

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX LIFE SCIENCES LIMITED,
Patent Owner.

IPR2020-01341 (Patent 8,142,413 B2)
IPR2020-01342 (Patent 8,142,413 B2)
IPR2020-01343 (Patent RE46,116 E)
IPR2020-01344 (Patent RE46,116 E)

Before SHERIDAN K. SNEDDEN, JAMES A. TARTAL, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.¹

SNEDDEN, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Unopposed Motion for *Pro Hac Vice* Admission of
Ryan E. Dornberger
37 C.F.R. § 42.10

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

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Medtronic, Inc. and Medtronic Vascular, Inc., (collectively “Petitioner”) filed Motions for *pro hac vice* admission of Ryan E. Dornberger in each of the above-captioned proceedings. Paper 14.² Petitioner states in each Motion that “[t]he parties have conferred, and Patent Owner does not oppose this Motion.” *Id.* at 1. The Motions are *granted*.

In accordance with 37 C.F.R. § 42.10(c), we may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause. In authorizing a motion 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 in the proceeding. *See* Paper 4, 2 (citing *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”)) (“Notice”).

Petitioner states that there is good cause for the Board to recognize Ryan E. Dornberger *pro hac vice* during these proceedings because “Mr. Dornberger is an experienced patent litigation attorney with over six years of experience in fact and expert discovery, Markman hearings, and oral arguments in patent infringement matters before Federal district courts, the United States Court of Appeals for the Federal Circuit, and the PTAB,” “has established familiarity with the subject matter at issue in this proceeding,” and “is actively involved in all aspects of Petitioners’ submissions in this

² We cite to Papers and Exhibits in IPR2020-01341. Similar items were filed in IPR2020-01342, IPR2020-01343, and IPR2020-01344.

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proceeding.” Paper 14, 1. Petitioner states further that “[i]f this motion was denied, Petitioners would be prejudiced because they 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.” *Id.* at 1–2.

Each Motion is supported by a Declaration of Mr. Dornberger (Ex. 1125) that attests to the statements above and comply with the requirements set forth in the Notice. *See* Ex. 1125 ¶¶ 1–11.

Upon consideration, Petitioner has demonstrated that Mr. Dornberger has sufficient legal and technical qualifications and familiarity with the subject matter at issue, and that there is a need for Petitioner to have counsel with his experience. *See, e.g.*, Ex. 1125 ¶¶ 2, 3, 9; Paper 14, 1–2. Petitioner therefore has established good cause for admitting Mr. Dornberger *pro hac vice* in each of the above-captioned proceedings.

Accordingly, it is

ORDERED that Petitioner’s Motions for *pro hac vice* admission of Ryan E. Dornberger in the above-captioned proceedings are *granted*; Mr. Dornberger is authorized to act as back-up counsel in these proceedings only;

FURTHER ORDERED that Petitioner must file an updated mandatory notice identifying Mr. Dornberger as back-up counsel in each of the above-captioned proceedings in accordance with 37 C.F.R. § 42.8(b)(3);

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FURTHER ORDERED that Petitioner must file a power of attorney for Mr. Dornberger in each of the above-captioned proceedings in accordance with 37 C.F.R. § 42.10(b);

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for these proceedings;

FURTHER ORDERED that Mr. Dornberger shall comply with the Consolidated Trial Practice Guide, 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; and

FURTHER ORDERED that Mr. Dornberger 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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