

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTAVIS LLC,
Petitioner,

v.

ABRAXIS BIOSCIENCE LLC,
Patent Owner.

Case IPR2017-01101, Patent 7,820,788 B2
Case IPR2017-01103, Patent 7,923,536 B2, and
Case IPR2017-01104, Patent 8,138,229 B2

Before JEFFREY N. FREDMAN, RAMA G. ELLURU, and SUSAN L. C.
MITCHELL, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

ORDER

Petitioner's Motions for Admission *Pro Hac Vice* of
George C. Lombardi, Charles B. Klein, Kevin E. Warner, and Eimeric
Reig-Plessis
37 C.F.R. § 42.10

Petitioner, Actavis LLC ("Actavis"), filed four Motions for Admission *Pro Hac Vice* of George C. Lombardi, Charles B. Klein, Kevin E. Warner, and Eimeric

IPR2017-01101 (Patent 7,820,788 B2)

IPR2017-01103 (Patent 7,923,536 B2)

IPR2017-01104 (Patent 8,138,229 B2)

Reig-Plessis pursuant to 37 C.F.R. § 42.10(c) in IPR2017-01101 (“Mot.,” Paper 11), IPR2017-01103 (IPR2017-01103, Paper 11), and IPR2017-01104 (IPR2017-01104, Paper 11), accompanied by Declarations of George C. Lombardi, Charles B. Klein, Kevin E. Warner, and Eimeric Reig-Plessis in support of the Motions (Ex. 1027–1030). Petitioner attests that Patent Owner does not oppose the motion. Paper 11, 1.

For the reasons provided below, Petitioner’s Motion is *granted*.

Pursuant to 37 C.F.R. § 42.10(c), 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. In its notice authorizing motions for *pro hac vice* admission, the Board requires a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding.

In this proceeding, lead counsel for Petitioner, Mr. Samuel S. Park, is a registered practitioner. Paper 11. Petitioner’s motions indicate that there is good cause for the Board to recognize each of George C. Lombardi, Charles B. Klein, Kevin E. Warner, and Eimeric Reig-Plessis (Mot. 2–11), and is supported by their declarations. Ex. 1027–1030.

Mr. Lombardi

Mr. Lombardi declares that he has extensive experience litigating patent cases. Ex. 1027 ¶ 8. Mr. Lombardi also declares that he has established familiarity with the subject matter at issue in the instant proceedings, as he served “as trial counsel for Petitioner in patent litigation against Patent Owner concerning the

IPR2017-01101 (Patent 7,820,788 B2)

IPR2017-01103 (Patent 7,923,536 B2)

IPR2017-01104 (Patent 8,138,229 B2)

patent challenged by the Petition.” *Id.* Mr. Lombardi further declares “I have obtained substantial familiarity with the involved patent, the prior art, and the various issues raised in this proceeding.” *Id.* Additionally, Mr. Lombardi’s declaration complies with the requirements set forth in the Board’s order authorizing motions for *pro hac vice* admission. *Id.* ¶¶ 1–8.

On this record, we determine that Petitioner has demonstrated that Mr. Lombardi has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. We further recognize that there is a need for Petitioner to have its counsel in the related district court litigation involved in this proceeding. *See* Mot. 3–4.

For the foregoing reasons, Petitioner has established that there is good cause for Mr. Lombardi’s *pro hac vice* admission in these proceedings. Mr. Lombardi will be permitted to appear *pro hac vice* in these proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Mr. Klein

Mr. Klein declares that he has extensive experience litigating patent cases. Ex. 1028 ¶ 8. Mr. Klein also declares that he has established familiarity with the subject matter at issue in the instant proceeding, as he served “as trial counsel for Petitioner in patent litigation against Patent Owner concerning the patent challenged by the Petition.” *Id.* Mr. Klein further declares “I have obtained substantial familiarity with the involved patent, the prior art, and the various issues raised in this proceeding.” *Id.* Additionally, Mr. Klein’s declaration complies with

IPR2017-01101 (Patent 7,820,788 B2)

IPR2017-01103 (Patent 7,923,536 B2)

IPR2017-01104 (Patent 8,138,229 B2)

the requirements set forth in the Board's order authorizing motions for *pro hac vice* admission. *Id.* ¶¶ 1–8.

On this record, we determine that Petitioner has demonstrated that Mr. Klein has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. We further recognize that there is a need for Petitioner to have its counsel in the related district court litigation involved in this proceeding. *See* Mot. 5–7.

For the foregoing reasons, Petitioner has established that there is good cause for Mr. Klein's *pro hac vice* admission in these proceedings. Mr. Klein will be permitted to appear *pro hac vice* in these proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Mr. Warner

Mr. Warner declares that he has extensive experience litigating patent cases. Ex. 1029 ¶ 8. Mr. Warner also declares that he has established familiarity with the subject matter at issue in the instant proceeding, as he served “as trial counsel for Petitioner in patent litigation against Patent Owner concerning the patent challenged by the Petition.” *Id.* Mr. Warner further declares “I have obtained substantial familiarity with the involved patent, the prior art, and the various issues raised in this proceeding.” *Id.* Additionally, Mr. Warner's declaration complies with the requirements set forth in the Board's order authorizing motions for *pro hac vice* admission. *Id.* ¶¶ 1–8.

On this record, we determine that Petitioner has demonstrated that Mr. Warner has sufficient legal and technical qualifications to represent Petitioner in

IPR2017-01101 (Patent 7,820,788 B2)

IPR2017-01103 (Patent 7,923,536 B2)

IPR2017-01104 (Patent 8,138,229 B2)

the instant proceeding. We further recognize that there is a need for Petitioner to have its counsel in the related district court litigation involved in this proceeding. *See* Mot. 7–9.

For the foregoing reasons, Petitioner has established that there is good cause for Mr. Warner’s *pro hac vice* admission in these proceedings. Mr. Warner will be permitted to appear *pro hac vice* in these proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Mr. Reig-Plessis

Mr. Reig-Plessis declares that he has extensive experience litigating patent cases. Ex. 1030 ¶ 8. Mr. Reig-Plessis also declares that he has established familiarity with the subject matter at issue in the instant proceeding, as he served “as trial counsel for Petitioner in patent litigation against Patent Owner concerning the patent challenged by the Petition.” *Id.* Mr. Reig-Plessis further declares “I have obtained substantial familiarity with the involved patent, the prior art, and the various issues raised in this proceeding.” *Id.* Additionally, Mr. Reig-Plessis’s declaration complies with the requirements set forth in the Board’s order authorizing motions for *pro hac vice* admission. *Id.* ¶¶ 1–8.

On this record, we determine that Petitioner has demonstrated that Mr. Reig-Plessis has sufficient legal and technical qualifications to represent Petitioner in the instant proceeding. We further recognize that there is a need for Petitioner to have its counsel in the related district court litigation involved in this proceeding. *See* Mot. 9–11.

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