

From: [Trials](#)
To: [Sadasivan, Bhanu](#); [Trials](#)
Cc: [Ambry Esoterix MWE](#); tmckeon@kilpatricktownsend.com; jalemanni@kilpatricktownsend.com; bhsing@bakerlaw.com; Matias Ferrario; cwray@kilpatricktownsend.com; jgrier@bakerlaw.com; paul.sun@elliswinters.com; kquicker@bakerlaw.com; [Mohr, Judy](#); [Alwine, Amy](#)
Subject: RE: IPR2017-002086; IPR2017-002093; IPR2017-002095; and IPR2017-002096
Date: Friday, March 23, 2018 9:47:10 AM

Counsel:

The Board authorizes the parties to file a joint motion to terminate the proceeding(s) pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. The joint motion must: (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related district court litigation involving the patent(s) in dispute and discuss the current status of each such related litigation with respect to each party to the litigation, and (3) identify the case numbers of any pending, related *inter partes* review proceedings.

The joint motion to terminate must be accompanied by a true copy of the parties' settlement agreement, including any collateral agreements referred to in such agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), filed as an exhibit. A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement. Under 37 C.F.R. § 42.74(c), the parties may file a confidential settlement agreement electronically as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions> for instructions on how to file their settlement agreement as confidential.

The joint motion(s) shall be filed no later than the close of business March 30, 2018.

Thank you,

Maria Vignone
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
703-756-1288

From: Sadasivan, Bhanu [mailto:Bsadasivan@mwe.com]
Sent: Thursday, March 22, 2018 3:16 PM
To: Trials <Trials@USPTO.GOV>
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<Aalwine@mwe.com>

Subject: IPR2017-002086; IPR2017-002093; IPR2017-002095; and IPR2017-002096

To whom it may concern:

Petitioner Ambry Genetics Corporation respectfully requests a conference call with the Board to request leave to file joint motions with patent owner to terminate IPR2017-02086 and IPR2017-02093 instituted proceedings under 35 U.S.C. § 317(a). The parties have entered into a confidential settlement agreement pursuant to which the petitioner and the patent owner agree to terminate the two recently-instituted proceedings, not to take any further action, including requests for rehearing, on the non-instituted IPRs (IPR2017-2095 and IPR2017-2096), and the parties have agreed to terminate with prejudice the related district court litigation, *Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Ambry Genetics Corporation*, 16-cv-1111 (M.D.N.C.).

Patent owner does not oppose this request for a conference call with the Board or the request to terminate the two IPR proceedings.

Counsels for the parties are available for the requested conference call at the Board’s convenience.

Respectfully,
Bhanu K. Sadasivan
Lead counsel for Petitioner

Bhanu K. Sadasivan, Ph.D.
Partner

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