

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MIM SOFTWARE INC.,  
*Petitioner,*

v.

EXINI DIAGNOSTICS AB,  
*Patent Owner.*

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IPR2025-00827  
U.S. Patent No. 11,941,817

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**DECLARATION OF MICHAEL H. BUNIS IN SUPPORT OF PATENT  
OWNER'S MOTION FOR *PRO HAC VICE* ADMISSION OF MICHAEL H.  
BUNIS UNDER 37 C.F.R. § 42.10(c)**

I, Michael H. Bunis, hereby declare as follows:

1. I am a member in good standing of the bars of the Commonwealth of Massachusetts and State of New York.

2. I have not been suspended or disbarred from practice before any court or administrative body.

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

4. No sanction or contempt citation has been imposed against me by any court or administrative body.

5. I have read and will comply with Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in 37 C.F.R. part 42.

6. I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et seq. and the USPTO's disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

7. I have not applied to appear *pro hac vice* in any proceeding before the Office in the past three years.

8. I am an experienced litigation attorney with more than thirty years of experience representing clients in patent litigation in various forums including the U.S. District Courts in Massachusetts, Delaware, and elsewhere. I am currently an equity partner in the Intellectual Property Litigation Practice Group of Choate Hall

& Stewart, LLP, and have been involved in multiple patent and trade secret litigations during the course of my career, including those involving biotech and pharmaceutical companies, as well as software, telecommunications technology companies, and internet service providers. My biography is attached hereto as Appendix A. In my practice, I have tried cases, argued dispositive motions and claim construction hearings, deposed, or defended the depositions of, and otherwise worked with numerous companies, with respect to various technology fields.

9. I am familiar with the subject matter at issue in this proceeding. I have invested a significant amount of time in reviewing and analyzing relevant materials as counsel of record for Patent Owner in the parallel district court proceeding, *Progenics Pharms., Inc. v. MIM Software Inc.*, Case 1:24-cv-10437-PBS (D. Mass.), and in preparation for representing Patent Owner in this proceeding.

10. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further these statements were 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. To the extent relevant, I understand that willful false statements herein may jeopardize the validity of the present application or any patent issued in reliance thereon.

I declare under penalty of perjury that the foregoing is true and correct.

Date: December 16, 2025

By: 

Michael H. Bunis  
CHOATE, HALL & STEWART LLP  
Two International Place  
Boston, MA 02110  
617-248-5000

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing **DECLARATION OF MICHAEL H. BUNIS IN SUPPORT OF PATENT OWNER’S MOTION FOR PRO HAC VICE ADMISSION OF MICHAEL H. BUNIS UNDER 37 C.F.R. § 42.10(c)** was served electronically in its entirety on December 16, 2025 via electronic mail to the following attorneys of record:

- Jeff.Metzcar@thompsonhine.com
- David.Jaglowski@thompsonhine.com
- Marla.Butler@thompsonhine.com
- Jesse.Jenike-Godshalk@thompsonhine.com
- IPDocket@thompsonhine.com

Date: December 16, 2025

Respectfully submitted,

By: /William R. Haulbrook/

William R. Haulbrook (Reg. No. 53,002)

Stephanie L. Schonewald (Reg. No. 72,452)

Michael H. Bunis (*pro hac vice* motion filed)

Anita M.C. Spieth (provisionally admitted *pro hac vice*)

John C. Calhoun (provisionally admitted *pro hac vice*)

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Boston, MA 02110

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*Attorneys for Patent Owner*

EX2037 – APPENDIX A

## Michael H. Bunis

### Partner



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mbunis@choate.com

### Practice Areas

Complex Intellectual Property Disputes  
Intellectual Property Protection  
Life Sciences  
Technology

### Education

Boston University School of Law  
JD (1994) *magna cum laude*

University of Vermont  
BA (1989)

### Clerkship

Honorable Nancy Gertner  
U.S. District Court, Massachusetts

### Admissions

Massachusetts  
New York  
U.S. Courts of Appeals,  
First and Federal Circuits

*“Michael is always highly responsive, but what I value most is the way he combines a creative legal mind with pragmatic business sense to get the right outcome for us. I trust his judgment and often seek his advice on matters falling outside of his subject matter expertise.”*

*- Thomas Kennedy, General Counsel and Chief Compliance Officer, Versa Capital Management*

Michael Bunis helps biotech, pharmaceutical, and other life sciences and technology clients to grow and protect their core competitive advantage, their intellectual property assets. With over 30 years of experience, he has successfully tried cases before juries and judges throughout the United States, where he is a go-to resource for a range of high stakes disputes including patent litigation, trade secret, commercial litigation, and other intellectual property disputes. His success in advising clients on defending or enforcing intellectual property rights is largely attributable to the way he approaches every engagement – beginning with a clear understanding of a client’s business goal. Michael then develops a critical “play book” for clients when they’re navigating the early stages of litigation, which helps to lay the groundwork for success through a more focused strategy heading into trial.

Clients also appreciate how Michael combines his trial experience with practical skills developed in part from his prior roles in industry. From 1999 to 2003, Michael served as Global General Manager for the Internet media company Terra Lycos. In that role, Michael led an international shared services organization focused on the development of platform services supporting billions of dollars of advertising revenue.

Michael’s clients have included Alnylam, HP Enterprises, New England BioLabs, and Azenta Life Sciences.

