

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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IPR2020-01065, Patent 10,407,459 B2  
IPR2020-01125, Patent 10,457,984 B2  
IPR2020-01177, Patent 10,435,742 B2

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Before ZHENYU YANG, JAMES A. WORTH, and  
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

ORDER<sup>1</sup>

Conduct of the Proceedings  
Authorizing Reply and Sur-Reply  
to Patent Owner's Preliminary Response  
*37 C.F.R. § 42.5*

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<sup>1</sup> This single Order is filed jointly for convenience in related cases IPR2020-01065, IPR2020-01125, and IPR2020-01177. The parties are not authorized to file single documents in this manner absent express authorization.

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By email dated October 30, 2020, Petitioner requests authorization to file a Reply to the Patent Owner Preliminary Response to address arguments raised in Patent Owner's Preliminary Response concerning "discretionary denial under 314(a) and 325(d), as well as claim construction of the term 'chemical linker.'" Ex. 3001. Petitioner avers "[g]ood cause exists for Petitioner to address Patent Owner's arguments concerning 314(a) and the state of the parallel district court litigation, as well as Patent Owner's theories under 325(d) and its characterizations of Sanger sequencing and Hiatt." *Id.*

Petitioner also seeks authorization to submit "non-testimonial exhibits in the same manner that the Board authorized in IPR2020-00988."<sup>2</sup> *Id.* Petitioner avers that "[g]ood cause also exists for Petitioner to address the statements raised in Patent Owner's Preliminary Response concerning whether the term 'chemical linker' requires construction in view of the District Court's Markman Order." *Id.* According to Petitioner, Patent Owner opposes the above requests. *Id.*

Although Board rules do not specifically authorize a reply to a patent owner's Preliminary Response, a Petitioner may seek leave to file such a reply, and any such request must make a showing of good cause. 37 C.F.R. § 42.108(c). In light of the above, we determine that good cause exists supporting Petitioner's request to file non-testimonial exhibits related to the parallel litigation and to file a Reply to the Preliminary Response. We also determine that good cause exists for Patent Owner to file a Sur-reply to Petitioner's Reply. Such additional briefing may be useful in determining whether to institute trial. The parties may file additional non-testimonial evidence to support any facts asserted in the Reply and

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<sup>2</sup> In IPR2020-00988, the non-testimonial exhibits comprised documents filed in the parallel district court litigation, such as the District Court's Markman Order and the parties' associated briefing. *See, e.g.*, Exs. 1146–1166 of IPR2020-00988.

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Sur-Reply as to the Board's discretion under §§ 314(a) and 325(d), but may not file additional declaration testimony.

Accordingly, it is

ORDERED that Petitioner shall file non-testimonial exhibits related to the parallel litigation, such as the District Court's Markman Order and the parties' associated briefing, in this proceeding on or before November 12, 2020;

FURTHER ORDERED that Petitioner may file a Reply to the Preliminary Response addressing only those issues outlined in its email of October 30, 2020, such Reply not exceeding five pages and received by the close of business on November 12, 2020;

FURTHER ORDERED that Patent Owner may file a responsive Sur-reply not exceeding five pages and received by the close of business on November 19, 2020; and

FURTHER ORDERED that, in connection with any Reply and Sur-reply, neither party is authorized to submit evidence beyond that stated above.

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IPR2020-01177, Patent 10,435,742 B2

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