

From: [Trials](#)
To: [Trials](#); [Walter, Derek](#); [Pepe, Christopher](#)
Cc: [dholman-ptab@sternekessler.com](#); [pkhanduri-ptab@sternekessler.com](#); [rsterne-ptab@sternekessler.com](#); [glongs-ptab@sternekessler.com](#)
Subject: RE: IPR2023-01298 and -1300
Date: Wednesday, June 26, 2024 4:51:47 PM

Counsel,

The panel approves Patent Owner's request to file a motion to substitute Bruker Corporation/Bruker Spatial Biology, Inc. as Patent Owner in IPR2023-01298. The panel instructs counsel for patent owner to additionally file an updated mandatory notices pursuant to 37 C.F.R. § 42.8(a)(3). Granting of the motion to substitute will result in issue of a new caption to be used by the parties in this matter.

The panel approves the proposed modified schedule submitted in the June 10, 2024, email, and will issue an updated scheduling order following filing of the motion to substitute and updated mandatory notices. The Board will additionally issue an extension for good cause to permit this matter to proceed on the new schedule.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, June 25, 2024 11:23 AM
To: Walter, Derek <Derek.Walter@weil.com>; Trials <Trials@USPTO.GOV>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: [dholman-ptab@sternekessler.com](#); [pkhanduri-ptab@sternekessler.com](#); [rsterne-ptab@sternekessler.com](#); [glongs-ptab@sternekessler.com](#)
Subject: RE: IPR2023-01298 and -1300

Counsel,

From the Board –

Thank you for the update. We will respond soon with further information regarding reactivation of this matter. In the interim, no filings are necessary at this time.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist

Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Walter, Derek <Derek.Walter@weil.com>
Sent: Monday, June 10, 2024 9:18 PM
To: Trials <Trials@USPTO.GOV>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: dholman-ptab@sternekessler.com; pkhanduri-ptab@sternekessler.com; rsterne-ptab@sternekessler.com; glongs-ptab@sternekessler.com
Subject: RE: IPR2023-01298 and -1300

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Your Honors,

Pursuant to the Panel’s Order, IPR2023-01298, Paper 23, Patent Owner provides the following status report as to its bankruptcy proceedings.

On April 19, 2024, the United States Bankruptcy Court for the District of Delaware approved the sale transaction of substantially of all of Patent Owner’s assets to Bruker Corporation (“Bruker”). On May 5, 2024, Bruker assigned its rights and obligations under the Asset Purchase Agreement to Bruker Spatial Biology, Inc. On May 6, 2024, the acquisition closed. Patent Owner has conferred with Petitioner as to the schedule of IPR2023-01298, and proposes the below schedule without objection from Petitioner:

IPR2023-1298 Schedule	Existing	Proposed
Patent Owner’s response to the petition	4/24/2024	8/24/2024
Patent Owner’s motion to amend the patent		
Petitioner’s reply to Patent Owner’s response to petition	7/17/2024	11/15/2024
Petitioner’s opposition to motion to amend		
Patent Owner’s sur-reply to reply		
Patent Owner’s reply to opposition to motion to amend (or Patent Owner’s revised motion to amend)	8/28/2024	1/3/2025
Request for oral argument (may not be extended by stipulation)	9/18/2024	1/24/2025
Petitioner’s sur-reply to reply to opposition to motion to amend	10/9/2024	2/14/2025
Motion to exclude evidence		
Opposition to motion to exclude	10/16/2024	2/21/2025
Request for prehearing conference		
Reply to opposition to motion to exclude	10/23/2024	2/28/2025
Oral argument (if requested)	11/4/2024	3/12/2025

Further, in view of the bankruptcy proceedings there has been a change in ownership of the patents at issue in the above captioned IPR proceedings. Patent Owner respectfully requests permission to file a paper substituting NanoString for the appropriate party.

To the extent the Board wishes to discuss further, the parties can be available for a phone call anytime after 10 AM PT on June 13.

