

No. 25-

---

---

IN THE  
**Supreme Court of the United States**

---

MONIB A. ZIRVI, M.D., PH.D.,

*Petitioner,*

*v.*

AKIN GUMP STRAUSS HAUER & FELD LLP;  
MATTHEW A. PEARSON; ANGELA VERRECCHIO,

*Respondents.*

---

---

**ON PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT**

---

---

**PETITION FOR A WRIT OF CERTIORARI**

---

---

TIMOTHY M. KOLMAN  
KOLMAN LAW P.C.  
414 Hulmeville Avenue  
Penndel, PA 19047

JOSEPH D. GARRITY  
*Counsel of Record*  
LORIUM LAW, P.A.  
101 Northeast Third Avenue,  
Suite 1800  
Fort Lauderdale, FL 33301  
(954) 462-8000  
jgarrity@loriumlaw.com

*Counsel for Petitioner*  
*Dr. Monib A. Zirvi*

---

---

388360



COUNSEL PRESS

(800) 274-3321 • (800) 359-6859

## QUESTIONS PRESENTED

### **Question 1**

Whether the circuit court improperly determined that a subsequent pleading rather than the initial complaint, is the operative bar date for claim preclusion in conflict with *Lawlor v. National Screen Service Corp.*, 349 U.S. 322 (1955), *Lucky Brand Dungarees, Inc. v. Marcel Fashions Group, Inc.*, 590 U.S. 405 (2020), and the Third Circuit's own precedent in *Morgan v. Covington Township*, 648 F.3d 172 (3d Cir. 2011).

### **Question 2**

Whether the Due Process Clause is violated when a court dismisses a legal-malpractice claim with prejudice at the pleading stage by resolving a disputed factual issue concerning the existence of an attorney-client relationship against the plaintiff, notwithstanding documentary evidence submitted in opposition to dismissal, without leave to amend.

### **Question 3**

Whether, under *Semtek International Inc. v. Lockheed Martin Corp.*, 531 U.S. 497 (2001), federal courts must apply the forum state's claim-preclusion and accrual rules when evaluating state-law professional-malpractice claims, rather than federal common-law preclusion principles.

## **PARTIES TO THE PROCEEDING**

Petitioner is Dr. Monib A. Zirvi, M.D., Ph.D.

Respondents in this Petition are Akin Gump Strauss Hauer & Feld LLP, Matthew A. Pearson and Angela Verrecchio (“Respondent Attorneys”).

The following entities and individuals were parties in the proceedings below but are not respondents in this Petition: Illumina, Inc., Thermo Fisher Scientific, Latham & Watkins, Sean Boyle, Roger Chin, Douglas Lumish, Rip Finst.

**RELATED PROCEEDINGS**

*Cornell University et al. v. Illumina, Inc.*, No. 1:10-cv-00433-LPS (D. Del.) (the “Delaware Litigation”).

*Zirvi v. Flatley et al.*, No. 1:18-cv-07003 (S.D.N.Y.) (the “New York”).

## TABLE OF CONTENTS

	<i>Page</i>
QUESTIONS PRESENTED .....	i
PARTIES TO THE PROCEEDING .....	ii
RELATED PROCEEDINGS .....	iii
TABLE OF CONTENTS.....	iv
TABLE OF APPENDICES .....	vii
TABLE OF CITED AUTHORITIES .....	ix
OPINIONS BELOW.....	1
JURISDICTION .....	1
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED .....	2
STATEMENT OF THE CASE .....	3
A. The Petitioner and his Zip Codes .....	3
B. The Cornell–Illumina Litigation (2010–2017) ..	3
C. The 2018 New York Litigation.....	6
D. The 2023 New Jersey Malpractice Action .....	6

*Table of Contents*

	<i>Page</i>
REASONS FOR GRANTING THE PETITION.....	10
I. The Third Circuit’s “operative-pleading cutoff” conflicts with this Court’s later-accruing-claims decisions and deepens a circuit conflict .....	10
II. The decision misapplies Semtek by displacing the forum state’s preclusion/accrual principles for a state-law malpractice claim .....	14
III. The decision creates an unconstitutional “privity without duty” regime and recreates the forum-void Gunn sought to avoid. In <i>Gunn v. Minton</i> , this Court held that patent-related malpractice claims generally belong in state court and do not “arise under” federal patent law for exclusive-jurisdiction purposes. 568 U.S. 251 (2013) .....	15
IV. The decision below compounds the accrual error by allowing a version of preclusion that binds Petitioner as though he were adequately represented, while simultaneously denying that counsel owed him any cognizable duty. That combination is difficult to reconcile with this Court’s nonparty-preclusion limits .....	16

*Table of Contents*

	<i>Page</i>
V. The Third Circuit Recreates Due Process Violations as Condemned in <i>Berk v. Choy</i> 607 U.S. Supreme Court 24-440 (2026) .....	16
CONCLUSION .....	20

**TABLE OF APPENDICES**

	<i>Page</i>
APPENDIX A — Opinion of the United States Court of Appeals for the Third Circuit, filed October 28, 2025.....	1a
APPENDIX B — Rule 12(b)(6) Dismissal Order of the United States District Court for the District of New Jersey, filed April 26, 2024.....	8a
APPENDIX C — Letter Order of the United States District Court for the District of New Jersey, filed August 6, 2024.....	27a
APPENDIX D — Complaint filed April 8, 2023, United States District Court for the District of New Jersey, Zirvi v. Illumina, Inc., et al., No. 2:23-cv-01997-MCA-JSA.....	30a
APPENDIX E — Exhibit 3 to the Complaint: First Amendment to Joint Development Agreement (Applied Biosystems—Illumina), dated March 27, 2001 .....	69a
APPENDIX F — Exhibit 4 to the Complaint: Motion to Vacate and Rescind Settlement pursuant to Rule 60(b)(6), Cornell Univ. v. Illumina, Inc., No. 1:10-cv-00433-LPS-MPT (D. Del. filed June 21, 2017) .....	74a
APPENDIX G — Findings of Fact, Conclusions of Law, and Order dated September 27, 2023.....	92a

*Table of Appendices*

	<i>Page</i>
APPENDIX H — Exhibit 9 to the Complaint: Affidavit of Dr. Francis Barany, submitted February 6, 2023.....	100a
APPENDIX I — Exhibit 14 to the Complaint: Affidavit of Merit, United States District Court for the District of New Jersey, dated March 24, 2023 .....	105a
APPENDIX J — Exhibit 1 to October 2, 2023 PLAINTIFF'S RESPONSE BRIEF IN OPPOSITION OF DEFENDANTS' MOTIONS TO DISMISS [ECF NO.82-1] and [ECF NO.84-1] doc 92-1Privileged Communications and Emails Demonstrating Representation.....	113a
APPENDIX K — Federal Rule of Appellate Procedure 28(j) Letters submitted to the United States Court of Appeals for the Third Circuit, filed September 2, 2025 .....	123a

## TABLE OF CITED AUTHORITIES

	<i>Page</i>
<b>U.S. Supreme Court Cases</b>	
<i>Berk v. Choy,</i> No. 24-440 (U.S. 2026).....	16-19
<i>Gunn v. Minton,</i> 568 U.S. 251 (2013).....	15
<i>Lawlor v. Nat'l Screen Serv. Corp.,</i> 349 U.S. 322 (1955).....	10-13, 17
<i>Lucky Brand Dungarees, Inc. v.</i> <i>Marcel Fashions Grp., Inc.,</i> 590 U.S. 405 (2020).....	11-13, 17
<i>Richards v. Jefferson Cnty.,</i> 517 U.S. 793 (1996) .....	16
<i>Semtek Int'l Inc. v. Lockheed Martin Corp.,</i> 531 U.S. 497 (2001).....	12, 14
<i>Taylor v. Sturgell,</i> 553 U.S. 880 (2008) .....	16
<b>Federal Courts of Appeals</b>	
<i>Apotex, Inc. v. FDA,</i> 393 F.3d 210 (D.C. Cir. 2004) .....	12
<i>Baker Grp., L.C. v. Burlington N. &amp; Santa Fe Ry. Co.,</i> 228 F.3d 883 (8th Cir. 2000) .....	12

	<i>Cited Authorities</i>	<i>Page</i>
<i>Blankenship v. United States</i> , 668 F. App'x 493 (3d Cir. 2016) .....	12	
<i>Florida Power &amp; Light Co. v. United States</i> , 198 F.3d 1358 (Fed. Cir. 1999) .....	12	
<i>Harkins Amusement Enters., Inc. v. United Artists Theatre Circuit, Inc.</i> , 850 F.2d 477 (9th Cir. 1988) .....	13	
<i>Heard v. Tilden</i> , 809 F.3d 974 (7th Cir. 2016) .....	13	
<i>Howard v. City of Coos Bay</i> , 871 F.3d 1032 (9th Cir. 2017) .....	13	
<i>Kilgoar v. Comm'r</i> , 594 F.2d 684 (5th Cir. 1979) .....	12	
<i>Mitchell v. City of Moore</i> , 218 F.3d 1190 (10th Cir. 2000) .....	12	
<i>Morgan v. Covington Twp.</i> , 648 F.3d 172 (3d Cir. 2011) .....	11, 12	
<i>Nilsen v. City of Moss Point</i> , 701 F.2d 556 (5th Cir. 1983) .....	12	
<i>Pleming v. Universal-Rundle Corp.</i> , 142 F.3d 1354 (11th Cir. 1998) .....	12	

*Cited Authorities*

	<i>Page</i>
<i>Rawe v. Liberty Mut. Fire Ins. Co.,</i> 462 F.3d 521 (6th Cir. 2006) .....	12

**Statutes**

28 U.S.C. § 1254(1).....	1
--------------------------	---

**Rules**

Federal Rules of Civil Procedure

Rule 12(b)(6) .....	7, 15
Rule 15(a)(2) .....	2

## **OPINIONS BELOW**

The United States District Court for the District of New Jersey entered a Letter Order on April 26, 2024 which dismissed Petitioner's initial complaint with prejudice and denied leave to amend. (App. B, 8a).

Letter Order entered August 6, 2024, by the district court denying Petitioner's motion for reconsideration<sup>1</sup>. (App. C, 27a).

A nonprecedential Opinion entered October 28, 2025 in The United States Court of Appeals for the Third Circuit affirming the district court. (App. A, 1a).

## **JURISDICTION**

This Court has jurisdiction under 28 U.S.C. § 1254(1). The petition is timely under Supreme Court Rule 13 because it is filed within 90 days of the judgment of the United States Court of Appeals for the Third Circuit entered on October 28, 2025.

---

1. This Letter Order reflects an agreement during a settlement conference in connection with the motion for reconsideration that Petitioner agreed to allow the dismissal to stand with the exception of Count III, for legal malpractice against Akin Gump Strauss Hauer & Feld LLC, and attorneys Matthew Pearson and Angela Verrecchio (collectively, the "Attorneys"). (App. C, 27a).

## **CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED**

This case involves the following constitutional provisions, statutes, and rules.

U.S. Const. art. I, § 8, cl. 8 (Intellectual Property Clause) provides that Congress shall have power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

U.S. Const. amend. V (Due Process Clause) provides that no person shall be deprived of property without due process of law.

Federal common law of judgments (claim preclusion /res judicata), including constitutional limits on binding nonparties and the rule that later-accruing claims cannot be extinguished before they exist.

35 U.S.C. § 256 provides a cause of action to correct inventorship and reflects Congress's recognition that inventors retain legally cognizable interests in patent rights independent of ownership.

Fed. R. Civ. P. 8(a) requires a short and plain statement of the claim showing entitlement to relief.

Fed. R. Civ. P. 12(b)(6) authorizes dismissal for failure to state a claim upon which relief can be granted.

Fed. R. Civ. P. 15(a)(2) provides that leave to amend should be freely given when justice so requires.

## STATEMENT OF THE CASE

### A. The Petitioner and his Zip Codes

In the 1990s, Dr. Monib A. Zirvi, M.D., Ph.D., worked in a Cornell University Medical College laboratory developing DNA diagnostic technology, including “Zip Code sequences” for incorporation into mass-produced DNA microchips, along with the methods for designing them. (App. A, 2a). Dr. Zirvi’s name appears as an inventor on certain patents which he assigned to Cornell to administer. During that time, Dr. Zirvi also worked independently on a separate data set of Zip Codes containing his trade secrets. (App. D, 30a–34a).

### B. The Cornell–Illumina Litigation (2010–2017)

In May 2010, Cornell University, Cornell Research Foundation, Inc. (collectively, the “Cornell Plaintiffs”), Life Technologies Corporation, and Applied Biosystems, LLC (collectively, the “Life Plaintiffs”) filed suit in the United States District Court for the District of Delaware against Illumina, Inc. (“Illumina”), alleging patent infringement arising from its use of the ZipCode technology. *Cornell University v. Illumina, Inc.*, No. 1:10-cv-00433-LPS-MPT (D. Del.) (the “Delaware Litigation”). Dr. Zirvi was not a party to the Delaware Litigation. (App. B, 12a).

During the course of the Delaware Litigation, the Life Plaintiffs became wholly owned subsidiaries of Thermo Fisher Scientific Inc. (“Thermo Fisher”) in 2014. (App. B, 11a). Respondent Attorneys, Akin Gump Strauss Hauer & Feld LLP entered appearances on behalf of all of the plaintiffs as co-counsel. *Cornell Univ. v. Illumina, Inc.*,

No. 1:10-cv-00433-LPS-MPT, Notice of Appearance of Matthew A. Pearson, ECF No. 231 (D. Del. Sept. 22, 2014).

In 2015, Dr. Zirvi was deposed as a fact witness. (App. B, 12a). As the Court of Appeals recounted, Thermo Fisher’s attorneys told Dr. Zirvi that they “represented his interests,” and their statements and conduct led him to believe that they were representing him personally. (App. A, 2a). *Zirvi v. Illumina, Inc.*, No. 24-2644, slip op. at 2 (3d Cir. Oct. 28, 2025) (quoting Compl. ¶¶ 18–19).

According to Dr. Zirvi, Respondent Attorneys Thermo Fisher’s counsel, “repeatedly requested via phone calls, video teleconferences, and emails for Plaintiff to submit his expert analysis and findings that would strengthen the *Cornell v. Illumina* (1L190cv099322-LPS) case, and Plaintiff spent hundreds of hours preparing such confidential analysis over a two year period.” (App. D, 36a).

On January 13, 2017, Respondent Attorneys sent Dr. Zirvi a “MEMORANDUM” bearing the words “ATTORNEY-CLIENT PRIVILEGED”. (App J, 119a). Shortly thereafter, Thermo Fisher retained Latham & Watkins to represent them in the Delaware Litigation. On March 27, 2017, Roger Chin, Esq. from Latham & Watkins first advised Dr. Zirvi (in an email copied to Respondent Attorneys), that the patent case was “not the proper vehicle” for Dr. Zirvi’s claims sounding in trade-secret misappropriation or breach of contract.<sup>2</sup> (App. D, 42a). This email attached as Exhibit 8 to Complaint was sealed on September 24, 2025 (App. G, 92a).

---

2. This email was attached as Exhibit “8” to the complaint that is the subject of this Petition, and sealed by the District Court on September 27, 2025. (App. G, 92a-93a).

