UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,
Petitioner,

v.

PERSONALIS, INC.,
Patent Owner.

Case No. IPR2023-00546
Patent No. 10,450,611

FORESIGHT DIAGNOSTICS INC.'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF ALAN J. HEINRICH UNDER 37 C.F.R. § 42.10(c)

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.10(c), Petitioner Foresight Diagnostics Inc., by and through its attorneys, respectfully requests that the Board admit Alan J. Heinrich *pro hac vice* in this proceeding.

II. GOVERNING LAW, RULES, AND PRECEDENT

37 C.F.R. § 42.10(c) states as follows:

> 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. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered 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.

The Board has further required that a motion for *pro hac vice* admission be filed in accordance with the "Order – Authorizing Motion for *Pro Hac Vice* Admission" entered in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (P.T.A.B. Oct. 15, 2013) ("*Unified* Patent Order").

The *Unified Patents* Order requires that such motion (1) "[c]ontain a statement of facts showing there is good cause for the Board to recognize counsel pro hac vice during the proceeding[,]" and (2) "[b]e accompanied by

an affidavit or declaration of individual seeking to appear attesting to the following."

i. Membership in good standing of the Bar of at least one State or the District of Columbia;

ii. No suspensions or disbarments from practice before any court or administrative body;

iii. No application for admission to practice before any court or administrative body ever denied;

iv. No sanctions or contempt citations imposed by any court or administrative body;

v. 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.;

vi. 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);

vii. All other proceedings before the Office for which the individual has applied to appear pro hac vice in the last three (3) years; and

viii. Familiarity with the subject matter at issue in the proceeding.

III. STATEMENT OF FACTS

Based on the following statement of facts, and supported by the Declaration of Alan J. Heinrich submitted herewith (EX1084), Foresight Diagnostics Inc. submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Alan J. Heinrich in this proceeding:

1. Petitioner's Lead Counsel, Andrew E. Krause, is a registered practitioner (Reg. No. 76,276). First Back-up Counsel, Amir Naini, is also a registered practitioner (Reg. No. 45,770).

2. Mr. Heinrich is a Partner at the law firm of Irell & Manella LLP. EX1084 ¶ 3.

3. Mr. Heinrich is an experienced litigating attorney and has been litigating cases relating to patents for over 22 years. *Id*. ¶ 4.

4. Mr. Heinrich is a member in good standing of the California State Bar, and has never been suspended or disbarred from practice before any court or administrative body. *Id*. ¶ 5.

5. No application filed by Mr. Heinrich for admission to practice before any court or administrative body has ever been denied. *Id*. ¶ 6.

6. No sanctions or contempt citations have been imposed against Mr. Heinrich by any court or administrative body. *Id*. ¶ 7.

7. Mr. Heinrich has read and agrees to comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials, as set forth in Part 42 of Title 37, Code of Federal Regulations. *Id.* ¶ 8.

8. Mr. Heinrich understands that he will be subject to the USPTO Rules of Professional Conduct 37 C.F.R. §§ 11.101 *et seq*. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶ 9.

9. Mr. Heinrich has appeared *pro hac vice* before the United States Patent and Trademark Office in IPR2013-00004, IPR2013-00007, IPR2015-01719, IPR2020-01163, IPR2020-01200, IPR2021-01064, IPR2021-01229, IPR2023-00224 and IPR2023-00317. *Id.* ¶ 10.

10. Mr. Heinrich is also concurrently applying for *pro hac vice* admission in IPR2023-00545. *Id.* ¶ 11.

11. Mr. Heinrich has an established familiarity with the subject matter at issue in this proceeding. *Id*. ¶ 12. Mr. Heinrich is involved in the related civil action, *Personalis, Inc. v. Foresight Diagnostics*

Inc., Case No. 1:22-cv-01913 (D. Colo. filed August 8, 2022) involving the ’611 patent, which is at the issue in this proceeding. *Id.* Mr. Heinrich has acquired a substantial understanding of the underlying legal and technological issues at stake in the related proceeding, including issues related to validity of the ’611 patent. *Id.* Petitioner has expended significant time and resources with Mr. Heinrich and wishes to continue using Mr. Heinrich as counsel in this proceeding as appropriate. *Id*.

IV. GOOD CAUSE EXISTS FOR *PRO HAC VICE* ADMISSION OF ALAN HEINRICH

The facts outlined above in the Statement of Facts, and contained in the Declaration of Alan J. Heinrich (EX1084), establish that there is good cause to admit Mr. Heinrich *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Petitioner’s lead counsel and first back-up counsel are registered practitioners. Mr. Heinrich is an experienced litigating attorney and has an established familiarity with the subject matter at issue.

V. NO OPPOSITION TO THE MOTION

Petitioner has conferred with Petitioner with regard to this Motion, and Petitioner confirmed that it would not oppose the motion.

VI. CONCLUSION

In light of the foregoing, Petitioner respectfully requests that the Board admit Alan Heinrich *pro hac vice* in this proceeding.

April 29, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on April 29, 2024, a copy of the foregoing document **FORESIGHT DIAGNOSTICS INC.'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF ALAN J. HEINRICH UNDER 37 C.F.R. § 42.10(C)** and **EX1084** were served by electronic mail, as agreed to by the parties, upon the following:

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