

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

CORNELL RESEARCH FOUNDATION, INC.,
Patent Owner.

Case IPR2016-00549 (Patent 8,703,928 B2)
Case IPR2016-00553 (Patent 8,288,521 B2)
Case IPR2016-00557 (Patent 8,597,891 B2)
Case IPR2016-00559 (Patent 8,624,016 B2)

Before JACQUELINE WRIGHT BONILLA, *Vice Chief Administrative Patent Judge*, TONI R. SCHEINER and SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

MITCHELL, *Administrative Patent Judge*.

JUDGMENT

Granting Patent Owner's Unopposed Motion for Entry of Protective Order,
Patent Owner's Motions to Seal, Joint Motion to Seal, and
Joint Motions to Terminate
35 U.S.C. § 317 and 37 C.F.R. §§ 42.1, 42.54, 42.72, 42.74

IPR2016-00549 (Patent 8,703,928 B2)
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IPR2016-00557 (Patent 8,597,891 B2)
IPR2016-00559 (Patent 8,624,016 B2)

On April 20, 2017, Petitioner Illumina Inc. (“Petitioner”) and Patent Owner Cornell Research Foundation, Inc. (“Patent Owner”) filed Joint Motions To Terminate Pursuant To 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 in all four above-referenced cases. *See* IPR2016-00549 (Paper 17); IPR2016-00553 (Paper 18); IPR2016-00557 (Paper 49); IPR2016-00559 (Paper 18). In IPR2016-00549, IPR2016-00553, and IPR2016-00559, *inter partes* review was denied, but there are outstanding requests for rehearing. *See* Papers 16, 17, 17, respectively. In IPR2016-00557, an instituted case, there are outstanding motions, including a motion for entry of protective order, motions to seal, motions for admission pro hac vice, and a motion to exclude. *See* Papers 6, 7, 22, 28, 29, 36, 43.

The parties filed a copy of their Settlement Agreement, made in connection with the termination of these proceedings, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *See* Ex. 2052 (all proceedings). The parties also filed Joint Requests that the settlement agreement be treated as business confidential information, and be kept separate from the file of the involved patent, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). IPR2016-00549 (Paper 18); IPR2016-000553 (Paper 19); IPR2016-00557 (Paper 50); IPR2016-00559 (Paper 19).

Joint Motions to Terminate and Joint Requests that the Settlement Agreement be Treated as Business Confidential Information

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.”

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Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 37 C.F.R. § 42.72. In their Joint Motions to Terminate, the parties indicate that they have settled all disputes regarding the patents involved in all four *inter partes* proceedings, and that no other petitioners remain in any proceeding. *See* IPR2016-00549 (Paper 17, 1–2); IPR2016-00553 (Paper 18, 1–2); IPR2016-00557 (Paper 49, 1–2); IPR2016-00559 (Paper 18, 1–2).

The Joint Motions to Terminate in three of the *inter partes* reviews IPR2016-00549, IPR2016-00553, and IPR2016-00559, were filed after institution was denied, but before a decision on rehearing was issued. The Joint Motion to Terminate in IPR2016-00557 was filed before oral argument, and thus, before a final written decision has issued on the merits.

Thus, upon consideration of the facts before us, we determine that it is appropriate to terminate all four proceedings. *See* 37 C.F.R. §§ 42.5(a), 42.71(a), 42.73(a), 42.74. Accordingly, we grant the Joint Motions to Terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Settlement Agreement treated as business confidential information and kept separate from the files of the patent at issue in this proceeding. Thus, we grant the Joint Requests to treat the Settlement Agreement as business confidential.

Motion for Entry of Protective Order

Patent Owner filed an Unopposed Motion for Entry of Protective Order in IPR2016-00557. *See* Paper 6. The parties agreed to a modified

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version of the Default Protective Order in Appendix B of the Office Patent Trial Practice Guide, modifying the definition of “parties” to include all real parties-in-interest identified in Petitioner’s and Patent Owner’s mandatory notices. *Id.* at 2. The parties provided a clean version of their proposed modified default protective order, as well as a redlined version. *See Exs.* 2004–2005, respectively.

We grant Patent Owner’s request to enter the modified protective order reflected in Exhibit 2004.

Motions to Seal in IPR2016-00557

Patent Owner filed two motions to seal. *See Papers* 7, 22. In its first motion to seal, Patent Owner requests that a confidential version of its Patent Owner Preliminary Response (Paper 8) that cites to confidential material contained in Exhibit 2003, and Exhibit 2003 itself, be sealed. Paper 7, 1–2. Patent Owner contends that Exhibit 2003 contains non-public research data from the laboratory notebook of one of the inventors at the time of the invention. *Id.* at 1. Patent Owner notes that Exhibit 2003 is subject to protective order in companion district court litigation. *Id.*

In its second motion to seal, Patent Owner requests that the confidential version of its Patent Owner Response (Paper 23) that cites to confidential material contained in Exhibits 2003, 2033, 2034, and 2048, as well as Exhibits 2033, 2034, and 2048, themselves, also be sealed. Patent Owner explains that Exhibit 2048 contains non-public research data from the laboratory notebook of one of the inventors of U.S. Patent No. 8,597,891 B2 (“the ’891 patent”) at the time of the claimed invention. Paper 22, 1. Patent

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Owner also explains that Exhibit 2033 is a declaration from Patent Owner's declarant that contains non-public data from Exhibits 2003 and 2048. *Id.* at 2. Finally, Patent Owner states that Exhibit 2034 is a declaration from one of the inventors of the '891 patent that contains disclosure of non-public information and the results of experiments that were disclosed in a different laboratory notebook. *Id.* at 3. Patent Owner notes that Exhibit 2048 is subject to protective order in companion district court litigation. *Id.* at 1.

Patent Owner filed redacted, public versions of its Patent Owner Preliminary Response and its Patent Owner Response, *see* Papers 9 and 24, respectively, as well as redacted, public versions of Exhibits 2033 and 2034, *see* Exhibits 2039 and 2049, respectively.

In a third motion to seal filed jointly by the parties, the parties request that confidential versions of the transcript of the January 20, 2017 Deposition of Dr. John Sutherland (Ex. 1104), and the transcript of the January 18, 2017 Deposition of Dr. Francis Barany (Ex. 1105), as well as a confidential version of Petitioner's Reply (Paper 37), be sealed. Paper 36, 1. The parties state that Dr. Sutherland's deposition and Dr. Barany's deposition contain testimony addressing the substance of non-public data from laboratory notebooks (Exs. 2003 and 2048 discussed above), i.e., the notebooks that the parties previously noted are subject to protective order in companion district court litigation. *Id.* at 2. The parties also state that Petitioner's Reply refers to confidential material from Dr. Sutherland's deposition transcript (Ex. 1104, sealed version) and Dr. Barany's deposition transcript (Ex. 1105, sealed version), Patent Owner's laboratory notebook

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