

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 Owner.

IPR2020-01467 (Patent 9,919,277 B2)
IPR2020-01468 (Patent 9,919,277 B2)¹

Before GEORGIANNA W. BRADEN, WESLEY B. DERRICK, and
RICHARD J. SMITH, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Denying Petitioner's Request for Authorization for Supplemental Briefing
and to File Stipulation
37 C.F.R. § 42.5

¹ This Order addresses overlapping issues in the cases listed above.
Therefore, we issue one Order to be filed in each case. The parties,
however, are not authorized to use this style of filing.

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On Tuesday, January 19, 2021, Petitioner requested via email authorization to file: (1) a five page brief addressing the Board’s institution decision in *Samsung Electronics Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01204, Paper No. 21 (Jan. 13, 2021) (citing *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper No. 12 (Dec. 1, 2020) (Section II.A designated precedential) (“*Samsung Electronics* case”); and (2) a stipulation similar to that filed in the *Samsung Electronics* case. *See* Ex. 3001. Petitioner did not indicate in its email whether it had conferred with Patent Owner regarding its requests. The following day on Wednesday, January 20, 2021, Patent Owner objected to Petitioner’s requests via a responsive email to the Board. *See* Ex. 3002. For the reasons explained below, Petitioner’s requests are denied as untimely.

Previously, on January 7, 2021, counsel for both parties participated in a conference call with the Board. At no point during the conference did Petitioner seek guidance regarding a stipulation, request to file a stipulation, or request to file briefing regarding the decision in *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper No. 12 (Dec. 1, 2020) (“*Sotera Wireless* decision”), which issued on December 1, 2020, and was made precedential on December 17, 2020.² Rather, during the conference call,

² The petitioner in the *Sotera Wireless* case had voluntarily filed a stipulation in a parallel district court proceeding stating they would “not pursue in [the District Court Litigation] the specific grounds . . . [in] the instituted inter parties [sic] review petition, or on any other ground . . . that was raised or could have been reasonably raised in an IPR.” IPR2020-01019, Paper 12, 18–19. The petitioner in *Sotera Wireless* then filed its stipulation with the Board and indicated in its Reply to Patent Owner’s Preliminary Response that due to the stipulation “there will be no overlap of invalidity issues

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counsel for Petitioner requested authorization to file briefing in IPR2020-01467 and IPR2020-01468 responding to Patent Owner's arguments under 35 U.S.C. § 314(a). *See* Paper 16 ("Order on Conduct of the Proceeding").³ Petitioner filed the requested briefing on January 14, 2021. *See* Paper 18 ("Petitioner's Reply to Patent Owner's Preliminary Response").

On January 13, 2021, the Board issued decisions denying institution in related cases IPR2020-01180, Paper 23; and IPR2020-01181, Paper 23 ("denial decisions"). Less than four business days following the Board's denial decisions, Petitioner sent its email requesting to file a stipulation limiting its invalidity defenses in parallel district court proceeding. *See* Ex. 3001. Petitioner argues the Board should allow the requested briefing and stipulation because of, in effect, an intervening change in case law; Petitioner specifically cites to the *Samsung Electronics* case, which issued on the same day as the denial decisions in IPR2020-01180 and IPR2020-01181. *Id.*

Patent Owner objects to Petitioner's request arguing that this case is distinguishable from the *Samsung Electronics* case because Petitioner never proposed any stipulation prior to January 19, 2021, "even though it has had multiple opportunities to do so, including in its petition, in supplemental

between the [parallel district court proceeding] and [this inter partes review]." *See* IPR2020-01019, Reply 6. Based on petitioner's broad stipulation, the Board in the *Sotera Wireless* decision found there were no longer concerns of duplicative efforts making the *inter partes* review proceeding a "true alternative" to the district court proceeding." IPR2020-01019, Paper 12, 19.

³ Citations are to IPR2020-01467, but the same or similar filings are found in IPR2020-01468.

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briefing permitted by the Board, and during a recent conference call.” *See* Ex. 3002. Patent Owner further argues that Petitioner’s request is untimely because Petitioner waited until after “all the papers had been submitted and the Board declined to institute review [. . .] in IPR Nos. 2020-01180 and 2020-01181” and, therefore, is “an improper attempt to have a do-over now that it has seen unfavorable results from its original positions.” *Id.*

We have considered the parties respective arguments, and we agree with Patent Owner that Petitioner’s requests are untimely. The decision in the *Samsung Electronics* case may have issued on January 13, 2021, but it is not precedential and does not represent an intervening change in law. Rather, it relies on the *Sotera Wireless* decision that issued on December 1, 2020, and became precedential on December 17, 2020. The timing is important because these dates demonstrate that Petitioner had ample opportunity to request authorization to file a stipulation (1) during the January 7, 2021 conference call with Board or (2) prior to filing its Reply Briefing on January 14, 2021, but failed to do so on both occasions. Unlike the petitioner in the *Sotera Wireless* case, Petitioner did not file a stipulation with the district court nor did it seek to file one in these proceedings with its Reply briefing. Instead, it simply declined to seek such authorization until after receiving denial decisions in the related proceedings. To allow Petitioner to file the proposed stipulation in these proceedings now, after the normal time periods for briefing have passed, and without the justification of any intervening change in law, would invite improper gamesmanship in future proceedings. In particular, it reasonably would invite Petitioners to decline filing stipulations in a timely manner if they could seek to gain an advantage upon the Board issuing decisions in related proceedings that

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might inform the likelihood of obtaining a favorable decision as to institution absent the stipulation.

ORDER

Accordingly, it is:

ORDERED that Petitioner's request for additional briefing in IPR2020-01467 and IPR2020-01468 is *denied*; and

FURTHER ORDERED that Petitioner's request to file a stipulation in IPR2020-01467 and IPR2020-01468 is *denied*.

For PETITIONER:

Samantha A. Jameson

Utsav Gupta

Daniel M. Radke

TENSEGRITY LAW GROUP LLP

samantha.jameson@tensegritylawgroup.com

utsav.gupta@tensegritylawgroup.com

daniel.radke@tensegritylawgroup.com

For PATENT OWNER:

Derek Walter

WEIL, GOTSHAL & MANGES LLP

derek.walter@weil.com

Ruben J. Rodrigues

James P. McParland

FOLEY & LARDNER LLP

rrodrigues@foley.com

jmcparland@foley.com