

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. IPR2023-00958
U.S. Patent No. 10,697,013

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

LIST OF EXHIBITS

Exhibit #	Description
EX1001	U.S. Patent No. 10,697,013 (“the ’013 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. 10,697,013
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”)

Exhibit #	Description
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”)

Exhibit #	Description
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

Exhibit #	Description
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: Stochastically 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	Intentionally left blank.
EX1058	Intentionally left blank.
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 (2008) (“Genereux”)

Exhibit #	Description
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	"Using Multiplex Identifier (MID) Adaptors for the GS FLX Titanium Chemistry Basic MID Set" Genome Sequencer FLX System, Technical Bulletin 004-2009, (Apr. 1, 2009) pp. 1-7. http://454.com/downloads/my454/documentation/technical-bulletins/TCB-09004 Using MultiplexIdentifierAdaptorsForTheGSFLXTitaniumSeriesChemistry-BasicMIDSet.pdf .
EX1064	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
EX1065	Declaration of Edward R. Reines in support of pro hac vice motion
EX1066	<i>In re Reines</i> Federal Circuit decision, 14-MA0004
EX1067	Personal Statement of Edward R. Reines, Fed. Cir. 14-MA004
EX1068	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)

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	viii
I. INTRODUCTION	1
II. FACTUAL BACKGROUND.....	3
III. ARGUMENT.....	5
A. Parallel District Court Motions May Well Moot This Motion	5
B. The Petition Should Not Be Terminated Because Of Unforeseeable Delay In Institution	5
C. Waiting For The District Court’s Decision Will Not Harm The Office Or The PO	8
D. PO Delayed In Seeking To Terminate	9
IV. Conclusion	10

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple, Inc. v. Universal Secure Registry</i> , CBM2018-00025, Pap.42 (Nov. 26, 2019).....	8
<i>Glasco v. Aerotek Prof'l Serv., Inc.</i> , No. 11-874, 2012 WL 12848184 (W.D. Okla. Aug. 6, 2012).....	6
<i>Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.</i> , IPR2014-00607, Pap.65 (May 22, 2015).....	8
<i>SK Hynix Inc. v. Netlist, Inc.</i> , IPR2017-00561, Pap.36 (July 5, 2018).....	8
<i>Waldorf v. Shuta</i> , 142 F.3d 601 (3d Cir. 1998).....	6
<i>XY LLC Beckman v. Trans Ova Genetics</i> , No. 17-00944, 2018 WL 7512225 (D. Colo. Dec. 5, 2018)	7

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.25, 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.25, 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.25, 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.

IPR2023-00958
U.S. Patent 10,697,013

Dated: July 30, 2024

Respectfully submitted,

/Derek C. Walter/

Lead Counsel for Petitioner

Reg. No. 74,656

Weil, Gotshal & Manges LLP

201 Redwood Shores Parkway

Redwood Shores, CA 94065.

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:

J. Steven Baughman (Reg. No. 47,414)
Megan Raymond (Reg. No. 72,997)
GROOMBRIDGE, WU, BAUGHMAN
& STONE LLP
801 17th Street, NW, Suite 1050
Washington, DC 20006
P: (202) 505-5832
steve.baughman@groombridgewu.com
megan.raymond@groombridgewu.com
10X-Parse-IPR@groombridgewu.com

Counsel for Patent Owner

Dated: July 30, 2024

By: /Derek C. Walter/
Derek C. Walter
Lead Counsel for Petitioner
Reg. No. 74,656