

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMNEAL PHARMACEUTICALS LLC,
Petitioner,

v.

ALKERMES PHARMA IRELAND LIMITED,
Patent Owner.

Case IPR2018-00943
Patent 7,919,499 B2

Before CHRISTOPHER M. KAISER, JACQUELINE T. HARLOW, and
KRISTIL R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for *Pro Hac Vice*
Admission of Joseph M. O'Malley, Jr.
37 C.F.R. § 42.10

On January 17, 2019, Patent Owner filed a motion for *pro hac vice* admission of Joseph M. O’Malley, Jr. Paper 12 (“Motion”). Patent Owner submitted an affidavit from Mr. O’Malley in support of the Motion. Ex. 2022. Upon review of the record before us, and for the reasons set forth below, Patent Owner’s Motion is *granted*.

In accordance with 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide 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 the 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”)).

Based on the facts set forth in the Motion and the accompanying declaration, we conclude that Mr. O’Malley has sufficient legal and technical qualifications to represent Patent Owner in this proceeding, that Mr. O’Malley has demonstrated sufficient familiarity with the subject matter of this proceeding, and that there is a need for Patent Owner to be represented by counsel with litigation experience. *See* Motion 1–3; Ex. 2022 ¶¶ 2, 8–9. Mr. O’Malley has also attested that (1) 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 and the Office Patent Trial Practice Guide, and that (2) he agrees to 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). *Id.* ¶¶ 6–7.

Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. O’Malley. Mr. O’Malley will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Accordingly, it is hereby:

ORDERED that Patent Owner’s Motion for *pro hac vice* admission of Joseph M. O’Malley, Jr. (Paper 12) is *granted*, and Mr. O’Malley is authorized to act as back-up counsel in the instant proceeding only;

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

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

FURTHER ORDERED that Mr. O’Malley is subject to the USPTO Rules of Professional Conduct as set forth in 37 C.F.R. §§ 11.101 *et seq.* and the USPTO’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a); and

FURTHER ORDERED that Patent Owner shall submit a power of attorney in accordance with 37 C.F.R. § 42.10(b) for Mr. O’Malley, update its mandatory notices, as required by 37 C.F.R. § 42.8, and update its counsel information in the PTAB E2E filing system.

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