On April 24, 2017, a Joint Stipulation of Dismissal was entered in the Delaware Litigation. *Cornell Univ. v. Illumina, Inc.*, No. 1:10-cv-00433-LPS-MPT (D. Del. Apr. 24, 2017).

After being told his interests were no longer being represented, Dr. Zirvi, through his own efforts, obtained an unredacted copy of a 2001 “First Amendment to Joint Development Agreement” between Applied Biosystems (a co-plaintiff in the Cornell litigation) and Illumina (the defendant in the Cornell litigation) which Illumina’s patents were based on the use of the ZipCode sequences. (App. E, 69a-70a). The Respondent Attorneys had claimed this document, which was redacted during the Delaware Litigation, was subject to a protective order. (App. I, 109a).

Dr. Zirvi relayed this information to Cornell, and the Cornell Plaintiffs retained new counsel. On June 21, 2017, Andrew L. Cole of LeClair Ryan filed the Cornell Plaintiff’s “Brief in Support of Motion to Vacate Stipulation for Dismissal Pursuant to Rule 60 and to Rescind Settlement Documents [redacted] or, Alternatively, For Leave to Conduct Discovery”. (App. F, 74a).

On August 25, 2017, the Respondent Attorneys moved to withdraw on behalf of all of the Plaintiffs in the Delaware Litigation “effective immediately”. *Cornell Univ. v. Illumina, Inc.*, No. 1:10-cv-00433-LPS-MPT, Notice of Withdrawal of Counsel, ECF No. 640 (D. Del. Aug. 25, 2017).

### C. The 2018 New York Litigation

In 2018, Dr. Zirvi, along with other co-inventors, filed suit in the Southern District of New York against Jay Flatley, Illumina, Inc., as well as Applied Biosystems, LLC and Affymetrix (both DBA Thermo Fisher Scientific Inc.), asserting claims including RICO, tortious interference, inequitable conduct, civil conspiracy, and breach of confidence. (the “Trade Secret litigation”). The Plaintiffs alleged that certain trade secrets were never assigned to Cornell or revealed and continued to belong to the plaintiffs. *See*, Second Amended Complaint ¶3, *Zirvi v. Flatley*, No. 1:18-cv-07003, Dkt. 127 (S.D.N.Y. Feb. 8, 2019). The Respondent Attorneys were not parties to that action and did not represent any party in the Trade Secret litigation.

In January 2020, the district court dismissed the Trade Secret litigation with prejudice, holding that trade-secret claims based on conduct in 1994 and 1999 were time-barred. *Zirvi v. Flatley*, 433 F. Supp. 3d 448 (S.D.N.Y. 2020), aff’d, 838 F. App’x 582 (2d Cir. 2020). That dismissal foreclosed Dr. Zirvi’s ability to monetize his trade secrets, based on time bars that occurred during the Delaware Litigation while Dr. Zirvi was relying on the Respondent Attorneys advocacy and representation.

### D. The 2023 New Jersey Malpractice Action

On April 8, 2023, Dr. Zirvi filed a complaint in the District of New Jersey asserting, as relevant to this Petition, a legal-malpractice claim against the Respondent Attorneys. (App. D, 30a). The complaint was supported by an Affidavit of Merit from a patent attorney opining that

Respondent Attorneys had an attorney client relationship with Dr. Zirvi, based on statements made to him during the Delaware litigation, and Respondent Attorneys deviated from accepted professional standards by failing to protect Dr. Zirvi's inventorship and royalty interests while misleading him to believe they were. (App I, 105a).

At the inception of the New Jersey malpractice action, Thermo Fisher moved to seal several exhibits attached to the complaint asserting that the materials contained attorney-client privileged communications and confidential case assessments prepared by outside counsel in the Delaware Litigation. (App. F, 93a–94a).

By Order dated September 26, 2023, the district court granted the motion to seal Exhibits 6, 7, and 8, finding that the materials contained “confidential commercially sensitive business information,” and declined to reach the merits of Thermo Fisher’s alternative argument that the materials were also protected by attorney-client privilege. (App. G, 98a).

On April 26, 2024, the district court dismissed the action under Rule 12(b)(6), holding the malpractice claims were barred by res judicata finding privity between non-parties to the New York Litigation, Respondent Attorneys and defendant in the New York Litigation Thermo Fisher. (App. B, 20a). The district court also dismissed Count II: Legal Malpractice holding “Zirvis complaint fails to plead the existence of an attorney-client relationship between himself and any of those Defendants or to even plead facts sufficient for an assumption by Zirvi that the Attorney Defendants represented his interests.” (App B, 24a).

The court did not reference the emails contained in Petitioner’s opposition to the Motions to Dismiss, authored by Respondent Attorneys and marked “ATTORNEY-CLIENT PRIVILEGED,” which clearly demonstrate the representations made by Respondent Attorneys which demonstrated the existence of an attorney-client relationship and Dr. Zirvi’s reasonable reliance on counsel’s representations. (App. J, 113a-119a). The court did not reference the sealed documents the magistrate removed from the public record which Petitioner attached to the complaint which also establish an attorney-client relationship, and dismissed the malpractice claim with prejudice on the ground that no attorney-client relationship had been pleaded or supported. (App. B, 24a).

On August 6, 2024, the district court entered an order denying reconsideration and noting that the malpractice claims against Respondent Attorneys were the only claim to be reconsidered. (App. C, 28a). Dr. Zirvi argued the court overlooked a February 2019 “second settlement agreement” from the Delaware litigation which arose after the New York Litigation was filed, and thus res judicata could not apply. (App. C, 29a). The district court ruled that Dr. Zirvi was aware of the “second settlement” in 2019 before he filed a Second Amended Complaint in the New York Litigation. (App. C, 29a). The district court upheld the ruling that Dr. Zirvi’s claim barred by res judicata and that he had “failed to state a claim under the 12(b)(6) standard.” (App. C, 29a).

The Court of Appeals affirmed in a non-precedential opinion, adopting an “operative-complaint” cutoff rule and holding that Dr. Zirvi was required to assert the later-discovered malpractice in his amended complaint,

even though the malpractice injury had not yet accrued. (App. A).

The malpractice and fraud claims asserted here could not have accrued earlier because the injury was neither complete nor discoverable until after the conclusion of the New York litigation. Until 2019, Petitioner had not received any royalty distributions reflecting the concealed settlement terms, had not been informed of the reallocation of inventor royalties, and had not been foreclosed from pursuing claims against the underlying commercial actors. Under settled accrual principles, a plaintiff is not required to sue counsel while representation is ongoing or while injury remains contingent and speculative which was the case while the New York litigation was pending. The injury here became concrete only when later proceedings and royalty disclosures confirmed that Petitioner's rights had been irretrievably impaired.

The Court ignored a record that also demonstrates that Petitioner's malpractice claims neither accrued nor were discoverable during the earlier proceedings. Pet App. E contains the sworn affidavit of Dr. Francis Barany, a co-inventor and principal scientific participant, corroborating Petitioner's inventorship, the technical significance of the ZipCode technology, and the manner in which its use and licensing were obscured during the *Cornell v. Illumina* litigation. Pet. App. G includes contemporaneous privileged communications and emails in which Respondent Attorneys affirmatively represented that they were acting on Petitioner's behalf and solicited his confidential expert work, substantiating Petitioner's reasonable reliance and the existence of an implied attorney-client relationship. Appendix I reflects Petitioner's Rule 28(j) submissions to

the Court of Appeals, which squarely alerted that court, before decision, of its own precedent regarding the Court’s inherent authority and obligation to investigate serious allegations of attorney misconduct and malpractice as well as recent new cases showing that Illumina had violated a legal standstill obligation by the EU Commission during an antitrust investigation. Finally, Pet. App. J, Petitioner’s sworn affidavit, sets forth the chronology of concealment, reliance, and delayed injury, confirming that no concrete harm materialized until after the conclusion of the New York litigation and the disclosure of the 2019 royalty underpayment. Taken together, these materials confirm that Petitioner was not required and indeed was not able to assert the malpractice claims earlier without speculation, directly implicating the accrual, due-process, and preclusion errors presented by this Petition.

## **REASONS FOR GRANTING THE PETITION**

### **I. The Third Circuit’s “operative-pleading cutoff” conflicts with this Court’s later-accruing-claims decisions and deepens a circuit conflict.**

The Third Circuit affirmed dismissal of Petitioner’s New Jersey malpractice action on the ground that Petitioner “could have” pleaded the malpractice theory by amending a prior complaint in different litigation, even though the alleged malpractice injury had not yet accrued when that earlier action commenced. That approach conflicts with this Court’s repeated instruction that claim preclusion does not extinguish claims “which did not even then exist” and could not have been sued upon in the earlier case. *Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322, 328 (1955).

This Court reiterated the same principle in *Lucky Brand Dungarees, Inc. v. Marcel Fashions Group, Inc.*, holding that res judicata principles do not bar claims (or defenses) premised on later conduct because they are not the “same claim” as earlier litigation over earlier events. 590 U.S. 405 (2020). And in *Whole Woman’s Health v. Hellerstedt*, the Court explained that res judicata does not bar challenges that rest on later developments and a materially different factual posture. 579 U.S. 582, 600 (2016).

The rule applied below—treating the last amended pleading in the earlier case as a forfeiture deadline for later-accruing claims—effectively requires plaintiffs to plead claims before they exist, or to sue counsel while counsel’s conduct is ongoing and the injury remains contingent. That is the opposite of *Lawlor* and *Lucky Brand*.

Courts of appeals have long recognized that claim preclusion ordinarily is measured against the claims that existed when the first action was filed; later-accruing claims are typically not barred because they were not then actionable. The Third Circuit itself articulated that principle in *Morgan v. Covington Twp.*, 648 F.3d 172 (3d Cir. 2011), explaining that res judicata “does not bar claims that are predicated on events that postdate the filing of the initial complaint.”

Other circuits have expressed the same general rule, while some decisions apply a more expansive “operative complaint” framework in particular procedural settings. That divergence is outcome-determinative in cases like this one, where the malpractice theory depends on concealment, post-dismissal settlement allocations, and

later royalty events—facts that were not actionable at the outset of the earlier litigation.

Circuit Courts nationwide disagree on whether the critical moment for claim preclusion is the initial filing of the complaint or the last amended complaint. The Third Circuit’s rule, which requires plaintiffs to allege future, undiscoverable misconduct in a case that is years old, has deepened a division that circuits have repeatedly acknowledged but have refused to resolve.

This split is stark and fully matured:

Numerous courts of appeals—including the Third Circuit (prior to the decision below), the Fifth, Sixth, Eighth, Tenth, D.C., and Federal Circuits—hold that claim preclusion cannot bar later-accruing claims because such claims “do not yet exist” at the time of the initial pleading and therefore cannot be asserted in the earlier action. These courts recognize that a plaintiff cannot be penalized for failing to plead injuries or misconduct that had not yet occurred or could not reasonably have been discovered.<sup>3</sup>

---

3. *Lawlor v. Nat'l Screen Serv. Corp.*, 349 U.S. 322 (1955); *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp., Inc.*, 590 U.S. 405 (2020); *Semtek Int'l Inc. v. Lockheed Martin Corp.*, 531 U.S. 497 (2001); *Morgan v. Covington Twp.*, 648 F.3d 172 (3d Cir. 2011); *Blankenship v. United States*, 668 F. App'x 493 (3d Cir. 2016); *Nilsen v. City of Moss Point*, 701 F.2d 556 (5th Cir. 1983) (en banc); *Kilgoar v. Comm'r*, 594 F.2d 684 (5th Cir. 1979); *Rawe v. Liberty Mut. Fire Ins. Co.*, 462 F.3d 521 (6th Cir. 2006); *Baker Grp., L.C. v. Burlington N. & Santa Fe Ry. Co.*, 228 F.3d 883 (8th Cir. 2000); *Mitchell v. City of Moore*, 218 F.3d 1190 (10th Cir. 2000); *Florida Power & Light Co. v. United States*, 198 F.3d 1358 (Fed. Cir. 1999); *Pleming v. Universal-Rundle Corp.*, 142 F.3d 1354 (11th Cir. 1998); *Apotex, Inc. v. FDA*, 393 F.3d 210 (D.C. Cir. 2004).

By contrast, other decisions, particularly in the Seventh Circuit and portions of the Ninth Circuit, apply a conflicting “operative complaint” rule, under which claims that accrue after the initial filing but before the last amended complaint may nonetheless be barred, even when they arise years into the litigation.<sup>4</sup>

The decision below by the Third Circuit deepens this conflict by adopting an even more extreme rule: requiring a plaintiff to plead future, concealed attorney misconduct in an earlier case or forfeit the claim forever—an approach not endorsed by any other circuit.

This division creates profound uncertainty about when federal claims accrue, and which injuries can be litigated. It yields radically different outcomes solely on geographic happenstance, precisely the inconsistencies the Federal Rules were designed to eliminate. These conflicts have persisted for years, are openly acknowledged by multiple courts, and show no realistic prospect of resolving themselves. Only this Court can restore a uniform national standard.

This Court should grant review to reaffirm the *Lawlor/Lucky Brand* line: later-accruing claims cannot be extinguished by the fiction that they “could have been brought” earlier via amendment.

The conflict presented here is not academic. The Third Circuit’s rule cannot be reconciled because it requires

---

4. *Heard v. Tilden*, 809 F.3d 974 (7th Cir. 2016); *Howard v. City of Coos Bay*, 871 F.3d 1032 (9th Cir. 2017); *Harkins Amusement Enters., Inc. v. United Artists Theatre Circuit, Inc.*, 850 F.2d 477 (9th Cir. 1988).

plaintiffs to choose between two untenable options: plead claims before they exist or sue their own lawyers while those lawyers are still litigating the underlying case. Other circuits reject that dilemma by tying claim preclusion to accrual, not amendment opportunity. Until this Court resolves that divide, the availability of malpractice remedies will turn on geography rather than law.

## **II. The decision misapplies *Semtek* by displacing the forum state's preclusion/accrual principles for a state-law malpractice claim.**

Petitioner's claims are state-law causes of action filed in New Jersey. Under *Semtek Int'l Inc. v. Lockheed Martin Corp.*, the preclusive effect of a federal judgment (in a diversity posture) generally tracks the preclusion law of the state in which the federal court sits, absent a governing federal statute. 531 U.S. 497 (2001).

Here, the decision below effectively displaced New Jersey's accrual and discovery-rule principles with a broader transactional approach drawn from another jurisdiction, which was dispositive because the alleged malpractice injury and its discoverability are the key temporal questions. That is precisely the sort of cross-jurisdictional distortion *Semtek* sought to avoid.<sup>5</sup>

---

5. Even if the Court were to disagree on accrual, *Semtek* independently requires reversal because the court below applied the wrong sovereign's preclusion law to extinguish a state-law malpractice claim.

**III. The decision creates an unconstitutional “privity without duty” regime and recreates the forum-void Gunn sought to avoid. In *Gunn v. Minton*, this Court held that patent-related malpractice claims generally belong in state court and do not “arise under” federal patent law for exclusive-jurisdiction purposes. 568 U.S. 251 (2013).**

The practical premise of *Gunn* is that inventors and litigants have an available malpractice forum even when the alleged negligence occurred in federal patent litigation. The decision below undermines that premise by using federal preclusion doctrine (and an “operative-pleading” cutoff) to extinguish a later-accruing malpractice claim before it can be brought. The result is a functional jurisdictional void: the malpractice claim is “too late” in federal court by preclusion, while *Gunn* confirms it is not the sort of claim that belongs exclusively in federal court in the first place.

