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

EXCLUSIVE LICENSEE 10X GENOMICS, INC.'S MOTION TO EXPUNGE CONFIDENTIAL INFORMATION UNDER 37 C.F.R. § 42.56

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

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.56, Exclusive Licensee 10x Genomics, Inc. ("10x") respectfully moves to expunge the confidential versions of the Patent Owner Response (Paper 21) and Exhibits 1083, 2024, 2026, 2064, and 2073 ("the confidential documents") from the record. The confidential documents contain confidential information relating to confidential design specifications of 10x's commercial Xenium product, as well as confidential financial information pertaining to Xenium sales revenue. The public's interests are served by the redacted versions of the Patent Owner Response (Paper 20), Exhibit 1083 (EX2083) and Exhibits 2024 and 2026. Thus, 10x's interest in expunging the confidential version of the confidential documents outweighs the public's interest in maintaining them in the record.

II. PROCEDURAL BACKGROUND

10x filed its Patent Owner Response under seal on December 10, 2024, along with a redacted version of the same. Papers 20 and 21. 10x filed Exhibits 2024, 2026, 2064, and 2073 also under seal, as well as filing redacted, public versions of Exhibits 2024 and 2026. 10x concurrently filed a Motion to Seal the confidential versions of the Patent Owner Response and Exhibits 2024, 2026, 2064, and 2073. Paper 22.

On March 18, 2025, Bruker filed its Petitioner's Reply. Accompanying that

Reply, Bruker filed Exhibit 1083 under seal, along with a Motion to Seal EX1083. Paper 28. 10x filed a Response in Support of Bruker's Motion to Seal EX1083 on April 18, 2025. Paper 33.

On May 30, 2025, the Board granted both 10x's and Bruker's Motions to Seal.[1] Paper 45.

This proceeding has now been terminated due to a settlement between the parties. *See* Papers 40 and 46. The Trial Practice Guide states that "[c]onfidential information that is subject to a protective order ordinarily would become public … 45 days after final judgment in a trial. … A party seeking to maintain the confidentiality of information, however, may file a motion to expunge the information from the record prior to the information becoming public." P.T.A.B. Trial Practice Guide (Nov. 2019) at 21-22; 37 C.F.R. § 42.56. 10x accordingly files this Motion to Expunge Confidential Information Under 37 C.F.R. § 42.56.

III. ARGUMENT

Under 37 C.F.R. § 42.56, "[a]fter denial of a petition to institute a trial or

[1] The Board also granted the parties' joint requests to treat the settlement agreement (EX1087) and collateral agreements (EX1088-1090) as business confidential information, kept separate from the file of the '554 patent. Paper 46, 4; *see also,* Paper 41; Paper 43.

after final judgment in a trial, a party may file a motion to expunge confidential information from the record." The Board has previously explained that a party moving to expunge has to show that i) "any information sought to be expunged constitutes confidential information" and ii) the movant's interest in expunging the information "outweighs the public's interest in maintaining a complete and understandable file history." *RPX Corp. v. Virnetx Inc.*, IPR2014-00171, Paper 62 at 3 (P.T.A.B. Sept. 9, 2014). The rules define "confidential information" as "a trade secret or other confidential research, development, or commercial information." 37 C.F.R. §§ 42.2 and 42.54(a)(7). In following the rules, the Board must "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." 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012); 37 C.F.R. § 42.54(a).

A. EX2064, EX2073, EX2024, and Paper 21 contain confidential design specifications

In this case, EX2064 and EX2073 contain confidential information pertaining to design specifications and design reviews of the Xenium commercial product, including design architecture, output specifications, electrical architecture, fluidics design, optics, chassis design, cooling system, and computing system specifications. Furthermore, 10x already demonstrated, and the Board agreed, that the sealed exhibits EX2064 and EX2073 contain confidential technical information. *See* Paper 45, at 4 ("We find that Exhibits 2064 and 2073 are the type

of research and development documents that businesses typically keep confidential to avoid competitive harm."); *see also*, 37 C.F.R. §§ 42.2, 42.54(a)(7).

