



May 30, 2024

VIA E-FILE

The Honorable Joel H. Slomsky
13614 U.S. Courthouse
601 Market Street
Philadelphia, PA 19106

FILED UNDER SEAL

Re: 10X Genomics, Inc., et al. v. Parse Biosciences, Inc.
C.A. No. 22-cv-1117-JHS

Dear Judge Slomsky,

Defendant Parse Biosciences, Inc. (“Parse”) requests that the Court modify the scheduling order (D.I. 48) to move the trial date from December 2, 2024 to sometime in the April-May 2025 timeframe. Without such an extension, there is a grave risk that the Court and parties will waste substantial time and resources preparing for and holding a jury trial on claims from three patents that the Patent Trial and Appeal Board (“PTAB”) will ultimately find invalid. The schedule for the PTAB is statutorily defined and the result on the invalidity issue (and the three-judge panel has already found likely invalidity based on the initial submissions) is reliably expected by February 2025. The current sequence of events does not make common sense. And it risks inconsistent results and would harm Parse, a start-up with minimal annual revenue compared to the \$600 million from 10x, which did not even seek a preliminary injunction in this case.

Parse is aware that the Court, on the record before it at the time, has previously declined to stay this case pending the PTAB proceedings. *See* D.I. 164. But this is not a repeat stay request. Parse is only requesting a short extension of the trial date, primarily to allow the PTAB proceedings to complete so that the Court and parties can avoid a costly jury trial on claims that may ultimately be held invalid. This middle-ground approach—where the case will go ahead with a slightly adjusted trial date—balances the concerns of the Court and parties without prejudicing 10x.

Indeed, a primary reason that the Court previously declined to stay this case was 10x’s alleged need to promptly adjudicate three “ATAC-seq” patents that are *not* before the PTAB. This rationale—which was always questionable—has now evaporated. Just a few days ago, 10x served its opening expert report on damages, [REDACTED]. Not one. [REDACTED]

[REDACTED] There is no time-sensitive need for a quick trial on 10x’s “ATAC-seq” patents. Likewise, as to the remaining patents in this case, 10x will not be prejudiced in the slightest if the trial date is moved by just a few months. 10x effectively acknowledges this by the fact that it never sought preliminary injunctive relief against Parse, a company with revenue that is only a tiny fraction of 10x’s.

For these reasons, and the additional reasons set forth below, good cause exists for a brief extension of the trial date.

Background

10x asserts six patents in this case: three “Brenner patents” and three “Giresi patents.” The relevant history has been documented in detail previously, *see* D.I. 153 at 1, and is summarized below.

All claims of the three Brenner patents are being reviewed by the PTAB in *inter partes* review (“IPR”) proceedings. For the first Brenner patent, the PTAB determined on October 13, 2023 that Parse had shown that at least one claim was likely invalid and instituted review. By statute, a final decision must issue well before trial on or before October 13, 2024. *See* 35 U.S.C. § 316(a)(11). For the remaining two Brenner patents—which are substantially like the first Brenner patent—the situation is slightly different. For these two patents, the PTAB originally determined **not** to institute review. This, however, was the product of a now-acknowledged PTAB mistake. On February 5, 2024, the PTAB recognized that its initial decisions were based on its “misunderstanding” of the record and belatedly instituted review. *See* D.I. 107-1; D.I. 109-1; D.I. 153-1; D.I. 153-2. While Parse certainly welcomes the PTAB correcting its mistake, the unusual delay in institution nonetheless resulted in the unfortunate situation that the PTAB will not issue a final decision on the two remaining Brenner patents until after the currently scheduled trial in this case. Critically, the three Brenner patents that are currently being reviewed by the PTAB are the **only** patents for which there is an actual accused commercial product, *i.e.* the “Evercode Products.” *See* D.I. 168-2.

Regarding the Giresi patents, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] 10x recently served its expert report on damages, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Good Cause Exists To Delay The Trial Date By A Few Months

Holding Trial Before The PTAB Decisions Will Waste Resources And Harm Parse

Good cause exists to delay the trial by a few months because, absent such an extension, the Court and parties will waste major resources preparing for and holding a jury trial on claims that are most likely to be held invalid. Because the PTAB erred in delaying institution of IPR for two of the Brenner patents, there will be no final decision until roughly February 2025—**2 months** after the current trial date. These two delayed IPRs challenge 13 of the 16 asserted claims from the Brenner patents. The most recent statistics from the PTAB show that all these claims are likely to be invalidated. Specifically, the statistics show that for IPRs that reach a final written decision, 70.6% of the time **all** challenged claims are invalidated. And, 87.1% of the time, at least **some** of

the challenged claims are invalidated. See Ex. E at 11 (231 IPRs that reached final written decision, with 163 resulting in invalidation of all claims and 38 resulting invalidation of some claims).

Thus, if the Court and parties continue with a trial in December 2023, they are likely to be in a situation where, just a few months afterwards, they will learn that all—or at least some—of the claims that were presented to the jury are invalid. The Court’s time in preparing for and adjudicating trial will have been wasted, as will the time of the jurors and the parties’ themselves. After the trial, the Court and parties may be faced with inconsistent results, wiping out the verdict or otherwise creating a mess for appeal. Parse, for its part, will have wasted millions of dollars on attorneys’ fees, expert fees, and other costs preparing the pre-trial order and then appearing for trial. While this may be a drop in the bucket for 10x, this is a major expenditure for Parse.

Instructive here is the *Netlist* case from the Eastern District of Texas. There, as here, the patents at issue were subject to IPRs, but the trial was set to take place shortly before the final written decisions would issue for some of the patents. The court sensibly decided not to go ahead with the trial on the scheduled date:

The remaining two patents (U.S. Patent Nos. 8,787,060 and 9,318,160) have been instituted for review by the PTAB but no decision has been issued to date. However, it is expected that the decisions from the PTAB will issue by or before April 12, 2024. ***To put this particular case to trial before a jury in this Court before the PTAB issues its decision on the two remaining patents risks an inefficient consumption of limited judicial resources that makes imposing a targeted stay, until that ruling is received, advisable.***

Netlist, Inc. v. Micron Tech. Inc., et al., No. 22-cv-00203-JRG, at 1-2 (E.D. Tex. Feb 10, 2024) (attached hereto as Ex. F). While the court in *Netlist* chose to implement a “targeted stay” rather than extend the trial date, the rationale applied there applies equally here¹.

¹ Other courts repeatedly adopt this rationale under similar circumstances, recognizing that that, in case of a pending IPR final decision, “proceeding to trial could...prove to be extraordinarily wasteful of both the parties' resources and the Court's resources.” *Crossroads Sys., Inc. v. Dot Hill Sys. Corp.*, No. A-13-CA-1025-SS, 2015 WL 3773014, at *3 (W.D. Tex. June 16, 2015); see also *AIP Acquisition LLC v. Level 3 Commc'ns, LLC*, No. CV 12-1688-GMS, 2014 WL 12642000 at *3 (D. Del. Jan. 9, 2014) (“Moreover, if the court proceeded through to trial, a jury verdict finding the '879 patent valid might be vacated if a later IPR final decision invalidated the '879 patent.”); *Evolutionary Intel. LLC v. Yelp Inc.*, No. C-13-03587 DMR, 2013 WL 6672451, at *6 (N.D. Cal. Dec. 18, 2013) (“If the PTAB finds that some or all of the asserted claims of the Asserted Patents are invalid or subject to modification, the Court will have wasted resources and the parties will have expended funds addressing invalid claims or claims subsequently modified during reexamination.”); *Rovi Guides, Inc. v. Comcast Corp.*, No. 16-CV-9278 (JPO), 2017 WL 4876305, at *5 (S.D.N.Y. Oct. 27, 2017) (“Were the case to go forward before IPR is complete (and its concomitant streamlining benefits realized), the resources of the Court and the parties would undoubtedly be wasted on voluminous (and perhaps ultimately unnecessary) summary judgment and Daubert briefing, motions *in limine*, and perhaps even trial.”); *Progressive Cas. Ins. Co. v. Safeco Ins. Co. of Illinois*, No. 1:10CV01370, 2013 WL 1662952, at *4 (N.D. Ohio

Indeed, a deferral of just a few months would allow for a more streamlined and cost-effective resolution without the specter of inconsistent results. This is in the interest of both parties, and 10x will not be prejudiced in the slightest. 10x’s revenue dwarfs that of Parse, and thus is not suffering genuine harm that requires resolution in December 2023, rather than just a few months later. Indeed, 10x never sought a preliminary injunction. 10x’s desire to continue to trial before the PTAB weighs in on validity appears motivated solely by a desire to harm Parse.

There Is No Need For An Immediate Trial On The Giresi Patents

As noted, Parse has previously sought to stay this case. In denying these prior requests, the Court sided with 10x that there may be a need for prompt resolution of 10x’s claims based on the Giresi patents. The Court said, for instance, that “‘the parties’ disputes regarding the...Giresi Patents will need to be resolved in this action’ and ‘[t]he parties will need to engage in the full scope of fact and expert discovery in this case as to at least these patents and Parse’s Single Cell ATAC-seq Product.’” D.I. 164 at 2. [REDACTED]

This case has been pending for nearly two years. Yet, in its expert reports, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] Allowing them to influence the trial schedule would be letting the tail wag the dog.

10x’s Uncooperative Discovery Practices Necessitates An Extension

A trial-date extension is also warranted because, while fact discovery has long since closed, and opening expert reports have been served, critical depositions of the inventors on the Brenner patents—who are located in England—have not happened. This is a situation of 10x’s making.

10x’s initial disclosures from March 2023, identified inventors Gi Mikawa and Robert Osborne as witnesses. 10x’s counsel listed its address as the point of contact. See Ex. G at 4. Parse noticed depositions of Drs. Osborne and Mikawa in December 2023. Throughout January, Parse sent repeated reminders to secure these depositions, only to ultimately be informed by 10x’s

Apr. 17, 2013) (“Because it appears virtually certain that the landscape of the litigation will be significantly different following the PTAB proceedings, it is wasteful to now engage in litigation over patent claims that are likely to be altered or invalidated in the course of CBM review.”); *Ultratec, Inc. v. Sorenson Commc’ns, Inc.*, No. 13-CV-346-BBC, 2015 WL 2248437, at *4 (W.D. Wis. May 13, 2015) (holding off on resolving post-trial motions before final IPR decisions because *inter alia* this would “simplify the case, avoid a needless waste of judicial resources and prevent inconsistent results between the inter partes review and this litigation”).

counsel that they “do not control them” and cannot make them available. See Ex. H. 10x then amended its initial disclosure to remove themselves as the point of contact for Dr. Osborne. See Ex. I at 4.

