

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,
Petitioner,

v.

PERSONALIS, INC.,
Patent Owner.

IPR2023-00545 (Patent 11,299,783 B2)
IPR2023-00546 (Patent 10,450,611 B2)¹

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

POLLOCK, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motions for
Pro Hac Vice Admission of Alan J. Heinrich
37 C.F.R. § 42.10(c)

¹ This Order addresses substantively identical motions filed in each of the above-captioned proceedings. We exercise our discretion to issue one Order to cover all proceedings. The combined caption is for administrative convenience only and does not indicate that IPR2023-00545 and IPR2023-00546 have been joined. The parties are not authorized to use this caption without express permission of the Board.

IPR2023-00545 (Patent 11,299,783 B2)
IPR2023-00546 (Patent 10,450,611 B2)

Petitioner filed Motions for *Pro Hac Vice* Admission of Alan J. Heinrich (Paper 30²) in each of the above-captioned proceedings. Petitioner submitted Declarations of Alan J. Heinrich (Ex. 1084) in support of each Motion. Petitioner states there is no opposition to the Motions. Paper 30, 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, Paper 7 (PTAB Oct. 15, 2013) (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. 1084 ¶¶ 4–9, 12.³ Accordingly, Petitioner has established good cause for *pro hac vice* admission of Mr. Heinrich.

² This Order cites to papers and exhibits filed in IPR2023-00545. Corresponding items were filed in IPR2023-00546.

³ Mr. Heinrich states he understands he will be “subject to the USPTO Code of Professional Responsibility” (Ex. 1084 ¶ 9) rather than the USPTO Rules of Professional Conduct. We excuse these occurrences in this instance.

IPR2023-00545 (Patent 11,299,783 B2)
IPR2023-00546 (Patent 10,450,611 B2)

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). Paper 2.

Petitioner has not filed an updated mandatory notice identifying Mr. Heinrich as a 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).

Accordingly, it is

ORDERED that Petitioner's Motions for *pro hac vice* admission of Mr. Heinrich are *granted*;

FURTHER ORDERED that 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);

FURTHER ORDERED that Petitioner continue to have a registered practitioner represent it as lead counsel in these proceedings;

FURTHER ORDERED that Mr. Heinrich is authorized to act as back-up counsel only in these proceedings;

FURTHER ORDERED that Mr. Heinrich be familiar with the Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019))⁴ and comply with 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>.

IPR2023-00545 (Patent 11,299,783 B2)
IPR2023-00546 (Patent 10,450,611 B2)

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.*

PETITIONER:

Andrew Krause
IRELL & MANELLA LLP
akrause@irell.com

Amir Naini
NAINI P.C.
amir@nainipc.com

PATENT OWNER:

Derek Walter
Adrian Percer
WEIL, GOTSHAL & MANGES LLP
derek.walter@weil.com
adrian.percer@weil.com