

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TENNANT COMPANY,

Petitioner,

v.

OXYGENATOR WATER TECHNOLOGIES, INC.,

Patent Owner.

IPR2021-00602

IPR2021-00625

Patent RE 45,415 E¹

Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Motions for *Pro Hac Vice* Admission of
Adam R. Steinert
37 C.F.R. § 42.10

¹ We exercise our discretion to issue one Order to be entered in each proceeding. The parties are not authorized to use a multiple-case caption.

IPR2021-00602
IPR2021-00625
Patent RE 45,415 E1

I. INTRODUCTION

On March 17, 2021, Petitioner, Tennant Company (“Petitioner”), filed a motion for *pro hac vice* admission of Adam R. Steinert in each of the above-captioned proceedings. Paper 4 (collectively “Motions”).² Patent Owner, Oxygenator Water Technologies, Inc., did not file an opposition. For the reasons provided below, Petitioner’s Motions are granted.

II. DISCUSSION

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, subject to the condition that lead counsel be a registered practitioner. The representative Order authorizing motions for *pro hac vice* admission requires a statement of facts showing there is good cause for us to recognize counsel *pro hac vice*, and an affidavit or declaration of the individual seeking to appear. *See* Paper 3, 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”).

In this proceeding, lead counsel for Petitioner, R. Scott Johnson, is a registered practitioner. Motions, 4. Petitioner asserts that there is good cause for us to recognize Mr. Steinert *pro hac vice* in this proceeding. Motions 2–4. Petitioner’s assertions in this regard are supported by a Declaration of Mr. Steinert. Paper 4, 5–9.³

² Paper numbers refer to IPR2021-00602. Corresponding Motions and Declarations were filed in IPR2021-00625.

³ Petitioner filed the Declarations as an addendum to the Motions (Paper 4) in the Patent Trial and Appeal Board End to End (PTAB E2E) system. The

IPR2021-00602
IPR2021-00625
Patent RE 45,415 E1

Mr. Steinert declares that he is a member in good standing of the State Bars of Minnesota and New York and that he is admitted to practice before several district and appellate courts. Paper 4 ¶ 2. Mr. Steinert also declares that he is familiar with the subject matter at issue in this proceeding, including U.S. Patent No. RE 45,415 E and the prior art references that are asserted by Petitioner. *Id.* ¶ 13. Moreover, the facts alleged in Mr. Steinert's Declaration comply with all the requirements set forth in our representative Order authorizing motions for *pro hac vice* admission. *See id.* ¶¶ 1–8.

On this record, we determine that Mr. Steinert has sufficient legal and technical qualifications to represent Petitioner in this proceeding. Accordingly, Petitioner has established that there is good cause for the *pro hac vice* admission of Mr. Steinert in this proceeding.

III. ORDER

Accordingly, it is

ORDERED that Petitioner's Motions for Admission *Pro Hac Vice* of Adam R. Steinert are *granted*;

FURTHER ORDERED that Mr. Steinert is authorized to represent Petitioner only as back-up counsel in these proceedings;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel in this proceeding;

parties are reminded that affidavits and declarations must be filed as exhibits, so they may be referenced individually by exhibit number. *See* 37 C.F.R. § 42.63.

IPR2021-00602
IPR2021-00625
Patent RE 45,415 E1

FURTHER ORDERED that Mr. Steinert shall comply with the Consolidated Trial Practice Guide⁴ (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. Steinert shall be subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), as well as the Office's Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2021-00602
IPR2021-00625
Patent RE 45,415 E1

FOR PETITIONER:

R. Scott Johnson
Adam R. Steinert
Fredrikson & Byron, P.A.
rsjohnson@fredlaw.com
asteinert@fredlaw.com

FOR PATENT OWNER:

J. Derek Vandenburg
Aaron W. Pederson
Nathan D. Louwagie
Carlson, Caspers, Vandenburg, & Lindquist, P.A.
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com