This belated change forced Parse to belatedly pursue the depositions through the Hague convention. It was not until April 28, 2024 that the Court in England finally ordered the depositions, which will proceed on May 30 and 31. It goes without saying that the testimony of inventors Mikawa and Osborne may prove critical and is directly relevant to Parse’s defenses in this case. Nevertheless, this delay in obtaining critical discovery reflects yet another reason why a trial extension is warranted. See, e.g., *FG SRC LLC v. Xilinx, Inc.* No. 20-00601-WCB (D. Del. Apr. 8, 2022) (attached hereto as Ex. J) (granted a “five-month extension” and cancelled trial date due to *inter alia* “Xilinx’s conduct in discovery [] been dilatory. For instance, Xilinx’s failure to make a witness available for the 30(b)(6) deposition that SRC sought until almost three months after Xilinx was served...”).

The Court Should Hold A Hearing On Both This Motion And Plaintiffs’ Motion To Strike

Just a few moments ago, Plaintiffs filed a motion to strike certain of Parse’s defenses based on events in the parallel IPR proceedings. See D.I. 218. Plaintiffs further request a prompt oral hearing on their motion. See *id.* at 4.

Parse will respond shortly to Plaintiffs’ motion on the merits. In the meantime, however, Parse agrees with Plaintiffs that a hearing on their motion to strike is needed. Parse further believes that such a hearing should be coordinated with a hearing on the instant motion to adjust the trial schedule. Indeed, as Parse will explain more fully, the two issues are intertwined. Specifically, the best way to address the concerns raised in Plaintiffs’ motion that is most consistent with justice, fairness, and efficiency is to simply delay the trial until a few months after the PTAB issues its final written decisions in the IPR. After these decisions issue, not only will the PTAB have adjudicated Parse’s invalidity defense on the merits, but Parse will be estopped by statute from presenting the defense at trial. See 35 U.S.C. § 315(e). Thus, if Parse’s proposal adopted, the concerns Plaintiffs raise about having to address Parse’s invalidity defense will be mooted, **and** the Court will be able to benefit from the PTAB’s decision, potentially avoiding a major waste of judicial and party resources.

Conclusion

The scheduling order should be modified for the reasons aforementioned, and the Court should set a hearing on the instant motion.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (via E-mail)

EXHIBIT A

REDACTED

EXHIBIT B

REDACTED

EXHIBIT C

REDACTED

EXHIBIT D

REDACTED

Exhibit E

UNITED STATES
PATENT AND TRADEMARK OFFICE



PTAB Trial Statistics FY24 Q2 Outcome Roundup IPR, PGR

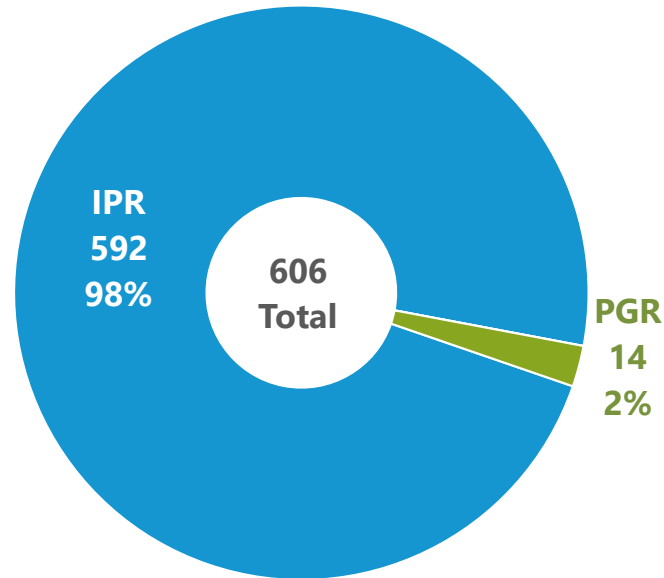
Patent Trial and Appeal Board
Fiscal Year 2024 2nd Quarter



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Petitions filed by trial type

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)

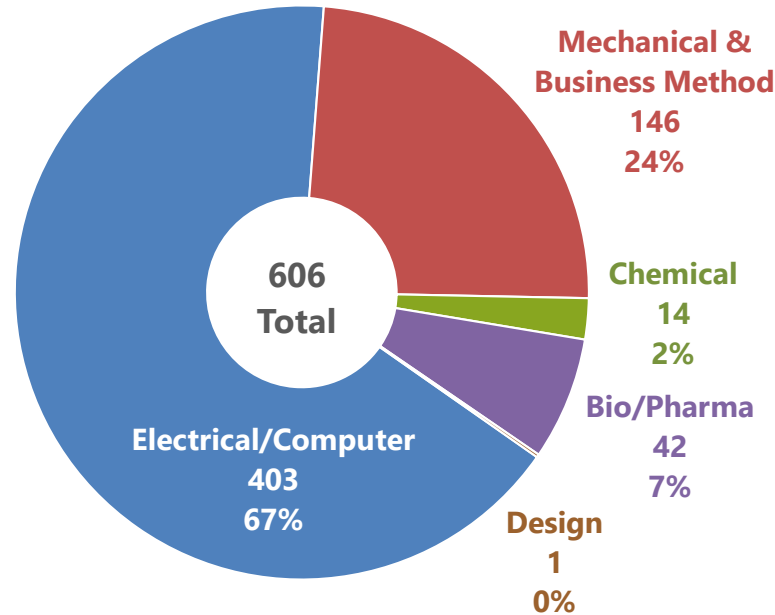


Trial types include Inter Partes Review (IPR) and Post Grant Review (PGR).



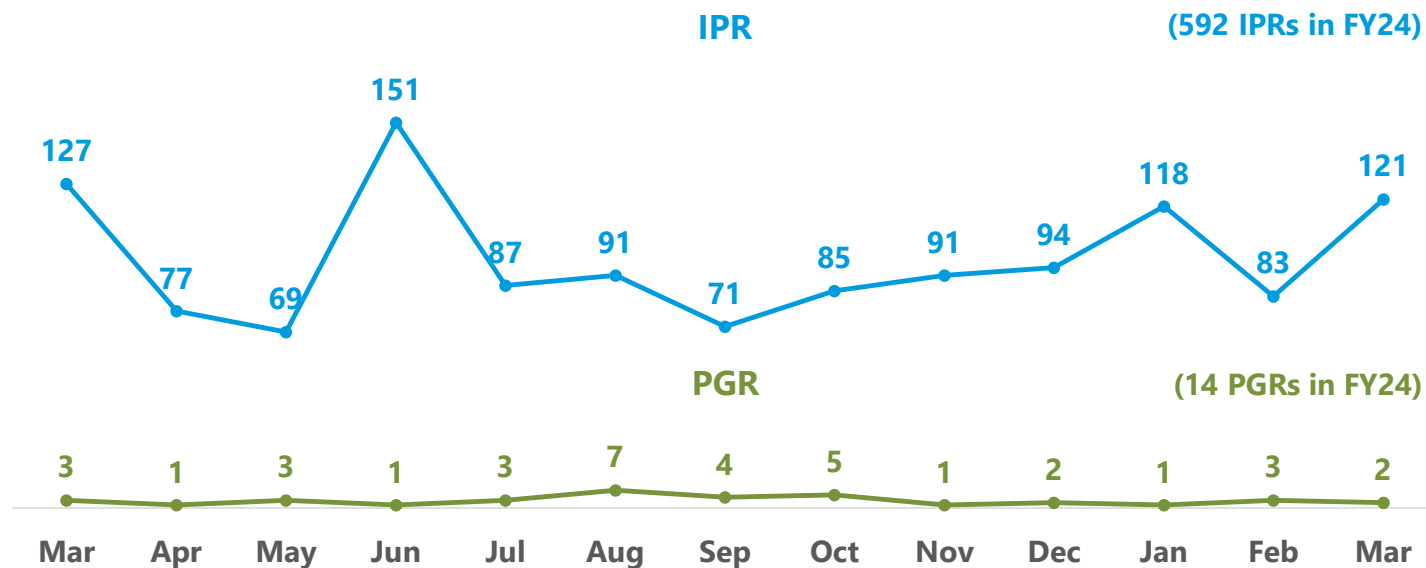
Petitions filed by technology

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)



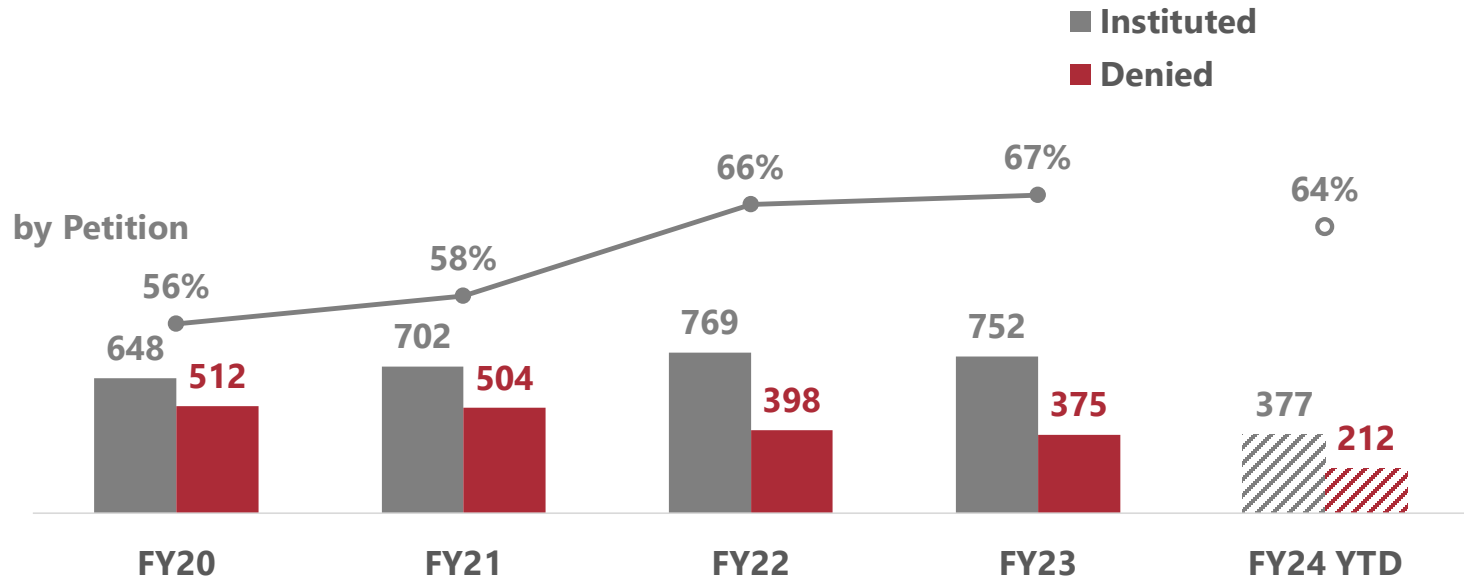
Petitions filed by month

(March 2024 and Prior 12 Months: Mar. 1, 2023 to Mar. 31, 2024)



