

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC., and
MEDTRONIC COREVALVE, LLC
Petitioner

v.

TROY R. NORRED, M.D.
Patent Owner

Case IPR2014-00111
Patent 6,482,228

Before JOSIAH C. COCKS, SHERIDAN K. SNEDDEN, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

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

Patent Owner Troy R. Norred (“Patent Owner”) requests, via motion, *pro hac vice* admission of Mr. David L. Marcus.¹ Paper 7. Patent Owner provides a declaration from Mr. Marcus in support of its motion.² The motion is unopposed. For the reasons stated below, the motion is *granted*.

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.* 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. *See* IPR 2013-00639 (Paper 7).

In its motion, Patent Owner argues that there is good cause for Mr. Marcus’s *pro hac vice* admission because he is an experienced litigation attorney and has an established familiarity with the subject matter at issue in these *inter partes* reviews. Paper 7 at 2. Specifically, Mr. Marcus is counsel for Patent Owner in *Troy R. Norred, M.D. v. Medtronic, Inc., et al.*, Case

¹ Authorization for such motion was given in the Notice mailed November 6, 2013 (Paper 3).

² The Board has assigned this declaration Exhibit number 2001. Patent Owner is reminded that a patent owner’s exhibits must be uniquely numbered sequentially in a range from 2001-2999. *See* 37 C.F.R. § 42.63 (c).

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No. 13-CV-2061 EFM/DJW filed in the United States District Court for the District of Kansas. *Id.* at 2-3. In his declaration, Mr. Marcus attests that:

- (1) he is “authorized to practice law in the States of Missouri, Kansas and Arizona”;
- (2) he has “never been suspended or disbarred in any court,” and has “never had sanctions or contempt citations imposed on me by any court of 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, as set forth in part 42 of 37 C.F.R.,” and agrees to be “subject to the USPTO Rules of Practice for Trials set forth in part 42 of 37 C.F.R.” and “the USPTO Professional 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 is “familiar with the subject matter at issue in this proceeding and have knowledge of the facts set forth in the Motion for *Pro Hac Vice* Admission.”

Ex. 2001, ¶¶ 1-8. We observe also that Patent Owner’s lead counsel in this proceeding, Jack Barufka, is a registered practitioner. Paper 4, 2.

Based on the facts set forth above, we conclude that Mr. Marcus has sufficient legal and technical qualifications to represent Patent Owner in this *inter partes* review proceeding and that there is a need for Patent Owner to have its counsel in the related litigation involved in such proceedings.

Accordingly, Patent Owner has established good cause for Mr. Marcus’s *pro hac vice* admission. Mr. Marcus will be permitted to appear *pro hac vice* in IPR2014-00111 as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

Accordingly, it is:

ORDERED that Patent Owner’s motion for *pro hac vice* admission is granted and Mr. David L. Marcus is authorized to represent Patent Owner as

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back-up counsel in IPR2014-00111;

FURTHER ORDERED that Patent Owner is to continue to have a registered practitioner as lead counsel in this *inter parte* review proceeding;

FURTHER ORDERED that Mr. Marcus 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. Marcus 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.*

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