

Filed: November 19, 2020

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.

---

IPR2020-01177 (Patent 10,435,742)

---

**PATENT OWNER'S UPDATED EXHIBIT LIST**

Pursuant to 37 C.F.R. § 42.63(e), Patent Owner The Trustees of Columbia University in the City of New York hereby provides an updated list of its exhibits in this proceeding.

### EXHIBIT LIST

Exhibit No.	Description
2001	Defendant Illumina, Inc.'s Response to Plaintiffs' Opening Claim Construction Brief
2002	Metzker, et al., "Elimination of residual natural nucleotides from 3'-O-modified-dNTP syntheses by enzymatic mop-up," <i>BioTechniques</i> , 25:814-817 (1998)
2003	PCT Publication WO 00/53805 ("Stemple")
2004	Defendant Illumina, Inc.'s Initial Invalidity Contentions, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , 19-cv-01681 (D. Del.)
2005	U.S. Patent No. 6,087,095 ("Rosenthal")
2006	Welch & Burgess, "Synthesis of fluorescent, photolabile 3'-O-protected nucleoside triphosphates for the base addition sequencing scheme," <i>Nucleosides &amp; Nucleotides</i> , 18:197-201 (1999)
2007	Canard & Sarfati, "DNA polymerase fluorescent substrates with reversible 3'-tags," <i>Gene</i> , 148:1-6 (1994)
2008	IPR2017-02172 Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,566,537
2009	IPR2017-02172 Preliminary Response of Patent Owner Illumina Cambridge Ltd.
2010	IPR2017-02174 Preliminary Response of Patent Owner Illumina Cambridge Ltd.
2011	IPR2013-00517 Illumina's Patent Owner Response

2012	IPR2013-00517 Final Written Decision
2013	IPR2013-00517 Deposition of Floyd Romesberg, Ph.D., July 8, 2014
2014	IPR2018-00291 Petitioner's Reply
2015	U.S. Patent No. 5,808,045
2016	Curriculum Vitae of Kenneth A. Johnson, Ph.D.
2017	IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, IPR2018-00797 Illumina's Demonstratives for Oral Hearing
2018	IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, IPR2018-00797 Illumina's Reply to Patent Owner's Opposition to Motion to Exclude
2019	IPR2018-00291 Institution Decision
2020	Exhibit Number Not Used
2021	WO 96/23807 ("Kwiatkowski")
2022	Ronaghi, et al. "A sequencing method based on real-time pyrophosphate," <i>Science</i> , 281(5375):363-365 (1998)
2023	Brief of Patent Owner-Appellant Illumina Cambridge Ltd., <i>Illumina Cambridge Ltd. v. Intelligent Bio-Systems, Inc.</i> , D.I. 27, 2015-1123 (Fed. Cir.)
2024	U.S. Patent No. 5,858,671 ("Jones")
2025	U.S. Patent No. 6,013,445 ("Albrecht")
2026	Excerpts from the Prosecution History of U.S. Patent No. 9,718,852

2027	Complaint for Patent Infringement, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 1, 19-cv-01681 (D. Del.)
2028	Exhibit Number Not Used
2029	Amended Complaint for Patent Infringement, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 12, 19-cv-01681 (D. Del.)
2030	Exhibit 7 to Complaint for Patent Infringement, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 1-7, 19-cv-01681 (D. Del.)
2031	Exhibit 8 to Complaint for Patent Infringement, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 1-8, 19-cv-01681 (D. Del.)
2032	Docket, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , 19-2302 (Fed. Cir.)
2033	Zhu, Z., et al., "Directly labeled DNA probes using fluorescent nucleotides with different length linkers," <i>Nucleic Acids Res.</i> , 22:3418-3422 (1994)
2034	IPR2018-00291, Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,718,852
2035	U.S. Patent No. 7,566,537
2036	Joint Claim Construction Brief, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 54, 19-cv-01681 (D. Del.)
2037	Excerpts of Joint Claim Construction Appendix (Declaration of John Kuriyan, Ph.D. in Support Of Plaintiffs' Opening Claim Construction Brief; Expert Declaration of Dr. Floyd Romesberg in Support of Illumina's Response to Plaintiffs' Opening Claim Construction Brief), <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 55, 19-cv-01681 (D. Del.)
2038	Exhibit Number Not Used

2039	IPR2012-00007 Illumina Reply
2040	IPR2012-00007 Illumina Expert Declaration
2041	IPR2012-00007 Illumina Petition
2042	Claim Construction Order, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 60, 19-cv-01681 (D. Del.)
2043	Plaintiffs' Motion for Reconsideration of the Court's Claim Construction Order, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , D.I. 63, 19-cv-01681 (D. Del.)
2044	Defendant Illumina, Inc.'s Answer to Plaintiffs' Motion for Reconsideration of the Court's Claim Construction Order, D.I. 64, 19-cv-01681 (D. Del.)
2045	Docket, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , 19-cv-01681 (D. Del.) (printed 10/2/2020)
2046	Protective Order, <i>The Trustees of Columbia University in the City of New York and Qiagen Sciences, LLC v. Illumina, Inc.</i> , 19-cv-01681 (D. Del.)
2047	Exhibit Number Not Used
2048	Declaration of Kenneth A. Johnson

Respectfully submitted,

Dated: November 19, 2020

By: /John P. White/  
John P. White, Reg. No. 28,678  
Lead Attorney for Patent Owner  
Cooper & Dunham LLP  
30 Rockefeller Plaza, 20<sup>th</sup> Floor  
New York, NY 10112  
Telephone: (212) 278-0400

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.