

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENEDX, INC.

Petitioners

v.

UNIVERSITY OF UTAH RESEARCH FOUNDATION, ET AL.

Patent Owner

CASE IPR2014-01316

Patent 5,753,441

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

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Patent Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and pursuant to the authorization to file this motion provided by the Board via email to the parties on February 12, 2015, Petitioner GeneDx (“GeneDx”) and Patent Owner University of Utah Research Foundation, et al., (“Myriad”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 5,753,441, Case IPR2014-01316.

Section 317 contemplates termination of *inter partes* review upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. See 35 U.S.C. § 317.

The parties have settled their dispute and have reached agreement to terminate this *inter partes* review and the parties' co-pending *inter partes* review proceedings (IPR2014-01296; IPR2014-01298; IPR2014-01299; IPR2014-01301; IPR2014-01310; IPR2014-01311; IPR2014-01312; IPR2014-01313; IPR2014-01314; IPR2014-01315; IPR2015-00152; and IPR2015-00154). The parties' settlement agreement has been made in writing, and a true and correct copy is being filed with this Office as Exhibit 1036. Also being filed as Exhibit 1037 is a copy of the Order from the U.S. District Court for the District of Utah granting the parties' Stipulation of Dismissal of that concurrent case pursuant to the settlement agreement. The parties are also filing concurrently herewith a joint request to treat the settlement agreement as business confidential information and keep it separate

from the files of the IPR and the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Termination under Section 317 is appropriate since the Office has not yet decided the merits of the proceeding. Indeed, this *inter partes* review has not been instituted. GeneDx filed its petition for *inter partes* review on August 18, 2014. No Motions or Petitions are outstanding in this proceeding. No other party's rights will be prejudiced by the termination of this *inter partes* review.

Accordingly, GeneDx and Myriad respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 5,753,441, Case IPR2014-01316.

Respectfully submitted,

Date: February 17, 2015

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CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that the above-captioned “Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317,” along with Exhibits 1036 and 1037 was served in its entirety on February 17, 2015 upon the following counsel of record for the Patent Owner via electronic mail:

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