

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner.

IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00130 (Patent RE45,380 E)
IPR2020-00136 (Patent RE45,776 E)
IPR2020-00138 (Patent RE47,379 E)¹

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motions for Admission
Pro Hac Vice of William E. Manske
37 C.F.R. § 42.10

¹ This Order applies to all of the above-identified proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00130 (Patent RE45,380 E)
IPR2020-00136 (Patent RE45,776 E)
IPR2020-00138 (Patent RE47,379 E)

On October 13, 2020, Petitioner filed motions for admission *pro hac vice* of William E. Manske in each of the above-identified proceedings (collectively “Motions”). Paper 43.² Petitioner also filed declarations of Mr. Manske in support of the Motions (collectively “Declarations”). Ex. 1497.³ Petitioner states that Patent Owner does not oppose the Motions. Paper 43, 1. For the reasons provided below, Petitioner’s Motions are *granted*.

Pursuant to 37 C.F.R. § 42.10(c), 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. In its notice authorizing motions for *pro hac vice* admission, the Board requires 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 in this proceeding. *See* Paper 6, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)).

Based on the facts set forth in the Motions⁴ and the accompanying Declarations, we conclude that Mr. Manske has sufficient legal and technical

² For purposes of expediency, we cite to Papers filed in IPR2020-00127. Petitioner filed similar Motions in IPR2020-00130 (Paper 42), IPR2020-00136 (Paper 42), and IPR2020-00138 (Paper 42).

³ For purposes of expediency, we cite to Exhibits filed in IPR2020-00127. Petitioner filed similar Declarations in IPR 2020-00130 (Ex. 1497), IPR2020-00136 (Ex. 1497), and IPR2020-00138 (Ex. 1297).

⁴ The Motions state that “Mr. Manske attests that he has read and will comply with the Patent Office Trial Practice Guide and the Board’s Rules of

IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00130 (Patent RE45,380 E)
IPR2020-00136 (Patent RE45,776 E)
IPR2020-00138 (Patent RE47,379 E)

qualifications to represent Petitioner in these proceedings, that Mr. Manske has demonstrated sufficient familiarity with the subject matter of these proceedings, and that Petitioner's intent to be represented by counsel with litigation experience is warranted. Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Manske. Mr. Manske will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

On October 13, 2020, Petitioner filed an Updated Mandatory Notice in the above-identified proceedings identifying Emily J. Tremblay as back-up counsel and indicating that a motion for *pro hac vice* admission of Ms. Tremblay is "pending." Paper 44, 1. On October 15, 2020, Petitioner indicated by e-mail correspondence that it does not intend to seek *pro hac vice* admission of Ms. Tremblay in the above-identified proceedings. Accordingly, Petitioner is directed to file an Updated Mandatory Notice correctly identifying back-up counsel in these proceedings.

Accordingly, it is

ORDERED that Petitioner's Motions for *pro hac vice* admission of Mr. William E. Manske are *granted*;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceedings;

Practice set forth in 35 C.F.R. § 42." Paper 43, 2. The Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials are set forth in Part 42 of *Title 37*, Code of Federal Regulations. Because the Declarations properly cite to 37 C.F.R., we deem this harmless error.

IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00130 (Patent RE45,380 E)
IPR2020-00136 (Patent RE45,776 E)
IPR2020-00138 (Patent RE47,379 E)

FURTHER ORDERED that Mr. Manske is authorized to represent Petitioner only as back-up counsel in the above-identified proceedings;

FURTHER ORDERED that Mr. Manske is to comply with the Office Patent Trial Practice Guide⁵ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations;

FURTHER ORDERED that Mr. Manske shall be 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.*; and

FURTHER ORDERED that Petitioner shall file Updated Mandatory Notices removing Emily J. Tremblay as back-up counsel in the above-identified proceedings.

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00130 (Patent RE45,380 E)
IPR2020-00136 (Patent RE45,776 E)
IPR2020-00138 (Patent RE47,379 E)

FOR PETITIONER:

Cyrus Morton
cmorton@robinskaplan.com
Sharon Roberg-Perez
sroberg-perez@robinskaplan.com
Christopher Pinahs
cpinahs@robinskaplan.com

FOR PATENT OWNER:

Derek Vandenburg
dvandenburg@carlsoncaspers.com
Dennis Bremer
dbremer@carlsoncaspers.com