

IN THE 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 REQUEST FOR ORAL ARGUMENT

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to the Board's August 23, 2024 Scheduling Order (Paper 16), Patent Owner (Exclusive Licensee) 10x Genomics, Inc. ("10x") respectfully requests oral argument, currently scheduled for May 16, 2025. 10x requests one hour in which to present its arguments, subject to any additional time allowed for participation in the LEAP program. Under 37 C.F.R. § 42.70, and without intending to waive any issue not specifically identified, 10x specifies the following issues to be argued:

1. Whether claims 36–39, 43, 44, 46, 47, 54, 56, 59, 60, 63–69 of U.S. Patent No. 11,542,554 ("the 554 patent") are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, and Shen;
2. Whether claim 40 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, Xiao, and Ehrlicher;
3. Whether claims 41 and 70 of the 554 patent are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Tirichine;
4. Whether claims 42 and 70 of the 554 patent are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Brileya;
5. Whether claim 45 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Fang-Yen;
6. Whether claim 48 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Richard;

7. Whether claim 49 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Nikon;
8. Whether claims 50 and 51 of the 554 patent are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, Nikon, and Skafte-Pedersen;
9. Whether claim 52 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Sands;
10. Whether claim 53 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, Sands, and Brooker;
11. Whether claims 55-58 of the 554 patent are unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and Wessels;
12. Whether claim 61 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, and the knowledge of a POSA;
13. Whether claim 62 of the 554 patent is unpatentable under 35 U.S.C. § 103 as obvious over Chen, Cai, Shen, Niman, and/or Winer;
14. Any issues specified by Petitioner in its Request for Oral Argument;
and
15. Any other issues the Board deems necessary for issuing a final written decision (e.g., any motion to exclude evidence and any motion to seal evidence).

10x also requests that the Board provide audio-visual equipment to display demonstrative exhibits, including a projector and screen for displaying documents from a computer.

Further, 10x requests that the hearing be held at the USPTO's Alexandria, Virginia office, because that location will be more convenient, have simpler logistics, and be less costly for 10x. 10x notes that its Counsel are located in the Washington, D.C. area. 10x also notes that Counsel for Petitioner also maintains an office in the Washington, D.C. area.

Respectfully submitted,

STERNE KESSLER GOLDSTEIN & FOX PLLC

/David H. Holman/

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Lead Attorney for Exclusive Licensee

Date: April 4, 2025

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

I certify that the above-captioned **PATENT OWNER'S REQUEST FOR ORAL ARGUMENT** was served in its entirety on April 4, 2025, upon the following parties via electronic mail:

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Respectfully submitted,

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Date: April 4, 2025

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