

Filed on behalf of: Maillefer Instruments Holding S.a.r.l.

Paper \_\_\_\_\_

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Date filed: July 31, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDGE ENDO, LLC,  
Petitioner,

v.

MAILLEFER INSTRUMENTS HOLDING S.A.R.L.,  
Patent Owner.

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Case IPR2018-01349  
Patent 9,801,696

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**PATENT OWNER'S MOTION FOR ADMISSION  
*PRO HAC VICE* OF STEVEN LIEBERMAN**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**I. Relief Requested**

Pursuant to 37 C.F.R. § 42.10, Patent Owner Maillefer Instruments Holding S.a.r.l. (“Patent Owner”) requests that the Board admit Steven Lieberman *pro hac vice* in this proceeding to serve as back-up counsel.

**II. Statement of Facts Showing There is Good Cause for the Board to Recognize Counsel *Pro Hac Vice* During the Proceeding**

In accordance with 37 C.F.R. § 42.10(c), 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. § 42.10(c) indicates that, “where lead counsel is a registered practitioner, a motion to appear *pro hac vice* may be granted upon a showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” The facts here establish good cause for the Board to recognize Steven Lieberman *pro hac vice* during this proceeding, so that he may participate in, *inter alia*, oral hearings, depositions, and conferences with the Board.

1. Lead counsel, Joseph a. Hynds, is a registered practitioner.

2. Counsel, Steven Lieberman, is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding. Accompanying this motion is the Declaration of Steven Lieberman in Support of Patent Owner's Motion for Admission *Pro Hac Vice* ("Lieberman Decl."). Mr. Lieberman is a member in good standing of the Bars of the State of New York and the District of Columbia, admitted to practice in the United States District Courts for the District of Columbia, Maryland, the Northern District of California, and the Northern, Eastern, and Southern Districts of New York. Lieberman Decl., ¶ 2. Mr. Lieberman is also admitted to practice in the Courts of Appeals for the District of Columbia, the Second Circuit, the Fourth Circuit, the Federal Circuit, and the United States Supreme Court. *Id.* Mr. Lieberman has served as a President of the Giles S. Rich American Inn of Court, and the D.C. Inn is devoted to the practice of intellectual property law. *Id.*, ¶ 3. Mr. Lieberman has been litigating patent cases since 1990, primarily as lead counsel. *Id.*, ¶ 4.

3. Mr. Lieberman is familiar with the subject matter at issue in this proceeding by virtue of his representing the Patent Owner in a lawsuit brought against the Petitioner, *Dentsply Sirona Inc. et al. v. Edge Endo, LLC et al.*, Case No. 1:17-cv-01041-WJ-SCY (D. N.M.), involving the patent at issue in this proceeding. Lieberman Decl., ¶ 11.

4. Mr. Lieberman attests to each of the listed items required by the “Order -- Authorizing Motion for *Pro Hac Vice* Admission in Case IPR2013-00639” referenced in the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, mailed July 18, 2018 (Paper 3). *See* Lieberman Decl., ¶¶ 1-11.

5. Mr. Lieberman has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials, as set forth in Part 42 of 37 C.F.R. Lieberman Decl., ¶ 8. Mr. Lieberman agrees to be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a) and to be subject to the USPTO Rules of Professional Conduct as set forth in Changes to Representation of Others Before the United States Patent and Trademark Office; Final Rule, 78 Fed. Reg. 20180 (Apr. 3, 2013) (effective May 3, 2013). Lieberman Decl., ¶ 9.

### **III. Conclusion**

The requirements for admission *pro hac vice* being hereby established, Patent Owner Maillefer Instruments Holding S.a.r.l., respectfully requests that the Board admit Steven Lieberman *pro hac vice* in this proceeding.

Respectfully submitted,

Date: July 31, 2018

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