

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 IPR2013-00468 (Patent 7,516,192 B2)
Case IPR2013-00469 (Patent 7,516,192 B2)¹

Before JUSTIN T. ARBES, BRYAN F. MOORE, and
TRENTON A. WARD, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

DECISION
Petitioner's Motion for *Pro Hac Vice* Admission of William D. Schultz
37 C.F.R. § 42.10

¹ This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

In both of the instant proceedings, Petitioner Cardiocom, LLC (“Cardiocom”) filed a motion requesting *pro hac vice* admission of William D. Schultz and provided a declaration from Mr. Schultz in support of the request.² Patent Owner Robert Bosch Healthcare Systems, Inc. did not file an opposition to either of the motions. For the reasons stated below, Cardiocom’s motions are *granted*. As the motions and declarations in the two proceedings are substantially similar, we will refer herein to the papers filed in Case IPR2013-00468 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, Cardiocom argues that there is good cause for Mr. Schultz’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 IPR2013-00468, Paper 17, Ex. 1012; IPR2013-00469, Paper 16, Ex. 1012.

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these proceedings. Paper 17 at 7-9. Specifically, Mr. Schultz is counsel for Cardiocom in *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC*, E.D. Tex. Case No. 2:13-cv-00349, where the patent being challenged in the instant proceedings is being asserted. Paper 17 at 4-5. Cardiocom contends that Mr. Schultz’s participation in these proceedings will enable Cardiocom to “avoid unnecessary expense and duplication of work between [these proceedings] and its district court litigation.” *Id.* at 8-9. In his declaration, Mr. Schultz attests that:

- (1) he is “a member in good standing of the Bar[] of: Minnesota”;
- (2) he has had “no suspensions or disbarments from practice before any court or administrative body,” “never had any court or administrative body deny [his] application to practice before said court or administrative body,” and “never been sanctioned or cited for contempt by any court or administrative body”;
- (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 37 C.F.R.,” and understands 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 only applied to appear *pro hac vice* in the instant proceedings and related Cases IPR2013-00431, IPR2013-00439, IPR2013-00449, IPR2013-00451, and IPR2013-00460;
- (5) he has been “litigating patent cases for at least eleven years”; and
- (6) he is “second counsel in the case *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC, and Abbott Diabetes Care, Inc.*, No. 2:13-CV-349 (E.D. Tex., filed Apr. 26, 2013),” which involves the patent being challenged in the instant proceedings, and has developed “a thorough understanding of the prior art, including the prior art cited in [the instant proceedings], as well as a thorough understanding of the patent at issue.”

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Ex. 1012 ¶¶ 1-12. Also, Cardiocom's lead counsel in these proceedings, Daniel W. McDonald, is a registered practitioner. Paper 17 at 3.

Based on the facts set forth above, we conclude that Mr. Schultz has sufficient legal and technical qualifications to represent Cardiocom in these proceedings and that there is a need for Cardiocom to have its counsel in the related litigation involved in these proceedings. *See* IPR2013-00639, Paper 7, dated October 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, Cardiocom has established good cause for Mr. Schultz's *pro hac vice* admission. Mr. Schultz 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 Cardiocom's motions for *pro hac vice* admission of William D. Schultz in the instant proceedings are granted and Mr. Schultz is authorized to represent Cardiocom as back-up counsel in the instant proceedings;

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

FURTHER ORDERED that Mr. Schultz 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

FURTHER ORDERED that Mr. Schultz 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).

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