

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
Miscellaneous Motion
37 C.F.R. § 42.20

I. Objections to Evidence

Columbia contacted the Board (see attached email) seeking authorization to file a Motion to Accept Filing of its “Objections to Evidence Served by Illumina

on September 28, 2013 under 37 C.F.R. 42.64” (Objections). Columbia indicates that it inadvertently failed to file the Objections when it filed its Motion to Exclude Evidence.¹ (Motion to Exclude, Paper 103). Columbia represents that Illumina has indicated that it does not oppose Columbia filing the Objections.

Columbia is authorized to file the Objections as an Exhibit to be filed on or before 17 December 2013.

II. Under Seal Demonstratives

Columbia further requested authorization to file a motion to seal so that it might file an “under seal” version of its demonstrative exhibits. Because the entire hearing will be open to the public there is no need to file “under seal” demonstrative exhibits. (Order, Paper 125).

III. Order

It is

ORDERED that Columbia is authorized to file Objections as set forth herein.

¹ Columbia filed a Notice representing that it served Illumina with the Objections on 4 October 2013. (Notice, Paper 90).

Case IPR2012-00007

U.S. Patent 7,790,869

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Sent: Wednesday, December 11, 2013 12:10 PM

To: Trials

Cc: IlluminaIPRs@reinhartlaw.com; Costakos, Jeffrey N. (JCostakos@foley.com); John White; Gary Gershik; Curry, Donald; Schwartz,Robert; O'Malley, Brendan

Subject: IPR2012-00006, IPR2012-00007, IPR2013-11

This email seeks permission to file two motions related to the oral argument scheduled for December 17, 2013 in the above-referenced IPR proceedings.

First, Patent Owner Columbia University ("Columbia") seeks permission to file in each IPR a Motion to Accept Filing of its "Objections to Evidence Served by Illumina on September 28, 2013 under 37 C.F.R. §42.64" which documents are referenced in the corresponding "Columbia's Motion to Exclude Evidence Under 37 C.F.R. §42.64" but were inadvertently not filed at that time. Columbia seeks to file each Objections to Evidence as a numbered exhibit in the corresponding IPR proceeding.

As reflected by the Certifications found at Paper 81 in IPR2012-00006, Paper 90 in IPR2012-00007 and Paper 81 in IPR2013-00011, Columbia's Objections to Evidence were timely served on Petitioner Illumina ("Illumina") on October 4, 2013. Illumina has indicated that it does not oppose Columbia filing its Objections to Evidence as an exhibit in each IPR.

Second, Columbia requests permission to file a Motion to Seal with regard to its demonstratives to be used at the oral hearing. Some of those demonstratives reflect the confidential business information of the Parties. That same information was the subject of an earlier Motion to Seal that was granted by the Board. Illumina has indicated that it does not oppose Columbia filing a Motion to Seal.

Finally, the Parties note that in its Order dated Dec. 2, 2013 (*see, e.g.*, IPR2013-00011 Paper 110), the Board stated:

"The parties seek guidance on how to proceed at oral argument, particularly given that some evidence is subject to protective order. The Board will consider the concerns of the party and will enter an Order prior to oral argument to provide further guidance."

The Parties request clarification on whether the Board still plans to enter the described Order prior to oral argument.

Respectfully submitted,

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