UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEURENT MEDICAL INC. & NEURENT MEDICAL LTD.

Petitioners,

v.

AERIN MEDICAL INC.,

Patent Owner.

Case No. IPR2024-00276

U.S. Patent No. 9,415,194

PETITIONERS' UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF JOSHUA L. STERN PURSUANT TO 37 C.F.R. § 42.10(c)

I. STATEMENT OF RELIEF REQUESTED

Petitioners Neurent Medical Inc. and Neurent Medical Ltd. (collectively, "Neurent" or "Petitioners") respectfully requests that the Patent Trial and Appeal Board ("Board") enter an order granting the *pro hac vice* admission of Joshua L. Stern as back-up counsel for Petitioners in this proceeding, Case No. IPR2024-00276.[1] Petitioners have conferred with counsel for Patent Owner, and Patent Owner does not oppose this motion.

II. APPLICABLE RULES

Pursuant to 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." "[A] motion to appear *pro hac vice* by counsel who is not a registered

[1] Petitioners are concurrently filing an unopposed motion to admit Joshua L. Stern as back-up counsel for Petitioners in the following related proceedings, Case Nos. IPR2024-00275, IPR2024-00277, IPR2024-00278, IPR2024-00279, IPR2024-00280, IPR2024-00282, and IPR2024-00669. *See* Petitioners' First Updated Mandatory Notices, IPR2024-00276, Paper 8 at 2-3 (identifying related IPR proceedings).

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." *Id.*

The PTAB set forth requirements for filing motions for pro hac vice admission in *Unified Patents, Inc. v. Parallel Iron, LLC*, Case IPR2013-00639, Paper 7 ("Order – Authorizing Motion For Pro Hac Vice Admission – 37 C.F.R. §42.10") (PTAB Oct. 15, 2013). A motion seeking *pro hac vice* admission must be filed no sooner than twenty-one (21) days after service of the petition, must contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding, and must be accompanied by a declaration or affidavit of the individual seeking *pro hac vice* admission. *Id.* at 2-3. The affidavit or declaration must attest to: (1) membership in good standing of the Bar of at least one State or the District of Columbia; (2) no suspensions or disbarments from any practice before any court or administrative body; (3) no application for admission to practice before any court or administrative body ever denied; (4) no sanctions or contempt citations imposed by any court or administrative body; (5) the individual seeking to appear has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R.; (6) the individual will 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); (7) all other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and (8) familiarity with the subject matter at issue in the proceeding. *Id.*

III. FACTS DEMONSTRATING GOOD CAUSE FOR THE BOARD TO RECOGNIZE JOSHUA L. STERN *PRO HAC VICE* DURING THIS PROCEEDING

On January 18, 2024, Petitioners filed a petition for inter partes review in IPR2024-00276 directed to U.S. Patent No. 9,415,194. Petitioners' lead counsel, David Cavanaugh, is a registered practitioner (Registration No. 36,476). Joshua L. Stern, a partner at Wilmer Cutler Pickering Hale and Dorr LLP, seeks *pro hac vice* admission in this proceeding. Accompanying this motion as Exhibit 1082 is the Declaration of Joshua L. Stern in Support of Motion for Admission *Pro Hac Vice* ("Stern Decl.").

Mr. Stern is a member of good standing of the Bars of the District of Columbia, the Commonwealth of Massachusetts, the State of New Jersey, and the State of New York. *See* Stern Decl., ¶¶2-4 (Ex.1082). He has never been suspended or disbarred from practice before any court or administrative body, and he has never been denied admission to practice before any court or administrative body. *See* Stern

Decl. ¶¶5-6 (Ex.1082). No court or administrative body has ever imposed sanctions or contempt citations on Mr. Stern. *See* Stern Decl. ¶7 (Ex.1082).

Mr. Stern has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 C.F.R. Mr. Stern understands that he will 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). *See* Stern Decl. ¶¶8-9 (Ex.1082).

