

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TROY R. NORRED, M.D.
Patent Owner

Case IPR2014-00395
Patent 6,482,228 B1

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Patent Owner's Motion for *Pro Hac Vice* Admission of David L. Marcus
37 C.F.R. § 42.10

Patent Owner filed a motion requesting *pro hac vice* admission of Mr. David L. Marcus. Paper 8. Patent Owner provided a declaration from Mr. Marcus in support of its motion, which was filed separately as Exhibit 2100. For the reasons stated below, Patent Owner's motion is GRANTED.

DISCUSSION

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, when 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 5 at 3 (referencing the “Order – Authorizing Motion for *Pro Hac Vice* Admission,” in IPR2013-00639, Paper 7 at 2-4).

In its motion, Patent Owner argues that there is good cause for Mr. Marcus's *pro hac vice* admission because he is an experienced litigating attorney and has established familiarity with the subject matter at issue in this proceeding. Paper 8 at 1-2. In particular, Patent Owner represents that this proceeding arises from and relates to *Troy R. Norred, M.D. v. Medtronic, Inc. et al.*, No. 13-CV-2061 EFM/DJW filed in the United States District Court for District of Kansas, where Mr. Marcus is counsel for Patent Owner. *Id.* In his declaration, Mr. Marcus attests that:

- (1) he is “duly authorized to practice law in the States of Missouri, Kansas, and Arizona” and “presently [is] in good standing and eligible to practice before [ten] courts”;
- (2) he has “never been suspended or disbarred in any court,” “never been denied admission *pro hac vice* before any court or administrative body,” and “never had sanctions or contempt citations imposed on [him] by any court or administrative body”;
- (3) he is “currently admitted *pro hac vice* to appear before the Patent Trial and Appeal Board in Case Nos. IPR2014-00110 and IPR2014-00111”;
- (4) 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 the 37 C.F.R.,” and agrees to 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)”;
- (5) he is “familiar with the subject matter at issue in this proceeding.”

Ex. 2100 ¶¶ 1, 3-5, 7, and 8.

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

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 this proceeding as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

ORDER

For the foregoing reasons, it is:

ORDERED that Patent Owner's motion for *pro hac vice* admission of Mr. David L. Marcus is GRANTED, and Mr. Marcus is authorized to represent Patent Owner only as back-up counsel in this proceeding;

FURTHER ORDERED that Patent Owner must continue to have a registered practitioner as lead counsel in this 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 USPTO'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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