

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TROY NORRED  
Patent Owner

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Case IPR2014-00823  
Patent 6,482,228 B1

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Before SHERIDAN K. SNEDDEN, BARRY L. GROSSMAN, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

Patent Owner Troy R. Norred (“Patent Owner”) moves for admission  
*pro hac vice* of Mr. David L. Marcus.<sup>1</sup> Paper 6. Patent Owner provides a

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<sup>1</sup> Authorization for such motion was given in the Notice mailed June 9,  
2014, (Paper 4).

declaration from Mr. Marcus in support of its motion.<sup>2</sup> 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, 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.* The Board requires the moving party to provide a statement of facts showing that good cause exists 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 good cause exists 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 this *inter partes* review. Paper 6 at 2. Specifically, Mr. Marcus is counsel for Patent Owner in *Troy R. Norred, M.D. v. Medtronic, Inc., et al.*, Case No. 13-CV-2061 EFM/DJW filed in the United States District Court for the District of Kansas. *Id.* at 1–2. 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;”

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<sup>2</sup> 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 2001–999. *See* 37 C.F.R. § 42.63 (c).

- (3) he is “currently admitted *pro hac vice* to appear before the Patent Trial and Appeal Board in Case Nos. IPR2014-00110, IPR2014-00111 and IPR2014-00395;”
- (4) 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);” and
- (5) 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, ¶¶ 1–4. We observe also that Patent Owner’s lead counsel in this proceeding, James J. Kernell, is a registered practitioner. Paper 3, 2.

Based on the facts set forth above, we conclude that Mr. Marcus has sufficient qualifications to represent Patent Owner in this *inter partes* review proceeding and that good cause exists for Patent Owner to have its counsel in the related litigation involved in such proceedings. Accordingly, we will permit Mr. Marcus to appear *pro hac vice* in IPR2014-00823 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 back-up counsel in IPR2014-00823;

FURTHER ORDERED that Patent Owner shall continue to designate a registered practitioner as lead counsel in this *inter partes* review proceeding;

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FURTHER ORDERED that Mr. Marcus shall 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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