

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 US 9,783,929 B2

Before ULRIKE W. JENKS, ZHENYU YANG, and JAMES A. WORTH,
Administrative Patent Judges.

JENKS, *Administrative Patent Judge.*

TERMINATION
Dismissing the Proceeding
35 U.S.C. § 317(a); 37 C.F.R. § 42.5(a)

The parties have requested that the above-captioned proceeding be terminated. The Board authorized Petitioner to file a motion to terminate the above-captioned proceeding on January 2, 2019. On January 11, 2019, the Petitioner filed a “motion to withdraw petition for *inter partes* review” in the above-captioned proceeding. Paper 7, 1. Patent Owner does not oppose the motion. *Id.* at 2.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” This case has not been decided on the merits and is still in the preliminary proceeding stage. A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. *See* 37 C.F.R. § 42.2. Petitioner filed its Petition on September 24, 2018. Patent Owner has not filed Preliminary Response. A decision on institution, which has not yet been made, is due on or before April 11, 2019.

The motion states that Petitioner, without opposition from Patent Owner, “requests the Board withdraw this petition for *inter partes* review and thereby terminate IPR2018-01785.” Paper 7, 2. The motion represents that Patent Owner does not oppose termination, and on this basis we construe this motion as a joint request for this purpose. *Id.*

The parties represent that the related matters involving US 9,783,929 B2 (the ‘929 patent”), namely, *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; and IPR2018-01792 filed on September 25, 2018 are both ongoing. Paper 7, 2.

Under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.” Based on e-mails to the Board seeking authorization to file this motion, we understand that the sole agreement among the parties is that Patent Owner does not oppose Petitioner’s request to withdraw its Petition.

Based on the facts of the case, and in view of the parties’ joint request for termination of this proceeding (*see* Paper 7, 2 (Petitioner filed an unopposed motion requesting termination of IPR2018-01785)), we determine that it is appropriate to dismiss the petition as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. § 42.5(a).

Therefore, the joint motion to terminate is granted. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the motion to terminate the proceeding is *granted*; and
FURTHER ORDERED that the Petition for Inter Partes Review of the
above-referenced patent is *dismissed*.

IPR2019-01785
Patent US 9,783,929 B2

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