

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROLLENIUM US INC.,
Petitioner,

v.

ALLERGAN INDUSTRIE, SAS,
Patent Owner.

IPR2019-01505 (Patent 8,450,475 B2);
IPR2019-01506 and IPR2019-01632 (Patent 8,357,795 B2);
IPR2019-01508 (Patent 9,238,013 B2);
IPR2019-01509 (Patent 9,358,322 B2);
IPR2019-01617 (Patent 8,822,676 B2); and
IPR2020-00084 (Patent 9,089,519 B2)¹

Before GRACE KARAFFA OBERMANN, JOHN G. NEW,
SHERIDAN K. SNEDDEN, and ROBERT A. POLLOCK,
*Administrative Patent Judges.*²

PER CURIAM

¹ This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. Unless otherwise authorized, the parties shall not use this heading style in any subsequent papers.

² This is not a decision by an expanded panel.

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IPR2019-01617 (Patent 8,822,676 B2);
IPR2020-00084 (Patent 9,089,519 B2)

DECISION

Provisionally Granting Patent Owner's Motion for Admission *Pro Hac Vice* of Elizabeth M. Flanagan *37 C.F.R. § 42.10*

On June 8, 2020, Patent Owner filed a Motion for Admission *pro hac vice* Admission of Elizabeth M. Flanagan in each of the above-identified proceedings. Paper 24 (“Motion”).³ Patent Owner states that Petitioner does not oppose the Motions. Motion 1. Each Motion is supported by a “Declaration of Elizabeth Flanagan in Support of Patent Owner’s Motion for *Pro Hac Vice* Admission.” Exhibit 2011 (“Declaration”).

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 admission *pro hac vice*, 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 5, 2 (citing *Unified Patents* (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

Having reviewed Patent Owner’s Motions and supporting Declarations, good cause has been shown for provisionally granting

³ Our citations to Papers and Exhibits will be to those filed in IPR2019-01505. Similar Papers and Exhibits were filed in each of the other proceedings.

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admission *pro hac vice* to Ms. Flanagan in each of the above-identified proceedings. This grant is provisional because the Declarations are not properly executed. Each Declaration begins with the language “I, Elizabeth Flanagan, hereby declare the following:,” presents several statements, and concludes with Ms. Flanagan’s signature and date. This does not meet the requirements for a declaration or for an affidavit.

“Affidavit means affidavit or declaration under § 1.68 of this chapter. A . . . declaration under 28 U.S.C. 1746 may be used as an affidavit.” 37 C.F.R. § 42.2. The reference to “affidavit” invokes the requirements of 37 C.F.R. § 1.66, and the remainder of the definition of “affidavit” (referencing a “declaration”) invokes the requirements of 37 C.F.R. § 1.68 or 28 U.S.C. § 1746.

Under 37 C.F.R. § 1.68, a party relying upon testimony in the form of a declaration must include a statement in the declaration that “willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.” 37 C.F.R. § 1.68. A declaration under 37 C.F.R. § 1.68 must also state “that all statements made of the declarant’s own knowledge are true and that all statements made on information and belief are believed to be true.” *Id.* 28 U.S.C. § 1746 permits a witness to “declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.” 28 U.S.C. § 1746. The

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Declarations do not include statements meeting the requirements of 37 C.F.R. § 1.68 or 28 U.S.C. § 1746.

Under 37 C.F.R. § 1.66, “[a]n oath or affirmation may be made before any person within the United States authorized by law to administer oaths” and the “oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made.” The Declarations do not include the seal of an officer before whom Ms. Flanagan’s oath or affirmation was made, and, thus, the Declarations do not meet the requirements for an affidavit under 37 C.F.R. § 1.66.

It is therefore,

ORDERED that Patent Owner’s Motions for Admission *pro hac vice* of Elizabeth M. Flanagan are provisionally GRANTED;

ORDERED that Patent Owner shall submit, within three (3) business days of the date of this order, an updated declaration or affidavit for Ms. Flanagan in each of the above-identified proceedings;

FURTHER ORDERED that Patent Owner shall submit, within ten business days of the date of this order, a Power of Attorney for Ms. Flanagan in accordance with 37 C.F.R. § 42.10(b) in each of the above-identified proceedings;

FURTHER ORDERED that Patent Owner shall submit an updated mandatory notice identifying Ms. Flanagan as back-up counsel in each of the above-identified proceedings, in accordance with 37 C.F.R. § 42.8;

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IPR2019-01617 (Patent 8,822,676 B2);
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FURTHER ORDERED that Ms. Flanagan is authorized to represent Patent Owner as back-up counsel only in these proceedings;

FURTHER ORDERED that Patent Owner shall continue to have a registered practitioner represent it as lead counsel in these proceedings;

FURTHER ORDERED that Ms. Flanagan shall comply with the Office Patent Trial Practice Guide, as updated by the Consolidated Trial Practice Guide (“Consolidated Practice Guide”), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>; *see also* 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 37,⁴ Code of Federal Regulations; and

FURTHER ORDERED that Ms. Flanagan is 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.*

⁴ The Motions each state that Ms. Flanagan has read, will comply with, and agrees to be subject to “the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of the C.F.R.” Motion 3. The Declarations each state that Ms. Flanagan has “read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations.” Declaration ¶ 5. We note, however, that the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials are set forth in Part 42 of 37 C.F.R., and it is those rules to which Ms. Flanagan will be subject.

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