

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner,

v.

NANOSTRING TECHNOLOGIES, INC.,
Patent Owner.

IPR2023-01298
U.S. Patent No. 11,377,689

Before KRISTI L. R. SAWERT, DEVON ZASTROWNEWMAN, and
JAMIE T. WISZ, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Authoring Additional Briefing
35 U.S.C. § 314, 37 C.F.R. § 42.4

On December 7, 2023, Petitioner requested authorization to file a reply to Patent Owner's Preliminary Response. *See* Ex. 3001 (Petitioner's email). Patent Owner opposed Petitioner's request. *See id.*

On December 8, 2023, Judges Sawert, Newman, and Wisz participated in a conference call with counsel for the parties, including Mr. David Holman for Petitioner and Mr. Derek Walter for Patent Owner. Petitioner engaged a court reporter, and the transcript of that call will be filed by Petitioner.

During the call, Petitioner and Patent Owner each presented arguments regarding whether Petitioner should be authorized to file a reply. Petitioner provided three bases for its request to file a reply in support of its challenge to Ground 4 of the Petition. One basis regarded Patent Owner's arguments that U.S. Patent Application No. 16/272,487 (Ex. 1009, the "'487 application'") provided sufficient written disclosure to support Patent Owner's priority claim and two bases related to Patent Owner's arguments regarding the law applied to discerning the knowledge of the skilled artisan. Petitioner asserted that it had good cause to file a reply because Patent Owner's arguments on these issues could not have been foreseen, including because the paragraphs cited by Patent Owner as supportive written description did not relate to the claimed subject matter. Patent Owner's counsel responded, arguing no reply was necessary, that the issues were foreseeable and the law is within the Board's existing knowledge. Patent Owner requested equal responsive briefing if Petitioner's request was granted.

Upon consideration of the parties' respective positions, the panel has determined that additional briefing on the first issue alone is warranted.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file, on or before December 15, 2023, a Reply, which shall not exceed 3 pages, and is limited to the issue of whether the cited disclosure in the '487 application provides sufficient written disclosure to support Patent Owner's priority claim;

FURTHER ORDERED that Patent Owner is authorized to file, on or before December 22, 2023, a Sur-reply, which shall not exceed 3 pages, and is limited to responding to Petitioner's Reply.

FURTHER ORDERED that neither party is authorized to file any additional evidence or exhibits in support of their brief;

FURTHER ORDERED that that a transcript of the conference call will be filed as an exhibit within 10 business days.

and FURTHER ORDERED that no additional briefing is authorized at this time.

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Patent 11,377,689

FOR PETITIONER:

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