

Filed: July 26, 2019

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

IPR2018-00322
Patent 9,708,358

JOINT MOTION TO PRESERVE RECORD UNDER SEAL

I. RELIEF REQUESTED

Pursuant to the Board’s email authorization dated July 19, 2019, Petitioner Illumina, Inc. (“Illumina”) and Patent Owner The Trustees of Columbia University in the City of New York (“Columbia”) jointly move for an order (i) preserving the record for appeal by maintaining the confidentiality of sealed Exhibits 2120-2124 and Columbia’s Sealed Patent Owner’s Response (Paper 34), and (ii) providing an opportunity for a motion to expunge those documents to be filed within 45 days after all appeal rights have been exhausted.

II. BACKGROUND

During the course of this proceeding, Patent Owner filed a motion to seal Exhibits 2120-2124 and a version of Columbia’s Patent Owner’s Response citing those Exhibits (Paper 34) as containing sensitive business confidential information of Petitioner. Paper 33. In addition, Patent Owner requested entry of the Board’s default protective order. *Id.* at 3-4.

Petitioner filed a response in support of Patent Owner’s motion to seal explaining that Exhibits 2120-2124 contain sensitive business confidential information and that good cause exists for placing the documents under seal. Paper 35. Petitioner did not object to using the Board’s default protective order to govern the treatment of sealed documents in this proceeding. *Id.* at 1.

The Board determined that good cause exists for sealing Exhibits 2120-2124 and granted the motion to seal. Paper 37. The Board entered the default protective order to govern the treatment of confidential information in this proceeding. *Id.* at 4.

III. ARGUMENT

A. The parties jointly request that the record be preserved for appeal.

The parties jointly request that the Board preserve the record for appeal by maintaining Exhibits 2120-2124 and Columbia's Sealed Patent Owner's Response (Paper 34) under seal until the exhaustion of all appeal rights.

In the Board's July 19, 2019 e-mail authorizing this motion, two issues were requested to be addressed: (1) the reason for extending the date, and (2) the basis for the panel's authority to extend the date.

1. The reason for extending the date.

Confidential information that is subject to a protective order will ordinarily become public "45 days after final judgement in a trial" unless a motion to expunge is filed. 77 Fed. Reg. 48756, 48761 (Aug. 14, 2012); 37 C.F.R. § 42.56. On June 21, 2019, the Board issued its Final Written Decision in this proceeding. Paper 67. Thus, the default date for unsealing Exhibits 2120-2124 is August 5, 2019. However, the deadline for Patent Owner to file a notice of appeal is "no later than sixty-three (63) days after the date of the final Board decision" (37

C.F.R. § 90.3(a)(1)), which falls on August 23, 2019. Patent Owner is currently evaluating its options regarding appeal. Accordingly, the reason for extending the date is to maintain the record intact at least until the due date for filing an appeal or until the resolution of an appeal, both of which contingencies extend beyond the default date for the Board making sealed documents in a proceeding public.

2. The basis for the panel’s authority to extend the date.

The Federal Circuit Rules require the record of this proceeding be retained by the Board pending appeal. Federal Circuit Rule 17(a) states that “[t]he agency must retain the record[.]” Federal Circuit Rule 17(d) is entitled “Access of Parties and Counsel to Original Record” and requires the parties and their counsel have access to both the sealed and unsealed portions of the record “[w]hen a petition for review or notice of appeal is filed[.]”

A notice of appeal has not yet been filed in this proceeding, and the deadline for filing a notice of appeal, as noted above, is August 23, 2019. To comply with the mandates of the Federal Circuit, it is appropriate to maintain the record of this proceeding as is, pending any possible appeal (*i.e.*, without removing or disclosing to the public information currently under seal). If the record is not preserved in its entirety including any sealed portions and an appeal is taken, the Federal Circuit may not be able to fully consider issues raised during this proceeding.

The Board has the authority to “determine a proper course of conduct in a proceeding” and it “may enter non-final orders to administer the proceeding.” 37 C.F.R. § 42.5. Other Board panels have recognized the Board’s authority and the reasonableness of maintaining an undisturbed record pending any appeal. *See, e.g., Illumina, Inc. v. The Trustees of Columbia University in the City of New York*, IPR2012-00006, Paper 133, IPR2012-00007, Paper 145, IPR2013-00011, Paper 135 (P.T.A.B. 2014); *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, IPR2013-00128, Paper 93 (P.T.A.B. 2014), IPR2013-00517, Paper 89 (P.T.A.B. 2015); *Electronic Arts Inc. v. Terminal Reality, Inc.*, IPR2016-00928, Paper 50 (P.T.A.B. 2017); *Merck Sharp & Dohme Corp. v. Mayne Pharma Int’l Pty Ltd.*, IPR2016-01186, Paper 75 (P.T.A.B. 2018); *Sanofi-Aventis U.S. LLC v. Immunex Corp.*, IPR2017-01879, Paper 90 (P.T.A.B. 2019).

Accordingly, the parties jointly request that the record in this case be preserved in its entirety by maintaining Exhibits 2120-2124 and Columbia’s Sealed Patent Owner’s Response (Paper 34) under seal until the time for filing a notice of appeal expires, or if an appeal is taken, until a final disposition of such appeal, whichever is later. Petitioner further requests that the Board order a date certain at the conclusion of all appeal proceedings for Petitioner to file a motion to expunge the confidential information from the record. Specifically, Petitioner seeks an order that a motion to expunge will be due within 45 days following all appeals

and opportunities to appeal. *See, e.g., Kayak Software Corp. v. Int’l Bus. Machines Corp.*, IPR2016-00608, Paper 67 at 43-44 (P.T.A.B. 2017); *L-3 Commc’ns Holdings, Inc. v. Power Survey, LLC*, IPR2014-00834, Paper 70 at 2-3 (P.T.A.B. 2016).

B. If the Board denies this motion, Petitioner respectfully requests additional time to file a motion to expunge confidential information.

As discussed above, sealed information subject to a protective order is typically made public 45 days after a final judgment unless a motion to expunge the information is filed before that time. Should the Board deny the relief requested herein, Petitioner respectfully requests that the Board provide five business days from such denial for a motion to expunge the sealed material to be filed.

IV. CONCLUSION

Based on the foregoing, the parties jointly request the Board to preserve the record of this proceeding by maintaining the confidentiality of sealed Exhibits 2120-2124 and Columbia’s Sealed Patent Owner’s Response (Paper 34) until all appeal rights have been exhausted, and to provide 45 days for a motion to expunge the sealed material to be filed after all appeal rights have been exhausted.

Dated: July 26, 2019

Respectfully submitted by:

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **JOINT MOTION TO MAINTAIN RECORD UNDER SEAL** is being served July 26, 2019, via e-mail, pursuant to agreement of the parties, to counsel for The Trustees of Columbia University in the City of New York, at the addresses below:

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