

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMBRY GENETICS CORPORATION  
Petitioner

v.

THE JOHNS HOPKINS UNIVERSITY  
Patent Owner

Case No. *To be assigned*

U.S. Patent No. 7,824,889

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PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,824,889  
UNDER 35 U.S.C. §§311-319 AND 37 C.F.R. §§ 42.1-.80, 42.100 ET SEQ.

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## INTRODUCTORY STATEMENT

Ambry Genetics Corporation (“Petitioner” or “Ambry”) in accordance with 35 U.S.C. §§311-319 and 37 C.F.R. §§42.1-.80,41.100-41.123, respectfully requests *inter partes* review for claims 1 and 8 of U.S. Patent No. 7,824,889 (‘889 Patent). Petitioner seeks review and cancellation of claims 1 and 8 of the ‘889 Patent. Claims 1 and 8 of the ‘889 Patent are unpatentable as anticipated and/or obvious under 35 U.S.C. §§ 102 and 103. The U.S. Patent and Trademark Office (“USPTO”) assignment records indicate that the ‘889 Patent is assigned to The Johns Hopkins University (“Patent Owner”).

### **I. MANDATORY NOTICES (37 C.F.R. § 42.8(A)(1))**

#### **A. Real Party-in-Interest (37 C.F.R. § 42.8(b)(1))**

The real party-in-interest is Ambry Genetics Corporation (“Petitioner” or “Ambry”). Ambry is a corporation organized under the laws of Delaware. Petitioner is not barred by operation of estoppel to submit this Petition for *inter partes* review.

#### **B. Related Matters (37 C.F.R. § 42.8(b)(2))**

U.S. Patent No. 7,824,889 (the ‘889 Patent; Ex. 1001) is asserted against Petitioner in a pending district court litigation, *Esoterix Genetics Laboratories, LLC and The John Hopkins University v. Ambry Genetics Corporation.*, United States District Court for the Middle District of North Carolina, Case No. 1:16-cv-

1111-WO-JEP (the “Ambry litigation”). The complaint was filed on September 7, 2016 (Ex. 1005) and served on Petitioner on September 12, 2016 (Ex. 1006). The '889 Patent is also presently the subject of a patent infringement lawsuit brought by the Patent Owner and assignee, The Johns Hopkins University, and its licensee, Esoterix Genetics Laboratories, against Myriad Genetics, Inc. and Myriad Genetic Laboratories, Inc., and captioned *Esoterix Genetic Laboratories, LLC and The Johns Hopkins University v. Myriad Genetics, Inc. and Myriad Genetics Laboratories, Inc.*, United States District Court for the Middle District of North Carolina, Case No. 1:16-cv-1112-WE-JEP (the “Myriad litigation”).

Petitioner is concurrently filing petitions for *inter partes review* of U.S. Patent Nos. 6,440,706, 7,915,015 and 8,859,206 also owned by Patent Owner and asserted against Ambry in the Ambry litigation.

Petitioner is aware of a petition for *inter partes review* of the '889 Patent was filed on 3/16/2017 by Myriad Genetics, Inc., Myriad Genetic Laboratories, Inc., Bio-Rad Laboratories, Inc., and RainDance Technologies, Inc. This proceeding was terminated on 8/22/2017.

**C. Designation of Lead and Back-Up Counsel (37 C.F.R. § 42.8(b)(3))**

LEAD COUNSEL	BACK-UP COUNSEL
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**A. Notice of Service Information (37 C.F.R. § 42.8(b)(4))**

Please address all correspondence to lead and back-up counsel. Petitioner consents to electronic service by email at: bsadasivan@mwe.com, Jfmahoney@mwe.com, AmbryEsoterixMWE@mwe.com and IPdocketMWE@MWE.com.

**B. Grounds for Standing (37 C.F.R. § 42.104(a))**

Petitioner certifies that the ‘889 Patent is eligible for *inter partes* review and further certifies that Petitioner is not barred or otherwise estopped from requesting *inter partes* review challenging the identified claims on the grounds in the present Petition. This Petition is filed within one year of the date Petitioner was served with a complaint of infringement of the ‘889 Patent. A true copy of the Proof of Service of Summons and Complaint, showing the date of service of September 12, 2016 is included as Ex. 1006. Petitioner has not filed a civil action challenging the validity of a claim of the ‘889 Patent. 35 U.S.C. § 315(a).

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