

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

10X GENOMICS, INC.  
10X

v.

BIO-RAD LABORATORIES, INC.  
Bio-Rad

U.S. Patent No. 9,562,837 to Link  
Issue Date: February 7, 2017  
Title: Systems For Handling Microfluidic Droplets

*Inter Partes* Review No. IPR2020-00086

**10X'S NOTICE RANKING PETITIONS**

Petitioner 10X concurrently filed two petitions challenging certain claims of U.S. Patent 9,562,837 (“837 Patent”). Per the Trial Practice Guide Update (July 2019), 10X submits this Notice including (1) a ranking of the petitions in the order in which 10X wishes the Board to consider the merits, and (2) a succinct explanation of the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute both petitions if it identifies one petition that satisfies 10X’s burden under 35 U.S.C. § 314(a).

Although both of 10X’s petitions are meritorious and justified, 10X requests the Board to consider the Petitions according to the following ranking:

<b>Rank</b>	<b>Petition</b>	<b>Claims</b>	<b>Prior Art References 10X Relies Upon</b>
1	IPR2020-00086 (Petition 1)	1-4, 7-13, and 19-20	<p><b>Primary References:</b> Ismagilov Patent No. 7,129,091 B2 (“Ismagilov”); Ismagilov Publication No. 2006/0094119 A1 (“Ismagilov 119”)</p> <p><b>Secondary References:</b> Quake Publication No. 2002/0058332 A1 (“Quake”); Pamula Publication No. 2007/0243634 (“Pamula 634”); U.S. Patent Publication No. 2015/0148238 A1 (“Pamula 238”)</p>
2	IPR2020-00087 (Petition 2)	1-4, 7-13, and 19	<p><b>Primary Reference:</b> Thorsen, Todd (2003) <i>Microfluidic Technologies for High-Throughput Screening Applications</i>. Dissertation (Ph.D.), California Institute of Technology (“Thorsen”)</p> <p><b>Secondary Reference:</b> Ismagilov Patent No. 7,129,091 B2 (“Ismagilov”); Ismagilov Publication No. 2006/0094119 A1 (“Ismagilov 119”)</p>

The material differences between the petitions warrant institution on both. First, the two petitions proceed on different primary references and differ materially with respect to the earliest date to which the asserted prior art is entitled to claim priority. This difference has the potential to materially affect the conduct of these proceedings based on information that will not be resolved until after Bio-Rad's Responses have been filed.

Specifically, Claim 20 is only challenged in Petition 1, and the Board may find that its challenge requires the use of the Pamula reference(s). Further, 10X is not challenging Claims 3 and 7-9 under Ismagilov/Quake in Petition 1, and the Board may find that the challenge to Claims 3 and 7-9 requires the combinations with the Pamula reference(s), and the availability of the Pamula references is likely to be in dispute. These are material differences between Petition 1 and Petition 2.

Pamula 634 was filed on December 15, 2006. If, as 10X contends, the 837 Patent is not entitled to claim priority to any provisional prior to at the earliest December 20, 2006, then Pamula 634 is available as prior art. Likewise, Pamula 238 was filed January 30, 2015, but 10X is entitled to claim priority to an April 18, 2006, provisional for Pamula. Thus, each of the Pamula references being available as prior art will depend on a determination regarding claiming priority to a provisional application about which the parties may raise disputes that will not be resolved until after Patent Owner Responses have been filed.

Further, Bio-Rad has asserted in the co-pending district court litigation that the AIA does not apply to the 837 Patent, thus leaving the possibility that Bio-Rad will try to swear behind the prior art.

In contrast with Pamula, Thorsen, asserted in Petition 2, has a publication date of December 2, 2002. The earliest possible priority date for the 837 Patent is May 11, 2006. The difference between Pamula and Thorsen means that if Bio-Rad should somehow succeed at claiming Pre-AIA status, Bio-Rad might try to defeat Petition 1 by alleging an earlier date of invention, but would be unable to do so with respect to Thorsen in Petition 2.

Further, the petitions proceed on different groups of claim constructions. While Bio-Rad has not yet disclosed its claim constructions, Bio-Rad's infringement contentions imply certain important aspects of Bio-Rad's apparent claim construction positions as explained in the petitions. Accordingly, 10X submitted petitions that take into account both 10X's proposed constructions and the constructions that are rendered necessary by implication of Bio-Rad's infringement contentions—Petition 1 Grounds 3-5 proceed under 10X's claim constructions (while also meeting Bio-Rad's constructions) and Petition 2 based on Thorsen proceeds exclusively under Bio-Rad's constructions. To the extent that the Board has not yet determined which constructions are correct at the time of institution, the Board should institute review based on both petitions. This is because Thorsen

includes both textual and photographic disclosures of the challenged claims under Bio-Rad's expected constructions whereas Ismagilov is more focused on textual disclosures, though Ismagilov (alone and in combination) satisfies the challenged claims under 10X's constructions as well.

The following table summarizes these material differences.

<b>Material Difference</b>	<b>Petition 1 (IPR2020-00086)</b>	<b>Petition 2 (IPR2020-00087)</b>
Primary Reference(s) Asserted	Ismagilov Ismagilov 119	Thorsen
Potential effects of pre-AIA treatment	Possible that Bio-Rad will try to swear behind	Bio-Rad cannot try to swear behind as a matter of law
Claim construction	10X's constructions and Bio-Rad's expected constructions	Bio-Rad's expected constructions only
Evidence	Primarily textual	Textual and photographic

Given these material differences, the Board should use its discretion to institute both Petitions. The materiality will be increased if Bio-Rad tries to exclude prior art (such as on the basis of alleged priority) or if Bio-Rad contests the teachings of the prior art or the reasons why a person of ordinary skill in the art would combine the prior art as 10X contends. The Petitions are not redundant, duplicative, or substantially similar. Moreover, each Petition provides a strong showing of unpatentability and/or obviousness, without repeating the same theory or points.

The Board should exercise its discretion under § 314(a) to institute. The first five *General Plastic* factors weigh in favor institution: 10X filed the petitions for the

first time and on the same day. *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00873, Paper 14 at 8-12 (P.T.A.B. Oct. 29, 2018). As to factor 6 (i.e., the finite resources of the Board), the grounds asserted between the two petitions have similarities such as the use of the Ismagilov and Ismagilov 119 references that will allow the Board to efficiently evaluate the two petitions. *Id.* at 11. As to factor 7, the Board's resources will not be tasked to the degree that final written decisions will not be timely completed. *Id.*

The prior art in both petitions was buried among nearly 1,700 references disclosed during prosecution and was not discussed. Thorsen was not even disclosed to the Patent Office even though it was heavily litigated in the then-pending district court litigation while the application for the 837 Patent was pending. The prior art 10X relies upon is materially different from that considered by the Examiner; and is not cumulative of the art actually relied upon during prosecution. For example, Ismagilov 119 (under either party's constructions) and Thorsen (under Bio-Rad's expected construction) disclose the "separation chamber" with a "volume sufficient to separate," Ex. 1008, ¶ 214, which are elements Bio-Rad relied upon for allowance. Ex. 1002, 1168-69. The Board should not deny institution under §325(d).

For all of these reasons, 10X respectfully requests that the Board institute *Inter Partes Review* on both of the petitions.

Dated: October 25, 2019

Respectfully submitted,

/ Samantha A. Jameson /

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**CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))**

The undersigned hereby certifies that the above-captioned “10X’S NOTICE RANKING PETITIONS,” was served in its entirety on October 25, 2019, upon the following parties via FedEx:

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