

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 IPR2018-00322
Patent 9,708,358 B2

Before JENNIFER MEYER CHAGNON, JAMES A. WORTH, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

SCHEDULING ORDER
37 C.F.R. § 42.5

A. GENERAL INSTRUCTIONS

1. Request for an Initial Conference Call

An initial conference call is not scheduled in this case. A party may request an initial conference call within 25 days after the institution of trial. A party requesting an initial conference call shall: (a) identify the proposed motions, if any, to be discussed during the call; and (b) propose two or more dates and times when both parties are available for the call. When an initial conference call is scheduled in response to a request, the parties are directed to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765–66 (Aug. 14, 2012) (“Trial Practice Guide”), for guidance in preparing for the initial conference call and should be prepared to discuss any proposed changes to the schedule in this proceeding.

2. Motions to Seal, Protective Orders, and Confidential Information

Papers and exhibits filed with the Board are public unless designated as confidential when filed. 37 C.F.R. § 42.14. Papers and exhibits may be filed as confidential if filed with a motion to seal. *Id.* Those papers and exhibits will remain under seal provisionally until the Board renders its decision on the motion. *Id.* A motion to seal must include a proposed protective order, or must refer to a protective order already approved in the proceeding. 37 C.F.R. § 42.54(a). A protective order does not exist in this proceeding unless the parties file one and the Board approves it. Board approval typically does not occur until its decision on a motion to seal, although the parties may request a conference call to seek approval prior to a decision on a motion to seal if the particular circumstances of the case so require.

Often, a party moves to seal confidential or protective order material of the opposing party. In this case, the opposing party is authorized to file a response to the motion to seal to address why the motion to seal should be granted. Such a response is due within 7 days of the filing of the motion to seal and is subject to the same filing requirements (e.g., length, document format) as the motion to seal.

We encourage the parties to adopt the Board's default protective order if they conclude that a protective order is necessary. *See* Default Protective Order, Trial Practice Guide, App. B. If the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences; and the parties must explain why the proposed deviations from the default protective order are necessary.

The Board has a strong interest in the public availability of the proceedings. We advise the parties that redactions to documents filed in this proceeding should be limited to isolated passages consisting entirely of confidential information, and that the thrust of the underlying argument or evidence must be clearly discernible from the redacted versions. We also advise the parties that information subject to a protective order will likely become public if identified in a final written decision in this proceeding, and that a motion to expunge the information will not necessarily prevail over the public interest in maintaining a complete and understandable file history. *See* Trial Practice Guide, 77 Fed. Reg. at 48,761.

3. Motion to Amend

Patent Owner may file a motion to amend without prior authorization from the Board. Nevertheless, the Patent Owner must confer with the Board before filing such a motion. 37 C.F.R. § 42.121(a). The following memorandum provides additional information regarding motions to amend: “Guidance on Motions to Amend in view of Aqua Products” (Nov. 21, 2017) (https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf).

4. Dispute Resolution During Trial

The Panel encourages parties to resolve disputes arising during trial on their own and in accordance with the precepts set forth in 37 C.F.R. § 42.1(b). To the extent that a dispute arises between the parties, the parties shall meet and confer to resolve their dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board and the other party in order to seek authorization to move for relief.

In any request for a conference call with the Board to resolve a dispute, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify with specificity the issues for which agreement has not been reached; (c) identify the precise relief to be sought; and (d) propose two or more specific dates and times at which both parties are available for the conference call.

5. Depositions

The parties are advised that the Testimony Guidelines appended to the Trial Practice Guide, App. D, apply to these proceedings. The Board may impose an appropriate sanction for failure to adhere to the Testimony

Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

Whenever a party submits a deposition transcript as an exhibit, the submitting party shall file the full transcript of the deposition rather than excerpts of only those portions being cited. After a deposition transcript has been submitted as an exhibit, all parties who subsequently cite to portions of the transcript shall cite to the first-filed exhibit rather than submitting another copy of the same transcript.

6. Cross-Examination

Except as the parties might otherwise agree, for each due date—

1. Cross-examination begins after any supplemental evidence is due. 37 C.F.R. § 42.53(d)(2).
2. Cross-examination ends no later than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. *Id.*

7. Observations on Cross-Examination

Observations on cross-examination provide the parties with a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness because no further substantive paper is permitted after the reply. *See* Trial Practice Guide, 77 Fed. Reg. at 48,768. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit. Each observation should not exceed a single, short paragraph. The opposing party may respond to the observation. Any response must be equally concise and specific.

B. DUE DATES

This order sets due dates for the parties to take action after institution of the proceeding. The parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6). A notice of the stipulation, specifically identifying the changed due dates, must be promptly filed. The parties may not stipulate to an extension of DUE DATES 6 and 7.

In stipulating to different times, the parties should consider the effect of the stipulation on times to object to evidence (37 C.F.R. § 42.64(b)(1)), to supplement evidence (37 C.F.R. § 42.64(b)(2)), to conduct cross-examination (37 C.F.R. § 42.53(d)(2)), and to draft papers depending on the evidence and cross-examination testimony.

1. DUE DATE 1

The patent owner may file—

- a. A response to the petition (37 C.F.R. § 42.120), and
- b. A motion to amend the patent (37 C.F.R. § 42.121).

The patent owner must file any such response or motion to amend by DUE DATE 1. If the patent owner elects not to file anything, the patent owner must arrange a conference call with the parties and the Board. The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.

2. DUE DATE 2

The petitioner must file any reply to the patent owner's response and opposition to the motion to amend by DUE DATE 2.

3. DUE DATE 3

The patent owner must file any reply to the petitioner's opposition to patent owner's motion to amend by DUE DATE 3.

4. DUE DATE 4

a. Each party must file any observations on the cross-examination testimony of a reply witness (*see* section A.7, above) by DUE DATE 4.

b. Each party must file any motion to exclude evidence (37 C.F.R. § 42.64(c)) by DUE DATE 4.

c. Each party must file any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.

5. DUE DATE 5

a. Each party must file any reply to an observation on cross-examination testimony by DUE DATE 5.

b. Each party must file any opposition to a motion to exclude evidence by DUE DATE 5.

6. DUE DATE 6

Each party must file any reply for a motion to exclude evidence by DUE DATE 6.

7. DUE DATE 7

The oral argument (if requested by either party) is set for DUE DATE 7.

DUE DATE APPENDIX

DUE DATE 1 September 24, 2018

Patent owner's response to the petition

Patent owner's motion to amend the patent

DUE DATE 2 December 17, 2018

Petitioner's reply to patent owner's response to petition

Petitioner's opposition to motion to amend

DUE DATE 3 January 15, 2019

Patent owner's reply to petitioner's opposition to motion to amend

DUE DATE 4 January 29, 2019

Observations regarding cross-examination of reply witness

Motion to exclude evidence

Request for oral argument

DUE DATE 5 February 12, 2019

Response to observations

Opposition to motion to exclude

DUE DATE 6 February 19, 2019

Reply to opposition to motion to exclude

DUE DATE 7 March 5, 2019

Oral argument (if requested)

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