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Paper 18
Date: February 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARSE BIOSCIENCES, INC.,
Petitioner,

v.

10X GENOMICS, INC.,
Patent Owner.

IPR2023-00958
Patent 10,697,013 B1

Before MICHAEL J. FITZPATRICK, SHERIDAN K. SNEDDEN, and DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request on Rehearing of
Decision Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Parse Biosciences, Inc., filed a Petition to institute an *inter partes* review of all claims, namely claims 1–28, of U.S. Patent No. 10,697,013 B1 ("the '013 patent") pursuant to 35 U.S.C. § 311(a). Paper 1 ("Pet."). Patent Owner, 10X Genomics, Inc., filed a Preliminary Response pursuant to 37 C.F.R. § 42.107(b). Paper 6 ("Prelim. Resp."). On December 13, 2023, we entered a decision ("First Decision") denying the Petition. Paper 7 ("First Dec."). On January 5, 2024, Petitioner filed a Request for Rehearing of the First Decision. Paper 8. On February 5, 2024, we entered another decision ("Second Decision"), which granted the Request and instituted an *inter partes* review. Paper 9 ("Second Dec."). On February 15, 2024, Patent Owner filed a Request for Rehearing of the Second Decision. Paper 11 ("Reh'g Req.")

For the reasons explained below, we deny Patent Owner's Request for Rehearing.

II. BACKGROUND

We have twice discussed the '013 patent, challenged claims, and asserted prior art and decline to do so here. *See* First Dec. 3–11; Second Dec. 3–9. However, we reproduce claim 1 of the '013 patent, which recites:

> 1. A method for multiplexed analysis of nucleic acids from single cells, the method comprising:
>
> (a) providing a sample comprising a plurality of cells, wherein a single cell of the plurality of cells comprises a plurality of sample polynucleotides;
>
> (b) performing combinatorial tagging to generate a plurality of tagged polynucleotides from said plurality of sample polynucleotides and a plurality of oligonucleotide tags,

wherein a tagged polynucleotide of the plurality of tagged polynucleotides is generated by:

(A) providing an extension product by primer extension using a first oligonucleotide tag and a sample polynucleotide of said plurality of sample polynucleotides, and

(B) ligating a second oligonucleotide tag to said extension product, and

wherein said tagged polynucleotide of the plurality of tagged polynucleotides comprises:

(i) a sample sequence corresponding to said sample polynucleotide of the plurality of sample polynucleotides;

(ii) a first tag sequence distinguishing said sample polynucleotide from sample polynucleotides from other cells; and

(iii) a second tag sequence distinguishing said sample polynucleotide from other sample polynucleotides from said cell;

(c) amplifying said tagged polynucleotide, thereby generating a plurality of amplified polynucleotides corresponding to the tagged polynucleotide; and

(d) sequencing said plurality of amplified polynucleotides to determine sequences of the amplified polynucleotides corresponding to the sample sequence, the first tag sequence, and the second tag sequence of the tagged polynucleotide; and

(e) using the sequences determined in step (d) to count sample polynucleotides for multiple different sample polynucleotides of multiple different single cells of said plurality of cells.

Ex. 1001, 30:38–31:10.

III. REHEARING STANDARD

"A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board." 37 C.F.R. § 42.71(d). The burden of showing a decision should be modified lies with the party making the request and said party "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply." *Id.*

IV. ANALYSIS

Patent Owner argues that "the Board overlooked several of [its] arguments . . . explaining why Petitioner's obviousness argument failed to show that (or how) a second tag could be ligated to the TSO or CDS of Petitioner's base reference, Linnarsson, while also practicing the rest of claim 1." Reh'g Req. 1. More specifically, Patent Owner argues that we overlooked its arguments that Petitioner's proposal of ligating a second tag to Linnarsson's CDS or TSO (1) would prevent the resulting structure from being amplified, (2) would not endure because the added tag would be cleaved off, (3) could not occur consistent with Hug, and (4) does not take into account the biotin group at the 5' end of the CDS. *Id.* at 3–7.

Although we did not discuss each of these points, they were not overlooked. These points were presented by Patent Owner as part of a broader argument set forth in Section VII.C.2. of the Preliminary Response (*see* Prelim. Resp. 51–57), which the Second Decision does address. Second Dec. 17–18.

In any event, these additional points all have something in common. They all rely on attorney argument about what would or could happen in the proposed modification. Patent Owner may be correct in some or all of these respects, but Patent Owner does not offer, for example, expert testimony to support its arguments about what would or could happen in the proposed modification. In short, Patent Owner's arguments about what would or could happen in the proposed modification are insufficient to rebut that Petitioner has met the reasonable likelihood of prevailing threshold for institution. 35 U.S.C. § 314(a); *see also In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1581 (Fed. Cir. 1989) ("Attorneys' argument is no substitute for evidence.").

V. CONCLUSION

We are not persuaded that the Second Decision should be modified.

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Request for Rehearing is denied.

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