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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.

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

Before SALLY G. LANE, RICHARD M. LEBOVITZ, and DEBORAH KATZ
Administrative Patent Judges.

LANE, *Administrative Patent Judge*.

DECISION
Motion For Additional Discovery
37 C.F.R. 42.51

Patent Owner The Trustees of Columbia University in the City of New York ("Columbia") filed an authorized motion for additional discovery of evidence said to be related to secondary considerations of non-obviousness of its involved patent. (Motion, Paper 35 authorized in the Order of 18 April 2013, Paper 33). Columbia identifies the evidence as the "[d]epositions of two Illumina witnesses that were taken on March 19 and 20, 2013" that consist of 605 pages of testimony and 20 exhibits. ("Evidence", See Motion at 3 and 6).[1] Petitioner Illumina, Inc. ("Illumina") opposes. (Opposition, Paper 40).

Use of the Evidence

In the Motion Columbia explains "that it is **not** asking the Board to authorize Columbia to take **any** discovery of Illumina in the IPR." Instead Columbia is requesting authorization to use the Evidence, obtained from Illumina in the District Court Ligation ("Illumina"), in the IPR proceeding. (Motion at 6, original emphasis).

Columbia further explains that the parties filed a stipulated protective order with the District Court (stipulated protective order, Ex. 2005) that the parties

1 In its Motion, Columbia does not identify the witnesses by name but it appears that Illumina is aware of the witnesses to whom Columbia refers.

expect to be entered by the District Court in due course. (Motion at 4). The parties appear to agree that the Evidence is covered by the stipulated protective order and that, under the stipulated protective order, attorneys who have access to the Evidence are prevented from, *inter alia*, amending claims in a related IPR proceeding. (Motion at 5).

We agree with both Columbia and Illumina that the Motion is not requesting that the Board authorize additional discovery. (Motion at 6, Opposition at 3). Instead the Motion seeks the Board's permission for Columbia to rely upon evidence which is already in its possession. In this regard we agree with Illumina that such permission is unnecessary. (Opposition at 2). However, the Board makes no determination as to whether:

(1) Columbia or any of its attorneys would be in violation of the stipulated protective order or any order of the District Court if it uses the Evidence in this proceeding, or

(2) Whether the Evidence is admissible evidence in this proceeding.

Protective Order in the IPR

The parties seem to be under the impression that there is a protective order in place in this proceeding. (Motion at 6, Opposition at 6). Our rules provide that

the Board may enter a protective order, such as the default protective order set forth in the Office Patent Trial Practice Guide ("Practice Guide"), upon the filing of a motion to seal. 37 C.F.R. ¶¶ 42.54(a), 42.55.[2] Neither party has filed a motion to seal and thus the Board had no occasion to enter a protective order and none is in place.

Order[3]

It is

ORDERED that the Columbia Motion for additional discovery is DISMISSED as moot Columbia is already in possession of the evidence it seeks.

2 Columbia refers to language in Appendix B of the Practice Guide as supporting its understanding that the default protective order is automatically entered. (Motion at 8) However, as required by the rule and as explained within the Practice Guide , unless otherwise ordered a party must file a motion to seal requesting that the default or other proposed protective order be entered by the Board. (Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 at 48760 (Aug. 14, 2012).

3 Identical Orders are being entered into related *inter partes* reviews

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