

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.*

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

I. Background

The parties jointly contacted the Board regarding the filing of a motion to expunge information that the Board authorized to be filed under seal. Further Columbia expressed a wish “to discuss the status of Dr. David Barker’s deposition transcript in the IPR record.” (See attached email communication).

II. Discussion

A. *Motion to Expunge*

Confidential information that is subject to a protective order ordinarily will become public 45 days after final judgment in the trial. However, here we authorize the parties to file jointly a motion to expunge in accordance with 37 CFR § 42.56. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012). Further, the information filed under seal shall remain sealed pending a Board decision on a timely filed motion.

B. *Deposition Transcript*

Columbia’s request to file the deposition transcript of Dr. Barker was denied in our Decision on Request for Rehearing. (Decision (Order) entered March 6, 2014, Paper 139 at 4-5). As the issue has been finally decided there is no basis for further rehearing of that Decision. To the extent it would be appropriate for Columbia to request rehearing of that portion of the Decision, the time for such a request has passed. 37 CFR § 42.71(d)(1) (request for rehearing of a non-final decision is 14 days after its entry).

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III. Order

It is

ORDERED that the parties are authorized to file jointly a motion to expunge as set forth herein on or before 18 April 2014; and

FURTHER ORDERED that information authorized to be filed under seal by the Board shall remain under seal pending a Board decision on a timely filed motion to expunge.

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Sent: Tuesday, April 08, 2014 4:50 PM

To: Trials

Cc: A Selikson; ColumbiaIPR; G Gershik; Illumina; J. Costakos; John White; uspto

Subject: Re: IPR2012-00006, IPR2012-00007, IPR2013-00011

Patent Owner Columbia University and Petitioner Illumina jointly request a telephone conference to discuss maintaining under seal confidential pleadings and exhibits filed in connection with the above-referenced IPRs pending a possible appeal.

Under the IPR Rules, documents filed under seal may be made public 45 days from the final written decision (April 20, 2013) unless the parties file a motion to expunge (Rule 42.56; see also Comment 172, 77 Fed. Reg. 48612, 48644). However, Columbia has 63 days from entry of judgment to file a notice of appeal, and Federal Circuit Rule 17 states that "the agency must maintain the record."

In addition, Columbia would like to discuss the status of Dr. David Barker's deposition transcript in the IPR record, and its inclusion in the record for appeal to the Federal Circuit. The Board's decision on Columbia's motion stated that the issue of the Barker transcript was preserved for appeal, but the Board did not permit Columbia to file the transcript on the IPR dockets. (e.g., IPR2012-00006, Paper 127 at 4-5.) Columbia notes that the Board permitted Illumina to file the deposition transcript of Dr. Bruce Branchaud for purposes of an appeal (e.g., IPR2012-00006, Paper 123 at 4), but did not permit Columbia to similarly file the Barker deposition transcript.

The parties are available for a telephone conference on Wednesday 4/9 between 1:00 and 2:00 PM EDT, Thursday 4/10 between 10:00 AM and noon or 2:00 and 3:00 PM EDT, and Friday 4/11 between 10:00 AM and noon or after 3:00 PM EDT.

Respectfully submitted,

Anthony M. Zupcic

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