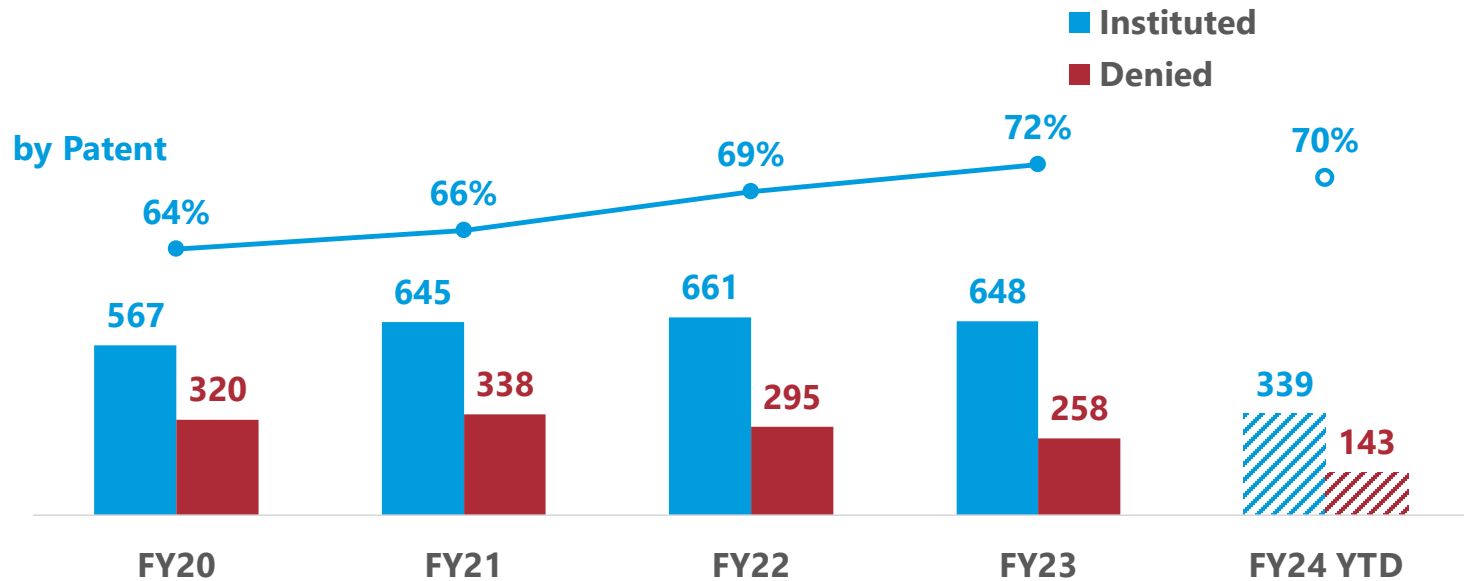
Institution rates by petition

(FY20 to FY24 through Q2: Oct. 1, 2019 to Mar. 31, 2024)



Institution rates by patent

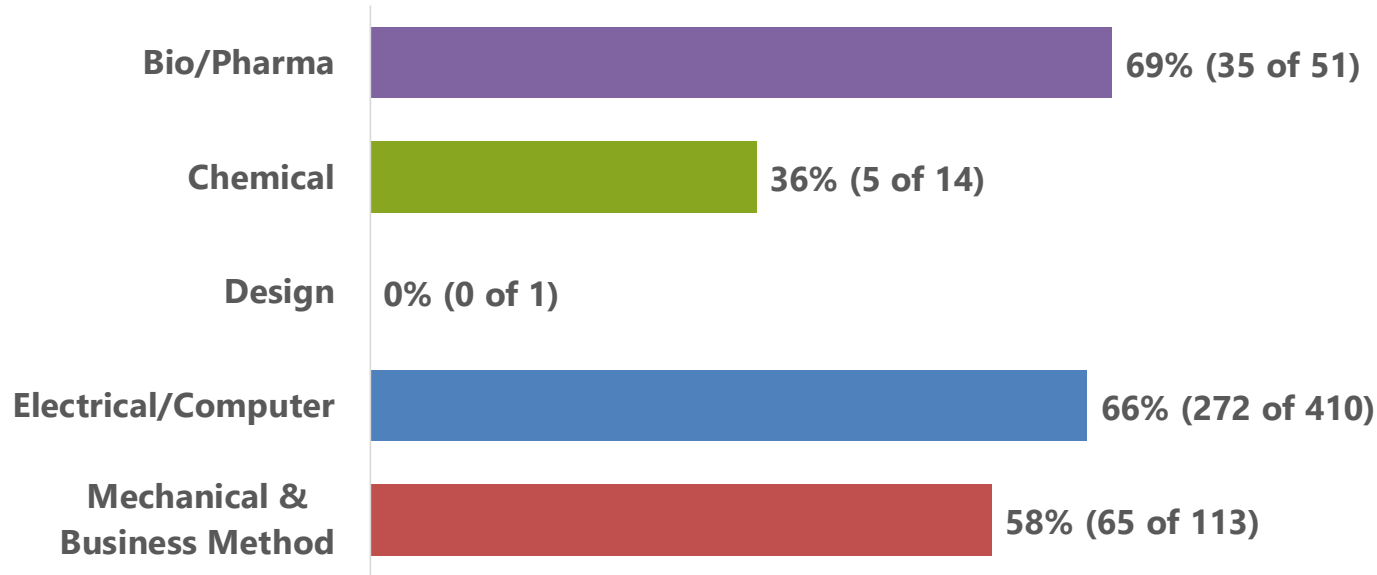
(FY20 to FY24 through Q2: Oct. 1, 2019 to Mar. 31, 2024)



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Institution rates by technology

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)

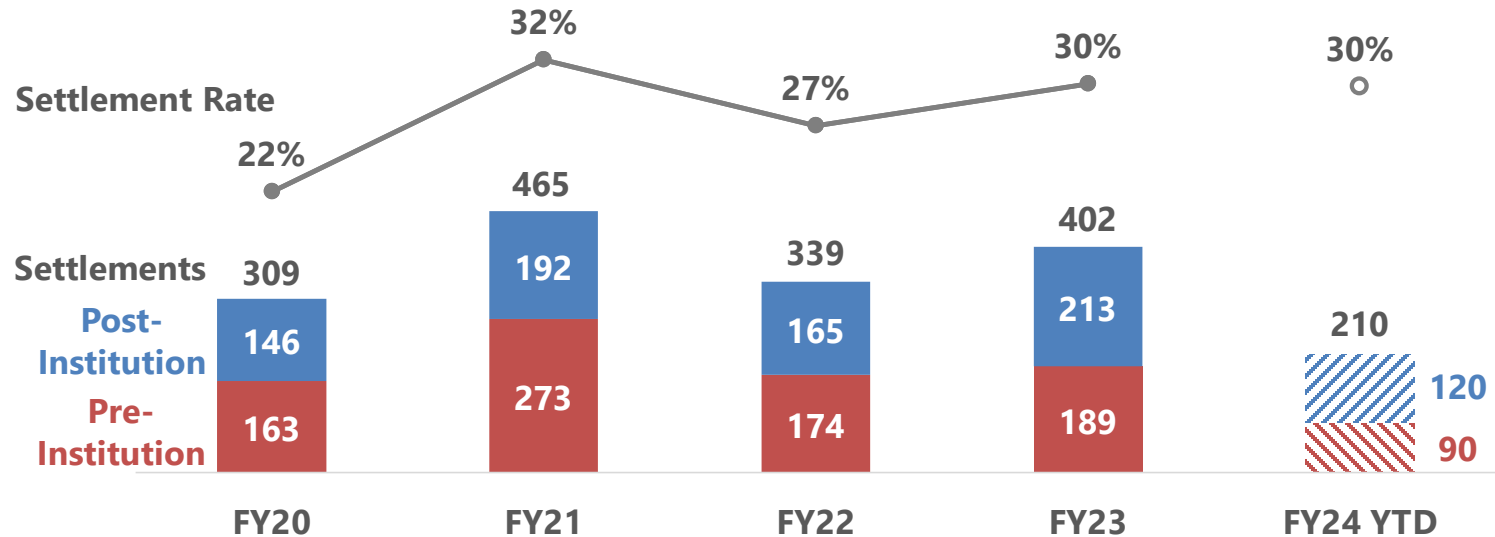


Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



Settlements

(FY20 to FY24 through Q2: Oct. 1, 2019 to Mar. 31, 2024)

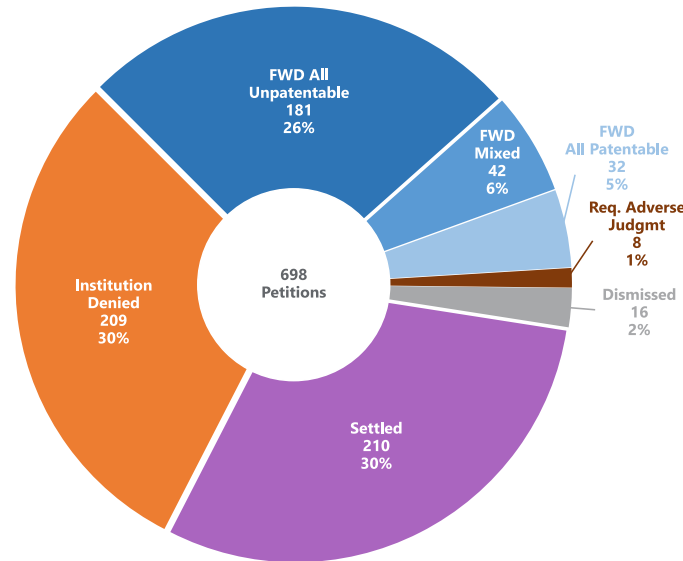


Settlement rate is calculated by dividing total settlements by concluded proceedings in each fiscal year (i.e., denied institution, settled, dismissed, requested adverse judgment, and final written decision), excluding joint cases.



