

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.

Case IPR2012-00007  
US 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. § 42.56

## **I. Introduction**

The parties have filed a paper entitled “JOINT MOTION FOR PRESERVATION OF THE RECORD PENDING APPEAL AND MOTION TO EXPUNGE CONFIDENTIAL INFORMATION UNDER RULE 42.56”. (“Joint Motion,” Paper 143). In the Joint Motion, the parties ask that the record in the proceeding be preserved pending outcome of a possible appeal “including preservation of all sealed documents in non-public form.” (Joint Motion at 1).

Alternatively, the parties ask that the information filed under seal be expunged from the record pursuant to 37 C.F.R. § 42.56 so that the information will not be made public. The parties ask that, if the Board denies the Joint Motion, they be permitted to file alternate redacted versions of the information that was filed under seal “to ensure that only a minimum amount of confidential information is disclosed.” (Joint Motion at 1).

## **II. Discussion**

The parties were permitted to file certain information under seal in accordance with 37 C.F.R. § 42.54(a) such that the record contains public and non-

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public versions of this information. (See, e.g., Decision granting motion to seal (Paper 92)). The non-public versions ordinarily become publicly available after final judgment. See *Office Patent Trial Practice Guide* at 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012))

However, a party may file a motion to expunge confidential information from the record if wishing to preserve its confidentiality. 37 C.F.R. 42.56. Here the parties ask that the record be preserved as is, i.e., without removal or disclosure to the public of the information filed under seal, “pending a possible appeal” or, alternatively, expunged from the record.

Under the present circumstances, it is reasonable to maintain the record undisturbed pending outcome of any appeal that is taken. At the conclusion of any appeal proceeding, or if no appeal is taken, the parties should contact the Board so that the Joint Motion may be renewed. If the parties do not contact the Board, then the information filed under seal will be made public in due course. See *Office Patent Trial Practice Guide* at 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012))

**III. Order**

It is

ORDERED that that portion of the Joint Motion seeking expungement is DISMISSED without prejudice to the parties renewing the Joint Motion as set forth herein;

FURTHER ORDERED that the parties shall contact the Board at the conclusion of any appeal proceeding or if no appeal is taken, so that the Joint Motion may be renewed; and

FURTHER ORDERED that the record shall remain undisturbed as discussed herein until such time as the Joint Motion is renewed or, if the parties fail to contact the Board as required herein, the information filed under seal shall be made public.

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