Thanks,

Derek

From: Walter, Derek
Sent: Monday, April 22, 2024 4:48 PM
To: 'Trials' <Trials@USPTO.GOV>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: dholman-ptab@sternekessler.com; pkhanduri-ptab@sternekessler.com; rsterne-ptab@sternekessler.com; glongs-ptab@sternekessler.com
Subject: RE: IPR2023-01298 and -1300

Dear Board:

Pursuant to the Board's March 22, 2024 Order regarding Conduct of the Proceeding and Suspending Deadlines Due to Bankruptcy Stay, Patent Owner provides the following status update regarding the bankruptcy proceedings.

On February 4, 2024, Patent Owner filed a petition for relief under chapter 11 of the Bankruptcy Code in the United States Bankruptcy Court for the District of Delaware. On March 22, 2024, the Board stayed all deadlines in the above-captioned proceeding until Chapter 11 proceedings in the Bankruptcy Court and any related appeals conclude or until the Board receives notice that the Bankruptcy Court has lifted the stay with respect to this proceeding. On April 17, 2024, Patent Owner announced substantially all of its assets will be acquired by Bruker Corporation ("Bruker"). This transaction is expected to close sometime in May of this year.

Thanks,

Derek

From: Trials <Trials@USPTO.GOV>
Sent: Friday, February 9, 2024 11:18 AM
To: Walter, Derek <Derek.Walter@weil.com>; Trials <Trials@USPTO.GOV>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: dholman-ptab@sternekessler.com; pkhanduri-ptab@sternekessler.com; rsterne-ptab@sternekessler.com; glongs-ptab@sternekessler.com
Subject: RE: IPR2023-01298 and -1300

Counsel,

The Panel agrees to suspend the deadline for Patent Owner's Pre-Institution Sur-Reply until after the conference with the Board. If necessary, a new date will be set at or following the conference.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Walter, Derek <Derek.Walter@weil.com>
Sent: Friday, February 9, 2024 12:48 AM
To: Trials <Trials@USPTO.GOV>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: dholman-ptab@sternekessler.com; pkhanduri-ptab@sternekessler.com; rsterne-ptab@sternekessler.com; glongs-ptab@sternekessler.com
Subject: RE: IPR2023-01298 and -1300

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Dear Board:

Patent Owner will meet and confer with counsel for Petitioner and report back shortly on times for a conference call regarding the stay of these proceedings in view of Patent Owner's Chapter 11 filing.

In the meantime, Patent Owner requests that the Board confirm that the February 9 deadline for it to file a sur-reply to Petitioner's reply in IPR2023-1300 shall be extended until the parties have an opportunity to meet and confer and participate in a status conference with the Board. Patent Owner believes that the stay applies to this proceeding, and does not wish to be subject to an argument that it has violated the automatic stay or waived its right to rely upon the statutory stay provided for in Section 362 of the Bankruptcy Code by making a substantive filing in this proceeding. By relieving Patent Owner of the February 9 deadline, it will provide the parties with an opportunity to meet and confer about these issues, and report to the Board, without being subjected to any claim that it has violated the stay or, alternatively, missed a deadline imposed by the Board.

Thanks,

Derek

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, February 8, 2024 10:11 AM
To: Walter, Derek <Derek.Walter@weil.com>; Pepe, Christopher <Christopher.Pepe@weil.com>
Cc: dholman-ptab@sternekessler.com; pkhanduri-ptab@sternekessler.com; rsterne-ptab@sternekessler.com; glongs-ptab@sternekessler.com; Trials <Trials@USPTO.GOV>
Subject: IPR2023-01298 and -1300

Counsel,

The panel requests a conference with counsel for the parties regarding the effect of Patent Owner's Chapter 11 filing. Counsel should be prepared to discuss whether the parties agree that the Chapter 11 filing stays IPR2023-01298 and -1300, including whether the Bankruptcy Court of Delaware has interpreted section 362 of the Bankruptcy Code to specifically apply to IPR2023-01298 and -1300, which do not involve a debt owed by Patent Owner.

Counsel are instructed to confer regarding this issue, and to identify mutually agreeable times for a conference call with the panel.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

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