

Filed July 20, 2021

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 |
| IPR2020-01065 | Patent 10,407,459 |
| IPR2020-01125 | Patent 10,457,984 |
| IPR2020-01177 | Patent 10,435,742 |
| IPR2020-01323 | Patent 10,428,380* |

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Illumina, Inc. (“Illumina”) and Patent Owner The Trustees of Columbia University in the City of New York (“Columbia”) jointly move to terminate the above-referenced *inter partes* review proceedings in light of the parties’ settlement of their disputes regarding the involved patents, U.S. Patent Numbers 10,407,458, 10,407,459, 10,457,984, 10,435,742, and 10,428,380. The filing of this Joint Motion was authorized by the Board in an e-mail dated July 16, 2021. The parties are filing, concurrently with this motion, a true copy of their written Settlement Agreement (Ex. 1169) in connection with these matters as required by the statute. Given that Illumina is the only Petitioner in these proceedings, the settlement effectively resolves all disputes, and the entire proceedings should be dismissed as to both Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On July 13, 2021, Petitioner and Patent Owner reached an agreement resolving all disputes regarding the patents involved in the *inter partes* review proceedings, which include the above-captioned *inter partes* reviews, as well as the related district court litigation between Petitioner and Patent Owner. No other petitioners remain in these *inter partes* review proceedings. Accordingly, termination is appropriate because all disputes between the parties regarding U.S.

Patent Numbers 10,407,458, 10,407,459, 10,457,984, 10,435,742, and 10,428,380 have been resolved.

Illumina's petitions and Columbia's responses to the petitions have been filed in these cases. No further trial briefs have been filed, and oral argument has not yet taken place. Accordingly, termination is appropriate because these proceedings are still in a relatively early stage.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), filed separately herewith as Exhibit 1169 is a true copy of the written Settlement Agreement resolving the disputes in the above-captioned *inter partes* reviews. The parties also are filing separately herewith a request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c).

For at least these reasons, Patent Owner and Petitioner submit that termination of these *inter partes* reviews is appropriate. Pursuant to 35 U.S.C. § 317(a), because the *inter partes* reviews are being terminated with respect to the Petitioner, no estoppel pursuant to 35 U.S.C. § 315(e) shall attach to Petitioner Illumina.

Dated: July 20, 2021

Respectfully Submitted By:

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing is being served on July 20, 2021, via email, pursuant to agreement of the parties, to counsel for the Trustees of Columbia University in the City of New York, at the email addresses below:

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