

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

10X GENOMICS, INC.,
Petitioner,

v.

PRESIDENT AND FELLOWS OF HARVARD COLLEGE and UNITED
KINGDOM RESEARCH AND INNOVATION,
Patent Owners.

Case No. IPR2020-01467
U.S. Patent No. 9,919,277

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

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

PREFACE

Petitioner 10X Genomics (“10X”) submits the following reply pursuant to the Board’s Order. Paper 16 (Order Granting Petitioner’s Request for Authorization to File Briefing). The Board’s Order limits Petitioner to submitting only “the same arguments presented previously by Petitioner in IPR2020-1180 and IPR2020-1181” *Id.* at 5. The Board denied Petitioner’s request to submit briefing addressing the District Court’s orders issued after Petitioner’s briefs were submitted in IPR2020-1180 and IPR2020-1181. *See* Ex. 2032, Transcript of Jan. 7, 2021 Conference Call, 24:18-25:10. Consistent with the limitations of the Board’s Order, Petitioner submits herewith the same briefing and exhibits submitted in IPR2020-1180. *See* IPR2020-1180, Paper 16 and Exhibits 1082-1093; *see also* IPR2020-1181, Paper 16 and Exhibits 1182-1193. As Petitioner further explained on the January 7, 2021 Conference Call, these arguments also apply to the Petition in this proceeding and establish that the *Fintiv* factors collectively weigh in favor of institution including because the District Court has set only a trial ready date (not a trial date); no trial date is likely to be set until after the anticipated deadline for a final written decision in this proceeding due to the backlog of civil jury trials in the District Court due to the COVID-19 pandemic and the fact that District Court has yet to restart civil jury trials; the lack of substantive investment by the District Court in invalidity-related issues; the fact that Claims 7, 10, and 12 of the 277 Patent are challenged in this

Petition (including under grounds involving the Lee reference and the Walker reference) but are not at issue in District Court; the fact that Patent Owner states in its Preliminary Response that Petitioner's grounds involving the Tawfik and Walker references are not at issue in the District Court; and the strong merits of the Petition. *See* Ex. 2032. As also explained in the following briefing, the *NHK-Fintiv* rule is contrary to law, arbitrary and capricious, and procedurally invalid—providing additional, independent bases for declining to exercise discretionary denial.

* * *

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Case No. IPR2020-01180
U.S. Patent No. 8,871,444

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