

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 NOTICE OF FILING STIPULATION REGARDING
DEFENSES IN CO-PENDING DISTRICT COURT LITIGATION**

PETITIONER’S UPDATED LIST OF EXHIBITS

Exhibit #	Description
EX1001	U.S. Patent No. 10,240,197 (“the ’197 patent”)
EX1002	Declaration of Gregory Cooper, Ph.D.
EX1003	PCT Patent Publication No. WO 2010/117620 to Linnarsson et al. (“Linnarsson”)
EX1004	Megan L McCloskey et al., <i>Encoding PCR Products with Batch-Stamps and Barcodes</i> , 45 Biochemical Genetics, 761-767 (2007) (“McCloskey”)
EX1005	Prosecution File History of U.S. Patent No. 10,240,197
EX1006	Leslie H. Brail et al., <i>Gene expression in individual cells: analysis using global single cell reverse transcription polymerase chain reaction (GSC RT-PCR)</i> , 406 Mutation Research Genomics, 45-54 (1999) (“Brail”)
EX1007	Hubert Hug et al., <i>Measurement of Number of Molecules of a Single mRNA Species in a Complex mRNA Preparation</i> , 221 J. Theor. Bio., 615-624 (2003) (“Hug”)
EX1008	Intentionally left blank.
EX1009	Gerald Schochetman et al., <i>Polymerase Chain Reaction</i> , 158 J. of Infectious Diseases 1154-1157 (1988) (“Schochetman”)
EX1010	Intentionally left blank.
EX1011	H.C. Yang et al., <i>A genome-wide study of preferential amplification/hybridization in microarray-based pooled DNA experiments</i> , 34 Nucleic Acids Research 1-11 (2006) (“Yang”)
EX1012	Severine A Degrelle et al., <i>Amplification biases: possible difference among deviating gene expressions</i> , 9 BMC Genomics 1-15 (2008) (“Degrelle”)

Exhibit #	Description
EX1013	Brooks E. Miner et al., <i>Molecular barcodes detect redundancy and contamination in hairpin-bisulfite PCR</i> , 32 Nucleic Acids Research 1-4 (2004) (“Miner”)
EX1014	Intentionally left blank.
EX1015	U.S. Patent Provisional Application No. 61/164,759 (filed March 30, 2009) (Sven Linnarsson, applicant) (“Linnarsson Provisional”)
EX1016	Defendant 10X Genomic’s Opening Brief In Support Of Its Motion To Dismiss, <i>Becton, Dickinson and Company and Cellular Research, Inc. v. 10X Genomics, Inc.</i> , C.A. No. 18-1800-RGA (Mar. 1, 2019 D. Del (No. 19)
EX1017	Defendant 10X Genomic’s Reply Brief In Support Of Its Motion To Dismiss, <i>Becton, Dickinson and Company and Cellular Research, Inc. v. 10X Genomics, Inc.</i> , C.A. No. 18-1800-RGA (Apr. 12, 2019 D. Del.) (No. 22)
EX1018	Scheduling Order, <i>10X Genomics, Inc. and The Board of Trustees of the Leland Stanford Junior University v. Parse Biosciences, Inc.</i> , C.A. No. 22-1117-JHS (Mar. 2, 2023 D. Del (No. 48)
EX1019	Federal Judicial Caseload Statistics (2022), at https://www.uscourts.gov/statistics-reports/analysis-reports/federal-judicial-caseload-statistics
EX1020	Curriculum Vitae of Gregory Cooper
EX1021	Jonas Binladen et al., <i>The Use of Coded PCR Primers Enables High Throughput Sequencing of Multiple Homolog Amplification Products by 454 Parallel Sequencing</i> , 2(2): e197 PLoS ONE 1-9 (2007) (Binladen)
EX1022	Intentionally left blank.
EX1023	Motion Success for Stay Pending IPR In Delaware District
EX1024	Hiroto Okayama and Paul Berg, <i>High-Efficiency Cloning of Full-Length cDNA</i> , 2 Molecular and Cellular Biology 161-170 (1982) (“Okayama”)

