

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, LLC.

Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.

Patent Owner

CASE: IPR2014-00436

Patent No. 7,587,469

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.'S

MOTION FOR *PRO HAC VICE*

ADMISSION OF LILLIAN MAO

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10 (c), Patent Owner, Robert Bosch Healthcare Systems, Inc., (“Bosch”) respectfully requests the *pro hac vice* admission of Lillian Mao in this proceeding.

II. GOVERNING LAWS, RULES AND PRECEDENT

Section 42.10(c) states as follows:

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.

For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

The Board’s Notice of Filing Date Accorded to Petition, Paper No. 7 in this proceeding (“Filing Date Notice”), states that motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c) must be filed in accordance with the “Order – Authorizing Motion for *Pro Hac Vice* Admission” entered in Case IPR2013-00639, Paper No. 7 (MPT) (“*Pro Hac Vice* Order”). Filing Date Notice, Paper No. 7, at 2. In accordance with the *Pro Hac Vice* Order, this motion is being filed no sooner than twenty-one (21) days after service of the petition. *Pro Hac Vice* Order, at 2.

The Filing Date Notice authorizes the parties to file motions for *pro hac vice* admission in this proceeding. Filing Date Notice, Paper No. 7, at 2.

The *Pro Hac Vice* Order requires that such motions (1) “[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding,” and (2) “[b]e accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:

- i. Membership in good standing of the Bar of at least one State or District of Columbia;
- ii. No suspensions or disbarments from practice before any court or administrative body;
- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear 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 C.F.R.;
- vi. The individual will be subject to the USPTO 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);

- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
- viii. Familiarity with the subject matter at issue in the proceeding.”

Pro Hac Vice Order, at 3-4.

III. STATEMENT OF FACTS

Based on the following facts, and supported by the Affidavit of Lillian Mao (BOSCH 2013) submitted herewith, Patent Owner Bosch requests the *pro hac vice* admission of Lillian Mao in this proceeding.

1. Robert Bosch Healthcare Systems, Inc.’s lead counsel, Don Daybell, is a registered practitioner (Reg. No. 50,877).
2. Ms. Mao is an associate at the law firm of Orrick Herrington & Sutcliffe LLP. (BOSCH 2013 ¶ 3)
3. Ms. Mao is an experienced litigating attorney and has been a litigating attorney for more than 4 (four) years. (*Id.*, ¶ 3). Ms. Mao has been litigating patent cases for over 4 (four) years. (*Id.*, ¶ 4).
4. Ms. Mao has established familiarity with the subject matter at issue in this proceeding. (*Id.*, ¶ 6). Ms. Mao has litigated patent cases in the area of computerized information systems

since 2010 (*Id.*, ¶ 5). She has become familiar with U.S. Patent No. 7,587,469 (the “469 Patent”) and with its prosecution file history. (*Id.*, ¶ 6). She also has an in-depth familiarity with Bosch’s related U.S. Patent Nos. 7,516,192; 7,769,605; 7,840,420; 7,870,249; 7,921,186, and their file histories. (*Id.*).

5. Ms. Mao is counsel for Bosch in a co-pending district court litigation against Petitioner's predecessor in interest, Cardiocom LLC (“Cardiocom”). That litigation is captioned *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC*, Civil Action No. 3:14-cv-01575-EMC (N.D. Cal.), and involves the same patent at issue in this proceeding. (*Id.*). As counsel for Bosch, Ms. Mao has been actively involved in all aspects of its district court litigation. (*Id.*).
6. In addition, Ms. Mao is counsel for Bosch in another district court litigation against Cardiocom, captioned *Robert Bosch Healthcare Systems, Inc. v. Cardiocom, LLC*, Case No. 5:12-CV-3864-EJD (N.D. Cal.). That litigation involves U.S. Patent Nos. 6,368,273; 6,968,375; 7,252,636; and 8,140,663 which are related to the patent at issue, and U.S. Patent Nos. 7,941,327

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