EX2024, the Declaration of 10x's technical expert Dr. Hari Shroff, also discusses certain confidential information disclosed in EX2064 and EX2073. *See* EX2024, ¶¶121-122. The Board agreed in its Order Granting Patent Owner's Motion to Seal that EX2024 discussed said confidential information, noting that paragraphs 121 and 122 of the Shroff Declaration "discuss, excerpt, and/or otherwise disclose and rely on information in Exhibits 2064 and 2073" and that 10x had established good cause to seal those paragraphs "[f]or the same reasons set forth above with regard to the sealing of Exhibits 2064 and 2073." Paper 45, at 5-6; *see also*, 37 C.F.R. §§ 42.2, 42.54(a)(7).

Paper 21, the confidential version of the Patent Owner Response, likewise contains discussion of confidential information related to design specifications of the Xenium product. The Board recognized that "the redacted portion of page 61 of Patent Owner's Response discusses, quotes, and/or otherwise discloses and relies on research and development information contained in Exhibits 2024 and 2073, of a type that businesses typically keep confidential to avoid competitive harm." Paper 45, at 7; *see also,* 37 C.F.R. §§ 42.2, 42.54(a)(7).

Accordingly, EX2064, EX2073, paragraphs 121-122 of EX2024, and page 61 of the Patent Owner's Response (Paper 21) each contain "trade secret or other

confidential research, development, or commercial information" under 37 C.F.R. § 42.54(a) and should be subject to expungement under 37 C.F.R. § 42.56. Additionally, there has been no change in the sensitivity or confidentiality of the information contained in EX2064, EX2073, EX2024, or the Patent Owner Response since they were filed. 10x has therefore met its burden of showing that "any information sought to be expunged constitutes confidential information." *RPX Corp.*, IPR2014-00171, Paper 62 at 3.

B. EX2026, EX1083, and Paper 21 contain confidential financial information

EX2026, 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 10x's proprietary financial information that is also disclosed in Appendixes B and C of her declaration. *See* EX2026, ¶¶33-35, Appendix B, Appendix C. In granting Patent Owner's Motion to Seal, the Board agreed that EX2026 contains confidential financial information, noting that "the redacted portions of the Davis Declaration contain financial information relating to Patent Owner's commercial Xenium product, which are of the type that businesses typically keep confidential to avoid competitive harm." Paper 45, at 6; *see also*, 37 C.F.R. §§ 42.2, 42.54(a)(7).

EX1083, the deposition transcript of Ms. Julie Davis, also contains

confidential financial information pertaining to sales revenue associated with 10x's Xenium commercial product. During deposition, Ms. Davis was asked questions involving the same proprietary financial information discussed in Ms. Davis' declaration (EX2026). Upon reviewing EX1083 and its redacted version EX2083, the Board found that "the redacted information generally pertains to counsel's questions and Ms. Davis's responses reflecting financial information relating to Patent Owner's commercial Xenium product, which is the type of information that businesses typically keep confidential to avoid competitive harm." Paper 45, at 8; *see also*, 37 C.F.R. §§ 42.2, 42.54(a)(7).

Paper 21, the confidential version of the Patent Owner Response, likewise contains confidential information pertaining to sale revenue associated with 10x's Xenium product. In particular, pages 64-65 of Paper 21 contain excerpts from Ms. Davis' declaration EX2026. In granting the Patent Owner's Motion to Seal, the Board noted that "the material redacted on pages 64-65 of Patent Owner's Response discusses, quotes, and/or otherwise discloses and relies on financial information relating to Patent Owner's commercial Xenium product, of the type that businesses typically keep confidential to avoid competitive harm." Paper 45, at 7; *see also*, 37 C.F.R. §§ 42.2, 42.54(a)(7).

