

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

PETITIONER 10X GENOMICS, INC.’S UPDATED EXHIBIT LIST

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Pursuant to the Board’s Order of March 22, 2024 (Paper 15), Petitioner, 10x Genomics, Inc. (“10x Genomics” or “Petitioner”), files this Updated Exhibit List to accompany filing of Exhibit 1054 (“Sales Order”), which is an order from the United States Bankruptcy Court for the District of Delaware. Petitioner directs the Board’s attention to paragraph 47 of the Sales Order.

Exhibit No.	Description
1001	<i>Intentionally Left Blank</i>
1002	<i>Intentionally Left Blank</i>
1003	<i>Curriculum Vitae</i> of Paul Spellman, Ph.D.
1004	File History of U.S. Patent No. 11,377,689
1005	International Patent Application Publication No. WO 2017/019456 A2 to So <i>et al.</i> , published February 2, 2017 (“So-456”)
1006	International Patent Application Publication No. WO 2021/133849 A1 to Chell <i>et al.</i> , published July 1, 2021 (“Chell”)
1007	“Explore Illumina sequencing technology,” Illumina, Inc., accessible at https://www.illumina.com/science/technology/next-generation-sequencing/plan-experiments/paired-end-vs-single-read.html
1008	<i>Intentionally Left Blank</i>
1009	U.S. Patent Application No. 16/272,487, filed February 11, 2019
1010	<i>Intentionally Left Blank</i>
1011	<i>Intentionally Left Blank</i>
1012	File History of U.S. Patent Application No. 16/272,487

Exhibit No.	Description
1013	Merritt, <i>et al.</i> , “Multiplex digital spatial profiling of proteins and RNA in fixed tissue,” <i>Nature Biotechnology</i> 38:586-599 (May 2020)
1014	<i>Intentionally Left Blank</i>
1015	<i>Intentionally Left Blank</i>
1016	Stahl <i>et al.</i> , “Visualization and analysis of gene expression in tissue selections by spatial transcriptomics,” <i>Science</i> 353(6294):78-82 (July 1, 2016), with attached Supplementary Materials
1017	International Patent Application Publication No. WO 2012/140224 A1 to Frisen <i>et al.</i> , published October 18, 2012
1018	Spatial Transcriptomics Workflow, accessible at https://spatialtranscriptomics.com/workflow/
1019	Kivioja <i>et al.</i> , “Counting absolute numbers of molecules using unique molecular identifiers,” <i>Nature Methods</i> 9(1):72-76 (January 2012), with attached Supplementary Information
1020	<i>Intentionally Left Blank</i>
1021	<i>Intentionally Left Blank</i>
1022	NanoString Technologies, Inc.’s Initial Infringement Contentions with Attachment A and Exhibit 1, <i>10x Genomics, Inc. et al. v. NanoString Technologies, Inc.</i> , Case No. 1:22-cv-01375 (D. Del.), filed November 23, 2022
1023	Scheduling Order, <i>NanoString Technologies, Inc. v. 10x Genomics, Inc.</i> , Case No. 1:22-cv-01375 (D. Del.), filed April 13, 2023
1024	Joint Claim Construction Statement with Exhibits A through C, <i>NanoString Technologies, Inc. v. 10x Genomics, Inc.</i> , Case No. 1:22-cv-01375 (D. Del.), filed August 4, 2023

Exhibit No.	Description
1025	Duncan <i>et al.</i> , “A method for detecting single mRNA molecules in <i>Arabidopsis thaliana</i> ,” <i>Plant Methods</i> 12:13 (2016)
1026	Lieben, L., “Spatial transcriptomics in plants,” <i>Nature Reviews Genetics</i> 18:394 (2017)
1027	Jemt <i>et al.</i> , “An automated approach to prepare tissue-derived spatially barcoded RNA-sequencing libraries,” <i>Scientific Reports</i> 6:37137 (2016)
1028	Asp <i>et al.</i> , “Spatial detection of fetal marker genes expressed at low level in adult human heart tissue,” <i>Scientific Reports</i> 7:12941 (2017)
1029	“Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” United States Patent and Trademark Office Memorandum, June 21, 2022
1030	Fantini <i>et al.</i> , “Assessment of antibody library diversity through next generation sequencing and technical error compensation,” <i>PLOS One</i> 12(5):e0177574 (2017)
1031-1037	<i>Intentionally Left Blank</i>
1038	Complaint, <i>NanoString Technologies, Inc. v. 10x Genomics, Inc.</i> , Case No. 1:22-cv-01375 (D. Del.), filed October 20, 2022
1039	5’ Amino Modifier C6, Integrated DNA Technologies
1040	Devor <i>et al.</i> , “Strategies for Attaching Oligonucleotides to Solid Supports,” Integrated DNA Technologies, 2005
1041	Ambardar <i>et al.</i> , “High Throughput Sequencing: An Overview of Sequencing Chemistry,” <i>Indian Journal of Microbiology</i> , 56(4):394-404 (October-December 2016)
1042	U.S. Patent No. 10,329,600 to Fu <i>et al.</i> , issued June 25, 2019
1043	U.S. Patent No. 11,473,142 to Beechem <i>et al.</i> , issued October 18, 2022 (“142 patent”)

Exhibit No.	Description
1044	Declaration of Paul Spellman, Ph.D.
1045	Onodera, K., “Selection for 3'-End Triplets for Polymerase Chain Reaction Primers,” <i>Methods in Molecular Biology</i> , 402:61-74 (2007)
1046	Tian <i>et al.</i> , “A large-scale analysis of mRNA polyadenylation of human and mouse genes,” <i>Nucleic Acids Research</i> , 33(1):201-212 (2012)
1047	CodeLink Activated Slides User Guide, SurModics, Inc.
1048	Khodakov <i>et al.</i> , “Recent developments in nucleic acid identification using solid-phase enzymatic assays,” <i>Microchem Acta</i> , 181(13-14):1633-1646 (2014)
1049	European Patent Application Publication No. EP 1114859 A1 to Ota <i>et al.</i> , published July 11, 2001
1050	Mercier <i>et al.</i> , “Solid Phase DNA Amplication: A Simple Monte Carlo Lattice Model,” <i>Biophysical Journal</i> , 85:2075-2086 (October 2003)
1051	<i>Intentionally Left Blank</i>
1052	Memorandum Opinion and Order, <i>NanoString Technologies, Inc. v. 10x Genomics Inc.</i> , Case No. 1:22-cv-01375 (D. Del.), February 1, 2024
1053	Motion of 10x Genomics, Inc. for Entry of an Order (i) Modifying the Automatic Stay with Respect to the 653 Action and the IPR Proceedings and (ii) Granting Related Relief, <i>In re: Nanostring Technologies, Inc., et al.</i> , Case No. 24-10160 (Bankr. D. Del.), February 22, 2024

Exhibit No.	Description
1054	Order (A) Approving Asset Purchase Agreement, (B) Approving the Sale of the Debtors' Assets Free and Clear of Liens, Claims, Interests, and Encumbrances, (C) Approving the Assumption and Assignment of Certain Executory Contracts and Unexpired Leases, and (D) Granting Related Relief, <i>In re: Nanostring Technologies, Inc., et al.</i> , Case No. 24-10160 (Bankr. D. Del.), April 19, 2024

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/David H. Holman/

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Date: May 7, 2024

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PETITIONER 10X GENOMICS, INC.'S UPDATED EXHIBIT LIST** and **EXHIBIT 1054** were served in their entirety on May 7, 2024, upon the following parties via electronic mail:

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