

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

----- x
ILLUMINA, INC., :
v. Plaintiff, :
GUARDANT HEALTH, INC.; HELMY : C.A. No. 1:22-cv-334-VAC
ELTOUKHY; and AMIRALI TALASAZ :
Defendants. :
----- x

**DEFENDANTS' OPENING BRIEF IN SUPPORT OF MOTION TO DISMISS
UNDER FEDERAL RULES OF CIVIL PROCEDURE 12(B)(1), 12(B)(2), AND 12(B)(6)**

OF COUNSEL:

Orin Snyder*
Jane M. Love*
Brian A. Rosenthal*
Grace E. Hart*
GIBSON, DUNN & CRUTCHER LLP
200 Park Avenue
New York, NY 10166
(212) 351-4000

Greta B. Williams*
Sophia A. Vandergrift*
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500

Daniel M. Silver (#4758)
Alexandra M. Joyce (#6423)
MCCARTER & ENGLISH, LLP
Renaissance Centre
405 N. King Street, 8th Floor
Wilmington, DE 19801
(302) 984-6300
dsilver@mccarter.com
ajoyce@mccarter.com

*Attorneys for Defendants Guardant Health,
Inc., Helmy Eltoukhy, and AmirAli Talasaz*

OF COUNSEL:

Trey Cox*
GIBSON, DUNN & CRUTCHER LLP
2001 Ross Avenue, Suite 2100
Dallas, TX 75201
(214) 698-3100

Dated: May 25, 2022

**pro hac vice* pending

TABLE OF CONTENTS

	Page(s)
I. NATURE AND STAGE OF THE PROCEEDINGS	1
II. SUMMARY OF THE ARGUMENT	3
III. STATEMENT OF FACTS	4
A. Dr. Eltoukhy and Dr. Talasaz Co-Founded Guardant to Develop Life-Saving Cancer Testing Technology	4
B. Illumina Alleges that Defendants Misappropriated Its Confidential Information a Decade Before Filing This Action	5
IV. ARGUMENT	7
A. Legal Standard	7
B. Illumina Has Failed to Plead a Plausible Inventorship and Ownership Claim under 35 U.S.C. § 256.....	8
1. Illumina Failed to Plausibly State a Claim for Inventorship.....	9
2. Illumina Does Not Plausibly Allege an Ownership Interest in the Patents at Issue, and Thus it Lacks Standing	13
3. Illumina Cannot Challenge Patent Applications under Section 256.....	16
C. Illumina’s Trade Secrets Misappropriation Claim Fails as a Matter of Law.....	17
1. Illumina Has Not Adequately Alleged a Trade Secret.....	17
2. To the Extent They Are Pledged with Any Specificity, Illumina’s Claims Are Time-Barred.....	19
D. Illumina’s Breach of Contract Claims Fail as a Matter of Law.....	21
1. Illumina’s Breach of Contract Claims Are Untimely	21
2. Illumina’s Breach of Contract Claims Are Deficient Because Illumina Fails to Plead the Essential Terms of the Contracts	23
E. This Court Lacks Personal Jurisdiction over Dr. Eltoukhy and Dr. Talasaz	24
V. CONCLUSION.....	25

TABLE OF AUTHORITIES

	<i>Page(s)</i>
CASES	
<i>Acrisure of California, LLC v. SoCal Com. Ins. Servs., Inc.</i> , 2019 WL 4137618 (C.D. Cal. Mar. 27, 2019).....	17, 18, 19
<i>Allergan, Inc. v. Apotex Inc.</i> , 754 F.3d 952 (Fed. Cir. 2014).....	14
<i>AlterG, Inc. v. Boost Treadmills LLC</i> , 388 F. Supp. 3d 1133 (N.D. Cal. 2019)	24
<i>Apple Inc. v. Allan & Assocs. Ltd.</i> , 445 F. Supp. 3d 42 (N.D. Cal. 2020)	21
<i>Ashcroft v. Iqbal</i> , 556 U.S. 662 (2009).....	7
<i>Bell Atl. Corp. v. Twombly</i> , 550 U.S. 544 (2007).....	7, 9
<i>Blackhawk Network Inc. v. SL Card Co., Inc.</i> , 2022 WL 704032 (D. Ariz. Mar. 9, 2022).....	10, 12
<i>Burroughs Wellcome Co. v. Barr Labs. Inc.</i> , 40 F.3d 1223 (Fed Cir. 1994).....	9, 11
<i>In re Chemed Corp., Shareholder Derivative Litig.</i> , 2015 WL 9460118 (D. Del. Dec. 23, 2015).....	6
<i>Chou v. Univ. of Chicago</i> , 254 F.3d 1347 (Fed. Cir. 2001).....	13
<i>Corning Inc. v. SRU Biosystems, LLC</i> , 292 F. Supp. 2d 583 (D. Del. 2003).....	21
<i>Czarnik v. Illumina, Inc.</i> , 437 F. Supp. 2d 252 (D. Del. 2006).....	13, 16
<i>Display Research Labs., Inc. v. Telegen Corp.</i> , 133 F. Supp. 2d 1170 (N.D. Cal. 2001)	17
<i>E.I. Du Pont de Nemours & Co. v. Okuley</i> , 344 F.3d 578 (6th Cir. 2003)	17