Accordingly, EX2026, EX1083, and pages 64-65 of the Patent Owner Response each contain "trade secret or other confidential research, development, or

commercial information" under 37 C.F.R. § 42.54(a) and should be subject to expungement under 37 C.F.R. § 42.56. Furthermore, there has been no change in the sensitivity or confidentiality of the information contained in EX2026, EX1083, and the Patent Owner Response since they were filed. Accordingly, 10x has met its burden of showing that "any information sought to be expunged constitutes confidential information." *RPX Corp.*, IPR2014-00171, Paper 62 at 3.

C. Patent Owner's interest in expunging EX2064, EX2073, EX2024, EX2026, and Paper 21 outweighs the public's interest in a complete and understandable file history

10x's interest in expunging EX2064, EX2073, EX2024, EX2026, and Paper 21 "outweighs the public's interest in maintaining a complete and understandable file history." *RPX Corp.*, IPR2014-00171, Paper 62 at 3. 10x has a strong interest in preserving the confidentiality of EX2064, EX2073, EX2024, and Paper 21 because the confidential information contained therein could be improperly used by competitors to gain unfair business and competitive advantages in the marketplace. This could include improperly using specifications and technical details of 10x's Xenium commercial product. Likewise, 10x has a strong interest in preserving the confidentiality of EX2026, EX1083, and Paper 21 because they contain confidential sales information related to the commercial Xenium product, which is the type of information that businesses typically keep confidential to avoid competitive harm.

Moreover, the record in IPR2024-00526 contains public, redacted versions of the Patent Owner's response (Paper 20), EX1083 (EX2083), EX2024, and EX2026. Thus, the public will continue to have access to the Patent Owner's arguments and the relied upon, non-confidential disclosures in these Exhibits. Expunging EX2064 and EX2073 is also appropriate here, as the general specifications of the Xenium product are provided in the papers and public exhibits, including the public, redacted version of EX2024.

Additionally, the Board did not rely on any of the confidential disclosures in these Exhibits or papers in rendering its Decision on Institution or its Decision on Termination Due to Settlement. *See generally*, Paper 14; Paper 46. No final written decision was issued in this case, and all sealed, confidential documents were submitted after trial was instituted. The confidential documents submitted during the trial thus have no effect on the determinations made in the institution decision, nor are they necessary to provide any understanding of the final result. Therefore, there is no public interest in seeing these confidential documents. Accordingly, the public's access to the redacted versions of these exhibits fulfills the public's interest in maintaining a complete and understandable record, and the expungement of the sealed versions of the Exhibits from the record will not diminish the public's understanding of the Board's Decisions.

IV. CONCLUSION

For the foregoing reasons, 10x respectfully requests that the Board expunge the confidential versions of the Patent Owner Response (Paper 21) and Exhibits 1083, 2024, 2026, 2064, and 2073.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/David H. Holman/

David H. Holman
Registration No. 61,205
Lead Attorney for Exclusive Licensee

Date: June 20, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

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

I certify that the above-captioned **EXCLUSIVE LICENSEE 10X GENOMICS, INC.'S MOTION TO EXPUNGE CONFIDENTIAL INFORMATION UNDER 37 C.F.R. § 42.56** was served in its entirety on June 20, 2025, upon the following parties via electronic mail:

Counsel for Petitioner Bruker Spatial Biology, Inc.
Derek C. Walter (Lead Counsel)
Concord Cheung (Back-up Counsel)
JONES DAY
dwalter@jonesday.com
concordcheung@jonesday.com
EXT-Bruker-10x@groups.jonesday.com

Counsel for Patent Owner President and Fellows of Harvard College
Ruben J. Rodrigues (Lead Counsel)
Sarah E. Rieger (Back-up Counsel)
Foley & Lardner LLP
rrodrigues@foley.com
srieger@foley.com
BOST-F-10Xv.Nanostring@foley.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/David H. Holman/

David H. Holman
Registration No. 61,205
Lead Attorney for Exclusive Licensee

Date: June 20, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600