Outcomes by petition

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)



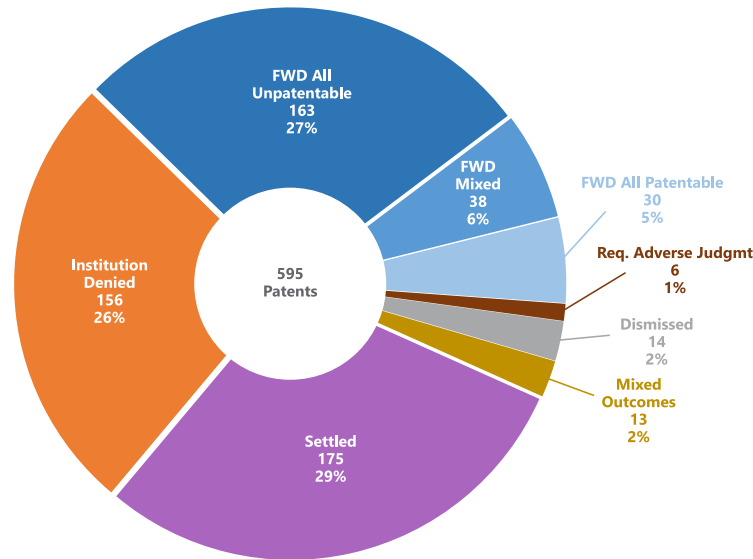
FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. Joined cases are excluded.



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Outcomes by patent

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)



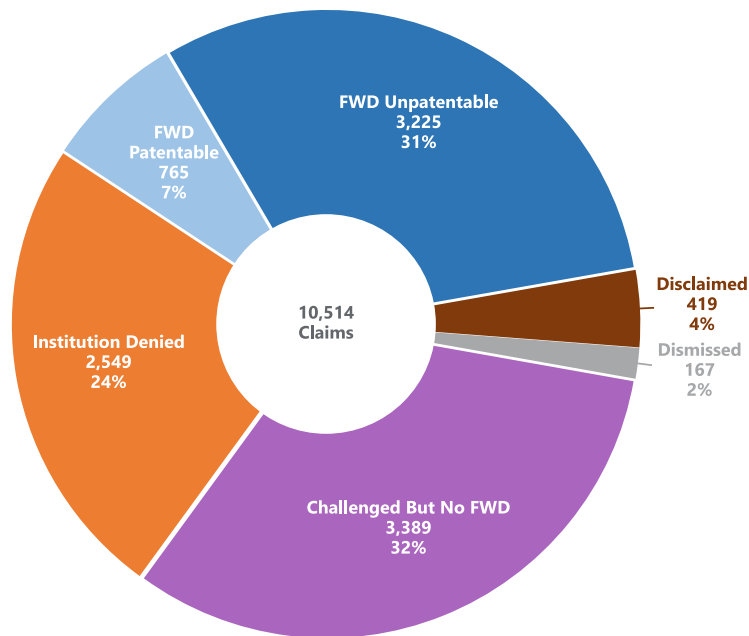
FWD patentability or unpatentability reported with respect to the claims at issue in the FWD. "Mixed Outcome" is shown for patents receiving more than one type of outcome from the list of: denied, settled, dismissed, and/or req. adverse judgement only. A patent is listed in a FWD category if it ever received a FWD, regardless of other outcomes.



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Outcomes by claim challenged

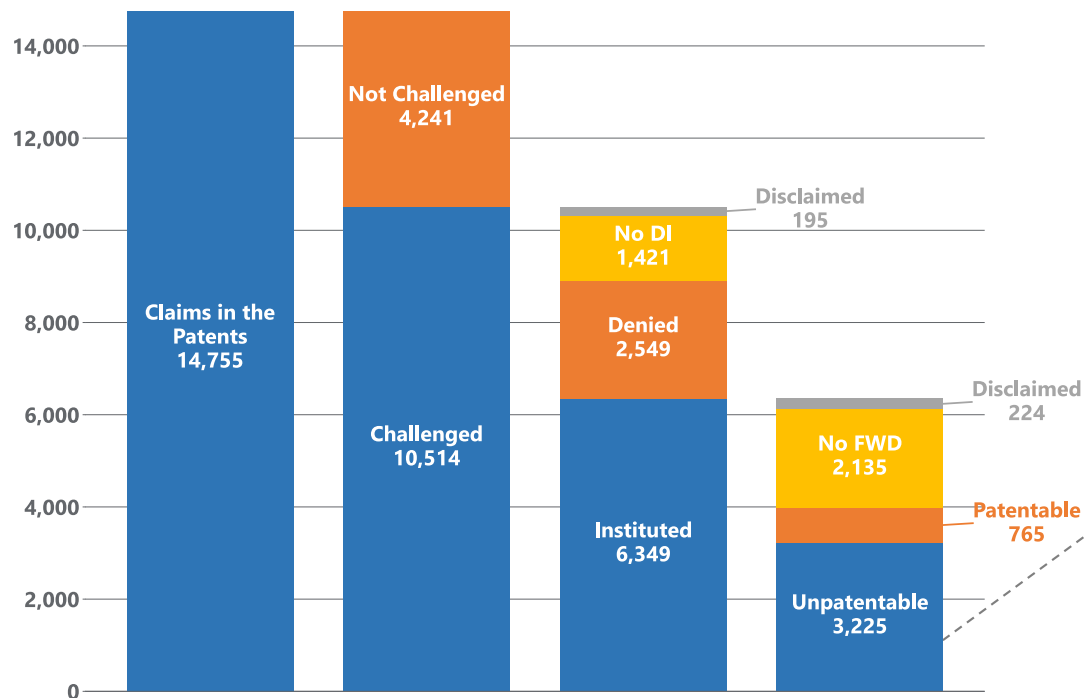
(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)



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Claim outcomes

(FY24 through Q2: Oct. 1, 2023 to Mar. 31, 2024)



"No DI" and "No FWD" mean the claim was challenged but not addressed in a DI/FWD, e.g., due to settlement.

31% of challenged claims and 51% of instituted claims were found unpatentable by a preponderance of the evidence.



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Exhibit F

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

NETLIST, INC.,

Plaintiff,

v.

MICRON TECHNOLOGY, INC., MICRON
SEMICONDUCTOR PRODUCTS INC,
MICRON TECHNOLOGY TEXAS LLC,

Defendants.

§
§
§
§
§
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§
§
§

CIVIL ACTION NO. 2:22-CV-00203-JRG

ORDER

The Court issues this Order *sua sponte*. Micron Semiconductor Products Inc., Micron Technology Texas LLC, and Micron Technology, Inc. (collectively, “Micron”) previously filed a Motion to Stay Pending Resolution of Inter Partes Review of the Asserted Patents (Dkt. No. 80.) Magistrate Judge Payne entered a Report and Recommendation (Dkt. No. 416), recommending denial of Micron’s Motion to Stay. The Court previously adopted the Report and Recommendation. (Dkt. No. 477.)

After further consideration, the Court finds that under these particular facts a limited stay is warranted in this case. This case began with six asserted patents.¹ All of these patents have been instituted for review by the Patent Trial and Appeal Board (PTAB). Four of these six patents have been invalidated by the PTAB. These decisions are being appealed. The remaining two patents (U.S. Patent Nos. 8,787,060 and 9,318,160) have been instituted for review by the PTAB but no decision has been issued to date.² However, it is expected that the decisions from the PTAB will issue by or before April 12, 2024. To put this particular case to trial before a jury in this Court

¹ U.S. Patent Nos. 10,860,506; 10,949,339; 11,016,918; 11,232,054; 8,787,060; and 9,318,160.

² These patents are before the PTAB pursuant to IPR 2022-01427 and IPR2022-01428.

before the PTAB issues its decision on the two remaining patents risks an inefficient consumption of limited judicial resources that makes imposing a targeted stay, until that ruling is received, advisable.

Accordingly, it is **ORDERED** that the Order adopting the Report and Recommendation (Dkt. No. 477) is hereby **VACATED**. It is further **ORDERED** that the above-captioned case is **STAYED** pending the PTAB's written decisions in IPR2022-01427 and IPR2022-01428, or until further order from this Court.

So Ordered this

Feb 10, 2024



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

Exhibit G

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

10X GENOMICS, INC. and THE BOARD OF)	
TRUSTEES OF THE LELAND STANFORD)	
JUNIOR UNIVERSITY)	
)	
)	
Plaintiffs,)	C.A. No. 22-1117 (JHS)
)	
v.)	
)	
PARSE BIOSCIENCES, INC.,)	
)	
Defendant.)	

PLAINTIFFS' INITIAL DISCLOSURES PURSUANT TO FED. R. CIV. P. 26(a)

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and the Scheduling Order (D.I. 48), Plaintiffs 10x Genomics, Inc. ("10x") and The Board of Trustees of Leland Stanford Junior University ("Stanford University") (collectively, "Plaintiffs") provide the following initial disclosures to Defendant Parse Biosciences, Inc. ("Parse").

Discovery and Plaintiffs' investigation are ongoing. By making these disclosures, Plaintiffs do not represent that they are identifying every document, tangible thing, or witness possibly relevant to all issues that may eventually be raised in this lawsuit. These disclosures are based on information reasonably available to Plaintiffs to date. Plaintiffs reserve all rights, consistent with Federal Rule of Civil Procedure 26(e) and the Delaware Local Rules, to modify, supplement, correct, clarify, or otherwise amend the disclosures made herein as additional evidence and information becomes available. Further, pursuant to Rule 26(a)(1) and other applicable Federal Rules of Civil Procedure, Plaintiffs are not disclosing documents or information protected by the attorney-client privilege, work product immunity doctrine or any other applicable privilege. Plaintiffs' disclosures do represent, however, a good faith effort by Plaintiffs to identify

information presently available that falls within the scope of Rule 26(a)(1). As such, these disclosures do not include information that may be used solely for impeachment purposes.

Plaintiffs' disclosures are made without in any way waiving the right to object: (1) to such information, any discovery request, or to the admissibility of any evidence on the grounds of competency, attorney-client privilege, work product protection, or any other applicable privilege, protection, or immunity, undue burden, relevancy, materiality, overbreadth, admissibility, hearsay, and any other proper ground; (2) to the use of any such information, for any purpose, in whole or in part, in any proceeding in this action or any other action; and (3) on any and all grounds, at any time, to any discovery request or proceeding involving or relating to the subject matter of these disclosures in this action or in any other action. These disclosures are made without waiver of any objections Plaintiffs may have regarding the subject matter of the disclosures and any person, entity, or documents identified by Plaintiffs herein. Nothing in these disclosures constitutes an admission on the part of Plaintiffs regarding any matter.