The sealing order is integral to the procedural posture of this case. It reflects that the district court treated the communications as sufficiently sensitive and potentially privileged to warrant sealing, yet resolved—at the Rule 12(b)(6) stage and without leave to amend—the disputed factual question whether those same communications could support the existence of an attorney-client relationship.

**IV. The decision below compounds the accrual error by allowing a version of preclusion that binds Petitioner as though he were adequately represented, while simultaneously denying that counsel owed him any cognizable duty. That combination is difficult to reconcile with this Court’s nonparty-preclusion limits.**

In *Taylor v. Sturgell*, the Court rejected broad “virtual representation” theories and emphasized that nonparty preclusion is permitted only in narrow, historically grounded categories consistent with due process. 553 U.S. 880 (2008). And *Richards v. Jefferson County* held that due process forbids binding individuals who did not appear, did not control the prior case, and were not adequately represented with notice and an opportunity to be heard. 517 U.S. 793 (1996).

If Petitioner can be treated as bound through “privity” or “adequate representation” sufficient to trigger claim preclusion, then the constitutional safeguards that justify nonparty preclusion become central—and the decision below’s “privity without duty” framework warrants review.

**V. The Third Circuit Recreates Due Process Violations as Condemned in *Berk v. Choy* 607 U.S. Supreme Court 24-440 (2026)**

This record shows that the decision below does not merely apply claim preclusion harshly. It rewrites accrual by demanding that clients sue their lawyers before fraud is adjudicated, before discovery is allowed, and before injury exists, precisely the structural due-process error

the Court condemned in *Lawlor, Lucky Brand*, and now *Berk v. Choy*. This case presents the same structural due-process defect that warranted this Court’s review in *Berk v. Choy*, but at a later and more constitutionally troubling stage. In *Berk*, state procedural rules barred a medical-malpractice plaintiff from discovery and trial by demanding proof before process. Here, federal courts have gone further by extinguishing a legal-malpractice claim before it could accrue, by insisting that Dr. Zirvi should have sued his attorneys in 2017 even though the factual and legal predicates for such a claim did not yet exist. In April 2017, the *Cornell v. Illumina* litigation was dismissed pursuant to a facially valid settlement. When *Cornell* later sought relief under Rule 60(b)(6), it alleged fraud solely by Thermo Fisher and Illumina concerning sublicensing and settlement representations. Akin Gump was not named, accused, or adjudicated as a wrongdoer, and it withdrew from the case at the moment those allegations surfaced, before any discovery was permitted and before any court made findings of misconduct. The Rule 60(b) record itself was largely sealed and *in camera*, and no royalty injury to Dr. Zirvi had yet been identified or quantified. Requiring Dr. Zirvi to have sued his attorneys at that moment would have demanded speculation about concealed facts, negligence and malpractice not yet discoverable by reasonable diligence, and future injuries. If *Berk* stands for the principle that courts may not require proof before discovery, then this case stands for the corollary that courts may not require malpractice claims to be filed before they exist. The Constitution tolerates neither.

This Court’s decision in *Berk v. Choy* confirms that the dismissal below cannot stand. As the Court explained, at the pleading stage “[e]vidence of the claim is not required,”

and plausibility “may proceed even if it strikes a savvy judge that actual proof of the facts alleged is improbable.” *Berk v. Choy*, 607 U.S. 24-440 (2026) (Barrett, J.), slip op. at 5 (quoting *Twombly*). That is because “[b]y design, this system of pleading makes it relatively easy for plaintiffs to subject defendants to discovery—even for claims that are likely to fail,” *Id.*, and “Rule 8 sets a ceiling on the information that plaintiffs can be required to provide about the merits of their claims.” *Id.* at 6. Accordingly, this Court has “consistently rejected efforts by lower federal courts to require more information than Rule 8 requires.” *Id.* Rather than extinguishing claims through pleading-stage gatekeeping, “the Federal Rules already prescribe a mechanism for putting a plaintiff to his proof: a motion for summary judgment,” *Id.* at 9—and even then, “the court must allow the nonmovant ‘adequate time for discovery.’” *Id.* (citing *Celotex*). The courts below violated these principles by dismissing Dr. Zirvi’s legal-malpractice claims without any discovery, demanding proof before process in direct conflict with *Berk* and the Federal Rules.

Just as *Berk v. Choy* rejects procedural rules that bar medical-malpractice claims before discovery, this case rejects the even more extreme rule that legal-malpractice claims may be barred before they accrue, before fraud is adjudicated, and before any forum is available.<sup>6</sup>

---

6. In *Berk v. Choy*, No. 24-440, (Argued October 6, 2025, and decided January 20, 2026) the Court **reversed and remanded**, holding that procedural rules may not bar a plaintiff’s claim by demanding proof before the plaintiff has access to discovery and an opportunity to be heard. The Court emphasized that due process forbids adjudicatory shortcuts that foreclose claims before the factual predicates necessary to establish liability can be developed

This case is an unusually clean vehicle to resolve these questions. The decision below rests entirely on legal determinations made at the pleading stage: when claims accrue, what law governs preclusion, and whether nonparty privity can exist without any corresponding duty. No disputed facts, jury findings, or interlocutory complications stand in the way. If review is denied, the Third Circuit's rule will continue to extinguish later-accruing claims by procedural fiat, contrary to this Court's precedent.

---

through ordinary judicial process. *Id.* This case presents the same structural due-process defect, but at a later procedural stage, where federal courts extinguished a negligence and malpractice claim after accrual by sealing the evidence of reliance. This error was then compounded by invoking claim-preclusion doctrine to deny any forum for adjudication, thus recreating precisely the kind of forum-void and proof-before-process regime *Berk* now condemns.

## CONCLUSION

For these reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

TIMOTHY M. KOLMAN  
KOLMAN LAW P.C.  
414 Hulmeville Avenue  
Penndel, PA 19047

JOSEPH D. GARRITY  
*Counsel of Record*  
LORIUM LAW, P.A.  
101 Northeast Third Avenue,  
Suite 1800  
Fort Lauderdale, FL 33301  
(954) 462-8000  
jgarrity@loriumlaw.com

*Counsel for Petitioner*  
*Dr. Monib A. Zirvi*

## **APPENDIX**

**TABLE OF APPENDICES**

	<i>Page</i>
APPENDIX A — Opinion of the United States Court of Appeals for the Third Circuit, filed October 28, 2025.....	1a
APPENDIX B — Rule 12(b)(6) Dismissal Order of the United States District Court for the District of New Jersey, filed April 26, 2024.....	8a
APPENDIX C — Letter Order of the United States District Court for the District of New Jersey, filed August 6, 2024.....	27a
APPENDIX D — Complaint filed April 8, 2023, United States District Court for the District of New Jersey, Zirvi v. Illumina, Inc., et al., No. 2:23-cv-01997-MCA-JSA.....	30a
APPENDIX E — Exhibit 3 to the Complaint: First Amendment to Joint Development Agreement (Applied Biosystems—Illumina), dated March 27, 2001 .....	69a
APPENDIX F — Exhibit 4 to the Complaint: Motion to Vacate and Rescind Settlement pursuant to Rule 60(b)(6), Cornell Univ. v. Illumina, Inc., No. 1:10-cv-00433-LPS-MPT (D. Del. filed June 21, 2017) .....	74a
APPENDIX G — Findings of Fact, Conclusions of Law, and Order dated September 27, 2023.....	92a

*Table of Appendices*

	<i>Page</i>
APPENDIX H — Exhibit 9 to the Complaint: Affidavit of Dr. Francis Barany, submitted February 6, 2023.....	100a
APPENDIX I — Exhibit 14 to the Complaint: Affidavit of Merit, United States District Court for the District of New Jersey, dated March 24, 2023 .....	105a
APPENDIX J — Exhibit 1 to October 2, 2023 PLAINTIFF'S RESPONSE BRIEF IN OPPOSITION OF DEFENDANTS' MOTIONS TO DISMISS [ECF NO.82-1] and [ECF NO.84-1] doc 92-1Privileged Communications and Emails Demonstrating Representation.....	113a
APPENDIX K — Federal Rule of Appellate Procedure 28(j) Letters submitted to the United States Court of Appeals for the Third Circuit, filed September 2, 2025 .....	123a

**APPENDIX A — Opinion of the United States Court  
of Appeals for the Third Circuit, filed October 28, 2025**

UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

No. 24-2644

MONIB ZIRVI,

*Appellant,*

v.

ILLUMINA, INC.; AKIN GUMP STRAUSS HAUER  
& FELD, LLP; LATHAM & WATKINS; SEAN  
BOYLE; MATTHEW A. PEARSON; ANGELA  
VERRECCHIO; ROGER CHIN; DOUGLAS LUMISH;  
RIP FINST; THERMO FISHER SCIENTIFIC.

On Appeal from the United States District Court  
for the District of New Jersey  
(D.C. No. 2:23-cv-01997)

District Judge: Honorable Madeline C. Arleo

Submitted Under Third Circuit L.A.R. 34.1(a)  
on September 9, 2025

Before: CHAGARES, *Chief Judge*, PORTER,  
and ROTH, *Circuit Judges*.

(Filed October 28, 2025)

*Appendix A***OPINION\***

PORTER, *Circuit Judge.*

Monib Zirvi commenced a malpractice claim against attorneys who he says impliedly formed an attorney-client relationship with him during a patent infringement dispute in which he was a witness. The District Court dismissed Zirvi's claims with prejudice under the doctrine of res judicata and for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6), and denied his motion to amend his complaint. We will affirm.

**I**

In the 1990s, Zirvi was a researcher at Cornell University. He alleges that he developed a trade secret: a private data set for DNA microchip technology. Thermo Fisher, he says, used that information to develop its own patent. In 2015, Zirvi served as a fact witness for Cornell and Thermo Fisher in a lawsuit against Illumina. During that time, Zirvi says, Thermo Fisher attorneys told him they "represented his interests"; this statement, and other conduct, led him to believe the attorneys were representing him personally. J.A. 4 (citing Compl. ¶¶ 18-19). Cornell's lawsuit ended in a 2017 settlement. Cornell later tried to escape the settlement, and Zirvi alleges its efforts resulted in a second settlement agreement in 2018, which he says he learned about in early 2019.

---

\* This disposition is not an opinion of the full Court and pursuant to I.O.P. 5.7 does not constitute binding precedent.

*Appendix A*

In 2018, Zirvi sued Illumina, Thermo Fisher, and others with a flurry of federal- and state-law claims in the Southern District of New York, alleging the two companies were in cahoots and had been conducting “a two-decade conspiracy to steal trade secret and intellectual property.” *Id.*; *see also Zirvi v. Flatley*, 433 F. Supp. 3d 448 (S.D.N.Y. 2020). Zirvi amended his claim in 2019, but did not reference the second settlement agreement. The Court found Zirvi’s claims were barred by the applicable statutes of limitations and dismissed with prejudice. The Second Circuit affirmed, and the Supreme Court denied his petition for certiorari.

Zirvi then filed a new action in the District of New Jersey relitigating the same issues, but with a twist: his suit added a claim of malpractice against Thermo Fisher’s counsel. The District Court, however, concluded that all of Zirvi’s claims were barred by res judicata, and in the alternative, that he failed to state a claim for relief in accordance with Federal Rule of Civil Procedure 12(b)(6). It dismissed his claims with prejudice and denied his motion for leave to amend his complaint. Zirvi timely appealed.<sup>1</sup>

---

1. On appeal, Zirvi moved to seal volume III of the appendix. ECF No. 30. The Clerk’s Office provisionally held it under seal pending our disposition. ECF No. 35. We now grant the motion.

*Appendix A***II<sup>2</sup>**

We need not review the District Court’s dismissal under Rule 12(b)(6). “Our review of an application of res judicata is plenary,” *Elkadrawy v. Vanguard Grp., Inc.*, 584 F.3d 169, 172 (3d Cir. 2009), and we conclude that the District Court correctly dismissed Zirvi’s claim under that doctrine. Res judicata, also called claim preclusion, “promotes judicial economy and protects defendants from having to defend multiple identical or nearly identical lawsuits by bar[ring] not only claims that were brought in a previous action, but also claims that could have been brought.” *Morgan v. Covington Twp.*, 648 F.3d 172, 177 (3d Cir. 2011) (alteration in original) (internal quotation marks omitted).

Res judicata bars litigation of a claim where “there exists (1) a final judgment on the merits in a prior suit involving (2) the same parties or their privies and (3) a subsequent suit based on the same cause of action.”

---

2. The District Court had jurisdiction over Zirvi’s patent claim under 28 U.S.C. §§ 1331 and 1338(a). It exercised supplemental jurisdiction over his malpractice claim under 28 U.S.C. § 1337(a). On appeal, Zirvi only contests the dismissal of his malpractice claim. We retain authority to review the merits of the malpractice claim under 28 U.S.C. § 1291, the lack of federal-question jurisdiction notwithstanding. *See Carlsbad Tech., Inc. v. HIF Bio, Inc.*, 556 U.S. 635, 640, 129 S. Ct. 1862, 173 L. Ed. 2d 843 (2009) (“Upon dismissal of the federal claim, the District Court retained its statutory supplemental jurisdiction over the state-law claims.”); § 1337(c) (3) (“The district courts *may* decline to exercise supplemental jurisdiction” if it “has dismissed all claims over which it has original jurisdiction[.]”) (emphasis added).

*Appendix A*

*Id.*; see also *Vanguard*, 584 F.3d at 172-73 (same). Zirvi asserts without citation or reasoning that there was no final judgment in the New York case, but such a passing jab is forfeited. Fed. R. App. P. 28(a)(8)(A); *Doeblers' Pa. Hybrids, Inc. v. Doebler*, 442 F.3d 812, 821 n.10 (3d Cir. 2006). So we turn to his brief contentions on the parties and cause of action.

Zirvi relies on a District of New Jersey case addressing mandatory joinder under New Jersey state law to assert that the Thermo Fisher attorneys are not privies to the parties in the New York case. *Fink v. Ritner*, 2007 U.S. Dist. LEXIS 107697, 2007 WL 9797650 (D.N.J. Mar. 29, 2007). But that is irrelevant, as res judicata is distinct from mandatory joinder, and “[t]he preclusive effect of a federal-court judgment is determined by federal common law,” not state law. *Taylor v. Sturgell*, 553 U.S. 880, 891, 128 S. Ct. 2161, 171 L. Ed. 2d 155 (2008). And to whatever extent state law informs our application of federal common law to the state law claims in Zirvi’s prior action, the relevant state law is New York’s rather than New Jersey’s. See *Semtek Int’l Inc. v. Lockheed Martin Corp.*, 531 U.S. 497, 508, 121 S. Ct. 1021, 149 L. Ed. 2d 32 (2001); see also *In re Berge*, 953 F.3d 907, 916-17 (6th Cir. 2020). Zirvi’s claim against the Thermo Fisher attorneys rests on an alleged conspiracy they conducted on Thermo Fisher’s behalf with Illumina. In other words, he alleges illicit conduct arising from an attorney-client relationship. That relationship is one which sounds in privity. See *Jackson v. Dow Chem. Co.*, 902 F. Supp. 2d 658, 671 (E.D. Pa. 2012)), aff’d per curiam, 518 Fed. App’x 99 (3d Cir. 2013).

