Trials@uspto.gov
571-272-7822

Paper 78
Entered: November 8, 2021

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 Patent Owner's Unopposed Motions for *Pro Hac Vice* Admission of Peter M. Kohlhepp
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.

Teleflex Life Sciences Limited ("Patent Owner") filed Motions for *pro hac vice* admission of Peter M. Kohlhepp in each of the above-captioned proceedings. Paper 19 ("Mot.", "Motion").[2] Patent Owner states in each Motion that "[t]he parties have conferred, and the Petitioner 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").

Patent Owner states that there is good cause for the Board to recognize Peter M. Kohlhepp *pro hac vice* during these proceedings because he "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." Mot. 2. Patent Owner explains that "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,

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

2019) involving the same parties and the same patent at issue in this proceeding," has "also assisted the lead counsel, Mr. Vandenburgh, representing the Patent Owner in other IPRs involving similar technology," and "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." *Id.* at 2–3. Patent Owner states further that it "has invested significant financial resources in the related proceedings described above," and "[i]f 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." *Id.* at 3. The Motions are supported by Declarations of Mr. Kohlhepp (Ex. 2088, "Decl.") that attest to the statements above and comply with the requirements set forth in the Notice. *See* Decl. ¶¶ 1–12.

Upon consideration, Patent Owner has demonstrated that Mr. Kohlhepp has sufficient legal and technical qualifications and familiarity with the subject matter at issue, and that there is a need for Patent Owner to have counsel with their experience. *See, e.g.*, Decl. ¶¶ 2, 9–12; Mot. 2–3. Patent Owner therefore has established good cause for admitting Mr. Kohlhepp *pro hac vice* in each of the above-captioned proceedings.

Accordingly, it is

ORDERED that Patent Owner's Motions for *pro hac vice* admission of Peter M. Kohlhepp in the above-captioned proceedings are *granted*;

Mr. Kohlhepp is authorized to act as back-up counsel in these proceedings only;

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

FURTHER ORDERED that Mr. Kohlhepp 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,[3] Code of Federal Regulations; and

FURTHER ORDERED that Mr. Kohlhepp 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.

[3] Patent Owner states that "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." Mot. 4. The Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, however, are set forth in Part 42 of *Title 37*, Code of Federal Regulations. We deem this to be harmless error.

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FOR PETITIONER:

Cyrus Morton
Sharon Roberg-Perez
Christopher Pinhas
ROBINS KAPLAN LLP
cmorton@robinskaplan.com
sroberg-perez@robinskaplan.com
cpinhas@robinskaplan.com

FOR PATENT OWNER:

Derek Vandenburgh
Dennis Bremer
Meghan Christner
Shelleaha Jonas
CARLSON, CASPERS, VANDENBURGH & LINDQUIST, P.C.
dvandenburgh@carlsoncaspers.com
dbremer@carlsoncaspers.com
mchristner@carlsoncaspers.com
sjonas@carlsoncaspers.com