I. INDIVIDUALS LIKELY TO HAVE DISCOVERABLE INFORMATION

Pursuant to Rule 26(a)(1)(A)(i), the following persons are believed likely to have discoverable information that Plaintiffs may use to support their claims, unless solely for impeachment. Plaintiffs' investigation of such issues is ongoing. Plaintiffs have conducted a diligent and good faith investigation that is reasonable under the circumstances to identify persons with relevant knowledge that Plaintiffs may use to support their claims, other than for purposes of impeachment. This disclosure is based on information reasonably available to Plaintiffs at this time, and subject to the limitations set forth above.

The contact information for all current employees of either 10x or Stanford University is Plaintiffs' counsel at Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, New York 10017 unless alternate contact information is provided in the Plaintiffs'

Current and Former Employees table below. Plaintiffs do not consent to or authorize any communications with their current employees or associates and as indicated in the table below. All such communications must be made through Groombridge, Wu, Baughman & Stone LLP. With respect to the former employees of either 10x or Stanford University, and the additional individuals and entities, Plaintiffs identify their addresses and telephone numbers and/or that of their counsel based on information and belief.

Plaintiffs' present list does not foreclose the identification of any expert witnesses who will be disclosed in accord with the Scheduling Order in this case. Accordingly, Plaintiffs reserve the right to identify additional individuals at a later date. In making these disclosures, Plaintiffs do not waive their right to object, pursuant to the applicable Local and Federal Rules, to the deposition testimony of the individuals listed below.

Plaintiffs' Current Employees	Subject Matter
Dr. Howard Y. Chang Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of U.S. Patent Nos. 10,150,995 (the "'995 Patent"), 10,619,207 (the "'207 Patent"), and 10,738,357 (the "'357 Patent").
Dr. William J. Greenleaf Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.
Dr. Michael Schnall-Levin Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matter relating to 10x's technology and embodying products, and reasons for 10x's commercial success.
One or more Stanford representatives Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman &	Matters related to the licensing of the '995, '207, and '357 Patents.

Plaintiffs' Current Employees	Subject Matter
Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY 10017, (332) 269-0030	
One or more 10x representatives Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY 10017, (332) 269-0030	Matters relating to the financials for 10x's embodying products.

Plaintiffs' Former Employees	Subject Matter
Dr. Paul Giresi Address Unavailable	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.
Dr. Jason Buenrostro Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.
Dr. Robert Osborne Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of U.S. Patent No. 10,155,981 (the "'981 Patent"), U.S. Patent No. 10,697,013 (the "'013 Patent"), and U.S. Patent No. 10,240,197 (the "'197 Patent").
Dr. Gi Mikawa Address Unavailable	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '981, '013, and '197 Patents.

Additional Individuals	Subject Matter
Dr. Charlie Roco c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's Evercode WT products and single-cell ATAC-seq product(s) and the market(s) for such products, including product design, development, operation, function, design, commercial launch, pricing, sales, and marketing.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to the financials for Parse's Evercode WT products and single-cell ATAC-Seq product(s).
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's awareness or knowledge of one or more of the '995, '207, '357, '981, '013, and '197 Patents.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's Evercode WT products and single-cell ATAC-Seq product(s) and the market(s) for such products, including product design, development, operation, function, design, commercial launch, pricing, sales, and marketing.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to the sale and use of Parse's Evercode WT products and single-cell ATAC-Seq product(s).

In addition to the specific individuals named immediately above, Plaintiffs may rely on any of the following: each person or entity disclosed or relied upon by Parse, including witnesses identified in Parse's Initial Disclosures; all expert witnesses who will be disclosed at an appropriate time in this litigation; any and all experts or third parties relied upon by Parse or Plaintiffs; all document custodians and witnesses; documents and testimony of third parties identified in Parse's disclosures; all persons or entities identified in Parse's discovery responses or in any version of Parse's Initial Disclosures; and all persons or entities referenced in documents produced.

Plaintiffs have not yet identified all employees, suppliers, agents, consultants, and/or other representatives of the parties or of non-parties likely to have discoverable information that Plaintiffs may use to support their claims. Plaintiffs reserve all rights to identify such individuals as additional evidence and information becomes available.

II. DOCUMENTS, INFORMATION, AND TANGIBLE THINGS

Pursuant to Rule 26(a)(1)(A)(ii), subject to the limitations set forth above, based upon information reasonably available to Plaintiffs at the present time, Plaintiffs hereby identify the following categories of documents, electronically stored information, data compilations, and tangible things (“documents”) that may be in their possession, custody, or control and that Plaintiffs may use to support their claims, other than for purposes of impeachment.

This disclosure does not constitute an admission as to the relevance, discoverability, or admissibility of the identified materials or any documents within the categories identified. This disclosure also does not constitute a waiver of an attorney-client privilege, work-product protection, or other applicable protection or immunity or Plaintiffs’ right to withhold the production of any documents or information on one or more of these bases.

1. The inventions of the Asserted Patents, including their conception, reduction to practice, and file histories, and Plaintiffs’ ownership of the Asserted Patents.
2. Parse’s accused products, including Parse’s Evercode Whole Transcriptome Products and the Parse Single-Cell ATAC-Seq Product, and documentation associated with the products, including product literature, promotional brochures, press releases, and advertisements, advertising material, technical documentation, tutorials, and instructions.
3. 10x products that embody one or more of the Asserted Patents.
4. The harm and damages resulting from Parse’s infringement.

Plaintiffs will produce copies of such documents in their possession, custody, or control as appropriate pursuant to the Federal Rules of Civil Procedure, the Delaware Local Rules, the

Scheduling Order (D.I. 48), any Protective Order entered by the Court, and any production protocol agreed to by the parties. Plaintiffs reserve their rights to object to the production of any document within the foregoing categories on any appropriate basis, including any bases permitted by the Federal Rules of Civil Procedure and the Delaware Local Rules.

Plaintiffs reserve the right to rely on any documents and materials from others, including Parse or third parties, provided in connection with this case. Plaintiffs reserve the right to identify and use documents from additional categories if, during the course of discovery and investigation relating to this case, Plaintiffs learn that such additional categories contain relevant documents. Plaintiffs also reserve the right to rely on any deposition exhibits, documents cited or referenced in any expert report, demonstrative exhibits prepared in this case, and any documents generated in this case after the date of this disclosure, including, without limitation, correspondence, papers filed with the Court, and written discovery.

III. COMPUTATION OF DAMAGES

Plaintiffs will seek damages based on lost profits, price erosion, convoyed sales, and/or a reasonable royalty for any sales for which lost profits are not available, including through their expert or experts. And Plaintiffs may present evidence and a calculation of pre-judgment interest they are owed on its damages. Plaintiffs seek a permanent injunction enjoining Parse from any acts of infringement. Plaintiffs also seek other relief as is deemed appropriate.

Plaintiffs are unable to fully compute their damages arising from Parse's conduct at this time because Plaintiffs have not yet obtained discovery and because the infringing conduct is ongoing and thus continuously adds to damages. Plaintiffs reserve the right to amend, supplement, or otherwise modify these disclosures on the basis of information obtained during discovery, and to rely upon the opinions of qualified experts regarding any claim for damages or costs and attorneys' fees.

IV. INDEMNITY AND/OR INSURING AGREEMENTS

Plaintiffs are not presently aware of any insurance agreement required to be disclosed under Rule 26(a)(1)(A)(iv).

MORRIS, NICHOLS, ARSHT & TUNNELL LLP

/s/ Cameron P. Clark

OF COUNSEL:

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*Attorneys for Plaintiffs 10x Genomics, Inc. and
the Board of Trustees of Leland Stanford
Junior University*

March 17, 2023

CERTIFICATE OF SERVICE

I hereby certify that on March 17, 2023, copies of the foregoing were caused to be served upon the following in the manner indicated:

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Michael J. Farnan, Esquire
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Attorneys for Defendant Parse Biosciences, Inc.

VIA ELECTRONIC FILING

Edward R. Reines, Esquire
Derek C. Walter, Esquire
WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Attorneys for Defendant Parse Biosciences, Inc.

VIA ELECTRONIC FILING

/s/ Cameron P. Clark

Cameron P. Clark (#6647)

Exhibit H

From: [Philip May](#)
To: [Stephenson, Gregg](#); [Jenna Deneault](#); [Parse 10X](#); bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: [10x Parse](#); [Karen Ann Jacobs - Morris, Nichols, Arsht & Tunnell LLP](#) (kjacobs@morrisnichols.com); [Cameron P. Clark - Morris, Nichols, Arsht & Tunnell LLP](#) (cclark@morrisnichols.com)
Subject: RE: 10x v. Parse - Stipulation to Extend Fact Discovery
Date: Sunday, January 28, 2024 10:10:53 AM

Counsel,

We confirm the parties agree to an extended fact discovery period and will file a stipulation with the Court as soon as possible. We are available to meet and confer regarding the stipulation tomorrow after 2pm ET or Tuesday at 4pm ET.

Please provide deposition dates for your remaining witnesses before the meet and confer: Moe Blackman, Alex Rosenberg, and Zeynep Sayar. These individuals are all Parse employees, including Parse's CEO, so there is no reason Parse cannot provide their availability.

We confirm the following deposition dates for our witnesses. Please confirm that these work for you.

- Howard Chang: February 21 in Silicon Valley
- Paul Giresi: February 27 or 29 in Silicon Valley
- William Greenleaf: March 1 in Silicon Valley
- Jason Buenrostro: March 12 (9am-2pm) in Boston

Neither Robert Osborne nor Gi Mikawa is employed by 10x and we do not control them. We are endeavoring to get a deposition date from Dr. Osborne, and expect to have an update on this shortly. We have reached out to Dr. Mikawa several times but have received no response. 10x does not intend to call him as a witness at trial. If that changes, we agree that he can be deposed later in the case. Given this, will Parse agree to withdraw the notice for his deposition?

Regards,
Philip

Philip S. May
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philip.may@groombridgewu.com
Pronouns: He/Him/His

Exhibit I

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

10X GENOMICS, INC. and THE BOARD OF	)	
TRUSTEES OF THE LELAND STANFORD	)	
JUNIOR UNIVERSITY	)	
	)	
Plaintiffs,	)	
	)	
v.	)	C.A. No. 22-1117 (JHS)
	)	
PARSE BIOSCIENCES, INC.,	)	
	)	
Defendant.	)	

**PLAINTIFFS' SECOND SUPPLEMENTAL
INITIAL DISCLOSURES PURSUANT TO FED. R. CIV. P. 26(a)**

Pursuant to Federal Rule of Civil Procedure 26(a)(1) and the Scheduling Order (D.I. 48), Plaintiffs 10x Genomics, Inc. ("10x") and The Board of Trustees of Leland Stanford Junior University ("Stanford University") (collectively, "Plaintiffs") provide the following second supplemental initial disclosures to Defendant Parse Biosciences, Inc. ("Parse").

