

**IN THE UNITED STATES BANKRUPTCY COURT
FOR THE DISTRICT OF DELAWARE**

In re:

NANOSTRING TECHNOLOGIES, INC.,
et al.,¹

Debtors.

Chapter 11

Case No. 24-10160 (CTG)

(Jointly Administered)

Hearing Date:

March 18, 2024 at 1:00 p.m. (ET)

Objection Deadline:

March 11, 2024 at 4:00 p.m. (ET)

NOTICE OF MOTION

PLEASE TAKE NOTICE that the above-captioned debtors and debtors in possession (collectively, the “Debtors”) have filed the *Debtors’ Motion for an Order Confirming, Restating and Enforcing the Protections of Section 362 of the Bankruptcy Code with Respect to Inter Partes Review Proceedings Before the Patent Trial and Appeal Board* (the “Motion”) with the United States Bankruptcy Court for the District of Delaware (the “Court”).

PLEASE TAKE FURTHER NOTICE that any objections to the Motion must be filed on or before **March 11, 2024 at 4:00 p.m. (ET)** (the “Objection Deadline”) with the United States Bankruptcy Court for the District of Delaware, 3rd Floor, 824 North Market Street, Wilmington, Delaware 19801. At the same time, you must serve a copy of any objection upon the undersigned proposed counsel to the Debtors so as to be received on or before the Objection Deadline.

PLEASE TAKE FURTHER NOTICE THAT A HEARING TO CONSIDER THE MOTION WILL BE HELD ON MARCH 18, 2024 AT 1:00 P.M. (ET) BEFORE THE HONORABLE CRAIG T. GOLDBLATT IN THE UNITED STATES BANKRUPTCY COURT FOR THE DISTRICT OF DELAWARE, 824 N. MARKET STREET, 3RD FLOOR, COURTROOM NO. 7, WILMINGTON, DELAWARE 19801.

¹ The Debtors in these Chapter 11 Cases, along with the last four digits of their U.S. federal tax identification numbers, to the extent applicable, are NanoString Technologies, Inc. (4687), NanoString Technologies International, Inc. (2723), NanoString Technologies Netherlands B.V., and NanoString Technologies Germany GmbH. The Debtors’ headquarters is located at 530 Fairview Avenue North, Suite 2000, Seattle, WA 98109.

PLEASE TAKE FURTHER NOTICE THAT, IF YOU FAIL TO RESPOND IN ACCORDANCE WITH THIS NOTICE, THE COURT MAY GRANT THE RELIEF REQUESTED IN THE MOTION WITHOUT FURTHER NOTICE OR A HEARING.

Dated: March 4, 2024
Wilmington, Delaware

**YOUNG CONAWAY STARGATT & TAYLOR,
LLP**

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Proposed Co-Counsel to the Debtors and Debtors in Possession

**IN THE UNITED STATES BANKRUPTCY COURT
FOR THE DISTRICT OF DELAWARE**

In re:

NANOSTRING TECHNOLOGIES, INC.,
et al.,¹

Debtors.

Chapter 11

Case No. 24-10160 (CTG)

(Jointly Administered)

Hearing Date:

March 18, 2024 at 1:00 p.m. (ET)

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March 11, 2024 at 4:00 p.m. (ET)

**DEBTORS' MOTION FOR AN ORDER CONFIRMING, RESTATING AND
ENFORCING THE PROTECTIONS OF SECTION 362 OF THE BANKRUPTCY CODE
WITH RESPECT TO INTER PARTES REVIEW PROCEEDINGS BEFORE THE
PATENT TRIAL AND APPEAL BOARD**

The debtors and debtors in possession in the above-captioned cases (the “Debtors”) hereby file this motion (the “Motion”) for entry of an order, substantially in the form attached hereto as Exhibit A (the “Proposed Order”), confirming, restating and enforcing the protections of the automatic stay, as set forth in section 362 of title 11 of the United States Code, 11 U.S.C §§ 101–1532 (the “Bankruptcy Code”), with respect to *inter partes* review proceedings pending before the Patent Trial and Appeal Board. In further support of this Motion, the Debtors respectfully represent as follows²:

¹ The Debtors in these Chapter 11 Cases, along with the last four digits of their U.S. federal tax identification numbers, to the extent applicable, are NanoString Technologies, Inc. (4687), NanoString Technologies International, Inc. (2723), NanoString Technologies Netherlands B.V., and NanoString Technologies Germany GmbH. The Debtors’ headquarters is located at 530 Fairview Avenue North, Suite 2000, Seattle, WA 98109.

² Capitalized terms used but otherwise not defined herein shall having the meanings ascribed to them in the First Day Declaration.

PRELIMINARY STATEMENT

1. On February 23, 2024, in one of the many legal actions commenced by 10x Genomics, Inc. (“10x”) against the Debtors, the Patent Trial and Appeals Board (“PTAB”) summoned the parties for a telephonic status conference. The purpose of the call was to discuss the impact of the Debtors’ chapter 11 petitions—in particular, the automatic stay—on proceedings brought by 10x against the Debtors in front of the PTAB. During that conference, the Debtors took the position that the automatic stay applied to those administrative proceedings. 10x refused to take a position on the issue, even though the day before it had filed a motion to lift the automatic stay in this Court as to those very same proceedings. (10x stated during the proceedings that it was “unclear” whether the stay applied, and that it had filed its motion to lift the stay in this Court as a “precaution.”)

2. The PTAB ruled that the question of whether the automatic stay applied to the proceedings before it involved an interpretation of the Bankruptcy Code, which was better determined by this Court than the PTAB. Accordingly, the PTAB instructed the Debtors to seek clarification from this Court that the automatic stay applied to the proceedings before the PTAB.

3. As set forth below, *inter partes* review proceedings in front of the PTAB are administrative proceedings that fall within the clear terms of Section 362 of the Bankruptcy Code, and to which no exception applies. The Debtors contacted 10x and asked it to stipulate to an order to be presented to this Court stating as much. 10x refused, despite having never articulated on what basis it believes Section 362 does not apply.

4. As a result, the Debtors are forced to bring this Motion seeking clarification that these actions are stayed. The PTAB has indicated that, absent an order or other clarification from

the Bankruptcy Court, it will continue to hear the 10x IPR Proceedings on their existing timelines. The Debtors' next upcoming deadline in the 10x IPR Proceedings is March 18, 2024.

JURISDICTION AND VENUE

5. The United States Bankruptcy Court for the District of Delaware (the “Court”) has jurisdiction over this matter pursuant to 28 U.S.C. §§ 157 and 1334 and the *Amended Standing Order of Reference* from the United States District Court for the District of Delaware, dated as of February 29, 2012. This matter is a core proceeding pursuant to 28 U.S.C. § 157(b) and, pursuant to Rule 9013-1(f) of the Local Rules of Bankruptcy Practice and Procedure of the United States Bankruptcy Court for the District of Delaware (the “Local Rules”), the Debtors consent to the entry of a final order by the Court in connection with this Motion to the extent that it is later determined that the Court, absent the consent of the parties, cannot enter final orders or judgments in connection herewith consistent with Article III of the United States Constitution.

6. Venue is proper in the Court pursuant to 28 U.S.C. §§ 1408 and 1409.

7. The statutory predicates for the relief requested herein are sections 105(a) and 362 of the Bankruptcy Code.

BACKGROUND

a. Background Facts

8. An *inter partes* review (“IPR”) is a trial proceeding conducted in front of the Patent Trial and Appeals Board (the “PTAB”), which is a “tribunal within” a federal agency, the United States Patent and Trademark Office (the “USPTO”).³ IPRs are commenced by third parties who wish to challenge the validity of a patent. The right to bring IPR proceedings arises under a federal

³ <https://www.uspto.gov/patents/ptab/about-ptab>.

statute, the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified in scattered sections of 35 U.S.C.) (the “AIA”).

9. In the months prior to the Petition Date, as part of its ongoing litigation campaign against the Debtors, 10x petitioned the PTAB in two separate IPR proceedings to contest the validity of U.S. Patent Nos. 11,377,689 (the “689 Patent”) and 11,473,142 (the “142 Patent”), both owned by the Debtors. 10x filed its IPR petition against the 689 Patent (IPR2023-01298) on August 16, 2023, and its IPR petition against the 142 Patent (IPR2023-01300) on September 25, 2023 (collectively, the “10x IPR Proceedings”).

RELIEF REQUESTED

10. By this Motion, the Debtors respectfully request entry of the Proposed Order, attached hereto as Exhibit A, confirming that the automatic stay (as set forth in section 362 of the Bankruptcy Code) applies to the 10x IPR Proceedings and restating and enforcing the protections of the automatic stay with respect to the 10x IPR Proceedings.

BASIS FOR RELIEF REQUESTED

I. The PTAB Has Requested a Clarification from the Bankruptcy Court

11. As set forth above, the 10x IPR Proceedings are judicial and administrative proceedings commenced against the Debtors prior to the Petition Date. Accordingly, they were automatically stayed upon the commencement of these Chapter 11 Cases on February 4, 2024.

12. Although the 10x IPR Proceedings were stayed by operation of law on the Petition Date, the PTAB *sua sponte* raised the question of whether the automatic stay applies. Specifically, on February 8, 2024, the PTAB requested the scheduling of a conference call with counsel to the Debtors and 10x regarding the effect of the chapter 11 filings on the 10x IPR Proceedings. The PTAB stated, “Counsel should be prepared to discuss whether the parties agree that the Chapter

11 filing stays IPR2023-1098 and -1300, including whether the Bankruptcy Court of Delaware has interpreted section 362 of the Bankruptcy Code to specifically apply to IPR 2023-02198 and -1300, which do not involve a debt owed by the Patent Owner” (*i.e.*, the Debtors). *See* Email from Trials@USPTO.gov to Derek Walter and Christopher Pepe (Feb. 8, 2024), attached hereto as Exhibit B.

13. The Debtors requested the opportunity to submit a brief to the PTAB regarding the applicability of the automatic stay to the 10x IPR Proceedings in advance of the conference call, which the PTAB granted. The Debtors submitted that brief, attached hereto as Exhibit C, on February 20, 2024. 10x did not submit a brief.

14. The PTAB held a telephonic conference on February 23, 2024 with counsel to the Debtors and 10x. At that conference, the PTAB stated that it did not have the authority to determine whether the automatic stay applied to the 10x IPR Proceedings and directed the Debtors to obtain a “clarification” from the Bankruptcy Court that the automatic stay is, in fact, in effect.⁴ Specifically, the PTAB stated as follows:

We are informed by the Federal Circuit’s holding in the Purdue Pharma case that a question of whether a bankruptcy automatic stay applies to AIA proceedings is an open question that requires interpretation of the Bankruptcy Code. And our feeling is and our decision is that as an administrative agency dealing with patent law, we are not able to interpret the Bankruptcy Code.

We noticed that the Federal Circuit also did not interpret the Bankruptcy Code and left it remaining an open question. And we don’t have any authority from Patent Owner indicating that IPRs are

⁴ Attorneys from Willkie attended the telephonic conference and, following the PTAB’s request for such clarification, explained on the record that this Court entered the *Order (I) Restating and Enforcing Protections of 11 U.S.C. §§ 362, 365, 525, and 541(c), (II) Approving Notice Related to Non-Debtor Affiliates, and (III) Granting Related Relief* [Docket No. 68] on February 6, 2024, and cited the language therein holding that “pursuant to and to the extent set forth in Section 362 of the Bankruptcy Code, the commencement of the chapter 11 cases operates as a stay of the commencement or continuation of all judicial, administrative or other actions or proceedings against the Debtors.” The PTAB stated that it was “familiar with the language,” but that it nonetheless needed “further clarification.” Conference Call Hr’g Tr. at 14:24 – 16:4.

stayed by a bankruptcy stay, aside from the statute itself, which we are not able to construe. So we do not – we are not taking the position that the IPRs are not subject to the bankruptcy stay, simply that we cannot make that interpretation as an agency.

Because we do not have that ability, we would like to ask that the Patent Owner who is seeking the protection of the bankruptcy court, petition the bankruptcy court for a clarification, whether that is by an order or holding or some other statement, that the . . . automatic stay applies to these IPRs.”

