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To: [Walter, Derek](#); [Trials](#)
Cc: [srieger@foley.com](#); [Gaby Longsworth](#); [Rob Sterne](#); [Prati Khanduri](#); [Rodrigues, Ruben J.](#); [Nanostring 10X](#)
Subject: RE: NanoString v. Harvard, IPR2024-00526 - request to file reply to preliminary response
Date: Monday, June 24, 2024 4:50:55 PM

Counsel,

From the Board –

Petitioner’s request for authorization to file a Reply to Patent Owner’s Preliminary Response is granted in part.

Petitioner’s request for authorization to file a Reply addressing Petitioner’s Chapter 11 bankruptcy proceedings, the stay of co-pending district court litigation, and their impact on the *Fintiv* factors is granted. The Reply shall be limited to 5 pages and shall be filed no later than seven calendar days from the date of this e-mail. Patent Owner is authorized to file a 5-page Sur-Reply, limited to the same topics, no later than seven calendar days after the filing of the Reply.

Petitioner’s request for authorization to file a Reply addressing Patent Owner’s arguments in the Preliminary Response regarding the “temperature control apparatus” element is denied. Petitioner alleges that certain of Patent Owner’s arguments “appear[]” not to be based on prior art, “a point Patent Owner did not address.” The panel is not persuaded Petitioner established good cause to reply to these arguments at this time. In particular, the panel is well situated to determine whether Patent Owner’s arguments are persuasive.

Regards,

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

From: Walter, Derek <Derek.Walter@weil.com>
Sent: Thursday, June 20, 2024 9:03 PM
To: Trials <Trials@USPTO.GOV>
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Subject: NanoString v. Harvard, IPR2024-00526 - request to file reply to preliminary response

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Your Honors,

Petitioner respectfully requests authorization from the Board to file a 6-page reply to the Patent Owner's Preliminary Responses ("POPRs") filed in the above captioned proceeding. Petitioner proposes to file its reply on June 28, 2024. Petitioner does not oppose a 6-page sur-reply from Patent Owner and proposes that the sur-reply be filed on July 12, 2024.

Petitioner's proposed replies would address the following issues:

1. Changes in circumstances relating to *Fintiv* factors.
2. Support for Patent Owner's arguments regarding the claim element calling for "a temperature control apparatus operatively coupled to said sample holder."

Good cause exists for Petitioner's proposed replies for at least the following reasons.

First, with respect to the *Fintiv* factors and discretionary denial, the relevant facts and circumstances have changed since the filing of the petition. This is because, since the filing of the petition, the petitioner in this proceeding has gone through chapter 11 bankruptcy proceedings, and co-pending district court litigation has been stayed. Petitioner wishes to provide the Board with an update regarding these facts and circumstances and how they pertain to the considerations relevant to the issue of discretionary denial under *Fintiv*. Petitioner believes it is important to provide this information to the Board because Patent Owner did not provide the updated information to the Board with its Patent Owner's response.

Second, as to the "temperature control apparatus" element, Patent Owner presented arguments regarding the existence of a Biopetechs FCS2 flow cell that allegedly lacked a thermal control system. Yet, it appears that Patent Owner's arguments to this effect were not based on prior art, a point that Patent Owner did not address in its Petition.

Patent Owner responds as follows to Petitioner's request:

- **Issue #1:** 10x did not substantively argue *Fintiv* factors 1-5 in its POPR. Nevertheless, 10x will not oppose Petitioner's request for authorization to file a brief update limited only to issue #1 (the bankruptcy proceedings and *Fintiv* factors), subject to 10x receiving authorization to file a sur-reply of equal length.
- **Issue #2:** 10x opposes Petitioner's request for additional briefing on the temperature control apparatus evidence (issue #2). Identifying and evaluating statements or misstatements of facts and law are well within the purview of the Board. Petitioner's request regarding issue #2 does not warrant good cause for additional briefing.

Thanks,

Derek

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