UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner,

v.

10X GENOMICS, INC.,
Patent Owner.

Case No. IPR2023-00955
U.S. Patent No. 10,240,197

PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO TERMINATE PROCEEDINGS

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EX1006	Leslie H. Brail et al., *Gene expression in individual cells: analysis using global single cell reverse transcription polymerase chain reaction (GSC RT-PCR)*, 406 Mutation Research Genomics, 45-54 (1999) ("Brail")
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EX1031	Cole Trapnell, *Defining cell types and states with single-cell genomics*, 25(10) Genome Research 1491-1498 (2015) ("Trapnell")
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EX1060	Reinhard Stöger, *Epigenetics and Obesity*, 9(12) Pharmacogenomics 1851-1860 (2008) at https://www.ncbi.nlm.nih.gov/pmc/articles/PMC2652025/ ("Stöger")
EX1061	Diane P. Genereux et. al, *Errors in the Bisulfite Conversion of DNA: Modulating Inappropriate- and Failed-Conversion Frequencies*, 36 Nucleic Acids Research 1-19 (2008) ("Genereux")

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I. INTRODUCTION

Patent Owner 10x Genomics, Inc. ("PO") seeks to hamstring Petitioner Parse Biosciences, Inc. ("Petitioner"/"Parse") by filing both a motion to terminate this action as well as a motion to strike Parse's invalidity defense based on Linnarsson/McCloskey in the parallel District Court proceedings. PO seeks to force a District Court trial without allowing for adjudication by this tribunal of one of Parse's primary defenses. PO strategically waited nearly 10 months to raise the issue until ***after*** Parse served its opening expert reports in District Court, functionally locking Parse into its invalidity defenses. Even worse, PO now refuses to agree to a modest extension of the trial of ***just a few months***, which would moot this issue entirely. PO's refusal to agree to this modest extension is proof-positive that the instant motion—coupled with PO's District Court actions—is nothing more than a strategic ploy to harm Parse, not a genuine effort to avoid duplicative litigation.

At the time Parse filed its Petition and offered the stipulation at issue over 18 months prior to the scheduled District Court trial, the timeline easily allowed for the final written decision to issue before trial. Thus, Parse reasonably believed that a final written decision would issue prior to the scheduled trial date. Terminating this proceeding would lead to an unjust and unfair result that stems from an unforeseeable set of changed circumstances—namely, an erroneous delay in institution of nearly four months. The law is clear that a party should not be held

to a stipulation or representation under such unforeseeable changed circumstances.

There is a better, alternative approach that fully addresses the concerns of all parties and is more efficient for the Board and the District Court. Specifically, as discussed with the Board, Parse has requested that the District Court extend the trial date by a few months until *after* the Board's final written decisions. Once the final written decisions issue, Parse will be estopped by statute from presenting the disputed defenses at trial, completely mooting PO's motion to terminate. The District Court has now scheduled a hearing on Parse's motion to extend the trial, as well as PO's motion to strike Parse's invalidity defense, for August 20, 2024. The Board should wait for the District Court to resolve those pending motions, which may well moot PO's motion to terminate this proceeding.

Though PO now says otherwise, it has known for roughly ten months that Parse intended to rely upon its IPR defenses in the District Court. PO, however, stood idly by and did not request a stipulation in the District Court regarding these defenses, nor raise the issue to the Board, until after Parse served its opening expert reports in the parallel proceeding. PO's motion is thus nothing more than a strategic and opportunistic attempt to harm Parse. PO's calculated strategy is confirmed by its refusal to agree to a modest extension of the trial that would avoid this entire issue. Having engaged in such prolonged delay solely for tactical purposes, Plaintiffs should be deemed to have waived the relief they request.

II. FACTUAL BACKGROUND

PO asserts three related Brenner patents in the parallel District Court proceeding. Parse filed the IPR Petitions for all three Brenner patents in spring 2022, the timing being selected so that the PTAB would have time to issue final decisions before the December 2024 trial date in the District Court. Each of the three Petitions was based on invalidity of the claims in view of the combination of Linnarsson and McCloskey. Given that Parse had filed its IPR requests with a reasonable belief that the PTAB would issue decisions before trial, Parse said in its Petitions that it would stipulate not to pursue the Linnarsson/McCloskey defense in the parallel proceeding if the PTAB were to institute the IPRs.

For the ’197 and ’013 patents, however, events took an unexpected turn. For these two patents, the panel originally determined not to institute review. These decisions were unanticipated because the Brenner patents are all substantially similar. In fact, the Board’s decisions for the two remaining Brenner patents were the product of a now-acknowledged misapprehension. On February 5, 2024, the panel recognized that its decisions were based on its “misunderstanding” of the record and instituted review. Pap.9, 3. The unusual delay in institution resulted in the unfortunate situation that the Board will now issue a final decision on the two remaining Brenner patents months after the currently scheduled trial in the parallel District Court case.