10x Genomics, Inc. v. NanoString Technologies, Inc., IPR2023-01298 and -01300, Conference Call Hr’g Tr. at 6:24–7:24 (PTAB Feb. 23, 2024), attached hereto as Exhibit D.

15. In response—and despite having formally sought stay relief with respect to the 10x IPR Proceedings in this Court the day prior⁵—10x stated that it “takes no position on whether the Bankruptcy Court’s automatic stay under section 362 of the Bankruptcy Code includes these IPRs,” and said that the motion was a “precaution because it is unclear right now whether these IPRs are stayed.” Conference Call Hr’g Tr. at 17:14-16. However, 10x’s motion contains no such language clarifying that the stay relief was being sought out of an abundance of caution, nor does it cite to any case law as evidence that the automatic stay may be inapplicable to the IPRs. Remarkably, 10x’s counsel also stated that it would “proceed accordingly” if the PTAB determined that the stay does not apply to the IPRs. Conference Call Hr’g Tr. at 17:24 – 18:3. Following the status conference, the Debtors asked 10x’s restructuring counsel to enter into a stipulation regarding the applicability of the automatic stay to the 10x IPR Proceedings. 10x would not agree. *See* Email from 10x’s counsel to Debtors’ counsel (Feb. 24, 2024), attached hereto as Exhibit E.

16. Absent the Debtors obtaining an order of the Bankruptcy Court to the contrary, the PTAB is requiring prepetition litigations to proceed against the Debtors on existing timelines

⁵ *See* Docket No. 127.

despite the intervening chapter 11 filing and the automatic stay. The soonest of the deadlines related to the 10x IPR Proceedings falls on March 18, 2024.

II. The PTAB's Reliance on *Collegium* is Misplaced

17. The PTAB's holding is based on a footnote in the November 2023 opinion of the United States Court of Appeals for the Federal Circuit in *Purdue Pharma L.P. v. Collegium Pharmaceutical, Inc.*, No. 2022-1482 (Fed. Cir. Nov. 21, 2023), attached hereto as Exhibit F. That footnote reads as follows:

“We do not reach the question of whether the bankruptcy automatic stay applies to PGRs. This would require interpretation of the Bankruptcy Code. The Bankruptcy Code provides that a bankruptcy petition stays “the commencement or continuation . . . of a judicial, administrative, or other action or proceeding against the debtor.” 11 U.S.C. §362(a)(1). There is an exception to the automatic stay for “the commencement or continuation of an action or proceeding by a governmental unit . . . to enforce such governmental unit’s or organization’s police and regulatory power, including the enforcement of a judgment other than a money judgment, obtained in an action or proceeding by the governmental unit to enforce such governmental unit’s or organization’s police or regulatory power. Id. § 362(b)(4). The question is whether this exception applies to PTO IPR or PGR proceedings.”

Id. at n. 5.

18. Notably, the Federal Circuit was not adjudicating or otherwise addressing a live dispute over the applicability of the automatic stay (which had actually been lifted by the Bankruptcy Court three years earlier following stay relief litigation among the parties). Prior to the Bankruptcy Court adjudicating the matter, the PTAB honored the automatic stay at the outset of Purdue's chapter 11 filing, and even after Collegium took the position that the stay was not applicable, the PTAB maintained the stay and deferred to the Bankruptcy Court to make the determination of whether it should be lifted (consistent with PTAB precedent). *Id.*; see also *Dr. Reddy's Laboratories Inc. v. Pozen Inc.*, No. IPR2018-01341, 2018 WL 5099672, at *1 (P.T.A.B.

Oct. 16, 2018) (deferring to bankruptcy court with respect to applicability of automatic stay to IPRs); *see also Mylan Pharms. Inc. v. Pozen Inc.*, No. IPR2017-01995, 2018 WL 4191553, at *1 (P.T.A.B. Aug. 31, 2018) (“Given the parties’ disagreement regarding whether the automatic stay applies to these proceedings—a disagreement that, in our view, is best addressed in the bankruptcy court—we determined that the appropriate course of action was to suspend all deadlines in these proceedings until further notice.”). The stay remained in place for approximately a year, until a motion to lift the stay was granted by the Bankruptcy Court.

19. The issue on appeal before the Federal Circuit did not relate to the applicability of the automatic stay. Instead, the *Collegium* opinion relates to solely whether the PTAB maintained authority to issue a written decision on Collegium’s post-grant review after a statutory period to do so had passed (in part because the automatic stay had been in place for a portion of that period due to Purdue’s bankruptcy filing). Within that context, the PTAB clarified “that the [*Collegium*] decision observed that, in the Federal Circuit’s view, it remains an open question whether the automatic stay provision of 11 U.S.C. § 362 applies to IPR or PGR proceedings at the PTAB, and that answering this question requires interpretation of the Bankruptcy Code.” *See 10x Genomics, Inc. v. NanoString Technologies, Inc.*, IPR2023-01298 and -01300, Paper 19 at 3 (PTAB Feb. 29, 2024), attached hereto as Exhibit G.

20. It is axiomatic that the automatic stay applies to judicial and administrative actions against chapter 11 debtors, like the 10x IPR Proceedings. As explained above, the 10x IPR Proceedings were commenced prior to the Petition Date, pursuant to a federal law, in front of an administrative tribunal that sits within an agency of the United States government. By operation of law pursuant to section 362 of the Bankruptcy Code, the automatic stay enjoins all entities from, among other things, commencing or continuing **any judicial, administrative, or other action or**

proceeding against the Debtors that was or could have been initiated before the Petition Date.

See 11 U.S.C. § 362(a) (emphasis added).

21. Moreover, the exception to the automatic stay referenced in the Federal Circuit’s opinion is not applicable. Section 362(b)(4) of the Bankruptcy Code provides an exception to the automatic stay with respect to “the commencement or continuation of an action or proceeding by a governmental unit . . . to enforce such governmental unit’s . . . police and regulatory power . . .” 11 U.S.C. § 362(b)(4). As an initial matter, the exception applies only to actions brought by governmental units, not private actors like 10x. *See* 11 U.S.C. § 101(27) (defining the term “governmental unit” for purposes of the Bankruptcy Code).

22. Further, even where a governmental unit is bringing an action against a debtor to enforce a law, the exception applies solely where the action is to enforce the governmental unit’s “police and regulatory power,” which is a power that is not at issue in a dispute among private parties over the validity of intellectual property. It is well-established that the purpose of the police and regulatory power exception is to “. . . discourage[] debtors from submitting bankruptcy petitions either primarily or solely for the purpose of evading impending governmental efforts to invoke the governmental police powers to enjoin or deter **ongoing debtor conduct which would seriously threaten the public safety and welfare (e.g., environmental and/or consumer protection regulations).**” *In re Nortel Networks, Inc.*, 669 F.3d 128, 137 (3d Cir. 2011) (emphasis added); S. Rep. 95-989 (1978) (“Paragraph (4) excepts commencement or continuation of actions and proceedings by governmental units to enforce police or regulatory powers. Thus, where a **governmental unit is suing a debtor to prevent or stop violation of fraud, environmental protection, consumer protection, safety, or similar police or regulatory laws, or attempting to fix damages for a violation of such a law**, the action or proceeding is not stayed under the

automatic stay.”) (emphasis added). The exception does not apply if the purpose of the government’s law enforcement is to adjudicate private rights. *See Chao v. Hospital Staffing Servs., Inc.*, 270 F.3d 374, 390 (6th Cir. 2001) (finding that suit by Secretary of Labor under the FLSA primarily benefitted the private rights of the employee and was not excepted from the automatic stay under § 362(b)(4) despite the public interest in enforcing wage laws); *Missouri v. U.S. Bankruptcy Court*, 647 F.2d 768, 776 (finding state’s attempt to enforce laws was related to pecuniary interests of the state in the debtor’s property and was therefore outside the police power exception of § 362(b)(4)) (8th Cir. 1981).

23. The 10x IPR Proceedings are no different from any other judicial or administrative proceeding brought against the Debtors prepetition. They remain subject to the automatic stay absent an order of this Court to the contrary. Given its fundamental importance to a debtor’s reorganization, courts broadly construe the Bankruptcy Code’s automatic stay provisions, and the Court has authority to fashion appropriate remedies for violations. *See* 11 U.S.C. § 105(a); *see also In re Odom*, 570 B.R. 718, 722 (Bankr. E.D. Pa. 2017) (holding that bankruptcy court has considerable discretion in fashioning a remedy in connection with violations of the automatic stay once a finding of civil contempt has been made).

RESERVATION OF RIGHTS

24. Nothing in the Proposed Order or this Motion (i) is intended or shall be deemed to constitute an assumption of any agreement pursuant to section 365 of the Bankruptcy Code or an admission as to the validity of any claim against the Debtors and their estates; (ii) shall impair, prejudice, waive, or otherwise affect the rights of the Debtors and their estates with respect to the validity, priority, or amount of any claim against the Debtors and their estates; (iii) shall impair,

prejudice, waive, or otherwise affect the rights of the Debtors and their estates with respect to any and all claims or causes of action; or (iv) shall be construed as a promise to pay a claim.

NOTICE

25. Notice of this Motion will be provided to: (i) the U.S. Trustee; (ii) the United States Attorney's Office for the District of Delaware; (iii) proposed counsel to the Committee; (iv) counsel to the Prepetition 2025 Note Trustee; (v) counsel to the Prepetition Trustee and Collateral Agent; (vi) counsel to the DIP Agent; (vii) counsel to the DIP Lenders; (viii) the USPTO; and (ix) the PTAB. In light of the nature of the relief requested herein, the Debtors submit that no other or further notice is necessary.

CONCLUSION

WHEREFORE, the Debtors respectfully request entry of the Proposed Order granting the relief requested herein and such other and further relief as the Court deems just and appropriate.

Dated: March 4, 2024
Wilmington, Delaware

YOUNG CONAWAY STARGATT & TAYLOR, LLP

/s/ Allison S. Mielke
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*Proposed Co-Counsel to the Debtors
and Debtors in Possession*

EXHIBIT A

Proposed Order

**IN THE UNITED STATES BANKRUPTCY COURT
FOR THE DISTRICT OF DELAWARE**

In re:

NANOSTRING TECHNOLOGIES, INC.,
et al.,¹

Debtors.

Chapter 11

Case No. 24-10160 (CTG)

(Jointly Administered)

Ref. Docket No. ____

**ORDER CONFIRMING, RESTATING AND ENFORCING THE PROTECTIONS
OF SECTION 362 OF THE BANKRUPTCY CODE
WITH RESPECT TO INTER PARTES REVIEW PROCEEDINGS**

Upon the motion (the “Motion”)² of the debtors and debtors in possession in the above-captioned cases (the “Debtors”) for entry of an order confirming, restating, and enforcing the automatic stay, as set forth in section 362 of title 11 of the United States Code, 11 U.S.C §§ 101–1532 (the “Bankruptcy Code”), with respect to the 10x IPR Proceedings; and upon consideration of the Motion and all pleadings related thereto, including the First Day Declaration; and due and proper notice of the Motion having been given; and having determined that no other or further notice of the Motion is required; and having determined that this Court has jurisdiction to consider the Motion in accordance with 28 U.S.C. §§ 157 and 1334 and the *Amended Standing Order of Reference* from the United States District Court for the District of Delaware, dated as of February 29, 2012; and having determined that this is a core proceeding pursuant to 28 U.S.C. § 157(b)(2); and having determined that venue of this proceeding and the Motion is proper pursuant to 28 U.S.C. §§ 1408 and 1409; and after due deliberation and sufficient cause appearing therefor,

¹ The Debtors in these Chapter 11 Cases, along with the last four digits of their U.S. federal tax identification numbers, to the extent applicable, are NanoString Technologies, Inc. (4687), NanoString Technologies International, Inc. (2723), NanoString Technologies Netherlands B.V., and NanoString Technologies Germany GmbH. The Debtors’ headquarters is located at 530 Fairview Avenue North, Suite 2000, Seattle, WA 98109.

² Capitalized terms used but not otherwise defined herein have the meanings given to them in the Motion.

