

Filed July 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**ILLUMINA, INC.**  
Petitioner,

v.

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

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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*

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**RENEWED 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, 37 C.F.R. § 42.74, and the Board’s July 23, 2021 Order, 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 Order dated July 23, 2021. The parties have filed a true copy of their written Settlement Agreement (Exs. 1169 and 1170) 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 as Exhibits 1169 and 1170 are a true copy of the written Settlement Agreement resolving the disputes in the above-captioned *inter partes* reviews (Ex. 1169), including a true copy of a referenced July 2017 Settlement Agreement (Ex. 1170). The parties also are filing separately herewith a request that these exhibits that constitute 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.

Illumina v. Columbia  
IPR2020-00988, -01065, -01125, -01177, & -01323

Dated: July 29, 2021

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## CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing is being served on July 29, 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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