UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,

Petitioner,

v.

PERSONALIS, INC.

Patent Owner.

Case IPR2023-00317
U.S. Patent No. 11,408,033

PATENT OWNER'S MOTION TO SEAL

Pursuant to 37 CFR §§ 42.14 and 42.54, as well as the Scheduling Order (Paper 12), Patent Owner Personalis, Inc. ("Personalis") makes this Motion to Seal discrete portions of the fact witness deposition transcript of Mr. John West (EX1222), discrete portions of the fact witness deposition transcript of Dr. MacQuitty (EX1221), and discrete portions of the fact witness deposition transcript of Mr. Dan Norton (EX1220).

Patent Owner also submits its proposed Protective Order, which is attached to this Motion to Seal as Exhibit A, along with a marked-up comparison of the proposed Protective Order relative to the Board's Default Protective Order as Exhibit B.

Patent Owner has conferred with Petitioner regarding this Motion. Petitioner has indicated that it does not take a position on the Motion.

I. Protective Order

Patent Owner submits its proposed Protective Order attached as Exhibit A to this Motion to Seal. The Protective Order is a modified version of the Default Protective Order found in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (hereinafter, the "Trial Practice Guide"). The modification sets forth an additional tier of confidential material as "Attorneys' Eyes Only." Patent Owner also submits as Exhibit B to this Motion a marked-up version of the Protective Order with redlines showing the modifications relative to the Default Protective Order.

The Attorneys' Eyes Only tier included in the proposed Protective Order is consistent with the same tier of confidentiality agreed to by the parties in the Stipulated Protective Order that governs confidential material in the corresponding district court litigation, *Personalis, Inc. v. Foresight Diagnostics Inc.*, Case No. 22-cv-01913-CNS (D. Colorado), D.I. 35 at ¶2.10 ("Stipulated Protective Order"), EX2163. The Attorneys' Eyes Only tier is reasonable and adequately defines the types of materials that are to be included in this tier. *See* Exhibit A at ¶4. In particular, good cause exists for this added tier of confidentiality to protect confidential information that Patent Owner reasonably and in good faith believes constitutes or contains trade secrets or particularly sensitive scientific research, licensing, business, financial, market or other proprietary information, the disclosure of which information to other parties, including their in-house counsel or other employees, would create a substantial risk of serious harm to Patent Owner. *Id.* This tier of confidentiality is required in this proceeding given that Petitioner and Patent Owner are business competitors, and further given that this proceeding includes certain confidential fact witness deposition testimony from Patent Owner's former Chief Executive Officer (Mr. John West), the former Chairman of its Board of Directors (Dr. Jonathan MacQuitty), and its current Director of Project Management (Mr. Dan Norton). The proposed Protective Order ensures that Petitioner's outside counsel can adequately access this tier of confidential information and represent

Petitioner's interest in this proceeding by viewing this tier of confidential information.

Aside from adding the additional tier of confidentiality, the Protective Order is substantively identical to the Default Protective Order. Such a change to the Default Protective Order is permitted under the Trial Practice Guide at Appendix B, Paragraph J. Patent Owner proposes that the parties be bound by the Protective Order submitted herewith as Exhibit A in this proceeding.

II. Good Cause Exists for Sealing Certain Confidential Information

The standard for granting a motion to seal is "good cause." 37 CFR § 42.54; *see Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 (Jan. 19, 2018) (Informative).

There is good cause for sealing certain discrete portions of the West deposition transcript (EX1222), certain discrete portions of the MacQuitty deposition transcript (EX1221), and certain discrete portions of the Norton deposition transcript (EX1220) for reasons provided below.

A. West deposition transcript (EX1222)

Mr. John West is the former Chief Executive Officer of Personalis. He served as the Chief Executive Officer of Personalis from the founding of the company in August 2011 through December 2022. He is a named inventor on the challenged

patent. He provided testimony as a fact witness in this proceeding. *See* EX2032 (West declaration), EX1222 (West deposition transcript).