IT IS HEREBY ORDERED THAT:

1. The Motion is GRANTED, as set forth herein.
2. Pursuant to, and to the extent set forth in, section 362 of the Bankruptcy Code the commencement of these Chapter 11 Cases operates as a stay, applicable to all entities of (among other things), the commencement or continuation, including the issuance or employment of process, of a judicial, administrative, or other action or proceeding against the Debtors that was or could have been commenced before the commencement of these Chapter 11 Cases. These actions or proceedings include, but are not limited to, IPR2023-1098 and IPR2023-1300 (the “10x IPR Proceedings”). No exception to the automatic stay applies to the 10x IPR Proceedings.
3. This Order is declarative and is intended to be coterminous with section 362 of the Bankruptcy Code. Nothing herein shall abridge, enlarge, or modify the rights and obligations of any party. For the avoidance of doubt, this Order does not expand or enlarge the rights afforded to the Debtors under the Bankruptcy Code and all such rights are fully preserved.
4. Notwithstanding any Bankruptcy Rule to the contrary, this Order shall be effective and enforceable immediately upon entry hereof.
5. The Debtors are hereby authorized to take such actions and to execute such documents as may be necessary to implement the relief granted by this Order.
6. This Court shall retain jurisdiction with respect to all matters arising from or related to the implementation, interpretation, and enforcement of this Order.

EXHIBIT B

**February 8, 2024 Email from Trials@USPTO.gov
to Derek Walter and Christopher Pepe**

From: Trials <Trials@uspto.gov>

Date: February 8, 2024 at 10:12:53 AM PST

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

EXHIBIT C

Debtors' Brief Regarding Automatic Stay in IPR Proceedings

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner,

v.

NANOSTRING TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2023-01300
U.S. Patent No. 11,473,142

PATENT OWNER'S BRIEF REGARDING AUTOMATIC STAY

Pursuant to the Board’s February 20, 2024 email, Patent Owner hereby submits this brief regarding the applicability of the statutory stay under § 362 of the bankruptcy code to these proceedings.

The automatic stay provided for by § 362 is triggered immediately and automatically upon filing of a bankruptcy petition. 11 U.S.C. § 362(a). The purpose of the stay is to protect a debtor’s estate and the interests of creditors. *See In re Rexene Prods., Co.*, 141 B.R. 574, 76 (Bankr. D. Del. 1992) (the automatic stay’s “purpose is three-fold: to prevent certain creditors from gaining a preference for their claims against the debtor; to forestall the depletion of the debtor’s assets due to legal costs in defending proceedings against it; and, in general, to avoid interference with the orderly liquidation or rehabilitation of the debtor.”). Accordingly, the “sweep of the automatic stay is broad and ‘serves as one of the most important protections of bankruptcy law.’” *Porter v. Nabors Drilling USA, L.P.*, 854 F.3d 1057, 1061 (9th Cir. 2017).

In practice, the filing of the bankruptcy petition “operates as a stay, applicable to all entities,” of, among other things, “the commencement or continuation...of a judicial, *administrative*, or other action or proceeding against the debtor[s] that was or could have been commenced before the commencement of the case under [the Bankruptcy Code], or to recover a claim against the debtor[s] that arose before the commencement of the [bankruptcy] case.” 11 U.S.C. §§ 362(a)(1) (emphasis

added). These IPRs are administrative proceedings commenced prior to Debtors' bankruptcy petition, and the automatic stay thus applies.

The exceptions to the stay are limited and specifically enumerated in the Bankruptcy Code. *See* 11 U.S.C. § 362(b). None of them apply here, and Patent Owner does not understand Petitioner to argue otherwise.

To the extent Petitioner believes that these IPRs should proceed, it has clear avenue to advance that position – by filing a motion to lift the stay in the Bankruptcy Court. *See Association of St. Croix Condominium Owners v. St. Croix Hotel Corp.*, 682 F.2d 446, 449 (3d Cir. 1982). Indeed, this Panel has recognized that the Bankruptcy Court is the proper venue to decide such questions. *See Dr. Reddy's Laboratories Inc. v. Pozen Inc.*, No. IPR2018-01341, 2018 WL 5099672, at *1 (P.T.A.B. Oct. 16, 2018) (deferring to bankruptcy court to determine whether the automatic stay under § 362 to IPRs); *see also Mylan Pharms. Inc. v. Pozen Inc.*, No. IPR2017-01995, 2018 WL 4191553, at *1 (P.T.A.B. Aug. 31, 2018) (“Given the parties' disagreement regarding whether the automatic stay applies to these proceedings—*a disagreement that, in our view, is best addressed in the bankruptcy court—we determined that the appropriate course of action was to suspend all deadlines in these proceedings until further notice.*”) (emphasis added). The Bankruptcy Court will then consider whether to lift the stay to allow these IPRs to continue, based on the balancing test found in *Rexene Prods. Rexene*

Prods., 141 B.R. at 576. Absent the Bankruptcy Court granting relief from the automatic stay, the automatic stay applies.

In the February 8, 2024 email, the Panel asked “whether the Bankruptcy Court of Delaware has interpreted section 362 of the Bankruptcy Code to specifically apply to IPR2023-01298 and -1300.” For the reasons set forth above, it has had no reason to do so: Patent Owner is a defendant in multiple pending legal actions, each of which are stayed by operation of law upon the filing of a bankruptcy petition. The Bankruptcy Court would only consider whether to allow any proceeding to continue upon the filing of a motion to lift the automatic stay, which no party has made.

It is also immaterial whether these IPR Proceedings involve a debt owed by the Debtors. As discussed above, the automatic stay applies to protect all assets of the estate and the Debtors’ IP is an asset of the estate. *See* §§ 362(a)(1), (3); *Maritime Elec. Co. v. United Jersey Bank*, 959 F.2d 1194, 1204 (3d Cir. 1991) (The “stay protects the bankrupt’s estate from being eaten away by creditors’ lawsuits and seizures of property before trustee has had chance to marshal estate’s assets and distribute them equitably among creditors.”). It does not matter whether Petitioner is seeking recovery of a debt – the automatic stay applies regardless.

Dated: February 20, 2024

RESPECTFULLY SUBMITTED,

/Derek C. Walter/

Derek C. Walter

Lead Counsel for Patent Owner

Reg. No. 74,656

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PATENT OWNER'S BRIEF REGARDING AUTOMATIC STAY** was served on February 20, 2024, via email pursuant to 37 C.F.R. and § 42.107 to the Petitioner at the addresses below:

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Dated: February 28, 2024

By: /Derek C. Walter/
Derek C. Walter
Lead Counsel for Patent Owner
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EXHIBIT D

February 23, 2024 Conference Call Hearing Transcript

In the Matter Of:

10X GENOMICS vs

NANOSTRING TECHNOLOGIES

CONFERENCE CALL

February 23, 2024



IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

10X GENOMICS, INC., and)
PROGNOSYS BIOSCIENCES, INC.,)
Plaintiffs,) CASE NO. 21-CV-653-MFK
v.)
NANOSTRING TECHNOLOGIES, INC.,) PAGES 1 - 23
Defendant.)
_____)

REMOTE TELECONFERENCE CALL

Friday, February 23, 2024

APPEARING REMOTELY FROM HUNTINGTON BEACH, CALIFORNIA

STENOGRAPHICALLY REPORTED BY:
LINDSAY A. STOKER, RMR, CRR, CRC
CA CSR No. 14373
Job No.: 2024-931134

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

10X GENOMICS, INC., and
PROGNOSYS BIOSCIENCES, INC.,
Plaintiffs,
v.
NANOSTRING TECHNOLOGIES, INC.,
Defendants.

)
)
)
) CASE NO. 21-CV-653-MFK
)
)
) PAGES 1 - 23
)
)
)

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Remote conference call taken in Huntington
Beach, California, commencing at 1:00 p.m. Pacific
Standard Time, on Friday, February 23, 2024, before
Lindsay Stoker, RMR, CRR, CRC, Certified Shorthand
Reporter No. 14373 in and for the State of California.

A P P E A R A N C E S
--000--

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STENOGRAPHIC REPORTER APPEARING REMOTELY

HUNTINGTON BEACH, CALIFORNIA

Friday, February 23, 2024, 1:00 p.m.

JUDGE NEWMAN: This is a conference call for
IPR2023-01298 and -01300, 10x Genomics, Inc. versus
NanoString Technologies, Inc.

Do we have a court reporter for the call?
(Whereupon, the reporter had to leave and
re-enter the meeting due to technical issues.)

JUDGE NEWMAN: So this is a conference call for
IPRs 2023-01298 and -01300 for 10x Genomics, Inc. versus
NanoString. We have Judges Newman, Mitchell, and Weiss
on the call. We have a list of attendees that was
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Counsel for patentor, would you please provide
that list to the court reporter if you have not already.
We would appreciate that.

THE REPORTER: Thank you.

JUDGE NEWMAN: And then if the court
reporter -- thank you. And then also file a transcript
of the call in the files for the case. Thank you.

And then would you confirm also that there are
no additional attendees or no changes to the list that
have been -- that was submitted in advance to the list

6

1 of counsel?

2 MR. WALTER: Yes, Your Honor, for Patent Owner,
3 there have been no changes to the list.

4 THE REPORTER: And sorry. Who was that for the
5 record?

6 MR. WALTER: That was Derek Walter.

7 MR. HOLMAN: Your Honor, this is David Holman
8 for Petitioner, and we also confirm there is no changes
9 to the list of attendees for Petitioner.

10 JUDGE NEWMAN: Okay. Thank you. And just to
11 summarize, we have reviewed the patentor's brief on the
12 bankruptcy issues, and counsel for Petitioner confirmed
13 that they elected not to file a brief on this issue.

14 All right.
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15 We have taken the issue under advisement. I'd
16 like to give you a little bit of information as to what
17 we are thinking at this point, and then give you a
18 chance to respond.

19 And we appreciate the brief from Patent Owner
20 and note that in that brief, Patent Owner identified
21 that other panels in the past have taken different
22 positions when there have been a bankruptcy stay in
23 effect in a case related to the patent at issue.

24 We understand that other panels may have taken
25 that position, that a stay is automatic in the past. We

7

1 are informed by the Federal Circuit's holding in the
2 previous pharma case that a question of whether a
3 bankruptcy automatic stay applies to AIA proceedings is
4 an open question that requires interpretation of the
5 bankruptcy code.

6 And our feeling is and our decision is that as
7 an administrative agency dealing with patent law, we are
8 not able to interpret bankruptcy code.

9 We noticed that the Federal Circuit also did
10 not interpret the bankruptcy code and left it remaining
11 an open question. And we don't have any authority from
12 Patent Owner indicating that IPRs are stayed by a
13 bankruptcy stay, aside from the statute itself, which we
14 are not able to construe.

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15 So we do not -- we are not taking the position
16 that the IPRs are not subject to the bankruptcy stay,
17 simply that we cannot make that interpretation as an
18 agency.

19 Because we did not have that ability, we would
20 like to ask that the Patent Owner, who is seeking the
21 protection of the bankruptcy court, petition the
22 bankruptcy court for a clarification whether that is by
23 an order or holding or some other statement, that the
24 bankruptcy stay -- automatic stay applies to these IPRs.
25 And once we have that indication from the bankruptcy

8

1 court, we can then consider that application and decide
2 what to do with it next.

3 In the meantime, we are advising that we are
4 also unaware of any statutory authority by which we can
5 extend the deadline to determine whether we should
6 institute an inter partes review under the 314(b)
7 section, even if there was a showing of good cause with
8 respect to the 1300 case, which has not yet been
9 instituted.

10 Once these proceedings are instituted as in the
11 1298 case, we can give a six-month extension of good
12 cause upon showing by the director, and we could ask the
13 director on behalf of Patent Owner, for that type of
14 extension. And so that authority is 35 USC 316(a)11,
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16 and it allows us to provide up to six months additional
17 time to issue a final written decision when good cause
18 is shown.

19 And 37 CFR 42.100 delegates that authority to
20 the chief administrative patent judge.

21 So if it Patent Owner desires a good -- a
22 six-month extension of good cause in the 1298 case, we
23 would be happy to ask the director -- the chief
24 administrative patent judge for an order to that effect.

