

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ILLUMINA, INC.

Petitioner,

V.

THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF

NEW YORK

Patent Owner.

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Case IPR2012-00007  
U.S. Patent 7,790,869

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Oral Hearing Held December 17, 2013

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Before SALLY GARDNER LANE, RICHARD M. LEBOVITZ, and  
DEBORAH KATZ, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

Case IPR2012-00007  
U.S. Patent 7,790,869

APPEARANCES:

On Behalf of Petitioner:

Jeffrey N. Costakos  
FOLEY & LARDNER, LLP

Robert Lawler  
REINHART BOERNER VAN DEUREN S.C.

Marcus Burch  
Roland Schwillinski  
ILLUMINA, INC.

On Behalf of Patent Owner:

Jon White  
COOPER & DUNHAM LLP

Anthony Zupcic  
Robert Schwartz  
Donald Curry  
FITZPATRICK, CELLA, HARPER & SCINTO

P R O C E E D I N G S

JUDGE LANE: Let's go on the record, please.

We're here today in three related IPRs. The parties are the Petitioner, Micron Technology Inc., the Patent Owner, the Board of Trustees of the -- I'm sorry. Sorry. Wrong one. Let me try that again.

The parties are the Petitioner, Illumina, Inc.; and the Patent Owner, the Trustees of Columbia University in the City of New York. The IPR numbers are 2012-00006, 2012-00007, and IPR 2013-00011.

What we'll do is start out and have the Petitioner, Illumina, introduce yourself and who you brought with you.

MR. COSTAKOS: Yes, Your Honor. My name is Jeff Costakos, of Foley & Lardner, representing Illumina. With me today is Robert Lawler from the Reinhart firm and Marcus Burch is also at counsel table. And behind me is Roland Schwillinski, also with Illumina.

JUDGE LANE: Welcome.

And who is for Patent Owner?

MR. WHITE: John White.

JUDGE LANE: Mr. White.

MR. WHITE: John White, Your Honor. I'm here for the Patent Owner,

Columbia University.

With me is Anthony Zupcic from the Fitzpatrick firm, who is the back-up counsel in the case; and Robert Schwartz from the Fitzpatrick firm; and Donald Curry who is from the Fitzpatrick firm. And he will be participating this morning on the one part about the objective indicia in our presentation.

JUDGE LANE: Okay. Welcome.

All right. So each side will have an hour to present your arguments. We'll begin with the Petitioner.

The Petitioner and Patent Owner as well may reserve time for rebuttal. When you get up, let me know how much of your one hour you would like to reserve for rebuttal. So, we'll go Petitioner, Patent Owner, Petitioner, Patent Owner, in that order.

Would you like to go ahead and get started?

MR. COSTAKOS: Yes, Your Honor. I would like to reserve 20 minutes for rebuttal.

JUDGE LANE: 20 minutes? Okay.

MR. COSTAKOS: Thank you, Your Honor.

May it please the Board, as I indicated, my name is Jeff Costakos, and I represent Illumina.

The claims at issue in this IPR are all invalid, and I think this first slide, which is for the record slide number 2.

JUDGE LANE: I'm sorry. Did you bring copies of your demo?

MR. COSTAKOS: Oh, yes, I did.

(Whereupon, there was a pause in the proceedings.)

MR. COSTAKOS: As I indicated, this slide, which, for the record, is slide number 2 of our invalidity demonstrative, I think it does a good job of illustrating exactly why the Columbia claims that are at issue in this lawsuit are invalid.

The original independent claims of the Ju patents and the Columbia patents are claims, for the most part, a method of doing DNA sequencing where a label was attached to the base, a cleavable label is in most instances in the claim, and where a capping group was at the 3'-OH position, removable capping group.

As the Board previously found, and as shown in this slide, the Tsien reference actually shows each one of those limitations that were in the independent claims. As we'll talk about in a few moments, Tsien shows examples where it has a label attached to the base, cleavable labels specifically, and where there is a removable cap improvement at the 3'-OH position. And it does it for the DNA sequencing purposes.

So as the Board found in its order initiating the trial, the Tsien reference discloses each and every element of the independent -- original independent claims of the Columbia patents.

And I think the correctness of the Board's original decision was shown by the fact that Columbia cancelled all of its original independent claims and has really made no attempt in this IPR to defend the validity of those independent claims.

JUDGE LEBOVITZ: So you're only -- will be addressing the claims as a mass -- you are only addressing the claims as amended?

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