

From: [Trials](#)
To: [Grossman, Dov](#); [Trials](#); [David H. Holman](#)
Cc: [Prati Khanduri](#); [Gaby Longsworth](#); [Rob Sterne](#); [Krinsky, David](#)
Subject: RE: IPR2023-01299 - expungement of confidential information (EX1047)
Date: Tuesday, September 17, 2024 3:55:15 PM
Attachments: [image001.png](#)
[image002.png](#)

Counsel:

From the Board –

We appreciate the parties' efforts to handle this matter efficiently. The Board now considers Petitioner's e-mail request to be an unopposed motion to expunge confidential Exhibit 1047, which we hereby grant because the Board did not rely on any confidential information from Exhibit 1047 in its Decision Denying Institution. *See generally* Paper 15.

Accordingly, Confidential Exhibit 1047 shall be expunged from the record and the publicly filed redacted version of Exhibit 1047 shall remain.

Regards,

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

From: Grossman, Dov <DGrossman@wc.com>
Sent: Wednesday, September 11, 2024 1:51 PM
To: Trials <Trials@USPTO.GOV>; David H. Holman <DHOLMAN@sternekessler.com>
Cc: Prati Khanduri <PKHANDURI@sternekessler.com>; Gaby Longsworth <GLONGS@sternekessler.com>; Rob Sterne <RSTERNE@sternekessler.com>; Krinsky, David <DKrinsky@wc.com>
Subject: RE: IPR2023-01299 - expungement of confidential information (EX1047)

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Dear Honorable Board,

Patent Owner hereby withdraws its opposition to Petitioner's request to file a motion to expunge the confidential version of Exhibit 1047.

Regards,
Dov Grossman
Counsel for Patent Owner

Williams & Connolly LLP
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Washington, D.C. 20024
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dgrossman@wc.com | www.wc.com/dgrossman

From: Trials <Trials@USPTO.GOV>
Sent: Monday, September 9, 2024 4:01 PM
To: David H. Holman <DHOLMAN@sternekessler.com>; Trials <Trials@USPTO.GOV>
Cc: Prati Khanduri <PKHANDURI@sternekessler.com>; Gaby Longsworth <GLONGS@sternekessler.com>; Rob Sterne <RSTERNE@sternekessler.com>; Grossman, Dov <DGrossman@wc.com>; Krinsky, David <DKrinsky@wc.com>
Subject: RE: IPR2023-01299 - expungement of confidential information (EX1047)

Counsel:

From the Board –

We have received Petitioner's request for authorization to file a motion to expunge confidential Exhibit 1047. Given Patent Owner opposes Petitioner's request, please provide several dates and times that both parties are available for a conference call with the panel. In particular, the panel would like Patent Owner to be prepared to explain how it is harmed by Petitioner's request.

Alternatively, if Patent Owner withdraws its opposition, no conference call is necessary and Petitioner is authorized to file its unopposed motion to expunge within ten business days of Patent Owner's notice of withdrawal of its opposition.

Regards,

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

From: David H. Holman <DHOLMAN@sternekessler.com>
Sent: Monday, September 9, 2024 2:47 PM
To: Trials <Trials@USPTO.GOV>
Cc: Prati Khanduri <PKHANDURI@sternekessler.com>; Gaby Longsworth <GLONGS@sternekessler.com>; Rob Sterne <RSTERNE@sternekessler.com>; Grossman, Dov <DGrossman@wc.com>; Krinsky, David <DKrinsky@wc.com>
Subject: IPR2023-01299 - expungement of confidential information (EX1047)

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Dear Honorable Board,

Petitioner 10x Genomics (“10x”) writes to respectfully request authorization to file a motion to expunge confidential information in IPR2023-01299. In particular, 10x seeks to expunge from the record the confidential version of Exhibit 1047.

Exhibit 1047 is a copy of Exclusive Licensee and Real Party in Interest Vizgen’s initial infringement contentions for the ‘303 patent from parallel district court litigation. Exhibit 1047 contains confidential information belonging to 10x. 10x filed two versions of Exhibit 1047 with its petition for IPR – a public, redacted version and a confidential, unredacted version, along with a Motion to Seal the confidential version of Exhibit 1047. The Board issued its Decision Denying Institution on March 7, 2024. The Board also concurrently dismissed 10x’s Motion to Seal as moot, leaving Exhibit 1047 sealed. See Paper 15, at 22; 37 C.F.R. § 42.14. The Board’s institution decision did not rely on any of the confidential information in Exhibit 1047. While the confidential version of Exhibit 1047 remains unavailable to the public in P-TACTS, 10x nevertheless seeks to expunge the confidential version of Exhibit 1047 from the record under 37 C.F.R. § 42.56. The public version of Exhibit 1047 would remain in the record.

Counsel for 10x contacted counsel for Patent Owner regarding this request on August 15. The parties met and conferred on August 30. Counsel for Patent Owner informed counsel for 10x on September 9 that Patent Owner opposes 10x’s request.

Patent Owner further provided the following statement: Patent Owner opposes Petitioner’s request as moot, as the unredacted version of Exhibit 1047 should have already been deemed public (and its status updated on P-TACTS). The Trial Practice Guide identifies a 45-day time period for materials filed under seal to ordinarily become public (pp. 21-22), and 10x did not raise this issue until more than 5 months had passed since denial of the Petition.

Should the Board request a conference call, counsel can be available upon the Board’s request.

Respectfully,

David Holman

Counsel for Petitioner 10x



David H. Holman, Ph.D.

Director

Sterne, Kessler, Goldstein & Fox P.L.L.C.

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