25 And -- but until we have some other type of
determination from the bankruptcy court confirming that

1 the IPRs are subject to the bankruptcy stay, our
2 position is that we need to, by our statutory authority,
3 render a decision on the 1300 case no later than
4 April 4th, 2024.

5 And if we do reach that point and we elect to
6 institute trial, we would then entertain a request by
7 Patent Owner to give another six-month good cause
8 extension in that case.

9 If the bankruptcy court does not take a
10 position, then in the instance that either case reaches
11 the ultimate 18-month statutory deadline, we will issue
12 a final written decision by that deadline.

13 With that as background, I will then turn it
14 over to Patent Owner who is seeking the protection of
15 the bankruptcy court to ask any questions or to take a
16 position on these issues.

17 MR. WALTER: Thank you, Your Honor. I think
18 there's been an important development that the board
19 should be informed of related to this, which is that
20 last night 10x filed a motion with the bankruptcy court
21 to lift the stay of these IPR proceedings. That
22 happened just last night, and we're happy to submit that
23 so that the board can have the benefit of that, if the
24 board will authorize that.

25 But there's a number of key points that need to

10

1 be made in connection with that that I think are highly
2 relevant here.

3 First, by filing the motion, 10x effectively
4 acknowledges that the stay applies. If the stay didn't
5 apply, you wouldn't file the motion.

6 And, second, and perhaps more important, their
7 motion to lift the stay was not based on the contention
8 that the stay doesn't apply, nor was the motion based on
9 the contention that there's some sort of exception to
10 the statutory stay that would apply.

11 In fact, the motion to lift the stay that 10x
12 filed, with respect to these IPR proceedings, was based
13 on a balance of hardships argument, that 10x would
14 suffer a hardship that outweighs the hardship to
15 NanoString if the stay is not lifted. In other words,
16 they're seeking to have the stay lifted under the normal
17 statutory and legal framework that applies to stay under
18 the assumption that the stay does apply.

19 So there is no question that 10x agreed that
20 the statutory stay applies. They may think there is a
21 basis to have it lifted, but there is no contention that
22 there's a threshold matter, that Section 362 does not
23 apply to IPR proceedings, and we're not going to hear
24 anything to the contrary from them on this call because
25 they've already affirmed the meet and confer and the

11

1 correspondence with the board that they plan to stay
2 silent on this issue.

3 There's a second major point as well, which is
4 that not only did they agree the stay applies, they
5 agreed that the bankruptcy court is the place that
6 should decide whether to lift the stay or not.

7 How do we know that? Well, it's obvious they
8 went to the bankruptcy court to get the stay lifted, and
9 they're not coming to Your Honors to request that the
10 stay be lifted.

11 So what we have is we have 10x effectively
12 agreeing that the stay does apply in the bankruptcy
13 court, and we have a motion to lift the stay that is
14 going to be decided -- my understanding is it is going
15 to be decided on or about March 7th. And that stay is
16 not going to be based -- or that motion is not going to
17 be based on any contention that the statutory framework
18 of Section 362 doesn't apply anymore. It's fairly well
19 accepted that it does apply.

20 So, you know, what I would ask the board, you
21 know, with that in mind, given the fact that 10x has
22 already filed a motion to stay and has not argued and is
23 not going to argue here that the stay doesn't apply, is
24 the board still suggests that we file our own separate
25 motion for some sort of legal ruling in the bankruptcy

12

1 court on the legal question of whether Section 362
2 applies to IPR proceedings?

3 (Reporter clarification.)

4 JUDGE NEWMAN: Yes. So on behalf of the panel,
5 we -- we are not bound by the party's agreement or the
6 party's interpretation of the law. We would prefer to
7 get clarification from the bankruptcy court.

8 MR. WALTER: Okay. Well, with that in mind,
9 what I would suggest is with respect to the IPR that has
10 been instituted, I think it does make sense to request
11 the six-month extension.

12 And with respect to the 1300 case, we will
13 likely -- we would request that extension. And I am
14 going to have to meet with our team on that, but we
15 likely would. We have this issue which is that there is
16 an outstanding paper, a response to a reply that was
17 due, and the deadline has been extended.

18 Does the board have any thoughts on how we
19 should handle that? The issue we face is that since we
20 believe the case is stayed and we believe there's an
21 order that applies to this case, and that we're not
22 allowed to take action inconsistent with that order.

23 There's an order the bankruptcy court has
24 issued that says administrative actions are stayed. And
25 given that we are not permitted to take action

13

1 inconsistent with that order, does it make sense for our
2 deadline to be tolled until we've had a chance to update
3 the board further on what happens in the bankruptcy
4 court?

5 JUDGE NEWMAN: So we -- we are not able to stay
6 it before the April 4th deadline, as I explained
7 earlier.

8 We can hold it as close to the deadline as we
9 can before issuing any decision, and because we have a
10 little bit of time there, our hope is that you would be
11 able to get the clarification from the bankruptcy court
12 confirming that the IPRs are also stayed. And then at
13 that point, no deadline would go further, including the
14 March 4th deadline.

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15 Does that make sense?

16 MR. WALTER: I think it does. If we can have
17 clarity that there is no deadlines that go forward, that
18 would be -- that would be helpful, so that we are not
19 deemed to have blown any sort of deadline.

20 JUDGE NEWMAN: I think we can reset that
21 deadline. I will -- I need to confer with the panel
22 briefly before we complete all of this, but I think we
23 can agree to at least reset that deadline to a later
24 time in March, if there's -- if there is no
25 clarification from the bankruptcy court, that is -- I

14

1 think that's about all we can do.

2 MR. WALTER: Okay. All right. And one more
3 point I want to ask. We do have the benefit of
4 bankruptcy counsel that is with us here on the board,
5 and I don't know if the board would appreciate hearing
6 from our bankruptcy counsel on whether there's any
7 barriers or issues with the proposed path you suggested,
8 which is that we go to the board and petition -- excuse
9 me, go to the bankruptcy court and petition the
10 bankruptcy court for guidance on whether the stay
11 applies.

12 And the -- would it make sense for the board to
13 hear any comments from a bankruptcy counsel on that
14 point?

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15 JUDGE NEWMAN: Yes, we welcome any comments.

16 MR. WALTER: Okay. I will hand it over to our
17 bankruptcy counsel, and to be clear, I don't know if
18 they have any specific comments; if they have specific
19 points they want to raise, I want to let them raise that
20 in connection with this issue.

21 JUDGE NEWMAN: All right. And, Counsel, please
22 identify yourself for the court reporter before
23 speaking.

24 MS. SINCLAIR: Good afternoon, Your Honor, this
25 is Debra Sinclair from Willkie Farr & Gallagher. We

15

1 have heard your comments on filing a motion for clarity
2 with the bankruptcy court. The one comment that I
3 wanted to make in that vein, which my co-counsel,
4 Mr. Walter, alluded to, is that the bankruptcy court did
5 enter an order at the beginning of the cases on
6 February 6th that restates and enforces the protection
7 of Section 362 of the bankruptcy code.

8 We're happy to make sure the board gets a copy
9 of this order as well, but I'd like to highlight for the
10 board that the order does say that "pursuant to and to
11 the extent set forth in Section 362 of the bankruptcy
12 code, the commencement of the Chapter 11 cases operate
13 as a stay of the commencement or continuation of all
14 judicial administrative or other actions or proceedings
15 against the debtors."

16 So I just wanted to make sure that the board,
17 before we all get off this call, is aware that there is
18 a bankruptcy court order to that effect. Obviously, it
19 did not specifically address the IPRs that are in front
20 of you, and we understand that you would like specific
21 clarification on those.

22 But there is an order that restates and
23 enforces that particular provision of the bankruptcy
24 code.

25 JUDGE NEWMAN: Thank you. I am familiar with

16

1 those types of orders and familiar with the language and
2 appreciate you addressing that.

3 But we continue to take the position that we
4 need further clarification.

5 MS. SINCLAIR: Yes, Your Honor. I don't have
6 anything else to --

7 (Indiscernible crosstalk.)

8 MS. SINCLAIR: -- add on that point.

9 Although I am happy to answer any questions the
10 Court has, but that is the only clarification I wanted
11 to make for the record.

12 JUDGE NEWMAN: I suggest that you file those
13 orders in the cases so that we have --

14 MR. WALTER: Your Honor, they already have been
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15 filed.

16 JUDGE NEWMAN: Okay. They were filed. All
17 right.

18 I don't think we have any further questions.
19 Let me just -- I am going to go on mute for a moment and
20 confer with my counsel.

21 Unless, Petitioners, do you have anything to
22 say?

23 MR. HOLMAN: Yes, Your Honor. This is David
24 Holman for Petitioner, just a quick comment.

25 As counsel for Patent Owner pointed out,

17

1 Petitioner takes no position on whether the bankruptcy
2 court's automatic stay under Section 362 of the
3 bankruptcy code includes these IPRs.

4 And while Petitioner did file a motion in
5 bankruptcy court yesterday to lift the stay, that was
6 filed with respect to certain district court actions, as
7 well as these IPRs.

8 But just to be clear, Patent Owner's
9 characterization of the motion was not quite accurate.

10 Petitioner had to file this motion yesterday in
11 order for the motion to be heard at an upcoming hearing
12 in the bankruptcy court, which is in early March -- I
13 believe March 7th.

14 And so Petitioner included the IPRs in its
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15 motion, motion to lift the stay, as a precaution because
16 it is unclear right now whether these IPRs are stayed.

17 So, you know, if this board agrees with that,
18 Your Honor, and gets a -- you know, confirmation from
19 the bankruptcy court that these IPRs are stayed,
20 Petitioner will, of course, follow the board's
21 direction. And as we've established on the record
22 today, the petitioner is already beginning to seek the
23 process of seeking relief in the bankruptcy court.

24 On the other hand, if the board disagrees with
25 Patent Owner or, you know, determines that the stay does

18

1 not apply to these IPRs and Petitioner, we'll, of
2 course, file the board's direction in that regard and
3 proceed accordingly. And Petitioner can then amend its
4 motion to lift the stay in bankruptcy court as needed.

5 So ultimately, Petitioner is taking no position
6 on whether the stay applies to these IPRs, and we will
7 await the board's decision on how the parties should
8 proceed.

9 I do have one other -- Petitioner has one other
10 issue to raise that we would like the board's guidance
11 on.

12 It is related to these cases, but it's -- it
13 involves the district court's claim construction order.
14 Is -- the district court, in the parallel litigation
15 involving these patents, issued its claim construction
16 order on February 1st, which is just a couple weeks ago.

17 And Patent Owner contacted -- excuse me,
18 Petitioner contacted Patent Owner that Tuesday to offer
19 to jointly notify this board about the claim
20 construction -- or the district court's claim
21 construction order and offered to submit it as an
22 exhibit in the IPRs. But on the same day, that was when
23 Patent Owner filed its notices of bankruptcy, and so the
24 Patent Owner informed Petitioner that it believed the
25 IPRs were stayed.

19

1 So it kind of -- kind of left Petitioner in a
2 little bit of a conundrum, in that on one hand, parties
3 are obligated to -- you know, follow the duty of
4 disclosure and candor to provide the board with this
5 claim construction order.

6 But on the other hand, Petitioner doesn't want
7 to be subject to an argument that we've somehow violated
8 the automatic stay if these IPRs were indeed stayed.

9 So we would appreciate the board's guidance on
10 whether we can table the submission of the district
11 court claim construction issue until the stay issue is
12 resolved, or if the board has any other recommendations,
13 we would appreciate it.

14 JUDGE NEWMAN: All right. Any response on that
15 issue from Patent Owner?

16 MR. WALTER: Yes. As I stated earlier, we view
17 ourselves as being subject to the order of the
18 bankruptcy court. We're not -- pursuant to that order,
19 we are not supposed to be making filings in this case,
20 because we think there's a stay.

21 I think the best way to handle it is to table
22 it for now and, you know, the -- the petitioner has
23 raised its concern that it will be subject to some sort
24 of criticism that it didn't promptly file the claim
25 construction order. I don't think there's any risk of

20

1 that. I suggest we table it until we get further
2 clarity on that point.

3 JUDGE NEWMAN: Thank you. Okay. I am going to
4 go on mute for a moment here while I confer with
5 counsel, and I will get back to you in just a moment.
6 Hold tight.