*Appendix A*

Because Zirvi alleges this malpractice arose from a conspiracy to shield the ongoing trade-secret theft, these claims arise from the same cause of action. But Zirvi pivots and asserts that “res judicata does not bar claims that are predicated on events that postdate the filing of the initial complaint,” *i.e.*, the complaint raised in the first court. Zirvi Br. 26 (quoting *Morgan*, 648 F.3d at 178). Because he was unaware of any representation issues until 2019, he says the doctrine does not apply. We reject this argument for two reasons. First, Zirvi never referenced the second settlement agreement in his complaint here, so his claims are not “predicated” on that allegation. *Morgan*, 648 F.3d at 178; *see Garrett v. Wexford Health*, 938 F.3d 69, 82 (3d Cir. 2019) (“In general . . . the most recently filed amended complaint becomes the operative pleading.”). His claims remain rooted in the same cause of action from the New York case. Second, Zirvi amended his complaint in the New York case *after* he learned of the second settlement agreement, so it cannot have “postdate[d]” the complaint in that case. *Morgan*, 648 F.3d at 178. Because the res judicata factors apply, and because no exceptions apply, the District Court properly dismissed Zirvi’s claim with prejudice.

**III**

In any event, Zirvi says the District Court should have given him leave to amend his complaint. Federal Rule of Civil Procedure 15(a)(2) gives courts discretion to grant for leave to amend “when justice so requires,” so we review for abuse of discretion. *United States ex rel. Zizic v. Q2Administrators, LLC*, 728 F.3d 228, 234 (3d Cir.

*Appendix A*

2013). Zirvi's motion did not explain how he would amend his complaint, or why. At this stage in the litigation, the District Court had already concluded res judicata barred the whole of his claims from this controversy, relying on a merits judgment that these claims were time-barred. In such a situation, "it could hardly have been an abuse of discretion for the District Court not to have afforded [him] such leave." *Id.* at 243 (internal quotation marks omitted). Zirvi urges that justice nonetheless requires his leave to amend. But he does not explain why, and since we cannot perceive any injustice from the District Court's denial, we cannot say it abused its discretion.

\* \* \*

For these reasons, we will affirm the District Court's judgment.

**APPENDIX B — Rule 12(b)(6) Dismissal Order of  
the United States District Court for the District  
of New Jersey, filed April 26, 2024**

***CLOSING***

**UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY**

**CHAMBERS OF  
MADELINE COX ARLEO  
UNITED STATES DISTRICT JUDGE**

**MARTIN LUTHER KING COURTHOUSE  
50 WALNUT ST. ROOM 4066  
NEWARK, NJ 07101  
973-297-4903**

April 26, 2024

VIA ECF

**LETTER ORDER**

**Re: *Monib Zirvi, M.D., Ph.D. v. Illumina, Inc. et al.*  
*Civil Action No. 23-1997***

Dear Litigants:

Before the Court are three motions to dismiss Plaintiff Monib Zirvi's ("Zirvi") Complaint, ECF No. 1.

First, Defendant Illumina Inc.'s ("Illumina") Motion to Dismiss Zirvi's Complaint pursuant to Federal Rule

*Appendix B*

of Civil Procedure 12(b)(6) (“Illumina’s Motion”). ECF No. 63.

Second, Defendants Thermo Fisher Scientific (“Thermo Fisher”), Rip Finst (“Finst”), Sean Boyle (“Boyle”) (Thermo Fisher, Finst, and Boyle, collectively, the “Thermo Fisher Defendants”), Akin Gump Strauss Hauer & Feld LLP (“Akin”), Matthew A. Pearson (“Pearson”), Angela Verrecchio (“Verrecchio”), (Akin, Pearson, and Verrecchio, collectively, the “Akin Defendants”), Latham & Watkins LLP (“Latham”), Roger Chin (“Chin”), and Douglas Lumish’s (“Lumish”) (Latham, Chin, and Lumish, collectively, the “Latham Defendants”) Motion to Dismiss Zirvi’s Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6) (“Defendants’ Motion”). ECF No. 82.

Third, the Latham Defendants’ Motion to Dismiss Zirvi’s Complaint pursuant to Federal Rules of Civil Procedure 12(b)(2), 12(b)(3), and 12(b)(6) (“Latham Motion”).<sup>1</sup> ECF No. 84.<sup>2</sup>

---

1. The Latham Motion pleads 12(b)(2) and 12(b)(3), only if the Plaintiff’s Complaint proceeds. *See* Latham Mot. at 8. As the Court is dismissing the Complaint, it will only consider the Latham Motion under 12(b)(6).

2. Also before the Court are two motions for Rule 11 Sanctions: first, Illumina’s Motion for Sanctions against Zirvi (“Illumina Sanctions Motion”), ECF No. 99; and second, Thermo Fisher and Finst’s Motion for Sanctions against Zirvi (“Thermo-Finst Sanctions Motion”) (Illumina Sanctions Motion and Thermo-Finst Sanctions Motion, collectively, the “Sanctions Motions”), ECF No. 104.

*Appendix B*

Because the claims asserted are a repackaging of the same claims summarily dismissed by the District Court in the Southern District of New York, Plaintiff’s Complaint is **DISMISSED WITH PREJUDICE**.

## I. BACKGROUND

In this newest Complaint, Plaintiff expands on the same wide-ranging conspiracy theories that were dismissed in the Southern District—that the defendant biotechnology companies, Illumina and Thermo Fisher, were engaged in a two-decade conspiracy to steal trade secret and intellectual property. The new Complaint tells the same story, but expands the misappropriation claims, asserts new claims of fraud, and now claims that the lawyers were in on it.

A brief review of the background facts and the various lawsuits involving the Parties is in order.

### A. Zirvi’s ZipCodes

In the 1990s, Zirvi worked in a Cornell University Medical College laboratory developing DNA diagnostic technology, including “ZipCode sequences” for incorporation into mass-produced DNA microchips. Compl. ¶¶ 9–14. During that time, Zirvi allegedly worked independently on a separate data set of ZipCodes that was his trade secret. *Id.* ¶ 14. Zirvi intended to incorporate his ZipCode operating system “into the manufacture of DNA microchips and receive royalties through the licensing of the invention.” *Id.* ¶ 13. According to Zirvi, Illumina

*Appendix B*

wrongfully obtained his data set and incorporated it into patents, products, and SEC filings in 2000. *Id.* ¶ 14. The use of ZipCodes by Illumina became the subject of several litigations. *Id.* ¶ 15.

**B. 2006 Patent Interference Claim**

In 2006, Zirvi, along with others, brought a patent interference claim before the United States Patent and Trademark Office (“USPTO”), alleging that the Chief Technology Officer of Affymetrix, a division of Thermo Fisher, unlawfully derived a 1994 patent application and a related family of patents from a grant proposal that incorporated Zirvi’s ZipCodes. *Zirvi v. Flatley*, 433 F. Supp. 3d 448, 457 (S.D.N.Y.), *aff’d*, 838 F. App’x 582 (2d Cir. 2020) (the “SDNY Litigation”). The Board of Patent Appeals concluded that Zirvi’s claim failed to establish that the Affymetrix inventors derived their subject matter from the grant proposal research. *Id.*

**C. The Delaware Litigation**

On May 24, 2010, Cornell University, Cornell Research Foundation, Inc., Life Technologies Corporation (purchased by Thermo Fisher in 2014), and Applied Biosystems, LLC (collectively, “Cornell”) sued Illumina for patent infringement in the U.S. District Court for the District of Delaware. Compl. ¶ 15; *see* SDNY Litigation, 433 F. Supp. 3d at 457; *see Cornell Univ. v. Illumina, Inc.*, No. 10-433, 2017 WL 89165, at \*1 (D. Del. Jan. 10, 2017) (the “Delaware Litigation”). During the Delaware Litigation, Thermo Fisher was represented by, among others, Finst,

*Appendix B*

Boyle, the Akin Defendants, and the Latham Defendants (collectively, the “Attorney Defendants”). Compl. ¶ 17. Zirvi, who was not a party to the Delaware Litigation, served as a fact witness and was deposed in 2015. SDNY Litigation, 433 F. Supp. 3d at 458. According to Zirvi, the Attorney Defendants advised him that his interests were aligned with those of plaintiffs in the Delaware Litigation and that, as such, they “represented his interests.” Compl. ¶¶ 18–19; SDNY Litigation, 433 F. Supp. 3d at 458.

The patents at issue in the Delaware Litigation are the same patents as those at issue in this Action. Compl. ¶¶ 40, 43; *see also* SDNY Litigation, 433 F. Supp. 3d at 463. The Delaware Litigation was settled in April of 2017, but Cornell, in June of 2017, moved to vacate the settlement; its motion was denied in March 2018. Compl. ¶¶ 25–30; Defs.’ Mot. at 6, ECF No. 82. Zirvi believes that the Delaware Litigation plaintiffs attempted to vacate the settlement because they discovered “fraud and collusion” by and between Illumina and Thermo Fisher. Compl. ¶ 30.

**D. The SDNY Litigation**

In 2018, Zirvi, along with three former colleagues, filed the SDNY Litigation against “scientists and businesspeople Jay Flatley, David Walt, Stephen Fodor, Kevin Gunderson, Jian- Bing Fan, Mark Chee, and John Stueplnagel, a patent lawyer Robin Silva, and biotechnology companies Affymetrix, P.E. Applied Biosystems<sup>3</sup>, and Illumina, Inc.” alleging claims under,

---

3. Affymetrix and Applied Biosystems are divisions of Thermo Fisher. *See* Defs.’ Mot. at 7, ECF No. 82.

*Appendix B*

the Defend Trade Secrets Act (DTSA), 18 U.S.C. § 1836, et seq.; the Racketeer Influenced and Corrupt Organizations Act (RICO), 18 U.S.C. § 1961, et seq.; the New York common law of trade secrets protections; and claims for other common law torts of fraud, conversion, tortious interference with prospective business advantage, inequitable conduct, civil conspiracy, and breach of confidence.

433 F. Supp. 3d at 453.

The court in the SDNY Litigation summarized Zirvi's allegations:

The gravamen of the Complaint is that the defendants misappropriated the plaintiffs' trade secrets in violation of both federal and New York state law in 1994 and 1999. The plaintiffs argue that two separate acts of alleged misappropriation – (1) Fodor's misappropriation of the Barany proposal in 1994, and (2) the Illumina defendants' misappropriation of Barany's and Zirvi's proprietary 465 zip codes in 1999 – resulted in the defendants' wrongful ownership of trade secrets that broadly fall into three categories – (1) positive trade secrets contained in the 1994 Barany proposal, (2) positive trade secrets contained in the 1999 proprietary zip codes, and (3) negative trade secrets derived from both acts of misappropriation that include the experimental knowhow and dead ends that

*Appendix B*

allegedly have independent economic value to a competitor seeking to replicate the plaintiffs' experimental results.

*Id.* at 458.

The court in the SDNY Litigation found that (1) plaintiffs' claims were time-barred because the alleged misappropriation occurred as far back as 1994 and 1999; (2) Illumina's patent filing in 2000 put Zirvi on constructive notice of his claims; and (3) the 2006 patent litigation and 2010 Delaware Litigation triggered accrual, therefore "whether the accrual date was in 1994, 1999, 2006, or 2010, the federal statutes of limitations have long since passed." *Id.* at 459–60. The same facts preclude the plaintiffs' state law claims. *See id.* at 461 (finding that "whether governed by the three-year or six-year limitations period. . . [t]he alleged misconduct in this case occurred in 1994 and 1999, at which point the claims accrued, and therefore the state law claims are barred by the statutes of limitations."). The Second Circuit affirmed, finding that, at best, the SDNY plaintiffs' federal claims "began to run no later than the dates of the 2006 patent interference proceedings before the [USPTO] and the 2010 [Delaware Litigation]." *Zirvi v. Flatley*, 838 F. App'x 582, 585 (2d Cir. 2020) (internal citations omitted).

The SDNY court also found that plaintiffs failed to plead a single state or federal claim upon which relief could be granted. SDNY Litigation, 433 F. Supp. 3d at 463–67.

*Appendix B***E. This Action**

On April 8, 2023, Zirvi filed his Complaint in this Court bringing *Count I*, for correction of inventorship of 52 Illumina patents pursuant to 35 U.S.C. § 256 against Illumina; *Count II*, for legal malpractice against the Attorney Defendants; *Count III*, for Fraud against Thermo Fisher and the Attorney Defendants; and *Count IV*, for civil conspiracy against all Defendants. *See* generally Compl.

For *Count I* against Illumina, Zirvi alleges that Illumina obtained patents that “incorporate inventive steps derived from [Zirvi’s] intellectual property and copyrights,” that Zirvi “contributed novel concepts and work to the inventions,” and that Zirvi’s ZipCodes were improperly appropriated for use in the patents. Compl. ¶¶ 55–61.

For *Count II*, Zirvi alleges that Attorney Defendants “failed to represent Plaintiff during settlement negotiations,” or “failed to inform Plaintiff during the [Delaware Litigation] that they were not going to represent Plaintiff’s interest.” *Id.* ¶¶ 63–68. According to Zirvi, this caused him to lose his right of enforcement against Illumina in an individual matter because he believed his claims would be resolved as part of the Delaware Litigation. *Id.* By the time he brought his claims, they were time-barred. *Id.*

For *Count III*, Zirvi alleges that Thermo Fisher and Attorney Defendants misrepresented that “they would represent Plaintiff and in fact did represent Plaintiff

*Appendix B*

in preparing and defending his deposition,” and “that Plaintiff’s interest and ThermoFisher’s interest were aligned” so that Zirvi would not hire his own attorney to represent his interests in intellectual property or, through his own attorney, be involved in the Thermo Fisher-Illumina settlement. *Id.* ¶¶ 78–87.

For *Count IV*, Zirvi alleges that Defendants worked together to deprive him of his intellectual property rights by “pretending to be engaged in a legitimate fight within the confines of a court case over the intellectual property” while Illumina and Thermo Fisher “had an agreement between each other to inflict harm upon Plaintiff by constructing an agreement that would make it impossible for Plaintiff [to] enforce his right to his intellectual property.” *Id.* ¶¶ 92–99. As part of this scheme, Thermo Fisher and Attorney Defendants “would feign to be averse to Illumina while at the same time working together to usurp Plaintiff’s Intellectual Property Rights for their own use and benefit.” *Id.*

The instant Motions followed.

**II. LEGAL STANDARD****A. Motion to Dismiss Under Rule 12(b)(6)**

In resolving a Rule 12(b)(6) motion to dismiss, the Court accepts all pleaded facts as true, construes the complaint in the plaintiff’s favor, and determines “whether, under any reasonable reading of the complaint, the plaintiff may be entitled to relief.” *Phillips v. County of Allegheny*, 515 F.3d 224, 233 (3d Cir. 2008) (internal quotation marks and citations omitted). To survive a

*Appendix B*

motion to dismiss, the claims must be facially plausible, meaning that the pleaded facts “allow[] the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). The allegations must be “more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).

