

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOCELLECT BIOMEDICAL, INC.,
Petitioner,

v.

CYTONOME/ST, LLC,
Patent Owner.

Case No. IPR2020-00548
Patent No. 8,623,295

PETITIONER'S PRE-INSTITUTION SUPPLEMENTAL BRIEFING¹

¹ Authorization for this briefing was given on June 14, 2020, via teleconference.

During a July 14, 2020, teleconference, the Board authorized this briefing to address the status of NanoCollect's invalidity counterclaims in the underlying Delaware case. EX1062, 15:4-13. Specifically, Cytonome argued in its sur-replies that Petitioner "still maintains its declaratory judgment invalidity counterclaim against all claims of the [asserted patents]." Cytonome's assertion is not correct.

First, NanoCollect's stipulations broadly cover whatever is adjudicated in the Delaware case. EX1048, 3 ("...NanoCollect will not pursue in this case..."); EX1063 at 3 (same).

Second, the Delaware case has now been limited to the 20 asserted claims in Cytonome's June 16, 2020, letter and, as a result, NanoCollect is no longer pursuing invalidity counterclaims against non-asserted claims in the Delaware case. In other words, any claims other than the 20 asserted claims in Cytonome's June 16, 2020, letter will not be adjudicated in the Delaware case. This is reflected in the stipulation, which provides:

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, NanoCollect 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 NanoCollect'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.

EX1063 at 4 (emphasis added).

As reflected in the Amended Stipulation, the parties' agreement and the Court's order to streamline the Delaware case limit the claims at issue there to the 20 asserted claims identified above. None of the other 100+ originally asserted claims will be adjudicated in the Delaware case. This is true both for Cytonome's infringement complaint and for NanoCollect's invalidity counterclaims. Thus, the non-asserted claims will not be adjudicated in the Delaware case and will not be included in NanoCollect's invalidity expert reports due next month. Simply put, NanoCollect does not maintain its declaratory judgment invalidity counterclaim against the non-asserted claims, including the following non-asserted IPR claims: '528 Patent: 19, 21, and 24; '295 Patent: 2, 9; '797 Patent: 2, 5, 18; '850 Patent: 6, 9, 10, 11, 12; '263 Patent: 5, 6; '188 Patent: 1, 10, 11, 12, 15; and '283 Patent: 1, 2, 4, 5, 6, 9, 11.

That the non-asserted IPR claims will not be adjudicated in the Delaware case is not just guaranteed by private obligation but also by force of law. As explained in Exhibit B to the Amended Stipulation, the Court's order to streamline the case was based on the Court's "broad discretionary power to manage this case to ensure that judicial resources are efficiently allocated," in accordance with *Landis v. N. Am. Co.*, 299 U.S. 248, 254-55 (1936); *Personalized User Model LLP v. Google, Inc.*, C.A. No. 09-525-LPS (D. Del. Sept. 8, 2010) (D.I. 88 at 26:17-18; 27:2-9) (ordering reduction of asserted claims to 15 because "[t]he jury can only be expected to work through so many asserted claims[.]"). Neither NanoCollect nor Cytonome can expand the Delaware case beyond the 20 asserted claims.

In sum, the Delaware case will only adjudicate the 20 asserted claims, and NanoCollect's stipulations ensure NanoCollect "will not pursue" in the Delaware case the instituted IPR grounds or any other ground for a given patent that reasonably could have been raised in an instituted IPR for that patent using the same references or substantially similar references (*e.g.*, Gilbert 7,069,943, Gilbert 8,210,209, and Wada U.S. Patent No. 6,506,609). EX1062, 3-4.

Respectfully submitted,

Dated: July 17, 2020

/Michael T. Rosato /
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WILSON SONSINI GOODRICH &
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Case No. IPR2020-00548

Patent No. 8,623,295

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e) and 42.105(a), this is to certify that I caused to be served a true and correct copy of the foregoing Petitioner's Pre-Institution Supplemental Brief by electronic mail, on this 17th day of July, 2020, on the Patent Owner at the correspondence address of the Patent Owner as follows:

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