

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZIMMER HOLDINGS, INC.  
ZIMMER, INC.  
Petitioners

v.

BONUTTI SKELETAL INNOVATION, LLC  
Patent Owner

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Case IPR2014-00321  
Patent 7,806,896 B1

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Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and  
RICHARD E. RICE, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION

Petitioner's Motion for *Pro Hac Vice* Admission of Kenneth Liebman  
*37 C.F.R. § 42.10*

Petitioner filed a motion requesting *pro hac vice* admission of Kenneth Liebman. Paper 8. Petitioner provided a declaration of Mr. Liebman, filed separately as Exhibit 1009, in support of its motion. *Id.* at 3-5. Patent Owner did not oppose Petitioner's motion for *pro hac vice* admission of Mr. Liebman. For the reasons stated below, Petitioner's 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.* In authorizing a motion 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. *See, e.g.*, “Order – Authorizing Motion for *Pro Hac Vice* Admission,” IPR2013-00639, Paper 7.

In its motion, Petitioner argues that there is good cause for Mr. Liebman's *pro hac vice* admission because he is an experienced litigation attorney and has an established familiarity with the subject matter at issue in this proceeding. Paper 8 at 3-4. In particular, Petitioner asserts that Mr. Liebman is counsel of record in co-pending litigation styled *Bonutti Skeletal Innovation LLC v. Zimmer Holdings, Inc. et al.*, No. 1:12-cv-1107-GMS (D. Del.), which involves the same patent at issue in this proceeding.

*Id.* In his affidavit, Mr. Liebman attests that:

- (1) he is “a member in good standing of the Bar of [the State of] Minnesota,” California, as well as a number of Federal Courts;
- (2) he has “never been suspended or disbarred from practice before any court or administrative body,” “never had a court or administrative body deny [his] application for admission to practice,” and “never had any court impose sanctions or contempt citations against [him]”;
- (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 the C.F.R.,” and agrees to be “subject to the [USPTO’s] Code of Professional Responsibility set forth in 37 C.F.R. §§ 10.20 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a)”;
- (4) he has “been in private practice for 33 years, and litigating patent cases for over 20 years,” with “[s]everal of these patent litigations involv[ing] USPTO post-grant procedures”; and
- (5) he is “familiar with the subject matter at issue in this proceeding” and is “lead counsel for Petitioner” in the related litigation that “involves the same patent at issue in this proceeding.”

Ex. 1009 ¶¶ 1-11.

Based on the facts set forth in support of the motion, we conclude that Mr. Liebman has sufficient legal and technical qualifications to represent Petitioner in this proceeding, and that there is a need for Petitioner to have its counsel in the related litigations involved in this proceeding.

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

In consideration of the foregoing, it is

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ORDERED that Petitioner's motion for *pro hac vice* admission of Kenneth Liebman is granted, and Mr. Liebman is authorized to represent Petitioner only as back-up counsel in this proceeding;

FURTHER ORDERED that Petitioner should continue to have a registered practitioner as lead counsel in this proceeding;

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

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