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EX1025	Bruce Alberts, et al., “Chapter 6 How Cells read the Genome: From DNA To Protein,” <i>Molecular Biology of the Cell</i> , Garland Science 299-335 (4th ed. 2002)
EX1026	Assignment Record for U.S. Patent 8,298,767
EX1027	10x Genomics Legal Notice
EX1028	Declaration of Sylvia D. Hall-Ellis, Ph.D.
EX1029	US Patent No. 8,835,358 B2
EX1030	S. Clancy et al., <i>Translation: DNA to mRNA to Protein</i> , Nature Education (2008), at https://www.nature.com/scitable/topicpage/translation-dna-to-mrna-to-protein-393/
EX1031	Cole Trapnell, <i>Defining cell types and states with single-cell genomics</i> , 25(10) Genome Research 1491-1498 (2015) (“Trapnell”)
EX1032	Gerard Brady et al., <i>Representative in Vitro cDNA Amplification From Individual Hemopoietic Cells and Colonies</i> , 2 Methods in Molecular and Cellular Biology 17-25 (1990) (“Brady”)
EX1033	James Eberwine et al., <i>Analysis of gene expression in single live neurons</i> , 89 Proc. Natl. Acad. Sci. 3010-3014 (1992) (“Eberwine”)
EX1034	Maria de Fatima Bonaldo et al., <i>Normalization and Subtraction: Two Approaches to Facilitate Gene Discovery</i> , 6(9) Genome Research 791-806 (1996) (“Bonaldo”)
EX1035	Sydney Brenner et al., <i>In vitro cloning of complex mixtures of DNA on microbeads: Physical separation of differentially expressed cDNAs</i> , 97.4 Proceedings of the Nat’l Academy of Sci. 1665-1670 (2000) (“Brenner”)
EX1036	David H. Persing, <i>Polymerase Chain Reaction: Trenches to Benches</i> , J. of Clinical Microbiology 1281-1285 (1991) (“Persing”)
EX1037	Kazuki Kurimoto et al., <i>An improved single-cell cDNA amplification method for efficient high-density oligonucleotide microarray analysis</i> , 34(5) Nucleic Acids Research 1-17 (2006) (“Kurimoto”)

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EX1038	Shigeyuki Esumi et al., <i>Method for single-cell microarray analysis and application to gene-expression profiling of GABAergic neuron progenitors</i> , 60 Neuroscience Research 439-451 (2008) (“Esumi”)
EX1039	Y. Shibata et al., <i>Cloning Full-length, Cap-Trapper-Selected cDNAs by Using the Single-Strand Linker Ligation Method</i> , 30(6) Biotechniques 1250-1254 (2001) (“Shibata”)
EX1040	U.S. Patent Application 2004/0166499
EX1041	Athina Gkazi, <i>An Overview of Next-Generation Sequencing</i> , Technology Networks Genomics Research at Figure 2 (March 17, 2021) at https://www.technologynetworks.com/genomics/articles/an-overview-of-next-generation-sequencing-346532
EX1042	Rami Sukarieh, <i>Relocalization of eIF4E by its binding partners upon stress</i> , Figure 2 (August 2009) at https://www.researchgate.net/publication/41663010_Relocalization_of_eIF4E_by_its_binding_partners_upon_stress
EX1043	Clyde A. Hutchinson, <i>DNA sequencing: bench to bedside and beyond</i> , 35(18) Nucleic Acids Research 6227-6237 (2007) (“Hutchinson”)
EX1044	Beáta G Vértessy and Judit Tóth, <i>Keeping Uracil Out of DNA: Physiological Role, Structure and Catalytic Mechanism of dUTPases</i> , Acc Chem Res. 1-20 (2009) (“Vértessy”)
EX1045	Elaine R. Mardis, <i>Next-Generation DNA Sequencing Methods</i> , 9 Annual Review Genomics and Human Genetics 387-402 (2008) (“Mardis”)
EX1046	Jay Shendure and Hanlee Ji, <i>Next-Generation DNA Sequencing</i> , 26(10) Nature Biotechnology 1135-1145 (2008) (“Shendure”)
EX1047	Elaine R. Mardis, <i>The impact of next-generation sequencing technology on genetics</i> , 24(3) Trends in Genetics 133-141 (2008) (“Mardis 2”)
EX1048	Robert A. Holt and Steven J.M. Jones, <i>The new paradigm of flow cell sequencing</i> , 18(6) Genome Research 839-846 (2008) (“Holt”)
EX1049	National Human Genome Research Institute, <i>Nucleotide</i> (March 21, 2023) at https://www.genome.gov/genetics-glossary/Nucleotide