Mr. Stern has appeared *pro hac vice* in the following proceedings before the United States Patent and Trademark Office in the last three years: *BioNTech SE v. ModernaTX, Inc.*, Case No. IPR2023-01358; *BioNTech SE v. ModernaTX, Inc.*, Case No. IPR2023-01359; *Quest Diagnostics Inc. v. Ravgen, Inc.*, Case No. IPR2021-00788; *Quest Diagnostics Inc. v. Ravgen, Inc.*, Case No. IPR2021-00789; *Quest Diagnostics Inc. v. Ravgen, Inc.*, Case No. IPR2021-00790; *Quest Diagnostics Inc. v. Ravgen, Inc.*, Case No. IPR2021-00791; *Pfizer Inc. v. uniQure BioPharma BV*, Case No. IPR2021-00925; *Pfizer Inc. v. uniQure BioPharma BV*, Case No. IPR2021-00926; and *Pfizer Inc. v. uniQure BioPharma BV*, Case No. IPR 2021-00928. *See* Stern Decl. ¶10 (Ex.1082).

As his accompanying declaration demonstrates, Mr. Stern has an established familiarity with the subject matter at issue in this proceeding. Mr. Stern is an

experienced patent litigator with more than thirteen years of experience. *See* Stern Decl. ¶2 (Ex.1082). Mr. Stern has reviewed the '194 patent and its file history, as well as the Petition, Institution Decision, and the exhibits in this proceeding. *See* Stern Decl. ¶11 (Ex.1082). Mr. Stern has been involved in numerous patent litigations and has extensive experience with the USPTO's rules and regulations. *See* Stern Decl. ¶¶2, 10 (Ex.1082). Furthermore, Mr. Stern represents Petitioners in *Aerin Medical Inc. and The Foundry LLC v. Neurent Medical Inc. and Neurent Medical Ltd.*, Case No. 1:23-cv-00756-JLH (D. Del.), the related district court litigation identified in Petitioners' Mandatory Notices.[2] *See* Stern Decl. ¶12 (Ex.1082). Through this litigation, Mr. Stern developed extensive experience with the subject matter at issue in this proceeding.

IV. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Board admit Joshua L. Stern *pro hac vice* in this proceeding.

[2] *See* Petitioners' First Updated Mandatory Notices, IPR2024-00276, Paper 8 at 2 (identifying related district court litigation).

Respectfully submitted,

By: /David L. Cavanaugh/
David L. Cavanaugh
Registration No. 36,476

Counsel for Petitioners

CERTIFICATE OF SERVICE

Pursuant to an agreement between Petitioners and Patent Owner, I hereby certify that, on September 13, 2024, I caused a true and correct copy of the following materials:

- Petitioners' Unopposed Motion for *Pro Hac Vice* Admission of Joshua L. Stern Pursuant to 37 C.F.R. § 42.10(c)
- Petitioners' Updated Table of Exhibits
- Exhibit 1082

to be served on Patent Owner via electronic mail to:

Heath J. Briggs, BriggsH@gtlaw.com;

Kathleen A. Daley, kathleen.daley@finnegan.com;

Sonja W. Sahlsten, sonja.sahlsten@finnegan.com;

Jason Stach, jason.stach@finnegan.com;

Anthony J. Berlenbach, anthony.berlenbach@finnegan.com;

Christopher C. Howes, christopher.howes@finnegan.com;

Kathleen C. Galleher, kathleen.hanley@finnegan.com;

Trenton Ward, Trenton.Ward@gtlaw.com;

Benjamin P. Gilford, gilfordb@gtlaw.com;

Elana Araj, Elana.Araj@gtlaw.com; and

Stephen M. Ullmer, UllmerS@gtlaw.com.

