

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMBRY GENETICS CORPORATION
Petitioner

v.

THE JOHNS HOPKINS UNIVERSITY
Patent Owner

Case No. IPR2017-02093

U.S. Patent No. 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") March 23, 2018 email (Exhibit 1032), Petitioner 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. Pursuant to the Board's March 23, 2018 email, 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

Petitioner filed its petition for IPR on September 11, 2017. (Paper No. 2.) On September 26, 2017, the Board accorded the petition a filing date of September 11, 2017, and gave the Patent Owner until December 26, 2017, to file a Preliminary Response. (Paper No. 3.) The Patent Owner filed a Preliminary Response on December 26, 2017. (Paper No. 6.) On March 19, 2018, the Board issued a decision instituting *inter partes* review of the '889 Patent (Paper No. 8). The parties subsequently settled their dispute and executed a confidential settlement agreement to terminate both this proceeding and the parties' related district court litigation: *Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Ambry Genetics Corporation*, 16-CV-1111 (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 1033.

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 1034.¹ 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 the merits of this proceeding, and Petitioner has agreed to no longer participate in 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), Petitioner has agreed to withdraw and no longer participate in the IPRs for the three patents that are related to the '889 patent – IPR2017-02086 (U.S. 6,440,706) (“’706 patent”), IPR2017-02096 (U.S. 8,859,206) (“’206 patent”), and IPR2017-02095 (U.S. 7,915,015) (“’015 patent”) – and the parties have agreed to

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

dismiss with prejudice the district court litigation between them regarding those patents.

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. |

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| <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 |
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The related district court litigations filed against Life Technologies Corporation, Applied Biosystems, LLC, and Ion Torrent Systems, Inc., and against Myriad Genetics, Inc. and Myriad Genetic Laboratories, Inc. were dismissed, with prejudice, on September 21, 2015 and August 24, 2017, respectively.

The related district court litigation filed against Ambry Genetics Corporation 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 1033 – in that litigation in accordance with its terms.

3. Case Numbers of Any Pending, Related IPR Proceedings

There are three pending IPR proceedings related to this proceeding: IPR2017-02086, IPR2017-02096, and IPR2017-02095. The Board issued a decision to institute IPR2017-02086 ('706 patent) (Paper No. 7) and to not institute IPR2017-02095 ('015 patent) (Paper No. 7) and IPR2017-02096 ('206 patent) (Paper No. 7). Concurrently with the submission of the joint motion to terminate this proceeding under 35 U.S.C. § 317(a), the parties are submitting a joint motion to terminate under 35 U.S.C. § 317(a) in the other related, instituted IPR, IPR2017-02086. The parties have also agreed not to take any further action, including

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