IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CYTONOME/ST, LLC, Plaintiff, v. NANOCELLECT BIOMEDICAL, INC., Defendant,	)	CASE NO.: 1:19-cv-00301-RGA **JURY TRIAL DEMANDED**

DEFENDANT NANOCELLECT BIOMEDICAL, INC.'S
AMENDED STIPULATION OF INVALIDITY CONTENTIONS

On February 10, 2020, Defendant NanoCellect Biomedical, Inc., ("Defendant" or "NanoCellect") filed petition no. IPR2020-00545 with the Patent Trial and Appeal Board requesting *inter partes* review of U.S. Patent No. 6,877,528 ("the '528 patent"); on February 11, 2020, NanoCellect filed with the Patent Trial and Appeal Board petition no. IPR2020-00546 requesting *inter partes* review of U.S. Patent No. 9,339,850 ("the '850 patent") and petition no. IPR2020-00549 requesting *inter partes* review of U.S. Patent No. 10,029,263 ("the '263 patent"); and on February 12, 2020, NanoCellect filed with the Patent Trial and Appeal Board petition no. IPR2020-00547 requesting *inter partes* review of U.S. Patent No. 10,029,283 ("the '283 patent"), petition no. IPR2020-00548 requesting *inter partes* review of U.S. Patent No. 8,623,295 ("the '295 patent"), petition no. IPR2019-00550 requesting *inter partes* review of U.S. Patent No. 9,011,797 ("the '797 patent"), and petition no. IPR2020-00551 requesting *inter partes* review of U.S. Patent No. 10,065,188 ("the '188 patent").

The petitions asserted the following grounds of invalidity:

IPR Petition No.	Patent No.	Ground	Claims	Grounds of Unpatentability
IPR2020-00545	'528 patent	1	18-22	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	23-24	Obvious under 35 U.S.C. §103 over Wada in view of International PCT Publication No. WO 97/02357 ("Anderson")
		3	18-24	Obvious under 35 U.S.C. §103 over U.S. Patent No. 5,101,978 ("Marcus") in view of Anderson
IPR2020-00549	'263 patent	1	1, 5-6, and 15-16	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	1, 5-6, 8, and 15-16	Obvious under 35 U.S.C. §103 over Wada in view of International PCT Publication No. WO 97/02357 ("Anderson")
IPR2020-00546	'850 patent	1	1 and 7-12	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	1 and 7-12	Obvious under 35 U.S.C. §103 over Wada in view of International PCT Publication No. WO 97/02357 ("Anderson")
		3	6	Obvious under 35 U.S.C. §103 over Wada in view of Anderson and U.S. Patent Publication No. 2002/0122167 ("Riley")
		4	6	Obvious under 35 U.S.C. §103 over Wada in view of Anderson and U.S. Patent No. 4,148,585 ("Bargeron").
		5	1 and 7-12	Obvious under 35 U.S.C. §103 over U.S. Patent No. 5,101,978 ("Marcus") in view of Anderson
		6	6	Obvious under 35 U.S.C. §103 over Marcus and Anderson in view of Riley
		7	6	Obvious under 35 U.S.C. §103 over Marcus and Anderson in view of Bargeron
IPR2020-00547	'283 patent	1	1, 5, 6	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	1-2, 4-6	Obvious under 35 U.S.C. §103 over Wada in view of PCT International Publication No. WO 97/002357 ("Anderson")
		3	9 and 11	Obvious under 35 U.S.C. §103 over Wada in view of Anderson and U.S. Patent Publication No. 2002/0122167 ("Riley")

		4	11	Obvious under 35 U.S.C. §103 over Wada in view of Anderson and U.S. Patent No. 4,148,585 ("Bargeron").
IPR2020-00551	'188 patent	1	1, 10, 12, 15, 17	Anticipated under 35 U.S.C. §102(b) by U.S. Patent Application Publication No. 2003/0196714 ("Gilbert")
		2	1, 10, 12, 15, 17	Obvious under 35 U.S.C. §103 over Gilbert
		3	11	Obvious under 35 U.S.C. §103 over Gilbert in view of U.S. Patent No. 6,325,114 ("Bevirt")
		4	1, 10, 12, 15, 17	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		5	11	Obvious under 35 U.S.C. §103 over Wada in view of Bevirt
IPR2020-00548	'295 patent	1	1-3, 9, 18	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	1-3, 9, 17-18	Obvious under 35 U.S.C. §103 over Wada in view of International PCT Publication No. WO 97/002357 ("Anderson")
		3	1-3, 9, 17-18	Obvious under 35 U.S.C. §103 over U.S. Patent No. 5,101,978 ("Marcus") in view of Anderson
IPR2019-00550	'797 patent	1	1-2, 5, 13, 16, 18-19	Obvious under 35 U.S.C. §103 over International PCT Publication No. WO 00/70080 ("Wada")
		2	1-2, 5, 13, 16, 18-19	Obvious under 35 U.S.C. §103 over Wada in view of International PCT Publication No. WO 97/002357 ("Anderson")
		3	1-2, 5, 13, 16, 18-19	Obvious under 35 U.S.C. §103 over U.S. Patent No. 5,101,978 ("Marcus") in view of Anderson

NanoCellect hereby stipulates that if the Patent Trial and Appeal Board institutes *inter partes* review on IPR2020-00545, IPR2020-00546, IPR2020-00547, IPR2020-00548, IPR2020-00549, IPR2019-00550, and/or IPR2020-00551, then NanoCellect will not pursue in this case the specific grounds identified above in connection with the referenced patent(s) and claim(s) as originally issued of the instituted *inter partes* review petition or on any other ground for a given patent that could reasonably have been raised in an instituted *inter partes* review for that patent using the same grounds references or substantially similar references (*e.g.*, Gilbert 7,069,943, Gilbert 8,210,209, and Wada U.S. Patent No. 6,506,609).

This stipulation is not intended and should not be construed to limit NanoCellect's ability to assert invalidity of the asserted claims of the '528 patent, '295 patent, '797 patent, '850 patent, '263 patent, '283 patent, and '188 patent in this case on any other ground regardless of whether *inter partes* review is instituted.

On November 19, 2019, "[p]ursuant to the parties' agreement to streamline the case" Cytonome limited the asserted claims from 104 to 42 asserted claims. Ex. A. On December 12, 2019, NanoCellect moved the Court to further order a reduction of asserted claims because the "scope of th[e] case [was] unmanageable." Ex. B. The Court denied NanoCellect's motion at the time "without prejudice to reconsideration." Ex. C. On April 28, 2020, at the *Markman* hearing this Court ordered Cytonome to reduce the number of asserted claims to 20. On June 16, 2020, Cytonome reduced the case to the adjudication of the following 20 asserted claims:

'528 Patent: 18, 20, 22, 23;
'295 Patent: 1, 3, 17, 18;
'797 Patent: 1, 13, 16, 19;
'850 Patent: 1, 7, 8;
'263 Patent: 1, 8, 15, 16; and
'188 Patent: 17.

Ex. D.

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was filed with the Court's CM/ECF system which will provide notice on all counsel deemed to have consented to electronic service. All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing document by mail on this day.

Dated: July 1, 2020

By: *<u>/s/ Ian R. Liston</u>*
Ian R. Liston (#5507)