

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

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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)

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Record of Oral Hearing  
Held: March 5, 2019

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

Case IPR2018-00291 (Patent 9,718,852 B2)  
Case IPR2018-00318 (Patent 9,719,139 B2)  
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Case IPR2018-00797 (Patent 9,868,985 B2)  
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.

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

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

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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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