

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,

Patent Owner.

PGR2025-00048

Patent No. 12,187,573

**PETITIONER'S NOTICE OF INTENT TO DESIGNATE
SCOTT D. SHERWIN AS A PROVISIONALLY RECOGNIZED
PTAB ATTORNEY ELIGIBLE FOR AUTOMATIC
PRO HAC VICE ADMISSION AS BACK-UP COUNSEL
PURSUANT TO 37 C.F.R. § 42.10**

Pursuant to 37 C.F.R. §42.10, Petitioner Milwaukee Electric Tool Corporation (“Petitioner”) respectfully files a notice of intent to designate Scott D. Sherwin as a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission as backup counsel in this proceeding. The facts, supported by the attached Declaration of Scott D. Sherwin in Support of Notice of Intent to Designate a Provisionally Recognized PTAB attorney as Back-up Counsel (“Sherwin Decl.”), establish Mr. Sherwin is a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission in this proceeding. Petitioner conferred with Patent Owner, and Patent Owner confirmed that it does not oppose this Notice.

I. STATEMENT OF FACTS

Lead counsel for Petitioner, Alexander B. Stein, is a registered practitioner (Reg. No. 71,397) and experienced in *post-grant* proceedings in the USPTO. Backup counsel David Bernstein is a registered practitioner (Reg. No. 71,064) and experienced in *post-grant* proceedings in the USPTO. Along with David Bernstein, Scott Sherwin represents Milwaukee Electric Tool Corporation in connection with the pending district court action captioned *Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, 1:25-cv-00143-JLH (D. De.); and Certain Glow Fish Tape Systems,

Safety Helmet Systems, and Components Thereof, Inv. No. 337-TA-1442. David P. Bernstein, Ph.D. (Reg. No. 71,064) is also counsel of record for these matters.

Scott Sherwin joined Morgan Lewis as an intellectual property litigation attorney in March 2011 after serving for four years as an associate at Howrey LLP. (Sherwin Decl. ¶ 1.) Mr. Sherwin was promoted to partner in October 2017. (Sherwin Decl. ¶ 1.)

While at Howrey LLP, and now at Morgan Lewis, Mr. Sherwin has primarily focused his practice on patent litigation. (*Id.* at ¶ 2.) In that time, Mr. Sherwin has gained experience conducting technical infringement and validity analysis, working with technical experts to prepare reports on infringement and validity issues, preparing for depositions of technical experts and fact witnesses, briefing claim construction issues, preparing for *Markman* hearings, drafting dispositive motions on a range of technical issues, and representing clients in patent litigation trials and hearings before district courts around the country. (Sherwin Decl. ¶ 2.) Further, Mr. Sherwin has assisted his colleagues at Morgan Lewis in proceedings before the Board, and he is familiar with its established practices. (*Id.*)

Mr. Sherwin is a member in good standing of the Illinois State Bar, admitted to practice in the United States Court of Appeals for the Federal Circuit, and the United States District Courts for the Northern District of Illinois, as well as the

Western District of New York, the Eastern District of Texas, and the Eastern District of Wisconsin. (*Id.* at ¶ 3.)

He has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶ 4.) He has never had an application for admission to practice before any court or administrated body denied. *Id.* Nor has any court or administrative body imposed sanctions or contempt citations against him. (*Id.*)

Mr. Sherwin has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of 37 C.F.R. (*Id.* at ¶ 5.) He attests to satisfying all requirements set forth by the Board for *pro hac vice* recognition of a provisionally recognized PTAB attorney. (*Id.* at ¶ 1.) He also acknowledges and agrees to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 *et seq.*, and to disciplinary jurisdiction under 37 C.F.R. §11.19(a). (*Id.* at ¶ 5.)

Mr. Sherwin has previously applied to appear *pro hac vice* before the Office, and has previously been recognized *pro hac vice* in a Board proceeding in the following IPR proceedings: IPR2020-00264, IPR2020-00265, IPR2020-00274, IPR2020-00275, IPR2024-01400 and IPR2024-01401. (*Id.* at ¶ 6.) He has also not been subsequently denied permission to appear *pro hac vice* in a Board proceeding. (*Id.*)

Mr. Sherwin has established familiarity with the subject matter at issue in this proceeding. (*Id.* at ¶ 7.) Mr. Sherwin graduated from the University of Notre Dame with a Bachelor of Science in Mechanical Engineering. (*Id.*) He has also reviewed in detail and is familiar with U.S. Patent No. 12,187,573.

II. ANALYSIS

The facts contained in the Statement of Facts above and Mr. Sherwin's Declaration establish that Mr. Sherwin is a provisionally recognized PTAB attorney and eligible for automatic *pro hac vice* admission in this proceeding under 37 C.F.R. § 42.10 as backup counsel. Lead counsel Alexander B. Stein and backup counsel David Bernstein are registered practitioners and experienced in *post-grant* proceedings in the USPTO. Mr. Sherwin is an experienced patent litigation attorney, and he has an established familiarity with the subject matter at issue in this proceeding.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully files a notice of intent to designate Scott D. Sherwin as a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission in this proceeding.

Petitioner will subsequently file updated mandatory Notices in each of the referenced proceedings in accordance with 37 C.F.R. § 42.8(b)(3), identifying Mr.

Sherwin as backup counsel.

Dated: May 28, 2025

Respectfully Submitted,

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), lead counsel for Petitioner hereby certifies that on May 28, 2025, a copy of this PETITIONER'S NOTICE OF INTENT TO DESIGNATE SCOTT D. SHERWIN AS A PROVISIONALLY RECOGNIZED PTAB ATTORNEY ELIGIBLE FOR AUTOMATIC *PRO HAC VICE* ADMISSION AS BACK-UP COUNSEL PURSUANT TO 37 C.F.R. § 42.10 was served via email to Patent Owner's counsel of record in this proceeding:

W. Todd Baker (todd.baker@kirkland.com)

Alan M. Rabinowitz (alan.rabinowitz@kirkland.com)

KleinTools_IPR@kirkland.com

Dated: May 28, 2025

Respectfully submitted,

/ Alexander B. Stein /
Alexander B. Stein, Reg. No. 71,397