

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

MOLECULAR LOOP BIOSCIENCES, INC.,
Patent Owner.

Patent No. 11,840,730

IPR2024-01419

**PETITIONER ILLUMINA, INC.'S SUPPLEMENTAL
MANDATORY NOTICES**

Pursuant to 37 C.F.R. 42.8, Petitioner Illumina, Inc. hereby submits these Supplemental Mandatory Notices to provide an update on the status of the co-pending litigation, which has been stayed pending the outcome of several IPRs against the asserted patents. The updated information is in the third paragraph of § B.2, below. The other sections of Illumina’s Mandatory Notices are unchanged. *See* Petition at 10-12.

A. Real Party in Interest (42.8(b)(1))

The real party in interest of this petition pursuant to Rule 42.8(b)(1) is Illumina, Inc. located at 5200 Illumina Way, San Diego, CA 92122.

B. Other Proceedings (42.8(b)(2))

1. Patents and Applications

U.S. Patent No. 11,840,730 (“’730 patent,” EX1001) is assigned to Molecular Loop Biosciences, Inc. (Patent Owner). The ’730 patent is related to the following pending applications:

- U.S. Application No. 13/266,862
- U.S. Application No. 18/483,878

2. Related Litigation

On June 10, 2024, Petitioner Illumina along with Verinata Health, Inc. (“Verinata”) filed a declaratory judgment Complaint in the U.S. District Court for the District of Massachusetts against Patent Owner asserting non-infringement of

five patents, including the '730 patent ("Massachusetts Action"). *See Illumina, Inc. and Verinata Health, Inc. v. Molecular Loop Biosciences, Inc.*, Case No. 1:24-cv-11501, D.I. 1 (D. Mass.). That same day, Patent Owner filed a Complaint against Illumina and Verinata in the U.S. District Court for the District of Delaware asserting infringement of three patents, including the '730 patent ("Delaware Action"). *See Molecular Loop Biosciences, Inc. v. Illumina, Inc. and Verinata Health, Inc.*, Case No. 1:24-cv-00680, D.I. 1 (D. Del.).

The parties subsequently agreed on some terms and filed a joint motion to transfer the Massachusetts Action to the District of Delaware where the related Delaware Action is pending. The joint motion was granted on August 2, 2024 and the Massachusetts Action was transferred to the District of Delaware on August 8, 2024. After the parties agreed on additional terms, including that Patent Owner grants Illumina a covenant not to sue under the two non-overlapping patents in the two Actions, they filed on August 29, 2024 a joint motion to dismiss the transferred Massachusetts Action.

In the Delaware Action, Patent Owner asserts that Illumina infringes three patents: the '730 patent (at issue here), U.S. 11,041,852 (subject to IPR2024-00964), and U.S. 11,768,200 (subject to IPR2024-00965). On January 27, 2025, the Board issued decisions instituting IPR2024-00964 and -00965. Following those institution decisions, the parties requested the district court to stay the

litigation. *On February 6, 2025, the district court stayed the Delaware Action pending the final written decisions in the -00964 and -00965 IPRs, both of which are currently expected to issue by January 27, 2026.*

3. Patent Office Proceedings

The '730 patent is not currently subject to any other proceedings before the Office. During prosecution of the '730 patent, the Board reversed the Examiner's final rejection in Appeal 2022-002597. The '730 patent's parents have not been subject to any other proceeding before the Board.

C. Lead and Backup Counsel (42.8(b)(3))

Lead Counsel is: Thomas A. Broughan III (Reg. No. 66,001), tbroughan@sidley.com, (202) 736-8314. Back-Up Counsel are: Ching-Lee Fukuda (Reg. No. 44,334), clfukuda@sidley.com, (212) 839-7364; and Sharon Lee (*pro hac vice* to be requested), sharon.lee@sidley.com, (212) 839-7305.

D. Service Information (42.8(b)(4))

Service on Petitioner may be made by e-mail (SidleyIlluminaMLTeam@sidley.com), mail or hand delivery to: Sidley Austin LLP, 1501 K Street, N.W., Washington, D.C. 20005. The fax number for lead and backup lead counsel is (202) 736-8711.

Dated: April 1, 2025

Respectfully submitted,

/Thomas A. Broughan III/

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CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of April, 2025, copies of this
Supplemental Mandatory Notices have been served on the following counsel of
record for Patent Owner Molecular Loop:

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