

Filed on behalf of Ancestry.com DNA, LLC

By: Daniel M. Becker, Reg. No. 38,376
Jennifer R. Bush, Reg. No. 50,784
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel: (650) 988-8500
Fax: (650) 938-5200

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANCESTRY.COM DNA, LLC,
Petitioner,

v.

DNA GENOTEK INC.,
Patent Owner.

Inter Partes Review No. IPR 2016-01152
Patent 8,221,381 B2

**PETITIONER ANCESTRY.COM DNA, LLC'S
MOTION FOR *PRO HAC VICE* ADMISSION
OF MICHAEL J. SACKSTEDER PURSUANT TO 37 C.F.R. § 42.10(c)**

I. RELIEF REQUESTED

Pursuant to the authorization provided by the Board in Paper No. 3 at page 2, Petitioner Ancestry.com DNA, LLC petitions under 37 C.F.R. § 42.10(c) for the *pro hac vice* admission of Michael J. Sacksteder in this proceeding.

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 statement of facts, and supported by the Declaration of Michael J. Sacksteder submitted herewith as Exhibit 1026 (“Ex. 1026”), Petitioner submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Michael J. Sacksteder in this proceeding:

1. This authorized petition is filed more than twenty-one (21) days after Petitioner's service of the PETITION FOR INTER PARTES REVIEW OF U.S.

IPR2016-01152

Petitioner's Motion for *Pro Hac Vice* Admission of Michael J. Sacksteder

PATENT 8,221,381 (Paper No. 1) and after the filing of PATENT OWNER'S MANDATORY NOTICES (Paper No. 5).

2. Petitioner's current lead counsel, Daniel M. Becker, is a registered practitioner (Reg. No. 38,376).

3. Mr. Sacksteder is Dr. Becker's partner at the law firm of Fenwick & West LLP. Ex. 1026 ¶ 3.

4. Mr. Sacksteder is an experienced litigating attorney and has been litigating cases relating to patents for over 18 years. Ex. 1026 ¶ 4.

5. Mr. Sacksteder has an established familiarity with the subject matter at issue in this proceeding. He was previously the supervising attorney in two of the co-pending district court litigations identified as Related Matters pursuant to 37 CFR § 42.8(b)(2) by Petitioner (Paper No. 1) and by Patent Owner (Paper No. 5): (i) *DNA Genotek, Inc. v. Ancestry.com DNA LLC*, Case No. 15-cv-00355-SLR (D. Del.) (the "Ancestry litigation"); and (ii) *DNA Genotek, Inc. v. Spectrum DNA, Spectrum Solutions LLC, and Spectrum Packaging, LLC*, Case No. 15-cv-00661-SLR (D. Del.) (the "Spectrum litigation"). 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"). As trial counsel for Petitioner in the Ancestry litigation and for the Spectrum defendants in the Spectrum litigation, he was actively involved in all

IPR2016-01152

Petitioner's Motion for *Pro Hac Vice* Admission of Michael J. Sacksteder

aspects of the district court litigations, including factual investigation and development of invalidity and non-infringement positions regarding the claims of the '381 patent challenged in this proceeding. In addition, he has been admitted *pro hac vice* in IPR2016-00060, which has been instituted and is also directed to the '381 patent. Ex. 1026 ¶¶ 11, 12.

6. Mr. Sacksteder is a member in good standing of the California State Bar. Ex. 1026 ¶ 5.

7. Mr. Sacksteder has never been suspended or disbarred from practice before any court or administrative body. Ex. 1026 ¶ 5.

8. No application filed by Mr. Sacksteder for admission to practice before any court or administrative body has ever been denied. Ex. 1026 ¶ 6.

9. No sanctions or contempt citations have been imposed against Mr. Sacksteder by any court or administrative body. Ex. 1026 ¶ 7.

10. Mr. Sacksteder 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. Ex. 1026 ¶ 8.

11. Mr. Sacksteder 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). Ex. 1026 ¶ 9.

12. Mr. Sacksteder has served in a consulting and supervisory role on several *inter partes* review proceedings. Ex. 1026 ¶ 10. He has applied to appear *pro hac vice* in six other proceedings before the Office within the last three (3) years. One of those proceedings is IPR2016-00060, which has been instituted and is also directed to the '381 patent. Ex. 1026 ¶ 10.

IV. GOOD CAUSE EXISTS FOR THE ADMISSION *PRO HAC VICE* OF MR. SACKSTEDER IN THIS PROCEEDING

The facts outlined above in the Statement of Facts, and contained in the Declaration of Michael J. Sacksteder (Ex. 1026), establish that there is good cause to admit Mr. Sacksteder *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Mr. Sacksteder is an experienced litigating attorney, and Mr. Sacksteder has an established familiarity with the subject matter at issue.

///

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.