### III. ANALYSIS

The Court dismisses Zirvi’s Complaint with prejudice because (1) Zirvi’s four claims for inventorship, legal malpractice, fraud, and civil conspiracy are all barred by claim preclusion; and (2) he fails to state any claims upon which relief can be granted.

#### A. Res Judicata (Claim Preclusion)

Defendants argues that Zirvi’s action is precluded under the doctrine of res judicata.<sup>4</sup> The Court agrees.

Res judicata,<sup>5</sup> also known as claim preclusion, applies when there has been “(1) a final judgment on the merits in

---

4. Res judicata and collateral estoppel are affirmative defenses, but they may be raised in a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6). *Walzer v. Muriel, Siebert & Co.*, 221 F. App’x 153, 155 (3d Cir. 2007).

5. The term “res judicata” broadly encompasses two concepts: claim preclusion and issue preclusion. Many courts and commentators use “res judicata” narrowly to mean claim preclusion and “collateral estoppel” to mean issue preclusion. *See Brownback v. King*, 141 S. Ct. 740, 747 n. 3 (2021) (explaining

*Appendix B*

a prior suit involving (2) the same claim and (3) the same parties or their privies.” *United States v. 5 Unlabeled Boxes*, 572 F.3d 169, 173 (3d Cir. 2009) (quoting *EEOC v. United States Steel Corp.*, 921 F.2d 489, 493 (3d Cir. 1990)). It requires a plaintiff to bring in one suit “all the claims for relief that he may have arising out of the same transaction or occurrence.” *Lubrizol Corp. v. Exxon Corp.*, 929 F. 2d 960, 964 (3d Cir. 1991) (internal citations omitted). Those elements are present here.

The SDNY Litigation presents a final judgment on the merits in a prior suit. The SDNY Litigation found that all of plaintiffs’ claims, including trade secrets, fraud, and civil conspiracy, were time barred and failed to state a claim. *See generally* 433 F. Supp. 3d; *see also Elkadrawy v. Vanguard Grp., Inc.*, 584 F.3d 169, 173 (3d Cir. 2009) (finding that “a dismissal on statute-of-limitations grounds” is “a judgment on the merits”). The SDNY litigation involved the same parties or those in privity. Zirvi was a plaintiff in the SDNY Litigation and Illumina was a defendant. Thermo Fisher, through its wholly owned divisions, Affymetrix and Applied Biosystems, was also a party in both actions. While Attorney Defendants, who were either in-house or outside counsel to Thermo Fisher in the Delaware Litigation, are new to this Action, they are all in privity with Thermo Fisher. *See Copeland v. US Bank Cust PC5 Sterling Nat'l*, No. 20-07016, 2021 WL 2134942, at \*8 (D.N.J. May 26, 2021) (finding that, for the purposes of claim preclusion, where attorneys represented

---

the nomenclature of claim and issue preclusion). The Court will follow the latter framework in discussing Defendant’s preclusion arguments.

*Appendix B*

defendants in a prior litigation, allegations against them were “inextricably intertwined to those asserted against the defendants” in the prior litigation).

The claims in this Action and in the SDNY Litigation are the same. “Suits involve the same claim (or cause of action) when they arise from the same transaction or involve a common nucleus of operative facts.” *Lucky Brand Dungarees, Inc. v. Marcel Fashions, Grp., Inc.*, 140 S. Ct. 1589, 1595 (2020) (internal citations omitted). “This analysis does not depend on the specific legal theory invoked, but rather the essential similarity of the underlying events giving rise to the various legal claims.” *Elkadravy*, 584 F.3d at 173 (3d Cir. 2009) (internal citations omitted). “[R]es judicata bars not only claims that were brought in [a] previous action, but also claims that could have been brought.” *Id.* (finding that the focal points of the courts analysis is “whether the acts complained of were the same, whether the material facts alleged in each suit were the same and whether the witnesses and documentation required to prove such allegations were the same.”) (internal citations omitted).

The SDNY Litigation asserted claims of inventorship, malpractice, and fraud, stemming from plaintiff’s intellectual property relating to DNA sequencing while working at Cornell labs in the 1990s. The SDNY Litigation and this Action both rest on the same general theory that Illumina and Thermo Fisher orchestrated a large conspiracy to deprive Zirvi of his intellectual property rights and trade secrets, including through Defendants actions during the Delaware Litigation. *Compare* SDNY Litigation *with* Compl.

*Appendix B*

First, although Zirvi did not bring an inventorship claim in the SDNY Litigation, he could have, and it is thus barred by res judicata. *See Cisco Sys., Inc. v. Alcatel USA, Inc.*, 301 F. Supp. 2d 599, 603 (E.D. Tex. 2004) (finding that where a party brought a trade secret misappropriation claim before the court, it could not make “a mere change in legal theory” requesting “declaratory relief as to the ownership of the appropriated materials” because the “factual predicates” for the new claim were “based on the same nucleus of operative facts as those in the underlying suit.”). Zirvi’s inventorship claim in this action mirrors his trade secrets claim in the SDNY Litigation. In fact, both claims are based on the same allegedly misappropriated DNA ZipCode sequences. *See Illumina Mot.* at 17. In his own Complaint, Zirvi even asserts that the same ZipCode sequences which were the subject of both the SDNY Litigation and this Action, “were protectable as patentable subject matter *and* as a trade secret.” Compl. ¶ 11 (emphasis added).

Second, although Zirvi’s malpractice claim involves entirely new parties, the Attorney Defendants (representatives for Thermo Fisher in the Delaware Litigation) are in privity with Thermo Fisher, an SDNY Litigation defendant. *See Jackson v. Dow Chem. Co.*, 902 F. Supp. 2d 658, 671 (E.D. Pa. 2012) (“An attorney-client relationship may justify application of claim preclusion even when the attorney was not a party to the prior suit.”), *aff’d*, 518 F. App’x 99 (3d Cir. 2013). The malpractice claim, while not brought in the SDNY Litigation, is based on the recycled theory that Thermo Fisher conspired with Illumina to deprive Zirvi of his intellectual property and

*Appendix B*

trade secrets. Under that theory, Zirvi could have brought a malpractice claim in his prior suit. Indeed, in the SDNY Litigation Second Amended Complaint (the “SDNY SAC”) plaintiffs make direct reference to lawyers’ involvement in the scheme. *See Declaration of Michael S. Stein (“Stein Decl”), Ex. 2 (SDNY SAC) ¶¶ 7–9, ECF No. 82.4.*<sup>6</sup>

Finally, because fraud and conspiracy were brought in the SDNY Litigation, res judicata bars Zirvi from realleging them here. Although these claims include new defendants, the new defendants are in privity with Thermo Fisher. Both claims, in SDNY and in this Action, are based on the same set of ZipCodes and share “a common nucleus of operative facts”: an alleged conspiracy to misappropriate Zirvi’s ZipCodes. *See Lucky Brand Dungarees, Inc.*, 40 S. Ct. at 1595; Defs.’ Mot. at 15–17, ECF No. 82; Illumina Mot. at 18, ECF No. 63.<sup>7</sup>

---

6. In the SDNY SAC, plaintiffs allege that attorneys were involved in the scheme: “[i]n the [Delaware Litigation] prior to his deposition and for a period immediately afterwards, Doctor Zirvi was specifically instructed by the lawyers for ThermoFisher not to look at any patents or any other scientific material that could be used as evidence in the case. Doctor Zirvi could not have known at the time, that ThermoFisher a defendant and co-conspirator in this case, had its own nefarious reasons for this instruction. Only after his deposition, in August 2015, did the lawyers for ThermoFisher instruct the inventors to actually search for any patents and/or other documents that might be used as evidence.” *Id.*

7. The SDNY SAC and the instant Complaint both include allegations of (1) collusion between Illumina and Thermo Fisher in developing Ampliseq for Illumina during the Delaware Litigation, (2) a plan to defraud third parties, including Zirvi, of

*Appendix B*

The Court therefore finds that all four of Zirvi's claims are barred by claim preclusion.

**B. Doctrine of Laches**

Illumina also argues that Zirvi's first claim—the correction of inventorship of 52 Illumina patents pursuant to 35 U.S.C. § 256—is barred by the doctrine of laches. The Court agrees.

Laches is an equitable defense that may bar an inventorship claim. To prevail on a defense of laches, a defendant must establish that (1) the plaintiff's delay in filing a suit was unreasonable and inexcusable; and (2) the defendant suffered material prejudice attributable to the delay. Further, a rebuttable presumption of laches attaches whenever more than six years passes from the time a purportedly omitted inventor knew or should have known of the issuance of the relevant patent.

*Lismont v. Alexander Binzel Corp.*, 813 F.3d 998, 1002 (Fed. Cir. 2016) (internal citations omitted). Every patent over which Zirvi claims an inventorship rights was issued over six years ago—creating a rebuttable presumption of laches—and was discussed in detail in the SDNY Litigation, thus putting Zirvi on notice of his omission

---

their royalties, and (3) a fraudulent settlement of the Delaware Litigation through collusion. Defs.' Mot. at 15, ECF No. 82; Illumina Mot. at 9, 18–19, ECF No. 63.

*Appendix B*

on the patents as a purported inventor. *See also* Illumina Mot. at 21–22.

### C. 12(b)(6) Analysis

#### 1. Count I: Correction of Inventorship

Zirvi fails to plead a cognizable injury and therefore does not have standing to sue Illumina for inventorship. To state a claim for inventorship, “a plaintiff must allege some redressable economic harm that directly flows from the incorrect listing of inventors on a patent.” *Feuss v. Enica Eng’g, PLLC*, No. 20-2034C, 2021 WL 1153146, at \*3 (D.N.J. Mar. 26, 2021). Zirvi alleges economic harm from loss in royalties because of Illumina’s use of his ZipCodes in its patents. Compl. ¶¶ 38, 47. But, as Zirvi concedes, his claim to those royalties is time-barred. *Id.* ¶ 86. Even if it was not, Zirvi does not allege the existence of any royalties agreement and only alleges that his “intent” was to “receive royalties through the licensing of the invention.” *Id.* ¶ 13. Without alleging the existence of a royalties agreement or any other right to profit, Zirvi fails to plead economic damage sufficient for standing. *See Feuss*, 2021 WL 1153146, at \*3.

Zirvi also alleges, without support, that not being named as an inventor on the patents, “has undermined [his] reputation and standing in the scientific community.” Compl. ¶ 48. But, a plaintiff, even on a motion to dismiss, cannot rest on “mere allegations of reputational injury alone” to plead a cognizable injury. *Feuss*, 2021 WL 1153146, at \*3.

*Appendix B*

Finally, Zirvi's Complaint lists 52 patents that he claims utilized his ZipCodes, but does not include any allegations specific to any one patent. Compl. ¶ 45. In Section 256 inventorship cases, there is a presumption that the listed patent investors are correct, and to meet the "heavy burden" to overcome the presumption, a plaintiff must identify a "specific patent claim" for each individual patent. *See Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1358 (Fed. Cir. 2004) ("The general rule is that a party alleging misjoinder or non-joinder of inventors must meet the heavy burden of proving its case by clear and convincing evidence."); *Pro Mktg. Sales, Inc. v. Secturion Sys., Inc.*, No. 19-113, 2020 WL 5912351, at \*5 (D. Utah Oct. 6, 2020) (finding that at the motion to dismiss stage, a plaintiff must "identify a single specific patent claim" to which he "made an inventive contribution"). Zirvi fails to so allege.

**2. Count II: Legal Malpractice**

Zirvi's malpractice claim is premised on the notion that the Attorney Defendants' "failure to represent, or inform Plaintiff to retain his own representation," caused him to fail "to be compensated or recognized" in the Delaware Litigation settlement and caused him to delay bringing his own case against Illumina. Compl. ¶ 65. But Zirvi's Complaint fails to plead the existence of an attorney-client relationship between himself and any of those Defendants, or to even plead facts sufficient for an assumption by Zirvi that the Attorney Defendants represented his interests. *See Iqbal*, 556 U.S. at 678 (finding that "[t]hreadbare recitals of the elements of a cause of action, supported by

*Appendix B*

mere conclusory statements, do not suffice” to survive a motion to dismiss). In fact, Zirvi was not even a party to the Delaware Litigation, and served only as a fact witness. Compl. ¶¶ 18–19.

The Court therefore finds that Zirvi failed to state a claim for legal malpractice against the Attorney Defendants.

**3. Count III: Fraud**

For a claim of fraud, the Court must apply the heightened Rule 9(b) pleading standard, meaning that “the complaint must describe the time, place, and contents of the false representations or omissions, as well as the identity of the person making the statement and the basis for the statement’s falsity.” *City of Warren Police and Fire Ret. Sys. v. Prudential Fin., Inc.*, 70 F.4th 668, 680 (3d Cir. 2023). Plaintiff has failed to do so here. Instead, the Complaint broadly alleges that “[d]efendants made false statements that Plaintiff’s interests and ThermoFisher’s interests were aligned and therefore he didn’t need an attorney,” and that “even if Plaintiff retained his own counsel,” he could not participate in the litigation. Compl. ¶¶ 80–81; *see* Defs.’ Mot. at 27, ECF No. 82. Without context, attribution, or specificity, plaintiff fails to state a claim.

**4. Count IV: Civil Conspiracy**

Zirvi fails to state a civil conspiracy claim because he does not plead any “predicate unlawful purpose” upon

*Appendix B*

which a conspiracy can be based. *Golden State Med. Supply Inc. v. AustarPharma LLC*, No. 21-17137, 2022 WL 2358423, at \*11 (D.N.J. June 30, 2022).

**IV. CONCLUSION**

For the reasons stated above, Plaintiff's Complaint is **DISMISSED WITH PREJUDICE**. The Court will hold the Sanctions Motions **IN ABEYANCE**, pending a conference with Judge Allen, which shall be scheduled forthwith.

**SO ORDERED.**

s/ *Madeline Cox Arleo*  
**MADELINE COX ARLEO**  
**UNITED STATES DISTRICT JUDGE**

**APPENDIX C — Letter Order of the United States  
District Court for the District of New Jersey,  
filed August 6, 2024**

***CLOSING***

**UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY**

<b>CHAMBERS OF MADELINE COX ARLEO UNITED STATES DISTRICT JUDGE</b>	<b>MARTIN LUTHER KING COURTHOUSE 50 WALNUT St. ROOM 4066 NEWARK, NJ 07101 973-297-4903</b>
--	--

August 6, 2024

VIA ECF

**LETTER ORDER**

**Re: Monib Zirvi, M.D., Ph.D. v. Illumina, Inc. et al.  
Civil Action No. 23-1997**

Dear Litigants:

Before this Court is Plaintiff Monib Zirvi’s (“Zirvi”) Motion for Reconsideration (the “Motion”) of the Court’s Order, ECF No. 119 (the “April Order”), dismissing his Complaint with prejudice. ECF No. 120. Following an in-person settlement conference with the Honorable Jessica S. Allen, Zirvi has withdrawn his Motion as to Defendants Thermo Fisher Scientific Inc., Rip Finst, Sean Boyle,

*Appendix C*

Illumina, Inc., Latham & Watkins LLP, Roger Chin, and Douglas Lumish (the “Settling Defendants”). ECF No. 137. His Motion, therefore, proceeds only as to Defendants Akin Gump Strauss Hauer & Feld LLP (“Akin”), Matthew A. Pearson (“Pearson”), and Angela Verrecchio (“Verrecchio”) (collectively, the “Akin Defendants”). For the reasons stated below, Zirvi’s Motion is **DENIED**.<sup>1</sup>

To prevail on a motion for reconsideration, the movant must demonstrate “(1) an intervening change in the controlling law; (2) the availability of new evidence that was not available when the court [issued its order]; or (3) the need to correct a clear error of law or fact or to prevent manifest injustice.” *Max’s Seafood Café v. Quinteros*, 176 F.3d 669, 677 (3d Cir. 1999). Reconsideration “is an extraordinary remedy that is rarely granted.” *Walsh v. Walsh*, No. 16-4242, 2017 WL 3671306, at \*1 (D.N.J. Aug. 25, 2017).

