

Filed: February 26, 2019

On behalf of **Illumina, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.
Petitioner

v.

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

IPR2018-00291	Patent 9,718,852
IPR2018-00318	Patent 9,719,139
IPR2018-00322	Patent 9,708,358
IPR2018-00385	Patent 9,725,480*

**ILLUMINA'S REPLY TO PATENT OWNER'S
MOTION TO EXCLUDE**

Columbia Ex. 2018 Illumina, Inc. v. The Trustees of Columbia University in the City of New York IPR2020-01177

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**ILLUMINA'S REPLY TO PATENT OWNER'S OPPOSITION TO
MOTION TO EXCLUDE**

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Illumina's motion to exclude is based upon, and consistent with, its timely objections to Ex. 2116 (Paper 35, 5-9)¹ and Ex. 2140 (Paper 54, 1). Illumina's previous papers addressed most of the arguments raised in Columbia's Opposition, and therefore Illumina will not repeat those points herein.

Dr. Menchen's Declaration (Ex. 2116) should be excluded

Columbia opposes the exclusion of Dr. Menchen's declaration by asserting it appropriately shielded Dr. Menchen from understanding the challenged claims and fundamental factual matters to insulate him from accountability during cross-examination. Columbia's cynical attempt to undermine the Board's Routine Discovery policies should be penalized by excluding Dr. Menchen's testimony. *See ePlus Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 523 (Fed. Cir. 2012) (affirming exclusion of testimony from a purported expert whose "analytical method was flawed and unreliable" and selectively "ignored" evidence of record).

Dr. Menchen testified that Columbia narrowly focused his attention on three portions of the challenged claims—(1) the chemically cleavability of 'R,' (2) whether an 'R' group is accepted as a polymerase substrate, and (3) the Y linker:

Q. I was asking you, did you make sure you understood Claim 1?

A. I made sure I understood Claim 1 in terms of the chemically cleavable part of it and in terms of the, acting as a substrate.

Q. Anything else?

¹ All citations to papers from IPR2018-00291. Any emphases have been supplied.

A. Those are the two things that I was supposed to focus on.

Q. Did you put in any effort into understanding the rest of the claim?

A. I have read it.

Q. Other than just reading it?

A. Yeah, the why [Y].

Q. Anything else?

A. Yeah, I mean the rest of it is pretty obvious.

Ex. 1112, 173:22-174:15. He avoided understanding the claimed “small” group:

Q. Okay. If you turn to column 35 [of Columbia’s patent], please. Do you see where it says "Wherein, R" and then "A represents a small chemically cleavable chemical group"? Do you see that?

A. I see that.

Q. And do you understand what small means there?

A. That wasn't something that -- that I really prepared for this.

Q. Do you have any idea what would qualify as small?

A. Yeah, I -- I can't answer that.

Id., 171:15-172:10; *id.*, 171:15-173:10, 176:14-177:10, 240:22-241:9. Dr.

Menchen did not consider whether the allyl capping group meets the claims:

Q. And based on all the work you've done in this case and your expertise in the field, do you have any reason to contest that statements of counsel that allyl would be an example of a capping group that meets the limitations of Claim 1 of the '985 patent?

A. Yeah. . . . I can't form an opinion on that.

Q. Do you have any information inconsistent with that or any basis to challenge it?

A. Yeah, I can't form an opinion on it.

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