Appeal Nos. 2019-2302, -2303, -2304, -2305, -2452

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

THE TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,

Appellant,

v.

ILLUMINA, INC.,

Appellee.

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, and IPR2018-00797

OPPOSITION TO APPELLANT'S MOTION FOR JUDICIAL NOTICE

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September 25, 2020

CERTIFICATE OF INTEREST

Counsel for Appellee Illumina, Inc., certifies the following:

1. The full name of every party or amicus represented by us is:

- Illumina, Inc.

2. The name of the real party in interest represented by us is:

- Illumina, Inc.

3. All parent corporations and any public companies that own 10 percent or more of the stock of the parties represented by us are:

- None

4. The names of all law firms and the partners or associates that appeared for the parties now represented by us in the trial court or are expected to appear in this Court are:

- WEIL, GOTSHAL & MANGES, LLP: Edward R. Reines, Derek C. Walter, Brian G. Liegel
- KNOBBE, MARTENS, OLSON & BEAR, LLP: Kerry S. Taylor, Michael L. Fuller, William R. Zimmerman, Nathanael R. Luman

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this Court's decision in the pending appeal:

- *The Trustees of Columbia University in the City of New York et al. v. Illumina, Inc.*, No. 17-cv-00973 (D. Del.).
- *The Trustees of Columbia University in the City of New York et al. v. Illumina, Inc.*, No. 1:19-cv-01681 (D. Del.)
- *Illumina, Inc. v. The Trustees of Columbia University in the City of New York,* PTAB-IPR2020-01323
- *Illumina, Inc. v. The Trustees of Columbia University in the City of New York,* PTAB-IPR2020-01177
- *Illumina, Inc. v. The Trustees of Columbia University in the City of New York,* PTAB-IPR2020-01125
- *Illumina, Inc. v. The Trustees of Columbia University in the City of New York,* PTAB-IPR2020-01065
- *Illumina, Inc. v. The Trustees of Columbia University in the City of New York,* PTAB-IPR2020-00988

Dated: September 25, 2020

/s/ Edward R. Reines

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Illumina, Inc. ("Illumina") respectfully submits this Opposition to Appellant The Trustees of Columbia University in the City of New York's ("Columbia") Motion for Judicial Notice. (D.I. 51 in 19-2302) (the "Motion").

ARGUMENT

I. COLUMBIA'S REQUEST FOR JUDICIAL NOTICE IS IMPROPER

"[A]ppellate review in § 141 proceedings is confined to the record before the PTO." *Nantkwest, Inc. v. Iancu*, 898 F.3d 1177, 1180 (Fed. Cir. 2018); *see also* 35 U.S.C. § 144. Columbia nevertheless asks this Court to consider the merits of new "evidence" on appeal. But this Court's "review of the Board's decision is confined to the four corners of the record." *Novartis AG v. Torrent Pharm. Ltd.*, 853 F.3d 1316, 1329 (Fed. Cir. 2017) (internal quotations and citations omitted).

Courts have long rejected attempts to use judicial notice to circumvent these foundational principles. *See Holmes v. Kelly*, 586 F.2d 234, 237 (C.C.P.A. 1978) ("Since this court is bound by 35 U.S.C. § 144 to determine appeals 'on the evidence produced before the Patent and Trademark Office,' we decline to take judicial notice of the patents submitted by Holmes in his reply brief.") (internal citation omitted); *Application of Lemin*, 408 F.2d 1045, 1049 (C.C.P.A. 1969) (rejecting request to "judicially notice and consider the technical publications presented with the request for reconsideration" because it is the "established practice of this court not to

consider evidence not considered by the tribunals below since we do not have the benefit of their views thereon").

Columbia's motion relies on authority that establishes only that the Court may take judicial notice of the fact of agency filings at any stage of the proceeding. *See* Motion at 4 ("the *fact* of their filing cannot be reasonably questioned") (emphasis added). Yet, Columbia's request goes far beyond this. Columbia improperly asks this Court to evaluate new materials and make factual determinations about the substance of those materials.

Rule 201 does not permit that. In *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1274 n.6 (Fed. Cir. 2017), this Court rejected an indistinguishable attempt to misuse judicial notice. There, also in an appeal from a PTAB decision, the appellee asked this Court to consider trial testimony from a parallel district court proceeding by taking judicial notice of it. *Id.* Like Columbia, the appellee encouraged this Court to "take judicial notice of the testimony and determine in the first instance whether it was consistent with [the declarant's] IPR declarations." *Id.* This Court squarely rejected the judicial notice request because it "does not have authority . . . to review evidence not considered by the agency and make factual determinations about the substance of that evidence." *Id.*

This Court has previously confirmed the importance of the "limits imposed by Rule 201(b)(2)" which permit it to consider "only *the fact*" that a filing was made,

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