Trials@uspto.gov
572-272-7822

Paper 137
Entered: February 27, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.
Petitioner,
V.

THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF NEW YORK
Patent Owner.

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

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

LANE, *Administrative Patent Judge*.

DECISION
Miscellaneous Motion
37 C.F.R. § 42.20

I. Introduction

On 25 February 2013, Columbia requested, via email communication to the Board, authorization under 37 CFR 42.20(b) to file a motion to submit supplemental information. 37 CFR 42.123(b). (Request, copy attached). Columbia indicates that Illumina opposes the Request. The Request is DENIED.

II. Background

Trial was instituted on 12 March 2013 (Decision on Petition, Paper 38). As the pendency before the Board after institution of trial normally should not exceed one year, the Board intends to issue a Final Decision no later than 11 March 2014. *See* 35 USC § 316 (a)(11); 37 CFR § 42.100(c).

The supplemental information that is the subject of the Columbia Request is the deposition testimony of Dr. David Barker, said to have been taken during parallel District Court litigation on 7 February 2014. Columbia indicates that "February 7 was the earliest date on which Dr. Barker's deposition could have been taken." Columbia further indicates that "the deposition record contains evidence that directly rebuts Illumina's prima facie obviousness case, and strongly supports Columbia's objective indicia evidence of Illumina's efforts to license Columbia's patented technology." (Request).

Recognizing the time for Final Decision is close at hand, Columbia argues that "its motion papers will amply show good cause for extension of the due date [up to 6 months under 35 USC 316 (a) (11) and 42.100(c)] to permit evaluation of the supplemental information." (Request).

III. Discussion

The Board administers each trial such that pendency before the Board is normally no more than one year. 35 USC § 316 (a)(11); 37 CFR § 42.100(c). In accordance with this aim, our rules require that a party seek relief promptly after the need for the relief is identified. A delay in seeking the relief may justify denial of the relief sought. 37 CFR § 42.25(b). We construe our rules "to secure the just, speedy, and inexpensive resolution of every proceeding." 37 CFR § 42.1(b).

In the situation before us, Columbia requests to file a late submission of supplemental information, two weeks before Final Decision and, more significantly, *nineteen* days after the deposition of Dr. Barker is said to have occurred. Under these particular circumstances, Columbia's delay of nineteen days in seeking relief, especially given its proximity to the time for Final Decision, justifies denial of the relief sought. Given this denial, we need not and do not address Columbia's argument that it could show good cause to extend the pendency of the trial past one year.

IV. Order

It is

ORDERED the Columbia Request is DENIED.

PETITIONER:

Robert Lawler
illuminaiprs@reinhartlaw.com

James Morrow
illuminaiprs@reinhartlaw.com

PATENT OWNER:

John White
jwhite@cooperhunham.com

Anthony Zupcic
clombiaipr@fchs.com

From: Zupcic,Anthony [mailto:AZupcic@fchs.com]
Sent: Tuesday, February 25, 2014 5:31 PM
To: Trials
Cc: A Selikson; ColumbiaIPR; G Gershik; Illumina; J. Costakos; John White
Subject: IPR2012-00006, IPR2012-00007, and IPR2013-00011 - teleconference re motion under Rule 42.123(b)

Patent Owner Columbia University requests a teleconference to seek the Board's permission to file a motion under Rule 42.123(b) to submit supplemental information in the above referenced proceedings. Both requirements of the rule are met.

Columbia has conferred with counsel for Petitioner Illumina, and Illumina opposes Columbia's request for permission to the file a motion.

1. The supplemental information reasonably could not have been obtained earlier.

On February 7, 2014, Columbia took the deposition of Dr. David Barker in the parallel district court litigation. Dr. Barker was the Chief Scientific Officer of Illumina from 2000-07 and is currently on Illumina's Scientific Advisory Board. February 7 was the earliest reasonable date on which Dr. Barker's deposition could have been taken, as Columbia can explain on the teleconference.

2. Consideration of the supplemental information would be in the interests of justice.

Dr. Barker's deposition transcript and its exhibits are currently designated "Highly Confidential – Attorneys Eyes Only" under the proposed protective order in the litigation, so the specifics of the supplemental information Columbia cannot be disclosed here. The fundamental point, however, is that the deposition record contains evidence that directly rebuts Illumina's prima facie obviousness case, and strongly supports Columbia's objective indicia evidence of Illumina's efforts to license Columbia's patented technology. Columbia will be severely prejudiced if it is not permitted to submit this supplemental information for the Board's consideration in deciding the merits of these IPRs.

Although Columbia wishes to submit the entire Barker transcript for the sake of completeness, Columbia anticipates that the supplemental information to be considered by the Board would be about 30 pages (or portions thereof) of testimony and no more than 5 exhibits, and Columbia's motion will highlight the specific relevant testimony.

* * * * *

Columbia recognizes that the Board's decision in these IPRs is close at hand and due no later than March 12, 2014. Should consideration of this supplemental information affect that due date, Columbia believes that any extension would be insubstantial relative to the 6 month extension that is authorized by statute. 35 U.S.C. §316(a)(11). Columbia believes that its motion papers will amply show good cause for extension of the due date to permit evaluation of the supplemental information.

Respectfully submitted,

DOCKET ALARM

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