In its April Order, this Court dismissed Zirvi’s Complaint with prejudice finding that all four of his claims for inventorship, legal malpractice, fraud, and civil conspiracy were barred by claim preclusion. He otherwise failed to state a claim upon which relief can be granted. *See generally* April Order. His claims in this Action are a repackaging of those set out in his 2018 Southern District of New York litigation where his claims were dismissed as time-barred and for failure to state a claim. *Id.* As part of his claims in both cases, Zirvi alleges that biotechnology

---

1. The Court discussed the background of this Action in its April Order and accordingly only discusses the facts necessary to resolve the instant Motion.

*Appendix C*

companies colluded during a prior settlement in a Delaware litigation to deprive Zirvi of his intellectual property rights and trade secrets. *Id.* In the instant Motion, Zirvi now states that the Court “overlooked” an alleged February 2019 second settlement agreement from the prior Delaware litigation, which arose after he filed his SDNY action, and therefore res judicata cannot apply. *See generally* Mot. Accordingly, Zirvi requests that the Court reverse its April Order dismissing his Complaint with prejudice.

Zirvi’s Motion fails for several reasons. First, the second settlement does not appear in Zirvi’s Complaint and thus was not “overlooked” by this Court. *See generally* Compl., ECF No. 1. Second, after receiving the royalty payment, Zirvi filed a Second Amended Complaint in the SDNY action and thus his claim arose prior to the judgment in the SDNY case. Third, Zirvi’s claims for malpractice, fraud, and civil conspiracy were not only dismissed under a res judicata theory but also for failure to state a claim under the 12(b)(6) standard. *See* April Order at 8–9. As Plaintiff fails to state any new issues of fact and has not otherwise met the standard for reconsideration, his Motion must be denied.

For the reasons stated above, Plaintiff’s Motion, ECF No. 120, as to the Akin Defendants is **DENIED** and the case is **CLOSED**.

**SO ORDERED.**

*/s/ Madeline Cox Arleo*

**MADELINE COX ARLEO**

**UNITED STATES DISTRICT JUDGE**

**APPENDIX D — Complaint of the United States  
District Court for the District of New Jersey,  
filed April 8, 2023**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

Case No.

MONIB ZIRVI, M.D., Ph.D.

*Plaintiff,*

v.

ILLUMINA, INC., THERMO FISHER SCIENTIFIC,  
AKIN GUMP STRAUSS HAUER & FELD LLP,  
LATHAM & WATKINS, RIP FINST, SEAN BOYLE,  
MATTHEW A. PEARSON, ANGELA VERRECCHIO,  
ROGER CHIN, and DOUGLAS LUMISH

*Defendants.*

Filed April 8, 2023

**PLAINTIFF DEMANDS TRIAL BY JURY**

**COMPLAINT**

Plaintiff, Dr. MONIB ZIRVI, by and through its undersigned counsel hereby sues Defendants, Illumina, Inc., ThermoFisher Scientific, Akin Gump Strauss Hauer & Feld LLP, Latham & Watkins, Rip Finst, Sean Boyle,

*Appendix D*

Matthew A. Pearson, Angela Verrecchio, Roger Chin and Douglas Lumish, and states the following in support thereof:

**THE PARTIES**

1. Dr. MONIB ZIRVI (hereinafter "Plaintiff") is an individual who has developed several trade secrets and intellectual property in the field of DNA diagnostics and DNA arrays, including the property at issue in this case and, at all times relevant, has been a practicing physician-scientist with his principal location at 1 Diamond Hill Road, Berkeley Heights, NJ 07922 in Union County.
2. Defendant Illumina, Inc., is a corporation of the State of Delaware with a principal place of business in the State of California.
3. Defendant ThermoFisher Scientific is a corporation of the State of Delaware with a principal place of business in the State of California.
4. Defendant Attorneys Rip Finst and Sean Boyle of THERMO FISHER SCIENTIFIC INC., Matthew A. Pearson and Angela Verrecchio, of AKIN GUMP STRAUSS HAUER & FELD LLP, Roger Chin and Douglas Lumish of LATHAM & WATKINS are attorneys whose principal places of business are in the States of Pennsylvania and California.

*Appendix D*

**JURISDICTION AND VENUE**

5. This Court has exclusive jurisdiction to hear Court I pursuant to 28 U.S.C. § 1338(a): “The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents. . . . No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents. . . .”

6. This Court has supplemental jurisdiction to hear the remaining Counts II – IV under 28 U.S. Code § 1337 (a) (2022) (“. . . in any civil action of which the district courts have original jurisdiction, the district courts shall have supplemental jurisdiction over all other claims that are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution.”)

7. Venue is governed by 28 U.S. Code § 1331(a) (2) proper in this case because the judicial district in which a substantial part of the events or omissions giving rise to the claim occurred in this district, and a substantial part of the property that is the subject of the action is situated in this district.

8. The acts complained of herein were directed against Plaintiff who, at all times relevant, has been a practicing physician-scientist with his principal location at 1 Diamond Hill Road, Berkeley Heights, NJ 07922 in Union County.

*Appendix D*

**GENERAL ALLEGATIONS**

**I. Factual Background**

9. Plaintiff was a graduate student in the laboratory of Dr. Francis Barany at Cornell University Medical College (now known as Weill Cornell Medicine) from August 1994 to January 1999.

10. During that time, the Barany laboratory was developing new technology in DNA diagnostics, including new methods to detect cancer mutations to improve patient cancer care.

11. After graduating from the laboratory, Plaintiff, on his own time, using his equipment, relying on his knowledge of computer programming, independently developed a data set of ZipCode sequences to enable mass production and manufacture of DNA computer chips known as DNA microarrays. The ZipCode sequences he invented were protectable as patentable subject matter and as a trade secret.

12. ZipCode sequences are necessary to identify cancer mutations and other DNA applications, analogous to developing the operating system software for personal computers. (MS-DOS, iOS, and Windows)

13. Plaintiff's intent was to incorporate the Zip Code Operating System (Zip Code Chemistry) into the manufacture of DNA microchips and receive royalties through the licensing of the invention.

*Appendix D*

14. The Zip Code Operating System invented independently by Plaintiff, and other work done at the lab, was incorporated into Illumina patents, products, and SEC filings. The key difference is that Illumina, including its founders, renamed the Zirvi-Barany Zip Code Operating System as “Tag Sequences”, “Illumacodes”, “Illumicodes, or other misleading names. All the while, Illumina’s source code of their software identified them as what they truly were, Plaintiffs “ZipCodes.”

15. Illumina’s illicit taking became the subject matter of multiple litigations between Cornell University, Cornell Research Foundation, Inc., Life Technologies Corporation, and Applied Biosystems, LLC versus Illumina.

16. Throughout the litigation the Plaintiff was in communication with, and advised extensively by Attorneys for Cornell University, Cornell Research Foundation, Inc., PE Applied Biosystems, LLC, Life Technologies Corporation, and Thermo Fisher Scientific Inc., who represented to the Plaintiff that they were his counsel as well.

17. At various points throughout the Cornell litigation, the Attorneys representing the Plaintiff included, **Rip Finst** and **Sean Boyle** of THERMO FISHER SCIENTIFIC INC., **Matthew A. Pearson** and **Angela Verrecchio**, of AKIN GUMP STRAUSS HAUER & FELD LLP, **Roger Chin** and **Douglas Lumish** of LATHAM & WATKINS. (Dr. Zirvi did not have direct contact with non-party attorneys Dianne B. Elderkin, Rachel J. Elsby, and Jason E. Weil of AKIN GUMP STRAUSS HAUER & FELD LLP).

*Appendix D*

18. Plaintiff's Attorneys advised him that his interests were aligned with Cornell University, Cornell Research Foundation, Inc., PE Applied Biosystems, LLC, Life Technologies Corporation, and Thermo Fisher Scientific Inc., and that these attorneys represented his interests.

19. The Attorneys advised Plaintiff to not prepare for his deposition, to not review any documents, including his own patent filings, and not research facts related to Illumina, its founders, employees, and patent filings.

20. Instead, the Attorneys instructed and advised Plaintiff to answer questions with "I don't know", and "I don't remember", all explained to him as the best way to benefit Cornell and his rights against Illumina's illicit taking.

21. Attorneys for the Plaintiff withheld from Plaintiff that ThermoFisher was secretly collaborating with Illumina to develop "Ampliseq for Illumina" during the entire time they were representing Plaintiff – a knowingly deliberate conflict of interest. The secret collaboration, which upon information and belief started at least three years prior, was publicly admitted to having occurred at least a year prior to January 30th, 2018, while the *Cornell v. Illumina* (1:10-cv-00433-LPS) case was still active. See, this Complaint's Exhibits 1 and 2. (respectively, Illumina\_SEC\_8k\_Ampliseq\_for\_Illumina\_01\_30\_2018\_v02Hi copy 2 and see Exhibit 13 of Zirvi v US NIH et al. Case 3:20-cv-07648-MAS-DEA: Bringing together two leaders: AmpliSeq™ for Illumina. <https://www.youtube.com/watch?v=1WPaZX1TDa4>).

*Appendix D*

22. Plaintiff subsequently learned that other inventors from Patent application WO 97/31256 were instructed to do the same.

23. Attorneys for the Plaintiff repeatedly requested via phone calls, video teleconferences, and emails for Plaintiff to submit his expert analysis and findings that would strengthen the *Cornell v Illumina* (1:10-cv-00433-LPS) case, and Plaintiff spent hundreds of hours preparing such confidential analysis over a two-year period.

24. Attorneys for ThermoFisher informed Plaintiff at the end of January 2017-beginning of February 2017 that they were unhappy with the performance of Akin Gump, and thus were immediately bringing in Roger Chin and Doug Lumish of Latham & Watkins to take over the *Cornell v Illumina* case (1:10-cv-00433-LPS). None of these Attorneys informed Plaintiff of their conflict of interest in they were simultaneously involved in a parallel and related case of *Illumina v Life Technologies Corp (Thermo Fisher)* Case 3:11-cv-03022-JAH-DHB.

25. Between January 2017 and April 2017, Plaintiff sent Attorneys at ThermoFisher, Latham & Watkins and Akin Gump numerous emails containing bullet-proof evidence of fraud by Illumina which would have proven the claims by Cornell, yet such evidence was kept from the court in the *Cornell v Illumina* case (1:10-cv-00433-LPS). Plaintiff requested to file a declaration to introduce this evidence to the court, yet inexplicably, Attorneys denied this request. (See Exhibit 12 for Draft of Declaration written by Plaintiff and emailed about to

*Appendix D*

Defendants including Rip Finst, Matthew Pearson, Roger Chin and Douglas Lumish shortly prior to the signing of the settlement agreement in *Cornell v Illumina*. Plaintiff specifically requested for their help to edit and submit this to the US District Court in Delaware as a Third Party with an interest.)

26. Unbeknownst to Plaintiff or Cornell at the time, *Cornell v Illumina* (1:10-cv-00433-LPS) was fraudulently settled by Illumina and ThermoFisher, simultaneously with several other lawsuits involving Illumina and ThermoFisher, in April 2017. Tellingly, Attorneys Roger Chin and Doug Lumish were working on the other cases involving Illumina and ThermoFisher but failed to disclose their obvious conflict of interest to either Plaintiff or Cornell. The settlements, while benefiting Illumina and ThermoFisher, completely undermined the rights of the Plaintiff.

27. Plaintiff discovered through a review of public SEC filings that Illumina had filed a First Amendment Agreement to raise funds for many years. In this document, the definition of "Tag Sequences" was redacted. When asked, Matthew Pearson said he knew about the First Amendment Agreement, and stated it had nothing to do with the inventors, including Plaintiff, as well as their rights as inventors under the *Cornell v. Illumina* suit. Matthew Pearson refused to share any details of the First Amendment Agreement, requiring Plaintiff to obtain a copy of the unredacted First Amendment Agreement through a FOIA request to the SEC, which was received by Plaintiff on May 17, 2017 (Exhibit 3).

*Appendix D*

28. In the redacted document, everything passed the words “‘Tag Sequence’ means” was redacted. In the unredacted document, it continues as follows: “Tag Sequence” means a set of oligonucleotide probes, developed pursuant to the Original Agreement or this First Amendment, which act independently of any target-sequence-specific analytical chemical reactions to allow the physical addressing of the products of a chemical reaction to locations on a solid support, such as the “addressable array-specific portion” of the oligonucleotide probes and their complements described in International Patent Application No. W097/31256 and that are designed for use in the Collaboration Product. The Parties will agree on the selection of Tag Sequences to be used in the Collaboration Product, subject to the approval of the Joint Steering Committee.

29. International Patent Application No. W097/31256 is an invention that was submitted before Illumina even existed, with Dr. Zirvi as a coinventor. In the First Amendment Agreement, it states: “The Parties will share responsibility for defining and developing Tag Sequences for the Collaboration Product which will attempt to avoid third party intellectual property rights or other encumbrances.” In other words, this was collusion by Illumina and ThermoFisher to apparently defraud third parties, such as Cornell and the Plaintiff. Dr. Zirvi informed Cornell of the findings in the unredacted First Amendment Agreement.

30. Cornell, when it became aware of the apparent fraud and collusion between these two companies, filed a

*Appendix D*

Rule 60(b)(6) motion to overturn this settlement agreement, attached hereto as Exhibit 4.

31. This motion was vigorously opposed by both Illumina and ThermoFisher, even though ThermoFisher was a Plaintiff allegedly representing Cornell's and Plaintiffs interests in the case against Illumina.

32. Unbeknownst to Plaintiff or Cornell at the time, Illumina and ThermoFisher were secretly working together to develop the "Ampliseq for Illumina" product line during the Cornell v Illumina case. (See Exhibits 1 and 2).

33. Illumina and ThermoFisher's joint venture in the "Ampliseq for Illumina" product line strengthened their duopoly in the DNA sequencing and DNA microarrays market.

34. Illumina has used its monopoly position in DNA sequencing to purchase Grail and claim that they have developed a "multi-cancer early detection" (MCED) test claiming to find 50 different cancers at early stages, without any evidence of long-term prospective population base clinical trial to prove clinical utility for this test.

