

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDICS, INC.
Patent Owner

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

**PETITIONER NUVASIVE, INC.'S
MOTION FOR *PRO HAC VICE* ADMISSION
UNDER 37 C.F.R. § 42.10(c)**

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

Pursuant to 37 C.F.R. § 42.10(c), the Petitioner (“NuVasive”) respectfully requests that the Board recognize Mr. Frank E. Scherkenbach as counsel *pro hac vice* in this proceeding, and is also (under a separate motion) requesting the same in a related proceeding (IPR2013-00395) on the same U.S. Patent No. 8,444,696. NuVasive seeks the counsel of Mr. Scherkenbach due to his experience in representing NuVasive in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response that was mailed on March 25, 2013. *See* Notice, Paper 3 at 2-3.

1. Statement of Facts

Mr. Scherkenbach is a patent litigation attorney with more than 20 years of experience representing clients in cases involving medical devices, computer software, and semiconductors. Mr. Scherkenbach regularly litigates patent cases before the United States Court of Appeals for the Federal Circuit, various federal district courts, and the International Trade Commission. Through his practice in such cases, Mr. Scherkenbach has gained substantial experience in jury trials, bench trials, discovery, Markman hearings, and appeals. Mr. Scherkenbach began his legal career considering patent cases as a clerk for the Honorable Judge H. Robert Mayer on the United States Court of Appeals for the Federal Circuit from

1989-1991. Previously, Mr. Scherkenbach was co-founder and Editor-in-Chief of the *Harvard Journal of Law & Technology*. Today, Mr. Scherkenbach is active in various bar organizations, including the Federal Circuit Bar Association, the American Bar Association, the American Intellectual Property Law Association, and he sits on the Federal Circuit Advisory Committee. NuVasive provides Exhibit A, as evidence of Mr. Scherkenbach's biography.

Mr. Scherkenbach also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. In two related matters, Mr. Scherkenbach is serving as lead counsel for NuVasive. The first of these related matters, *Warsaw Orthopedic, Inc., et al. v. Nuvasive, Inc.*, Case No. 3:12-cv-02738-CAB (MDD) (S.D. Cal.) is currently pending in district court, which recently granted Patent Owner's motion for leave to amend the complaint to add U.S. Patent No. 8,444,696 to the case. In addition, there is another earlier-filed related case, which is also currently pending in the district court and is soon to be appealed to the Federal Circuit Court of Appeals, involving related U.S. Patent Nos. 5,772,661 and 5,860,973, *Warsaw Orthopedic, Inc., et al. v. Nuvasive, Inc.*, Case No. 3:08-cv-01512-MMA-AJB (S.D. Cal.). In this case, Mr. Scherkenbach oversaw representation of many phases of the litigation from discovery through trial, and he will be involved in the Federal Circuit appeal on the matter. NuVasive has invested significant financial resources in each of these

related matters in which Mr. Scherkenbach served as lead counsel. Moreover, through his representation in the related matters, NuVasive has developed a particular relationship with Mr. Scherkenbach such that NuVasive desires to continue the relationship with Mr. Scherkenbach for the purpose of this proceeding.

2. Affidavit of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by an Affidavit of Mr. Frank E. Scherkenbach as required by the Order Authorizing Motion for *Pro Hac Vice* mailed March 25, 2013.

Accordingly, NuVasive submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Mr. Scherkenbach as counsel *pro hac vice* during this proceeding.

Respectfully submitted,

Date: October 31, 2013

/Michael T. Hawkins/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on October 31, 2013, a complete and entire copy of this Motion for *Pro Hac Vice* Admission and the supporting exhibits were provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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