

No. 2019-2302, 2019-2303, 2019-2304, 2019-2305, 2019-2452

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The Trustees of Columbia University in the City of New York,

Appellant,

v.

Illumina, Inc.,

Appellee.

Appeals from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in Nos. IPR2018-00291,
IPR2018-00318, IPR2018-00322, IPR2018-00385, and IPR2018-00797

**REPLY IN SUPPORT OF APPELLANT'S
MOTION FOR JUDICIAL NOTICE**

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Illumina Ex. 1166

CERTIFICATE OF INTEREST

Counsel for The Trustees of Columbia University in the City of New York certifies the following:

1. The full name of every party or amicus represented by me is:

- The Trustees of Columbia University in the City of New York.

2. The real party in interest is:

- The Trustees of Columbia University in the City of New York.

3. All parent corporations and any publicly held companies that own 10% or more of the stock of the parties I represent are:

- None.

4. The names of all law firms and the partners or associates that appeared for the parties now represented by me in the trial court or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

- Cooper & Dunham: Gary J. Gershik;
- Morris, Nichols, Arsht & Tunnell: Jack B. Blumenfeld; Maryellen Noreika (now Judge Maryellen Noreika).

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this Court's decision in the pending appeal:

- *The Trustees of Columbia University in the City of New York et al. v. Illumina, Inc.*, 17-cv-00973 (D. Del.)

:

I. ARGUMENT

Illumina waited until the briefing period in these appeals was over before filing the IPR2020-00988 documents, toward the end of its 1-year filing window. Illumina's statements in those documents are relevant to these appeals, and Columbia should be permitted to address those statements at the upcoming oral argument.

Illumina opposes Columbia's request by mischaracterizing the law in a manner that would all but negate this Court's ability to take judicial notice. Illumina contends that while this Court can take judicial notice of the fact that a document was filed, it cannot further notice the contents of the filed document. That is wrong. Federal Rule of Evidence 201 permits judicial notice to be taken of any fact "that is not subject to reasonable dispute because" it "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." In IPR2020-00988, Illumina filed with the Patent Trial and Appeal Board ("PTAB") a Petition and Expert Declaration. The indisputable fact is that Illumina and its expert made the statements in those documents, including the statements that Columbia wishes to bring to this Court's attention. *See* Columbia's Motion, D.I. 51 at 3 (quoting statements). Anyone can go the PTAB's website, download the documents in question, which were submitted by Illumina, and confirm the existence of those statements.

It is well within this Court's ability to take judicial notice of statements made in documents filed in district court and Patent Office proceedings. In *LA Biomed*, this Court took judicial notice of the contents of infringement contentions filed in a district court litigation. *Los Angeles Biomedical Res. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1061, 1061 n.6 (Fed. Cir. 2017). Illumina contends that the Court in *LA Biomed* noticed only that the contentions were filed, as opposed to noticing statements found therein. D.I. 53 at 3 n.1. That is wrong. After taking judicial notice, this Court explicitly considered, ***and even quoted***, statements in the contentions:

Nor do LAB's infringement contentions in the ongoing district court case render the "arresting or regressing" limitation irrelevant.... LAB alleged that the "[l]ong-term administration of Cialis on a once daily basis for the treatment of [erectile dysfunction] results in the arrest or regression of penile tunical fibrosis (i.e., [Peyronie's disease]) and corporal tissue fibrosis (i.e., [CVOD])." [LAB]'s Disclosure of Asserted Claims and Preliminary Infringement Contentions, Ex. A at 5, *Los Angeles Biomed. Research Inst. v. Eli Lilly & Co.*, No. 2:13-cv-08567-JAK-JCG (C.D. Cal. filed May 19, 2014).

849 F.3d at 1061-1062 (brackets in original); *see also St. Clair Intellectual Prop. Consultants, Inc. v. Canon Inc.*, 412 F. App'x 270, 275-276, 275 n.1 (Fed. Cir. 2011) (considering remarks made in documents before the Patent and Trademark Office after taking judicial notice of those documents).

Illumina also mischaracterizes *Uniloc*, a case in which this Court took judicial notice of a patent's prosecution history and then cited the contents of that

history. *Uniloc USA, Inc. v. ADP, LLC*, 772 F. App'x 890, 897-898, 898 n.3 (Fed. Cir. 2019). Illumina alleges that the *Uniloc* “Court was clear that the prosecution history was part of the record[,]” D.I. 53 at 3 n.1, but that is wrong and illogical. If the prosecution history were part of the record being appealed, there would have been no need for the Court to take judicial notice of it. Instead, this Court stated that the prosecution history was “a matter of *public* record,” not that it was part of the record being appealed. 772 F. App'x at 898 n.3 (internal quotations and brackets omitted, emphasis added). Likewise, the IPR2020-00988 documents at issue here are a matter of public record, verifiable by anyone who wishes to download the documents from the PTAB’s website.

Beyond mischaracterizing the law, Illumina attempts to obfuscate issues by alleging that Columbia’s motion requests this Court take judicial notice of the fact that the methyl capping group is unsuitable for SBS. D.I. 53 at 2 (“Columbia improperly asks this Court to evaluate new materials and make factual determinations about the substance of those materials.”). Columbia makes no such request, and Illumina’s cited case law is thus inapposite. Instead, Columbia’s motion merely requests this Court take notice of Illumina’s IPR2020-00988 Petition and Expert Declaration. Judicial notice of these documents is necessary to allow consideration during the upcoming oral argument of Illumina’s statements

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