



Press release dated December 12, 2023

AAS/EIs available at Munich Local Division of the UPC

On October 5, 2023, BARDEHLE PAGENBERG requested – on behalf of their client 10x Genomics – the first ever preemptive anti-anti-suit/enforcement injunction (AAS/EI) at the Unified Patent Court (UPC) against NanoString to protect the enforcement of a preliminary injunction granted by the Munich Local Division (MLD) based on the Unitary Patent EP 4 108 782 B1 ([LD Munich, 19 September 2023, decision and orders on preliminary measures, UPC CFI 2/2023 » UPC Law](#)). With preliminary order of October 6, 2023 (docket no. UPC CFI 357/2023) issued by the presiding judge, the MLD made clear that it would grant an *ex parte* AAS/EI if NanoString would not provide a sufficient cease and desist declaration to not request an AS/EI with the US Delaware District Court within a very short deadline. As a consequence, NanoString provided a respective cease and desist declaration under contractual penalty so that a decision by the MLD was no longer necessary and the proceedings were terminated.

The background of this case is that NanoString had already previously tried to obstruct/delay the grant of an injunction in parallel national infringement proceedings in Germany by way of an AS/EI request before the United States District Court for the District of Delaware. This was countered by 10x Genomics by successfully requesting an AAS/EI before the Regional Court of Munich I (docket no. 7 O 5416/23), which was granted within 24 hours ([BARDEHLE PAGENBERG paves way to successful infringement proceedings for 10x Genomics with anti-anti-suit-injunction | BARDEHLE PAGENBERG](#)). This AAS/EI was later confirmed upon NanoString's appeal after the oral hearing and the subsequent judgment dated July 20, 2023 ([BARDEHLE PAGENBERG achieves another victory for 10x Genomics against NanoString | BARDEHLE PAGENBERG](#)).

Notably, 10x Genomics had sent a warning letter to NanoString before approaching the UPC in this regard. NanoString failed to provide the respective cease and desist declaration in response and in the subsequent oral hearings at the UPC and the oral hearing in the German AAS/EI-proceedings at the Regional Court Munich I.

10x Genomics is a highly innovative US life science company that designs and manufactures life science technology used in basic scientific research. In March 2022, it

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filed two patent infringement lawsuits against NanoString with the Regional Court of Munich I to protect its ground-breaking intellectual property underlying its Xenium platform. The 10x Xenium platform allows analyses of gene expression in tissues and distinguishes itself in characteristics that matter most to scientists.

The German patent infringement action against NanoString is based on indirect infringement of claim 1 of the European patent EP 2 794 928 B1 restricted particularly to in-situ detection of RNA molecules (the patent). 10x Genomics obtained an exclusive license to the patent. On May 17, 2023, the Court held that NanoString Technologies Inc. and NanoString Technologies GmbH infringe the patent by offering and distributing their products CosMx Spatial Molecular Imager and CosMx reagents for RNA detection in Germany (docket nos. 7 O 2693/22 and 7 O 5812/22). Both injunctions were provisionally enforced against a provision of security. NanoString Technologies Inc. and NanoString Technologies GmbH filed an appeal, which is currently pending.

On September 19, 2023, the MLD 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 Member States of the Agreement on a Unified Patent Court (UPCA) (docket no. UPC CFI 2/2023; [BARDEHLE PAGENBERG secures landmark UPC victory for 10x Genomics against NanoString | BARDEHLE PAGENBERG](#)). The patent at issue is EP 4 108 782. After extensive briefing, a two-day *inter partes* hearing took place on September 5 and 6, 2023, *i.e.* about three months after filing. This was the UPC's very first substantive hearing. The MDL pronounced the decision on September 19, 2023 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 clearly preponderant likelihood and that 10x Genomics' interests in interim relief outweigh NanoString's interests in continuing the infringing business within the UPC territory. The MLD rejected many other arguments made by NanoString and did not order 10x Genomics to provide an enforcement security. Thus, the injunction became effective immediately on September 20, 2023. Specifically, the MLD held that NanoString Technologies Inc., NanoString Technologies Germany GmbH, and 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 a decision has not been yet rendered. Meanwhile, parallel UPC main infringement proceedings are pending at the MLD.

Representatives of 10x Genomics:

BARDEHLE PAGENBERG (Munich, Germany)



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Munich Local Division

Presiding Judge Dr. Matthias Zigann

Judge Rapporteur: Tobias Pichlmaier

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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