35. Despite this fact, Illumina / Grail is attempting to unduly influence lawmakers to pass bills (117 HR 1947, To amend title XVIII of the Social Security Act to provide for Medicare coverage of multi-cancer early detection screening tests; 117 S 1873, To amend title XVIII of the Social Security Act to provide for Medicare coverage of

*Appendix D*

multi-cancer early detection screening tests.) requiring Medicare to reimburse for this unproven test, misspending up to \$60B in taxpayer funds per year.

36. Moreover, under the guise of this “testing” to detect “early cancer” patients would unwittingly be providing all their private DNA information, which Illumina could resell for their own personal profit regardless of the end user’s purpose.

37. At the foundation of the DNA analysis market is Plaintiffs Zip Code Operating System that allows samples to be processed and reliable results obtained.

38. The Plaintiff has not been recognized as an inventor on any of Illumina’s patents using the Zip Code Operating System; has not received royalties from Illumina’s use of Plaintiff’s Zip Code Operating System in their software and products Others have noted: “To paraphrase William Shakespeare’s Hamlet, something is rotten in the state of Illumina.”<sup>1</sup>

39. Illumina and its founders and employees have incorporated the ZipCode Operating System and utilized Plaintiffs’ ZipCode sequences and designs to manufacture and commercialize numerous products. Illumina knowingly applied for these patents without including Plaintiff as an inventor and the patent claims

---

1. Open letter to Shareholders of Illumina, Inc., March 13th, 2023, Carl Icahn: (<https://carlicahn.com/open-letter-to-shareholders-of-illumina-inc/>)

*Appendix D*

would not have been issued had it not been for Illumina's commercial success using ZipCode sequences and the ZipCode Operating System to determine the location of DNA sequences in the Sentrix arrays, GoldenGate assays and Infinium arrays as demonstrated by the software used to analyze .dmap files associated with these products. This software specifically calls the DNA sequences, used by Illumina in its products, ZipCode (and not by any other name or pseudonym).

40. The patents were issued by the USPTO without Plaintiff as a named inventor solely because Illumina knowingly and fraudulently withheld this usurpation of intellectual property rights from the USPTO patent examiners (See First Amendment Agreement, Exhibit 3) by renaming ZipCode sequences as Addresses, DBL, decoders and adaptors as well as other pseudonym and not referencing Plaintiffs 465 and 4633 ZipCode sets which Kevin Gunderson and Mark Chee and Illumina purloined as Illumacodes 1-16. (See Probes and Decoder Oligonucleotides patent application, in Expert analysis as filed in Zirvi v. US NIH et al. (Case 3:20-cv-07648-MAS-DEA) as Exhibit 17, see Exhibit 5). Illumina's "Tag Sequences" and Illumicodes and Illumacodes and DBLs and adaptors are all in fact derivatives of Plaintiffs ZipCode sequences and ZipCode Operating System. As others have noted: "Yet these individuals suffer no consequences or remorse. The members of Illumina's management team and board of directors collectively own less than 0.1% of the company's stock yet they feel entitled to take these reckless actions with our money."<sup>2</sup>

---

2. *Id.*

*Appendix D*

41. During the *Cornell v. Illumina* case, Attorneys Roger Chin, Doug Lumish, and Rip Finst presented “legal advice” that included knowingly false statements and deliberate omissions in two PowerPoint presentations (Exhibits 6 and 7). Tellingly, the First Amendment Agreement was never mentioned, let alone discussed in these presentations, thus allowing for a false and misleading legal analysis, including the misleading definition of ZipCodes.

42. At the end of the *Cornell v. Illumina* case, Plaintiff was informed by Attorney Roger Chin that the protection of the purloined 16 Zip Code sequences was a trade-secret case and that Attorney Matthew Pearson had investigated bringing the action as a trade-secret case. See the email from Roger Chin addressed to Plaintiff and inventors (Exhibit 8).

43. Based on Roger Chin’s legal advice, Plaintiff Zirvi filed *Zirvi v. Flatley* (Case 1:18-cv-07003-JGK). As part of *Zirvi v. US NIH et al.* (Case 3:20-cv-07648-MAS-DEA) case, Expert Analysis revealed numerous additional instances of apparent fraud (see Exhibit 5), including, but not limited to the dependence of numerous Illumina patent filings and Illumina products on Zip Code sequences (i.e. Sentrix, Infinium Arrays.). These findings were subverted by Attorneys Matthew Pearson, Roger Chin, Doug Lumish, and Rip Finst. As others have noted: “In response to our letter, Illumina’s board did what boards do best. They used our money – and yours – to defend themselves against their own shareholders by hiring highly-paid bankers, lawyers and PR firms. In the process, they issued a press release and spoke to sell-side

*Appendix D*

analysts to disseminate the incumbent board's message. They make several points which are either misleading, improbable or are clear double speak.”<sup>3</sup>

44. At the conclusion of *Zirvi v. Flatley* legal analysis of “storm warnings” of fraud and IP theft by Illumina should have commenced by the ThermoFisher Attorneys, who at the time were representing Cornell and all the inventors at the beginning of *Cornell v. Illumina*.

45. The patents that Illumina filed that absolutely depend on ZipCodes to function include but are not limited to the following:

- a. 6355431 (the ‘5431 patent); Detection of nucleic acid amplification reactions using bead arrays Chee; Mark S. (Del Mar, CA), Gunderson; Kevin (Encinitas, CA)
- b. 6620584 (the ‘0584 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark (Del Mar, CA), Walt; David R. (Lexington, MA)
- c. 6770441 (the ‘0441 patent); Array compositions and methods of making same Dickinson; Todd (San Diego, CA), Coblenz; Kenneth D. (Del Mar, CA), Carlson; Edward (Oceanside, CA)

---

3. Icahn Responds to Illumina’s Obfuscations; March 15th, 2023, Carl Icahn: (<https://carlicahn.com/icahn-responds-to-illuminas-obfuscations/>)

*Appendix D*

- d. 6812005 (the '2005 patent); Nucleic acid detection methods using universal priming Chee; Mark S. (Del Mar, CA), Auger; Steven R. (Norwell, MA), Stuelpnagel; John R. (Encinitas, CA)
- e. 6858394 (the '8394 patent); Composite arrays utilizing microspheres Fan; Jian-Bing (San Diego, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Del Mar, CA)
- f. 6890741 (the '0741 patent); Multiplexed detection of analytes Fan; JianBing (San Diego, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Del Mar, CA)
- g. 6913884 (the '3884 patent); Compositions and methods for repetitive use of genomic DNA Chee; Mark S. (Del Mar, CA), Czarnik; Anthony W. (San Diego, CA), Stuelpnagel; John R. (Encinitas, CA)
- h. 7033754 (the '3754 patent); Decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Czarnik; Anthony W. (San Diego, CA), Stuelpnagel; John R. (Encinitas, CA)
- i. 7060431 (the '0431 patent); Method of making and decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)

*Appendix D*

- j. 7166431 (the '6431 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark S. (Del Mar, CA), Walt; David R. (Lexington, MA)
- k. 7226734 (the '6734 patent); Multiplex decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)
- l. 7361488 (the '1488 patent); Nucleic acid detection methods using universal priming Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)
- m. 7455971 (the '5971 patent); Multiplex decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)
- n. 7510841 (the '0841 patent); Methods of making and using composite arrays for the detection of a plurality of target analytes Stuelpnagel; John (Encinitas, CA), Chee; Mark (Del Mar, CA), Auger; Steven (Norwell, MA)
- o. 7563576 (the '3576 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark S. (Del Mar, CA), Walt; David R. (Lexington, MA)

*Appendix D*

- p. 7582420 (the '2420 patent); Multiplex nucleic acid reactions Shen; Mun-Jui Richard (Poway, CA), Oliphant; Arnold (Poway, CA), Butler; Scott L. (San Diego, CA), Stuelpnagel; John E. (Encinitas, CA), Chee; Mark S. (Del Mar, CA), Kuhn; Kenneth M. (San Diego, CA), Fan; Jian-Bing (San Diego, CA)
- q. 7611869 (the '1869 patent); Multiplexed methylation detection methods Fan; Jian-Bing (San Diego, CA)
- r. 7612020 (the '2020 patent); Composite arrays utilizing microspheres with a hybridization chamber Fan; Jian-Bing (San Diego, CA), Chee; Mark S (Del Mar, CA)
- s. 7670810 (the '0810 patent); Methods and compositions for whole genome amplification and genotyping Shen; Mun-Jui Richard (Poway, CA), Oliphant; Arnold (Poway, CA), Butler; Scott L. (San Diego, CA), Stuelpnagel; John E. (Encinitas, CA), Chee; Mark S. (Del Mar, CA), Kuhn; Kenneth M. (San Diego, CA), Fan; Jian-Bing (San Diego, CA)
- t. 7776531 (the '6531 patent); Compositions and methods for stabilizing surface bound probes Fan; Jian-Bing (San Diego, CA)
- u. 7803537 (the '3537 patent); Parallel genotyping of multiple patient samples Fan;

*Appendix D*

Jian-Bing (San Diego, CA), Chee; Mark S (Del Mar, CA)

v. 7899626 (the '9626 patent); System and method of measuring methylation of nucleic acidsi Kruglyak; Semyon (San Diego, CA), Bibikova; Marina (San Diego, CA), Chudin; Eugene (Kirkland, WA)

w. 7901897 (the '1897 patent); Methods of making arrays Kain; Robert (San Diego, CA)

x. 7914988 (the '4988 patent); Gene expression profiles to predict relapse of prostate cancer Chudin; Eugene (Kirkland, WA), Lozach; Jean (San Diego, CA), Fan; Jian-Bing (San Diego, CA), Bibikova; Marina (San Diego, CA)

y. 7955794 (the '5794 patent); Multiplex nucleic acid reactions Shen; Min-Jui Richard (San Diego, CA), Oliphant; Arnold (Poway, CA), Butler; Scott L. (San Diego, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Del Mar, CA), Kuhn; Kenneth M. (San Diego, CA), Fan; Jian-Bing (San Diego, CA)

z. 7960119 (the '0119 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark S. (Encinitas, CA), Walt; David R. (Lexington, MA)

*Appendix D*

aa. 8003354 (the '3354 patent); Multiplex nucleic acid reactions Oliphant; Arnold (Poway, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Del Mar, CA), Butler; Scott L. (San Diego, CA), Fan; Jian-Bing (San Diego, CA), Shen; Min-Jui Richard (Poway, CA)

bb. 8076063 (the '6063 patent); Multiplexed methylation detection methods Fan; Jian-Bing (San Diego, CA)

cc. 8080380 (the '0380 patent); Use of microfluidic systems in the detection of target analytes using microsphere arrays Chee; Mark S. (Encinitas, CA), Dickinson; Todd A. (San Diego, CA), Gunderson; Kevin (Encinitas, CA), O'Neil; Don (San Juan Capistrano, CA), Stuelpnagel; John R. (Encinitas, CA)

dd. 8110363 (the '0363 patent); Expression profiles to predict relapse of prostate cancer Chudin; Eugene (Kirkland, WA), Lozach; Jean (San Diego, CA), Fan; Jian-Bing (San Diego, CA), Bibikova; Marina (San Diego, CA)

ee. 8150626 (the '0626 patent); Methods and compositions for diagnosing lung cancer with specific DNA methylation patterns Fan; Jian-Bing (San Diego, CA), Bibikova; Marina (San Diego, CA)

ff. 8150627 (the '0627 patent); Methods and compositions for diagnosing lung cancer with

*Appendix D*

specific DNA methylation patterns Fan; Jian-Bing (San Diego, CA), Bibikova; Marina (San Diego, CA)

gg. 8206917 (the '6917 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark S. (Encinitas, CA), Walt; David R. (Lexington, MA)

hh. 8288103 (the '8103 patent); Multiplex nucleic acid reactions Oliphant; Arnold (Sunnyvale, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Encinitas, CA), Butler; Scott L. (Sandwich, GB), Fan; Jian-Bing (San Diego, CA), Shen; Min-Jui Richard (Poway, CA)

ii. 8440407 (the '0407 patent); Gene expression profiles to predict relapse of prostate cancer Chudin; Eugene (Kirkland, WA), Lozach; Jean (San Diego, CA), Fan; Jian-Bing (San Diego, CA), Bibikova; Marina (San Diego, CA)

jj. 8460865 (the '0865 patent); Multiplex decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)

kk. 8481268 (the '1268 patent); Use of microfluidic systems in the detection of target analytes using microsphere arrays Chee; Mark S. (Encinitas, CA), Dickinson; Todd A. (San Diego,

*Appendix D*

CA), Gunderson; Kevin (Encinitas, CA), O'Neil; Don (San Juan Capistrano, CA), Stuelpnagel; John R. (Encinitas, CA)

ll. 8486625 (the '6625 patent); Detection of nucleic acid reactions on bead arrays Chee; Mark S. (Encinitas, CA), Walt; David R. (Lexington, MA)

mm. 8541207 (the '1207 patent); Preservation of information related to genomic DNA methylation Gormley; Niall Anthony (Nr. Saffron Walden, GB), Smith; Geoffrey Paul (Nr Saffron Walden, GB), Bentley; David (Nr Saffron Walden, GB), Rigatti; Roberto (Nr Saffron Walden, GB), Luo; Shujun (Hayward, CA)

nn. 8563246 (the '3246 patent); Combinatorial decoding of random nucleic acid arrays Chee; Mark S. (Encinitas, CA), Walt; David R. (Lexington, MA)

oo. 8628952 (the '8952 patent); Array kits and processing systems Lebl; Michal (San Diego, CA), Perbost; Michel (San Diego, CA), DeRosier; Chad F. (San Diego, CA), Nibbe; Mark J. (San Diego, CA), Burgett; Steve R. (San Diego, CA), Heiner; David L. (San Diego, CA)

pp. 8741630 (the '1630 patent); Methods of detecting targets on an array Dickinson; Todd (San Diego, CA), Coblenz; Kenneth D. (San Diego, CA), Carlson; Edward (San Diego, CA)

*Appendix D*

qq. 8795967 (the '5967 patent); Multiplex decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)

rr. 8883424 (the '3424 patent); Use of microfluidic systems in the detection of target analytes using microsphere arrays Chee; Mark S. (Encinitas, CA), Dickinson; Todd A. (San Diego, CA), Gunderson; Kevin (Encinitas, CA), O'Neil; Don (San Juan Capistrano, CA)

ss. 8895268 (the '5268 patent); Preservation of information related to genomic DNA methylation Kester; Henri A. (San Diego, CA)

tt. 8906626 (the '6626 patent); Multiplex nucleic acid reactions Oliphant; Arnold (Sunnyvale, CA), Stuelpnagel; John R. (Santa Barbara, CA), Chee; Mark S. (Encinitas, CA), Butler; Scott L. (Sandwich, GB), Fan; Jian-Bing (San Diego, CA), Shen; Min-Jui Richard (Poway, CA)

uu. 9045796 (the '5796 patent); Methods and compositions for whole genome amplification and genotyping Gunderson; Kevin (Encinitas, CA), Stuelpnagel; John R. (Encinitas, CA), Chee; Mark S. (Encinitas, CA), Fan; JianBing (San Diego, CA)

vv. 9163283 (the '3283 patent); Combinatorial decoding of random nucleic acid arrays Chee;

*Appendix D*

Mark S. (Encinitas, CA), Walt; David R. (Lexington, MA)

ww. 9279148 (the '9148 patent); Detection of nucleic acid reactions on bead arrays Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)

xx. 9289766 (the '9766 patent); Use of microfluidic systems in the detection of target analytes using microsphere arrays Chee; Mark S. (Encinitas, CA), Dickinson; Todd A. (San Diego, CA), Gunderson; Kevin (Encinitas, CA), O'Neil; Don (San Juan Capistrano, CA)

yy. 9399795 (the '9795 patent); Multiplex decoding of array sensors with microspheres Chee; Mark S. (Del Mar, CA), Stuelpnagel; John R. (Encinitas, CA), Czarnik; Anthony W. (San Diego, CA)

zz. 9441267 (the '1267 patent); Detection of nucleic acid reactions on bead arrays Oliphant; Arnold (Sunnyvale, CA), Stuelpnagel; John R. (Santa Barbara, CA), Chee; Mark S. (Encinitas, CA), Butler; Scott L. (Sandwich, GB), Fan; JianBing (San Diego, CA), Shen; Min-Jui Richard (Poway, CA).

