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Paper No. 139
Entered: March 6, 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
Request for Rehearing
37 C.F.R. § 42.71(d)(1)

I. Introduction

Columbia requests rehearing under 37 CFR 42.71(d) (1) (Request, Paper 138) of our Decision (Decision, Paper 137) denying its request for authorization to file a motion for late submission of supplemental information. We have considered the Columbia Request but do not authorize the filing of the motion.

II. Background

In the Decision we stated:

> 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.

(Decision at 3).

III. Discussion

The burden of showing a decision should be modified lies with the party challenging the decision. 37 CFR § 42.71(d).

In the Request, Columbia argues that the delay of nineteen days cited in the Decision was not a delay because Columbia "expeditiously took the necessary steps to determine whether the amount and substantive significance of the new evidence warranted seeking approval to submit that information with the time for Final Decision close at hand." (Request at 2). Columbia cites to activities it undertook during the nineteen days after Dr. Barker's deposition including waiting for the final deposition transcript,[1] reviewing and analyzing the transcript and exhibits, considering the significance of the testimony, and conferring with its client and Illumina counsel.

Despite Columbia's additional explanation for the delay, we are not persuaded that Columbia acted as promptly as it could or should have under the circumstances. Columbia indicates that Dr. Barker's testimony "directly undermines Illumina's prima facie obviousness arguments, and strongly supports Columbia's objective indicia evidence." (Request at 2). Given the professed significance of Dr. Barker's testimony and with the time for final decision close at

[1] Columbia does not indicate if or when it received any earlier "non-final" version of the transcript.

hand, it would seem reasonable to contact the Board shortly after the testimony was given.

Columbia does not explain why it could not have contacted the Board without waiting for a final transcript. Even after a final transcript was obtained, Columbia indicates it waited another twelve days to contact the Board so that it might take additional actions, i.e., review, analyze and consider the significance of the testimony and consult with Illumina and its client. While the actions are not unreasonable, Columbia has not explained why any of them prevented Columbia from alerting the Board about the situation much sooner than it did.

Columbia argues that the denial of its request for authorization to file the motion is "severely prejudicial." (Request at 1). However, if the request were authorized Illumina would be left with a very short time to respond due, at least in part, to Columbia's delay in seeking relief resulting in prejudice to Illumina.

Columbia again argues that "good cause exists for a short extension of the trial pendency period" beyond one year. (Request at 3). As we do not grant Columbia's request to file the motion, there is no need to extend the period, so we need not and do not consider Columbia's argument.

Columbia requests authorization to submit Dr. Barker's transcript for the record "so that it is available for purposes of appeal". (Request at 3). Dr. Barker's transcript is said to be "highly confidential." (See attachment to Decision). As it is

not necessary for Columbia to file the transcript to preserve the issue for appeal, we do not authorize Columbia's request under these particular circumstances.

IV. Conclusion

Given the one year pendency of the trial (35 USC § 316 (a) (11); 37 CFR § 42.100(c)), it is imperative that a party contact the Board as soon as the need for relief is identified. 37 § CFR 42.25(b). Despite Columbia's additional explanation set forth in the Request, we are not convinced that Columbia acted as promptly as it should have under the circumstances. Columbia has not met its burden to show that the Decision should be modified. 37 CFR § 42.71(d).

V. Order

It is

ORDERED that the Decision denying the Columba request to file a motion for the late submission of supplemental information is not modified.

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