

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,

v.

ILLUMINA, INC.,

Defendant.

C.A. No. 19-1681-CFC

~~PROPOSED~~ SCHEDULING ORDER

This 11th day of December, 2019, the Court having conducted an initial Rule 16(b) scheduling conference pursuant to Local Rule 16.1(b), and the parties having determined after discussion that the matter cannot be resolved at this juncture by settlement, voluntary mediation, or binding arbitration:

IT IS ORDERED that:

1. Relevant Deadlines and Dates. All relevant deadlines and dates established by this Order are set forth in the chart attached as Exhibit A.
2. Initial Disclosures. The parties shall make their initial disclosures required by Federal Rule of Civil Procedure 26(a)(1) and the disclosures required under paragraph 3 of the District of Delaware Default Standard for Discovery, Including Discovery of Electronically Stored Information (“Delaware Default Standard”) on **January 6, 2020**.
3. Disclosure of Asserted Claims and Infringement Contentions. Plaintiffs shall serve on Defendant a “Disclosure of Asserted Claims and Infringement Contentions” no later than **January 17, 2020**. The “Disclosure of Asserted Claims and Infringement Contentions” shall contain the following information:

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(a) Each claim of each asserted patent that is allegedly infringed by Defendant, including for each claim the applicable statutory subsections of 35 U.S.C. §271 asserted;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of Defendant of which Plaintiffs are aware. This identification shall be as specific as possible. Each product, device, and apparatus shall be identified by name or model number, if known. Each method or process shall be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) A chart identifying specifically where and how each limitation of each asserted claim is found within each Accused Instrumentality, including for each limitation that Plaintiffs contend is governed by 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) For each claim alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of Defendant in the direct infringement must be described;

(e) Whether each limitation of each asserted claim is alleged to be present literally or under the doctrine of equivalents in the Accused Instrumentality;

(f) For any patent that claims priority to an earlier application, the priority date to which each asserted claim is alleged to be entitled;

(g) If Plaintiffs wish to preserve the right to rely, for any purpose, on the assertion that their own or their licensee's apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, Plaintiffs shall identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim;

(h) The timing of the point of first infringement, the start of claimed damages, and the end of claimed damages; and

(i) If Plaintiffs allege willful infringement, the basis for such allegation.

4. Document Production Accompanying Disclosure of Asserted Claims and Infringement Contentions. With the "Disclosure of Asserted Claims and Infringement Contentions," Plaintiffs shall produce to Defendant or make available for inspection and copying:

(a) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, or any public use of, the claimed invention prior to the date of application for the asserted patent(s);

(b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the asserted patent(s) or the priority date identified pursuant to paragraph 3(f) of this Order, whichever is earlier;

- (c) A copy of the file history for each asserted patent;
- (d) All documents evidencing ownership of the patent rights by Plaintiffs;
- (e) If Plaintiffs identify instrumentalities pursuant to paragraph 3(g) of this Order, documents sufficient to show the operation of any aspects or elements of such instrumentalities Plaintiffs rely upon as embodying any asserted claims;
- (f) All agreements, including licenses, transferring an interest in any asserted patent;
- (g) All agreements that Plaintiffs contend are comparable to a license that would result from a hypothetical reasonable royalty negotiation;
- (h) All agreements that otherwise may be used to support Plaintiffs' damages case;
- (i) If Plaintiffs identify instrumentalities pursuant to paragraph 3(g) of this Order, documents sufficient to show marking of such embodying accused instrumentalities; and if Plaintiffs want to preserve the right to recover lost profits based on such products, the sales, revenues, costs, and profits of such embodying accused instrumentalities; and
- (j) All documents comprising or reflecting a F/RAND commitment or agreement with respect to the asserted patent(s).

Plaintiffs shall separately identify by production number the documents that correspond to each category set forth in this paragraph. Plaintiffs' production of a document as required by this paragraph shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102.

5. Invalidity Contentions. No later than **February 21, 2020**, Defendant shall serve on Plaintiffs its “Invalidity Contentions” which shall contain the following information:

(a) The identity of each item of prior art that Defendant alleges anticipates each asserted claim or renders the claim obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication shall be identified by its title, date of publication, and, where feasible, author and publisher. Each alleged sale or public use shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. For pre-AIA claims, prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. For pre-AIA claims, prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

(b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;

(c) A chart identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that

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