

Filed May 2, 2018

On behalf of:

**Illumina, Inc.**

By: Kerry S. Taylor

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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 No.: IPR2018-00322

U.S. Patent 9,708,358

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**MOTION FOR WILLIAM R. ZIMMERMAN TO APPEAR  
PRO HAC VICE ON BEHALF OF ILLUMINA, INC.**

**I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Pursuant to the Board's January 10, 2018 Notice of Filing Date Accorded (Paper 5) and 37 C.F.R. §§ 42.10(c) and 42.22, Petitioner Illumina, Inc. ("Illumina") hereby moves for an Order allowing William R. Zimmerman of Knobbe, Martens, Olson & Bear, LLP to appear *pro hac vice* on behalf of Illumina in the above-captioned case.

**II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION**

Illumina Exhibit 1087 - Declaration of William R. Zimmerman in Support of Motion to Appear *Pro Hac Vice* on Behalf of Illumina, Inc.

**III. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED**

As set forth below in the Statement of Material Facts, Illumina has made all of the showings required under 37 C.F.R. § 42.10(c) for recognizing Mr. Zimmerman *pro hac vice*. In particular, Mr. Zimmerman is an experienced litigating attorney who has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit, including technically and legally complex matters such as will be present in this proceeding. Accordingly, allowing Mr. Zimmerman to appear *pro hac vice* on behalf of Illumina is appropriate in this proceeding.

#### IV. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.”

2. Lead counsel in this *inter partes* review proceeding is Kerry S. Taylor. Mr. Taylor is registered to practice before the United States Patent and Trademark Office and holds Registration No. 43,947.

3. As set forth in Illumina Exhibit 1087 (the “Zimmerman Declaration”), Mr. Zimmerman is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding. Zimmerman Decl.

¶ 4. In particular, Mr. Zimmerman has over 19 years of experience as a patent litigator and has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit. *Id.*

¶¶ 2, 3. In addition, Mr. Zimmerman has experience in *inter partes* review proceedings, for example, IPR2013-00024, IPR2013-00128, IPR2013-00266,

IPR2013-00517, IPR2013-00518, IPR2014-00549, IPR2014-00550, IPR2014-01093, IPR2015-00265, IPR2015-00268, IPR2016-00397, IPR2016-00399, IPR2016-00549, IPR2016-00553, IPR2016-00557, IPR2016-00559, IPR2016-01198, IPR2016-01201, IPR2017-02172, and IPR2017-02174. *Id.* ¶ 2.

4. Further, Mr. Zimmerman holds a Bachelor of Science degree in Chemical Engineering from the University of Notre Dame and served as a law clerk to the Honorable Alvin A. Schall, Circuit Judge of the United States Court of Appeals for the Federal Circuit. *Id.* ¶ 3. Moreover, Mr. Zimmerman is experienced with technically and legally complex matters in the field of chemistry and biotechnology. *Id.*

5. With regard to U.S. Patent 9,708,358 (“the ’358 patent”), the patent at issue in this proceeding, Mr. Zimmerman is familiar with the ’358 patent, and with the legal subject matter, technical subject matter, and prior art discussed in Illumina’s petition for *inter partes* review of the ’358 patent. *Id.* ¶ 4. In view of his legal experience, technical background, and familiarity with the issues in the present matter and the related matters, Petitioner Illumina, Inc., has requested his services in the present matter. Denial of his appearance in this case would create an undue burden on Petitioner. *Id.*

6. Mr. Zimmerman has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in Part 42 of

Title 37 of the C.F.R. *Id.* ¶ 9. Mr. Zimmerman also agrees to be subject to the United States Patent and Trademark Office Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶ 10.

7. Finally, Mr. Zimmerman has attested to the remaining elements of Paragraph 2(b) of the representative “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7. *Id.* ¶¶ 4-11; *see* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 5) at 2.

## V. CONCLUSION

In view of the foregoing, and having satisfied the requirements of 37 C.F.R. § 42.10(c), Illumina hereby moves for an Order allowing William R. Zimmerman of Knobbe, Martens, Olson, & Bear, LLP to appear *pro hac vice* on behalf of Illumina in the above-captioned case.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 2, 2018

By: /Kerry Taylor/  
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Michael L. Fuller (Reg. No. 36,516)  
Attorneys for Petitioner  
Illumina, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **MOTION FOR WILLIAM R. ZIMMERMAN TO APPEAR PRO HAC VICE ON BEHALF OF ILLUMINA, INC.** is being served on May 2, 2018, via e-mail to counsel for the Trustees of Columbia University, at the email addresses below:

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