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EX1050	National Human Genome Research Institute, <i>Polymerase Chain Reaction</i> (March 21, 2023) at https://www.genome.gov/genetics-glossary/Polymerase-Chain-Reaction
EX1051	Plaintiffs, Becton, Dickinson and Company and Cellular Research, Inc.’s First Amended Complaint, <i>Becton, Dickinson and Company and Cellular Research, Inc. v. 10X Genomics, Inc.</i> , C.A. No. 18-1800-RGA (Feb 08, 2019 D. Del.) (No. 15)
EX1052	Exhibits 26 and 27 attached with Plaintiffs’ First Amended Complaint, <i>Becton, Dickinson and Company and Cellular Research, Inc. v. 10X Genomics, Inc.</i> , C.A. No. 18-1800-RGA (Feb 08, 2019 D. Del.) (No. 15-3)
EX1053	US 9,708,659 B2
EX1054	Georgi K. Marinov et. al, <i>From single-cell to cell-pool transcriptomes: Stochasticity in gene expression and RNA splicing</i> , 24.3 Genome Research 496-510 (2014) (“Marinov”)
EX1055	United States Patent Application Publication to McCloskey et al. (“McCloskey II”)
EX1056	Boris Hollas and Rainer Schuler, <i>A Stochastic Approach to Count RNA Molecules Using DNA Sequencing Methods</i> , 2812 Algorithms in Bioinformatics 55-62 (2003) (“Hollas”)
EX1057	Thomas J Albert et al., <i>Direct Selection of Human Genomic Loci by Microarray Hybridization</i> , 4 Nature Methods 903-905 (2007) (“Albert”)
EX1058	US 7,537,897 B2
EX1059	Intentionally left blank.
EX1060	Reinhard Stöger, <i>Epigenetics and Obesity</i> , 9(12) Pharmacogenomics 1851-1860 (2008) at https://www.ncbi.nlm.nih.gov/pmc/articles/PMC2652025/ (“Stöger”)
EX1061	Diane P. Genereux et. al, <i>Errors in the Bisulfite Conversion of DNA: Modulating Inappropriate- and Failed-Conversion Frequencies</i> , 36 Nucleic Acids Research 1-19 (2008) (“Genereux”)

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EX1062	Pierre Nicolas et. al., <i>The Stem Cell Population of the Human Colon Crypt: Analysis via Methylation Patterns</i> , 3 Plos Computational Biology 0364-0374 (2007) (“Nicolas”)
EX1063	Transcript of the deposition of Gregory Cooper, Ph.D., taken on December 20, 2023, in <i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> , Case IPR2023-00876
EX1064	Declaration of Edward R. Reines in support of pro hac vice motion
EX1065	<i>In re Reines</i> Federal Circuit decision, 14-MA0004
EX1066	Personal Statement of Edward R. Reines, Fed. Cir. 14-MA004
EX1067	Opinion, <i>10X Genomics, Inc. and The Board of Trustees of the Leland Stanford Junior University v. Parse Biosciences, Inc.</i> , C.A. No. 22-1117-JHS (May 2, 2024 D. Del (No. 209)
EX1068	Intentionally left blank.
EX1069	Transcript of the deposition of John Quackenbush, Ph.D., taken on June 26, 2024, in <i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> , Case IPR2023-00958
EX1070	Declaration of Gregory Cooper, Ph.D.
EX1071	Transcript of the deposition of John Quackenbush, Ph.D., taken on February 28, 2024, in <i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> , Case IPR2023-00876
EX1072	Joint Claim Construction Brief, <i>10X Genomics, Inc. and The Board of Trustees of the Leland Stanford Junior University v. Parse Biosciences, Inc.</i> , C.A. No. 22-1117-JHS (December 7, 2023 D. Del) (No. 104)
EX1073	NEBcutter, https://nc3.neb.com/NEBcutter/prj/pz62Y3ZH7vX-03Y95_Unnamed
EX1074	Mary Ann Moran et. al, <i>Sizing up metatranscriptomics</i> , The ISME Journal (2013) 7, 237-243