### Representative Engagements

- Represent Defendant **New England BioLabs** in patent infringement lawsuit alleging infringement of 8 patents directed to DNA methylation. Successfully defeated patent holders attempt to obtain a preliminary injunction blocking the sale of accused products. Won Motion to Dismiss based on 35 USC Section 101 dismissing several patents from the litigation.
- **Adimab, LLC v. LinkedUp Bioscience, Inc. and Tao Wang, No., Mass. Super. Ct:** Counsel to Adimab in trade secret misappropriation and breach of contract dispute brought against LinkedUp related to highly engineered yeast strains, and technologies for cultivating and utilizing those strains to express and screen antibodies that bind to target antigens.

- **Hewlett-Packard Company v. Oracle Corporation, SCC Superior Court:** Member of the trial team for **Hewlett-Packard Company** in jury trial in Santa Clara County Superior Court. Litigation related to Oracle’s unilateral decision to stop porting its software to HP’s Itanium mission critical server platform in violation of an agreement between the companies. After a five week trial, jury returned a verdict in favor of Hewlett-Packard – awarding \$3 billion in HP’s favor and rejecting Oracle’s counterclaim entirely.
- Counsel for **Progenics Pharmaceuticals, Inc.** in a PGR proceeding challenging a patent directed to compounds for preparing 18F-radiolabeled Prostate-Specific Membrane Antigen (PSMA)-targeting conjugates.
- **EMC Corporation v. Pure Storage, Inc., D Mass:** Representation of **EMC** in several cases relating to former key employees who left company to found commercial rival using stolen trade secrets. EMC has already obtained preliminary injunction in two of the cases. In addition, three arbitration matters are pending versus former employees for violations pertaining to key employee contract violations.
- Lead counsel for publicly traded **pharmaceutical company** in dispute related to ownership of intellectual property directed to Prostate Specific Membrane Antigen.
- **Hewlett-Packard Company v. Rhode Island Department of Motor Vehicles, RI:** Lead counsel for **Hewlett Packard Enterprise** in a dispute related to the implementation of a complex computer network system controlling the Department of Motor Vehicles for the State of Rhode Island.
- Representation of major **pharmaceutical company** in a dispute relating to milestone payments.
- **NeuroLogica v. Mobius Imaging LLC, Mass Superior Court:** Representation of **NeuroLogica**, a mobile CT manufacturer in trade secret action related to computed tomography, the design and configuration of detector arrays, scintillator crystals, and data acquisition systems.
- **Stat Medical Devices Inc. v. Facet Technologies, LLC, et al., D Del:** Representation of **Facet Technologies, LLC**, a manufacturer and seller of reusable lancet medical devices designed for testing blood glucose levels in patent infringement action.
- Represented **Respondent Japanese manufacturer** of probe cards in United States International Trade Commission Section 337 Investigation. Trial victory on behalf of client.  
*In the Matter of Certain Probe Card Assemblies, Components Thereof and Certain Tested DRAM and NAND Flash Memory Devices, Investigation No. 337 – TA – 621*
- **iRobot Corporation v. Robotic FX, Inc., D Mass:** Representation of **iRobot**, a publicly traded provider of tactical military robots, in trade secret and patent infringement suit against industry competitor. As a consequence of the litigation, iRobot was awarded \$300 million contract with the United States Military for supply of tactical robots to soldiers in Iraq and Afghanistan.

## Publications and Presentations

- “Keeping Litigation and Prosecution Aligned,” moderator, Consero IP Forum for Life Sciences, December 2023.
- “Fortifying the Vault: Strategies for Mitigating Trade Secret Theft,” moderator, Consero IP Life Sciences Executive Roundtable, March 2022
- “Section 112 Enablement: What to Watch Out For,” moderator, BIO IP Counsels Committee Webinar, September 2021
- “Patents,” speaker, 19<sup>th</sup> Annual BBA Intellectual Property Year in Review, January 2019

- “Raising the Stakes in Patent Cases,” moderator, BIO IPCC Fall Conference, November 2018
- “On-Sale Bar Questions Leading Up To Helsinn At High Court,” co-author, *Law360*, August 2018
- “Could Your Cure Walk Out the Door?,” co-author, *Corporate Counsel*
- Halo V. Pulse: The Willfulness Debate Rages On,” co-author, *IP Law360*
- “Peregrine Puts Hired-to-Invent Issues in Spotlight,” co-author, *IP Law360*
- “Searching for ‘Reasonable Particularity,’” co-author, *Intellectual Property Magazine*
- “Lawyers Weigh in on High Court’s Patent Rulings,” quoted, *IP Law360*
- “You Need to Work Harder to Fight Trade Secret Theft,” co-author, *IP Law360*
- “Trade Secrecy: Massachusetts Update,” speaker, 16<sup>th</sup> Annual New England Intellectual Property Law Conference
- “Q&A With Choate’s Michael Bunis,” featured, *IP Law360*

## Professional and Community Involvement

- Board Member, Brookline Center for Community Mental Health
- Member, Federal Circuit Bar Association
- Former co-chair, Boston Patent Law Association Trade Secret Committee
- Former co-chair, Intellectual Property Section of the Boston Bar Association
- Former Adjunct Faculty, Boston University School of Law
- Lecturer, Gordon Engineering Leadership Program at Northeastern University
- Former Member, Choate Executive Committee

## Recognition

- *Chambers USA* (2024-2025)
- *The Legal 500* (2013-2022)
- *Best Lawyers in America* (2016-2026)
- A World’s Leading Patent Practitioner by *IAM Patent 1000* (2018-2025)
- *Lexology Client Choice*: Recognizing excellence in client service (2022)
- “National Practice Area Star” and “Litigation Star” by *Benchmark Litigation*

- *Massachusetts Super Lawyer*
- *BTI Client Service All-Star*
- *“Patent Star” by Managing Intellectual Property (2022-2025)*