

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LCY Biotechnology Holding, Inc.,

Petitioner

v.

Radici Chimica S.p.A.,

Patent Owner

Case No. PGR2024-00044

U.S. Patent No. 11,781,148

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

No.	Description
1001	U.S. Patent No. 11,781,148 (the “’148 Patent”)
1002	’148 Patent Prosecution History
1003	PCT Publication No. WO2008042338 (“Bailey”) was filed by Microbia, Inc. on September 28, 2007, and published on April 10, 2008.
1004	US2004-0265980 (“Zhang”) was filed by Cognis Corp. on July 29, 2003, and published on December 30, 2004.
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1006	Declaration of Dr. Sylvia Hall-Ellis
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1010	Sam Zwenger & Chhandak Basu, <i>Plant Terpenoids: Applications and Future Potentials</i> , 3 BIOTECHNOL. MOL. BIOL. REV. 1, 1-7 (2008).
1011	John Blazeck & Hal Alper, <i>Promotor engineering: Recent advances in controlling transcription at the most fundamental level</i> , 8 BIOTECHNOL. J., 46-58 (2013).
1012	Vikki M. Weake & Jerry L. Workman, <i>Inducible Gene Expression: Diverse Regulatory Mechanisms</i> , 11 NATURE GENET., 426-437 (2010).
1013	Katrin Weinhandl et al., <i>Carbon Source Dependent Promoters in Yeasts</i> , 13 MICROBIOL. CELL. FACTORIES 5, 1-17 (2014).
1014	Tamotsu Kanai et al., <i>An n-Alkanane- Responsive Promoter Element Found in the Gene Encoding the Peroxisomal Protein of Candida tropicalis Does Not Contain a C₆ Zinc Cluster DNA-Binding Motif</i> , 182 J. BACTERIOL. 9, 2492-2497 (2000).
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1018	Michael E. Lee et al., <i>A Highly Characterized Yeast Toolkit for Modular, Multipart Assembly</i> , 4 ACS. SYNTH. BIOL. 9, 975-986 (2015).
1019	J.P. Van der Walt & J.A. von Arx, <i>The Yeast Genus Yarrowia gen. nov.</i> , 46 ANTONIE VAN LEEUWENHOEK, 517-521 (1980).
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1021	David L. Craft et al., <i>Identification and Characterization of the CYP52 Family of Candida tropicalis ATCC 20336, Important for the Conversion of Fatty Acids and Alkanes to Dicarboxylic Acids</i> , 69 APPL. ENVIRON. MICROBIOL. 10, 5983-5991 (2003).
1022	Catalogue entry for NCYC 825 <i>Yarrowia lipolytica</i> (available at https://www.ncyc.co.uk/catalogue/yarrowia-lipolytica-825).
1023	Gotthard Kunze et al., <i>The Complete Genome of Blastobotrys (Arxula) adeninivorans LS3 – a Yeast of Biotechnological Interest</i> , 7 BIOTECHNOLOGY FOR BIOFUELS 66, 1-15 (2014).
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1035	Bernard Dujon, <i>Yeast evolutionary genomics</i> , 11 NATURE GENET., 512-524 (2010).
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1073	Middelhoven, W. J., M. C. Hoogkamer-Te Niet, and N. J. Kreger-Van Rij. “ <i>Trichosporon adeninivorans</i> sp. nov., a yeast species utilizing adenine, xanthine, uric acid, putrescine and primary n-alkylamines as the sole source of carbon, nitrogen and energy.” <i>Antonie van Leeuwenhoek</i> , vol. 50, no. 4 (July 1984): 369-378.
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1076	James A. Sloots et al., <i>Glucose-responsive and oleic acid-responsive elements in the gene encoding the peroxisomal trifunctional enzyme of Candida tropicalis</i> , 105 GENE 1, 130, Figure 1 (1991).
1077	Confidential Settlement Agreement Between LCY and Radici

Petitioner, LCY Biotechnology Holding, Inc. (“Petitioner”), and Patent Owner, Radici Chimica S.p.A. (“Patent Owner”), have reached a settlement. Pursuant to 35 U.S.C. § 327(a) and 37 C.F.R. § 42.74, Petitioner and Patent Owner hereby jointly move to terminate the present post-grant review proceeding.