The following pages and lines of the deposition transcript of Mr. West, EX1222, contain particularly sensitive financial, business, and market information relating to the profitability of Personalis before it became a publicly traded company:

- Page 26, line 25 to Page 27, line 5; and
- Page 27, line 11 to Page 28, line 7.

The following pages and lines contain particularly sensitive business information regarding Personalis' C-level leadership:

- Page 29, line 23 to Page 30, line 1.

The following pages and lines contain trade secrets and particularly sensitive business information regarding details of Personalis' whole genome plus product:

- Page 146, line 22 to Page 147, line 8; and
- Page 147, lines 13-25.

Patent Owner designates this information under the "Attorneys' Eyes Only" tier of the Protective Order. Unless the information in these selected pages and lines are sealed, Personalis' competitors (including Foresight) and others in the marketplace will be provided access to Personalis' highly sensitive and confidential information that would not ordinarily be available to the public or Personalis' competitors, exposing Personalis to substantial financial risk in the industry in which it competes.

The following pages and lines contain confidential information regarding the current stock holdings and stock options held by Mr. West:

- Page 31, lines 14-18; and
- Page 31, lines 21 to Page 32, line 4.

Patent Owner designates this information under the lower "Protective Order Material" tier of the Protective Order. Unless the information in these selected pages and lines are sealed, the public would be unnecessarily provided access to Mr. West's personal confidential information.

In conclusion, the redaction of the discrete portions of Exhibit 1222 identified above is appropriate and narrowly tailored to best balance the need for public disclosure of filings with the Patent Trial and Appeal Board and for protecting the limited amount of confidential information contained in the exhibit. Counsel for Patent Owner is not aware of a previous public disclosure of the information contained in the identified portions of Exhibit 1222.

B. MacQuitty deposition transcript (EX1221)

Dr. Jonathan MacQuitty is the former Chairman of the Board of Directors at Personalis. He served as Chairman of the Board of Directors at Personalis from 2011 until 2022. He provided testimony as a fact witness in this proceeding. *See* EX2033 (MacQuitty declaration), EX1221 (MacQuitty deposition transcript).

The following pages and lines of the deposition transcript of Dr. MacQuitty,

EX1221, contain particularly sensitive financial, business, and market information regarding topics of discussion during Personalis' Board of Directors meetings and policies in place at such meetings:

- Page 19, lines 5-9;
- Page 20, lines 5-14;
- Page 33, line 10 to Page 34, line 11;
- Page 40, line 17 to Page 41, line 1;
- Page 83, line 24 to Page 84, line 2; and
- Page 85, lines 8-21.

The following pages and lines contain particularly sensitive financial and business information relating to the level of investment in Personalis before it became a publicly traded company:

- Page 31, line 14 to Page 32, line 14.

The following pages and lines contain Personalis' particularly sensitive licensing, business, financial, and market information regarding discussions of patent disputes:

- Page 41, line 16 to Page 42, line 2.

Patent Owner designates this information under the "Attorneys' Eyes Only" tier of the Protective Order. Unless the information in these selected pages and lines are sealed, Personalis' competitors (including Foresight) and others in the marketplace will be provided access to Personalis' highly sensitive and confidential information

that would not ordinarily be available to the public or Personalis' competitors, exposing Personalis to substantial financial risk in the industry in which it competes.

The following pages and lines contain confidential information regarding the current stock holdings and stock options held by Dr. MacQuitty:

- Page 27, line 6 to Page 28, line 9;
- Page 28, line 14 to Page 31, line 7;
- Page 37, lines 4-21;
- Page 38, lines 4-10; and
- Page 82, line 24 to Page 83, line 2.

Patent Owner designates this information under the lower "Protective Order Material" tier of the Protective Order. Unless the information in these selected pages and lines are sealed, the public would be unnecessarily provided access to Dr. MacQuitty's personal confidential information.

In conclusion, the redaction of the discrete portions of Exhibit 1221 identified above is appropriate and narrowly tailored to best balance the need for public disclosure of filings with the Patent Trial and Appeal Board and for protecting the limited amount of confidential information contained in the exhibit. Counsel for Patent Owner is not aware of a previous public disclosure of the information contained in the identified portions of Exhibit 1221.