7 (Recess.)

8 JUDGE NEWMAN: All right. Counsel, this is
9 Judge Newman. Thank you for your patience.

10 We would like to suggest that Petitioner file
11 the claim construction order as an exhibit in both
12 cases, and also we would appreciate the -- being kept
13 apprised of the motion to lift the stay, and the easiest
14 method for that would seem to also be to file those as
15 exhibits in the -- in the cases.

16 Subject to that, we would continue to ask that
17 Patent Owner seek clarification from the bankruptcy
18 court on the applicability of the stay to the IPRs, and
19 we will get started requesting six-month extension for
20 good cause on the 1298 case.

21 And with that, I don't think we have anything
22 further for today, unless someone has something to add.

23 MR. WALTER: Nothing for Patent Owner, Your
24 Honors.

25 JUDGE NEWMAN: All right. Thank you very much

1 for your time.

2 Yes, go ahead.

3 MR. HOLMAN: Sorry. This is David Holman for
4 Petitioner, and I apologize I don't have the transcript
5 in front of me, because we don't have it yet.

6 What was the decision on Patent Owner's
7 surreply that is due in the 1300 case?

8 JUDGE NEWMAN: We will be issuing a --

9 MR. HOLMAN: That I think you said -- sorry, go
10 ahead.

11 JUDGE NEWMAN: We will be issuing an order that
12 will recap what happened today at the call, and then we
13 will include in that order a new deadline for
14 Petitioner's reply.

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15 MR. HOLMAN: Okay. Thank you. I think you
16 meant patent surreply; is that correct?

17 JUDGE NEWMAN: Yes. I'm sorry. Yes, the
18 surreply.

19 MR. HOLMAN: Okay.

20 JUDGE NEWMAN: And as a further exhibit, if
21 Patent Owner does seek clarification from the bankruptcy
22 court, we would appreciate that -- that paper also being
23 filed as an exhibit in the cases so that way we are kept
24 apprised.

25 MR. WALTER: Understood. Thank you, Your

Honors.

JUDGE NEWMAN: Thank you for your time today.

We are adjourned.

(The deposition was concluded
at 1:29 p.m.)

1 STATE OF CALIFORNIA)
2) ss.
3 COUNTY OF ORANGE)

4 I, LINDSAY ANNE STOKER, RMR, CRR, CRC, and
5 Certified Shorthand Reporter and Deposition Notary
6 Public of the State of California, does hereby certify:

7 That the foregoing deposition was taken
8 before me at the time and place therein set forth, at
9 which time the witness was duly sworn by me;

10 That the testimony of the witness and all
11 objections made at the time of the deposition were
12 recorded stenographically by me and were thereafter
13 transcribed, said transcript being a true and correct
14 copy of the proceedings thereof;

15 I further certify that I am neither counsel for
16 nor related to any party to said action, nor in any way
17 interested in the outcome thereof;

18 Further, that if the foregoing pertains to the
19 original transcript of a deposition in a federal case,
20 before completion of the proceedings, review of the
21 transcript was not requested/offered on the record.

22 In witness whereof, I have subscribed my name,
23 this 27th day of February, 2024.

24



25

Lindsay A. Stoker, RMR, CRR, CRC

1 10x 9:20 10:3,11,13,19 11:11,21 11 15:12 1298 8:11,21 20:20 1300 8:8 9:3 12:12 18-month 9:11 1st 18:16 2 2024 9:4 3 314(b) 8:6 316(a)11 8:14 35 8:14 362 10:22 11:18 12:1 15:7,11 17:2 37 8:18 4 42.100 8:18 4th 9:4 13:6,14 6 6th 15:6 7 7th 11:15 17:13 A ability 7:19 accepted 11:19 accurate 17:9 acknowledges 10:4 action 12:22,25 actions 12:24 15:9,11,17,18 www.lexitasLegal.com/Premier add 16:8 20:22 additional 8:15	address 15:19 addressing 16:2 administrative 7:7 8:19,23 12:24 15:14 advisement 6:15 advising 8:3 affirmed 10:25 afternoon 14:24 agency 7:7,18 agree 11:4 13:23 agreed 10:19 11:5 agreeing 11:12 agreement 12:5 agrees 17:17 AIA 7:3 allowed 12:22 alluded 15:4 amend 18:3 anymore 11:18 applicability 20:18 application 8:1 applies 7:3,24 10:4,17,20 11:4 12:2, 21 14:11 18:6 apply 10:5,8,10,18,23 11:12,18,19,23 18:1 apprised 20:13 April 9:4 13:6 argue 11:23 argued 11:22 argument 10:13 19:7 assumption 10:18 attendees 6:9 authority 7:11 8:4,14,18 9:2 authorize 9:24 automatic 6:25 7:3,24 17:2 19:8 await 18:7 aware 15:17 B back 20:5	background 9:13 balance 10:13 bankruptcy 6:12,22 7:3,5,8,10,13, 16,21,22,24,25 8:25 9:1,9,15,20 11:5, 8,12,25 12:7,23 13:3,11,25 14:4,6,9, 10,13,17 15:2,4,7,11,18,23 17:1,3,5, 12,19,23 18:4,23 19:18 20:17 barriers 14:7 based 10:7,8,12 11:16,17 basis 10:21 beginning 15:5 17:22 behalf 8:13 12:4 believed 18:24 benefit 9:23 14:3 bit 6:16 13:10 19:2 blown 13:19 board 9:18,23,24 11:1,20,24 12:18 13:3 14:4,5,8,12 15:8,10,16 17:17,24 18:19 19:4,12 board's 17:20 18:2,7,10 19:9 bound 12:5 briefly 13:22 C call 10:24 15:17 candor 19:4 case 6:23 7:2 8:8,11,21 9:3,8,10 12:12,20,21 19:19 20:20 cases 15:5,12 16:13 18:12 20:12,15 CFR 8:18 chance 6:18 13:2 Chapter 15:12 characterization 17:9 chief 8:19,22 Circuit 7:9 Circuit's 7:1 claim 18:13,15,19,20 19:5,11,24 20:11 clarification 7:22 12:3,7 13:11,25 15:21 16:4,10 20:17 clarity 13:17 15:1 20:2
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clear 14:17 17:8 close 13:8 co-counsel 15:3 code 7:5,8,10 15:7,12,24 17:3 commencement 15:12,13 comment 15:2 16:24 comments 14:13,15,18 15:1 complete 13:22 concern 19:23 confer 10:25 13:21 16:20 20:4 confirm 6:8 confirmation 17:18 confirmed 6:12 confirming 8:25 13:12 connection 10:1 14:20 construction 18:13,15,20,21 19:5, 11,25 20:11 construe 7:14 contacted 18:17,18 contention 10:7,9,21 11:17 continuation 15:13 continue 16:3 20:16 contrary 10:24 conundrum 19:2 copy 15:8 correspondence 11:1 counsel 6:1,12 14:4,6,13,17,21 16:20,25 20:5,8 couple 18:16 court 7:21,22 8:1,25 9:9,15,20 11:5, 8,13 12:1,7,23 13:4,11,25 14:9,10,22 15:2,4,18 16:10 17:5,6,12,19,23 18:4, 14 19:11,18 20:18 court's 17:2 18:13,20 criticism 19:24 crosstalk 16:7	deadline 8:5 9:11,12 12:17 13:2,6,8, 13,14,19,21,23 deadlines 13:17 dealing 7:7 Debra 14:25 debtors 15:15 decide 8:1 11:6 decided 11:14,15 decision 7:6 8:16 9:3,12 13:9 18:7 deemed 13:19 delegates 8:18 Derek 6:6 desires 8:20 determination 8:25 determine 8:5 determines 17:25 development 9:18 direction 17:21 18:2 director 8:12,13,22 disagrees 17:24 disclosure 19:4 district 17:6 18:13,14,20 19:10 due 12:17 duty 19:3	exhibit 18:22 20:11 exhibits 20:15 explained 13:6 extend 8:5 extended 12:17 extension 8:11,14,21 9:8 12:11,13 20:19 extent 15:11
	E	F
	earlier 13:7 19:16 early 17:12 easiest 20:13 effect 6:23 8:23 15:18 effectively 10:3 11:11 elect 9:5 elected 6:13 enforces 15:6,23 enter 15:5 entertain 9:6 established 17:21 exception 10:9 excuse 14:8 18:17	face 12:19 fact 10:11 11:21 fairly 11:18 familiar 15:25 16:1 Farr 14:25 February 15:6 18:16 Federal 7:1,9 feeling 7:6 file 6:13 10:5 11:24 16:12 17:4,10 18:2 19:24 20:10,14 filed 9:20 10:12 11:22 16:15,16 17:6 18:23 filing 10:3 15:1 filings 19:19 final 8:16 9:12 follow 17:20 19:3 forward 13:17 framework 10:17 11:17 front 15:19
		G
		Gallagher 14:25 give 6:16,17 8:11 9:7 good 8:7,11,16,20,21 9:7 14:24 20:20 guidance 14:10 18:10 19:9
		H
David 6:7 16:23 day 18:22		hand 14:16 17:24 19:2,6

handle 12:19 19:21 happened 9:22 happy 8:22 9:22 15:8 16:9 hardship 10:14 hardships 10:13 hear 10:23 14:13 heard 15:1 17:11 hearing 14:5 17:11 helpful 13:18 highlight 15:9 highly 10:1 hold 13:8 20:6 holding 7:1,23 Holman 6:7 16:23,24 Honor 6:2,7 9:17 14:24 16:5,14,23 17:18 Honors 11:9 20:24 hope 13:10 I identified 6:20 identify 14:22 important 9:18 10:6 included 17:14 includes 17:3 including 13:13 inconsistent 12:22 13:1 indicating 7:12 indication 7:25 indiscernible 16:7 information 6:16 informed 7:1 9:19 18:24 instance 9:10 institute 8:6 9:6 instituted 8:9,10 12:10 inter 8:6 interpret Lexipol.com/Premier interpretation 7:4,17 12:6 involves 18:13	involving 18:15 IPR 9:21 10:12,23 12:2,9 IPRS 7:12,16,24 9:1 13:12 15:19 17:3,7,14,16,19 18:1,6,22,25 19:8 20:18 issue 6:13,15,23 8:16 9:11 11:2 12:15,19 14:20 18:10 19:11,15 issued 12:24 18:15 issues 6:12 9:16 14:7 issuing 13:9 J jointly 18:19 judge 6:10 8:19,23 12:4 13:5,20 14:15,21 15:25 16:12,16 19:14 20:3, 8,9,25 judicial 15:14 K key 9:25 kind 19:1 L language 16:1 law 7:7 12:6 left 7:10 19:1 legal 10:17 11:25 12:1 lift 9:21 10:7,11 11:6,13 17:5,15 18:4 20:13 lifted 10:15,16,21 11:8,10 list 6:3,9 litigation 18:14 M made 10:1 major 11:3 make 7:17 12:10 13:1,15 14:12 15:3, 8,16 16:11 making 19:19 Lexitas March 11:15 13:14,24 17:12,13	matter 10:22 meantime 8:3 meet 10:25 12:14 method 20:14 mind 11:21 12:8 moment 16:19 20:4,5 months 8:15 motion 9:20 10:3,5,7,8,11 11:13,16, 22,25 15:1 17:4,9,10,11,15 18:4 20:13 mute 16:19 20:4 N Nanostring 10:15 needed 18:4 Newman 6:10 12:4 13:5,20 14:15,21 15:25 16:12,16 19:14 20:3,8,9,25 night 9:20,22 normal 10:16 note 6:20 noticed 7:9 notices 18:23 notify 18:19 number 9:25 O obligated 19:3 obvious 11:7 offer 18:18 offered 18:21 open 7:4,11 operate 15:12 order 7:23 8:23 12:21,22,23 13:1 15:5,9,10,18,22 17:11 18:13,16,21 19:5,17,18,25 20:11 orders 16:1,13 outstanding 12:16 outweighs 10:14 Owner 6:2,19,20 7:12,20 8:13,20 9:7, 14 16:25 17:25 18:17,18,23,24 19:15 20:17,23
--	---	---

