

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORPAK MEDSYSTEMS, INC. and HALYARD HEALTH, INC,
Petitioners

v.

KIRN MEDICAL DESIGN, L.L.C. and
APPLIED MEDICAL TECHNOLOGY, INC.
Patent Owner

Inter Partes Review No. IPR2017-01990
Patent 6,631,715

Mailed: September 27, 2017

Before PATRICK E. BAKER, *Trial Paralegal*

NOTICE OF FILING OF PATENT OWNER'S MOTION FOR *PRO HAC VICE*
ADMISSION OF MICHAEL PADDEN AS BACK-UP COUNSEL UNDER 37
C.F.R. § 42.10(c)

A pro hac vice motion in the above proceeding is filed herewith.

Pursuant to 37 C.F.R. § 42.10(c), and the Board's order received September 13, 2017 authorizing the filing of the instant motion, exclusive licensee APPLIED MEDICAL TECHNOLOGY, INC. respectfully requests that the Board recognize Michael P. Padden, Esq., as back-up counsel *pro hac vice* on behalf of Patent Owner during this proceeding.

In an *Inter Partes* Review (IPR), the Board has discretion under 37 C.F.R. § 42.10(c) to recognize counsel *pro hac vice*. 37 C.F.R. § 42.10(c) provides that:

The Board 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 and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

This motion is being filed no sooner than twenty one (21) days after service of the petition in accordance with the "Order -- Authorizing Motion for *Pro Hac Vice* Admission" in Case IPR2013-00639, Paper 7, a copy of which is available on the Board website under "Representative Orders, Decisions, and Notices."

I. Statement of Facts Showing That There Is Good Cause For The Board To Recognize Mr. Padden *Pro Hac Vice* In This Proceeding

Based on the following facts, and supported by the Declaration of Mr. Michael P. Padden submitted herewith, there is good cause for the Board to recognize Mr. Padden as back-up counsel *pro hac vice* in this matter:

1. Lead counsel in this *Inter Partes* Review proceeding is Gregory M. York.

Mr. York is a partner at the law firm Pearne & Gordon LLP and registered to practice before the United States Patent and Trademark Office (Reg. No. 57,533).

2. Mr. Padden is a partner at the law firm Pearne & Gordon LLP. Declaration of Michael P. Padden, Exhibit 2001, ¶ 1.
3. Mr. Padden is an experienced litigating attorney. Mr. Padden has been a litigating attorney for more than thirty years and has been litigating patent cases for at least twenty years. Mr. Padden is a co-chair of the Patent Litigation Subcommittee of the American Bar Association's Section of Litigation. He was a member of the working group that drafted the Local Patent Rules for the United States District Court for the Northern District of Illinois. He is a frequent speaker and author on topics relating to patent litigation. *Id.*, ¶ 2.
4. Mr. Padden is a member in good standing of the State Bar of Illinois. *Id.*, ¶ 3.
5. Mr. Padden has never been suspended or disbarred from practice before any court or administrative body. *Id.*, ¶ 4.
6. This is Mr. Padden's third application for *pro hac vice* admission to the Patent Trial and Appeal Board. No application under his name for admission to practice before any court or administrative body has been denied. *Id.*, ¶ 5.

7. Mr. Padden is a member of the Trial Bar of the United States District Court for the Northern District of Illinois and has also been admitted to practice in federal district courts in Ohio, Indiana, Michigan, Florida, and Wyoming. Mr. Padden has been allowed to appear *pro hac vice* in numerous state and federal courts throughout the country and has never been denied admission *pro hac vice*. *Id.*, ¶6.
8. No sanctions or contempt citations have ever been imposed against Mr. Padden by any court or administrative body. *Id.*, ¶7.
9. Mr. Padden has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trial set forth in Part 42 of 37 C.F.R. *Id.*, ¶8.
10. Mr. Padden understands that he will be subject to the USPTO Rules of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.*, ¶9.
11. Mr. Padden has established familiarity with the subject matter at issue in this proceeding. He has participated extensively in advising Patent Owner in this matter. Through his participation to date he has become very familiar with the '715 Patent and the prior art cited in the Petition. *Id.*, ¶10.
12. Mr. Padden is also the lead trial counsel for Patent Owner in the concurrent litigation *Applied Medical Technology, Inc. v. Corpak Medsystems, Inc.*,

1:16-cv-02190 (N.D. Ohio), involving the same patent and prior art submitted by Petitioner in the Petition of this proceeding. As lead trial counsel of the concurrent litigation, he is involved in claim construction regarding the '715 patent.

II. Declaration of Mr. Padden

In support of this motion, a declaration of Michael P. Padden is submitted herewith (Exhibit 2001) showing that Mr. Padden satisfies the requirements for *pro hac vice* admission as set forth in IPR2013-00639, Paper 7, dated October 15, 2013.

Given his knowledge of the subject matter at issue in this proceeding and his experience in litigating patent validity issues, Patent Owner would benefit from Mr. Padden's expertise and involvement in this proceeding.

III. Conclusion

Patent Owner respectfully submits that, in light of the foregoing, the Board should recognize Mr. Padden as back-up counsel *pro hac vice* for Patent Owner during this proceeding.

Respectfully submitted,

Date: September 27, 2017

By: /Gregory M. York/
Gregory M. York (Reg. No. 57,533)
Pearne & Gordon LLP
Attorney for Patent Owner

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