

Filed on behalf of: COLUMBIA

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.
Petitioner,

v.

Patent of THE TRUSTEES OF COLUMBIA UNIVERSITY IN THE CITY OF
NEW YORK¹
Patent Owner.

Case IPR2012-00006
U.S. Patent 7,713,698

COLUMBIA'S OPPOSITION TO ILLUMINA'S MOTION TO WAIVE
PETITION PAGE LIMIT UNDER 37 C.F.R. §42.24(a)(2)

¹ The caption on the "Notice of Filing Date Accorded to Petition and Notice for Setting the Time Period for Filing Patent owner Preliminary Response" mailed September 20, 2012, is incorrect. The Patent Owner is The Trustees of Columbia University in the City of New York, not the National Science Foundation (NSF). The NSF only holds a limited license pursuant to federal assistance of university research under the Bayh-Dole Act of 1980. 35 USC 200 et seq.

**COLUMBIA’S OPPOSITION TO ILLUMINA’S MOTION TO WAIVE
PETITION PAGE LIMIT UNDER 37 C.F.R. §42.24(a)(2)**

I. INTRODUCTION

Respondent The Trustees of Columbia University in the City of New York (“Columbia”) opposes Petitioner Illumina, Inc.’s (“Illumina’s”) September 16, 2012 Motion to Waive Petition Page Limit Under 37 C.F.R. §42.24(a)(2) (“Motion to Waive Page Limit” or “Motion”). (See IPR2012-00006 D.I. 4 at 1-3.)² Illumina’s Motion to Waive Page Limit does not meet the “interests of justice” requirement of Rule 42.24 and should be denied.³

II. ARGUMENT

**A. Granting Illumina’ Motion to Waive Page Limits
Would Not Be “In The Interests of Justice”**

Illumina’s Motion to Waive Page Limit seeks a waiver of the limit of 60 pages for its Petition for *Inter Partes* Review (D.I. 3) (“Petition”). To obtain a waiver of the 60-page limit, Illumina “must show in the motion how a waiver of the page limits is in the interests of justice.” Rule 42.24(a)(2). Illumina argues that the page limit should be waived for its Petition “due to the number of invalidating and noncumulative prior art references available and due to the length

²“D.I.” numbers correspond to the exhibit/paper numbers listed under “Petition Documents” for trial number IPR2012-00006 available at <https://ptabtrials.uspto.gov>.

³ Provisions of 37 C.F.R. cited herein are cited as “Rules,” e.g., 37 C.F.R. §42.24 is cited as Rule 42.24.

and number of claims challenged.” (D.I. 6 at 2.) Illumina’s arguments about the “number of references” and “number of claims” do not provide the showing for a waiver required by Rule 42.24(a)(2), namely, that a waiver is in the interests of justice.

The Board explicitly rejected the suggestion that “page limits be based, in whole or in part, on the number of grounds raised or number of proposed rejections in a petition.” 77 FED. REG. 48,635 (Aug. 14, 2012). Indeed, if a single Petition limited to 60 pages was not sufficient to address all of Illumina’s proposed rejections, Illumina could have filed multiple petitions (and paid the appropriate fees) directed to subsets of related claims in the patent-at-issue, but chose not to do so. 77 FED. REG. 48,635 (Aug. 14, 2012) (where one petition is not sufficient, “multiple petitions directed to subsets of related claims should be considered.”). Thus, Illumina’s statement that “the 60 page limit will bar the Petitioner from making any additional grounds for validity” (D.I. 4 at 2) rings hollow. Illumina’s Motion is an attempted end-run around the Rules and should be denied.

In its Motion, Illumina offers no rationale beyond the attorney argument quoted above to justify why it is entitled to a page limit waiver “in the interests of justice.” “Each motion to waive page limits will be decided on the particular facts presented on a case-by-case basis. However, exceptions to the page limits are not anticipated to be granted commonly.” 77 FED. REG. 48,635

(Aug. 14, 2012). Illumina’s Motion to Waive Page Limit fails to provide any facts that would justify an exception to the page limits.

As shown in Table 1, in its Proposed Petition Illumina discusses no new §102 references and makes no new §102 arguments that are not already discussed in its page-limited Petition.

