

Filed on behalf of:

The Trustees of Columbia University in the City of New York

By: John P. White

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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

Filed: January 8, 2018

PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8

MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8(a)(2)

Pursuant to 37 C.F.R. § 42.8(a)(2), the mandatory notices identified in 37 C.F.R. § 42.8(b) are provided below.

A. Real Party-In-Interest (37 C.F.R. § 42.8(b)(1))

The Trustees of Columbia University in the City of New York (“Columbia”) is the real party-in-interest for Patent Owner.

B. Related Matters (37 C.F.R. § 42.8(b)(2))

Illumina, Inc. (“Illumina”) has filed petitions for IPR of U.S. Patents Nos. 9,718,852, 9,719,139, and 9,725,480 (“the ’852, ’139, and ’480 patents”) owned by Columbia. The ’852, ’139, ’358, and ’480 patents were asserted against Illumina in *Trustees of Columbia Univ. v. Illumina, Inc.*, C.A. No. 17-cv-973-GMS (D. Del.).

Columbia previously asserted related U.S. Patents Nos. 7,790,869, 7,713,698, and 8,088,575 (“the ’869, ’698, and ’575 patents”) against Illumina in *Trustees of Columbia Univ. v. Illumina, Inc.*, C.A. No. 12-cv-376 (D. Del.). The ’869, ’698, and ’575 patents were the subject of IPR2012-00007, IPR2012-00006, and IPR2013-00011, respectively. The Board held all challenged claims from the ’869, ’698, and ’575 patents were unpatentable in those IPRs.

The Federal Circuit affirmed the Board’s unpatentability determinations from IPR2012-00007, IPR2012-00006, and IPR2013-00011 in *Trustees of Columbia Univ. v. Illumina, Inc.*, 620 Fed. Appx. 916 (Fed. Cir. 2015).

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Illumina raised counterclaims alleging infringement of U.S. Patents Nos. 7,057,026, 8,158,346, and 7,566,537 (“the ’026, ’346, and ’537 patents”) in *Trustees of Columbia Univ.*, C.A. No. 12-cv-376. Illumina’s ’026 and ’346 patents were the subject of IPR2013-00128 and IPR2013-00266, respectively. The Board held all claims at issue in those IPRs unpatentable.

The Federal Circuit affirmed the Board’s unpatentability determinations from IPR2013-00128 and IPR2013-00266 in *Illumina Cambridge Ltd. v. Intelligent Bio-Systems, Inc.*, 638 Fed. Appx. 999 (Fed. Cir. 2016).

Illumina’s ’537 patent was the subject of IPR2013-00517. The Board held all claims at issue in that IPR were not unpatentable.

The Federal Circuit affirmed the Board’s determinations from IPR2013-00517 in *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359 (Fed. Cir. 2016).

Illumina’s ’537 patent is currently the subject of two follow-on petitions filed on October 5, 2017 by Complete Genomics, Inc. in IPR2017-02172 and IPR2017-02174. Illumina’s preliminary responses are due on January 23, 2018 in these two IPRs.

C. Lead and Back-up Counsel (37 C.F.R. § 42.8(b)(3))

Columbia provides the following designation of counsel.

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Lead Counsel	Back-up Counsel
John P. White, Reg. No. 28,678 Cooper & Dunham LLP (Customer No. 23432) jwhite@cooperdunham.com <u>Postal and Hand-Delivery Address:</u> 30 Rockefeller Plaza 20 th Floor New York, New York 10112 Telephone: (212) 278-0400 Facsimile: (212) 391-0525	John D. Murnane, Reg. No. 29,836 Fitzpatrick, Cella, Harper & Scinto (Customer No. 05514) jmurnane@fchs.com <u>Postal and Hand-Delivery Address:</u> 1290 Avenue of the Americas New York, NY 10104 Telephone: (212) 218-2100 Facsimile: (212) 218-2200 Justin J. Oliver, Reg. No. 44,986 Fitzpatrick, Cella, Harper & Scinto (Customer No. 05514) joliver@fchs.com <u>Postal and Hand-Delivery Address:</u> 975 F Street, N.W. Washington, D.C. 20004 Telephone: (202) 530-1010 Facsimile: (202) 530-1055 Gary J. Gershik, Reg. No. 39,992 Cooper & Dunham LLP (Customer No. 23432) ggershik@cooperdunham.com <u>Postal and Hand-Delivery Address:</u> 30 Rockefeller Plaza 20 th Floor New York, New York 10112 Telephone: (212) 278-0400 Facsimile: (212) 391-0525

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D. Service Information (37 C.F.R. § 42.8(b)(4))

Please direct all correspondence to lead counsel and back-up counsel at the addresses shown above. Patent Owner also consents to electronic service by email to ColumbiaIPR@cooperdunham.com.

Respectfully submitted,

Cooper & Dunham LLP

Dated: January 8, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PATENT OWNER'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8** is being served on January 8, 2018, via email to Counsel for Petitioner, Kerry Taylor and Michael L. Fuller, at:

BoxIllumina@knobbe.com

Dated: January 8, 2018

By: /Brittany N. Internoscia/
Brittany N. Internoscia
Law Clerk
Cooper & Dunham LLP