

Paper No. ____
Date Filed: Nov, 28, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOCKHARDT BIO AG,
Petitioner,

v.

JANSSEN ONCOLOGY, INC.,
Patent Owner.

Case IPR2016-01582
Patent 8,822,438

**JANSSEN ONCOLOGY, INC.'S MOTION FOR *PRO HAC VICE*
ADMISSION OF BINDU DONOVAN**

Pursuant to 37 C.F.R. § 42.10(c) and the Board's August 16, 2016 Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 5), Patent Owner Janssen Oncology, Inc. ("Janssen") respectfully requests the *pro hac vice* admission of attorney Bindu Donovan in this proceeding. Patent Owner has conferred with counsel for Wockhardt Bio AG. ("Petitioner"), and Petitioner does not oppose this motion.

I. Statement of Facts Showing Good Cause for the Board to Recognize Bindu Donovan *Pro Hac Vice* in this Proceeding

The Board may recognize counsel *pro hac vice* during an *inter partes* review 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). 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." *Id.*

As set forth below and in the accompanying Declaration of Bindu Donovan in Support of Motion to Appear *Pro Hac Vice* ("Donovan Decl.," Exhibit 2009), the facts here establish good cause for the Board to recognize Bindu Donovan *pro hac vice* in this proceeding.

1. Lead Counsel, Dianne Elderkin, is a registered practitioner (Reg. No. 28,598).
2. Ms. Donovan is a member in good standing of the State Bar of New York (Bar No. 2977981). *See Exhibit 2009, ¶ 2.*
3. Ms. Donovan has never been suspended or disbarred from practice before any court or administrative body. *See Exhibit 2009, ¶ 3.*
4. None of Ms. Donovan's applications for admission to practice before any court or administrative body have ever been denied. *See Exhibit 2009, ¶ 4.*
5. Ms. Donovan has not been sanctioned nor has she had a contempt citation imposed on her by any court or administrative body. *See Exhibit 2009, ¶ 5.*
6. Ms. Donovan has declared that she has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trial set forth in part 42 of 37 C.F.R. *See Exhibit 2009, ¶ 6.*
7. Ms. Donovan has acknowledged and agrees that she 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). *See Exhibit 2009, ¶ 7.*
8. Ms. Donovan has applied to appear *pro hac vice* before the Patent Trial and Appeal Board twice in the last three years. Ms. Donovan was granted *pro hac vice* admission by the Board in IPR2016-00286 and IPR2016-01332, which is

directed to the same patent that is at issue in the instant proceeding. *See* Exhibit 2009, ¶ 8.

9. Ms. Donovan has been a practicing attorney for over 15 years and has been involved in numerous patent cases. She is presently counsel for Janssen in pending patent litigations involving the patent under review in this proceeding, U.S. Patent No. 8,822,438 (the “’438 patent”). These cases are captioned *BTG Int’l Ltd., et al. v. Actavis Labs. FL, Inc., et al.*, C.A. No. 2:15-cv-05909-KM-JBC (D.N.J.), *Janssen Biotech, Inc., et al. v. Mylan Pharm. Inc., et al.*, C.A. No. 1:15-cv-00130-IMK (N.D. W. Va.), *BTG Int’l Ltd., et al. v. Amerigen Pharms., Inc., et al.*, C.A. No. 2:16-cv-02449-KM-JBC (D.N.J.) (consolidated with C.A. No. 2:15-cv-05909-KM-JBC (D.N.J.)), and *BTG Int’l Ltd., et al. v. Glenmark Pharms., Inc., USA et al.*, C.A. No. 2:16-cv-03743-KM-JBC (D.N.J.). As part of these litigations, Ms. Donovan has studied and analyzed the ’438 patent and has become very familiar with its subject matter. She is also familiar with prior art asserted in this IPR proceeding, conception and reduction to practice of the inventions claimed in the ’438 patent, and claim construction of various claim terms. *See* Exhibit 2009, ¶ 9.

In view of Ms. Donovan’s knowledge of the subject matter at issue in this proceeding, and in view of the interrelatedness of this proceeding and the four district court litigations mentioned above, Janssen has a substantial need for Ms.

Donovan's *pro hac vice* admission and her involvement in the continued prosecution of this proceeding. In addition, *pro hac vice* admission of Ms. Donovan will enable Janssen to avoid unnecessary expense and duplication of work between this proceeding and the related district court litigations. *See* 77 Fed. Reg. 48,612, 48,661 (Aug. 14, 2012) (Office's comment on final rule discussing concerns about efficiency and costs where an entity has already engaged counsel for parallel district court litigation).

II. Conclusion

For the foregoing reasons, Patent Owner Janssen respectfully requests that the Board admit Bindu Donovan *pro hac vice* in this proceeding.

Respectfully submitted,

Date: Nov. 28, 2016

/Dianne B. Elderkin/
Dianne B. Elderkin
Registration No. 28,598
Counsel for Patent Owner

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