IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF NEW YORK and QIAGEN SCIENCES LLC,	)	
Plaintiffs,	)	C.A. No. 19-1681-CFC-SRF
v.	)	
ILLUMINA, INC.,	)	
Defendant.	)	

DEFENDANT ILLUMINA, INC.'S INITIAL INVALIDITY CONTENTIONS

Pursuant to the Court's Scheduling Order (D.I. No. 17) Defendant Illumina, Inc. ("Illumina") hereby provides the following Initial Invalidity Contentions for U.S. Patent Nos. 10,407,458 (the "'458 Patent"); 10,407,459 (the "'459 Patent"); 10,428,380 (the "'380 Patent"); 10,435,742 (the "'742 Patent"); and 10,457,984 (the "'984 Patent") (collectively, the "Patents In-Suit"), as well as the related invalidating references (*e.g.*, manuals, patents, and publications).

I. RESERVATION OF RIGHTS

Illumina provides its Contentions subject to the following objections and reservation of rights:

1. Discovery in this matter is at a very early stage. Illumina's investigation regarding the potential grounds of invalidity is ongoing. The Trustees of Columbia University in the City of New York ("Columbia") and Qiagen Sciences, LLC (collectively, "Plaintiffs") have not yet produced documents and things relating to the Patents In-Suit. Illumina's invalidity contentions are given without prejudice to Illumina's right to supple[illegible] ascertained, analyses are made, research is completed,

Columbia Ex. 2004
Illumina, Inc. v. The Trustees of Columbia University in the City of New York
IPR2020-01177

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construed. Illumina further reserves the right to modify, supplement, amend, or otherwise alter these disclosures as discovery progresses, as permitted by the Federal Rules of Civil Procedure, by the Default Standard, or by order of the Court. In particular, Illumina reserves the right to modify, supplement, amend, or otherwise alter these disclosures following an opportunity for expert discovery. These disclosures do not encompass patent unenforceability, which Illumina may allege separately.

2. In the absence of a claim construction order from the Court, Illumina has relied upon ordinary meaning of claim terms, definitions in the patents, and Plaintiffs' apparent claim construction positions from Plaintiffs' infringement contentions served on January 17, 2020, to the extent any such constructions can be discerned. Illumina's reliance on Plaintiffs' claim constructions should not be taken to mean that Illumina in any way agrees with Plaintiffs' apparent claim constructions or that Illumina is precluded from propounding alternative claim constructions or requesting Plaintiffs' actual claim construction positions in the future. Illumina expressly reserves the right to propose alternative constructions to those advocated by Plaintiffs. Furthermore, prior art not included in this disclosure, whether or not known to Illumina, may become relevant depending upon the claim constructions that Plaintiffs may assert or that the Court may adopt. Illumina's investigation is continuing and is likely to uncover additional art. Illumina will supplement its disclosures at appropriate times in light of newly discovered art or changes in claim constructions.

3. The disclosure of a reference as anticipating of a claim includes a disclosure of the reference for obviousness purposes should any element of the claim be determined by the Court to be absent from the reference. Moreover, Illumina is at the present time unaware of the extent, if any, to which Plaintiffs will contend that elements of the claims are not disclosed in references

identified by Illumina as anticipatory. To the extent that Plaintiffs make any such claim with respect to any limitation, Illumina reserves the right to identify other references which may explain the inherency of, or make obvious the addition of, the allegedly missing element.

4. References disclosed as rendering a claim obvious are representative and are not intended to be exhaustive. Other references disclosing the same or similar elements may be substituted for the cited references. Additional obviousness combinations of the references identified below are possible, and Illumina reserves the right to use any such combination(s) in this litigation. Motivation to combine references can be inferred generally for all references within the fields of art of the Patents In-Suit. Furthermore, where references refer to or cite one another, motivation to combine may be specifically inferred whether or not called out in a claim chart. Lastly, Illumina's identification of motivation to combine references should not be taken as an admission or a representation that Illumina will not rely upon other tests for obviousness in view of *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). This would include showing any of the following: (1) that the combination of elements was obvious to try; (2) that the combination of elements according to known methods yielded predictable results; (3) that the substitution of one known element for another obtained predictable results; (4) that the application of a known technique to a known device, method, or product ready for improvement yielded predictable results; or (5) that known work in one field of endeavor prompted variations of such work for use in either the same field or a different one based on design incentives or other market forces because the variations are predictable to one of ordinary skill in the art.

5. The identification of prior art that anticipates and/or renders obvious a particular claim element in these contentions is not an admission that the claim element satisfies the requirements of 35 U.S.C. § 112. Where Illumina asserts that a claim is invalid under 35 U.S.C.

§ 112 (such as because of a failure to particularly point out and distinctly claim the alleged invention, failure to provide written description support, and/or failure to enable one of ordinary skill in the art to make and use the claimed invention), Illumina has nonetheless provided prior art that anticipates or renders obvious the claim on the assumption that Plaintiffs will contend that those claims are definite, supported by an adequate written description, and adequately enabled.

6. In addition to the prior art identified in these contentions, and any future supplement to these contentions, Illumina may rely on relevant portions of the Patents In-Suit, the prosecution histories of the Patents In-Suit, all references listed in the References Cited portion of the Patents In-Suit, all references cited, documents filed, or arguments made in IPR Nos. 2012-00006, 2012-00007, 2013-00011, 2018-00291, 2018-00318, 2018-00322, 2018-00385, and 2018-00797, all references cited or arguments made in Illumina's Initial Invalidity Contentions from *Columbia v. Illumina*, C.A. No. 17-973-GMS served on Plaintiffs on July 13, 2018, and fact and expert testimony about the prior art.

7. Illumina objects to the disclosure of information that is protected by the attorney-client privilege, attorney work-product immunity, the common-interest privilege, or any other applicable privilege or immunity.

8. Illumina reserves the right to amend and/or supplement these contentions as fact and expert discovery and claim construction proceed.

II. PRIOR ART

A. Identification of Prior Art References

Subject to the reservation of rights above, Illumina identifies at least the prior art references set forth in Appendix A, which alone or in combination, render the asserted claims of the Patents In-Suit invalid under 35 U.S.C. § 103. This prior art identified is also relevant for their showing of the state of the art and reasons and motivations for making improvements, additions, and

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