

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OXFORD NANOPORE TECHNOLOGIES, INC.
Petitioner,

v.

PACIFIC BIOSCIENCES OF CALIFORNIA, INC.
Patent Owner.

Case IPR2018-01785
Patent 9,738,929

MOTION TO WITHDRAW PETITION FOR *INTER PARTES* REVIEW

I. INTRODUCTION

The Board authorized Petitioner Oxford Nanopore Technologies, Inc. (“Oxford” or “Petitioner”) to file a motion to withdraw its petition for *inter partes* review and thereby terminate IPR2018-01785 directed to U.S. Patent No. 9,738,929 (“the ’929 Patent”) on January 2, 2019. Oxford now so moves. IPR2018-01785 is in its preliminary phase and Patent Owner Pacific Biosciences of California, Inc. (“PacBio” or “Patent Owner”) does not oppose this motion. To preserve the Board’s and parties’ resources and to achieve a just, speedy, and inexpensive resolution to this dispute, Oxford requests the Board withdraw this petition for *inter partes* review and thereby terminate IPR2018-01785.

II. RELATED PROCEEDINGS

The ’929 Patent is subject to a pending lawsuit entitled *Pacific Biosciences of California, Inc., v. Oxford Nanopore Technologies, Inc.*, which was consolidated into actions 1:17-cv-00275-LPS, 1:17-cv-01353-LPS (D. Del.), in which Petitioner is a defendant. The ’929 Patent is also the subject of *Oxford Nanopore Technologies, Inc. et al v. Pacific Biosciences of California, Inc.*, IPR2018-01792. IPR2018-01792 was filed on September 25, 2018 and is currently in its pre-institution phase.

III. ARGUMENT

Good cause exists to withdraw Oxford’s petition for *inter partes* review and thereby terminate IPR2018-01785 pursuant to 37 C.F.R. § 42.71(a) and § 42.72.

IPR2018-01785 is in its preliminary stage as the Patent Owners have not yet filed a Preliminary Response and the Board has not yet reached the merits or issued a decision on institution. Accordingly, withdrawal at this time would preserve both the Board's and the parties' resources in accordance with the intent of 37 C.F.R. § 42.1(b) "to secure the just, speedy, and inexpensive resolution every proceeding."

Withdrawal of Oxford's petition for *inter partes* review is also a just resolution as Patent Owner will not be prejudiced by such withdrawal and subsequent termination of IPR2018-01785. The lack of any such prejudice is evidenced by Patent Owner's agreement that it does not object to the filing of this motion. Further, to the extent Patent Owner wishes to address any issues raised in the instant petition, ample opportunity to do so is available in connection with IPR2018-01792.

IV. CONCLUSION

Petitioner respectfully requests withdrawal of the instant Petition for *inter partes* review and that the thereby Board terminate IPR2018-01785.

Date: January 11, 2019

Respectfully submitted,

/Steven P. Lendaris/

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on January 11, 2019, a complete and entire copy of the foregoing was provided by electronic service to counsel retained by Patent Owner in the Related Matters identified herein:

PacBio.Oxford.Delaware@weil.com

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: January 11, 2019

Respectfully submitted,

/Steven P. Lendaris/
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