I. STATEMENT OF FACTS

Petitioner and Patent Owner have reached an agreement (the “Settlement Agreement”) to resolve their disputes and terminate this post-grant review proceeding. Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being contemporaneously filed with the Board as Confidential Exhibit 1077. Pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 327(b), Petitioner and Patent Owner are filing a joint request that the Settlement Agreement be treated as Business Confidential Information and be kept separate from the files of the subject patent. The joint request is being contemporaneously filed with this Motion, and the Settlement Agreement is being contemporaneously filed with “Board Only” access. The Board authorized the filing of these papers in an e-mail dated January 16, 2025.

II. ARGUMENT

The parties jointly request termination of this post-grant review and submit that termination is justified for at least the following reasons. First, this request is submitted as a “joint request” by the parties, and the Office has not yet “decided the

merits of the proceeding.” 35 U.S.C. § 327(a). Accordingly, the statutory conditions of 35 U.S.C. § 327(a) are satisfied, and the post-grant review “*shall* be terminated . . .” *Id.* (emphasis added).

Second, Petitioner and Patent Owner have reached settlement with respect to this post-grant review and with respect to the subject patent. A true and correct copy of the Settlement Agreement is being filed contemporaneously with this Motion. (Conf. Ex. 1077.) Pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 327(b), the parties request that the Settlement Agreement be kept separate from the files of this proceeding and the subject patent, and be treated as Business Confidential Information.

Finally, there are “strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Termination would also conserve judicial resources and resources of the parties. In the interest of promoting settlement and furthering the purpose of post-grant review proceedings in providing an efficient alternative to litigation in the district courts, the Motion should be granted.

III. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this post-grant review.

Respectfully submitted,

Dated: January 16, 2025

By: Mackenzie Martin
Mackenzie Martin
Registration No. 77,950
BAKER & McKENZIE LLP
1900 North Pearl Street, Suite 1500
Dallas, Texas 75201
Tel: (214) 978-3048
Mackenzie.Martin@bakermckenzie.com
Jessica Greenwald
Registration No. 75,936
BAKER & McKENZIE LLP
1900 North Pearl Street, Suite 1500
Dallas, Texas 75201
Tel: (214) 978-3063
jessica.greenwald@bakermckenzie.com

Counsel for LCY Biotechnology Holding,
Inc.

Dated: January 16, 2025

By: /Patrick A. Doody/
Patrick Doody
Registration No. 35,022
Pillsbury Winthrop Shaw Pittman LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: (703) 770-7755
Patrick.doody@pillsburylaw.com
Robert M. Bedgood
Registration No. 43,488
Pillsbury Winthrop Shaw Pittman LLP
11682 El Camino Real, Suite 200
San Diego, CA 92130-2092
Tel: (858) 509-4010
Robert.bedgood@pillsburylaw.com

Counsel for Radici Chimica S.p.A.

CERTIFICATE OF SERVICE

I hereby certify that on January 16, 2025, I caused a true and correct copy of the foregoing Joint Motion to Terminate Proceeding to be served on the Patent Owner via electronic mail to Patent Owner's counsel of record below:

Patrick Doody – Patrick.doody@pillsburylaw.com
Robert M. Bedgood – Robert.bedgood@pillsburylaw.com

Dated: January 16, 2025

By: Mackenzie Martin
Mackenzie Martin
Registration No. 77,950
BAKER & McKENZIE LLP
1900 North Pearl Street, Suite 1500
Dallas, Texas 75201
Tel: (214) 978-3048
Mackenzie.Martin@bakermckenzie.com