

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC,
Petitioner,

v.

NANOSTRING TECHNOLOGIES, INC.
Patent Owner

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

PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

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Patent Owner files this pre-institution Sur-Reply as authorized by the Board. Paper 9 at 3. In the Petition, 10x Genomics, Inc. (“Petitioner”) argued that the ’689 patent was not entitled to claim priority to the ’487 application because the ’487 application “uniformly” discloses “collecting only portions of probes and *never* the whole probe.” Paper 2 at 53-54. Petitioner now concedes that the ’487 application does disclose collecting “whole probes”—a term not used in the ’689 patent claims—and argues instead that the “whole probes” are not collected “*as claimed.*” Paper 11 (“Reply”) at 1. Petitioner’s new argument is procedurally improper and factually misleading.

First, despite three pages in the Petition arguing that the ’487 application “*never*” discloses collecting “whole probes,” Petitioner failed to address any disclosure in the ’487 application regarding “intact probe” molecules. *See* Paper 2 at 53-55. Thus, Petitioner’s new arguments are procedurally improper and should be disregarded. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[T]he petitioner’s petition...is supposed to guide the life of the litigation.”); *see also* Consolidated Trial Practice Guide at 73 (Nov. 2019) (Petitioner “may not submit new evidence or argument in reply.”).

Second, Petitioner misstates the ’487 application’s disclosure of “intact probes.” Petitioner concedes that the ’487 application discloses “intact probes.”

Reply at 1. Petitioner, however, brings a new argument that the “intact probes” collected in the ’487 application are not used “in the subsequent steps, *as claimed*” by mischaracterizing the ’487 application’s disclosure. *Id.*

As Patent Owner previously explained, “intact probes” are disclosed in a section describing a variety of probes that may be used with the invention. *See* Paper 8 at 37-39; ’487 app. ¶¶ 251-259. For example, the ’487 application clearly explains: “Any probe or set of probes described herein may be used in methods and kits of the present disclosure.” *Id.* ¶ 259; *see also id.* ¶ 261 (“As described in the preceding, probes of the present disclosure can be used to detect a target nucleic acid or target protein present in any sample, e.g., a biological sample.”). Thus, since Petitioner does not dispute that the ’487 application discloses collecting portions of probes, the disclosure of “intact probes” sufficiently describes collecting “whole probes.”

Petitioner ignores the explicit disclosures regarding “intact probes.” Instead, Petitioner argues that the “intact probes” are somehow “undesirable contaminants.” Reply at 2-3. The ’487 application, however, never uses such language. The application only states that a “negative purification” “*can be*” performed. ’487 app. ¶¶ 251-252. This disclosure, however, is not limiting, as the specification provides that “*any probe or set of probes* described herein may be used” and “probes

of the present disclosure can be used to detect a target nucleic acid.” *Id.* ¶¶ 259, 261. Thus, a POSA would understand that the disclosed “intact probe” could be used for the “methods and kits of the present disclosure,” adequately describing the claimed probes of the ’689 patent to support its priority claim.

Third, Petitioner fails to meet its burden by never explaining why a POSA would not understand the ’487 application to describe collecting “whole probes” in practicing the claimed invention. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (“[W]hatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.”). As discussed above, the ’487 application describes “probes, or portions thereof,” as required by the ’689 patent claims. Even if, assuming *arguendo*, the ’487 application does not explicitly describe using the “probes” specifically as claimed in the ’689 patent, Petitioner never explains why a POSA would not, nonetheless, understand the ’487 application’s disclosure for collecting and using probes to apply to both partial and intact probes.

For at least the reasons above, Petitioner fails to show a reasonable likelihood that the ’487 application lacks adequate written description to support the ’689 patent’s priority claim.

Dated: December 22, 2023

Respectfully submitted,

/Derek C. Walter/

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PATENT OWNER'S PRE-INSTITUTION SUR-REPLY** was served on December 22, 2023, via email pursuant to 37 C.F.R. and § 42.107 to the Petitioner at the addresses below:

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