

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOSTRING TECHNOLOGIES, INC.,
Petitioner

v.

PRESIDENT AND FELLOWS OF HARVARD COLLEGE¹,
Patent Owner

Case IPR2024-00526
U.S. Patent No. 11,542,554

PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ While 10x Genomics, Inc. is the exclusive licensee and the real party-in-interest, President and Fellows of Harvard College is the Patent Owner.

UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	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
2002	Declaration of Laura Waller, Ph.D.
2003	International Patent Application Publication No. WO 2012/140224 A1 to Frisen <i>et al.</i> , published October 18, 2012
2004	“No-Heat Flow Cell (FSC2),” Bioptechs Inc., accessible at https://bioptechs.com/product/no-heat-flow-cell-fcs2/ (last accessed May 24, 2024)
2005	“FCS2 Chamber,” Bioptechs Inc., accessible at https://bioptechs.com/product/fcs2-chamber/ (last accessed May 24, 2024)
2006	Prosecution File History of U.S. Patent No. 11,542,554
2007	Fang, <i>et al.</i> , “Three-dimensional single-cell transcriptome imaging of thick tissues,” <i>eLife</i> , August 16, 2023, accessible at https://elifesciences.org/reviewed-preprints/90029 (last accessed May 23, 2024) (“Zhuang 2023”)
2008	Lu, <i>et al.</i> , “Spatially resolved epigenomic profiling of single cells in complex tissues,” <i>Cell</i> 185:4448–4464 (2022)
2009	Su, <i>et al.</i> , “Genome-Scale Imaging of the 3D Organization and Transcriptional Activity of Chromatin,” <i>Cell</i> 182:1641–1659 (2020)
2010	Cox, Jr., <i>et al.</i> , “Organizing your space: The potential for integrating spatial transcriptomics and 3D imaging data in plants,” <i>Plant Physiology</i> 188:703-712 (2022) (“Czymmek 2022”)
2011	Ghani, <i>et al.</i> , “Optimisation of MERFISH Data Analysis and Visualisation,” May 21, 2019, accessible at https://www.ucl.ac.uk/~ucbpngh/MiniProject3.pdf (last accessed May 28, 2024)
2012	<i>Curriculum Vitae</i> of Laura Waller, Ph.D.
2013	Docket Report, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), July 8, 2024

Exhibit No.	Description
2014	Oral Order, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 109, April 25, 2023
2015	Hearing Transcript, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), June 14, 2024
2016	Notice of Service of 10x Genomics, Inc.’s Initial Infringement Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 68, November 23, 2022
2017	Notice of Service of NanoString Technologies, Inc.’s Initial Invalidity Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 79, January 3, 2023
2018	Notice of Service of 10x Genomics, Inc.’s Supplemental Infringement Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 100, March 24, 2023
2019	Notice of Service of NanoString Technologies, Inc.’s Supplemental Invalidity Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 132, May 17, 2023
2020	Memorandum Opinion and Order, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 269, February 1, 2024
2021	Notice of Service of NanoString Technologies, Inc.’s Initial Infringement Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 64, November 23, 2022
2022	Notice of Service of 10x Genomics, Inc.’s Initial Invalidity Contentions, <i>10x Genomics, Inc. v. NanoString Techs., Inc.</i> , Case No. 1:22-cv-00261 (D. Del.), ECF No. 77, December 27, 2022
2023	E-mail Correspondence from Jason J. Rawnsley to Melissa Astell, July 8, 2024

10x Genomics, Inc. files this Sur-reply in response to Petitioner's pre-institution Reply ("Reply," Paper 9). EX3001. The Reply argues that *Fintiv* Factors 1-3 favor institution despite a parallel litigation involving the 554 patent at the District Court of Delaware (Case No. 22-cv-00261, "the 22-261 litigation"). The Reply, however, omits key facts and evidence pertinent to the Board's *Fintiv* analysis: Judge Matthew F. Kennelly (the judge presiding over the parallel 22-261 litigation) expects to end his term as a visiting judge in Delaware in August 2025 and is highly motivated to complete the trial in the 22-261 litigation before his departure. Judge Kennelly has accordingly instructed the parties to submit a case schedule with the 22-261 litigation ready for trial on or about May 19, 2025.

Given the delay caused by Petitioner's bankruptcy filing and Judge Kennelly's keenness to begin the trial by May 2025, a stay (or any delay) is *highly unlikely* in the 22-261 litigation (*Factor 1*). The trial in the 22-261 litigation is *highly likely* to take place before any Final Written Decision projected in late-August 2025 if this IPR is instituted (*Factor 2*). Moreover, the parties and district court will have *already heavily invested* in the 22-261 litigation by the time the Board issues a Decision on Institution in this IPR in late August 2024 (*Factor 3*).

I. Petitioner's portrayal of the likelihood of a stay is inaccurate

Fintiv Factor 1 assesses whether in a parallel district court litigation a stay exists or is likely to be granted if the PTAB proceeding is instituted. *Apple Inc. v.*

Fintiv, Inc., IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020)

(precedential) (“*Fintiv*”). Petitioner argues that a stay is “realistic” (Reply, 3), but omits facts and evidence that show otherwise. Contrary to Petitioner’s argument, the facts show that a stay is *highly unlikely* in the parallel 22-261 litigation.

