

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 NANOSTRING TECHNOLOGIES, INC.'S
MOTION FOR ADMISSION PRO HAC VICE OF EDWARD R. REINES
PURSUANT TO 37 C.F.R. § 42.10**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the 37 C.F.R. § 42.10(c) and 42.22, NanoString Technologies, Inc. (“NanoString”), hereby moves for an Order allowing Edward R. Reines of Weil, Gotshal & Manges LLP to appear *pro hac vice* on behalf of NanoString in the above-captioned case. NanoString has conferred with counsel for Petitioner 10x Genomics, Inc. (“10x”), and 10x does not oppose NanoString’s motion to allow Mr. Reines to appear *pro hac vice* in this matter.

II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION

NanoString Exhibit 2005 – Declaration of Edward R. Reines in Support of Motion to Appear *Pro Hac Vice* on behalf of NanoString.

III. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

As set forth below in the Statement of Material Facts, NanoString has made all of the showings required under 37 C.F.R. § 42.10(c) for recognizing Mr. Reines *pro hac vice*. In particular, Mr. Reines is an experienced litigating attorney who has represented clients in numerous patent litigation cases in various United States District Courts and Court of Appeals for the Federal Circuit, including technically and legally complex matters such as will be present in this proceeding. Accordingly, allowing Mr. Reines to appear *pro hac vice* on behalf of NanoString is appropriate in this proceeding.

IV. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.”

2. Lead counsel for NanoString in this *inter partes* review proceeding is Derek C. Walter. Mr. Walter is registered to practice before the United States Patent and Trademark Office and holds Registration No. 74,656.

3. As set forth in NanoString Exhibit 2005 (the “Reines Declaration”), Mr. Reines is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding. Reines Decl. ¶¶ 1-2, 4. In particular, Mr. Reines has over 30 years of experience as a patent litigator and has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit. *Id.* ¶¶ 1-2. In addition, Mr. Reines has experience in *inter partes* review proceedings, for example, IPR2014-01093, IPR2017-01170, IPR2017-01447, IPR2017-01448, IPR2015-

01156, IPR2015-01157, IPR2015-01158, IPR2015-01162, IPR2015-01163, IPR2015-01558, IPR2015-01560, IPR2018-00665, IPR2018-00291, IPR2018-00318, IPR2018-0322, IPR2018-00385, IPR2018-00797, IPR2019-01201, IPR2020-01180, IPR2020-01181, IPR2022-00402, IPR2022-00403, IPR2023-00955, IPR2023-00958, and IPR2023-00876. *Id.* ¶ 3.

4. Further, Mr. Reines is experienced with technically and legally complex matters in the Life Sciences. *Id.* ¶ 2.

5. With regard to U.S. Patent No. 11,473,142 (“the ’142 patent”), the patent at issue in this proceeding, Mr. Reines is familiar with the ’142 patent, and with the legal subject matter, technical subject matter, and prior art discussed in the petition for *inter partes* review of the ’142 patent. *Id.* ¶ 4. In view of his legal experience, technical background, and familiarity with the issues in the present matter and the related matters, NanoString has requested his services in the present matter. Denial of his appearance in this case would create an undue burden on the Patent Owner.

6. Mr. Reines has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in Part 42 of Title 37 of the Code of Federal Regulations. *Id.* ¶ 10. Mr. Reines also agrees to be subject to the United States Patent and Trademark Office Rules of Professional Conduct set forth in 37 C.F.R. § 11.19(a). *Id.* ¶ 11.

7. Finally, Mr. Reines has attested to the remaining elements of Paragraph 2(b) of the representative “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7. *Id.* ¶¶ 2-12; *see* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3) at 2.

V. **CONCLUSION**

In view of the foregoing, and having satisfied the requirements of 37 C.F.R. § 42.10(c), NanoString hereby moves for an Order allowing Edward R. Reines of Weil, Gotshal & Manges LLP to appear *pro hac vice* on behalf of NanoString in the above-captioned case.

Respectfully submitted,

WEIL, GOTSHAL AND MANGES LLP

Dated: July 19, 2024

/Christopher M. Pepe/

Christopher M. Pepe
Back-Up Counsel for Patent Owner
Registration No. 73,851
Weil, Gotshal & Manges LLP
2001 M. Street NW, Suite 600
Washington, DC 20036

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **PATENT OWNER NANOSTRING TECHNOLOGIES, INC'S MOTION FOR ADMISSION PRO HAC VICE OF EDWARD R. REINES PURSUANT TO 37 C.F.R. § 42.10 and EXHIBITS 2005-2006** was served in its entirety on July 19, 2024, via electronic email pursuant to 37 C.F.R. § 42.6(e) to the counsel for 10x Genomics, Inc. at the addresses below:

David H. Holman, Reg. No. 61,205
Pratibha Khanduri, Reg. No. 81,318
Robert Greene Sterne, Reg. No. 28,912
Gaby L. Longworth, Reg. No. 47,756
STERNE, KESSLER, GOLDSTEIN &
FOX PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005
202.772.8989 (telephone)
202.371.2540 (facsimile)
dholman-PTAB@sternekessler.com
pkhanduri-PTAB@sternekessler.com
rsterne-PTAB@sternekessler.com
glongs-PTAB@sternekessler.com
PTAB@sternekessler.com

Matthew D. Powers (*Pro Hac Vice to be filed*)
Paul Ehrlich (*Pro Hac Vice to be filed*)
Robert L. Gerrity (*Pro Hac Vice to be filed*)
Kiley A. White, Reg. No. 71,212
Tensegrity Law Group LLP
555 Twin Dolphin Drive, Suite 650
Redwood Shores, CA 94065
650.802.6000 (telephone)
650.802.6001 (facsimile)
Matthew.Powers@tensegritylawgroup.com
Paul.Ehrlich@tensegritylawgroup.com
Robert.Gerrity@tensegritylawgroup.com
Kiley.White@tensegritylawgroup.com

Attorneys for Petitioner 10x Genomics, Inc.

Dated: July 19, 2024

/Christopher M. Pepe/

Christopher M. Pepe
Back-Up Counsel for Patent Owner
Reg. No. 73,851