

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOFRONTERA INCORPORATED, BIOFRONTERA BIOSCIENCE GMBH,
BIOFRONTERA PHARMA GMBH, and BIOFRONTERA AG
Petitioner

v.

DUSA PHARMACEUTICALS, INC.
Patent Owner

Case IPR2018-01585
U.S. Patent No. 8,216,289

PETITIONER'S MOTION FOR ADMISSION PRO HAC VICE OF
DAVID E. FINKELSON

Pursuant to 37 C.F.R. § 42.10 and the Board’s authorization to file motions for *pro hac vice* admission in *Inter Partes* Review Case No. IPR2018-01585 (Paper No. 3), Petitioner requests that the Board admit David E. Finkelson *pro hac vice* in this proceeding.¹

The Board may recognize counsel *pro hac vice* during a proceeding on a showing of good cause. “[W]here lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigation attorney and has an established familiarity with the subject matter at issue in the proceeding.” 37 C.F.R. § 42.10(c).

Here, lead counsel, Rachelle Thompson is a registered practitioner (Reg. No. 50,860). Mr. Finkelson has over 18 years of patent litigation experience, and he is familiar with the subject matter at issue in this proceeding. United States Patent Nos. 8,261,289 and 9,723,991 are currently asserted against Petitioner in a co-pending litigation, *DUSA Pharmaceuticals, Inc. v. Biofrontera, Inc., Biofrontera Bioscience GmbH, Biofrontera Pharma GmbH, and Biofrontera AG*, Case No. 1:18-cv-10568-RGS (D. Mass.) (the “District Court Litigation”). Mr. Finkelson is lead counsel for

¹ Pursuant to the Order Authorizing Motion for *Pro Hac Vice* Admission in IPR2013-00639, Paper No. 7 (PTAB Oct. 15, 2013), Petitioners are filing this motion no sooner than twenty one (21) days after service of the petition.

Petitioner in the District Court Litigation, responsible for overseeing all aspects of Petitioner's defense in the District Court Litigation. Mr. Finkelson is also a senior member of the team that prepared the following Petitions for *Inter Partes* Review: IPR2018-01585 and IPR2018-01586 (the "Petitions"). In the foregoing capacities, Mr. Finkelson has overseen the review of the prior art references set forth in the Petitions, and is intimately familiar with the disclosures of these prior art references, the asserted grounds of invalidity, and the subject matter in this proceeding

Accompanying this motion is the Declaration of David E. Finkelson (Ex. A), where Mr. Finkelson attests to his aforementioned experience and established familiarity with the subject matter of this proceeding. Petitioner already has expended significant resources in the District Court Litigation with Mr. Finkelson as lead counsel, and Petitioner wishes to continue using Mr. Finkelson as counsel in this proceeding.

Further, counsel for Patent Owner does not oppose Mr. Finkelson appearing *pro hac vice* during this proceeding.

Therefore, Petitioner submits that there is good cause for the Board to recognize Mr. Finkelson as backup counsel *pro hac vice* during this proceeding.

Dated: October 29, 2018

Respectfully submitted,

By: /Rachelle H. Thompson/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on October 29, 2018, a true and correct copy of this Motion to Appear *Pro Hac Vice*, and all supporting exhibits, was served electronically on the following counsel of record for Patent Owner:

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