



Press release dated October 2, 2023

## **BARDEHLE PAGENBERG secures landmark UPC victory for 10x Genomics against NanoString**

**By decision and orders (decision) of September 19, 2023, the Munich Local Division of the European Unified Patent Court (UPC) granted the first ever preliminary injunction based on the first ever asserted Unitary Patent in favor of 10x Genomics against NanoString with effect in all 17 UPCA member states (docket no. UPC CFI 2/2023). This is another, most important win of 10x Genomics in an ongoing international patent litigation battle against NanoString.**

10x Genomics is a highly innovative US life science company that designs and manufactures life science technology used in basic scientific research. It vigorously protects ground-breaking intellectual property that underlies its Xenium platform. 10x Xenium platform allows analyses of gene expression in tissues and distinguishes itself in characteristics that matter most to scientists.

On June 1, 2023, the day the UPC started operations, 10x Genomics filed two requests for preliminary injunctions based on two European patents, namely EP 2 794 928 (classic bundle patent validated in Germany, France and the Netherlands) and EP 4 108 782 (Unitary Patent valid in all 17 UPCA member states): [10x Genomics Files Two New Lawsuits Requesting Preliminary Injunctions Against NanoString's CosMx Products | 10x Genomics](#).

EP 4 108 782 is the very first Unitary Patent asserted at the UPC. After extensive briefing, a two-days *inter partes* hearing took place on September 5 and 6, 2023, i.e. about three months after filing, and the very first substantive one of the UPC as a whole. The Munich Local Division pronounced the decision on September 19, 2023, granted a preliminary injunction in favor of 10x Genomics and served the written reasons on the parties on September 20, 2023. It held that NanoString infringed the patent, that the patent is valid with a high likelihood and that 10x Genomics' interests in interim relief outweigh NanoString's interests in continuing the infringing business within the UPC territory. The Munich Local Division rejected many other arguments by NanoString and did not order 10x Genomics to provide an enforcement security so that the injunction became effective immediately on September 20, 2023. Specifically, the Munich Local Division held that NanoString Technologies Inc., NanoString Technologies Germany GmbH, and

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NanoString Technologies Netherlands B.V. infringe the patent directly and indirectly by offering and distributing their products CosMx Spatial Molecular Imager and CosMx reagents for RNA detection. NanoString has filed an appeal on which no decision has been rendered yet.

NanoString filed an opposition against EP 4 108 782 with the EPO on July 21, 2023 which is ongoing but did not file a central revocation action at the UPC.

Regarding EP 2 794 928, a one-day hearing was held on September 19, 2023, a decision will be pronounced on October 10, 2023 (docket no. UPC\_CFI\_17/2023).

Meanwhile 10x Genomics also filed main infringement proceedings based on both patents against NanoString at the Munich Local Division which are ongoing (docket nos. ACT\_573637/2023 and ACT\_568963/2023).

On July 27, 2023 NanoString filed a central revocation action against EP 2 794 928 at the Munich Central Division of the UPC (docket no. UPC\_CFI\_252/2023).

NanoString Technologies GmbH also filed a German nullity action against the German part of EP 2 794 928 (docket no. 3 Ni 20/22 (EP)). However, pursuant to the written preliminary opinion of the Federal Patent Court of February 7, 2023, the patent is valid in the form asserted in the infringement proceedings. A trial was scheduled for May 7, 2024.

In March 2022, 10x Genomics had filed two patent infringement lawsuits against NanoString with the Regional Court of Munich I based on EP 2 794 928. On May 17, 2023 the Regional Court of Munich I held that NanoString Technologies Inc. and NanoString Technologies Germany GmbH infringe the patent by offering and distributing their products CosMx Spatial Molecular Imager and CosMx reagents in Germany for RNA detection (docket nos. 7 O 2693/22 and 7 O 5812/22; [BARDEHLE PAGENBERG paves way to successful infringement proceedings for 10x Genomics with anti-anti-suit-injunction | BARDEHLE PAGENBERG; 10x Genomics Wins Permanent Injunction Against NanoString's CosMx Products | 10x Genomics](#)). Both injunctions were provisionally enforced against a security bond. NanoString Technologies Inc. and NanoString Technologies GmbH filed an appeal which is pending.

Prior to these judgements NanoString Technologies Inc. tried to prevent the pronouncement and enforcement by filing an anti-suit/enforcement injunction in parallel U.S. proceedings with the U.S. District Court for the District of Delaware on April 27, 2023. On April 28, 2023, 10x Genomics obtained an *ex parte* anti-anti-suit/enforcement



injunction from the Regional Court of Munich I and initiated its enforcement. Subsequently, NanoString Technologies Inc. withdrew their anti-suit/enforcement injunction request before the U.S. Court and filed an appeal before the German Court. After the exchange of various briefs and an oral hearing held on July 20, 2023, the German Court confirmed the anti-anti-suit/enforcement injunction by judgment of the same day and ordered NanoString Technologies Inc. to bear the costs of the proceedings (docket no. 7 O 5416/23; [BARDEHLE PAGENBERG achieves another victory for 10x Genomics against NanoString | BARDEHLE PAGENBERG](#)). The judgment is subject to another appeal.

#### **Representatives of 10x Genomics:**

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#### **Munich Local Division**

Judge Dr. Matthias Zigann (Presiding Judge, DE)

Judge Tobias Pichlmaier (Judge Rapporteur, DE)

Judge András Kupecz (LQJ, NL)

Judge Eric Enderlin (TQJ, FR)



**BARDEHLE PAGENBERG** combines the professional expertise of attorneys-at-law, patent attorneys, professional representatives before the European Patent Office, specialized trademark lawyers and qualified technical consultants. Our consulting services are tailored to our clients' individual needs and the specific circumstances of each case.

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