

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC.  
Petitioner

v.

NUVASIVE, INC.  
Patent Owner

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Cases IPR2013-00506 (Patent 8,361,156)  
IPR2013-00507 (Patent 8,187,334)  
IPR2013-00508 (Patent 8,187,334)<sup>1</sup>

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

GREEN, *Administrative Patent Judge.*

ORDER

Patent Owner's Motion for *Pro Hac Vice* Admission of  
Michael A. Amon  
*37 C.F.R. § 42.10*

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<sup>1</sup> This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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IPR2013-00508 (Patent 8,187,334)

Patent Owner, NuVasive Inc., (“Patent Owner”), timely filed Motions for *Pro Hac Vice* Admission of Michael A. Amon under 37 C.F.R. § 42.10(c), (Papers 19, 15, and 17),<sup>2</sup> accompanied by the Declarations of Mr. Amon in support of the Motions (Exhibits 2102, 2002, and 2102). Petitioner has not opposed. For the reasons provided below, Patent Owner’s Motions are *granted*.

As set forth in § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the conditions that lead counsel be a registered practitioner. 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.” 37 C.F.R. § 42.10(c). In authorizing motions for *pro hac vice* admission, we also require a statement of facts showing there is good cause for us to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in this proceeding. *See* Papers 4, 3, and 3 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” in *Motorola Mobility LLC v. Arnouse*, Case IPR2013-00010 (PTAB October 15, 2012) (Paper 6 at 3-4) (expanded panel)).

In its Motions, Patent Owner asserts that there is good cause for Mr. Amon’s *pro hac vice* admission because: (1) Mr. Amon is an experienced litigation attorney; and (2) Mr. Amon has an established familiarity with the subject matter at issue in the instant proceeding, having served as counsel for NuVasive in related litigation. Moreover, according to the Motions, “NuVasive has developed a

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<sup>2</sup> All references to the papers and exhibits refer to the proceedings in numerical order; *i.e.*, the first paper number refers to the paper number in IPR2013-00506, the second paper number refers to the paper number in IPR2013-00507, and the third paper number refers to the paper number in IPR2013-00508.

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particular relationship with Mr. Amon such that NuVasive desires to continue the relationship with Mr. Amon for the purpose of [these] proceeding[s].” Papers 19, 15, and 17 at 2-3. In support of the Motions, Mr. Amon attests to these facts in the Declarations with sufficient explanations. Exhibits 2102, 2002, and 2102. In addition to the foregoing, Patent Owner’s lead counsel, Stephen R. Schaefer, is a registered practitioner. Papers 7, 5, and 5 at 3.

Based on the facts set forth above, we conclude that Mr. Amon has sufficient legal and technical qualifications to represent Patent Owner in these proceedings. *See Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (expanded panel), (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, Patent Owner has established good cause for Mr. Amon’s *pro hac vice* admission. Mr. Amon 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).

For the foregoing reasons, it is

ORDERED that Patent Owner’s Motion for *Pro Hac Vice* Admission of Mr. Amon for the involved proceedings is granted; Mr. Amon is authorized to represent Patent Owner as back-up counsel in the instant proceedings;

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

FURTHER ORDRED that Mr. Amon 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

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FURTHER ORDERED that Mr. Amon is to be 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 – 11.901.

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