

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRUKER SPATIAL BIOLOGY, INC.,
Petitioner

v.

PRESIDENT AND FELLOWS OF HARVARD COLLEGE and
10X GENOMICS, INC.,
Patent Owner

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

PATENT OWNER'S MOTION TO SEAL

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	GOVERNING RULES AND PTAB GUIDANCE.....	1
III.	GOOD CAUSE EXISTS FOR SEALING EX2024, EX2026, EX2064, EX2073, AND PATENT OWNER’S RESPONSE	2
	A. EX2064, EX2073, and EX2024	2
	B. EX2026.....	4
	C. Patent Owner’s Response.....	7
	D. Redacted versions of EX2024, EX2026, and Patent Owner’s Response are provided	7
IV.	DEFAULT PROTECTIVE ORDER.....	7
V.	CERTIFICATION OF NONPUBLICATION	7
VI.	RELIEF REQUESTED.....	7

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.14 and 42.54, Patent Owner (Exclusive Licensee) 10x Genomics, Inc. (“10x”) respectfully submits this Motion to Seal EX2024, EX2026, EX2064, and EX2073, along with Patent Owner’s Response. Good cause to seal these documents exists because they include 10x’s highly confidential, competitively sensitive information. 10x also respectfully requests entry of the Default Protective Order.

The parties have met and conferred regarding the motion to seal and entry of the Default Protective Order, as required by 37 C.F.R. § 42.54(a), and Petitioner Bruker Spatial Biology, Inc. has stated it will not oppose this motion.

II. GOVERNING RULES AND PTAB GUIDANCE

“A party intending a document or thing to be sealed shall file a motion to seal concurrent with the filing of the document or thing to be sealed. The document or thing shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion.” 37 C.F.R. § 42.14. The Consolidated Trial Practice Guide (“TPG”) explains that “the rules aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.” TPG at 19. As the TPG states, “[t]he rules identify confidential information in a manner consistent with Federal Rule of Civil Procedure

26(c)(1)(G), which provides for protective orders for trade secret or other confidential research, development, or commercial information.” *Id.* (citing 37 C.F.R. § 42.54).

In determining whether to grant a Motion to Seal, the Board must find “good cause.” 37 C.F.R. § 42.54(a). Good cause for sealing material can be established by demonstrating that the balance of the following considerations favors sealing the material: whether (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record. *See Argentum Pharms. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 4 (P.T.A.B. January 19, 2018) (informative).

III. GOOD CAUSE EXISTS FOR SEALING EX2024, EX2026, EX2064, EX2073, AND PATENT OWNER’S RESPONSE

A. EX2064, EX2073, and EX2024

EX2064 and EX2073 contain highly sensitive information pertaining the confidential specifications of 10x’s commercial product Xenium. To the best of the Undersigned’s knowledge, both EX2064 and EX2073 have not been published or otherwise made public. 10x has undertaken efforts to maintain the confidentiality of this information in the parallel district court litigation by marking EX2064 and EX2073 as “OUTSIDE ATTORNEYS’ EYES ONLY.”

EX2064 and EX2073 are marked in the present proceeding as “PROTECTIVE ORDER MATERIAL” per the Board’s Default Protective Order.

EX2064 and EX2073 contain confidential information related to design specifications and design reviews of the Xenium product, including design architecture, output specifications, electrical architecture, fluidics design, optics, chassis design, cooling system, and computing system specifications. EX2024, the Declaration of 10x’s technical expert Dr. Hari Shroff, discusses certain confidential information disclosed in EX2064 and EX2073. *See* EX2024, ¶¶121-122. Accordingly, EX2064, EX2073, and paragraphs 121-122 of EX2024 contain “trade secret or other confidential research, development, or commercial information” under 37 C.F.R. § 42.54(a) and should be subject to the protection of the Board’s Default Protective Order.

10x would suffer concrete harm from the public disclosure of EX2064, EX2073, and paragraphs 121-122 of EX2024. The confidential information in these documents could be improperly used by competitors to gain unfair business and competitive advantage in the marketplace. This could include improperly using confidential details of 10x’s Xenium product.

There is genuine need to rely on EX2064, EX2073, and paragraphs 121-122 of EX2024 in this proceeding. The confidential information in EX2064, EX2073, and paragraphs 121-122 of EX2024 is pertinent to objective indicia of commercial

success, long-felt need, and industry praise of 10x's Xenium product, and supports 10x's argument that the challenged claims are nonobvious over the asserted art. This confidential information is not available from any non-confidential sources.

