

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APOTEX CORP.  
Petitioner,

v.

ALCON RESEARCH, LTD  
Patent Owner.

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Cases IPR2013-00428 (Patent 8,268,299 B2)  
IPR2013-00429 (Patent 8,323,630 B2)  
IPR2013-00430 (Patent 8,388,941 B2)<sup>1</sup>

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Before LORA M. GREEN, FRANCISCO C. PRATS, and RAMA G. ELLURU,  
*Administrative Patent Judges.*

GREEN, *Administrative Patent Judge.*

DECISION

Alcon Research, Ltd.'s Motion for *Pro Hac Vice* Admission of  
David M. Horniak  
*37 C.F.R. § 42.10*

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<sup>1</sup> This order addresses issues that are the same in all three cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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Patent Owner, Alcon Research, Ltd., (“Alcon”), filed Motions for *Pro Hac Vice* Admission of David M. Horniak under 37 C.F.R. § 42.10(c) (Papers 33, 31, and 33),<sup>2</sup> accompanied by Declarations of David M. Horniak in support of the Motions (Exs. 2074, 2074, 2057). Alcon represents that Petitioner does not object to the Motions. Papers 33, 31, and 33, at 1. For the reasons provided below, Alcon’s Motions are *granted*.

As set forth in Section 42.10(c), we 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. For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, we also require a statement of facts showing there is good cause for us to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. *See* Paper 4 in each proceeding (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” in *Motorola Mobility LLC v. Arnouse*, Case IPR2013-00010 (PTAB October 15, 2012) (Paper 6 at 3-4) (expanded panel)).

In its Motions, Alcon asserts that there is good cause for Mr. Horniak’s *pro hac vice* admission because: (1) Mr. Horniak is a litigation attorney, and (2) Mr. Horniak has an established familiarity with the subject matter at issue in the instant

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<sup>2</sup> All references to the papers or exhibits refer to the three proceedings in numerical order; *i.e.*, the first paper or exhibit number refers to the number in IPR2013-00428, the second paper or exhibit number refers to the number in IPR2013-00429, and the third paper or exhibit number refers to the number in IPR2013-00430.

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proceedings based on his representation of Alcon in three litigations in the U.S. District Court for the District of Delaware in which the '299, '630, and '941 patents are at issue, and also based on his work directly with Alcon's fact and expert witnesses on the matters at issue in these proceedings. Papers 33, 31 and 33, at 4, 6. In support of the Motions, Mr. Horniak attests to these facts in his Declarations with sufficient explanations. Exs. 2074, ¶ 10; 2074, ¶ 10; 2057, ¶ 10. Additionally, according to the Motions, as trial counsel for Alcon, Mr. Horniak has experience litigating the precise subject matter raised in the Petitions; thus, the admission of Mr. Horniak will avoid unnecessary expense and duplication of work for Alcon. Papers 33, 31, and 33 at 4, 6-7. Moreover, Alcon's lead counsel, Stanley E. Fisher, and back-up counsel, David M. Krinsky and Barry L. Copeland, are registered practitioners. Papers 33, 31, and 33, at 4-6.

Based on the facts set forth above, we are persuaded that Mr. Horniak has sufficient legal and technical qualifications to represent Alcon in this proceeding. We are persuaded also that there is a need for Alcon to have its litigation counsel, who possesses knowledge of the precise subject matter at issue in these proceedings stemming from his involvement in district court litigations involving the same patents as those at issue herein, involved in these proceedings. We conclude, therefore, that the criteria for *pro hac vice* admission are satisfied. See *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (expanded panel), (superseding IPR2013-00010, Paper 6, dated October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under "Representative Orders, Decisions, and Notices"). Accordingly, Alcon has established good cause for Mr. Horniak's

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*pro hac vice* admission. Mr. Horniak will be permitted to appear *pro hac vice* in the instant proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

For the foregoing reasons, it is

ORDERED that Alcon's Motions for *Pro Hac Vice* Admission of Mr. Horniak for the involved proceedings is granted; Mr. Horniak is authorized to represent Alcon as back-up counsel in the proceedings;

FURTHER ORDERED that Alcon is to continue to have a registered practitioner as lead counsel in the instant proceedings;

FURTHER ORDERED that Mr. Horniak is to 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; and

FURTHER ORDERED that Mr. Horniak 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. §§ 11.101-11.901.

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