

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.
Petitioners,

v.

TELEFLEX INNOVATIONS S.A.R.L.
Patent Owner.

Case IPR2020-00136
Patent RE 45,776

**PATENT OWNER'S UNOPPOSED MOTION FOR
PRO HAC VICE ADMISSION OF PETER M. KOHLHEPP**

Pursuant to the Notice in this case authorizing the parties to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c), Patent Owner Teleflex hereby respectfully moves for the *pro hac vice* admission of Peter M. Kohlhepp due to his experience representing Patent Owner in other patent-related matters concerning the GuideLiner technology and his familiarity with the technical and substantive issues involved in this proceeding. The parties have conferred, and the Petitioner does not oppose this Motion.

In support of this motion, Patent Owner states as follows:

The Board may recognize counsel *pro hac vice* upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose. 37 C.F.R. § 42.10(c). A motion for *pro hac vice* admission may be granted where a party shows that “counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.*

Good cause exists under 37 C.F.R. § 42.10(c) for the *pro hac vice* admission of Peter M. Kohlhepp as backup co-counsel in this matter. Mr. Kohlhepp has assisted in the representation of Teleflex in a related patent infringement action in the District of Minnesota (Civil Action. No. 19-cv-1760 (PJS/TNL), filed July 2, 2019) involving the same parties and the same patent at issue in this proceeding. Mr. Kohlhepp has also assisted the lead counsel representing the Patent Owner in this IPR, Mr. Vandenburg. As a result of these experiences, Mr. Kohlhepp has developed an intimate familiarity with the patents at issue and the Petitioner’s validity challenges, and the Patent Owner wishes to have Mr. Kohlhepp continue representing it in this matter before the Board.

In addition, Mr. Kohlhepp has previously been admitted *pro hac vice* and participated in other IPR proceedings, developing a familiarity with IPR statutes, regulations, and practice in the process.

The Patent Owner has invested significant financial resources in the related proceedings described above. If this motion was denied, the Patent Owner would be prejudiced because it would have to undertake the burdensome and costly task of educating another attorney regarding the patent at issue in this proceeding, and the related evidence. The Patent Owner respectfully requests that the Board avoid this prejudice and grant this Motion.

Pursuant to the requirements of 37 C.F.R. § 42.10(c), Derek Vandenburg, a registered practitioner, will remain as lead counsel in this matter. Mr. Vandenburg is a partner at Carlson Caspers, the same law firm that is representing the Patent Owner in the related federal court action involving the patent at issue here, as well as the patents at issue in the related instituted *inter partes* review proceedings. Mr. Kohlhepp has worked with Mr. Vandenburg on other similar matters.

Pursuant to the order in this IPR authorizing motion for *pro hac vice* and the requirements of the “Order -- Authorizing Motion for *Pro Hac Vice* Admission” Case IPR2013-00639, Paper 7, this Motion is also supported by the Declaration of Peter M. Kohlhepp (Exhibit 2088), filed herewith.

In the Declaration of Peter M. Kohlhepp (Ex. 2088), Mr. Kohlhepp attests that he has read and will comply with the Patent Office Trial Practice Guide and the Board’s Rules of Practice set forth in 35 C.F.R. § 42. Mr. Kohlhepp further attests that he agrees to be subject to the USPTO’s Rules of Professional Conduct

as set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

For the foregoing reasons, and in view of the Declaration submitted herewith, Patent Owner submits that good cause exists for the *pro hac vice* admission of Peter M. Kohlhepp and respectfully requests that the Board grant this motion.

Dated: August 19, 2020.

Respectfully submitted,

/J. Derek Vandenburg/

J. Derek Vandenburg (Lead Counsel)

Registration No. 32,179

Carlson, Caspers, Vandenburg

& Lindquist, P.A.

225 South Sixth Street, Suite 4200

Minneapolis, MN 55402

Telephone: (612) 436-9600

Facsimile: (612) 436-9650

Email: DVandenburg@carlsoncaspers.com

Lead Counsel for Patent Owner

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on August 19, 2020, a true and correct copy of the foregoing *Patent Owner's Unopposed Motion for Pro Hac Vice Admission of Peter M. Kohlhepp*, along with the accompanying Exhibit 2088, was served via electronic mail upon the following:

Cyrus A. Morton (Reg. No. 44,954)
Sharon Roberg-Perez (Reg. No. 69,600)
Christopher A. Pinahs (Reg. No. 76,375)
Robins Kaplan LLP
800 LaSalle Avenue, Suite 2800
Minneapolis, MN 55401
Phone: 349-8500
Fax: 612-339-4181
Email: Cmorton@robinskaplan.com
Email: Sroberg-perez@robinskaplan.com
Email: Cpinahs@robinskaplan.com

/J. Derek Vandenburg/
J. Derek Vandenburg (Lead Counsel)