Discovery and Plaintiffs' investigation are ongoing. By making these disclosures, Plaintiffs do not represent that they are identifying every document, tangible thing, or witness possibly relevant to all issues that may eventually be raised in this lawsuit. These disclosures are based on information reasonably available to Plaintiffs to date. Plaintiffs reserve all rights, consistent with Federal Rule of Civil Procedure 26(e) and the Delaware Local Rules, to modify, supplement, correct, clarify, or otherwise amend the disclosures made herein as additional evidence and information becomes available. Further, pursuant to Rule 26(a)(1) and other applicable Federal Rules of Civil Procedure, Plaintiffs are not disclosing documents or information protected by the attorney-client privilege, work product immunity doctrine or any other applicable privilege. Plaintiffs' disclosures do represent, however, a good faith effort by Plaintiffs to identify

information presently available that falls within the scope of Rule 26(a)(1). As such, these disclosures do not include information that may be used solely for impeachment purposes.

Plaintiffs' disclosures are made without in any way waiving the right to object: (1) to such information, any discovery request, or to the admissibility of any evidence on the grounds of competency, attorney-client privilege, work product protection, or any other applicable privilege, protection, or immunity, undue burden, relevancy, materiality, overbreadth, admissibility, hearsay, and any other proper ground; (2) to the use of any such information, for any purpose, in whole or in part, in any proceeding in this action or any other action; and (3) on any and all grounds, at any time, to any discovery request or proceeding involving or relating to the subject matter of these disclosures in this action or in any other action. These disclosures are made without waiver of any objections Plaintiffs may have regarding the subject matter of the disclosures and any person, entity, or documents identified by Plaintiffs herein. Nothing in these disclosures constitutes an admission on the part of Plaintiffs regarding any matter.

I. INDIVIDUALS LIKELY TO HAVE DISCOVERABLE INFORMATION

Pursuant to Rule 26(a)(1)(A)(i), the following persons are believed likely to have discoverable information that Plaintiffs may use to support their claims, unless solely for impeachment. Plaintiffs' investigation of such issues is ongoing. Plaintiffs have conducted a diligent and good faith investigation that is reasonable under the circumstances to identify persons with relevant knowledge that Plaintiffs may use to support their claims, other than for purposes of impeachment. This disclosure is based on information reasonably available to Plaintiffs at this time, and subject to the limitations set forth above.

The contact information for all current employees of either 10x or Stanford University is Plaintiffs' counsel at Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, New York 10017 unless alternate contact information is provided in the Plaintiffs'

Current and Former Employees table below. Plaintiffs do not consent to or authorize any communications with their current employees or associates and as indicated in the table below. All such communications must be made through Groombridge, Wu, Baughman & Stone LLP. With respect to the former employees of either 10x or Stanford University, and the additional individuals and entities, Plaintiffs identify their addresses and telephone numbers and/or that of their counsel based on information and belief.

Plaintiffs' present list does not foreclose the identification of any expert witnesses who will be disclosed in accord with the Scheduling Order in this case. Accordingly, Plaintiffs reserve the right to identify additional individuals at a later date. In making these disclosures, Plaintiffs do not waive their right to object, pursuant to the applicable Local and Federal Rules, to the deposition testimony of the individuals listed below.

Plaintiffs' Current Employees	Subject Matter
Dr. Howard Y. Chang Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of U.S. Patent Nos. 10,150,995 (the "'995 Patent"), 10,619,207 (the "'207 Patent"), and 10,738,357 (the "'357 Patent").
Jens Durruthy Durruthy Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the market(s) for 10x's embodying products, including pricing, sales, and marketing.
Dr. William J. Greenleaf Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.

Plaintiffs' Current Employees	Subject Matter
Dr. Michael Schnall-Levin Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matter relating to 10x's technology and embodying products, and reasons for 10x's commercial success.
Mira Grigorova Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY 10017, (332) 269-0030	Matters relating to the financials for 10x's embodying products.
One or more 10x representatives Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY 10017, (332) 269-0030	Matters related to the licensing of the '995, '207, and '357 Patents.

Plaintiffs' Former Employees	Subject Matter
Dr. Paul Giresi Address Unavailable	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.
Dr. Jason Buenrostro Contact through counsel for Plaintiffs, Groombridge, Wu, Baughman & Stone LLP, 565 Fifth Avenue, Suite 2900, New York, NY, (332)-269-0030	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '995, '207, and '357 Patents.
Dr. Robert Osborne Robert Osborne, Ph.D. 330 Cambridge Science Park Milton Road Cambridge CB4 0WN United Kingdom	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of U.S. Patent No. 10,155,981 (the "'981 Patent"), U.S. Patent No. 10,697,013 (the "'013 Patent"), and U.S. Patent No. 10,240,197 (the "'197 Patent").

Plaintiffs' Former Employees	Subject Matter
Dr. Gi Mikawa Address Unavailable	Matters relating to the subject matter of, the inventions disclosed in, and the conception, reduction to practice, and development of the '981, '013, and '197 Patents.

Additional Individuals	Subject Matter
Dr. Charlie Roco c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's Evercode WT products and single-cell ATAC-seq product(s) and the market(s) for such products, including product design, development, operation, function, design, commercial launch, pricing, sales, and marketing.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to the financials for Parse's Evercode WT products and single-cell ATAC-Seq product(s).
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's awareness or knowledge of one or more of the '995, '207, '357, '981, '013, and '197 Patents.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to Parse's Evercode WT products and single-cell ATAC-Seq product(s) and the market(s) for such products, including product design, development, operation, function, design, commercial launch, pricing, sales, and marketing.
One or more representatives of Parse c/o Weil, Gotshal & Manges LLP, 201 Redwood Shores Parkway, Redwood Shores, CA 94065, (650)-802-3000	Matters relating to the sale and use of Parse's Evercode WT products and single-cell ATAC-Seq product(s).

In addition to the specific individuals named immediately above, Plaintiffs may rely on any of the following: each person or entity disclosed or relied upon by Parse, including witnesses identified in Parse's Initial Disclosures; all expert witnesses who will be disclosed at an appropriate time in this litigation; any and all experts or third parties relied upon by Parse or Plaintiffs; all document custodians and witnesses; documents and testimony of third parties identified in Parse's disclosures; all persons or entities identified in Parse's discovery responses or in any version of Parse's Initial Disclosures; and all persons or entities referenced in documents produced.

Plaintiffs have not yet identified all employees, suppliers, agents, consultants, and/or other representatives of the parties or of non-parties likely to have discoverable information that Plaintiffs may use to support their claims. Plaintiffs reserve all rights to identify such individuals as additional evidence and information becomes available.

II. DOCUMENTS, INFORMATION, AND TANGIBLE THINGS

Pursuant to Rule 26(a)(1)(A)(ii), subject to the limitations set forth above, based upon information reasonably available to Plaintiffs at the present time, Plaintiffs hereby identify the following categories of documents, electronically stored information, data compilations, and tangible things ("documents") that may be in their possession, custody, or control and that Plaintiffs may use to support their claims, other than for purposes of impeachment.

This disclosure does not constitute an admission as to the relevance, discoverability, or admissibility of the identified materials or any documents within the categories identified. This disclosure also does not constitute a waiver of an attorney-client privilege, work-product protection, or other applicable protection or immunity or Plaintiffs' right to withhold the production of any documents or information on one or more of these bases.

1. The inventions of the Asserted Patents, including their conception, reduction to practice, and file histories, and Plaintiffs' ownership of the Asserted Patents.
2. Parse's accused products, including Parse's Evercode Whole Transcriptome Products and the Parse Single-Cell ATAC-Seq Product, and documentation associated with the products, including product literature, promotional brochures, press releases, and advertisements, advertising material, technical documentation, tutorials, and instructions.
3. 10x products that embody one or more of the Asserted Patents.
4. The harm and damages resulting from Parse's infringement.

Plaintiffs will produce copies of such documents in their possession, custody, or control as appropriate pursuant to the Federal Rules of Civil Procedure, the Delaware Local Rules, the Scheduling Order (D.I. 48), any Protective Order entered by the Court, and any production protocol agreed to by the parties. Plaintiffs reserve their rights to object to the production of any document within the foregoing categories on any appropriate basis, including any bases permitted by the Federal Rules of Civil Procedure and the Delaware Local Rules.

Plaintiffs reserve the right to rely on any documents and materials from others, including Parse or third parties, provided in connection with this case. Plaintiffs reserve the right to identify and use documents from additional categories if, during the course of discovery and investigation relating to this case, Plaintiffs learn that such additional categories contain relevant documents. Plaintiffs also reserve the right to rely on any deposition exhibits, documents cited or referenced in any expert report, demonstrative exhibits prepared in this case, and any documents generated in this case after the date of this disclosure, including, without limitation, correspondence, papers filed with the Court, and written discovery.

III. COMPUTATION OF DAMAGES

Plaintiffs will seek damages based on lost profits, price erosion, convoyed sales, and/or a reasonable royalty for any sales for which lost profits are not available, including through their

expert or experts. And Plaintiffs may present evidence and a calculation of pre-judgment interest they are owed on its damages. Plaintiffs seek a permanent injunction enjoining Parse from any acts of infringement. Plaintiffs also seek other relief as is deemed appropriate.

Plaintiffs are unable to fully compute their damages arising from Parse's conduct at this time because Plaintiffs have not yet obtained discovery and because the infringing conduct is ongoing and thus continuously adds to damages. Plaintiffs reserve the right to amend, supplement, or otherwise modify these disclosures on the basis of information obtained during discovery, and to rely upon the opinions of qualified experts regarding any claim for damages or costs and attorneys' fees.

IV. INDEMNITY AND/OR INSURING AGREEMENTS

Plaintiffs are not presently aware of any insurance agreement required to be disclosed under Rule 26(a)(1)(A)(iv).

/s/ Cameron P. Clark

OF COUNSEL:

Nicholas Groombridge
Jennifer H. Wu
Josephine Young
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Naz Wehrli
Jennifer Rea Deneault
Joshua Reich
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February 1, 2024

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*Attorneys for Plaintiffs 10x Genomics, Inc. and
the Board of Trustees of Leland Stanford
Junior University*

CERTIFICATE OF SERVICE

I hereby certify that on February 1, 2024, copies of the foregoing were caused to be served upon the following in the manner indicated:

Brian E. Farnan, Esquire
Michael J. Farnan, Esquire
FARNAN LLP
919 North Market Street, 12th Floor
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Attorneys for Defendant Parse Biosciences, Inc.

VIA ELECTRONIC FILING

/s/ Cameron P. Clark

Cameron P. Clark (#6647)

Exhibit J

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

FG SRC LLC,

Plaintiff,

v.

