

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANCESTRY.COM DNA LLC,
Petitioner

v.

DNA GENOTEK INC.,
Patent Owner

Patent No. 8,221,381

Inter Partes Review No. IPR2016-00060

**DECLARATION OF JOHN R. LANHAM IN SUPPORT OF
MOTION FOR *PRO HAC VICE* ADMISSION OF JOHN R. LANHAM
UNDER 37 C.F.R. § 42.10(c)**

I, John R. Lanham, declare as follows:

1. I am more than twenty-one years of age, am competent to present this declaration, and have personal knowledge of the facts set forth herein.

2. This declaration is made in support of Patent Owner DNA Genotek Inc.'s Motion for *Pro Hac Vice* Admission of John R. Lanham Under 37 C.F.R. § 42.10(c).

3. I am an associate attorney at the law firm of Morrison & Foerster LLP. I have been an attorney with Morrison & Foerster since 2008.

4. I have been involved in the litigation of patent cases for seven years. My work in patent litigation has included investigating the validity and alleged infringement of various patents, working with technical expert witnesses, appearing at trial, and representing clients in connection with specialized patent-related proceedings including claim construction and disclosures such as invalidity and infringement contentions and responses thereto.

5. I am an attorney and a member of the trial team in (1) *DNA Genotek Inc. v. Ancestry.com DNA, LLC*, Case No. 15-cv-00355-SLR (D. Del) and (2) *DNA Genotek Inc. v. Spectrum DNA, Spectrum Solutions LLC, and Spectrum Packaging LLC*, Case. No. 15-cv-00661-SLR (D. Del.). Both of these district court litigations involve the same patent at issue in this proceeding, U.S. Patent No. 8,221,381 (“the ’381 patent”). I am also an attorney and a member of the trial team in pending

district court litigation involving U.S. Patent No. 9,207,164, a continuation of the application for the '381 patent, *DNA Genotek Inc. v. Spectrum DNA and Spectrum Solutions LLC*, No. 3:16-cv-01544-JLS-NLS (S.D. Cal.) I have been actively involved in all aspects of the above-referenced cases, including factual investigation and assessment of validity and infringement positions regarding the claims of the '381 patent challenged by Petitioner Ancestry.com DNA LLC ("Ancestry") in this proceeding. I have reviewed in detail the '381 patent and the prior art raised in Ancestry's Petition for *Inter Partes* Review (Paper No. 1). I am thus very familiar with the '381 patent and the issues raised in Ancestry's Petition.

6. I am a member in good standing of the State Bar of California and the State Bar of Colorado.

7. I have never been suspended or disbarred from practice before any court or administrative body.

8. I have never had an admission to practice before any court or administrative body denied.

9. I have never had sanctions or contempt citations imposed against me by any court or administrative body.

10. I have read and agrees to 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.

11. I understand that I will be subject to the USPTO Rules of Professional

Conduct and disciplinary jurisdiction set forth in 37 C.F.R. §§ 10.20 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

12. I have not applied to appear *pro hac vice* in no other proceedings before the Office in the last three (3) years.

13. I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of U.S. Patent No. 8,221,381.

EXECUTED at Salt Lake City, UT this 11th of August, 2016.

/John R. Lanham/

John R. Lanham