

(Also referred to as FORM PTO-1465)

REQUEST FOR EX PARTE REEXAMINATION TRANSMITTAL FORM

U.S. PTO

Address to:
**Mail Stop Ex Parte Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Attorney Docket No.: BLG-RE-00002



06/25/10

Date: 6/25/10

1. This is a request for *ex parte* reexamination pursuant to 37 CFR 1.510 of patent number 5,808,045 issued 8/15/1998. The request is made by:
 patent owner. third party requester.
2. The name and address of the person requesting reexamination is:

3. a. A check in the amount of \$ 2520.00 is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(1);
 b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(1) to Deposit Account No. _____; or
 c. Payment by credit card. Form PTO-2038 is attached.
4. Any refund should be made by check or credit to Deposit Account No. _____ 37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.
5. A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.510(b)(4)
6. CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table
 Landscape Table on CD
7. Nucleotide and/or Amino Acid Sequence Submission
If applicable, items a. - c. are required.
 - a. Computer Readable Form (CRF)
 - b. Specification Sequence Listing on:
 - i. CD-ROM (2 copies) or CD-R (2 copies); or
 - ii. paper
 - c. Statements verifying identity of above copies
8. A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.
9. Reexamination of claim(s) 1-7 is requested.
10. A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.
11. An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.510. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND TO: Mail Stop Ex Parte Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-1465.

Columbia Ex. 2054
Illumina, Inc. v. The Trustees of
Columbia University in the City of

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

12. The attached detailed request includes at least the following items:
- a. A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.510(b)(1)
- b. An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.510(b)(2).

13. A proposed amendment is included (only where the patent owner is the requester). 37 CFR 1.510(e)

14. a. It is certified that a copy of this request (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).

The name and address of the party served and the date of service are:

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK600 SOUTH AVENUE WESTWESTFIELD NJ 07090-1497Date of Service: 6/25/10; or

- b. A duplicate copy is enclosed because service on patent owner was not possible. An explanation of the efforts made to serve patent owner is **attached**. See MPEP 2220.

15. Correspondence Address: Direct all communications about the reexamination to:

- The address associated with Customer Number:

35938

OR

- Firm or
Individual Name

Address

City

State

Zip

Country

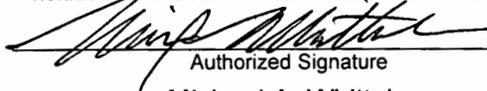
Telephone

Email

16. The patent is currently the subject of the following concurrent proceeding(s):

- a. Copending reissue Application No. _____
- b. Copending reexamination Control No. _____
- c. Copending Interference No. _____
- d. Copending litigation styled: _____

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.



Authorized Signature

Michael A. Whittaker

Typed/Printed Name

6/25/10

Date

46,230Registration No. For Patent Owner Requester For Third Party Requester

CUSTOMER NUMBER 21967

as its attorneys and agents with full power of substitution and revocation, to prosecute said patent, including any and all continuation, divisional, renewal, substitute, reexamination and reissue applications based in whole or in part on said patent application, before the U.S. Patent and Trademark Office, to transact all business in the U.S. Patent and Trademark Office connected therewith, including receiving any Letters Patent issuing thereon, and to take any and all other legal action with regard to this patent application.

All correspondence and telephone communications should be addressed to:

CUSTOMER NUMBER 21967

which corresponds to the following:

Intellectual Property Department
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(202) 778-2201 (facsimile)

Dated: August 31, 2010

By: Christian G. Cabou
Name: Christian G. Cabou
Title: Senior Vice President
and General Counsel
Illumina, Inc.
9885 Towne Centre Drive
San Diego, CA 92121

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Control Number : 90/009,769 Confirmation No.: 5114
Inventors : Andrew C. HIATT et al.
Patent Number : 5,808,045
Issue Date : September 15, 1998
Title : COMPOSITIONS FOR ENZYME CATALYZED TEMPLATE-
INDEPENDENT CREATION OF PHOSPHODIESTER BONDS
USING PROTECTED NUCLEOTIDES
TC/Art Unit : 3991
Examiner: : Gary L. KUNZ
Docket No. : 68205.000103
Customer No. : **21967**

MAIL STOP *EX PARTE* REEXAM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**AMENDMENT AND RESPONSE TO NON-FINAL OFFICE
ACTION IN *EX PARTE* REEXAMINATION**

Sir:

This amendment and response is responsive to the non-final Office Action issued December 21, 2010 in the above-captioned *ex parte* reexamination. A one-month extension of time was granted on February 7, 2011, thereby extending the due date for responding up to and including March 21, 2011.

Amendments to the Claims begin on page 2 of this Amendment.

Remarks begin on page 9 of this Amendment.

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