

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)¹

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

WORTH, *Administrative Patent Judge.*

ORDER

Oral Argument

37 U.S.C. § 316(a)(10) and 37 C.F.R. § 42.70

¹ The proceedings have not been consolidated. The parties are not authorized to use a combined caption unless an identical paper is being entered into each proceeding, and the paper contains a footnote indicating the same.

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The date set for oral argument in these five proceedings is March 5, 2019, if either party requests oral argument and the Board grants the request. Case IPR2018-00291, Paper 30, 3²; Case IPR2018-00385, Paper 23, 8; Case IPR2018-00797, Paper 26, 9. Both parties have requested oral argument pursuant to 37 C.F.R. § 42.70. Papers 51, 52. The parties represent that they have conferred and that they agree in their request for a consolidated argument for the five proceedings, in which each side is allotted one hour for its arguments. *Id.* The parties' requests are *granted* to the extent set forth below.

A single combined oral argument for all five cases will commence at **9:00 AM Eastern Time, on Tuesday, March 5, 2019**. The oral argument will be conducted on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, Virginia. The oral argument will be open to the public for in-person attendance, which will be accommodated on a first-come, first-served basis. The Board will provide a court reporter for the oral argument, and the reporter's transcript will constitute the official record of the oral argument.

As there is significant commonality of issues in the five proceedings, we believe that it would be appropriate to have a combined hearing with each party presenting its arguments in all cases in a single argument, and to allocate each party a total of **1 hour** to present arguments. Because Petitioner bears the ultimate burden of proof that the claims at issue are

² Where the same or similar papers have been filed in multiple proceedings, we refer herein to the papers filed in Case IPR2018-00291, except where otherwise indicated.

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unpatentable, Petitioner will begin the oral argument by presenting its case regarding the challenged claims at issue and on any of Petitioner's pending motions, such as Motions to Exclude. Thereafter, Patent Owner will argue its opposition to Petitioner's case, and can present on any pending motions. Petitioner may reserve time to rebut Patent Owner's opposition. Finally, Patent Owner may request an opportunity to present a brief sur-rebuttal to Petitioner's rebuttal.

Pursuant to 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven (7) business days before the hearing date. The demonstrative exhibits shall be filed with the Board no later than five (5) business days before the hearing date. **Demonstrative exhibits are not evidence, but merely a visual aid for use at the hearing, and should be clearly marked as such. For example, each slide of the demonstratives may be marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in the footer.**

Demonstrative exhibits shall not introduce new arguments or evidence. The parties shall meet and confer in good faith to discuss any objections to demonstrative exhibits at least three (3) business days before the hearing. If any issues regarding demonstratives remain unresolved after the parties meet and confer, the parties shall jointly file a one-page list of objections to the demonstrative exhibits with the Board at least two (2) business days before the hearing. For each objection, the list must identify with particularity the demonstratives subject to the objection and include a short, one-sentence statement explaining the objection. We will consider the objections and schedule a conference call if necessary. Regardless of

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whether either party disputes the propriety of any demonstrative exhibit, we consider demonstrative exhibits only to the extent (1) they elucidate the parties' arguments presented during the hearing *and* (2) they include only arguments and/or evidence already of record in the proceedings. For further guidance on what constitutes an appropriate demonstrative exhibit, the parties are directed to *CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper 118).

We expect lead counsel for each party to be present at the hearing; however, any backup counsel may make the actual presentation, in whole or in part. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,758 (Aug. 14, 2012). If lead counsel for either party is unable to attend the hearing, the parties shall request a joint telephone conference call no later than two (2) days prior to the hearing date to discuss the matter.

At least one member of the panel will be attending the hearing electronically from a remote location and will have access only to the courtesy copy of the demonstratives provided in advance, as referenced above, and will not be able to view the projection screen in the hearing room. We take this opportunity to remind the parties that each presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript, and to enable any judge that is attending the hearing from a remote location to follow the presentation.

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Requests for special accommodations or audio-visual equipment are to be made at least five (5) business days in advance of the hearing date. Such requests must be sent to Trials@uspto.gov. If the requests are not received timely, requested accommodations and/or equipment may not be available on the day of the hearing.

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