On behalf of Illumina, Inc.

DOCKET

ALARM

By: Kerry S. Taylor Nathanael R. Luman Michael L. Fuller William R. Zimmerman (pro hac vice) KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 Tel.: (858) 707-4000 Fax: (858) 707-4001 Email: BoxIllumina@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC. Petitioner,

v.

TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF NEW YORK Patent Owner.

IPR2020-00988 Patent 10,407,458

ILLUMINA UPDATED EXHIBIT LIST

DOCKE.

Δ

Pursuant to 37 C.F.R. § 42.63(e), Petitioner Illumina, Inc., hereby provides

an updated list of its exhibits in this proceeding.

Exhibit No.	Description	
1001	U.S. Patent No. 10,407,458 ("Ju") – (guanine with allyl proviso)	
Exhibit numbers 1002-1012 not used.		
1013	U.S. Patent No. 7,790,869 ("Ju")	
1014	U.S. Patent No. 7,713,698 ("Ju")	
1015	U.S. Patent No. 8,088,575 ("Ju")	
1016	U.S. Patent No. 9,718,852 ("Ju") – (adenine)	
1017	U.S. Patent No. 9,719,139 ("Ju") – (thymine)	
1018	U.S. Patent No. 9,708,358 ("Ju") – (cytosine)	
1019	U.S. Patent No. 9,725,480 ("Ju") – (guanine)	
1020	U.S. Patent No. 9,868,985 ("Ju") – (method)	
1021	2014-03-06 IPR2012-00007, Paper 140, Final Written Decision	
1022	2014-03-06 IPR2012-00006, Paper 128, Final Written Decision	
1023	2014-03-06 IPR2013-00011, Paper 130, Final Written Decision	
1024	2019-06-21 IPR2018-00291, -00318, -00322, -00385, Final Written Decisions	
1025	Exhibit number not used	
1026	Exhibit number not used	
1027	Exhibit number not used	

EXHIBIT LIST

A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

Exhibit No.	Description
1028	2019-09-09 IPR2018-00797, Final Written Decision
1029	2015-07-17 Federal Circuit Opinion Affirming IPR2012-00006, IPR2012-00007 and IPR2013-00011
1030	U.S. Patent No. 5,547,839 ("Dower")
1031	WO 91/06678 ("Tsien")
1032	Excerpt from Prosecution History of U.S. Patent No. 10,407,458 (Declaration of Jingyue Ju and Accompanying Documents)
1033	Welch et al., "Syntheses of Nucleosides Designed for Combinatorial DNA Sequencing," Chem. Eur. J., 5:951-960 (1999) ("Welch")
1034	Excerpt from Prosecution History of U.S. Patent No. 10,407,458 (2019- 01-16 Pre-interview First Office Action)
1035	Excerpt from Prosecution History of U.S. Patent No. 10,407,458 (2019- 02-12 Applicant Arguments/Remarks Made in an Amendment)
1036	Excerpt from Prosecution History of U.S. Patent No. 10,407,458 (2019- 05-09 Applicant Arguments/Remarks Made in an Amendment)
1037	Alberts et al., "Molecular Biology of the Cell," Third Edition, Garland Publishing Inc., New York (1994)
1038	Declaration of Dr. Floyd Romesberg, Ph.D.
1039	Metzker et al., "Termination of DNA synthesis by novel 3'-modified- deoxyribonucleoside 5'-triphosphates," Nucleic Acids Research, 22:4259-67 (1994) ("Metzker")
1040	Sanger et al., "DNA sequencing with chain-terminating inhibitors," Proc. Nat'l Acad. Sci. USA, 74:5463-5467 (1977) ("Sanger")
1041	Prober et al., "A System for Rapid DNA Sequencing with Fluorescent Chain-Terminating Dideoxynucleotides," Science, 238:336-341 (1987) ("Prober")

Exhibit No.	Description
1042	U.S. Patent No. 5,302,509 ("Cheeseman")
1043	U.S. Patent No. 5,763,594 ("Hiatt")
1044	Pelletier et al., "Structures of Ternary Complexes of Rat DNA Polymerase β, a DNA Template-Primer, and ddCTP," Science, 264:1891-1903 (1994) ("Pelletier")
1045	U.S. Patent No. 4,804,748 ("Seela Patent")
1046	Rosenblum et al., "New dye-labeled terminators for improved DNA sequencing patterns," Nucleic Acid Research, 25:4500-4504 (1997) ("Rosenblum")
1047	Exhibit number not used
1048	Excerpts from 2019-01-14 Deposition Transcript of Dr. Menchen in IPR2018-00291, -00318, -00322, and -00797
1049	2018-05-04 IPR2018-00385, Paper 13, Patent Owner Preliminary Response
1050	Canard et al., "Catalytic editing properties of DNA polymerases," Proc. Nat'l Acad. Sci. USA, 92:10859-10863 (1995) ("Canard")
1051	Exhibit number not used
1052	Yu et al., "Cyanine dye dUTP analogs for enzymatic labeling of DNA probes," Nucleic Acids Research, 22:3226-3232 (1994) ("Yu")
1053	Livak et al., "Detection of single base differences using biotinylated nucleotides with very long linker arms," Nucleic Acids Research, 20:4831-4837 (1992) ("Livak")
1054	Stryer, "Biochemistry," Fourth Edition, W.H. Freeman and Co., New York (1995) ("Stryer")

Exhibit No.	Description
1055	Watson & Crick, "Genetical Implication of the Structure of Deoxyribonucleic Acid," Nature, 171:964-967 (1953) ("Watson & Crick")
1056	U.S. Patent No. 5,151,507 ("Hobbs")
1057	Seela et al., "Oligonucleotide Duplex Stability Controlled by the 7- Substituents of 7-Deazaguanine Bases," Bioorganic & Mechanical Chemistry Letters, 5:3049-3052 (1995) ("Seela 1995")
1058	Excerpts from Sept. 4-5, 2013 Deposition Transcript of Dr. George L. Trainor in IPR2012-00007
1059	Exhibit number not used
1060	Hovinen et al., "Synthesis of 3'-O-(ω-Aminoalkoxymethyl)thymidine 5'-Triphosphates, Terminators of DNA Synthesis that Enable 3'- Labeling," J. Chem. Soc. Perkin Trans. 1, 211-217 (1994) ("Hovinen")
1061	Exhibit number not used
1062	Excerpt from Prosecution History of U.S. Patent No. 9,725,480
1063	Ireland et al., "Approach to the Total Synthesis of Chlorothricolide: Synthesis of (±)-19,20-Dihydro-24- <i>O</i> -methylchlorothricolide, Methyl Ester, Ethyl Carbonate," J. Org. Chem. 51:635-648 (1986) ("Ireland")
1064	Exhibit number not used
1065	Excerpt from Prosecution History of U.S. Patent No. 10,428,380 [U.S. Appl. No. 16/150,191] (2019-03-12 Pre-interview first office action)
1066	Ruparel et al., "Design and synthesis of a 3'-O-allyl photocleavable fluorescent nucleotide as a reversible terminator for DNA sequencing by synthesis," PNAS, Vol. 102, No. 17, 5932-37 (2005) ("Ruparel")
1067	Ju et al., "Four-color DNA sequencing by synthesis using cleavable fluorescent nucleotide reversible terminators," PNAS, Vol. 103, No. 52, 19635-40 (2006) ("Ju")

DOCKET A L A R M



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.