

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ANCESTRY.COM DNA, LLC,
Petitioner,

v.

DNA GENOTEK INC.,
Patent Owner.

Patent No. 8,221,381 B2

Inter Partes Review No. IPR2016-01152

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

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 & 42.74, DNA GENOTEK INC. (“Patent Owner”) and ANCESTRY.COM DNA, LLC (“Petitioner”) jointly move for termination of the *inter partes* review of U.S. Patent No. 8,221,381 B2 (“the ’381 Patent”) in the above-captioned Case No. IPR2016-01152. This Joint Motion was authorized by the Board pursuant to its e-mail dated February 1, 2017. In that correspondence, the Board deemed that it would treat this Joint Motion as a request to withdraw Petitioner’s request for rehearing.

Petitioner filed its second petition for *inter partes* review of the ’381 Patent on June 3, 2016 (Paper 1). Patent Owner filed a preliminary response on September 9, 2016 (Paper 6). On November 23, 2016, the Board issued its Decision Denying Institution (Paper 11). On December 23, 2016, Petitioner requested rehearing (Paper 12). The parties have since settled their dispute, and agreed to terminate this *inter partes* review of the ’381 Patent.

The parties’ Settlement Agreement has been made in writing and was executed by Patent Owner on January 30, 2017, and by Petitioner on February 1, 2017. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement Agreement is being submitted concurrently herewith as Exhibit 2004. The parties certify that there are no collateral agreements or understandings, oral or written, made in connection with, or in contemplation of, the termination of this *inter partes* review, and that the Settlement Agreement reflects the final

settlement and resolution of all disputes between Patent Owner and Petitioner regarding this *inter partes* review.

Submitted concurrently herewith is a request by Patent Owner and Petitioner that the Settlement and License Agreement 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. § 317(b) and 37 C.F.R. § 42.74(c).

No other petitioners remain in this *inter partes* review, and no final written decision on the merits has been entered. For at least these reasons, termination of this *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R.

§ 42.74(a). Should this joint motion to terminate be denied, Petitioner would not continue to participate in this proceeding.

As stated in 35 U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), because Patent Owner and Petitioner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to the Petitioner.

Dated: February 1, 2017

Respectfully submitted,

By /s/ Jennifer R. Bush

Jennifer R. Bush

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Dated: February 1, 2017

Respectfully submitted,

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Attorneys for Respondent

DNA Genotek Inc.

Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317(a) was served as of the below date by electronic mail, on the Petitioner at the following correspondence address:

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Dated: February 1, 2017

By /s/ Brian M. Kramer
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