

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Myriad Genetics, Inc., Myriad Genetic Laboratories, Inc., Bio-Rad Laboratories,
Inc., and RainDance Technologies, Inc.,
Petitioners,

v.

The Johns Hopkins University,
Patent Owner.

Case IPR2017-01106
Patent 7,824,889

JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317(a)

As authorized by the Patent Trial and Appeal Board's ("the Board's") August 14, 2017 e-mail (Exhibit 1048), Petitioners and Patent Owner jointly and respectfully move that the *inter partes* review ("IPR") of U.S. Patent No. 7,824,889 ("889 patent") be terminated under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. As required by the Board's August 14, 2017 email (*id.*), the parties provide the following information in support of their joint motion.

1. Brief Explanation As To Why Termination Under 35 U.S.C. § 317(a) Is Appropriate

Petitioners filed their petition for IPR on March 17, 2017. (Paper 1.) On April 5, 2017, the Board accorded the petition a filing date of March 17, 2017 and gave the Patent Owner until July 5, 2017 to file a Preliminary Response. (Paper 4.) The Patent Owner did not file a Preliminary Response. The parties subsequently settled their dispute and executed a confidential settlement agreement to terminate, without prejudice, both this proceeding and the parties' related district court litigation: *Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Myriad Genetics, Inc. and Myriad Genetic Laboratories, Inc.*, 16-cv-1112 (M.D.N.C.). The Stipulation and Order of Dismissal agreed to by the parties in the related district court litigation is being filed concurrently herewith as Exhibit 1049.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties' confidential settlement agreement is in writing, and a true copy of that confidential

settlement agreement – including any collateral agreements and without any redactions - is being filed concurrently herewith as Exhibit 1050.¹ The parties are also filing concurrently herewith a joint request to treat the confidential settlement agreement as business confidential information and to keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Termination of this proceeding under 35 U.S.C. § 317(a) is proper because the Board has not yet decided whether to institute an *inter partes* review and has not yet decided the merits of this proceeding. Upon the requested termination under 35 U.S.C. § 317(a), no estoppel or prejudice provided by 35 U.S.C. § 315(e) should attach to this proceeding.

Further supporting the requested termination of this proceeding under 35 U.S.C. § 317(a), the parties have agreed to terminate, without prejudice, the IPRs for the three patents that are related to the '889 patent - IPR2017-01102 (U.S. 6,440,706) ("706 patent"), IPR2017-01107 (U.S. 7,915,015) ("015 patent"), and IPR2017-01105 (U.S. 8,859,206) ("206 patent") and all district court litigation between them regarding those patents.

¹ The settlement agreement is being filed electronically via the Patent Review Processing System with access to the "Parties and Board Only."

Outside of their motions to terminate under 35 U.S.C. § 317(a), the parties are not aware of any other matter before the USPTO that would be affected by the outcome of this proceeding. Accordingly, the parties respectfully request that the Board terminate this proceeding under 35 U.S.C. § 317(a).

2. All Parties To Any Related District Court Litigation Involving The Patent In Dispute And The Current Status Of Each Such Related Litigation

To date, there have been three related district court litigations involving the patent in dispute in this proceeding. Esoterix Genetic Laboratories, LLC and The Johns Hopkins University have been the plaintiffs in each of those litigations. The case captions and defendants for each of those litigations are provided in the chart below.

Case	Defendants
<i>Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Life Technologies Corp, et al.</i> , 1:12-cv-01173-CCE-JEP (M.D.N.C.)	Life Technologies Corporation Applied Biosystems, LLC Ion Torrent Systems, Inc.
<i>Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Myriad Genetics, Inc. and Myriad Genetic Laboratories, Inc.</i> , 16-cv-1112 (M.D.N.C.)	Myriad Genetics, Inc. Myriad Genetic Laboratories, Inc.
<i>Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Ambry Genetics Corporation</i> , 16-cv-1111 (M.D. N.C.)	Ambry Genetics Corporation

The related district court litigation filed against Life Technologies Corporation, Applied Biosystems, LLC, and Ion Torrent Systems, Inc. was dismissed, with prejudice, on September 21, 2015.

The related district court litigation filed against Myriad Genetics, Inc. and Myriad Genetic Laboratories, Inc. has been settled and the parties will jointly file an agreed Stipulation and Order of Dismissal – a copy of which has been filed concurrently herewith as Exhibit 1049 – in that litigation upon termination of this proceeding under 35 U.S.C. § 317(a).

The related district court litigation against Ambry Genetics Corporation ("Ambry") remains pending. That litigation involves the '889 patent in dispute in this proceeding, as well as the '706 patent, '015 patent, and '206 patent. The Ambry litigation is currently in fact discovery and a trial date has not been set. Ambry was not, and is not, a party to Petitioners' March 2017 request for IPR of the '889 patent, and was not, and is not, a party to Petitioners' March 2017 request for IPRs of the '706 patent, '015 patent, or '206 patent. To date, and to the best of Petitioners' and Patent Owner's knowledge, Ambry has not filed a petition seeking IPR of the '706 patent, '889 patent, '015 patent, or '206 patent.

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.