

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,
Patent Owner.

Case IPR2024-00526
Patent 11,542,554 B2

Before ZHENYU YANG, TAWEN CHANG, and CYNTHIA M.
HARDMAN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER
Granting Motion to Expunge
37 C.F.R. § 42.56

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.56, 10x Genomics, Inc. (“10x Genomics”), the exclusive licensee of U.S. Patent No. 11,542,554 B2 at issue in this *inter partes* review, filed a motion seeking to expunge confidential versions of Patent Owner Response (Paper 21) and Exhibits 1083, 2024, 2026, 2064, and 2073 (collectively, “Sealed Documents”).¹ Paper 47 (“Motion” or “Mot.”). No opposition to the Motion has been filed.

“[A]fter final judgment in a trial, a party may file a motion to expunge confidential information from the record.” See 37 C.F.R. § 42.56. On May 30, 2025, we entered a Termination Decision due to Settlement After Institution of Trial (Paper 46) (“Decision” or “Dec.”). On June 20, 2025, 10x Genomics filed this Motion. For the reasons discussed below, the Motion is *granted*.

II. DISCUSSION

A strong public policy exists for making open to the public all information filed in this administrative proceeding. Only “confidential information” is protected from disclosure. 35 U.S.C. § 316(a)(7) (“The Director shall prescribe regulations . . . providing for protective orders governing the exchange and submission of confidential information.”). The Consolidated Trial Practice Guide (“TPG”) states:

¹ We granted Patent Owner’s Motion to Seal (Paper 22), relating to Exhibits 2064 and 2073 and portions of Exhibits 2024, 2026, and Patent Owner Response, as well as Petitioner’s Motion to Seal Exhibit 1083 (Paper 28), on May 30, 2025. Paper 45.

Confidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial. There is an expectation that information will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following 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. 37 C.F.R. § 42.56. The rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes. The rule encourages parties to redact sensitive information, where possible, rather than seeking to seal entire documents.

Consolidated Trial Practice Guide at 21–22 (Nov. 2019), available at <http://www.uspto.gov/TrialPracticeGuideConsolidated>. “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.” *Id.* at 19.

10x Genomics argues that the Sealed Documents “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.” Mot. 3–7. 10x Genomics represents that “there has been no change in the sensitivity or confidentiality of the information contained in [the Sealed Documents] since they were filed.” *Id.* at 5, 7.

10x Genomics asserts that its interest in expunging the Sealed Documents “outweighs the public’s interest in maintaining a complete and understandable file history” because the confidential information contained in the Sealed Documents “could be improperly used by competitors to gain unfair . . . advantages in the marketplace” and/or are of “the type . . . businesses typically keep confidential to avoid competitive harm,” and the record in this *inter partes* review contains public, redacted versions of the Patent Owner Response as well as Exhibits 1083, 2024, and 2026.² Mot. 7–8. 10x Genomics further notes that, because no final written decision was issued in this case, and all Sealed Documents were submitted after institution, the Board did not rely on any of the confidential information therein in rendering its decisions. *Id.* at 8.

We are persuaded by 10x Genomics’ contentions that expunging the Sealed Documents would protect its confidential information without harming the public’s interest in maintaining a complete and understandable filed history. The redacted, public versions of Patent Owner Response as

² The redacted, public versions of Patent Owner Response and Exhibit 1083 are filed as, respectively, Paper 20 and Exhibit 2083. 10x Genomics states that Exhibits 2064 and 2073 “contain confidential information pertaining to design specifications and design reviews of [its] Xenium commercial product.” Mot. 3. Although no redacted versions of Exhibits 2064 and 2073 were filed, 10x Genomics assert that expunging these exhibits is also appropriate, because “the general specifications of the Xenium product are provided in the papers and public exhibits, including the public, redacted version” of Exhibit 2024. *Id.* at 8.

well as Exhibits 1083, 2024, and 2026 will be retained in the record for public access.

III. ORDER

Accordingly, it is

ORDERED that 10x Genomics' Motion to Expunge confidential versions of the Patent Owner Response (Paper 21) and Exhibits 1083, 2024, 2026, 2064, and 2073, is *granted*.

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Patent 11,542,554 B2

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