UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED LIMITED, RESMED INC., and RESMED CORP.,
Petitioner

v.

FISHER & PAYKEL HEALTHCARE LIMITED
Patent Owner

Case IPR2016-01719
Patent 6,398,197

PETITIONER'S
UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION
OF FRANK E. SCHERKENBACH UNDER 37 C.F.R. § 42.10(c)

EXHIBITS

EX. #	Exhibit Description
RMD1001	U.S. Patent No. 6,398,197 to Dickinson et al. ("the '197 patent")
RMD1002	Relevant portions of the file history of the '197 patent
RMD1003	Declaration of Mr. Alexander Virr
RMD1004	U.S. Patent No. 6,135,432 to Hebblewhite et al. ("Hebblewhite")
RMD1005	File History of Hebblewhite and parent app. no. 08/633,413
RMD1006	U.S. Patent No. 5,953,763 to Gouget ("Gouget")
RMD1007	File History of Gouget parent app. no. 08/737,879
RMD1008	U.S. Patent No. 5,231,979 to Rose et al. ("Rose")
RMD1009	U.S. Patent No. 5,588,423 to Smith ("Smith")
RMD1010	PCT Pub. WO 98/04311 to Netzer and a certified translation thereof ("Netzer")
RMD1011	File History of U.S. Patent No. 6,006,748 (App. No. 08/951,357)
RMD1012	Fisher & Paykel Healthcare, "HC200 Series Humidified CPAP System" Instruction Sheet, (Rev. B)
RMD1013	Fisher & Paykel Healthcare, SEC Form-1 Registration Statement
RMD1014	Stuff.co.nz, "Sleeping beautifully" article

EX. #	Exhibit Description
RMD1015	Fisher & Paykel Healthcare, "HC200 Series Nasal CPAP Blower & Heated Humidifier User's Manual," (Rev. A)
RMD1016	Fisher & Paykel, Correspondence regarding FDA 510(k) submission
RMD1017	U.S. Patent No. 485,127 to Lynch ("Lynch")
RMD1018	U.S. Patent No. 933,301 to Hartmann ("Hartmann")
RMD1019	U.S. Patent No. 1,813,959 to Romanoff ("Romanoff")
RMD1020	Patent Owner's Complaint for *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 3:16-cv-02068-GPC-WVG (S.D. Cal.)
RMD1021	Patent Owner's Complaint for *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 2:16-cv-06099-R-AJW (C.D. Cal.)
RMD1022	Patent Owner's Notice of Voluntary Dismissal Without Prejudice for *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 2:16-cv-06099-R-AJW (C.D. Cal.)
RMD1023	Petitioners' Complaint for *ResMed Inc., et al. v. Fisher & Paykel Healthcare Corp. Ltd., et al.*, Case No. 3:16-cv-02072-JAH-MDD (S.D. Cal.)
RMD1024	Petitioners' Notice of Voluntary Dismissal Without Prejudice for *ResMed Inc., et al. v. Fisher & Paykel Healthcare Corp. Ltd., et al.*, Case No. 3:16-cv-02072-JAH-MDD (S.D. Cal.)
RMD1025	Transcript of Telephone Conference between Board and Parties on January 25, 2017
RMD1026	Second Declaration of Mr. Alexander Virr

EX. #	Exhibit Description
RMD1027	Deposition Transcript of Dr. Hartmut Schneider
RMD1028	Declaration of Frank E. Scherkenbach in support of unopposed motion for *pro hac vice* admission

Pursuant to 37 C.F.R. § 42.10(c), the Petitioner ResMed Limited ("ResMed") respectfully requests that the Board recognize Frank E. Scherkenbach as counsel *pro hac vice* in this proceeding. ResMed seeks the counsel of Frank E. Scherkenbach in this proceeding due to his experience in representing ResMed in other patent-related matters and, particularly, due to his familiarity with the substantive and technical issues involved in this proceeding. This motion is authorized by the Notice of Filing Date that was mailed on September 16, 2016. ResMed conferred with Patent Owner on October 9, 2017, and Patent Owner does not oppose ResMed's motion here.

Where the lead counsel is a registered practitioner, a non-registered practitioner may be permitted to appear *pro hac vice* "upon a showing that counsel is an experienced litigating attorney and has established familiarity with the subject matter at issue in the proceeding." 37 C.F.R. § 42.10(c); *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (setting forth requirements for *pro hac vice* admission). As set forth in his declaration submitted herewith (Exhibit 1028), Mr. Scherkenbach is a Principal at Fish & Richardson P.C. and a patent litigation attorney with significant experience advising clients regarding patent matters, including as counsel in multiple litigations involving ResMed and its patented technology related to masks/systems for treating sleep disorders (e.g., including CPAP mask systems). Mr.

Scherkenbach also represents Petitioner in connection with the underlying district court litigation involving the patent at issue in this IPR proceeding, U.S. Patent No. 6,398,197 ("the '197 patent"). Based on this underlying litigation and the other facts detailed below and in his declaration, Mr. Scherkenbach has significant familiarity with the particular subject matter in this IPR proceeding.