TABLE 1 – References Cited in Illumina’s Page-Limited and Proposed Petitions

Claims challenged	Proposed Petition (84 pages)	Page-Limited Petition (60 pages)
§ 102	References Cited	
1-7, 11, 12, 14, 15, 17	Tsien (challenge 1, “C1”)	
	Dower , C3	
	Stemple II, C6	Stemple II, C5
	Stemple III, C9	Stemple III, C8
§ 103	References Cited	
1-7, 11, 12, 14, 15, 17	Tsien and Prober I, C2	
	Dower and Prober I, C4	
	Rabani and Prober I, C5	
	Stemple II and Anazawa, C7	Stemple II and Anazawa, C6
	Stemple II and Prober I, C8	Stemple II and Prober I, C7
	Stemple III and Prober I, C10	Stemple III and Prober I, C9
	Tsien, Prober I, and Rabani C11	Tsien, Prober I, and Rabani C10
	Dower and Prober II, C12	Dower and Prober II, C11
	Tsien and Prober II, C13	Tsien and Prober II, C12
	Rabani and Prober II, C14	
Stemple II and Prober II, C15	Stemple II and Prober II, C13	

Stemple III and Prober II, C16	Stemple III and Prober II, C14
Dower and Seela I, C17	Dower and Seela I, C15
Tsien and Seela I, C18	Tsien and Seela I, C16
Rabani and Seela I, C19	
Stemple II and Seela I, C20	Stemple II and Seela I, C17
Stemple III and Seela I, C21	Stemple III and Seela I, C18
Dower and Hobbs, C22	Dower and Hobbs, C19
Tsien and Hobbs, C23	Tsien and Hobbs, C20
Rabani and Hobbs, C24	
Stemple II and Hobbs, C25	Stemple II and Hobbs, C21
Stemple III and Hobbs, C26	Stemple III and Hobbs, C22
Dower and Seela II , C27	
Tsien and Seela II , C28	
Rabani and Seela II , C29	
Stemple II and Seela II , C30	
Stemple III and Seela II , C31	
Rosenthal and Tsien, C32	

With regard to §103, Illumina adds twenty-four pages in its Proposed Petition beyond the 60-page limit, introducing two new purported §103 references (**Rosenthal and Seela II**). Illumina argues that “the 60 page limit must be waived,” in part because of the number of “noncumulative prior art references available,” but fails to explain why its two added references are noncumulative or how either the interests of justice would not be served or Illumina would be

prejudiced if these references were omitted. (D.I. 4 at 2.) Indeed, the two new references are cumulative, and add nothing that is not disclosed in the references discussed in Illumina’s page-limited Petition. The fact that Illumina does not even mention those two references in its page-limited Petition, when the possibility exists that its Motion to Waive Page Limit could be denied, suggests that these references are not crucial to Illumina’s arguments.

Illumina’s Proposed Petition also raises ten additional obviousness combinations, four of which rely only on references raised in its page-limited Petition. (*See* Table 1; two new references [bolded] and ten new combinations [shaded] were added in the Proposed Petition.) Illumina does not explain why the ten new combinations, including the four combinations which use only references discussed in its page-limited Petition, are noncumulative or could not have been concisely included in the page-limited Petition.

Finally, Illumina’s Motion to Waive Page Limit is contrary to the stated public policy reasons for implementing page limits, namely, to “ease the burden on both the parties and the court” and to “encourage[] the parties to focus on dispositive issues, and reduc[e] costs for the parties and the Board.” 77 Fed. Reg. 48658 (Aug. 14, 2012). In particular, the Federal Rule Notice stated that:

[A]s the page limit more than doubles the default page limit currently set for a motion before the Board, *a 60-page limit is considered sufficient in*

all but exceptional cases and is consistent with the considerations provided in 35 U.S.C. 316(b), as amended.

77 FED. REG. 48,621 (Aug. 14, 2012) (emphasis added). Illumina provides no facts or argument to support, and does not even assert, that its case is exceptional.

III. CONCLUSION

As explained above, Illumina's Motion To Waive Page Limit fails to show how a waiver of the 60-page limit would be "in the interests of justice" as required by Rule 42.24(a)(2). Illumina's Motion should be denied.

Respectfully submitted,

Dated: October 16, 2012

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CERTIFICATE OF SERVICE

I hereby certify that COLUMBIA'S OPPOSITION TO ILLUMINA'S MOTION TO WAIVE PETITION PAGE LIMIT UNDER 37 C.F.R. §42.24(a)(2) in connection with Inter Partes Review Case IPR2012-00006 was served on this 16th day of October 2012 by electronic mail to Reinhart, Boerner, Van Deuren s.c., Counsel for Petitioner, at ipadmin@reinhardtllaw.com, having a postal address at:

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Dated: October 16, 2012

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