/Gilbert Smolenski/
Gilbert Smolenski
Registration No. 78,549

Petitioners' Table of Exhibits

Exhibit	Description
1001	U.S. Patent No. 9,415,194 ("'194 patent")
1002	Declaration of Dr. John DelGaudio
1003	File History of U.S. Patent No. 9,415,194
1004-1005	RESERVED
1006	District Court Amended Complaint
1007	Exhibit U to District Court Amended Complaint
1008	Docket Navigator District of Delaware Statistics as of January 18, 2024
1009	RESERVED
1010	U.S. Patent No. 6,517,535 ("Edwards-'535")
1011	U.S. Patent No. 5,575,788 ("Baker")
1012	RESERVED
1013	WO 2010/077980 ("Baker-'980")
1014-1016	RESERVED
1017	Chen et al., "Radiofrequency treatment of nasal posterior-under nerve, ethmoidal nerve and infraturbinal for perennial allergic rhinitis under nasal endoscope," 11:3 China J. Endoscopy 239 (March 2005) (English translation) ("Chen")
1018	File History of U.S. Patent No. 8,936,594
1019	U.S. Patent App. No. 2007/0219600 ("Gertner")
1020	RESERVED
1021	U.S. Patent App. No. 2005/0240147 ("Makower")
1022-1024	RESERVED
1025	U.S. Patent No. 874,178 ("De Forest")
1026	U.S. Patent No. 3,538,919 ("Meyer")

Exhibit	Description
1027	U.S. Patent No. 3,117,571 ("Fry")
1028	RESERVED
1029	Arora et al., Cryodestruction of Vidian Nerve Branches, 32:3 Indian J. Otolaryngology 80 (September 1980) ("Arora")
1030-1036	RESERVED
1037	Chung, Cough: Causes, Mechanisms and Therapy, Blackwell Publ'g Ltd (2003) ("Chung")
1038	U.S. Patent No. 6,109,268 ("Thapliyal")
1039	Banhiran, Quality of life in patients with chronic rhinitis after radiofrequency inferior turbinate reduction, J. Med Assoc Thai, Vol. 93 No.8 (2010) ("Banhiran")
1040	Kong et al., "Clinical observation on radiofrequency ablation treatment in perennial allergic rhinitis" J. Clin Otorhinolaryngol (China) Vol.19, No.5 (March 2005)(English translation) ("Kong")
1041-1045	RESERVED
1046	U.S. Patent No. 3,941,121 ("Olinger")
1047	U.S. Patent No. 4,271,848 ("Turner")
1048	Nomura et al., Distribution and Clinical Significance of Autonomic Nervous System in the Human Nasal Mucosa, 73 Acta Otolaryng 493 (1972). ("Nomura")
1049	Akiyoshi Konno, Historical, Pathophysiological, and Therapeutic Aspects of Vidian Neurectomy, 10 Curr Allergy Asthma Rep 105 (2010). ("Konno")
1050-1054	RESERVED
1055	Fang et al., Nasal endoscopy combined with multple radiofrequency for perennial allergic rhinitis, 25:7 J. First Mil Med Univ 876 (2005) (English translation) ("Fang")
1056	Liang et al., Radiofrequency treatment of ethmoidal nerve with allergic rhinitis under nasal endoscopy, 13:8 J. Clin

Exhibit	Description
	Otorhinolaryngol (China) 341 (August 1999) (English translation) ("Liang")
1057-1058	RESERVED
1059	Chinese Patent No. 2225227 (English translation) ("Liang '227")
1060	Andrew P. Lane, Nasal anatomy and physiology 12 Facial Plast Surg Clin N Am 387 (2004) ("Lane")
1061-1065	RESERVED
1066	U.S. Patent App. No. 2004/0230188 ("Cioanta")
1067-1069	RESERVED
1070	Declaration of June Munford
1071	Translator Declaration for Chen
1072	Translator Declaration for Liang
1073	Translator Declaration for Fang
1074	Translator Declaration for Kong
1075	Munford Appendices for Chen
1076	Munford Appendices for Liang
1077	Munford Appendices for Fang
1078	Munford Appendices for Kong
1079	Additional Appendices to Munford Declaration
1080	Translator Declaration for Liang '227
1081	RESERVED
1082	Declaration of Joshua L. Stern