From the earliest stages of the District Court proceeding—including before the PTAB issued its institution decisions—Parse put Plaintiffs on notice that it might rely upon the arguments presented in its IPR decisions. For instance, in its September 19, 2023 invalidity contentions, Parse said precisely this: "Parse incorporates in full all invalidity arguments made in IPR2023-00876, IPR2023-00955, IPR2023-00958, IPR2023-00878, IPR2023-01030 and IPR2023-01033." EX2035 at 8. Similarly, after the institution decisions, Parse served amended invalidity contentions, where it similarly stated as follows:

> Parse incorporates in full all invalidity arguments made in IPR2023-00876, IPR2023-00955, IPR2023-00958, IPR2023-00878, IPR2023-01030 and IPR2023-01033. The same prior art and combinations thereof before the Patent Trial and Appeal Board renders the Asserted Claims of the Patents-in-Suit invalid here.

EX2035 at 17. After the panel issued its first institution decision in October 2023, PO made no contact with Parse regarding a stipulation to withdraw the Linnarsson/McCloskey defenses in the District Court. Likewise, after the PTAB corrected its error in the remaining two IPRs and instituted review in February 2024, PO remained silent. Then, after Parse served its amended invalidity contentions in April 2024 stating that it might rely upon the Linnarsson/McCloskey defense in the District Court, PO remained silent. It was not until roughly a week ***after*** Parse

served its expert report on May 17, 2023 that PO first reached out to Parse regarding a stipulation to withdraw the Linnarsson/McCloskey defense. EX2037.

III. ARGUMENT

A. Parallel District Court Motions May Well Moot This Motion

First, and most important, the panel should wait to rule on this motion until after the District Court's decision on the parallel motion to strike, scheduled for hearing on August 20. If this hearing results in an extension of the trial date, the final written decisions will issue prior to trial as Parse originally anticipated, and this will entirely moot PO's motion here.

B. The Petition Should Not Be Terminated Because Of Unforeseeable Delay In Institution

PO argues that even had the "IPRs been initially instituted without any rehearing, the final written decisions still would not have been due until after the scheduled December 2, 2024 trial." Pap.23, 6. It is undisputed, however, that the final written decisions would have been due within two weeks of that trial and Parse could have advised the Board and the District Court of the timeline. Under those circumstances the final written decisions could have easily issued in advance of the trial or the District Court trial could be moved. In the District Court, PO never disputed this point.

Regardless, at the time Parse offered the stipulation, Parse could not have

expected the months-long delay in institution from the Board's misunderstanding, and reasonably believed the final written decision would issue prior to the District Court trial. Parse should not now be held to the stipulation, which was offered based on its reasonable expectation at the time. Stipulations can be vacated to prevent "manifest injustice." *Waldorf v. Shuta*, 142 F.3d 601, 616 (3d Cir. 1998); *Glasco v. Aerotek Prof'l Serv., Inc.*, No. 11-874, 2012 WL 12848184, at *3 (W.D. Okla. Aug. 6, 2012) (holding adherence to stipulated facts "is not categorical" and that courts may relieve a party from a stipulation "that might work injustice").

This is precisely such a case where holding Parse to a prior stipulation and terminating this IPR would work injustice. Parse filed the '197 and '013 patent IPR Petitions on May 25, 2023, well over 18 months prior to the scheduled District Court trial. Parse timed its IPR filings reasonably believing that the PTAB would have plenty of time to issue final written decisions before trial in the District Court. Due to the unforeseeable misunderstanding of the Board, however, the IPR proceedings for these two Brenner patents were delayed by months, such that they now will not complete for several months beyond the current trial date. At the time Parse filed its IPRs, it could not have anticipated such unexpected circumstances that would cause the schedule to deviate so substantially from the normal timeline.

If Parse's IPRs are conditionally terminated in view of the representation Parse made in its initial IPR filings based on the understanding that the IPRs would

proceed according to their normal timeline, then Parse will be penalized harshly for the PTAB's misunderstanding. As Parse has made clear, it will need to drop the McCloskey/Linarsson defense in District Court so that it can have the benefit of the PTAB's adjudication of the defense, which may well lead to the invalidation of the challenged claims. Through no fault of its own, Parse would then be forced to spend millions of dollars doing a jury trial on potentially invalid claims ***and*** without the benefit of one of its strongest defenses. Such circumstances call for the Board to not hold Parse to representations made months ago when circumstances were different. *See, e.g.*, *XY LLC Beckman v. Trans Ova Genetics*, No. 17-00944, 2018 WL 7512225 at *3 (D. Colo. Dec. 5, 2018) ("Defendant has good cause to seek withdrawal from the Stipulation on the basis of changed circumstances, and to prohibit Defendant from withdrawing from the Stipulation as to infringement occurring after May 6, 2018 would deprive Defendant of the opportunity to have issues related to infringement, willful infringement, damages, and injunctive relief decided on the merits.").

