

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. IPR2016-01152
Patent 8,221,381 B2

**PETITIONER ANCESTRY.COM DNA, LLC'S MOTION FOR
PRO HAC VICE ADMISSION OF MELANIE L. MAYER
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 Melanie L. Mayer 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 facts, and supported by the Declaration of Melanie L. Mayer submitted herewith as Exhibit 1027 (“Ex. 1027”), Petitioner submits that a showing of good cause has been made and respectfully requests the *pro hac vice* admission of Melanie L. Mayer 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 Melanie L. Mayer

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. Dr. Mayer is an associate at the law firm of Fenwick & West LLP where Dr. Becker is a partner. Ex. 1027, ¶ 3.

4. Dr. Mayer, who has a Ph.D. in Molecular Biology and Genetics, is an experienced litigating attorney who has been litigating cases relating to patents for over 10 years. Ex. 1027, ¶ 4.

5. Dr. Mayer has an established familiarity with the subject matter at issue in this proceeding. She was previously an 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, Dr. Mayer was actively involved in all 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. Dr. Mayer has also reviewed in detail the '381 patent, as well as the Petition and prior art upon which the Patent Owner bases its challenge. In addition, Dr. Mayer is admitted *pro hac vice* in IRP2016-00060, which has been instituted and is also directed to the '381 patent. Ex. 1027, ¶¶ 11, 12.

6. Dr. Mayer is an attorney in good standing of the State Bar of Washington. Ex. 1027, ¶ 5.

7. Dr. Mayer has never been suspended or disbarred from practice before any court or administrative body. Ex. 1027, ¶ 5.

8. No application of Dr. Mayer for admission to practice before any court or administrative body has ever been denied. Ex. 1027, ¶ 6.

9. No sanctions or contempt citations have been imposed against Dr. Mayer by any court or administrative body. Ex. 1027, ¶ 7.

10. Dr. Mayer has read and will 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. 1027, ¶ 8.

11. Dr. Mayer understands that she will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). Ex. 1027, ¶ 9.

12. Dr. Mayer has been admitted to appear *pro hac vice* in one other *inter partes* review proceeding before the Office in the last three years. As explained above, that proceeding (IPR2016-00060) has been instituted and is also directed to the '381 patent. Ex. 1027, ¶ 10.

IV. GOOD CAUSE EXISTS FOR THE *PRO HAC VICE* ADMISSION OF MELANIE L. MAYER

The facts outlined above in the Statement of Facts, and contained in the Declaration of Melanie L. Mayer (Ex. 1027), establish that there is good cause to admit Dr. Mayer *pro hac vice* in this proceeding under 37 C.F.R. § 42.10. Dr. Mayer is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding.

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