

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC,
Petitioner,

v.

PERSONALIS, INC,
Patent Owner.

IPR2023-00224 (Patent 11,384,394 B2)
IPR2023-00317 (Patent 11,408,033 B2)

Before ULRIKE W. JENKS, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER¹
Granting Petitioner's Motions for
Pro Hac Vice Admission of ALAN J. HEINRICH
37 C.F.R. § 42.10

¹ The combined caption is for administrative convenience only and does not indicate that IPR2023-00224 and IPR2023-00317 have been joined. The parties are not authorized to use this caption without express permission of the Board.

On November 19, 2023, Petitioner filed motions requesting *pro hac vice* admission of ALAN J. HEINRICH in each of the above-identified proceedings (collectively “Motions”). Paper 27.² Petitioner also submitted Declarations from ALAN J. HEINRICH in support of the Motions (collectively “Declarations”). Ex. 1079.³

Petitioner attests that Patent Owner does not oppose the Motions. Paper 27, 5.

For the reasons provided below, Petitioner’s Motions are *granted*.

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. In authorizing a motion for *pro hac vice* admission, the Board requires the moving party to provide a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* and an affidavit or declaration of the individual seeking to appear in the proceeding. *See Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639 (PTAB Oct. 15, 2013) (Paper 7) (representative “Order – Authorizing Motion for *Pro Hac Vice* Admission”).

Based on the facts set forth in the Motions and the accompanying Declarations, we conclude that Mr. Heinrich has sufficient legal and technical qualifications to represent Petitioner in these proceedings, has demonstrated sufficient litigation experience and familiarity with the subject matter of these proceedings, and meets all other requirements for admission *pro hac vice*. *See* Ex. 1079. Accordingly, Petitioner has established good

² For purposes of expediency, we cite to Papers filed in IPR2023-00224. Petitioner filed a similar Motion in IPR2023-00317 (Paper 26).

³ We cite to Exhibits filed in IPR2023-00224. Petitioner filed a similar Declaration in IPR2023-00317 (Ex. 1079).

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cause for *pro hac vice* admission of Mr. Heinrich. Mr. Heinrich will be permitted to serve as back-up counsel only. *See* 37 C.F.R. § 42.10(c).

We note that Petitioner filed a Power of Attorney including Mr. Heinrich in accordance with 37 C.F.R. § 42.10(b). IPR2023-00224, Paper 2; IPR2023-00317, Paper 2.

Petitioner has not filed updated mandatory notices identifying Mr. Heinrich as back-up attorney. Therefore, Petitioner must file an updated mandatory notice identifying Mr. Heinrich as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3).

In consideration of the foregoing, it is hereby

ORDERED that Petitioner's Motions for *pro hac vice* admission of ALAN J. HEINRICH are *granted*;

FURTHER ORDERED that Petitioner is to continue to have a registered practitioner represent it as lead counsel for the above-identified proceedings;

FURTHER ORDERED that Petitioner must file updated mandatory notices identifying Mr. Heinrich as back-up counsel in accordance with 37 C.F.R. § 42.8(b)(3);

FURTHER ORDERED that Mr. Heinrich is authorized to represent Petitioner as back-up counsel only in the above-identified proceedings;

FURTHER ORDERED that Mr. Heinrich comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide⁴ (84 Fed. Reg. 64,280 (Nov. 21, 2019)), and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations; and

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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FURTHER ORDERED that Mr. Heinrich is subject to the Office's disciplinary jurisdiction under 37 C.F.R. § 11.19(a), and the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.*

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