

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

Patent Owner's Motion for Admission *Pro Hac Vice* of
Andrew S. Chalson and Daniel C. Wiesner
37 C.F.R. § 42.10

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

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

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

Patent Owner, Abraxis Bioscience LLC (“Abraxis”), filed Motions (collectively referred to as “Mot.”) for Admission Pro Hac Vice of Andrew S. Chalson and Daniel C. Wiesner pursuant to 37 C.F.R. § 42.10(c) in IPR2017-01101 (IPR2017-01101, Paper 15), IPR2017-01103 (IPR2017-01103, Paper 15), and IPR2017-01104 (IPR2017-01104, Paper 15), accompanied by Declarations of Andrew S. Chalson and Daniel C. Wiesner (Ex. 2064–2065)¹. Patent Owner attests that Petitioner does not oppose the motion. Paper 15, 2.

For the reasons provided below, Patent Owner’s Motions are *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 Patent Owner, Mr. J. Patrick Elsevier, is a registered practitioner. Paper 15. Patent Owner’s motions indicate that there is good cause for the Board to recognize Andrew S. Chalson and Daniel C. Wiesner (Mot. 2–11), and is supported by the declarations. Ex. 2064–2065.

Mr. Chalson

¹ Unless otherwise specified, paper and exhibit numbers are to CASE IPR2017-01101.

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

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

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

Mr. Chalson declares that he has experience litigating patent cases.

Ex. 2064 ¶ 7. Mr. Chalson also declares that he has established familiarity with the subject matter at issue in the instant proceedings, as he served as “trial counsel for Abraxis in the patent litigation against Actavis concerning the patent challenged in the petition.” *Id.* Mr. Chalson further declares “I have had experience representing Abraxis with respect to the subject matter at issue in this *inter partes* review, including the specific patent and prior art at issue.” *Id.* Additionally, Mr. Chalson’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 Patent Owner has demonstrated that Mr. Chalson has sufficient legal and technical qualifications to represent Patent Owner in the instant proceedings. We further recognize that there is a need for Patent Owner to have its counsel in the related district court litigation involved in these proceedings. *See* Mot. 1–2.

For the foregoing reasons, Patent Owner has established that there is good cause for Mr. Chalson’s *pro hac vice* admission in these proceedings. Mr. Chalson 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. Wiesner

Mr. Wiesner declares that he has established familiarity with the subject matter at issue in the instant proceedings, as he served as “trial counsel for Abraxis in the patent litigation against Actavis concerning the patent challenged in the petition.” Ex. 2064 ¶ 8. Mr. Wiesner further declares “I have had experience

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

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

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

representing Abraxis with respect to the subject matter at issue in this *inter partes* review, including the specific patent and prior art at issue.” *Id.* Additionally, Mr. Wiesner’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 Patent Owner has demonstrated that Mr. Wiesner has sufficient legal and technical qualifications to represent Patent Owner in the instant proceedings. We further recognize that there is a need for Patent Owner to have its counsel in the related district court litigation involved in these proceedings. *See* Mot. 2–3.

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

It is

ORDERED that Patent Owner’s motions for *pro hac vice* admission of Mr. Chalson and Mr. Wiesner are *granted*; Mr. Chalson and Mr. Wiesner are authorized to represent Patent Owner only as back-up counsel in the instant proceedings, IPR2017-01101, IPR 2017-01103, and IPR2017-01104;

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

FURTHER ORDERED that Mr. Chalson and Mr. Wiesner are to 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

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

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

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

FURTHER ORDERED that Mr. Chalson and Mr. Wiesner are to be 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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