

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APOTEX INC.,  
Petitioner,

v.

CELGENE CORPORATION,  
Patent Owner.

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IPR2023-00512  
Patent No. 8,846,628 B2

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Before TINA E. HULSE, RYAN H. FLAX, and  
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER

Conditionally Granting Patent Owner's Motion for *Pro Hac Vice* Admission  
of Nora Q.E. Passamaneck, Amy K. Wigmore, and Andrew J. Danford  
*37 C.F.R. § 42.10*

Patent Owner filed motions requesting *pro hac vice* admission of Nora Q.E. Passamaneck, Amy K. Wigmore, and Andrew J. Danford. Papers 17, 18, and 20 (collectively “Motions”). Patent Owner also submitted Declarations from Attorneys Passamaneck, Wigmore, and Danford in support of the Motions. Exs. 2152–2154 (collectively “Declarations”). Patent Owner attests that Petitioner does not oppose the Motions. Motions 2. For the reasons provided below, the Motions are *conditionally granted*.

In accordance with 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 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 Unified Patents, Inc. v. Parallel Iron, LLC*, 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 Motions and the accompanying Declarations, we conclude that Attorneys Passamaneck, Wigmore, and Danford each have sufficient legal and technical qualifications to represent Patent Owner in this proceeding, that Attorneys Passamaneck, Wigmore, and Danford have each demonstrated sufficient litigation experience and familiarity with the subject matter of this proceeding, and that Attorneys Passamaneck, Wigmore, and Danford meet all other requirements for admission *pro hac vice*. *See* Declarations 1–3. Accordingly, Patent Owner has established good cause for *pro hac vice* admission of Attorneys

IPR2023-00512  
Patent No. 8,846,628 B2

Passamaneck, Wigmore, and Danford. They will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Patent Owner, however, has not filed updated Mandatory Notices identifying Attorneys Passamaneck, Wigmore, and Danford as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3). *See, e.g.*, Papers 7, 11. Accordingly, the Motions are *conditionally granted* for Attorneys Passamaneck, Wigmore, and Danford, and are to be effective after Patent Owner files updated Mandatory Notices identifying Attorneys Passamaneck, Wigmore, and Danford as back-up counsel.

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Motions for *pro hac vice* admission of Attorneys Passamaneck, Wigmore, and Danford are *conditionally granted* provided that within twenty-one (21) business days of the date of this order Patent Owner must submit updated Mandatory Notices identifying each of Attorneys Passamaneck, Wigmore, and Danford as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner represent it as lead counsel for this proceeding;

FURTHER ORDERED that Attorneys Passamaneck, Wigmore, and Danford are authorized to represent Patent Owner as back-up counsel only in this proceeding;

FURTHER ORDERED that Attorneys Passamaneck, Wigmore, and Danford comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide<sup>1</sup> (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's

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

IPR2023-00512  
Patent No. 8,846,628 B2

Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;<sup>2</sup> and

FURTHER ORDERED that Attorneys Passamaneck, Wigmore, and Danford are 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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<sup>2</sup> The Declarations attest Attorneys Passamaneck, Wigmore, and Danford “will comply with the Patent Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in 35 C.F.R. § 42.” Declarations 4 (underline added). The Trial Practice Guide and the Rules of Practice for Trials are set forth in Part 42 of Title 37, Code of Federal Regulations. We deem this harmless error.

IPR2023-00512  
Patent No. 8,846,628 B2

FOR PETITIONER:

Vishal Gupta  
[vgupta@steptoe.com](mailto:vgupta@steptoe.com)

John Molenda  
[jmolenda@steptoe.com](mailto:jmolenda@steptoe.com)

Robert Kappers  
[rkappers@steptoe.com](mailto:rkappers@steptoe.com)

Tyler Doh  
[tdoh@steptoe.com](mailto:tdoh@steptoe.com)

Michael Green  
[migreen@steptoe.com](mailto:migreen@steptoe.com)

FOR PATENT OWNER:

Heather Petruzzi  
[heather.petruzzi@wilmerhale.com](mailto:heather.petruzzi@wilmerhale.com)

Laura Macro  
[aura.macro@wilmerhale.com](mailto:aura.macro@wilmerhale.com)

Gabriel Rosanio  
[gabriel.rosanio@wilmerhale.com](mailto:gabriel.rosanio@wilmerhale.com)