

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDIC, INC.
Patent Owner

Case IPR2013-00396
Patent 8,444,696

Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

DECISION
Motion for *Pro Hac Vice* Admission
37 C.F.R. § 42.10

NuVasive, Inc. (“NuVasive”) filed a motion for *pro hac vice* admission of Frank E. Scherkenbach. Paper 9. The motion is unopposed. The motion is *granted.*

IPR2013-00396
Patent 8,444,696

Pursuant to 37 C.F.R. § 42.10(c), the Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing motions for *pro hac vice*, 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 this proceeding. “Notice”; Paper 4.

In its motion, NuVasive states that there is good cause for the Board to recognize Mr. Scherkenbach *pro hac vice* during this proceeding, because Mr. Scherkenbach is an experienced litigating attorney with an established familiarity with the subject matter at issue in the proceeding. In addition, the motion states that Mr. Scherkenbach is counsel for NuVasive in related litigation between Warsaw and NuVasive. Mr. Scherkenbach made an affidavit attesting to, and explaining, these facts. Exhibit 1113. The affidavit complies with the requirements set forth in the Notice.

Upon consideration, NuVasive has demonstrated that Mr. Scherkenbach has sufficient legal and technical qualifications to represent NuVasive in this proceeding. Moreover, the Board recognizes that there is a need for NuVasive to have its related litigation counsel involved in this proceeding. Accordingly, NuVasive has also established that there is good cause for admitting Mr. Scherkenbach.

Attention is directed to the Office’s Final Rule adopting new Rules of Professional Conduct. *See Changes to Representation of Others Before the United States Patent and Trademark Office*; Final Rule, 78 Fed. Reg. 20180 (Apr.

IPR2013-00396
Patent 8,444,696

3, 2013). The Final Rule also removes Part 10 of Title 37, Code of Federal Regulations. The changes set forth in that Final Rule including the USPTO's Rules of Professional Conduct took effect on May 3, 2013. Therefore, Mr. Scherkenbach is subject to the USPTO's Rules of Professional Conduct that took effect May 3, 2013.

It is

ORDERED that the NuVasive motion for *pro hac vice* admission of Frank E. Scherkenbach for this proceeding is *granted*;

FURTHER ORDERED that NuVasive is to continue to have a registered practitioner represent it as lead counsel for this proceeding; and

FURTHER ORDERED that Mr. Scherkenbach is to comply with the Office Patent Trial Practice Guide 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. Scherkenbach is 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.*

IPR2013-00396
Patent 8,444,696

PETITIONER:

Stephen Schaefer
Michael Hawkins
Fish and Richardson PC
schaefer@fr.com
hawkins@fr.com

PATENT OWNER:

Thomas Martin
Wesley Meinerding
Martin and Ferraro LLP
tmartin@martinferraro.com
wmeinerding@martinferraro.com