Filed: June 28, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORESIGHT DIAGNOSTICS INC.,

Petitioner,

v.

PERSONALIS, INC.

Patent Owner.

IPR2023-00546
U.S. Patent No. 10,450,611

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Foresight Diagnostics Inc. ("Foresight") and Patent Owner Personalis, Inc. ("Personalis") jointly move to terminate the above-referenced *inter partes* review proceeding in light of the parties' settlement of their disputes regarding the involved patent, U.S. Patent Number 10,450,611. The filing of this Joint Motion was authorized by the Board in an email dated June 26, 2024. The parties have filed a true copy of their written Settlement Agreement (Ex. 2022) in connection with this matter as required by the statute. Given that Foresight is the only Petitioner in this proceeding, the settlement effectively resolves all disputes, and the entire proceeding should be dismissed as to both Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On June 21, 2024, Petitioner and Patent Owner reached an agreement resolving all disputes regarding the patent involved in this *inter partes* review proceeding, as well as the related district court litigation between Petitioner and Patent Owner. No other petitioners remain in this *inter partes* review proceeding. Accordingly, termination is appropriate because all disputes between the parties regarding U.S. Patent Number 10,450,611 has been resolved.

The Board has not entered a Final Written Decision in this proceeding. Accordingly, termination is appropriate.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), filed separately as Exhibit 2022 is a true copy of the written Settlement Agreement resolving the disputes in the above-captioned *inter partes* review. The parties also are filing separately herewith a request that this exhibit that constitutes the settlement agreement be treated as business confidential information and be kept separate from the file of this proceeding in accordance with 37 C.F.R. § 42.74(c).

For at least these reasons, Patent Owner and Petitioner submit that termination of this *inter partes* reviews is appropriate.

Dated: June 28, 2024

Respectfully Submitted By:

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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74** and **Exhibit 2202** are being served electronically on June 28, 2024, to the e-mail addresses shown below:

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Dated: June 28, 2024

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