

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARDIOCOM, LLC
Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.
Patent Owner

Case IPR2013-00431 (Patent 7,921,186 B2)
Case IPR2013-00449 (Patent 7,840,420 B2)
Case IPR2013-00451 (Patent 7,587,469 B2)
Case IPR2013-00468 (Patent 7,516,192 B2)¹

Before STEPHEN C. SIU, JUSTIN T. ARBES, and MIRIAM L. QUINN,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

DECISION

Patent Owner's Motion for *Pro Hac Vice* Admission of
Siddhartha Venkatesan
37 C.F.R. § 42.10

¹ Case IPR2013-00469 has been joined with Case IPR2013-00468. This Decision addresses an issue pertaining to all four cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

In each of the four instant proceedings, Patent Owner Robert Bosch Healthcare Systems, Inc. (“Bosch”) filed a motion requesting *pro hac vice* admission of Siddhartha Venkatesan and provided a declaration from Mr. Venkatesan in support of the request.² Petitioner Cardiocom, LLC did not file an opposition to any of the motions. For the reasons stated below, Bosch’s motions are *granted*. As the motions and declarations in the four proceedings are substantially similar, we will refer herein to the papers filed in Case IPR2013-00431 for convenience.

The Board may recognize counsel *pro hac vice* during a proceeding “upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose.” 37 C.F.R. § 42.10(c). For example, where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* “upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.* In authorizing motions 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. Paper 4 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” Paper 6 in IPR2013-00010, at 3-4).

In its motions, Bosch argues that there is good cause for Mr. Venkatesan’s *pro hac vice* admission because he is an experienced litigation attorney and has an established familiarity with the subject matter at issue in

² See IPR2013-00431, Paper 30, Ex. 2005; IPR2013-00449, Paper 29, Ex. 2009; IPR2013-00451, Paper 33, Ex. 2008; IPR2013-00468, Paper 32, Ex. 2006.

these proceedings. Paper 30 at 7-8. Specifically, Mr. Venkatesan is counsel for Bosch in *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC*, E.D. Tex. Case No. 2:13-cv-00349, where the patents being challenged in the instant proceedings are being asserted. Paper 30 at 5. Bosch contends that Mr. Venkatesan's participation in these proceedings will enable Bosch to "avoid unnecessary expense and duplication of work between [these proceedings] and its district court litigation." *Id.* at 8. In his declaration, Mr. Venkatesan attests that:

- (1) he is "a member in good standing of the State Bar[s] of California and New York";
- (2) he has "never been suspended or disbarred from practice before any court or administrative body," "[n]o court or administrative body has ever denied [his] application for admission to practice before it," and "[n]o court or administrative body has ever imposed sanctions or contempt citations on [him]";
- (3) he has "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 Section 37 of the Code of Federal Regulations," and "understand[s] that [he] will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)";
- (4) he has "not applied to appear *pro hac vice* in any other proceedings before the Office in the last three (3) years";
- (5) he has been "litigating patent cases for over nine years"; and
- (6) he is "counsel for Bosch in . . . *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC*, Civil Action No. 2:13-cv-349 (E.D. Tex.)," which "involves U.S. Patent No. 7,921,186 also at issue in this *inter partes* review proceeding," and has been "actively involved in preparing the technical aspects of the case relating to infringement and validity of the '186 Patent, including detailed analysis of the '186 Patent and its file history."

Case IPR2013-00431, Case IPR2013-00449, Case IPR2013-00451,
Case IPR2013-00468

Ex. 2005 ¶¶ 1-13. Also, Bosch's lead counsel in the instant proceedings, Don Daybell, is a registered practitioner. Paper 30 at 4.

Based on the facts set forth above, we conclude that Mr. Venkatesan has sufficient legal and technical qualifications to represent Bosch in these proceedings and that there is a need for Bosch to have its counsel in the related litigation involved in these proceedings. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (Oct. 15, 2013) (superseding IPR2013-00010, Paper 6, dated October 15, 2012, and setting forth the requirements for *pro hac vice* admission) (copy available on the Board Web site under "Representative Orders, Decisions, and Notices"). Accordingly, Bosch has established good cause for Mr. Venkatesan's *pro hac vice* admission. Mr. Venkatesan will be permitted to appear *pro hac vice* in the instant proceedings as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

In consideration of the foregoing, it is hereby:

ORDERED that Bosch's motions for *pro hac vice* admission of Siddhartha Venkatesan in the instant proceedings are granted and Mr. Venkatesan is authorized to represent Bosch as back-up counsel in the instant proceedings;

FURTHER ORDERED that Bosch is to continue to have a registered practitioner as lead counsel in the instant proceedings;

FURTHER ORDERED that Mr. Venkatesan is to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Title 37, Part 42 of the Code of Federal Regulations; and

Case IPR2013-00431, Case IPR2013-00449, Case IPR2013-00451,
Case IPR2013-00468

FURTHER ORDERED that Mr. Venkatesan is subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.