XILINX, INC.

Defendant.

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§
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§
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§
§
§
§

Civil Action No. 20-00601-WCB

FILED UNDER SEAL

MEMORANDUM OPINION AND ORDER

In this case, plaintiff FG SRC LLC (“SRC”) has accused defendant Xilinx, Inc., (“Xilinx”) of infringing U.S. Patent No. 9,153,311 (“the ’311 patent”). Claim construction has been completed, and fact discovery is currently scheduled to close on May 2, 2022. The parties have filed two motions relating to the discovery proceedings in this case. SRC has moved to extend the deadline for fact discovery and all subsequent deadlines by five months. Dkt. No. 116. Xilinx has moved for a protective order to limit SRC’s use of third-party subpoenas. Dkt. No. 133. This order addresses both motions. SRC’s motion to extend the deadline for fact discovery (Dkt. No. 116) is GRANTED, and Xilinx’s motion for a protective order to limit SRC’s use of third-party subpoenas (Dkt. No. 133) is GRANTED IN PART.

1. Extension of Deadlines

SRC moves to extend the deadline for fact discovery by five months because SRC asserts that it “cannot reasonably conduct [its] third-party discovery before the current deadline of May 2, 2022.” Dkt. No. 117 at 1. SRC argues that Xilinx’s delay in producing information regarding its customers, many of which are located outside of the United States, has prevented it from seeking

discovery that is necessary to its case. Specifically, SRC seeks information regarding which, if any, of Xilinx's customers use Xilinx's products in an infringing manner.

Earlier in this case, SRC moved to compel Xilinx to produce certain information regarding its customers, including a spreadsheet listing customers who had purchased certain products from Xilinx that can be adapted to infringe the asserted patent. *See generally* Dkt. No. 107. After a discovery teleconference, Xilinx provided such a spreadsheet to SRC, but did not provide sufficient information for SRC to understand the contents of the spreadsheet. Dkt. No. 109 at 1. I then ordered Xilinx to provide SRC information sufficient to convey “full knowledge of the meaning of terms and abbreviations used in the spreadsheet.” Dkt. No. 111 at 1. The parties then agreed to resolve the dispute, and I entered an order memorializing the parties' agreement on February 25, 2022. Dkt. No. 113.

SRC asserts that Xilinx's delay in providing customer information has prevented SRC from conducting discovery with respect to those customers, in particular Xilinx's non-U.S. customers. Xilinx argues that the dispute regarding customer information “was crystallized in July 2021,” and therefore any delay between July 2021 and February 2022 is attributable to SRC. Dkt. No. 126 at 1 (emphasis omitted).

I find SRC's version of events to be more persuasive. Although it is true that SRC might have brought this issue to the court in July 2021, SRC instead sought to conduct a Rule 30(b)(6) deposition of Xilinx regarding its “practices and policies related to record keeping” so as to determine how to obtain information regarding possible infringing activities by Xilinx's customers. Dkt. No. 118, Exh. M, at 7–8. SRC served Xilinx with notice of that deposition on September 1, 2021. Xilinx, however, did not make that witness available until November 30, 2021, and the deposition was ultimately taken on December 14, 2021. Dkt. No. 118, Exhs. P, R.

In that deposition, SRC learned that the “information sought by SRC could be readily obtained from Xilinx’s databases in a couple of hours.” Dkt. No. 117 at 11 (emphasis omitted). I found that fact to be persuasive when I ordered Xilinx to produce the spreadsheet of customer information to SRC. If SRC had approached the court prior to obtaining that information, it may not have been able to make as strong a case for obtaining Xilinx’s customer list. I therefore find that SRC was sufficiently diligent in proceeding as it did in seeking that information.

Furthermore, I find that in certain respects Xilinx’s conduct in discovery has been dilatory. For instance, Xilinx’s failure to make a witness available for the 30(b)(6) deposition that SRC sought until almost three months after Xilinx was served with notice of that deposition contributed significantly to the delay in resolving the customer information issue between July 2021 and February 2022. And Xilinx’s refusal to provide SRC with sufficient information to interpret its customer spreadsheet, which I ordered Xilinx to produce, impeded SRC’s efforts to obtain the accessible information it sought regarding Xilinx’s customer list. While Xilinx points out that it produced some documents earlier in the discovery process that identified many of the Xilinx customers that had purchased the accused products, Xilinx failed to produce a complete customer list, in a comprehensible form, until February 2022. For that reason, Xilinx’s argument that SRC should have been more aggressive in pursuing the information that Xilinx was withholding is not persuasive.

With that said, I was disappointed to learn, from SRC’s reply memorandum, that SRC has not even begun seeking discovery from foreign sources. SRC’s excuse for its inactivity in that regard is that it did not begin foreign discovery because it did not believe it could complete all of the necessary foreign discovery by the current May 2, 2022, date for the close of fact discovery. Dkt. No. 132 at 4. That is, of course, no justification for SRC not at least beginning the foreign

discovery process. Notwithstanding SRC's failure to initiate foreign discovery, however, the course of the discovery in this case to date—and in particular the prospect that at least some foreign discovery will be required—justifies an extension of the period for fact discovery.

Accordingly, I will grant the five-month extension that SRC requests. That extension will require that the trial date currently set for March 20, 2023, be canceled. A revised scheduling order will be entered shortly. Any further extensions of the fact discovery deadline will be entertained only upon a robust showing of diligence by the party seeking the extension.

2. Protective Order

Xilinx moves for a protective order because, in its view, SRC is using subpoenas to harass its customers without a legitimate basis for doing so. More specifically, Xilinx asserts that SRC is conducting a “fishing expedition” in which it is looking for entities that have purchased Xilinx's products and may be using them in an infringing manner, even though SRC lacks a “plausible basis for believing that any of th[o]se customers use the functionality of the Asserted Patent.” Dkt. No. 134 at 1–2. As a remedy, Xilinx requests that I order SRC to withdraw most of the subpoenas it has served on Xilinx's customers in this case.

To date, SRC has served 88 subpoenas on Xilinx's domestic customers. *See* Dkt. Nos. 115, 119, 120, 129, 130, 137. And although SRC has indicated that it does not intend to serve more subpoenas on Xilinx's domestic customers, it does intend to serve subpoenas on several of Xilinx's foreign customers. Dkt. No. 142, Exh. E, at ¶ 8. For the entities that are targeted by most of those subpoenas, SRC has not suggested that it has any reason to believe that Xilinx has induced them to use methods that would infringe the asserted patent or that the target entities actually practice the infringing methods. It appears that the sole predicate for the issuance of those

subpoenas is the fact that those entities are customers of Xilinx, and that they have purchased products from Xilinx that could be used in an infringing manner.

Xilinx argues that SRC's 88 subpoenas are intended primarily to "harass Xilinx's customers and disrupt Xilinx's business." Dkt. No. 134 at 1. The subpoenas, according to Xilinx, are designed not with the expectation that they will produce evidence of infringement by Xilinx, but principally to exert pressure on Xilinx to settle this case. *Id.* at 2. Xilinx reports that it has already received complaints from customers regarding the subpoenas and questions about why those customers have been targeted "despite never having heard of the accused functionality," and that the subpoenas will impose considerable legal expenses on Xilinx's subpoenaed customers. Dkt. No. 144 at 6. SRC responds that the subpoenas are part of a legitimate effort to identify customers of Xilinx that Xilinx has induced to infringe the asserted patent and that SRC has received responses to several of its subpoenas directly from the subpoenaed parties without the involvement of outside counsel. In its reply brief, however, Xilinx reports that at least 15 law firms have already been involved in responding to the various subpoenas directed to Xilinx's customers. *Id.* Collectively, Xilinx asserts, the burden on the subpoenaed third parties, and indirectly on Xilinx, is likely to be considerable.

Under Federal Rule of Civil Procedure 26(c), "[t]he court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense." In this district, courts have identified four factors that govern the good-cause inquiry for this purpose: "relevance, need, confidentiality, and harm." *AbbVie Inc. v. Boehringer Ingelheim Int'l GmbH*, No. CV 17-1065, 2018 WL 2337133, at *1 (D. Del. May 23, 2018) (quoting *Mannington Mills, Inc. v. Armstrong World Indus., Inc.*, 206 F.R.D. 525, 529 (D. Del. 2002)).

A. Relevance

The subpoenas, which are all quite similar, are broad in scope. And for many of the subpoenas, SRC has not provided a sufficient basis for believing that they are likely to produce evidence relevant to the current action. SRC has identified no evidence that Xilinx is inducing infringement by its customers generally, and for a large majority of the subpoenaed targets, SRC has identified no evidence that those customers practice the claimed invention.¹

There are, however, a few customers for which broad subpoenas may be justified. For instance, Xilinx has identified a set of customers that it believes may use the accused functionality: Ericsson, Amazon, IBM, and Microsoft. Dkt. No. 134 at 4; Dkt. No. 107, Exh. 5, at 4. And SRC has identified two additional foreign customers for which it has articulated a basis to believe that they use the accused functionality: Nokia Oyj² and Napatech A/S. Dkt. No. 132 at 3–4. As to those customers, I find that SRC’s discovery efforts are justified, as they are directed to information that may be relevant to this litigation. In addition, Xilinx acknowledges that SRC’s subpoenas to Google and Qualcomm are supported by a sufficient showing to justify SRC’s discovery efforts, and Xilinx therefore does not seek withdrawal of the subpoenas to those two companies. Dkt. No. 144 at 1. With respect to the remaining subpoenaed Xilinx customers,

¹ SRC suggests that because certain customers have spent large sums of money on Xilinx’s products, those customers are likely to infringe. *See, e.g.*, Dkt. No. 132 at 3 (suggesting that because Nokia Oyj has “over \$[REDACTED] in purchases of Accused Products,” it is likely “that at least some portion of those Accused Products are used in an infringing manner.”). But without more, the fact that a customer has purchased more than a certain dollar amount of Xilinx’s products does not establish, or even suggest, that the customer is likely to practice the asserted claims.

² To be clear, the subpoena to Nokia Oyj is justified because “Xilinx has produced documents evidencing that Nokia Oyj and/or its subsidiaries use [the accused] functionality.” Dkt. No. 132 at 3. The sum of money that Nokia Oyj has spent on Xilinx’s products is not relevant to that determination. *See supra* note 1.

however, SRC has not pointed to any basis for believing that a broad subpoena to any of those customers is likely to produce evidence relevant to SRC's claims against Xilinx.

