

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIM SOFTWARE INC.,
Petitioner,

v.

EXINI DIAGNOSTICS AB,
Patent Owner.

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

**DECLARATION OF JOHN C. CALHOUN IN SUPPORT OF PATENT
OWNER'S NOTICE OF INTENT TO DESIGNATE JOHN C. CALHOUN, A
PROVISIONALLY RECOGNIZED PTAB ATTORNEY, AS BACK-UP
COUNSEL UNDER 37 C.F.R. § 42.10(c)(2)**

I, John C. Calhoun, hereby declare as follows:

1. I am a member in good standing of the Bar of the Commonwealth of Massachusetts.

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 was admitted *pro hac vice* in IPR2021-01355. I have not otherwise applied to appear *pro hac vice* in any other proceeding before the Office in the past three years.

8. I am an experienced litigation attorney with more than nine years of experience representing clients in patent litigation in various forums including the U.S. District Courts in Massachusetts, Delaware, the Eastern District of Virginia, the

Eastern and Western Districts of Texas, and elsewhere. I am currently a principal 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 argued dispositive motions, 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: 

John C. Calhoun
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 JOHN C. CALHOUN IN SUPPORT OF PATENT OWNER’S NOTICE OF INTENT TO DESIGNATE JOHN C. CALHOUN, A PROVISIONALLY RECOGNIZED PTAB ATTORNEY, AS BACK-UP COUNSEL UNDER 37 C.F.R. § 42.10(c)(2)** was served electronically in its entirety on December 16, 2025 via electronic mail to the following attorneys of record:

- Jeff.Metzcar@thompsonhine.com
- David.Jaglowksi@thompsonhine.com
- Marla.Butler@thompsonhine.com
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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* to be filed)

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

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

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Attorneys for Patent Owner

EX2038 – APPENDIX A

John C. Calhoun

Principal



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Practice Areas

Complex Business Litigation
IP Litigation
Securities Litigation
Insurance & Reinsurance
Investigations

Education

Yale Law School
JD (2015)

Editor, *Yale Law Journal*
Managing Editor, *Yale Journal of International Law*

Oriel College, Oxford University
M.Sc (2012) *with honors*

University of York (UK)
MA (2011) *with honors*

University of Richmond
BA (2009) *summa cum laude*, Phi Beta Kappa

Admissions

U.S. Court of Appeals, First Circuit
District of Massachusetts
Massachusetts

John Calhoun advises a wide range of clients, with particular emphases on complex contract, patent/trade secret, securities, and general commercial litigation. In addition to representing clients at trial and throughout the litigation process, he also helps clients avoid or resolve litigation risk in a cost-effective way.

Some of John's notable clients include Bank of America, Biogen, Hewlett Packard, Wells Fargo, Cisco, Liberty Mutual, Swiss Re, and Foundation Medicine.

Prior to law school, John served as a Marshall Scholar at the University of Oxford, as well as a Fulbright Scholar in Taiwan. He has advised presidential, gubernatorial, and congressional administrations and campaigns on a range of legal and policy issues.

Representative Engagements

- Prevailed at summary judgment (including for costs) while representing a major private equity firm in a suit filed by the founder of an acquired company.
- Prevailed in a First Circuit appeal while representing a major private equity firm on an issue related to a purchase agreement's indemnity provisions.
- Won at trial while representing an international insurer in successful action to rescind \$25 million product contamination insurance policy based upon policyholder's material misrepresentation of facts.
- Prevailed on a motion to dismiss while representing the founder of a leading software firm in a board dispute.
- Reached favorable settlement for law firm in a legal malpractice suit filed by a former client.
- Reached favorable settlement for automotive parts manufacturer seeking indemnification from Chinese suppliers.
- Reached favorable settlement for large U.S. bank in an OSHA-proceeding brought by an internal company whistleblower.
- Extensive representation of private independent schools in investigating and remediating allegations of sexual misconduct.
- Investigated internal company whistleblower complaint for international insurer.
- ***Momenta Pharm., Inc. v. Amphastar Pharm., Inc. et al., D. Mass., Fed. Cir.***: Trial counsel for Momenta Pharmaceuticals in patent infringement litigation relating to innovative methods of processing therapeutic polysaccharides.

- ***Guardant Health, Inc. v. Foundation Medicine, Inc., D. Del.***: Counsel for Foundation Medicine in patent infringement litigation relating to next generation sequencing analysis.
- ***Alnylam Pharmaceuticals, Inc. v. Dicerna Pharmaceuticals, Inc., D. Mass.***: Counsel in trade secret misappropriation lawsuit brought against Dicerna Pharmaceuticals.

Publications and Presentations

- “1st Circ. ADA Decision Turns On 'Essential Function' Doctrine,” author, *Law360*, May 2018
- “6th Circ. Sheds Light on Mandatory Arbitration,” co-author, *Law360*, March 2018
- “Investigating and Reporting Sexual Misconduct at Private Independent Schools,” co-author, *New England Association of Schools and Colleges Newsletter*, January 2018
- “When Can a Former Employee-Turned-Whistleblower Use Internal Company Documents?,” co-author, *Corporate Counsel*
- “Proving Ratification Of A Supervisor’s Retaliatory Motive,” author, *Law360*
- “Looking for the Dog That Didn’t Bark: Do Increased SEC Budgets Reduce Rates of Securities Fraud?,” author, *41 Vermont Law Review* 208
- *Whistleblowing and Retaliation* (6th Ed.), contributor
- “Measuring the Fortress: Explaining Trends in Supreme Court and Circuit Court Dictionary Use,” author, *Yale Law Journal*
- Book Review of “Terrorism, Ticking Time Bombs, and Torture” by Fritz Allhoff, author, *Yale Journal of International Law*, Vol. 38, No. 1

Professional and Community Involvement

- Member, Boston Bar Association
- Member, American Bar Association
- Member of multiple business and charitable boards, including the Connecticut Policy Institute, Give a Summer, the Match Charter School Network, and Firoz Academy
- Through Choate’s pro bono program, John represents special needs children to help them secure appropriate educational services

Recognition

- *The Legal 500* (2024)
- High Honors Recipient, Massachusetts Supreme Judicial Court Pro Bono Honor Roll (2023)
- *Best Lawyers in America: “Ones to Watch”* (2026)