Owner's 17:8 P panel 12:4 13:21 panels 6:21,24 paper 12:16 parallel 18:14 partes 8:6 parties 18:7 19:2 party's 12:5,6 past 6:21,25 patent 6:2,19,20,23 7:7,12,20 8:13, 19,20,23 9:7,14 16:25 17:8,25 18:17, 18,23,24 19:15 20:17,23 patentor's 6:11 patents 18:15 path 14:7 patience 20:9 permitted 12:25 petition 7:21 14:8,9 petitioner 6:8,9,12 16:24 17:1,4,10, 14,20,22 18:1,3,5,9,18,24 19:1,6,22 20:10 Petitioners 16:21 pharma 7:2 place 11:5 plan 11:1 point 6:17 9:5 11:3 13:13 14:3,14 16:8 20:2 pointed 16:25 points 9:25 14:19 position 6:25 7:15 9:2,10,16 16:3 17:1 18:5 positions 6:22 precaution 17:15 prefer 12:6 previous 7:2 proceed 18:3,8 proceedings 7:3 8:10 9:21 10:12,23 12:2 15:14 process 17:23	promptly 19:24 proposed 14:7 protection 7:21 9:14 15:6 provide 8:15 19:4 provision 15:23 pursuant 15:10 19:18 Q question 7:2,4,11 10:19 12:1 questions 9:15 16:9,18 quick 16:24 R raise 14:19 18:10 raised 19:23 reach 9:5 reaches 9:10 Recess 20:7 recommendations 19:12 record 6:5 16:11 17:21 regard 18:2 related 6:23 9:19 18:12 relevant 10:2 relief 17:23 remaining 7:10 render 9:3 reply 12:16 reporter 6:4 12:3 14:22 request 9:6 11:9 12:10,13 requesting 20:19 requires 7:4 reset 13:20,23 resolved 19:12 respect 8:8 10:12 12:9,12 17:6 respond 6:18 response 12:16 19:14 restates 15:6,22 review 8:6	reviewed 6:11 risk 19:25 ruling 11:25 S section 8:7 10:22 11:18 12:1 15:7,11 17:2 seek 17:22 20:17 seeking 7:20 9:14 10:16 17:23 sense 12:10 13:1,15 14:12 separate 11:24 set 15:11 showing 8:7,12 shown 8:17 silent 11:2 simply 7:17 Sinclair 14:24,25 16:5,8 six-month 8:11,21 9:7 12:11 20:19 sort 10:9 11:25 13:19 19:23 speaking 14:23 specific 14:18 15:20 specifically 15:19 started 20:19 stated 19:16 statement 7:23 statute 7:13 statutory 8:4 9:2,11 10:10,17,20 11:17 stay 6:22,25 7:3,13,16,24 9:1,21 10:4,7,8,10,11,15,16,17,18,20 11:1,4, 6,8,10,12,13,15,22,23 13:5 14:10 15:13 17:2,5,15,25 18:4,6 19:8,11,20 20:13,18 stayed 7:12 12:20,24 13:12 17:16,19 18:25 19:8 subject 7:16 9:1 19:7,17,23 20:16 submission 19:10 submit 9:22 18:21 suffer 10:14 suggest 12:9 16:12 20:1,10 suggested 14:7
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suggests11:24 summarize6:11 supposed19:19 T table19:10,21 20:1 takes17:1 taking7:15 18:5 team12:14 thinking6:17 thoughts12:18 threshold10:22 tight20:6 time8:16 13:10,24 today17:22 20:22 tolled13:2 trial9:6 Tuesday18:18 turn9:13 type8:13,24 types16:1 U ultimate9:11 ultimately18:5 unaware8:4 unclear17:16 understand6:24 15:20 understanding11:14 upcoming17:11 update13:2 USC8:14 V vein15:3 view19:16 www.LexitasLegal.com/Premier violated19:7	W Walter6:2,6 9:17 12:8 13:16 14:2,16 15:4 16:14 19:16 20:23 wanted15:3,16 16:10 weeks18:16 Willkie14:25 words10:15 written8:16 9:12 Y yesterday17:5,10 Lexitas	
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EXHIBIT E

February 24, 2024 Email from 10x's Counsel to Debtors' Counsel

From: Kim.posin@lw.com
To: [Sinclair, Debra](#)
Cc: [Strickland, Rachel](#); Brian.Rosen@lw.com
Subject: RE: NanoString/10x
Date: Saturday, February 24, 2024 4:02:56 PM

*** EXTERNAL EMAIL ***

Hi Debbie:

As I mentioned in my email to you and Rachel on Thursday (see text below), 10x does not concede that the stay applies to the IPRs:

“10x also intends to seek relief from the stay to allow the following *inter parties* review proceedings pending in the PTAB to continue (even though it is unclear at this point whether those actions are actually stayed and 10x doesn’t concede that they are): IPR2023-01298 and IPR2023-01300.”

In that regard, I’m not sure 10x would be in a position to enter into a stipulation with NanoString. However, we can speak to our client as to whether they would agree not to oppose a request for clarification.

Best,
Kim

Kimberly A. Posin

Pronouns: She/Her/Hers

LATHAM & WATKINS LLP

355 South Grand Avenue, Suite 100

Los Angeles, CA 90071-1560

Direct Dial: +1.213.891.7322

Email: kim.posin@lw.com

<https://www.lw.com>

From: Sinclair, Debra <DSinclair@willkie.com>

Sent: Saturday, February 24, 2024 12:40 PM

To: Posin, Kimberly (LA) <Kim.posin@lw.com>

Cc: Strickland, Rachel <RStrickland@willkie.com>; Rosen, Brian (NY) <Brian.Rosen@lw.com>

Subject: NanoString/10x

Kim,

I am writing regarding the parties’ conference with the Patent Trial and Appeal Board yesterday. I don’t know if you were in attendance, but 10x’s counsel in the IPR cases took the position that it is “unclear” whether the stay applies to those actions, and that 10x filed its motion to lift the stay

concerning the IPR actions merely as a “precaution.” We were surprised to hear that because we have discussed stay issues on several occasions and you never mentioned that was 10x’s position.

In any event, the PTAB ordered the Debtors to seek a “clarification” from the Bankruptcy Court regarding whether the stay applies to the IPRs. Our thought was that we could prepare a stipulated order and present that jointly for the Bankruptcy Court’s approval. We do not want to spend estate resources and burden the Court with unnecessary motions. Please let us know if that works.

Thanks.

Debbie

Debra McElligott Sinclair

Willkie Farr & Gallagher LLP

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EXHIBIT F

Collegium Opinion

**United States Court of Appeals
for the Federal Circuit**

**PURDUE PHARMA L.P., PURDUE
PHARMACEUTICALS L.P.,**
Appellants

v.

COLLEGIUM PHARMACEUTICAL, INC.,
Appellee

**KATHERINE K. VIDAL, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE,**
Intervenor

2022-1482

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. PGR2018-
00048.

Decided: November 21, 2023

JENNIFER L. SWIZE, Jones Day, Washington, DC, ar-
gued for appellants. Also represented by GREGORY A.
CASTANIAS, JOHN R. BOULE, III; GASPER LAROSA, JOHN
JOSEPH NORMILE, JR., New York, NY; PABLO DANIEL
HENDLER, Potomac Law Group PLLC, New York, NY.

2 PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC.

CHRISTOPHER A. PINAHS, Robins Kaplan LLP, Minneapolis, MN, argued for appellee. Also represented by JACOB M. HOLDREITH, BRENDA L. JOLY, EMILY TREMBLAY; OREN D. LANGER, New York, NY.

FARHEENA YASMEEN RASHEED, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by PETER J. AYERS, MAUREEN DONOVAN QUELER.

Before DYK, HUGHES, and STOLL, *Circuit Judges*.

DYK, *Circuit Judge*.

Purdue Pharma L.P. (“Purdue”) appeals from a judgment of the Patent Trial and Appeal Board (“Board”) finding claims 1–17 of U.S. Patent No. 9,693,961 (“’961 patent”) unpatentable for lack of written description and anticipation. The Board issued its Final Written Decision after the statutory deadline, concluding that the passing of the deadline did not deprive it of authority. Purdue contends the Board lost jurisdiction once the deadline passed, and that, if the Board did not lose jurisdiction, the Board’s decision was incorrect. We affirm.

BACKGROUND

Purdue is the owner of the ’961 patent which issued on July 4, 2017. The patent is titled “Pharmaceutical Formulation Containing Gelling Agent” and is meant to “prevent[] or deter[] the abuse of opioid analgesics by the inclusion of at least one aversive agent in the dosage form.” ’961 patent, col. 5, ll. 54–56. Specifically, the addition of an aversive agent “helps to prevent injection, inhalation, and/or oral abuse by decreasing the ‘attractiveness’ of the dosage form to a potential abuser.” *Id.* at col. 2, ll. 59–61. Representative claim 1 recites:

1. A method of preparing an abuse deterrent controlled release dosage form comprising:

combining oxycodone or a pharmaceutically acceptable salt thereof as active agent, polyglycolized glycerides, a C₁₂ to C₄₀ fatty acid or a mixture thereof, carnauba wax and beeswax, to form a homogenous mixture, wherein the oxycodone or pharmaceutically acceptable salt thereof is the sole active agent in the dosage form;

preparing particles from the homogenous mixture; and containing the particles in a capsule;

the abuse deterrent dosage form providing a therapeutic effect for about 12 hours or longer when orally administered to a human patient, and

the abuse deterrent dosage form being abuse deterrent when subjected to tampering comprising heating at a temperature greater than about 45° C.

Id. at col. 41, ll. 37–52.

Purdue brought suit against Collegium Pharmaceutical, Inc. (“Collegium”) for infringement of the ’961 patent in September 2017. On March 13, 2018, Collegium petitioned the Board for post grant review (“PGR”) of claims 1–17 of the ’961 patent. The district court infringement case proceeded in parallel to the PGR.

In the PGR, Purdue argued that the ’961 patent was not subject to PGR as it claimed priority to an August 6, 2001, application, and applications filed before March 16, 2013, were not subject to PGR. The Board found the challenged claims eligible for PGR because the pre-America Invents Act (“AIA”) application to which Purdue claimed

4 PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC.

priority did not contain sufficient written description support for the claimed invention, and the effective filing date was therefore after March 16, 2013. Based on that finding, and a finding of likely lack of sufficient written description in the '961 patent itself, the Board instituted PGR. Under 35 U.S.C. § 326(a)(11) and 37 C.F.R. § 42.200(c), the Board had one year to issue a Final Written Decision subject to a six-month extension for “good cause.”

On September 24, 2019, Purdue filed a Notice of Bankruptcy Filing and Imposition of Automatic Stay. The Board subsequently stayed the PGR proceeding, and the parallel district court case was also stayed.

The one-year deadline fell on October 4, 2019. Before the deadline, on October 2, 2019, the Chief Administrative Patent Judge found good cause to grant a six-month extension so the bankruptcy court could assess whether the automatic stay applied to PGRs. Petitioner Collegium took the position that the Automatic Stay provision was not applicable to Board proceedings. Purdue contended that the bankruptcy automatic stay applied to PGRs. The Board advised that “Petitioner should seek any relief it deems appropriate from the Bankruptcy Court.” J.A. 868.

Neither party sought guidance from the bankruptcy court nor asked the bankruptcy court to lift the stay during the six-month extension period. The April 4, 2020, extended deadline passed. On July 2, 2020, Purdue moved at the bankruptcy court for the automatic stay to be partially lifted so the district court case could proceed. Collegium opposed the request and argued that if the stay were lifted for the district court case, it should also be lifted for the PGR proceeding. The bankruptcy court lifted the stay for both the district court case and the PGR proceeding on September 1, 2020.

On September 11, 2020, Purdue filed a motion to terminate the PGR proceeding, arguing the Board no longer had the authority to issue a Final Written Decision as the

18-month deadline had passed. On November 19, 2021, the Board denied Purdue's motion, explaining that "[a]pplying the principles from the Supreme Court cases assessing statutes without consequences for noncompliance with time limits, we hold that, under the circumstances of this case, the AIA's silence as to a consequence for timely issuing a final written decision does not divest us of our authority to issue our final written decision." J.A. 78. That same day the Board issued its Final Written Decision, finding claims 1–17 of the '961 patent unpatentable for lack of written description and anticipation.¹

Purdue appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).²

¹ The anticipation finding flowed from the lack of written description in the claimed priority application.