The interest in maintaining confidentiality outweighs the public interest in having an open record. EX2064, EX2073, and paragraphs 121-122 of EX2024 contain confidential specifications of 10x's Xenium product, and if publicly disclosed, 10x risks significant competitive harm. In contrast, sealing EX2064, EX2073, and EX2024 deprives the public of only the confidential information related to design specifications and design reviews of the Xenium product. Furthermore, the public's interest in an open record is served as the general specifications of the Xenium product are provided in the papers and public exhibits, including the public, redacted version of EX2024, contemporaneously filed herewith.

Accordingly, 10x respectfully moves to seal EX2024, EX2064, and EX2073.

B. EX2026

Exhibit 2026, the Declaration of Ms. Julie Davis, contains confidential financial information pertaining to sales revenue associated with 10x's Xenium product. Ms. Davis, who is 10x's economics expert, provides opinions on the commercial success of the Xenium product, and relies upon proprietary financial

information belonging to 10x and disclosed in Appendixes B and C of her declaration. *See* EX2026, ¶¶33-35, Appendix B, Appendix C. To the best of the Undersigned’s knowledge, the confidential information in paragraphs 33-35 and Appendixes B and C of EX2026 have not been published or otherwise made public, and 10x has undertaken efforts to maintain the confidentiality of this information in the parallel district court litigation. The documents are marked in the present proceeding as “PROTECTIVE ORDER MATERIAL” per the Board’s Default Protective Order.

Paragraphs 33-35 and Appendixes B and C of EX2026 contain “commercial information” under 37 C.F.R. § 42.54(a). The Board’s Default Protective Order permits for protection of sensitive commercial information. *See* Consolidated Trial Practice Guide, 19 (Nov. 2019) (defining “confidential information” to match Fed. R. Civ. P. 26(c)(1)(G), including “other . . . commercial information”). The Board consistently seals product sales and internal financial documents. *See e.g., Echelon Fitness Multimedia, LLC v. Peleton Interactive, Inc.*, IPR2020-01541, Paper 54, at 87-89 (P.T.A.B. March 2, 2022); *Quest USA Corp. v. PopSockets LLC*, IPR2018-00497, Paper 59 at 87-90 (P.T.A.B. Aug. 12, 2019); *Arista Networks, Inc. v. Cisco Sys., Inc.*, IPR2016-00309, Paper 51 at 2-3 (P.T.A.B. May 8, 2017). Accordingly, EX2026 should be subject to the protection of the Board’s Default Protective Order.

10x would suffer concrete harm from the public disclosure of EX2026. The confidential financial information therein could provide competitor insight into 10x's pricing and marketing decisions. Such competitor insight could motivate copying and infringement of 10x's intellectual property.

There is genuine need to rely on paragraphs 33-35 and Appendices B and C of EX2026 in this proceeding. The confidential information in paragraphs 33-35 and Appendices B and C of EX2026 is pertinent to objective indicia of commercial success of 10x's Xenium product and supports 10x's argument that the challenged claims are nonobvious over the asserted art. This confidential information is not available from any non-confidential sources.

The interest in maintaining confidentiality outweighs the public interest in having an open record. Paragraphs 33-35 and Appendices B and C of EX2026 contain financial information of 10x's Xenium product, and if publicly disclosed, 10x risks significant competitive harm. In contrast, sealing of EX2026 deprives the public of only the confidential information related to 10x's pricing and marketing decisions for the Xenium product. Furthermore, the public's interest in an open record is served as the general facts on commercial success of the Xenium product are provided in the papers and public exhibits, including the public, redacted version of EX2026, contemporaneously filed herewith.

Accordingly, 10x respectfully moves to seal EX2026.

C. Patent Owner's Response

Patent Owner's Response discusses certain confidential information disclosed in EX2024, EX2026, EX2064, and EX2073. *See* POR, at 61, 64-65. For the reasons discussed above, Patent Owner's Response should be subject to the protection of the Board's Default Protective Order. Accordingly, 10x respectfully moves to seal Patent Owner's Response.

D. Redacted versions of EX2024, EX2026, and Patent Owner's Response are provided

In an effort to balance "the public's interest in maintaining a complete and understandable file history," 10x has concurrently filed a public version of each of EX2024, EX2026, and Patent Owner's Response, with redactions of the confidential information. TPG at 19.

IV. DEFAULT PROTECTIVE ORDER

10x submits that the confidential information referenced herein be subject to the Board's Default Protective Order, attached hereto as Exhibit A. 37 C.F.R. § 42.54(a).

V. CERTIFICATION OF NONPUBLICATION

Undersigned counsel certifies that the information sought to be sealed has not, to their knowledge, been published or otherwise made public.

VI. RELIEF REQUESTED

For the foregoing reasons, 10x respectfully requests that the Board enter

Default Protective Order and seal EX2024, EX2026, EX2064, EX2073, and Patent
Owner's Response.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

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Date: December 10, 2024

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

I certify that the above-captioned **PATENT OWNER'S MOTION TO SEAL** was served in its entirety on December 10, 2024, upon the following parties via electronic mail:

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EXHIBIT A

DEFAULT PROTECTIVE ORDER

The following Default Protective Order will govern the filing and treatment of confidential information in the proceeding:

Default Protective Order

This protective order governs the treatment and filing of confidential information, including documents and testimony.

