

From: [Trials](#)
To: [Walter, Derek](#); [David H. Holman](#); [Trials](#)
Cc: [Rob Sterne](#); [Gaby Longworth](#); [Prati Khanduri](#); [Pepe, Christopher](#); [Nanostring 10X](#)
Subject: RE: IPR2023-01300
Date: Friday, January 26, 2024 2:28:38 PM
Attachments: [image001.png](#)
[image002.png](#)

Counsel,

The panel authorizes a 5-page reply by Petitioner, to be filed by February 2nd, 2024, limited to the two identified issues. Patent Owner is authorized to file a sur-reply, if desired, limited to 5 pages and the same issues, due by February 9, 2024. Neither party is authorized to file additional evidence in connection with this briefing.

Regards,

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

From: Walter, Derek <Derek.Walter@weil.com>
Sent: Thursday, January 25, 2024 7:13 PM
To: David H. Holman <DHOLMAN@sternekessler.com>; Trials <Trials@USPTO.GOV>
Cc: Rob Sterne <RSTERNE@sternekessler.com>; Gaby Longworth <GLONGS@sternekessler.com>; Prati Khanduri <PKHANDURI@sternekessler.com>; Pepe, Christopher <Christopher.Pepe@weil.com>; Nanostring 10X <Nanostring.10X@weil.com>
Subject: RE: IPR2023-01300

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Dear Board:

Lead counsel for NanoString has been engaged in a jury trial in Delaware this week and, unfortunately, did not see 10x's one email on this issue earlier this week. To the extent the Board wishes to hold a call on this issue, NanoString states that the dates 10x proposed on Tuesday and Wednesday of next week will work.

Thanks,

Derek

From: David H. Holman <DHOLMAN@sternekessler.com>
Sent: Thursday, January 25, 2024 2:58 PM

To: trials@uspto.gov

Cc: Rob Sterne <RSTERNE@sternekessler.com>; Gaby Longsworth <GLONGS@sternekessler.com>; Prati Khanduri <PKHANDURI@sternekessler.com>; Walter, Derek <Derek.Walter@weil.com>; Pepe, Christopher <Christopher.Pepe@weil.com>; Nanostring 10X <Nanostring.10X@weil.com>

Subject: IPR2023-01300

Dear Honorable Board:

Petitioner (10x Genomics) respectfully requests authorization to file a Reply to Patent Owner's Preliminary Response in IPR2023-01300 to address two specific issues in Patent Owner's arguments pertaining to all Grounds of the Petition:

- (i) Patent Owner's position in this proceeding on claim 1's identifying/sequencing step that is inconsistent with Patent Owner's position in its preliminary infringement contentions from parallel district court litigation;
- (ii) Patent Owner's position in this proceeding on claim 1's synthesizing steps that is inconsistent with Patent Owner's position in its preliminary infringement contentions from parallel district court litigation.

Petitioner believes that good cause exists for a short pre-institution reply in this IPR as both issues relate to inconsistencies in Patent Owner's arguments in parallel proceedings that could not have been anticipated by Petitioner and are potentially dispositive to the Board's decision on institution. Petitioner accordingly seeks authorization to file a 5-page pre-institution reply to address these two issues. Petitioner is amenable to Patent Owner receiving authorization to file a sur-reply of equal length. Petitioner proposes filing the pre-institution reply 5 business days from the Board's date of authorization, and filing Patent Owner's sur-reply 5 business days after the filing of Petitioner's pre-institution reply.

Counsel for Petitioner reached out to counsel for Patent Owner on January 22 in an attempt to meet and confer on this issue, but has received no response.

Should the Board believe a conference call is necessary, Petitioner can be available at the following times:

- Friday 1/26, 10am – 3pm ET;
- Monday 1/29, 10:30am – 12pm and 1.30pm – 3:30pm ET;
- Tuesday 1/30, 10:30am – 1pm and 2.30pm – 5pm ET;
- Wednesday 1/31, 10am – 1pm ET.

Respectfully,
David Holman
Counsel for Petitioner

David H. Holman, Ph.D.

Director

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

1101 K Street NW, 10th floor, Washington, DC 20005



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