

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,
Patent Owner.

IPR2020-01323
Patent 10,428,380 B2

Before ZHENYU YANG, JAMES A. WORTH, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

ORDER

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

By email dated November 24, 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 points out that these are "the same topics for which the Board authorized Reply briefing in the closely related matters of IPR2020-00988, -01065, -01125, and -01177." *Id.*

Petitioner also seeks authorization to submit "non-testimonial exhibits related to parallel litigation in the same manner that the Board authorized in the closely related matters."¹ *Id.*

Petitioner further requests authorization to respond to Patent Owner's proposed construction of the preamble, which is an issue unique to this proceeding.

Petitioner avers that good cause exists for Petitioner to address all these issues. *Id.* According to Petitioner, Patent Owner does not oppose the above requests, as long as Patent Owner is authorized to file a sur-reply. *Id.*

Under our rules, a petitioner may seek leave to file a reply to the preliminary response, and such a 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

¹ In the closely related matters, 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.*, IPR2020-00988, Exs. 1146–1166.

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and 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 December 9, 2020;

FURTHER ORDERED that Petitioner may file a Reply to the Preliminary Response addressing only those issues outlined in its email of November 24, 2020, such Reply not exceeding five pages and received by the close of business on December 9, 2020;

FURTHER ORDERED that Patent Owner may file a responsive Sur-reply not exceeding five pages and received by the close of business on December 16, 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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