It is unclear why the Board took over a year after the stay was lifted to issue its Final Written Decision. As an intervenor in the case, the Patent and Trademark Office ("PTO") claims it was the result of Purdue's late argument that the Board lacked authority to issue a Final Written Decision, which necessitated more briefing. Additionally, because of the length of this PGR proceeding, there was turnover in the panel, and two panel change orders were issued.

² Collegium argues that Purdue's appeal was not timely as it occurred more than sixty-three days after the Board issued its Final Written Decision. We disagree that Purdue solely sought review of the motion to terminate, which Collegium argues is subject to a fourteen-day deadline pursuant to 37 C.F.R. § 42.71(d)(1). Purdue also sought Director review of the Final Written Decision which, contrary to Collegium's argument, was subject to a thirty-day deadline. This tolled Purdue's time to appeal, and once the Director denied review on February 7, 2022, Purdue timely appealed on February 16, 2022.

DISCUSSION

I

Purdue contends that if the Board fails to meet the deadline established by 35 U.S.C. § 326(a)(11) and 37 C.F.R. § 42.200(c) (one year plus the six-month extension), the Board no longer has the authority to issue a Final Written Decision. This appears to be the only proceeding in which the Board has failed to meet the statutory deadline, and this is accordingly a matter of first impression. Statutory interpretation is an issue of law reviewed de novo. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1330 (Fed. Cir. 2020).

Section 326(a)(11) of Title 35 provides:

(a) Regulations—The Director shall prescribe regulations—

...

(11) requiring that the final determination in any post-grant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c).]

And 37 C.F.R. § 42.200(c) provides:

(c) A post-grant review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC. 7

The Supreme Court has established that “if a statute does not specify a consequence for non-compliance with statutory timing provisions, the federal courts will not in the ordinary course impose their own coercive sanction.” *United States v. James Daniel Good Real Prop.*, 510 U.S. 43, 63 (1993); *see also Nielsen v. Preap*, 139 S. Ct. 954, 967 (2019); *Dolan v. United States*, 560 U.S. 605, 611 (2010); *Barnhart v. Peabody Coal Co.*, 537 U.S. 149, 159 (2003); *Regions Hosp. v. Shalala*, 522 U.S. 448, 459 n.3 (1998); *United States v. Montalvo-Murillo*, 495 U.S. 711, 717 (1990). We have “faithfully applied this rule of law as formulated by the Supreme Court . . . that, ‘even in the face of a statutory timing directive, when a statute does not specify the consequences of non-compliance, courts should not assume that Congress intended that the agency lose its power to act.’” *Hitachi Home Elecs. (Am.), Inc. v. United States*, 661 F.3d 1343, 1347 (Fed. Cir. 2011) (quoting *Liesegang v. Sec’y of Veterans Affs.*, 312 F.3d 1368, 1376–77 (Fed. Cir. 2002)); *see also Transpacific Steel LLC v. United States*, 4 F.4th 1306, 1320–21 (Fed. Cir. 2021). Where “the statute does not specify” the “consequences of the missed deadline . . . [the Supreme] Court has looked to statutory language, to the relevant context, and to what they reveal about the purposes that a time limit is designed to serve,” in order to determine the impact of the deadline. *Dolan*, 560 U.S. at 610. The statute at issue here does not provide consequences for non-compliance with the deadline.

Thus, following the Supreme Court’s rule, the Board has authority to issue a Final Written Decision even after the deadline proscribed in the statute has passed absent any contrary indication in the language, structure, or legislative history of the statute.

A

Purdue argues there are indications in the statutory language that support the view that the Board loses its

authority to issue a Final Written Decision after the deadline expires.

First, Purdue argues that the use of “shall” and “requiring” in section 326(a)(11) deprives the Board of authority to issue a Final Written Decision after the deadline. Purdue’s argument is contrary to the Supreme Court’s decision in *Brock*. In *Brock*, the Court held the “requirement that the Secretary ‘shall’ take action within 120 days does not, standing alone, divest the Secretary of jurisdiction to act after that time.” *Brock v. Pierce Cnty.*, 476 U.S. 253, 266 (1986). Purdue contends that *Brock* is distinguishable because the statute contains more than just “shall . . . standing alone,” *see id.*, because it reads the “Director *shall* prescribe regulations— . . . *requiring* that the final determination in any post-grant review be issued not later than 1 year.” 35 U.S.C. § 326(a)(11) (emphases added). The word “requiring” simply is the equivalent of “shall,” and *Brock* governs.

Second, Purdue, relying on *French v. Edwards*, 80 U.S. 506 (1871), contends that the “negative words” of “not later than 1 year” and “by not more than 6 months” in section 326(a)(11) show “the acts required shall not be done in any other manner or time than that designated.” *Id.* at 511. But *French* did not involve a statutory deadline, and in later cases, the Supreme Court has held that similar statutory language as that involved here does not result in a loss of authority. *Barnhart*, 537 U.S. at 161 (statute set the deadline as “not later than 60 days after the enactment date”); *Dolan*, 560 U.S. at 607 (statute required action “not to exceed 90 days after sentencing”). Similarly, we have held that a statute containing “not later than” created “timing provisions [that] are at best precatory rather than mandatory.” *Liesegang*, 312 F.3d at 1371, 1377.

Third, Purdue contends the statutory language bars action after the statutory deadline because section 326(a)(11) is linked to the Board’s jurisdictional grant in section 6 of

35 U.S.C. Section 326(c) provides that “[t]he Patent Trial and Appeal Board shall, *in accordance with section 6*, conduct each post-grant review instituted under this chapter” (emphasis added). The Board has identified section 6 as the source of its jurisdiction, *see* J.A. 3, thus Purdue argues that when the deadline in section 326(a)(11) passes, the Board’s jurisdiction also expires. This is not correct. The Supreme Court has “repeatedly held that procedural rules, including time bars, cabin a court’s power only if Congress has ‘clearly state[d]’ as much” and “absent such a clear statement, . . . ‘courts should treat the restriction as non-jurisdictional.’” *United States v. Wong*, 575 U.S. 402, 409 (2015) (alteration in original) (quoting *Sebelius v. Auburn Reg’l Med. Ctr.*, 568 U.S. 145, 153 (2013)). The mere mention that PGRs shall be conducted “in accordance” with section 6 or PGRs be conducted “pursuant to” chapter 32 does not rise to the level of a clear statement that section 326(a)(11) is jurisdictional.

Fourth, Purdue argues that the exceptions in section 326(a)(11) for “good cause” and “joinder” show those are the only two limited circumstances under which the Board may issue a Final Written Decision after the one-year deadline.³ Purdue further argues this precludes recognizing other exceptions, relying on *United States v. Johnson*, 529 U.S. 53, 58 (2000). The existence of statutory exceptions does not show that the Board is without authority to act once the deadline passes. In *Barnhart*, the statute provided for two exceptions to the deadline and the Court ultimately held the “[i]nitial assignment[s] made after [the deadline were] valid despite [their] untimeliness.”

³ Section 326(a)(11) provides two exceptions to the one-year deadline. “[T]he Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c).”

10 PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC.

Barnhart, 537 U.S. at 152.⁴ The Court found that “enunciation of two exceptions does not imply an exclusion of a third,” “nor does it require the absolute finality of assignments urged by the companies.” *Barnhart*, 537 U.S. at 170–71. Thus, exceptions to the deadline do not strip the Board of authority to issue a Final Written Decision after the deadline passed.

Finally, it is significant that section 328(a) mandates that the Board issue a Final Written Decision. And other provisions of the AIA use quite different language to bar action after deadlines pass. Section 315(b) contains explicit language denying agency power after a time deadline, saying “[a]n inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” (emphasis added); *see also* section 321(c) (“A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent” (emphasis added)). Had Congress meant to deprive the agency of power in section 326(a)(11), it knew how to do it, and, significantly, it did not use language in section 326(a)(11) similar to that used in other sections.

⁴ The statute in *Barnhart* provided that the Commissioner of Social Security “shall, before October 1, 1993,” assign each coal industry retiree who was eligible for benefits under the Coal Act to an operating company to fund said benefits. 26 U.S.C. § 9706(a); *Barnhart*, 537 U.S. at 152. There were “two exceptions [to the deadline] recognizing changes for initial error or the demise of an assignee operator.” *Barnhart*, 537 U.S. at 170 (referring to 26 U.S.C. § 9704(f)(2)).

PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC. 11

B

Just as the structure of the statute does not support denying the Board authority after the deadline, the legislative history likewise does not support denying the authority to act after the one-year period passes. Congress enacted the AIA in part to replace inter partes reexaminations. Congress complained that inter partes reexaminations were lengthy and inefficient, often lasting three to five years. 157 Cong. Rec. 3429 (Mar. 8, 2011). The AIA provided for PGRs and IPRs, which were “designed to allow parties to challenge a granted patent through a[n] expeditious and less costly alternative to litigation.” Introduction of Patent Reform Act, 153 Cong. Rec. E774 (Apr. 18, 2007). Congress had a clear intent to make patent review expeditious, which was reflected in the deadline in section 326(a)(11). But the importance of the deadline does not support denying authority after the deadline passes. To the contrary, forbidding the Board to issue a Final Written Decision after the deadline has passed would go against Congressional intent. If the Board could not issue a Final Written Decision, the parties would be forced to pursue the issue in district court litigation. This is the exact opposite of the purpose of the AIA, which is meant to create a more efficient alternative to district court litigation. Further, some of the work done during the PGR would be lost and the parties would have to duplicating briefing and arguments. This certainly is not the efficient process contemplated by the AIA.

Purdue argues that under the Board’s reading “[section] 326(a)(11) would mean nothing more than the undefined timing for reexamination that Congress disliked and replaced.” Brief of Appellants Purdue Pharma L.P. and Purdue Pharmaceuticals L.P. at 15. This is not accurate. The Board may not ignore statutory deadlines. *See, e.g., Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988) (holding the Board may not indefinitely stay an ex parte reexamination in light of parallel district court litigation

via the “special dispatch” standard). “[W]hen an agency is compelled by law to act within a certain time period . . . a court can compel the agency to act.” *Norton v. Southern Utah Wilderness All.*, 542 U.S. 55, 65 (2004). The appropriate remedy is mandamus. *Telecommunications Rsch. & Action Ctr. v. F.C.C.*, 750 F.2d 70, 76 (D.C. Cir. 1984); *Mylan Lab’ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1380–81 (Fed. Cir. 2021) (quoting *Int’l Union, United Mine Workers of Am. v. U.S. Dep’t of Lab.*, 358 F.3d 40, 43 (D.C. Cir. 2004)) (“[U]nreasonable delay of agency action . . . ‘defeats [our] prospective jurisdiction’ . . . [t]o protect our future jurisdiction, we have jurisdiction to review [a] petition for a writ of mandamus”); *In re Paralyzed Veterans of Am.*, 392 F. App’x 858, 859–860 (Fed. Cir. 2010) (non-precedential); see also 5 U.S.C. § 706(1). Contrary to the PTO’s arguments, mandamus is available immediately upon the deadline’s expiring, assuming that the other requirements for issuance of the writ are satisfied. There is no requirement to show unreasonable delay in the issuance of the decision—only that the deadline has passed.

Here, Purdue had an available mandamus remedy and simply chose not to seek to compel an earlier decision from the Board. Failure to seek relief by mandamus does not, however, mean a loss of the Board’s authority to act.⁵

⁵ We do not reach the question of whether the bankruptcy automatic stay applies to PGRs. This would require interpretation of the Bankruptcy Code. The Bankruptcy Code provides that a bankruptcy petition stays “the commencement or continuation . . . of a judicial, administrative, or other action or proceeding against the debtor.” 11 U.S.C. § 362(a)(1). There is an exception to the automatic stay for “the commencement or continuation of an action or proceeding by a governmental unit . . . to enforce such governmental unit’s or organization’s police and regulatory

PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC. 13

Despite Purdue's numerous arguments for cabining the Board's authority, we conclude that the Board's failure to comply with the statutory deadline does not deprive it of authority thereafter to issue a final written decision.

