

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NUVASIVE, INC.  
Petitioner

v.

WARSAW ORTHOPEDICS, INC.  
Patent Owner

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Case IPR2013-00396  
Patent No. 8,444,696

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**AFFIDAVIT OF MR. FRANK E. SCHERKENBACH IN SUPPORT OF PETITIONER'S  
MOTION FOR *PRO HAC VICE* ADMISSION**

**Mail Stop PATENT BOARD**  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AFFIDAVIT OF MR. FRANK E. SCHERKENBACH IN SUPPORT  
OF PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION**

I, Frank E. Scherkenbach, being duly sworn and upon oath, hereby attest to the following:

1. I am a member in good standing of the state Bars of California and Massachusetts, as well as the United States Court of Appeals for the Federal Circuit.
2. I have not been suspended or disbarred from practice before any court or administrative body.
3. I have never had an application for admission to practice before any court or administrative body denied.
4. No sanction or contempt citation has been imposed against me by any court or administrative body.
5. I have 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.
6. I will be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).
7. I have applied to appear *pro hac vice* before the Office in IPR2013-00206 and IPR2013-00208, and the motions were granted. Concurrently herewith, I have applied to appear *pro hac vice* before the Office in an *inter partes* review proceeding on the same patent that is at issue in the present *inter partes* review proceeding, IPR2013-00395.
8. I am an experienced litigation attorney with more than 20 years of experience representing clients in patent cases involving medical devices, computer software, and semiconductors. I regularly litigate patent cases in various forums including the United States Court of Appeals for the Federal Circuit, federal district courts, and the International Trade Commission. Through my experience in patent litigation matters, I have represented clients in

many phases of litigation including discovery, Markman hearings, jury trials, bench trials, and appeals. My biography is attached hereto as Exhibit A. I am lead counsel for Petitioner NuVasive, Inc. in *Warsaw Orthopedic, Inc., et al. v. Nuvasive, Inc.*, Case No. 3:12-cv-02738-CAB (MDD) (S.D. Cal.), a co-pending district court case in which the court recently granted Patent Owner's motion for leave to amend the complaint to add U.S. Patent No. 8,444,696 to the case. I am also lead counsel for the Petitioner in a separate pending patent infringement matter, *Medtronic v. NuVasive*, Case No. 3:08-cv-01512-MMA-AJB (S.D. Cal.), which involves similar subject matter (spinal implants) to this proceeding (including U.S. Patent Nos. 5,772,661 and 5,860,973) and in which I oversaw many phases of the litigation from discovery through trial, and will continue to be involved in an appeal to the Federal Circuit.

Respectfully submitted,

Date: \_\_\_\_\_

10/23/13

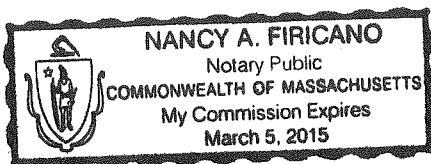
Frank E. Scherkenbach

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Sworn to and subscribed before me,  
this 23 day of October, 2013.

Nancy A. Firicano  
Notary Public

My Commission Expires: March 5, 2015



**EXHIBIT A**  
**To Motion for *Pro Hac Vice* of**  
**Frank E. Scherkenbach**



## FISH & RICHARDSON



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Frank Scherkenbach is a trial lawyer who specializes in complex high technology litigation, with particular expertise in computer software, semiconductors, and medical devices.

After co-founding the *Harvard Journal of Law & Technology*, Mr. Scherkenbach clerked for the Honorable H. Robert Mayer at the United States Court of Appeals for the Federal Circuit. He began his private practice career with Fish & Richardson in the firm's Silicon Valley office, where he immediately made a mark winning jury trials for Power Integrations, among others. In 2001 he relocated to the Boston office.

Since then, Mr. Scherkenbach has proceeded to litigate patent disputes in a wide range of technologies. Examples include a patent relating to the use of voice control in a robotic surgical system in the 2002 case, *Intuitive Surgical, Inc. and IBM v. Computer Motion, Inc.*; the 2005 case involving patents for spinal surgery devices, *Kyphon, Inc. v. Disc-O-Tech Medical Technologies, et al.*; and the 2006 case, *Fairchild Semiconductor Corporation, et al v. Power Integrations*, which involved patents relating to semiconductors used in switching power supplies and which resulted in a \$34 million verdict for Mr. Scherkenbach's client.

Mr. Scherkenbach also won a patent defense verdict for the Microsoft Corporation in a 2004 suit brought by Arendi U.S.A., Inc. In fact, a few of Mr. Scherkenbach's jury trial wins have been selected by *The National Law Journal* as particularly significant: *Power Integrations, Inc. v. Motorola, Inc.*, in which Mr. Scherkenbach and his team achieved a jury award of \$32.3 million, was named as one of the "most significant intellectual property cases" of 2004, and both *Adobe Systems, Inc. v. Quantel Ltd.* and the

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