Statement of Facts

Mr. Scherkenbach is a patent litigation attorney with more than 25 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. Mr. Scherkenbach litigates patent cases before various federal courts and administrative agencies, including the Patent Office where he has handled prior IPR trials before the Board. Through his years of practice, Mr. Scherkenbach has gained substantial experience in jury trials, discovery, *Markman* hearings, and appeals. His declaration provides Appendix A, as evidence, with additional details of Mr. Scherkenbach's biography.

Frank E. Scherkenbach also has particular experience and familiarity with the substantive and technical issues involved in this *inter partes* review proceeding. ResMed requests that the Board recognize Mr. Scherkenbach as counsel *pro hac vice* because Mr. Scherkenbach serves a unique and critical role for Petitioner regarding this and other IPR proceedings involving the same parties

here. Mr. Scherkenbach has substantial experience and expertise representing ResMed regarding patents involving the applicable masks/systems for treating sleep disorders, which are relevant technologies at issue in this proceeding.

Mr. Scherkenbach represents the ResMed in the concurrent litigation involving the '197 Patent (*Fisher & Paykel Healthcare Ltd. V. ResMed Corp.*, 3:16-cv-02068-DMS-WVG (S.D. Cal.)). Mr. Scherkenbach's knowledge of this litigation matter is important for purposes of this proceeding for several reasons, including ensuring consistency between Petitioner's position in those matters and in this proceeding. Mr. Scherkenbach has reviewed the '197 Patent in the concurrent litigation, which overlaps with the corresponding issues in this IPR proceeding involving the '197 Patent. Moreover, Mr. Scherkenbach's work has included a review of the Petition for IPR here (including the proposed invalidity grounds therein, the cited references, and exhibits), the Declaration of Mr. Eaton, and the Board's Decision instituting *Inter Partes* Review of the '197 Patent in this proceeding. Mr. Scherkenbach also has significant familiarity with the prior art references relied on in the petition from the concurrent litigation related to this IPR proceeding.

As explained in Mr. Scherkenbach's declaration, he is uniquely suited to appear *pro hac vice* before the Office based upon his substantial knowledge of this case, the concurrent litigation, and the technology at issue in these proceedings

involving ’197 patent. This knowledge includes his analysis of a significant number of patents, articles, products, and other materials regarding masks/systems for treating sleep disorders. He has used this knowledge on behalf of ResMed to help prepare materials for the concurrent litigations.

If the Board denies the present Motion, not only is ResMed denied its choice of counsel, but ResMed would also be prejudiced by having to undertake the burdensome and costly task of preparing another attorney to replace Mr. Scherkenbach’s specific combination of familiarity with the concurrent litigation, the ‘197 patent, the asserted prior art references, and the relevant technologies for masks/systems for treating sleep disorders. ResMed has repeatedly retained Mr. Scherkenbach regarding disputes involving mask-related patents to provide continuity across cases involving related technologies, and thus ResMed would be prejudiced if Mr. Scherkenbach could not fully represent its interests here. Accordingly, ResMed respectfully requests that the Board avoid such prejudice and grant this Motion.

Declaration of Individual Seeking to Appear

This Motion for *Pro Hac Vice* Admission is accompanied by a Declaration of Frank E. Scherkenbach as required by the Order Authorizing Motion for *Pro Hac Vice* mailed September 16, 2016. As Mr. Scherkenbach stated in his

accompanying Declaration, he has read, will comply with, and agrees to be subject to the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations. Additionally, Mr. Scherkenbach has previously applied to appear before the Board in the following proceedings and all were granted: IPR2013-00206, IPR2013-00208, IPR2013-00395, IPR2013-00396, IPR2014-00034, IPR2014-00073, IPR2014-00074, IPR2014-00075, IPR2014-00081, and IPR2014-00087. Mr. Scherkenbach is concurrently applying to appear *pro hac vice* in the following proceedings: IPR2016-01716, IPR2016-01717, IPR2016-01729, IPR2016-01730, IPR2016-01731, IPR2016-01725, and IPR2016-01727. As also set forth in his Declaration, Mr. Scherkenbach is a member in good standing of the Bars of the States of California and Massachusetts and is admitted to practice in many federal courts. He has litigated dozens of patent cases across the country.

Accordingly, ResMed submits that there is good cause under 37 C.F.R. § 42.10(c) for the Board to recognize Frank E. Scherkenbach as counsel *Pro Hac Vice* during this proceeding.

Date: October 27, 2017

Respectfully submitted,
/Michael T. Hawkins/
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 27, 2017, a complete and entire copy of this Petitioner's Unopposed Motion for *Pro Hac Vice* Admission of Frank E. Scherkenbach with supporting declaration was provided via email to the Patent Owner by serving the correspondence email address of record as follows:

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