

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEOGENOMICS LABORATORIES, INC.,
Petitioner,

v.

NATERA, INC.,
Patent Owner.

Case No. IPR2024-00812
U.S. Patent No. 11,519,035

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

TABLE OF EXHIBITS

Exhibit No.	Description
2001	RESERVED
2002	RESERVED
2003	RESERVED
2004	Abbosh et al., <i>Phylogenetic ctDNA Analysis Depicts Early-stage Lung Cancer Evolution</i> , Nature, Vol. 545 (2017)
2005	Press Release, FDA Grants Two Breakthrough Device Designations for Natera’s Signatera™ MRD Test, (March 24, 2021), https://www.natera.com/company/news/fda-grants-two-new-breakthrough-device-designations-for-nateras-signatera-mrd-test/
2006	2021 MedTech Breakthrough Award Winners, https://medtechbreakthrough.com/2021-winners/ (annotated)
2007	Press Release, Natera Awarded Advanced Diagnostic Laboratory Test (ADLT) Status for its Signatera® MRD Test From CMS (June 18, 2021), https://www.natera.com/company/news/natera-awarded-advanced-diagnostic-laboratory-test-adlt-status-for-its-signatera-mrd-test-from-cms-2/
2008	RESERVED
2009	RESERVED
2010	RESERVED
2011	Stipulation To Stay Consolidated Action, <i>Natera, Inc. v. Inivata, Inc. and Inivata, Ltd.</i> , Case No. 1:21-cv-0056 (D. Del. March 6, 2024)
2012	Complaint For Patent Infringement, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 1 (M.D.N.C. July 28, 2023)
2013	Plaintiff Natera’s Memorandum Of Law In Support Of Its Motion For A Preliminary Injunction, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 6 (M.D.N.C. July 31, 2023)
2014	RESERVED

Exhibit No.	Description
2015	RESERVED
2016	Order Granting Preliminary Injunction, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 169 (M.D.N.C. Dec. 27, 2023)
2017	Preliminary Injunction, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 171 (M.D.N.C. Dec. 27, 2023)
2018	RESERVED
2019	Order Setting Preliminary Injunction Bond, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 193 (M.D.N.C. Jan. 10, 2024)
2020	Joint Motion For Entry Of A Scheduling Order, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 203 (M.D.N.C. Jan. 29, 2024)
2021	Order On Joint Motion For Entry Of Scheduling Order, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 213 (M.D.N.C. Feb. 12, 2024)
2022	Order Denying NeoGenomics’ Motion to Stay Preliminary Injunction Pending Appeal, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 216 (M.D.N.C., Feb. 14, 2024)
2023	RESERVED
2024	RESERVED
2025	RESERVED
2026	RESERVED
2027	RESERVED
2028	Claim Construction Order, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 280 (M.D.N.C. May 17, 2024)
2029	Plaintiff Natera, Inc.’s Opening Claim Construction Brief, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 262 (M.D.N.C. Apr. 8, 2024)

Exhibit No.	Description
2030	Defendant NeoGenomics, Inc.’s Opening Claim Construction Brief, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 264 (M.D.N.C. Apr. 8, 2024)
2031	Plaintiff Natera, Inc.’s Responsive Claim Construction Brief, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 272 (M.D.N.C. Apr. 22, 2024)
2032	Defendant NeoGenomics, Inc.’s Responsive Claim Construction Brief, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 271 (M.D.N.C. Apr. 22, 2024)
2033	U.S. Patent Application No. 13/110,685 (excerpted)
2034	Order On Joint Motion To Modify Scheduling Order, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 256 (M.D.N.C. Apr. 2, 2024)
2035	Joint Stipulation And Order Regarding Extension Of Deadlines To Exchange Final Infringement And Invalidity Contentions, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 286 (M.D.N.C. June 7, 2024)
2036	U.S. Patent Application No. 16/743,724 Specification
2037	U.S. Patent Application No. 16/399,268 Specification
2038	U.S. Patent Application No. 16/140,298 Specification
2039	U.S. Patent Application No. 14/918,544 Specification
2040	U.S. Patent Application No. 14/877,925 Specification
2041	U.S. Patent Application No. 13/780,022 Specification
2042	U.S. Patent Application No. 13/335,043 Specification
2043	U.S. Patent Application No. 13/683,604 Specification
2044	U.S. Patent Application No. 13/300,235 (excerpted)
2045	Defendant NeoGenomics Laboratories, Inc.’s Opposition to Plaintiff Natera Inc.’s Motion For a Preliminary Injunction, Public Redacted Version, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 89 (M.D.N.C. Oct. 19, 2023)

NeoGenomics Laboratories v. Natera
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Exhibit No.	Description
2046	Plaintiff Natera’s Reply in Support of Its Motion For a Preliminary Injunction, Public Redacted Version, <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629, Dkt. 139 (M.D.N.C. Nov. 6, 2023)
2047	Patent Owner Natera’s annotated version of Petitioner NeoGenomics’ Exhibit 1002 in IPR2024-00812
2048	NeoGenomics’ Final Invalidity Contentions (Redacted), <i>Natera, Inc. v. NeoGenomics Labs., Inc.</i> , Case No. 1:23-cv-00629 (M.D.N.C. served July 11, 2024)
2049	Confidential Settlement Agreement Between Parties [FILED UNDER SEAL]

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board via email on September 24, 2024, Petitioner NeoGenomics Laboratories, Inc. and Patent Owner Natera, Inc., by and through their respective counsel of record, jointly request termination of this proceeding, IPR2024-00812, directed to U.S. Patent No. 11,519,035 (“’035 Patent”).

Petitioner and Patent Owner have settled their dispute regarding the ’035 Patent, including this proceeding and the related district court litigation, *Natera, Inc. v. NeoGenomics Laboratories, Inc.*, Case No. 1:23-cv-00629 (M.D.N.C.). The parties do not anticipate further litigation between them concerning the ’035 Patent.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the ’035 Patent, the proceeding is still in its early stages, and the Board has not issued a decision on institution. Terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

A true and correct copy of the parties’ settlement agreement will be filed as Exhibit 2049, along with a joint motion to treat the settlement agreement as business confidential information. Pursuant to 35 U.S.C. § 317(b), the parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreement in Exhibit 2049.

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Dated: September 24, 2024

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Dated: September 24, 2024

By: /Mehran Arjomand/

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **JOINT MOTION TO TERMINATE INTER PARTES REVIEW** and **EXHIBIT 2049** are being served electronically on September 24, 2024 to the following counsel for Petitioner to the following email addresses:

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