II

Having concluded the Board retained the authority to act, we consider the Board's holding that the claims lacked written description support.⁶ Whether a patent claim satisfies the written description requirement of 35 U.S.C. § 112 is a question of fact reviewed for substantial evidence. *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1354 (Fed. Cir. 2015). To satisfy the written description requirement, the description must "clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (alteration in original) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). "[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* We have required that the specification "provide sufficient 'blaze marks' to guide a reader through the forest of disclosed possibilities toward the claimed compound." *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1346 (Fed. Cir. 2013). The

power, including the enforcement of a judgment other than a money judgment, obtained in an action or proceeding by the governmental unit to enforce such governmental unit's or organization's police or regulatory power." *Id.* § 362(b)(4). The question is whether this exception applies to PTO IPR or PGR proceedings.

⁶ As noted earlier, there was also an anticipation ground argued in the PGR, which was dependent on written description in the priority application.

14 PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC.

issue here is whether the '961 specification adequately discloses the claimed polyglycolized glycerides ("PGGs") as an aversive agent. The Board found the claimed formulation was not disclosed. We conclude that substantial evidence supports the Board's finding.

Although the '961 claims on their face do not require an aversive agent, the specification makes clear that the claims require "inclusion of at least one aversive agent" and the parties agree that the claims require the use of an aversive agent. '961 patent, col. 5, ll. 53–56. The specification of the '961 patent states an aversive agent is "a bittering agent, an irritant, a gelling agent, or combinations thereof." *Id.* at col. 4, ll. 28–29. Long lists of potential bittering agents and gelling agents are provided. *See id.* at col. 5, l. 64–col. 6, l. 14; col. 6, l. 64–col. 7, l. 23. Among the extensive list of possible gelling agents, surfactants are given as an example. *Id.* at col. 7, l. 11. Later in the specification, PGGs are identified as a possible surfactant "useful in accordance with the present invention." *Id.* at col. 28, ll. 35–41.

While the specification discloses that some surfactants can be gelling agents and that gelling agents can satisfy the aversive agent requirement, the parties agree that not all surfactants are gelling agents. Oral Argument at 16:54–17:01. The specification does not say that PGGs are gelling agents, as Purdue's expert witness admitted. J.A. 3184 (79:9–18, 80:7–11). In fact, the only time PGGs are mentioned in the specification, they are described as a surfactant, and not as a gelling agent, and surfactants generally are described as "useful in accordance with the present invention." '961 patent, col. 28, ll. 36–37. In other parts of the specification, the patent recognizes that surfactants can be used completely separate from and in addition to the gelling agent. *Id.* at col. 25, ll. 45–46 (surfactants can be used as an "absorption enhancer"). Just because the specification states PGGs are useful for the invention does not suggest how PGGs are gelling agents. The disclosure of the

PURDUE PHARMA L.P. v. COLLEGIUM PHARMACEUTICAL, INC. 15

application does not reasonably convey to those skilled in the art that the inventor had possession of the claimed drug formula containing PGGs as a gelling agent (aversive agent). In other words, there are insufficient blaze marks.

The parties agree that the '961 patent “has substantially the same disclosures as the specification of” U.S. Provisional Application No. 60/310,534 (“534 application”) to which Purdue claims priority. J.A. 14. The specification for the '961 patent does not provide adequate written description support, and neither does the '534 application. Because the claims do not satisfy the written description requirement, we need not reach the issue of anticipation.

CONCLUSION

We affirm that the Board has authority to issue a Final Written Decision after the statutory deadline has passed. We also affirm the Board’s determination that claims 1–17 of the '961 patent are unpatentable for lack of written description under 35 U.S.C. § 112.

AFFIRMED

EXHIBIT G

February 29, 2024 PTAB Order

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 (Patent 11,377,689 B2)
IPR2023-01300 (Patent 11,473,142 B2)¹

Before SUSAN L. C. MITCHELL, DEVON ZASTROW NEWMAN, and
JAMIE T. WISZ, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
Authorizing the Parties to File Certain Exhibits
35 U.S.C. § 314, 37 C.F.R. § 42.4

¹ This Order addresses issues common to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Background

Petitioner filed a Petition for *inter partes* review in IPR202-01298 on August 16, 2023. IPR2023-01298, Paper 2. Trial was instituted on February 1, 2024. *Id.*, Paper 15.

Petitioner filed a Petition for *inter partes* review in IPR202-01300 on September 25, 2023.² IPR2023-01300, Paper 2. The deadline for institution in that proceeding is April 4, 2024.

On February 4, 2024, Patent Owner filed Chapter 11 proceedings in the United States Bankruptcy Court for the District of Delaware (the “Bankruptcy Court”). IPR2023-01300, Paper 8, 1; IPR2023-01298, Paper 16, 1. Patent Owner had been authorized to file a sur-reply opposing institution of *inter partes* review on or before February 9, 2023 in IPR2023-01300 (Ex 3001), but had not yet filed the brief when bankruptcy proceedings commenced.

On February 8, 2024, the panel requested a conference with counsel in both matters to discuss the effect of Patent Owner’s Chapter 11 filing on the IPRs. Ex. 3002. Patent Owner’s deadline for filing a sur-reply in IPR2023-01300 was suspended pending the discussion, and the parties were authorized to file briefing regarding their respective opinions on the effect of Patent Owner’s Chapter 11 filing on the IPRs. *Id.*

On February 20, 2024, Patent Owner filed a brief regarding the applicability of the statutory stay effective in Patent Owner’s proceedings under 11 U.S.C. § 362 of the Bankruptcy Code to these proceedings. IPR2023-01298, Paper 18; IPR2023-01300, Paper 10.

² We refer to the *inter partes* proceedings collectively as “the IPRs.”

February 23, 2024, Conference Call

On February 23, 2024, Judges Newman, Mitchell, and Wisz participated in a conference call with counsel for the parties, including Mr. Derek Walter for Patent Owner and Mr. David Holman for Petitioner, and the parties' respective bankruptcy counsel. Ex. 3002. Patent Owner engaged a court reporter, and the transcript of the call will be filed by Patent Owner.

During the call, Judge Newman addressed the Court of Appeals for the Federal Circuit's decision in *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 86 F.4th 1338, 1345 (Fed. Cir. 2023). Specifically, Judge Newman explained that the *Purdue Pharma* decision observed that, in the Federal Circuit's view, it remains an open question whether the automatic stay provision of 11 U.S.C. § 362 applies to IPR or PGR proceedings at the PTAB, and that answering this question requires interpretation of the Bankruptcy Code.³ Judge Newman further explained the panel's view that, as an administrative agency dealing with patent law, the Board is not able to interpret the Bankruptcy Code. Judge Newman requested that Patent Owner

³ See *Purdue Pharma*, footnote 5:

We do not reach the question of whether the bankruptcy automatic stay applies to PGRs. This would require interpretation of the Bankruptcy Code. The Bankruptcy Code provides that a bankruptcy petition stays "the commencement or continuation ... of a judicial, administrative, or other action or proceeding against the debtor." 11 U.S.C. § 362(a)(1). There is an exception to the automatic stay for "the commencement or continuation of an action or proceeding by a governmental unit ... to enforce such governmental unit's or organization's police and regulatory power, including the enforcement of a judgment other than a money judgment, obtained in an action or proceeding by the governmental unit to enforce such governmental unit's or organization's police or regulatory power." *Id.* § 362(b)(4). The question is whether this exception applies to PTO IPR or PGR proceedings.

seek an order or other clarification from the Bankruptcy Court indicating that the IPRs are subject to the automatic stay imposed during Chapter 11 proceedings and not exempted by 11 U.S.C. § 362(b)(4) or another provision. Judge Newman explained that, absent this order or other indication, the panel would continue to follow the statutory deadlines proscribed by the AIA.

Judge Newman further observed that, in an instituted proceeding, a party may request authorization to file a motion to extend the due dates by up to 6 months beyond the deadlines in a scheduling order. *See* 35 U.S.C. § 316(a)(11) (providing up to six additional months to issue a final written decision when good cause is shown); 37 C.F.R. § 42.100(c) (delegating authority to extend the deadline for good cause to the Chief Administrative Patent Judge). During the call, Judge Newman invited Patent Owner to request an extension of the due dates by up to 6 months beyond the deadlines in our standard scheduling order in IPR2023-01298. Patent Owner requested the extension and Judge Newman indicated the panel would request an extension from the Chief Administrative Patent Judge.

Judge Newman explained that 35 U.S.C. § 316(a)(11) does not apply to matters not yet instituted, and that the panel is unaware of any statutory authority by which it may extend the deadline to determine whether to institute an *inter partes* review under § 314(b) (even with a showing of good cause). Judge Newman indicated that, unless the Bankruptcy Court indicates that these *inter partes* review proceedings are subject to the stay, the Board will render an institution decision on the petition in IPR2023-01300 no later than April 4, 2024, the deadline for determining whether to institute an *inter partes* review. Judge Newman indicated that, if trial were

instituted and a scheduling order issued, the panel authorized Patent Owner to request an extension of proceeding deadlines by up to 6 months beyond the deadlines in our standard scheduling order, for good cause.

The panel advised the parties that, absent any indication from the Bankruptcy Court confirming that the automatic stay provision of the Bankruptcy Code applies to these *inter partes* review proceedings, and in the event that any instituted case remains pending before the Board, the Board will issue a final written decision in IPR2023-01298 and in IPR2023-01300, if trial is instituted in that proceeding, on or before their respective 18-month statutory deadlines.

Patent Owner explained its view that the automatic stay imposed by the Bankruptcy Court on various proceedings applies to the IPRs. Petitioner took no position on the issue. However, Patent Owner noted that on February 22, 2024, Petitioner filed a motion in the Bankruptcy Court requesting an order lifting the automatic stay with respect to the IPRs. The parties indicated that a ruling on that motion is expected from the bankruptcy court on March 7, 2024.

Patent Owner requested clarification as to Patent Owner's suspended deadline for filing a sur-reply opposing institution in IPR2023-01300. The panel indicated that a new deadline would issue with this order.

The parties were also advised that the Board wishes to be kept apprised of the bankruptcy proceedings as they may relate to these *inter partes* review proceedings. The panel instructed counsel to file any documents filed in the Bankruptcy Court by either party that are relevant to these *inter partes* review proceedings to be filed with PTAB, by the filing party, as an exhibit. Petitioner advised that the district court in the related

IPR2023-01298 (Patent 11,377,689 B2)
IPR2023-01300 (Patent 11,473,142 B2)

patent infringement litigation, *NanoString Technologies, Inc. v. 10x Genomics, Inc.*, Case 1:22-CV1375-MFK (D. Del.), had recently issued a claim construction order, and the panel requested that a copy of that order be filed as an exhibit in the IPRs.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner and Patent Owner shall file copies of any documents relevant to these *inter partes* review proceedings that are filed in the Bankruptcy Court. Documents should be filed in these proceedings as exhibits by the filing party.

FURTHER ORDERED that Patent Owner is authorized to file any decision by the Bankruptcy Court relevant to these *inter partes* review proceedings as an exhibit in these proceedings, and shall notify the Board via email when any such decision issues.

FURTHER ORDERED that, Patent Owner is authorized to file a sur-reply opposing institution no later than March 18, 2024.

FURTHER ORDERED that, in the event that trial is instituted in IPR2023-01300, Patent Owner will be authorized to request an extension of the due dates by up to 6 months beyond the deadlines in our standard scheduling order in IPR2023-01300.

FURTHER ORDERED that Petitioner is authorized to file, as an exhibit, the district court's claim construction order in *NanoString Technologies, Inc. v. 10x Genomics, Inc.*, Case 1:22-CV1375-MFK (D. Del.) in each of these proceedings.

IPR2023-01298 (Patent 11,377,689 B2)
IPR2023-01300 (Patent 11,473,142 B2)

FURTHER ORDERED that Patent Owner shall file, in each of these proceedings, a transcript of the conference call as an exhibit within 10 business days.

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

IPR2023-01298 (Patent 11,377,689 B2)
IPR2023-01300 (Patent 11,473,142 B2)

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