

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

**PATENT OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
JOHN R. LANHAM UNDER 37 C.F.R. § 42.10(c)**

I. Relief Requested

Pursuant to 37 C.F.R. § 42.10, Patent Owner DNA GENOTEK INC. requests that the Board admit John R. Lanham *pro hac vice* in this proceeding. The undersigned contacted counsel for Petitioner ANCESTRY.COM DNA LLC (“Ancestry”), Daniel M. Becker of FENWICK & WEST LLP, who indicated that Petitioner did not plan to oppose Mr. Lanham’s admission *pro hac vice*.

II. Governing Laws, Rules, and Precedent

Section 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.

III. Statement of Facts

Based on the following facts, and supported by the Declaration of John R. Lanham in Support of this Motion for Admission *Pro Hac Vice* filed herewith (“Exhibit 2012”), Patent Owner submits that a showing of good cause has been made and respectfully requests the *pro hac vice* of John R. Lanham in this proceeding:

1. This authorized petition is filed more than twenty-one (21) days after Petitioner Ancestry served its PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 8,221,381 (Paper No. 1).

2. Lead counsel for Patent Owner DNA GENOTEK INC. (“DNA Genotek”), Brian M. Kramer, is a registered practitioner. Mr. Lanham is an associate at the law firm of Morrison & Foerster LLP where Mr. Kramer is a partner.

3. Mr. Lanham is an experienced litigator. Mr. Lanham has seven years of experience in patent litigation, including 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. Exhibit 2012 ¶¶ 4-5.

4. Mr. Lanham has established familiarity with the subject matter at issue in this proceeding. Mr. Lanham is an attorney for Patent Owner DNA Genotek and a member of the trial team in both of the co-pending district court litigations identified as Related Matters by Petitioner Ancestry (Paper No. 1): (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”). Exhibit 2012 ¶ 5. Mr. Lanham is also an attorney for Patent Owner DNA Genotek 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.) Exhibit 2012 ¶ 5. As counsel for Patent Owner DNA Genotek in the above-referenced matters, Mr. Lanham has been actively involved in all aspects of the district court litigations, including factual investigation and assessment of validity and infringement positions regarding the claims of the ’381 patent challenged by Petitioner Ancestry in this proceeding. Exhibit 2012 ¶ 5. Mr. Lanham has reviewed in detail the ’381 patent and the prior art raised in Ancestry’s Petition. Exhibit 2012 ¶ 5.

5. Mr. Lanham is a member in good standing of the State Bar of California and the State Bar of Colorado. Exhibit 2012 ¶ 6.

6. Mr. Lanham has never been suspended or disbarred from practice before any court or administrative body. Exhibit 2012 ¶ 7.

7. No application by Mr. Lanham for admission to practice before any court or administrative body has ever been denied. Exhibit 2012 ¶ 8.

8. No sanctions or contempt citations have ever been imposed against Mr. Lanham by any court or administrative body. Exhibit 2012 ¶ 9.

9. Mr. Lanham has 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. Exhibit 2012 ¶ 10.

10. Mr. Lanham understands that he 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). Exhibit 2012 ¶ 11.

11. Mr. Lanham has applied to appear *pro hac vice* in no other proceedings before the Office in the last three (3) years. Exhibit 2012 ¶ 12.

IV. Good Cause Exits for the *Pro Hac Vice* Admission of John R. Lanham

The facts outlined above in the Statement of Facts and contained in the Declaration of John R. Lanham (Exhibit 2012) establish that there is good cause to admit Mr. Lanham *pro hac vice* in this proceeding under 37 C.F.R. § 32.10. Mr. Lanham is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding.

V. Conclusion

For the foregoing reasons, Patent Owner respectfully requests that the Board admit Mr. Lanham *pro hac vice* in this proceeding.

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