UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner

v.

10X GENOMICS, INC.,
Patent Owner

Case IPR2023-00955
Patent 10,240,197

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO TERMINATE PROCEEDINGS

LIST OF EXHIBITS

Exhibit	Description
EX2001	File History of U.S. App. No. 15/677,957
EX2002	File History of U.S. App. No. 13/859,450
EX2003	Dictionary of Microbiology and Molecular Biology (2d ed. 1987)
EX2004	File History of U.S. App. No. 14/792,094
EX2005	File History of U.S. App. No. 13/387,343
EX2006	U.S. Patent Pub. No. 2007/0238113
EX2007	Laird *et al*., *Hairpin-bisulfite PCR: assessing epigenetic methylation patterns on complementary strands of individual DNA molecules*, 101 PNAS 204-09 (Dec. 12, 2003)
EX2008	Parse Biosciences, Inc. v. 10x, Genomics Inc., IPR2023-00876, Pap.1 (May 25, 2023)
EX2009	File History of U.S. App. No. 14/172,694
EX2010	Declaration of Sayem Osman
EX2011	Declaration of Sayem Osman
EX2012	*Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00876, EX1002 (Apr. 20, 2023) (Declaration of Gregory Cooper, Ph.D.)
EX2013	Declaration of Dr. John Quackenbush
EX2014	Bruce Alberts, et al., *Molecular Biology of the Cell*, Garland Science (4th ed. 2002)
EX2015	S. Guan, A. Blanchard, P. Zhang, & Z. Zhu, *Alteration of Sequence Specificity of the Type IIS Restriction Endonuclease BtsI*, (July 26, 2010)
EX2016	Piovesan *et al., On the length, weight, and GT content of the human genome,* BMC Res. Notes 12:106 (2019) (https://www.ncbi.nlm.nih.gov/pmc/articles/PMC6391780/#:~:text=Considering%20a%20mean%20weight%20in,units%2Fcarat.htm)
EX2017	T. Chauhan, *T4 DNA Ligase: Introduction, Functions, Applications, and Protocol*, (available at https://geneticeducation.co.in/t4-dna-ligase/)
EX2018	IPR2023-00876 Deposition Transcript of Gregory Cooper, Ph.D.
EX2019	Li *et al.*, *Amplification and analysis of DNA sequences in single human sperm and diploid cells,* Nature 335(6189):414-417 (1998)

Exhibit	Description
EX2020	IPR2023-00955 Deposition Transcript of Gregory Cooper, Ph.D.
EX2021	INTENTIONALLY OMITTED
EX2022	INTENTIONALLY OMITTED
EX2023	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 001 (D. Del. Aug. 24, 2022) (Complaint)
EX2024	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00878, Pap.1 (Apr. 20, 2023)
EX2025	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00958, Pap.1 (May 25, 2023)
EX2026	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-01030, Pap.1 (June 06, 2023)
EX2027	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-01033, Pap.1 (June 06, 2023)
EX2028	INTENTIONALLY OMITTED
EX2029	INTENTIONALLY OMITTED
EX2030	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 121 (D. Del. Dec. 21, 2023) (Order Denying Motion to Stay)
EX2031	Excerpt of *Parse Biosciences, Inc. v. 10x Genomics, Inc.* IPR2023-00958, Pap.8 (Jan. 05, 2024) (Rehearing Request)
EX2032	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 048 (D. Del. Mar. 07, 2023) (Scheduling Order)
EX2033	INTENTIONALLY OMITTED
EX2034	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 164 (D. Del. Feb. 20, 2024) (Order Denying Parse Renewed Motion to Stay)
EX2035	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 229 (D. Del. June 12, 2024) (Parse's Opposition to 10x Ltr. re Motion to Strike Portions of Cooper Report; Ex. A: Sept. 19, 2023 Parse First Amended Invalidity Contention; Ex. B: Apr. 16, 2024 Parse Second Amended Invalidity Contention)
EX2036	Excerpt of *10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 218 (D. Del. May 30) (10x Ltr. re Motion to Strike Portions of Cooper Report; Ex. A: May 17, 2024 Expert Report of Dr. Gregory Cooper Regarding Invalidity (Excerpted))

Exhibit	Description
EX2037	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, May 21, 2024 Email from J. Reich to D. Walter re Cooper Report
EX2038	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, May 28, 2024 Email from D. Walter to J. Reich re Cooper Report
EX2039	*10x Genomics, Inc. et al. v. Parse Biosciences, Inc.*, No. 22-1117-JHS, D.I. 224 (D. Del. June 06, 2024) (Parse Ltr. Requesting New Trial Date)