1. Confidential information shall be clearly marked “PROTECTIVE ORDER MATERIAL.”

2. Access to confidential information is limited to the following individuals who have executed the acknowledgment appended to this order:

(A) Parties. Persons who are owners of a patent involved in the proceeding and other persons who are named parties to the proceeding.

(B) Party Representatives. Representatives of record for a party in the proceeding.

(C) Experts. Retained experts of a party in the proceeding who further certify in the Acknowledgement that they are not a competitor to any party, or a consultant for, or employed by, such a competitor with respect to the subject matter of the proceeding.

(D) In-house counsel. In-house counsel of a party.

(E) Support Personnel. Administrative assistants, clerical staff, court reporters and

other support personnel of the foregoing persons who are reasonably necessary to assist those persons in the proceeding shall not be required to sign an Acknowledgement, but shall be informed of the terms and requirements of the Protective Order by the person they are supporting who receives confidential information.

(F) The Office. Employees and representatives of the United States Patent and Trademark Office who have a need for access to the confidential information shall have such access without the requirement to sign an Acknowledgement. Such employees and representatives shall include the Director, members of the Board and their clerical staff, other support personnel, court reporters, and other persons acting on behalf of the Office.

3. Employees (e.g., corporate officers), consultants, or other persons performing work for a party, other than those persons identified above in (d)(2)(A)–(E), shall be extended access to confidential information only upon agreement of the parties or by order of the Board upon a motion brought by the party seeking to disclose confidential information to that person and after signing the Acknowledgment. The party opposing disclosure to that person shall have the burden of proving that such person should be restricted from access to confidential information.

4. Persons receiving confidential information shall use reasonable efforts to

maintain the confidentiality of the information, including:

- (A) Maintaining such information in a secure location to which persons not authorized to receive the information shall not have access;
- (B) Otherwise using reasonable efforts to maintain the confidentiality of the information, which efforts shall be no less rigorous than those the recipient uses to maintain the confidentiality of information not received from the disclosing party;
- (C) Ensuring that support personnel of the recipient who have access to the confidential information understand and abide by the obligation to maintain the confidentiality of information received that is designated as confidential; and
- (D) Limiting the copying of confidential information to a reasonable number of copies needed for conduct of the proceeding and maintaining a record of the locations of such copies.

5. Persons receiving confidential information shall use the following procedures to maintain the confidentiality of the information:

- (A) Documents and Information Filed With the Board.
 - (i) A party may file documents or information with the Board along with a Motion to Seal. The Motion to Seal should provide a non-confidential description of the nature of the confidential information that is under seal, and set forth the reasons why the information is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing

the Motion to Seal. The documents or information shall remain under seal unless the Board determines that some or all of it does not qualify for confidential treatment.

(ii) Where confidentiality is alleged as to some but not all of the information submitted to the Board, the submitting party shall file confidential and non-confidential versions of its submission, together with a Motion to Seal the confidential version setting forth the reasons why the information redacted from the non-confidential version is confidential and should not be made available to the public. A party may challenge the confidentiality of the information by opposing the Motion to Seal. The non-confidential version of the submission shall clearly indicate the locations of information that has been redacted. The confidential version of the submission shall be filed under seal. The redacted information shall remain under seal unless the Board determines that some or all of the redacted information does not qualify for confidential treatment.

(B) Documents and Information Exchanged Among the Parties. Documents (including deposition transcripts) and other information designated as confidential that are disclosed to another party during discovery or other proceedings before the Board shall be clearly marked as “PROTECTIVE ORDER MATERIAL” and shall be produced in a manner that maintains its confidentiality.

6. Within 60 days after the final disposition of this action, including the

exhaustion of all appeals and motions, each party receiving confidential information must return, or certify the destruction of, all copies of the confidential information to the producing party.

(k) Standard Acknowledgement of Protective Order. The following form may be used to acknowledge a protective order and gain access to information covered by the protective order:

[CAPTION]

Standard Acknowledgment for Access to Protective Order Material

I _____, affirm that I have read the Protective Order; that I will abide by its terms; that I will use the confidential information only in connection with this proceeding and for no other purpose; that I will only allow access to support staff who are reasonably necessary to assist me in this proceeding; that prior to any disclosure to such support staff I informed or will inform them of the requirements of the Protective Order; that I am personally responsible for the requirements of the terms of the Protective Order and I agree to submit to the jurisdiction of the Office and the United States District Court for the Eastern District of Virginia for purposes of enforcing the terms of the