

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
Petitioner,

v.

MERCK SHARP & DOHME CORP.,
Patent Owner.

IPR2020-00040
Patent 7,326,708 B2

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

ORDER

Conditionally Granting Patent Owner's Motions for *Pro Hac Vice*
Admission of Alexander S. Zolan and Elise M. Baumgarten
37 C.F.R. § 42.10(c)

On May 18, 2020, Patent Owner filed Motions for *pro hac vice* admission of Alexander S. Zolan and Elise M. Baumgarten. Papers 22 and 23 (“Motions”). The Motions are accompanied by the Declarations of Mr. Zolan and Ms. Baumgarten (“Declarations”). Exs. 2025 ad 2026. Patent Owner asserts that Petitioner does not oppose the Motions. Paper 22 at 6; Paper 23 at 5.

Upon review of the record before us, we note that Patent Owner’s Mandatory Notices (Paper 7) do not identify Mr. Zolan or Ms. Baumgarten as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3). We also note that Patent Owner’s Power of Attorney (Paper 6) does not identify Mr. Zolan or Ms. Baumgarten as back-up counsel in accordance with 37 C.F.R. § 42.10(b).

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 this proceeding. *See* Paper 3, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Zolan and Ms. Baumgarten have sufficient legal and technical qualifications to represent Patent Owner in this proceeding, that Mr. Zolan and Ms. Baumgarten have demonstrated sufficient familiarity with the subject matter of this proceeding, and that Patent Owner’s desire to include counsel from the corresponding district

court proceeding is warranted. *See* Motions 5; Declarations ¶¶ 2, 10. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Mr. Zolan and Ms. Baumgarten.

Accordingly, it is:

ORDERED that Patent Owner's Motions for *pro hac vice* admission of Mr. Alexander S. Zolan and Ms. Elise M. Baumgarten are *conditionally granted*, provided that within ten (10) days of the date of this order, Patent Owner must submit a Power of Attorney for Mr. Zolan and Ms. Baumgarten in accordance with 37 C.F.R. § 42.10(b); Mr. Zolan and Ms. Baumgarten are authorized to represent Patent Owner as back-up counsel only in the above-identified proceeding;

FURTHER ORDERED that Patent Owner must file an updated mandatory notice identifying Mr. Zolan and Ms. Baumgarten as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Patent Owner shall continue to have a registered practitioner represent it as lead counsel for the above-identified proceeding;

FURTHER ORDERED that Mr. Zolan and Ms. Baumgarten are to comply with the Office Patent Trial Practice Guide¹ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), 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. Zolan and Ms. Baumgarten are subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a),

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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and the USPTO Rules of Professional Conduct set forth in 37 C.F.R.
§§ 11.101 *et seq.*²

² The Declarations state that “I understand that I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*” Declarations ¶ 8. We assume Mr. Zolan and Ms. Baumgarten also intended to be subject to the Office’s disciplinary jurisdiction under 37 C.F.R. § 11.19(a). We deem this harmless error.

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