C. Norton deposition transcript (EX1220)

Mr. Dan Norton is the current Director of Product Management at Personalis. He has been an employee of Personalis from 2018 to present. He provided testimony as a fact witness in this proceeding. *See* EX2035 (Norton declaration), EX1220 (Norton deposition transcript).

The following pages and lines of the deposition transcript of Mr. Norton, EX1220, contain trade secrets or particularly sensitive business, financial, and market information relating to the production of components for Personalis' NeXT Personal Assay®:

- Page 20, line 4 to Page 21, line 2; and
- Page 21, lines 12-22.

The following pages and lines contain particularly sensitive licensing, business, financial, and market information regarding Personalis' customers:

- Page 26, lines 2-10;
- Page 27, lines 6-22;
- Page 28, lines 6-13;
- Page 28, line 18 to Page 29, line 17; and
- Page 32, lines 6-11.

The following pages and lines contain particularly sensitive scientific research and market information regarding Personalis' products and position in the marketplace:

- Page 32, lines 12-21;
- Page 34, lines 17-22;
- Page 35, lines 7-9;
- Page 40, line 25 to Page 41, line 6;
- Page 41, lines 11-12;
- Page 43, lines 12-16; and
- Page 45, line 18 to Page 46, line 18.

The following pages and lines contain particularly sensitive business, marketing, and other proprietary information regarding the process Personalis uses to draft documents, select speakers, and communicate with the media:

- Page 68, line 14 to Page 69, line 8;
- Page 83, lines 22-25;
- Page 86, lines 2-7;
- Page 87, line 15 to Page 88, line 3;
- Page 89, lines 15-19;
- Page 91, lines 11-14;
- Page 94, lines 22-25;
- Page 98, lines 2-11;
- Page 110, lines 2-18; and
- Page 125, lines 9-23.

Patent Owner designates this information under the "Attorneys' Eyes Only" tier of the Protective Order. Unless the information in these selected pages and lines are sealed, Personalis' competitors (including Foresight) and others in the marketplace will be provided access to Personalis' highly sensitive and confidential information that would not ordinarily be available to the public or Personalis' competitors, exposing Personalis to substantial financial risk in the industry in which it competes.

In conclusion, the redaction of the discrete portions of Exhibit 1220 identified above is appropriate and narrowly tailored to best balance the need for public disclosure of filings with the Patent Trial and Appeal Board and for protecting the limited amount of Personalis' confidential information contained in the exhibit. Counsel for Patent Owner is not aware of a previous public disclosure of the information contained in the identified portions of Exhibit 1220.

III. Conclusion

Patent Owner respectfully requests entry of the Protective Order attached as Exhibit A to this motion and that the Board grant this Motion to file under seal the above-identified portions of Exhibit 1222 (the West deposition transcript), Exhibit 1221 (the MacQuitty deposition transcript), and Exhibit 1220 (the Norton deposition transcript).

Respectfully submitted,

WEIL, GOTSHAL & MANGES LLP

Dated: December 22, 2023

/*Derek C. Walter*/

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Counsel for Patent Owner Personalis, Inc.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S MOTION TO SEAL** is being served electronically on December 22, 2023, to the e-mail addresses shown below:

Andrew E. Krause, Lead Counsel akrause@irell.com Alan J. Heinrich, Backup Counsel (pro hac vice) aheinrich@irell.com ForesightIPRs@irell.com IRELL & MANELLA LLP 1800 Avenue of the Stars, Suite 900 Los Angeles, California 90067 Telephone: (310) 277-1010 Facsimile: (310) 203-7199	Amir Naini, Backup Counsel NAINI P.C. 2632 Wilshire Blvd., Suite 268 Santa Monica, CA 90403 T: 310- 592-3030 F: 310-453-9008 amir@nainipc.com

Dated: December 22, 2023

/Derek C. Walter/
Derek C. Walter,
Lead Counsel for Personalis, Inc
Reg. No. 74,656

EXHIBIT A

Protective Order

This protective order governs the treatment and filing of confidential information, including documents and testimony, in this proceeding.

