

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 Lane, Lebovitz, and Katz *Administrative Patent Judges*.

Lane, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding

37 C.F.R. § 42.5

The parties jointly contacted the Board seeking clarification of the Board's Order of April 14, 2014 (Paper 141). (*See* attached e-mail communication, dated

April 15, 2014.) Specifically, the parties asked for confirmation that if the confidential exhibits are expunged, they will still remain available for inclusion in an appeal Appendix and will still be available to the Board if the case should be remanded.

The parties should include any requested relief regarding the requested expunging of documents in the motion authorized on April 14, 2014, for consideration in due course.

In the communication of April 15, 2014, Columbia also requested clarification as to how the Barker transcript would be made available to the Federal Circuit during an appeal. As previously stated, the issue has been finally decided and 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 impacted by the Barker transcript, 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).

It is ORDERED that there is no modification of the Order dated April 14, 2014 (Paper 141).

Petitioner:

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From: John P White [<mailto:JWHITE@COOPERDUNHAM.COM>]
Sent: Tuesday, April 15, 2014 3:44 PM
To: Trials
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Subject: IPR2012-00006, IPR2012-00007, IPR2013-00011

This email concerns the Board's Order issued on April 14, 2014 in the above-captioned IPRs. See, e.g., IPR2012-00006, Paper 129. The Parties respectfully seek clarification of the Board's Order.

First, regarding the issue of maintaining the availability of confidential information pending resolution of an appeal, the Board's Order states that the Parties may now file a Motion to Expunge. The confidential information in question could be important to an appeal to the Federal Circuit, and the Parties would appreciate confirmation that if the confidential exhibits are expunged, they will still remain available for inclusion in an appeal Appendix and will still be available to the Board if the case should be remanded.

Second, Columbia sought clarification as to how the Barker transcript would be made available to the Federal Circuit during an appeal. The Board's Order only states that a request for rehearing of the Board's decision denying Columbia's request to file the Barker transcript as supplemental information is now untimely. Columbia respectfully notes that it timely sought rehearing of the Board's decision, and rehearing was denied. (IPR2012-00006, Paper 127.) In its decision, the Board stated that "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." (Paper No. 127 at 4-5.)

Given this statement by the Board, Columbia seeks guidance on how to properly include the Barker transcript in the record on appeal. Again, Columbia respectfully points out that under identical circumstances, Illumina was allowed to file the deposition transcript of Dr. Branchaud on the docket so that it would be available for appeal.

Sincerely,

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