

Filed on behalf of:

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

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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.

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

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Case IPR2020-01177

Patent 10,435,742

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PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8

**MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8(a)(2)**

Pursuant to 37 C.F.R. § 42.8(a)(2), the mandatory notices identified in 37 C.F.R. § 42.8(b) are provided below.

**A. REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(b)(1))**

The Trustees of Columbia University in the City of New York (“Columbia”) is the real party-in-interest for Patent Owner.

**B. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))**

Illumina, Inc. (“Illumina”) has filed a petition for IPR of U.S. Patent No. 10,435,742 (the ’742 patent). The ’742 patent is asserted against Illumina in *Trustees of Columbia Univ. v. Illumina, Inc.*, 19-cv-1681-CFC (D. Del.). U.S. Patent Nos. 10,407,458; 10,407,459; and 10,457,984 are asserted in that same litigation, and Illumina has filed IPR Petitions against those patents in IPR2020-00988, IPR2020-01065, and IPR2020-01125, respectively.

**a. Matters Involving Patents from the Same Patent Family**

Columbia asserted U.S. Patent Nos. 9,718,852, 9,719,139, 9,708,358, 9,725,480, and 9,868,985 (“the ’852, ’139, ’358, ’480, and ’985 patents”) against Illumina in *Trustees of Columbia Univ. v. Illumina, Inc.*, 17-cv-973-GMS (D. Del.). The ’852, ’139, ’358, ’480, and ’985 patents were the subject of IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, and IPR2018-00797, respectively. The Board held the challenged claims from the ’852, ’139, ’358,

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'480, and '985 patents unpatentable, and Columbia is presently appealing those decisions in *Trustees of Columbia Univ. v. Illumina, Inc.*, 19-2302 (consolidated) (Fed. Cir.).

Columbia asserted U.S. Patent Nos. 7,790,869, 7,713,698, and 8,088,575 (“the '869, '698, and '575 patents”) against Illumina in *Trustees of Columbia Univ. v. Illumina, Inc.*, 12-cv-376 (D. Del.). The '869, '698, and '575 patents were the subject of IPR2012-00007, IPR2012-00006, and IPR2013-00011, respectively, in which the Board held the challenged claims from the '869, '698, and '575 patents unpatentable. *See also Trustees of Columbia Univ. v. Illumina, Inc.*, 620 Fed. Appx. 916 (Fed. Cir. 2015).

**b. Matters Involving Petitioner’s Patents**

In *Trustees of Columbia Univ. v. Illumina, Inc.*, 12-cv-376 (D. Del.), Illumina raised counterclaims alleging infringement of U.S. Patent Nos. 7,057,026, 8,158,346, and 7,566,537. Illumina’s '026 and '346 patents were the subject of IPR2013-00128 and IPR2013-00266, respectively. The Board held the challenged claims unpatentable, and the Federal Circuit affirmed the Board’s decisions in *Illumina Cambridge Ltd. v. Intelligent Bio-Systems, Inc.*, 638 Fed. Appx. 999 (Fed. Cir. 2016). Illumina’s '537 patent was the subject of IPR2013-00517. The Board held the challenged claims not unpatentable, and the Federal Circuit affirmed the

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Board's decision in *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821

F.3d 1359 (Fed. Cir. 2016).

**C. LEAD AND BACK-UP COUNSEL (37 C.F.R. § 42.8(b)(3))**

Columbia provides the following designation of counsel.

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**D. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))**

Please direct all correspondence to lead counsel and back-up counsel at the addresses shown above. Patent Owner also consents to electronic service by email to [ColumbiaIPR@cooperdunham.com](mailto:ColumbiaIPR@cooperdunham.com).

Respectfully submitted,

Dated: July 17, 2020

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