

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)
IPR2020-01343 (Patent RE46,116 E)

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

SNEDDEN, *Administrative Patent Judge*.

ORDER¹

Granting Petitioner's Unopposed Motions for *Pro Hac Vice* Admission of
Emily J. Tremblay
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 Emily J. Tremblay in each of the above-captioned proceedings. Paper 47 (“Mot.,” “Motion”).² Petitioner states in each Motion that “[t]he parties have conferred, and Patent Owner does not oppose this Motion.” Mot. 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 Emily J. Tremblay *pro hac vice* during these proceedings because “Ms. Tremblay has been a practicing patent litigation attorney for about four years,” “spent four years clerking for federal judges, experiencing fact and expert discovery, dispositive motions, oral arguments, and trial in patent infringement matters,” “has established familiarity with the subject matter at issue in this proceeding as well as other related proceedings,” and “is supporting Petitioner’s ongoing work in opposition to the conception and reduction to practice briefing that Patent Owner filed on May 14, 2021, and

² We cite to Papers in IPR2020-01341. Similar items were filed in IPR2020-01343.

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Petitioner’s reply in support of its Petition.” Mot. 1. Petitioner states further that “[i]f this motion were denied, Petitioner 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 Ms. Tremblay (Paper 48, “Decl.”)³ that attests to the statements above and comply with the requirements set forth in the Notice. *See* Decl. ¶¶ 1–11.

Upon consideration, Petitioner has demonstrated that Ms. Tremblay 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 her experience. *See, e.g.*, Decl. ¶¶ 2, 3, 11; Mot. 1–2. Petitioner therefore has established good cause for admitting Ms. Tremblay *pro hac vice* in each of the above-captioned proceedings.

Accordingly, it is

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

³ Petitioner filed the Declarations as Papers rather than as separate Exhibits. *See* Decl.; IPR2020-01343, Paper 43. We deem this to be harmless error; however, Petitioner is reminded that affidavits and declarations must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

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

FURTHER ORDERED that Petitioner must file a power of attorney for Ms. Tremblay 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 Ms. Tremblay 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;⁴ and

FURTHER ORDERED that Ms. Tremblay 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.

⁴ In each Declaration, Ms. Tremblay states that she has “read and will comply with the Office’s Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of 37 C.F.R.” Decl. ¶ 7. Petitioner, however, states that “Ms. Tremblay attests that she 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.” Mot. 2 (emphasis added). 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. We deem this misstatement by Petitioner to be harmless error.

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