

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN LABORATORIES LIMITED,
Petitioner,

v.

AVENTIS PHARMA S.A.,
Patent Owner.

Case IPR2016-00712
Patent 8,927,592 B2

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
William E. Solander
37 C.F.R. § 42.10

On February 23, 2017, Patent Owner filed a motion for *pro hac vice* admission of William E. Solander. Paper 38 (“Motion” or “Mot.”). A “Declaration In Support Of Patent Owner’s Motion For *Pro Hac Vice* Admission Of William E. Solander Under 37 C.F.R. § 42.10” was submitted with the Motion. Ex. 2255 (“Declaration”). Petitioner does not oppose the Motion. Mot. 1. For the reasons discussed below, Patent Owner’s Motion is *granted*.

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. Mot. 3. In the Motion, Patent Owner asserts there is good cause for Mr. Solander to be admitted *pro hac vice* because: (1) Mr. Solander is an experienced litigation attorney who has litigated patent cases in District Courts across the country and the Federal

Circuit; (2) Mr. Solander has an established familiarity with the relevant technology and U.S. Patent No. 8,927,592; and (3) Mr. Solander has served as counsel for Patent Owner in several lawsuits in which U.S. Patent No. 8,927,592 was asserted. *Id.* at 4–6. In the Declaration, Mr. Solander attests that he is a member in good standing of the bar of the State of New York. Declaration ¶ 5. Mr. Solander 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. Solander 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.* ¶¶ 11–13.

Mr. Solander 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.

Patent Owner has established good cause for admission of Mr. Solander, *pro hac vice*. Mr. Solander 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 William E. Solander is *granted*; Mr. Solander is authorized to act as back-up counsel in the instant proceedings only;

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. Solander 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. Solander 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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