PO contends that termination is proper because "a fundamental underpinning" or the institution decision has changed. Pap.23, 4. This mischaracterizes the institution decisions. The Board did not discuss the *Fintiv* factors or mention the offered stipulation in either its original Decision Denying Institution or its Decision Granting Rehearing and Instituting. Pap.7, Pap.9. Further, PO did not provide

any argument on the *Fintiv* factors or mention the stipulation in its Preliminary Response. Pap.6. Thus, because Petitioner's offered stipulation does not appear to weigh on the decision to institute, and PO failed to provide any argument on *Fintiv*, there is no prejudice caused by the lack of adopting the offered stipulation. Denying termination here will not "encourage others to repeat" these circumstances because future Petitioners cannot intentionally seek denial of institution and rehearing for the sake of getting around a limited stipulation. Pap.23, 5.

Given the unforeseeable circumstances of these proceedings, PO's cited cases are inapposite. *See Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, IPR2014-00607, Pap.65, 20-21 (May 22, 2015) (terminating IPR where Petitioner mislead the Board regarding the real parties-in-interest such that Petitions were "incomplete and cannot be considered"); *Apple, Inc. v. Universal Secure Registry*, CBM2018-00025, Pap.42, 20 (Nov. 26, 2019) (terminating CBM where the patent "does not meet the statutory definition…and is ineligible for CBM review"); *SK Hynix Inc. v. Netlist, Inc.*, IPR2017-00561, Pap.36, 8-9 (July 5, 2018) (terminating IPR as to a claim that had already been invalidated in a parallel proceeding).

C. Waiting For The District Court's Decision Will Not Harm The Office Or The PO

PO contends that it will be burdened by "duplicative simultaneous litigation" including "expert responses and depositions" if this IPR is not terminated. In the

District Court, expert reports have already been exchanged and the expert on the invalidity defense has been deposed. Thus, PO bears little added burden moving forward in the District Court. PO's next brief in this proceeding is not due until September 13th. Thus, PO bears little burden if the Board chooses to wait for the District Court's August 20 hearing on the parallel motions. Similarly, the Board will suffer no harm awaiting the District Court's decision, given that oral argument in these proceedings will not occur until November 6.

D. PO Delayed In Seeking To Terminate

PO contends that it was blindsided by Dr. Cooper's reliance on the Linnarsson/McCloskey reference in his expert report in the District Court. According to, PO, Parse's actions constitute a "secret repudiation" because its contentions "including the same section incorporating its IPR arguments" were merely a "copy-paste" despite the fact that Parse made "revisions to other sections." Pap.23, 10. PO's assertion is false. As documented above, Parse's April 16, 2024 invalidity contentions expressly referred to the IPR proceedings and disclosed Parse's intention to rely upon the same arguments. EX2035 at 17. This was not hidden in Parse's contentions, but was rather highlighted in a specific section of the contentions entitled "Inter Partes Review." *Id.* Plaintiffs were thus on notice both before and after the institution decisions that Parse intended to preserve the ability to rely upon the Linnarsson/McCloskey argument raised in the IPR. PO, however,

said nothing about this until after Parse had served its expert report in the District Court case. Based on PO's months of silence in the face of Parse's unambiguous disclosures, one can only conclude that its calculated strategy was to delay raising the issue until after Parse had served its expert report and was no longer able to modify or augment the defenses it planned to raise before the jury. Had PO been diligent about requesting a stipulation regarding the Linnarsson/McCloskey defense, Parse may have approached its expert reports differently. PO's strategy is further demonstrated by its refusal to agree to a modest extension of the trial that would moot this issue entirely.

PO was not diligent, and it should not be permitted to prejudice Parse even further by belatedly seeking to have this proceeding terminated, resulting in Parse dropping the Linnarsson/McCloskey defense in the District Court and possibly proceeding to a trial without one of its best defenses. Just the opposite, Plaintiffs should be deemed to have waived the relief they now request. Even if the Board deems that Parse should not be allowed to proceed in two venues, the Board should wait until after the District Court's decision on the parallel motions.

IV. CONCLUSION

PO's motion to terminate should be denied, or the Board should await the District Court's decision on the parallel motions before issuing a decision.

Dated: July 30, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO TERMINATE PROCEEDINGS are being served on July 30, 2024, via electronic mail pursuant to 37 C.F.R. § 42.6(e) to the counsel for Patent Owner at the addresses below:

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