

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

DUSA PHARMACEUTICALS, INC.,  
Patent Owner.

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Case IPR2018-01585 (Patent 8,216,289 B2)  
Case IPR2018-01586 (Patent 9,723,991 B2)

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Before WILLIAM V. SAINDON and STEVEN M. AMUNDSON,  
*Administrative Patent Judges.*

SAINDON, *Administrative Patent Judge.*

ORDER  
Granting Petitioner's Motions for  
*Pro Hac Vice* Admission of David E. Finkelson  
37 C.F.R. § 42.10

Case IPR2018-01585 (Patent 8,216,289 B2)

Case IPR2018-01586 (Patent 9,723,991 B2)

On October 29, 2018, Petitioner filed a motion requesting *pro hac vice* admission of David E. Finkelson in each of the above identified proceedings. Paper 7 (“Motion”).<sup>1</sup> The Motion is supported by a declaration of Mr. Finkelson. Ex. 1020 (“Declaration”). Petitioner attests that Patent Owner does not oppose the Motion. Motion 3.

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 the proceeding. *See* Paper 3, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case 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 Motion, we conclude that Mr. Finkelson has sufficient legal and technical qualifications to represent Petitioner in this proceeding, that Mr. Finkelson has demonstrated sufficient familiarity with the subject matter of these proceedings, and that there is a need for Petitioner to be represented by counsel with litigation experience. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Finkelson. Mr. Finkelson will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

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<sup>1</sup> For purposes of expediency, we refer to papers and exhibits filed in IPR2018-01585. Petitioner filed a similar motion (Paper 7) and declaration (Ex. 1023) in IPR2018-01586.

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In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motions for *Pro Hac Vice* Admission of David E. Finkelson are *granted*, and Mr. Finkelson is authorized to represent Petitioner as back-up counsel only in the above-listed proceedings;

FURTHER ORDERED that Petitioner shall continue to have a registered practitioner represent it as lead counsel for the instant proceedings;

FURTHER ORDERED that, within ten (10) business days of the date of this order, Petitioner must submit a Power of Attorney for Mr. Finkelson in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner must file updated mandatory notices identifying Mr. Finkelson as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Mr. Finkelson shall comply with the Office Patent Trial Practice Guide as updated by the August 2018 Update, 83 Federal Register 39,989 (Aug. 13, 2018), 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. Finkelson shall 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.*

Case IPR2018-01585 (Patent 8,216,289 B2)

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PETITIONER:

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