support Of Patent Owner’s Motion For *Pro Hac Vice* Admission Of Joshua I. Rothman Under 37 C.F.R. § 42.10” was submitted with the Motion. Ex. 2254 (“Declaration”). Petitioner does not oppose the Motion. Mot. 1. We note that a Power of Attorney in accordance with 37 C.F.R. § 42.10(b) has not been submitted for Mr. Rothman. Patent Owner provides Power of Attorney for all Practitioners associated with Customer Number 05514. Paper 5. Mr. Rothman, however, is not associated with Customer Number 05514. In view of the above, Patent Owner’s motion is *conditionally granted*, and is to be effective after the aforementioned item is corrected.

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel is a registered practitioner. 37 C.F.R. § 42.10(c). If 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.” *Id.* In authorizing motions for *pro hac vice* admission, the Board requires a statement of facts showing there is good cause to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear in this proceeding. *See* Paper 4, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

In this proceeding, lead counsel for Patent Owner is Mr. Dominick A. Conde, a registered practitioner. Motion 3. In the Motion, Patent Owner asserts there is good cause for Mr. Rothman to be admitted *pro hac vice* because: (1) Mr. Rothman is an experienced litigation attorney who has litigated patent cases in federal district courts and the Federal Circuit; (2) Mr. Rothman has an established familiarity with the relevant technology and U.S. Patent 8,927,592; and (3) Mr. Rothman has served as counsel for Patent Owner in several co-pending lawsuits in which U.S. Patent 8,927,592 was asserted. *Id.* at 4–6. In the Declaration, Mr. Rothman attests that he is a member in good standing of the bar of the State of New York.

Declaration ¶ 5. Mr. Rothman attests that he has never been suspended, disbarred, sanctioned, or cited for contempt by any court or administrative body, and that he has never had an application for admission to practice denied anywhere. *Id.* ¶¶ 5–7. Mr. Rothman attests that he is familiar with the subject matter at issue in this proceeding based on his work as counsel in the several related lawsuits referenced above. *Id.* ¶¶ 11–12.

Mr. Rothman further states (1) that he has read and will comply with the Board’s Rules of Practice for Trials as set forth in Part 42 of Title 37, Code of Federal Regulations, as well as the Office Patent Trial Practice Guide, and (2) that he agrees to be subject to the USPTO Code of Professional Responsibility as set forth in 37 C.F.R. §§ 11.101 *et seq.*, and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶¶ 8–9.

Notwithstanding the aforementioned absence of a Power of Attorney, Patent Owner has established good cause for admission of Mr. Rothman, *pro*

*hac vice*. Mr. Rothman will be permitted to appear *pro hac vice* in this proceeding as back-up counsel only. 37 C.F.R. § 42.10(c).

It is

ORDERED that Patent Owner's Motion for *pro hac vice* admission of Joshua I. Rothman is *conditionally granted* provided that within seven (7) calendar days of the date of this order, Patent Owner shall submit a Power of Attorney, in accordance with 37 C.F.R. § 42.10(b), appointing Mr. Rothman as backup counsel for Patent Owner;

FURTHER ORDERED that Patent Owner shall continue to have a registered practitioner represent it as lead counsel for the instant proceeding;

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

FURTHER ORDERED that Mr. Rothman is 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.*

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