1. Confidential information shall be clearly marked "PROTECTIVE ORDER MATERIAL" or "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY."

2. Access to confidential information designated "PROTECTIVE ORDER MATERIAL" is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Outside Counsel. Outside counsel of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court

reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

(G) Other Employees of a Party. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in paragraphs (2)(A)–(E), shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

3. Access to confidential information designated "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY" is limited to the following individuals defined in paragraphs 2(B), 2(C), 2(E), and 2(F) who have executed the acknowledgment appended to this order.

4. A party may mark confidential information as "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY" if the party reasonably and in good faith believes the confidential information constitutes or contains trade secrets or particularly sensitive scientific research, licensing, business, financial, market or other proprietary information, the disclosure of which information to other parties, including their in-house counsel or other employees, would create a substantial risk of serious harm to the disclosing party that could not be avoided by less restrictive means.

5. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

(A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(B) Otherwise using reasonable efforts to maintain the confidentiality of the

information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

6. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

(A) Documents and Information Filed With the Board.

(i) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The documents or information

shall remain under seal unless the Board determines that some or all of it does not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as "PROTECTIVE ORDER MATERIAL" or "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY" and shall be produced in a manner

that maintains its confidentiality.

7. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information must return, or certify the destruction of, all copies of the confidential information to the producing party.

Standard Acknowledgment for Access to Protective Order Material

I _____, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

_____

[Signature]

By:_____

Date:_____

EXHIBIT B

Foresight Diagnostics Inc. v. Personalis, Inc.
IPR2023-00317

~~Default~~ Protective Order

This protective order governs the treatment and filing of confidential information, including documents and testimony, in this proceeding.

8. Confidential information shall be clearly marked "PROTECTIVE ORDER MATERIAL~~.~~" or "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY."

9. Access to confidential information designated "PROTECTIVE ORDER MATERIAL" is limited to the following individuals who have executed the acknowledgment appended to this order:

(H) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(I) Outside Counsel~~Party Representatives~~. Outside counsel~~Representatives~~ of record for a party in the proceeding.

(J) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(K) In-house counsel. In-house counsel of a party.

(L) Support Personnel. Administrative assistants, clerical staff, court

reporters and other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(M) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

~~1.~~(N) Other Employees of a Party. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in paragraphs ~~(d)~~(2)(A)–(E), shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to

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confidential information.

10. Access to confidential information designated "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY" is limited to the following individuals defined in paragraphs 2(B), 2(C), 2(E), and 2(F) who have executed the acknowledgment appended to this order.

11. A party may mark confidential information as "PROTECTIVE ORDER MATERIAL – OUTSIDE ATTORNEYS' EYES ONLY" if the party reasonably and in good faith believes the confidential information constitutes or contains trade secrets or particularly sensitive scientific research, licensing, business, financial, market or other proprietary information, the disclosure of which information to other parties, including their in-house counsel or other employees, would create a substantial risk of serious harm to the disclosing party that could not be avoided by less restrictive means.

~~10.~~12. Persons receiving confidential information shall use reasonable efforts to maintain the confidentiality of the information, including:

(E) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;

(F) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;

(G) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and

(H) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

~~11.~~13. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

(C) Documents and Information Filed With the Board.

(iii) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may challenge the confidentiality of the

information by opposing the Motion to Seal. The documents or information shall remain under seal unless the Board determines that some or all of it does not qualify for confidential treatment.

(iv) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(D) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as "PROTECTIVE ORDER MATERIAL" or "PROTECTIVE ORDER MATERIAL –

OUTSIDE ATTORNEYS' EYES ONLY" and shall be produced in a manner that maintains its confidentiality.

~~12.~~14. Within 60 days after the final disposition of this action, including the exhaustion of all appeals and motions, each party receiving confidential information must return, or certify the destruction of, all copies of the confidential information to the producing party.

Standard Acknowledgment for Access to Protective Order Material

I _____, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the Protective Order and providing remedies for its breach.

_____

[Signature]

By:_____

Date:_____