Filed on behalf of: The Board of Trustees of the Leland Stanford Junior University Paper _____ Date: July 17, 2013

By: R. Danny Huntington, Lead Counsel Sharon E. Crane, Ph.D., Backup Counsel Rothwell, Figg, Ernst & Manbeck, P.C. 607 14th St., N.W., Suite 800 Washington, DC 20005 Telephone: 202-783-6040 Facsimile: 202-783-6031 E-mail: <u>dhuntington@rfem.com</u> scrane@rfem.com

DOCKET

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEQUENOM, INC. Petitioner,

v.

THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR UNIVERSITY Patent Owner.

> Case IPR2013-00390 Patent 8,195,415

PATENT OWNER'S MANDATORY NOTICES

Mail Stop PATENT BOARD Patent Trial and Appeal Board U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.8, Patent Owner, The Board of Trustees of the

Leland Stanford Junior University ("Stanford"), submits the following Mandatory

Notices in response to the Petition for Inter Partes Review of U.S. Patent No.

8,195,415.

1. Real Party-In-Interest

In accordance with 37 C.F.R. § 42.8(b)(1), Patent Owner Stanford identifies

the real parties-in-interest as follows.

The Assignee for U.S. Patent No. 8,195,145 is:

The Board of Trustees of the Leland Stanford Junior University 1705 El Camino Real Palo Alto, California 94306-1106.

In addition, the following companies are licensees of U.S. Patent No.

8,195,415:

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Fluidigm Corporation 7000 Shoreline Court, Suite 100 South San Francisco, California 94080; and

Verinata Health, Inc. 800 Saginaw Drive Redwood City, California 94063. Verinata Health, Inc. is a wholly owned subsidiary of Illumina, Inc.:

Illumina, Inc. 5200 Illumina Way San Diego, California 92122.

The U.S. Government also has certain rights as reflected in the confirmatory

license recorded at Reel/Frame 024129/0136 to:

National Institutes of Health U.S. Department of Health and Human Services Division of Extramural Inventions and Technology Resources 6705 Rockledge Drive, Suite 310, MSC 7980 Bethesda, Maryland 20892-7980.

2. Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Patent Owner Stanford identifies the following related proceedings:

U.S. Patent No. 8,195,415 is at issue in Interference No. 105,922, currently

pending before the Patent Trial and Appeal Board.

U.S. Patent No. 8,195,415 issued on June 5, 2012, from U.S. Patent

Application No. 12/696,509, filed on January 29, 2010, and claims benefit to: U.S.

Patent Application No. 12/560,708, filed on September 16, 2009, which is

pending; and U.S. Provisional Patent Application No. 61/098,758, filed on

September 20, 2008, and now expired.

International Application No. PCT/US09/57136, filed on September 16,

2009, which was published as WO/2010/033578, on March 25, 2010; U.S. Patent

Application No. 12/560,708, filed on September 16, 2009, which is pending; U.S.

Patent Application No. 13/102,717, filed on May 6, 2011, which is pending; and

U.S. Patent Application No. 13/218,317, filed on August 25, 2011, which is

pending, also claim the benefit of priority from U.S. Provisional Patent Application

No. 61/098,758.

U.S. Patent Application No. 13/102,717, filed on May 6, 2011, and U.S.

Patent Application No. 13/452,083, filed on April 20, 2012, and issued as U.S.

Patent No. 8,296,076, also claim, or may claim, the benefit to/priority from U.S.

Patent Application No. 12/696,509.

3. Lead and Back-Up Counsel

In accordance with 37 C.F.R. § 42.8(b)(3), Patent Owner Stanford identifies

R. Danny Huntington as lead counsel and Sharon E. Crane as back-up counsel:

R. Danny Huntington, Lead Counsel USPTO Reg. No. 27,903 Rothwell, Figg, Ernst & Manbeck, P.C. 607 14th Street, N.W., Suite 800 Washington, DC 20005 Phone: 202-783-6040 Facsimile: 202-783-6031 E-mail: <u>dhuntington@rfem.com</u>

Sharon E. Crane, Ph.D., Back-up Counsel USPTO Reg. No. 36,113 Rothwell, Figg, Ernst & Manbeck, P.C. 607 14th Street, N.W., Suite 800 Washington, DC 20005 Phone: 202-783-6040 Facsimile: 202-783-6031 E-mail: scrane@rfem.com

4. Service Information

In accordance with 37 C.F.R. § 42.8(b)(4), Patent Owner Stanford identifies

the following service information:

R. Danny Huntington Rothwell, Figg, Ernst & Manbeck, P.C. 607 14th Street, N.W., Suite 800 Washington, DC 20005 Service E-mails: <u>dhuntington@rfem.com</u> <u>scrane@rfem.com</u> Phone: 202-783-6040 Facsimile: 202-783-6031

Respectfully submitted,

Date: July 17, 2013

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By: <u>/s/ R. Danny Huntington</u> R. Danny Huntington, Reg. No. 27,903 Sharon E. Crane, Ph.D., Reg. No. 36,113 Rothwell, Figg, Ernst & Manbeck, P.C. 607 14th Street, N.W., Suite 800 Washington, DC 20005

> Counsel for Patent Holder The Board of Trustees of the Leland Stanford Junior University

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