

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 IPR2018-00291 (Patent 9,718,852 B2)
Case IPR2018-00318 (Patent 9,719,139 B2)
Case IPR2018-00322 (Patent 9,708,358 B2)
Case IPR2018-00385 (Patent 9,725,480 B2)
Case IPR2018-00797 (Patent 9,868,985 B2)

Record of Oral Hearing
Held: March 5, 2019

Before JAMES A. WORTH, MICHELLE N. ANKENBRAND, and BRIAN
D. RANGE, *Administrative Patent Judges*.

Case IPR2018-00291 (Patent 9,718,852 B2)
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APPEARANCES:

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The above-entitled matter came on for hearing on Tuesday, March 5, 2019, commencing at 9:01 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

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1 PROCEEDINGS

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3 JUDGE ANKENBRAND: Good morning, you may be seated. Just
4 give us a minute here. Is the court reporter ready? All right. Let's go on the
5 record. Good morning, everybody. Today we have our final hearing in IPR
6 numbers 2018-00291, 318, 322, 385 and 797. Between petitioner Illumina
7 Inc., and patent owner, The Trustees of Columbia University in the City of
8 New York.

9 I'm JUDGE ANKENBRAND. I'm joined today by Judge Worth who
10 is sitting to my left and Judge Range who is appearing remotely from our
11 Dallas hearing room.

12 Counsel, can you please introduce yourselves and let us know who
13 will be making the arguments today? We will start with petitioner, Illumina.

14 MR. ZIMMERMAN: Good morning, Your Honor. Bill Zimmerman
15 of Knobbe Martens, Holston and Bear on behalf of petitioner Illumina. I
16 will be making the argument today. With me are my partners Kerry Taylor
17 and Nate Luman, also of Knobbe Martens and Roland Schwillinsky and
18 Marcus Burch of Illumina.

19 JUDGE ANKENBRAND: All right. Good morning, everyone. And
20 for the patent owner, who do we have today?

21 MR. WHITE: John White from Cooper and Dunham. Presentation
22 will be made by Mr. John Murnane of Venable and he is sitting right here.
23 And with us are also from Venable, Justin Oliver, Robert Schwartz, and
24 Zachary Garrett. And we have a number of people from Columbia, as well
25 as the inventor, Dr. Ju, present.

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1 JUDGE ANKENBRAND: All right. Good morning, everyone.

2 Thank you, welcome. It is good to have everyone here.

3 We set forth the procedures for today's hearing in our trial order but

4 I'll just remind everyone a little bit about the way this will work today.

5 Each party will have 60 minutes of total time to present their arguments.

6 Petitioner, since you have the burden of showing unpatentability,
7 you'll go first and then that will be followed by patent owner's presentation.

8 Also both parties may reserve some brief time for rebuttal.

9 One thing I'll say is that one of our goals it to keep the hearing
10 running smoothly and focused on the merits so we ask that everybody
11 refrain from objecting during an opposing -- an opponent's presentation. If
12 you do have an objection you can make that objection during your
13 presentation time.

14 One more thing before we begin. Judge Range will not be able to
15 view anything that you project on the screen in the room here. So when you
16 refer to an exhibit on the screen, please state for the record the exhibit and
17 page number or if it's a demonstrative, the slide number to which you are
18 referring so that Judge Range can follow along with us. It is also important
19 to do so for the clarity and accuracy of our transcript.

20 Also, our microphones do have limitations so Judge Range will be
21 unable to hear you if you stray too far from the podium. So just keep that in
22 mind as you are making your arguments. I will try to give each counsel a
23 warning when you are reaching the end of argument time. Does anyone
24 have any questions or concerns at this point? Mr. Zimmerman?

25 MR. ZIMMERMAN: No, Your Honor, thank you.

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1 JUDGE ANKENBRAND: Okay. Mr. White?

2 MR. WHITE: No. No, Your Honor.

3 JUDGE ANKENBRAND: All right. So we will start with Mr.
4 Zimmerman. And I guess the first thing I will ask is would you like to
5 reserve any time for rebuttal?

6 MR. ZIMMERMAN: Yes, Your Honor, I would like to reserve 15
7 minutes.

8 JUDGE ANKENBRAND: Okay.

9 MR. ZIMMERMAN: And I have copies of petitioner's
10 demonstratives. I know they were already submitted. If you'd like a bound
11 copy we have them.

12 JUDGE ANKENBRAND: Sure, you can pass them up.

13 JUDGE WORTH: Have you given one to the patent owner?

14 MR. ZIMMERMAN: Yes, patent owner already has a copy. We
15 talked to them earlier.

16 JUDGE ANKENBRAND: Thank you. All right. We are ready to
17 begin whenever you are.

18 MR. ZIMMERMAN: May it please the Board. Illumina has
19 challenged four Columbia patents that claim 3'-O protected labeled
20 nucleotides and one patent that claims a method of sequencing using any of
21 those nucleotides. These patents share the same specification and the same
22 or similar claim limitations to patents that were previously cancelled by the
23 Board in IPR and affirmed by the Federal Circuit.

24 I would like to start with the issues common to all five patents, then
25 address one issue unique to the method patent relating to claim construction,

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