Through imploring Board calls (*e.g.,* Pap.21 ("Tr."), 12-13 (lamenting "uncertainty [about] Board's position")) and now its Opposition ("Opp."), *Parse claims its only wish is that the PTAB decide '197's validity*. But Parse could have that *right now*—without further burdening the Board, Court, and PO with policing Parse's ongoing violation of its stipulation. If Parse started keeping its promise today, it would (in Parse's words (Opp.1)) have a PTAB validity decision and court infringement decision within "*just a few months*" of each other—and, if unhappy, it could appeal either. *This* is what Parse promised to avoid discretionary denial. And *this* is what would "address[] the concerns of all parties and [be] more efficient" than more litigation (here and in Court) of Parse's *sub rosa* breach—with what Parse would only *later* float as its secret excuse that Parse disliked its "unanticipated," but foreseeable, situation. *E.g.*, Opp.2-3 (Parse "selected" "timing"), 5; Pap.23 ("Mot.") 1, 5-8.

But the Opposition confirms that what Parse *really seeks* is a litigation windfall to reward its misconduct—leveraging its broken promise to the Board and 10x *to delay its infringement trial*.[1] Many infringers seek delay, but this doesn't justify releasing Parse from its explicit promise to secure institution (avoiding wasteful,

[1] Parse's complaints about trial without "its strongest defenses" (Opp.7) are baseless: even if it received a favorable Board decision before trial (which includes other patents), §325(e) would estop *Parse* (*not 10x*) on those defenses at trial.

duplicative litigation in two forums at once, as 10x is now enduring).[2] Parse has continued full-tilt court and PTAB litigation of identical issues in hopes that—with the Board's help—it can parlay this misconduct into *an extension the court has twice denied*. EX2030; EX2034. Rather than appreciation for an advisory opinion on this dispute that 10x raised in a *June 12* Board email (*see* Pap.22, 2 (Parse may "obviate termination")), Parse offers *more requests for delay until at least late August* (Opp.5 ("panel should wait" for decision after August 20 hearing))—meaning *more* wasteful duplication and wasted resources as 10x prepares for, *e.g.*, *more* duplicative depositions and a sur-reply here due September 13.

Parse never denies it intentionally repudiated its freely-offered stipulation, nor explains why it "should have the opportunity to be able to present [these identical defenses] twice." Mot.1, 7 n.3; Tr.12:8-13:11. Parse also doesn't dispute the Board's power to terminate these proceedings, or the harm to the Office if petitioners like Parse unilaterally disavow their *Fintiv* stipulations. *See Mylan Pharms. Inc. v. Novo Nordisk A/S*, IPR2023-00724, Pap.69, 5 (July 26, 2025). Instead, Parse *tries to blame 10x*—suggesting 10x's *May 21* objection to Parse's *May 17* expert report

[2] As the Board observed during the June 18 call, 10x didn't argue *Fintiv because of Parse's stipulation*—the bargain Parse struck with the Board and 10x. *Cf.* Opp.7-8.

came too late and somehow excuses Parse's violation, since Parse's April 16 contentions one month earlier (the only ones after institution here) copy-pasted its earlier invalidity language. Nonsense. *Parse's promise to the Board wasn't conditioned on Parse being caught*, and 10x catching Parse's wrongdoing within a month was certainly no waiver—it was timely.

Finally, Parse hasn't sought leave or moved here for relief from its stipulation (it seeks that, instead, in district court). And in any event, Parse cites no case releasing an IPR petitioner from a *Fintiv* stipulation—instead offering inapt citations to disputes about liability or pre-discovery fact stipulations. *E.g.*, *Waldorf v. Shuta*, 142 F.3d 601, 616-19 (3d Cir. 1998) (*denying* relief from liability stipulation based on "'exceptional circumstances'… to prevent a manifest injustice"; "*a party may not be freed of the burdens of a stipulation while maintaining its benefits*"); *XY, LLC v. Trans Ova Genetics, LC*, No. 17-cv-00944-WJM-NYW, 2018 WL 7512225, at *2–3 (D. Colo. Dec. 5, 2018) (allowing partial withdrawal of infringement stipulation after accused product altered); *Glasco v. Aerotek Pro. Serv., Inc.*, No. CIV-11-874-F, 2012 WL 12848184, at *1 (W.D. Okla. Aug. 6, 2012) (relieving from pre-discovery fact stipulation on "linchpin issue of material fact").

As the Board observed, the very "purpose of [this] motion… [is] to force [Parse] to make [its] decision." Tr., 15:2-4. Respectfully, that time has come.

Respectfully submitted: /*Megan Raymond*/ August 6, 2024

CERTIFICATE OF PAGE COUNT

The undersigned certifies that the foregoing PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO TERMINATE PROCEEDINGS complies with the 3-page limitation in Paper 22.

Dated: August 6, 2024

Respectfully Submitted,

By: /*Megan Raymond*/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO TERMINATE PROCEEDINGS has been served in its entirety by causing the aforementioned document to be electronically mailed to the following attorneys of record for the Petitioner listed below:

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