UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

DATAVANT, INC.

Petitioner

v.

VIGILYTICS LLC

Patent Owner

IPR2024-00311

Patent No. 10,109,375

Title: De-Identifying Medical History Information for Medical Underwriting

---

PETITIONER'S MOTION FOR WITHDRAWAL AND SUBSTITUTION OF COUNSEL

1. RELIEF REQUESTED

Pursuant to 37 C.F.R. §§ 42.10(e) and 42.20(b), Petitioner Datavant, Inc. hereby respectfully moves to withdraw Peter Shapiro as its current lead counsel of record and substitute Justin Oliver as its new lead counsel in this proceeding.

2. STATEMENT OF FACTS AND SHOWING OF GOOD CAUSE

On December 15, 2023, Petitioner filed its Petition for *Inter Partes* Review appointing Peter Shapiro (Reg. No. 43,107) of Venable LLP as lead counsel in this proceeding. (Paper 1). Mr. Shapiro will be leaving Venable LLP this month to serve as a PTAB judge and will no longer be associated with Venable LLP. Petitioner therefore requests that the current designated lead counsel, Mr. Shapiro, be allowed to withdraw from the proceeding, and that Justin Oliver (Reg. No. 44,986) of Venable LLP be substituted as new lead counsel in this proceeding. An updated Power of Attorney reflecting this change will be filed with this Motion. The withdrawal and substitution of lead counsel will not have an adverse effect on Patent Owner or otherwise delay the proceeding in this matter.

Mr. Oliver meets the requirements of 37 C.F.R. § 42.10 as lead counsel and is a registered practitioner. Mr. Oliver has read and intends to comply with the Patent Trial and Appeal Board Consolidated Trial Practice Guide and the Board's Rules of Practice for Trials as set forth in Part 42 of Title 37 of the Code of Federal Regulations.

Nicholas Marcello (Reg. No. 77,182) and Michael Sandonato (Reg. No. 35,345) will remain as back-up counsel for Petitioner.

The Parties conferred via email on January 5, 2024 and Patent Owner indicated that it does not oppose this motion. Further, authorization for this motion was granted by the Board via e-mail on January 10, 2024.

3. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board grant this Motion for Withdrawal and Substitution of Counsel.

Date: January __, 2024

Respectfully submitted,

/s/Justin Oliver

Justin Oliver (Reg. No. 44,986)
JOliver@Venable.com
600 Massachusetts Avenue, NW
Washington, D.C. 20001
T: 202-721-5423
F: 202-344-8300

Peter Shapiro (Reg. No. 43,107)
Nicholas D. Marcello (Reg. No. 77,182)
PShapiro@venable.com
NDMarcello@Venable.com
VENABLE LLP
151 W. 42nd Street
New York, NY 10036
T: 212-307-5500
F: 212-307-5598

Attorneys for Petitioner Datavant, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that true and correct copies of the foregoing Motion for Withdrawal and Substitution of Counsel and Power of Attorney were served on Patent Owner via email to the following attorneys of record for the Patent Owner listed below:

W. Karl Renner, Reg. No. 41,265
Jeffrey J. Barclay, Reg. No. 48,950
Nicholas Stephens, Reg. No. 74,320
Fish & Richardson P.C.
IPR25412-0021IP1@fr.com
PTABInbound@fr.com
axf-ptab@fr.com
barclay@fr.com
nstephens@fr.com

DATED: January 11, 2024

Respectfully submitted,

By: */s/Nicholas Marcello*

Nicholas D. Marcello (Reg. No. 77,182)
NDMarcello@Venable.com
VENABLE LLP
151 W. 42nd Street
New York, NY 10036
T: 212-307-5500
F: 212-307-5598