

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PACIFIC BIOSCIENCES OF CALIFORNIA, INC.,
Petitioner

v.

THE CHINESE UNIVERSITY OF HONG KONG,
Patent Owner

Case **IPR2024-00028**
Patent No. **11,091,794 B2**

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

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Chinese University Of Hong Kong (“Patent Owner”) and Pacific Biosciences of California, Inc. (“Petitioner”) hereby jointly request that the above-referenced pending *inter partes* review be terminated. The Board authorized the filing of this motion in an email to the parties on March 19, 2025.

An *inter partes* review “shall be terminated with respect to any petitioner 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.” 35 U.S.C. § 317(a). “If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” *Id.* “There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board *expects that a proceeding will terminate after the filing of a settlement agreement*, unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal Board, Consolidated Trial Practice Guide, at 86 (Nov. 2019) (emphasis added). The Board has routinely terminated proceedings at the request of settling parties after oral hearing has been held. *E.g., Ascend Performance Materials Operations LLC v. Samsung SDI Co., LTD*, IPR2020-00349, Pap.64, pp. 2-5 (Mar. 3, 2022) (granting motion to terminate filed after issuance of final written decision and prior to the issuance of a new final written decision on

remand from the Director); *Taiwan Semiconductor Mfg. Co. Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-01862, Pap.39, pp. 2-4 (Jan. 24, 2019) (granting termination of proceeding in view of settlement two months after oral argument); *Petroleum Geo-Services Inc. v. WesternGeco LLC*, IPR2016-00407, Pap.29, pp. 2-4 (July 5, 2017) (terminating proceeding where parties notified the Board of settlement less than a week before the statutory deadline for a final written decision); and *Lam Research Corp. v. Flamm*, IPR2015-01764, Pap.27, 4, 6 (Dec. 15, 2016) (granting full termination of proceeding after oral argument despite “extremely advanced nature” of proceeding, when “substantial resources—both on the part of the Board, as well as the parties—have been invested in this matter”).

IPR2024-00028 should be terminated in its entirety because of the strong public policy and expectation that IPRs will terminate upon settlement prior to a decision on the merits. Because Petitioner is the sole petitioner of IPR2024-00028, no petitioner will remain in IPR2024-00028 upon Petitioner’s termination. Moreover, the parties filed a Joint Stipulation for Dismissal in the United States District Court for the Northern District of California in the underlying lawsuit styled *Take2 Technologies Limited et al v. Pacific Biosciences of California, Inc.*, Case No. 5-23-cv-04166 (N.D. Cal.) which was granted on March 19, 2025. Patent Owner and Petitioner have resolved this IPR and related litigation through settlement. The

Board has not issued a decision. As such, termination would save significant further expenditures of resources by the Board and the parties.

For at least those reasons discussed above, the parties respectfully request that the Board terminate IPR2024-00028 in its entirety.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner is depositing concurrently herewith a true and correct copy of two agreements listed below (collectively the “Confidential Settlement, Assignment and Mutual Release Agreements”) governing the resolution of the *inter partes* review and underlying litigation:

1. PacBio – CUHK Assignment and Settlement Agreement. Confidential Exhibit 2061.
2. PacBio – Take2 Mutual Release. Confidential Exhibit 2062.

In accordance with 35 U.S.C. § 317(b), there is no other agreement or understanding between the Patent Owner and the Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of this *inter partes* review.

The parties are concurrently filing a joint request that the Confidential Settlement, Assignment and Mutual Release Agreements, Confidential Exhibits 2061 and 2062, be treated as business confidential information, be kept separate

from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c).

Respectfully submitted,

Date: March 20, 2025 By: / Michael J. Wise /
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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that service on Petitioner was made as follows, in accordance with 37 C.F.R. § 42.6(e):

Date of service: March 20, 2025

Manner of service: 1. Electronic submission through the USPTO Patent Trial and Appeal Board P-TACTS System
2. Electronic mail

Document(s) served: **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. §317**

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