<i>Eli Lilly & Co. v. Aradigm Corp.</i> , 376 F.3d 1352 (Fed. Cir. 2004).....	9
<i>Ethicon, Inc. v. U.S. Surgical Corp.</i> , 135 F.3d 1456 (Fed. Cir. 1998).....	9
<i>Gould Elecs. Inc. v. United States</i> , 220 F.3d 169 (3d Cir. 2000).....	13
<i>Gross v. Symantec Corp.</i> , 2012 WL 3116158 (N.D. Cal. July 31, 2012).....	23
<i>Hor v. Chu</i> , 699 F.3d 1331 (Fed. Cir. 2012).....	16
<i>In re Horizon Healthcare Servs. Inc. Data Breach Litig.</i> , 846 F.3d 625 (3d Cir. 2017).....	7
<i>inno360, Inc. v. Zakta, LLC</i> , 50 F. Supp. 3d 587 (D. Del. 2014).....	7
<i>Invitrogen Corp. v. Clontech Labs., Inc.</i> , 429 F.3d 1052 (Fed. Cir. 2005).....	14
<i>Joint Stock Soc. Trade House of Descendants of Peter Smirnoff, Off. Purveyor to the Imperial Ct. v. Heublein, Inc.</i> , 936 F. Supp. 177 (D. Del. 1996).....	25
<i>Klang v. Pflueger</i> , 2014 WL 12587028 (N.D. Cal. Oct. 2, 2014).....	9, 20
<i>Langan v. United Servs. Auto. Ass'n</i> , 69 F. Supp. 3d 965 (N.D. Cal. 2014).....	23, 24
<i>Larson v. Correct Craft, Inc.</i> , 569 F.3d 1319 (Fed. Cir. 2009).....	13
<i>Loop AI Labs Inc. v. Gatti</i> , 195 F. Supp. 3d 1107 (N.D. Cal. 2016)	18
<i>Lujan v. Defenders of Wildlife</i> , 504 U.S. 555 (1992).....	13
<i>Morse v. Lower Merion Sch. Dist.</i> , 132 F.3d 902 (3d Cir. 1997).....	7
<i>Nami v. Fauver</i> , 82 F.3d 63 (3d Cir. 1996).....	7

<i>NBCUniversal Media, LLC v. Superior Court,</i> 225 Cal. App. 4th 1222 (Cal. Ct. App. 2014)	22
<i>Neuberger v. Gordon,</i> 567 F. Supp. 2d 622 (D. Del. 2008).....	6
<i>Pappalardo v. Stevens,</i> 746 F. App'x 971 (Fed. Cir. 2018)	16
<i>Pellerin v. Honeywell Int'l, Inc.,</i> 877 F. Supp. 2d 983 (S.D. Cal. 2012).....	18
<i>Plumlee v. Pfizer, Inc.,</i> 664 F. App'x 651 (9th Cir. 2016)	23
<i>Reach & Assocs., P.C. v. Dencer,</i> 269 F. Supp. 2d 497 (D. Del. 2003).....	25
<i>Regents of Univ. of California v. Chen,</i> 2017 WL 3215356 (N.D. Cal. July 26, 2017).....	21
<i>Space Data Corp. v. X,</i> 2017 WL 5013363 (N.D. Cal. Feb. 16, 2017)	18
<i>Spokeo v. Robins,</i> 578 U.S. 330 (2016).....	11, 13
<i>Vanderbilt Univ. v. ICOS Corp.,</i> 601 F.3d 1297 (Fed. Cir. 2010).....	9
<i>Vendavo, Inc. v. Price f(x) AG,</i> 2018 WL 1456697 (N.D. Cal. Mar. 23, 2018).....	18
<i>In re VerHoef,</i> 888 F.3d 1362 (Fed. Cir. 2018).....	9
<i>Vint v. Universal Studios Co. LLC,</i> 2021 WL 6618535 (C.D. Cal. Apr. 29, 2021)	23
<i>Wang v. Palo Alto Networks, Inc.,</i> 2014 WL 1410346 (N.D. Cal. Apr. 11, 2014)	20
<i>Whitewater West Indus., Ltd. v. Alleshouse,</i> 981 F.3d 1045 (Fed. Cir. 2020).....	13, 15
<i>Wiggins v. Physiologic Assessment Servs., LLC,</i> 138 A.3d 1160 (Del. Super. Ct. 2016)	25

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.