

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  
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**

On Friday 26 September 2014, Columbia counsel contacted the Board via email inquiring as to “how to expedite unsealing certain confidential documents in connection to their use in the Federal Circuit appeal briefs”. The parties indicated that “[b]riefing is due on Monday 9/29.” (See attached email communication appearing to have been sent at 10:15 am on 26 September 2014).<sup>1</sup> A later email states that:

Pursuant to the Patent Owner’s earlier e-mail to the Board regarding unsealing confidential exhibits, the Parties have reached an agreement that portions of the record no longer contain confidential information. The Parties therefore jointly request that the following sealed exhibits be made public: 2054, 2065-2070, and 2072-2087 [listed exhibits].

(See attached email communication appearing to have been sent at 11:00 am on 26 September 2014 (Request)).

Communications from Illumina counsel via email confirm that the request to make public the sealed versions of the listed exhibits is a joint request. (See

---

<sup>1</sup> While we are able to accommodate the parties in the case, it is not a good practice to wait until just prior to a due date to seek relief as the Board needs a reasonably sufficient time to consider issues put before it.

Case IPR2012-00007  
US Patent 7,790,869

attached email communications appearing to have been sent at 12:12pm and 1:51pm on 26 September 2014).

## **II. Discussion**

The parties were authorized to file certain Exhibits under seal. As to those certain Exhibits, each was filed as an “under seal” and “public” version. The parties have agreed that the listed Exhibits no longer contain confidential information and that the under seal versions of these Exhibits may be made public.

There is a strong public interest in making the record of the proceeding open to the public as the proceeding affects the rights of the public by determining whether a party has a right to its patent. Accordingly, we grant the Request as its grant makes further information available to the public. We understand that judicial review of our decision has been sought (See Notice of Appeal, Paper 146) but we view making the listed Exhibits public as a purely ministerial act that is reasonable in the present circumstances.<sup>2</sup>

Case IPR2012-00007  
US Patent 7,790,869

### **III. Order**

It is

ORDERED that the under seal versions of the following exhibits shall be made publically available:

Exhibits 2054, 2065-2070, and 2072-2087.

---

2 See *Loshbough v. Allen*, 359 F.2d 910, 912 (CCPA 1966) (stating that the Board may “exercise a purely ministerial function in their administrative capacity” despite a notice of appeal).

Case IPR2012-00007  
US Patent 7,790,869

PETITIONER:

Robert Lawler  
[illuminaiprs@reinhartlaw.com](mailto:illuminaiprs@reinhartlaw.com)

James Morrow  
[illuminaiprs@reinhartlaw.com](mailto:illuminaiprs@reinhartlaw.com)

PATENT OWNER:

John White  
[jwhite@cooperdunham.com](mailto:jwhite@cooperdunham.com)

Anthony Zupcic  
[ColumbiaIPR@fchs.com](mailto:ColumbiaIPR@fchs.com)

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.