The 22-261 litigation is on a coordinated case management schedule with a related case (22-595) before Judge Kennelly. EX2014. Judge Kennelly is a judge in the Northern District of Illinois and is also currently a visiting judge in the District of Delaware. He intends to either try his remaining District of Delaware cases by August 2025 or return them to another Delaware District judge. EX2015, 10-13. This is clear from Judge Kennelly’s instructions in the recent case management conferences held on June 14, 2024 (after 10x filed its POPR in this IPR, but before Petitioner filed its Reply), and again on July 8, 2024. EX2015, 10-13; EX2013, pp. 45, 47. For example, during the June 14 conference, Judge Kennelly addressed “re-setting of schedules upon lifting of the bankruptcy stays” in the litigation, and indicated that if the trial cannot be completed in these cases “before August 1,” he will “need to give back one of these cases” to another judge. EX2015, 12-13; *see also id.*, 11 (“If these cases go past August [2025], I may be giving them back to the judges in Delaware.”). To avoid this outcome, Judge Kennelly elaborated that he is “inclin[ed]” to have in “one of the ... case[s] ... a trial date in June of 2025,” with “August [2025] the latest” for both cases. *Id.*, 10-

11. And, in fact, in the July 8 conference, Judge Kennelly instructed the parties to submit a case schedule that would have the trial in the 22-261 litigation begin on or about May 19, 2025. EX2013, p. 47.²

The 22-261 litigation was already delayed due to Petitioner's bankruptcy filing, and is unlikely to be delayed or stayed any further if Judge Kennelly intends to meet his May 2025 trial deadline for the 22-261 litigation and August 2025 departure deadline. Moreover, the 22-261 litigation is on a coordinated schedule with Case 22-595 involving related patents and highly overlapping antitrust counterclaims that has a February 2025 trial date. Thus, Judge Kennelly is *highly unlikely* to stay the 22-261 litigation, as doing so would risk extending the 22-261 litigation beyond August 2025 against Judge Kennelly's preference and judicial efficiency. Further, as explained for Factor 3 below, the parties and court will have already invested significant resources by the time the Board issues a Decision on Institution in this IPR, additionally disfavoring a stay.

² The July 8, 2024 Docket Entry for the 22-261 litigation contains a typographical error, referring to "Case No. 22-cv-595" (instead of Case No. 22-cv-261) as anticipated to go to trial "on or about 5/19/2025." The parties have jointly requested the Court to correct the entry to state that Case 22-261 is anticipated to go to trial on or about 5/19/2025. *See* EX2023.

II. Petitioner’s portrayal of the potential trial date is inaccurate

Fintiv Factor 2 assesses the proximity of the court’s trial date to the Board’s statutory deadline for a Final Written Decision. *Fintiv*, IPR2020-00019, Paper 11, at 9. Petitioner argues that “there is no scheduled trial date,” but concedes that the court is likely to enter a schedule soon. Reply, 3. In fact, as stated above, on July 8, 2024, Judge Kennelly instructed the parties that trial in the 22-261 litigation will begin “on or about 5/19/2025,” before the Board’s late-August 2025 statutory deadline to issue a Final Written Decision in this IPR. EX2013, p. 47; EX2023.

Additionally, in response to 10x’s interrogatory seeking non-infringement contentions in the 22-261 litigation, Petitioner failed to raise any non-infringement arguments regarding the 554 patent’s claimed system.³ Thus, the district court will likely resolve the invalidity challenges to the 554 patent since there is virtually no chance of a summary judgment of non-infringement for the 554 patent.

III. The parties will have invested significant resources by the time the Board issues a Decision on Institution in this IPR

Fintiv Factor 3 assesses the investment by the parties and the court in the parallel litigation at the time of the institution decision. *Fintiv*, IPR2020-00019, Paper 11, at 9-12. Petitioner argues “the investment remaining after the institution

³ 10x disagrees with Petitioner’s assertion that “there are strong non-infringement defenses” in the 261 litigation. Reply, 2.

decision is significant.” Reply, 5. However, fact discovery is well developed in the 22-261 litigation, and the parties and district court will have made substantial investments by the time the Board issues an institution decision here. For example, the parties have already exchanged infringement and invalidity contentions, claim construction is complete and the district court has issued Markman Order, and electronically stored information discovery is substantially complete. EX2013, pp. 28, 29, 31, 33, 44; EX2016-EX2022. Thus, the current and future investments by the court and parties by the time of the institution decision are substantial. *BOE Tech. Grp. Co., Ltd. v. Element Capital Commercial Co. Pte. Ltd.*, IPR2023-00808, Paper 9, at 23-24 (P.T.A.B. Nov. 15, 2023) (finding “the parties and the District Court have invested substantial resources” when at institution decision, “[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document requests and interrogatories, and proposed claim terms for construction”; the “date for the close of fact discovery is near”; and “the claim construction phase ... is now completed”).

IV. Conclusion

Petitioner mischaracterizes certain facts and circumstances related to *Fintiv* Factors 1-3. Should the Board determine that the *Fintiv* Factors collectively weigh against exercising its discretion to deny trial, the Petition’s numerous defects and deficiencies on the merits still preclude instituting this IPR.

Respectfully submitted,

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

I certify that the above-captioned **PATENT OWNER'S PRE-
INSTITUTION SUR-REPLY** and **Exhibits 2013-2023** were served in their
entireties on July 8, 2024, upon the following parties via electronic mail:

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