I recognize that without the use of third-party subpoenas, SRC may not be able to determine which (if any) of Xilinx's customers use Xilinx's products to infringe the asserted claims. In light of the liberal scope generally accorded to discovery, SRC is entitled to employ means to develop that information if it can be done without imposing undue burdens on third parties. The problem is that SRC's current subpoenas seek large amounts of information, much of which does not directly address the question whether the targeted customers infringe. For example, SRC's subpoenas generally request the following categories of documents:

“1. Documents sufficient to show, on a quarterly or monthly basis, the total volume of Accused Products purchased by You during the period from October 2015 to present.

2. Documents sufficient to show, on a quarterly or monthly basis, the total amounts paid by You to purchase Accused Products during the period from October 2015 to present.

3. Documents sufficient to show each of Your products and/or services that currently incorporates or implements an Accused Product or that previously did so at any time during the period from October 2015 to present.

4. Documents sufficient to show each of Your products and/or services that currently utilizes the Self-Refresh Functionality of any Accused Product or that previously did so at any time during the period from October 2015 to present.

5. For each of Your products and/or services that utilizes the Self-Refresh Functionality of any Accused Product or that previously did so at any time during the period from October 2015 to present, Documents sufficient to identify where such product or service is or was made, used, offered for sale, and/or sold.

6. For each of Your products and/or services that utilizes the Self-Refresh Functionality of any Accused Product or that previously did so at any time during the period from October 2015 to present, Documents sufficient to identify any code, software, development tools, platforms, or other resources provided by or obtained from Xilinx and utilized, incorporated, or implemented by or in Your product or service, including without limitation Documents sufficient to identify any Xilinx IP cores used for such product or service and what Vivado Design Suite, if any, was used in the development of the product or service.

7. Documents sufficient to show all assistance and/or support provided by Xilinx to You related to the utilization of the Self-Refresh Functionality of any Accused Product by or for any of Your products and/or services. For clarity, such Documents include, but

are not limited to, (1) project descriptions, (2) support tickets, and (3) training and instruction.

8. All Documents exchanged between You and Xilinx related to any utilization of the Self-Refresh Functionality of any Accused Product by or for any of Your products and/or services.

9. All Documents exchanged between You and any third party, including but not limited to Xilinx, related to FG SRC, the Lawsuit, and/or the '311 patent.”

See, e.g., Dkt. No. 142, Exh. A at 4 (SRC’s subpoena to Google). Of those requests, the first three relate only to the Accused Products, i.e., Xilinx’s products that, according to SRC, could be adapted to be used in an infringing manner. Those requests do not address the question whether the targeted customer actually modifies the Accused Products in a manner that could infringe the asserted patent. Requests 5 through 9 could be relevant to the current action, but only if there were a reasonable basis to believe that the targeted customer engages or has engaged in conduct that could infringe the asserted claims.

In support of its contention that most of SRC’s third-party subpoenas should be quashed in their entirety, Xilinx cites *Micro Motion, Inc. v. Kane Steel Co.*, 894 F.2d 1318 (Fed. Cir. 1990). In that case, the Federal Circuit held that a discovery request directed to a third party is not justified solely by virtue of the fact “[t]hat the discovery might uncover evidence showing that a plaintiff has a legitimate claim.” *Id.* at 1327. The court in *Micro Motion* noted that the plaintiff sought discovery from a non-party based on a “suspicion of infringement” by the non-party. *Id.* The court added that “[a]n unfounded suspicion regarding [a third party’s] infringement does not support discovery into that subject matter.” *Id.* That case is distinguishable from this one, however, because in this case SRC is targeting customers who have purchased specific products from Xilinx that SRC alleges can be used to infringe the asserted claims. That evidence, although insufficient by itself to prove infringement by the third parties or induced infringement by Xilinx,

nevertheless rises above the level of the “unfounded suspicion” that the court in *Micro Motion* addressed. *See id.*

b. Need

With respect to need, it is clear that SRC has a need for information from third parties demonstrating that the parties practice the asserted claims. Without evidence of direct infringement by a third party, SRC will be unable to establish inducement of infringement by Xilinx. *See Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 843 F.3d 1315, 1332 (Fed. Cir. 2016). And Xilinx has suggested at various points in this case that it is typically unaware of how specific customers use its products. As a result, the information SRC seeks is likely to be “uniquely available” from the parties that SRC is targeting with its subpoenas. *See AbbVie*, 2018 WL 2337133, at *2 (citation omitted).

c. Confidentiality

It is not clear whether the information SRC seeks will be confidential to the third parties that are targeted by the subpoenas. I do not find that this factor weighs heavily in the analysis, however, because any confidential information of third parties can be protected, upon request of the third parties, using confidentiality designations consistent with the protective order already entered in this case. *See* Dkt. No. 49, and April 8, 2021, order of court.

d. Harm

The potential harm to Xilinx’s customers, and by extension to Xilinx itself, is significant. As noted, SRC’s requests are quite broad. Each target of a subpoena will need to respond to it, and SRC acknowledges that many targets are likely to be cautious in responding, given that SRC is seeking evidence that those customers infringe the asserted patent. Dkt. No. 134, Exh. C. Because of the nature of the information sought, many of the subpoenaed parties may feel it

necessary to retain counsel before responding to the subpoenas, at significant cost. Moreover, as Xilinx points out, the imposition of costs associated with responding to the subpoenas “directly harms [those] customers’ willingness to continue doing business with Xilinx.” Dkt. No. 134 at 5.

It is true, as SRC suggests, that Xilinx has not provided “specific examples to substantiate any hypothetical harm to its customers.” Dkt. No. 142 at 4. For example, Xilinx does not offer any evidence of communications between Xilinx and its customers regarding SRC’s subpoenas. It does stand to reason, however, that the breadth of the subpoenas will require a significant commitment of resources from the targets of the subpoenas, and that customers may be less inclined to do business with Xilinx as a result. I therefore conclude that there is some potential harm to both Xilinx and its customers from the subpoenas, but that the nature and degree of that harm has not been shown with specificity.

* * *

Upon weighing the four relevant factors, I conclude that discovery directed to Xilinx’s customers should proceed in an iterative manner and in a different fashion with regard to different groups of third parties. With respect to the customers that Xilinx has identified as possibly using the accused functionality and the two additional foreign customers identified by SRC that are discussed above,³ I conclude that there is a sound basis for concluding that those customers may have relevant information, and that SRC’s need for that information outweighs the potential harm that may result from requests to those customers for the information sought in SRC’s subpoenas. SRC therefore need not withdraw or limit the subpoenas it has issued to those customers or any similar subpoenas it may issue to those customers in the future.

³ For clarity, the customers identified by Xilinx are Ericsson, Amazon, IBM, and Microsoft. The foreign customers identified by SRC are Nokia Oyj, and Napatech A/S.

Similarly, in light of Xilinx's concession with regard to the subpoenas to Google and Qualcomm, I will not require the subpoenas to those companies to be withdrawn or limited.

With respect to the remaining third-party domestic customers, however, the likelihood that those subpoenas will produce relevant information is entirely dependent on whether the targeted customer practices the accused functionality. If the targeted customer does use the accused functionality, the information SRC requests will likely be relevant to the action. But if the targeted customer does not use the accused functionality, the information SRC requests will likely have no relevance to this case. I find that at this point SRC has provided little reason to believe that any of the remaining third-party domestic customers are direct infringers of the '311 patent, or that Xilinx has induced any of those customers to infringe the patent. For that reason, the risk of harm to Xilinx and the potential burden on that group of customers outweighs the speculative possibility that the broad subpoenas to any of those customers may generate relevant evidence. *See Joy Techs., Inc. v. Flakt, Inc.*, 772 F. Supp. 842, 849 (D. Del. 1991) (concluding that third-party customers are "entitled to protection" absent "a specific need for evidence available only from third party customers"). I will therefore allow SRC to request only the documents listed in request number 4, identified above,⁴ from any of Xilinx's other domestic customers. In that more limited form, the subpoenas will allow SRC to determine whether the targeted customer practices the accused functionality while minimizing the burden on Xilinx's customers, and by extension, Xilinx.

⁴ Request number 4 seeks "Documents sufficient to show each of Your products and/or services that currently utilizes the Self-Refresh Functionality of any Accused Product or that previously did so at any time during the period from October 2015 to present." Dkt. No. 142, Exh. A at 4.

If further discovery reveals either (1) that Xilinx has engaged in conduct that could fairly be viewed as inducing particular customers to practice the methods claimed in the asserted patent, or (2) that particular Xilinx customers are in fact practicing the accused functionality, I will permit SRC to serve a supplemental subpoena of greater breadth directed to those customers as to which a showing of possible inducement by Xilinx, or possible direct infringement by the customers has been made. For the present, however, a broad demand for information from 80 or more customers of Xilinx, based on no indication that those customers are direct infringers or that Xilinx has taken any steps that would constitute inducement for those customers to infringe, is not justified. Before serving any such supplemental subpoena, as described in this paragraph, on any of the remaining third-party customers of Xilinx, SRC must seek leave of court.

In summary, and to be clear, SRC will be allowed to issue only limited subpoenas to any third-party domestic customers of Xilinx absent a showing either that Xilinx induced infringement by the customer being targeted or that the customer being targeted uses the accused functionality. A sufficient showing exists for Amazon, IBM, and Microsoft, and the subpoenas already served on those three customers may remain in effect. Likewise, the subpoenas to Google and Qualcomm may remain in effect, and discovery directed to foreign customers Ericsson, Nokia Oyj, and Napatech A/S that is commensurate in scope with the subpoenas already served on the domestic customers will be permitted. All other subpoenas must be withdrawn except to the extent that they request documents identified in request number 4 of SRC's subpoena to Google or to the extent that those subpoenas have already been responded to. *See* Dkt. No. 142, Exh. A, at 4. SRC is directed to inform the remaining Xilinx customers on which such subpoenas have been served that in light of this court's order, they are required at this time to respond only to paragraph 4 (or the equivalent paragraph) of the subpoena. Xilinx will be permitted to confirm that instruction with

the targeted customers if it elects to do so. No broader subpoenas directed to Xilinx's domestic customers may be issued by SRC without first seeking leave of court.

In an abundance of caution, this order has been filed under seal because some of the parties' initial briefs and exhibits regarding the present motions were filed under seal. *See, e.g.*, Dkt. Nos. 118, 126, 132. Within three days of the issuance of this order, the parties are directed to advise the court by letter whether they wish any portions of the order to remain under seal. Any request that portions of the order should remain under seal must be supported by a particularized showing of need to limit public access to those portions of the order.

IT IS SO ORDERED.

SIGNED this 8th day of April, 2022.

A handwritten signature in black ink, reading "William C. Bryson", is written over a horizontal line.

WILLIAM C. BRYSON
UNITED STATES CIRCUIT JUDGE