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EX1075	Philip Ball, <i>Smallest genome clocks in at 182 genes</i> , Nature (October 12, 2006) doi:10.1038/news061009-10
EX1076	Jose E. Perez-Ortin et. al, <i>A genomic view of mRNA turnover in yeast</i> , Academie des Sciences (2011) doi:10.1016/j.crv.2011.05.013
EX1077	Intentionally left blank.
EX1078	Intentionally left blank.
EX1079	Excerpts from Opening Expert Report of John Quackenbush, Ph.D., <i>10X Genomics, Inc. and The Board of Trustees of the Leland Stanford Junior University v. Parse Biosciences, Inc.</i> , C.A. No. 22-1117-JHS (May 17, 2024 D. Del)
EX1080	BtsCI, NEB, https://www.neb.com/en-us/products/r0647-btscli
EX1081	Transcript of the deposition of Gregory Cooper, Ph.D., taken on May 2, 2024, in <i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> , Case IPR2023-00876
EX1082	Nilima Sarkar, <i>Polyadenylation of mRNA in Prokaryotes</i> , Annu. Rev. Biochem. (1997), 66:173-97
EX1083	Shimyn Slomovic et. al, <i>RNA Polyadenylation in Prokaryotes and Organelles; Different Tails Tell Different Tales</i> , Critical Reviews in Plant Sciences (2006), 25:65-77 doi:10.1080/07352680500391337
EX1084	Excerpts from Redacted Rebuttal Expert Report of John Quackenbush, Ph.D., <i>10X Genomics, Inc. and The Board of Trustees of the Leland Stanford Junior University v. Parse Biosciences, Inc.</i> , C.A. No. 22-1117-JHS (June 14, 2024 D. Del)
EX1085	Declaration of Sylvia D. Hall-Ellis, Ph.D., dated April 17, 2023 and filed as Exhibit 1065 on March 29, 2024, in <i>Parse Biosciences, Inc. v. 10x Genomics, Inc.</i> , Case IPR2023-00876
EX1086	U.S. Patent No. 7,544,473
EX1087	U.S. Patent No. 7,393,665

Exhibit #	Description
EX1088	Stipulation and [Proposed] Order regarding Invalidity Defenses, <i>10x Genomics, Inc. v. Parse Biosciences, Inc.</i> , C.A. 1:22-cv-01117-JHS, D.I. 248 (D. Del. Aug. 22, 2024)
EX1089	Electronic notification confirming receipt of filing of Stipulation and [Proposed] Order regarding Invalidity Defenses, D.I. 248, dated August 22, 2024

Pursuant to the Board's August 21, 2024 order, Petitioner Parse Biosciences, Inc. hereby submits as EX1088 the attached stipulation agreeing not to pursue in district court the defenses based on the instituted grounds in IPR Nos. 2023-00876, 2023-00955, and 2023-00958. This stipulation was filed in the district court on August 22, 2024, and the electronic notification confirming filing is attached here to as EX1089.

Dated: August 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PETITIONER’S
NOTICE OF FILING STIPULATION REGARDING DEFENSES IN CO-
PENDING DISTRICT COURT LITIGATION** are being served on August 22,
2024, via electronic mail pursuant to 37 C.F.R. § 42.6(e) to the counsel for Patent
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