46. But for the intentional acts and negligence of the attorneys representing Plaintiff in the Cornell case the

*Appendix D*

Plaintiff would have been able to enforce his intellectual property rights against Illumina.

47. But for the conspiring of all Defendants, Plaintiff Zirvi would have received the recognition and royalties on a series of patents (See: *Czarnik v. Illumina*, Case 1 :05-cv-00400-JJF).

48. Plaintiff asserts that the failure to name Plaintiff as an inventor on the patents filed by the assignee has caused significant reputational harm. Plaintiff's contributions to the development of the technology are significant and cannot be denied. The claimant has been acknowledged as a key contributor to the development of the technology. (See Exhibit 9 Affidavit of Dr. Francis Barany) However, the failure to name the claimant as an inventor on the patents has undermined the claimant's reputation and standing in the scientific community.

49. The Plaintiff's claim is based on 35 U.S.C. § 256, which provides for correction of inventorship in patents. Plaintiff believes that the assignee erred in failing to name Plaintiff as an inventor on the patents and that this error should be corrected.

50. Exhibit 10 is the original provisional application 60/180,810 submitted by Jian-Bing Fan for Illumina on Feb. 07, 2000. This provisional matured into the following patents which incorporate inventive concepts and steps of the Plaintiff: the '9148 patent, the '1267 patent, the '3354 patent, the '8103 patent, the '6626 patent, the '0536 patent, the '2005 patent, the '1488 patent, the '3754 patent, the

*Appendix D*

‘0431 patent, the ‘5796 patent, the ‘6734 patent, the ‘5971 patent, the ‘865 patent, the ‘9795 patent, the ‘5794 patent, the ‘0741 patent, the ‘1869 patent, and the ‘6063 patent.

51. In the 60/180,810 provisional application JB Fan claims inventorship of Zip Code arrays (Universal Arrays) and zip-code sequences, as well as their combined use with PCR and ligation reactions. On the cover sheet, the box at the bottom was knowingly left unchecked for “Additional inventors are being named on separately numbered sheets attached hereto.” The provisional application contains an NIH grant application within, wherein the last Figure (page 50) titled “Detection of Alternative Splicing on Zip-code Arrays and Comparison with RT-PCR” shows the use of Plaintiff’s Zip Code Array invention and completely dependent on Zip-code sequences to work. Tellingly, this smoking gun figure is missing from these issued patents, including US 6,812,005 patent (‘2005), as well as US 7,955,794 patent (‘5794). (See Exhibit 11)

52. When Defendant Matthew Pearson was asked as to why Jian Bing Fan was not deposed in *Cornell v Illumina*, he stated that Illumina had taken him off the deposed witness list, even though a subpoena had been served and accepted by Illumina. Illumina stated that they “no longer knew where he was.” Plaintiff was able to track Jian Bing Fan’s fraudulent “exodus” to China with evidence of the assistance and knowledge of Illumina. (Exhibit 13) Despite being presented with all this information, Defendants Rip Finst, Matthew Pearson, Roger Chin and Douglas Lumish inexplicably made no attempt to contact or depose such a key witness,

*Appendix D*

yet alone notify the Court of this obstruction of justice. This is further evidence of legal malpractice as other key witnesses including Mark Chee and David R. Walt were also not deposed. This is well below the acceptable standard of legal practice in an intellectual property case involving multiple billions of dollars of revenue.

53. Illumina has used US 7,955,794 patent to extract a \$26.7 million judgment from Roche (Verinata Health, Inc. v. Ariosa Diagnostics, Inc., Case No. 12-cv-05501-SI), showing the value of the Patents derived from the Plaintiffs inventive steps and contributions. The Defendants have all aided and abetted Illumina in its journey towards “a new low in corporate governance.”<sup>4</sup>

54. An analysis of the merits of legal malpractice claims has been performed by Jeff Oster (See Affidavit of Merit, Exhibit 14).

**COUNT I – FAILURE TO NAME  
PLAINTIFF ON PATENT**

55. Plaintiff repeats and re-alleges all of the paragraphs 1-54 above as if fully set forth herein.

56. The Defendant, Illumina, has obtained the following issued patents which incorporate inventive steps derived from Plaintiff s intellectual property and

---

4. Icahn to Commence Investigation into Value Destruction by Illumina’s Board (<https://carlicalm.com/ieahn-to-commence-investigation-into-value-destruction-by-illuminas-board/>)

*Appendix D*

copyrights. The '5431 patent, the '0584 patent, the '0441 patent, the '2005 patent, the '8394 patent, the '0741 patent, the '3884 patent, the '3754 patent, the '0431 patent, the '6431 patent, the '6734 patent, the '1488 patent, the '5971 patent, the '0841 patent, the '3576 patent, the '2420 patent, the '1869 patent, the '2020 patent, the '0810 patent, the '6531 patent, the '3537 patent, the '9626 patent, the '1897 patent, the '4988 patent, the '5794 patent, the '0119 patent, the '3354 patent, the '6063 patent, the '0380 patent, the '0363 patent, the '0626 patent, the '0627 patent, the '6917 patent, the '8103 patent, the '0407 patent, the '0865 patent, the '1268 patent, the '6625 patent, the '1207 patent, the '3246 patent, the '8952 patent, the '1630 patent, the '5967 patent, the '3424 patent, the '5268 patent, the '6626 patent, the '5796 patent, the '3283 patent, the '9148 patent, the '9766 patent, the '9795 patent and the '1267 patent. These issued patents generally relate to the concepts of detecting a mutation, generic aberrations, copy number variations, or a cancer, etc., using ZipCodes and the ZipCode Operating System via universal addressable DNA arrays to analyze a sample.

57. Plaintiff contributed novel concepts and work to the inventions claimed in the '5431 patent, the '0584 patent, the '0441 patent, the '2005 patent, the '8394 patent, the '0741 patent, the '3884 patent, the '3754 patent, the '0431 patent, the '6431 patent, the '6734 patent, the '1488 patent, the '5971 patent, the '0841 patent, the '3576 patent, the '2420 patent, the '1869 patent, the '2020 patent, the '0810 patent, the '6531 patent, the '3537 patent, the '9626 patent, the '1897 patent, the '4988 patent, the '5794 patent, the '0119 patent, the '3354 patent, the '6063 patent, the

*Appendix D*

‘0380 patent, the ‘0363 patent, the ‘0626 patent, the ‘0627 patent, the ‘6917 patent, the ‘8103 patent, the ‘0407 patent, the ‘0865 patent, the ‘1268 patent, the ‘6625 patent, the ‘1207 patent, the ‘3246 patent, the ‘8952 patent, the ‘1630 patent, the ‘5967 patent, the ‘3424 patent, the ‘5268 patent, the ‘6626 patent, the ‘5796 patent, the ‘3283 patent, the ‘9148 patent, the ‘9766 patent, the ‘9795 patent and the ‘1267 patent. These contributions include, for example, applications of ZipCode sequences sets to decode the physical location or addresses of various DNA sequences in random bead arrays such as Sentrix and Infinium arrays.

58. David R. Walt and Mark Chee and Jian Bing Fan and John R. Stuelpnagel, and others while employed at Illumina, received and used 20 of ZipCodes invented by the Plaintiff and confidential information via the Joint Development Agreement and Joint Steering Committee with Perkin Elmer Applied Biosystems and produced products including Sentrix arrays and GoldenGate assay and derivative arrays using multiple ZipCodes per bead such as Infinium arrays, including to conceive claimed inventions of the ‘5431 patent, the ‘0584 patent, the ‘0441 patent, the ‘2005 patent, the ‘8394 patent, the ‘0741 patent, the ‘3884 patent, the ‘3754 patent, the ‘0431 patent, the ‘6431 patent, the ‘6734 patent, the ‘1488 patent, the ‘5971 patent, the ‘0841 patent, the ‘3576 patent, the ‘2420 patent, the ‘1869 patent, the ‘2020 patent, the ‘0810 patent, the ‘6531 patent, the ‘3537 patent, the ‘9626 patent, the ‘1897 patent, the ‘4988 patent, the ‘5794 patent, the ‘0119 patent, the ‘3354 patent, the ‘6063 patent, the ‘0380 patent, the ‘0363 patent, the ‘0626 patent, the ‘0627 patent, the ‘6917

*Appendix D*

patent, the '8103 patent, the '0407 patent, the '0865 patent, the '1268 patent, the '6625 patent, the '1207 patent, the '3246 patent, the '8952 patent, the '1630 patent, the '5967 patent, the '3424 patent, the '5268 patent, the '6626 patent, the '5796 patent, the '3283 patent, the '9148 patent, the '9766 patent, the '9795 patent and the '1267 patent.

59. There is a dispute as to the correct naming of inventors on the '5431 patent, the '0584 patent, the '0441 patent, the '2005 patent, the '8394 patent, the '0741 patent, the '3884 patent, the '3754 patent, the '0431 patent, the '6431 patent, the '6734 patent, the '1488 patent, the '5971 patent, the '0841 patent, the '3576 patent, the '2420 patent, the '1869 patent, the '2020 patent, the '0810 patent, the '6531 patent, the '3537 patent, the '9626 patent, the '1897 patent, the '4988 patent, the '5794 patent, the '0119 patent, the '3354 patent, the '6063 patent, the '0380 patent, the '0363 patent, the '0626 patent, the '0627 patent, the '6917 patent, the '8103 patent, the '0407 patent, the '0865 patent, the '1268 patent, the '6625 patent, the '1207 patent, the '3246 patent, the '8952 patent, the '1630 patent, the '5967 patent, the '3424 patent, the '5268 patent, the '6626 patent, the '5796 patent, the '3283 patent, the '9148 patent, the '9766 patent, the '9795 patent and the '1267 patent.

60. Plaintiff requests that the Court issue a declaratory judgment correcting the inventorship of the patents at issue in this claim and adding Plaintiff Zirvi as a co-inventor pursuant to 35 USC § 256.

61. Plaintiff had to hire the undersigned attorneys and agree to pay attorney's fees to the firm to represent him in this matter.

*Appendix D***PRAYER FOR RELIEF COUNT I**

62. The Plaintiff seeks relief under 35 U.S.C. § 256 and requests that the inventorship of the patents in question be corrected to include the Plaintiff as an inventor. In addition, Plaintiff seeks damages for reputational harm resulting from not being named as an inventor on the patents. The claimant requests damages to compensate for both the economic harm and the reputational harm caused by the assignee's failure to name the claimant as an inventor on the patents.

**WHEREFORE**, Plaintiff prays for judgment as follows:

(a) An order directing the Director of the United States Patent and Trademark Office to issue a certificate correcting inventorship of: the '5431 patent, the '0584 patent, the '0441 patent, the '2005 patent, the '8394 patent, the '0741 patent, the '3884 patent, the '3754 patent, the '0431 patent, the '6431 patent, the '6734 patent, the '1488 patent, the '5971 patent, the '0841 patent, the '3576 patent, the '2420 patent, the '1869 patent, the '2020 patent, the '0810 patent, the '6531 patent, the '3537 patent, the '9626 patent, the '1897 patent, the '4988 patent, the '5794 patent, the '0119 patent, the '3354 patent, the '6063 patent, the '0380 patent, the '0363 patent, the '0626 patent, the '0627 patent, the '6917 patent, the '8103 patent, the '0407 patent, the '0865 patent, the '1268 patent, the '6625 patent, the '1207 patent, the '3246 patent, the '8952 patent, the '1630 patent, the '5967 patent, the '3424 patent, the '5268 patent, the '6626 patent, the '5796 patent, the '3283 patent, the

*Appendix D*

‘9148 patent, the ‘9766 patent, the ‘9795 patent and the ‘1267 patent, by including Plaintiff Zirvi as co-inventor of the claims is the patents;

- (b) An order directing the Defendants to correct inventorship of any foreign or international patent based on patents in paragraph (a) by including Plaintiff Zirvi as co-inventor of the claims of those patents and pending applications;
- (c) A declaration that this case be deemed exceptional pursuant to 35 USC section 285, as appropriate and provided by law;
- (d) Reasonable attorney’s fees, costs, and expenses, as appropriate and provided by law; and
- (e) Such other and further relief as the Court deems just and proper,

**COUNT II – LEGAL MALPRACTICE**

63. Plaintiff repeats and re-alleges all of the paragraphs 1-62 above as if fully set forth herein.

64. Defendant Attorneys were negligent in their representation of Plaintiff in the Cornell case and subsequent settlement thereof when they failed to represent Plaintiff during settlement negotiations or failed to inform Plaintiff during the Cornell case that they were not going to represent Plaintiffs interest.

*Appendix D*

65. The Defendant Attorneys' failure to represent, or inform Plaintiff to retain his own representation, was the proximate cause of damages, including, failing to be compensated or recognized under the Cornell case settlement agreement, and causing Plaintiff to lose rights of enforcement against Illumina in an individual matter because of a delay him bringing such action against Illumina, based upon representations that those claims would be resolved on behalf of the Plaintiff in the Cornell case.

66. Plaintiffs damages include lost compensation for the intellectual property that was incorporated into a series of Illumina patents and products since the time of Plaintiff's invention. In addition, damages include all expenses incurred trying to enforce intellectual property rights against Illumina that the Federal Court of Appeals ultimately ruled were time-barred, even though Plaintiff's counsel never advised of the potential that his claims could be barred. Indeed, Plaintiff's counsel advised that there was no need to pursue individual claims, or representation because Plaintiff was represented and all ThermoFisher, Cornell, and the inventors' interests were all aligned.

67. The damage suffered by Plaintiff are actual and ascertainable damages that would not have been incurred by the Plaintiff but for the malpractice of Defendant Attorneys.

68. In doing the acts alleged herein, Defendants acted with fraud, oppression and/or malice entitling Plaintiff to punitive damages according to proof at trial.

*Appendix D*

**PRAYER FOR RELIEF COUNT II**

**WHEREFORE**, Plaintiff's pray for judgment as follows:

69. A declaratory judgment that Defendants engaged in fraudulent conduct in violation of federal and state law;

70. An award of compensatory and consequential damages, including but not limited to the costs and expenses associated with investigating and prosecuting this matter;

71. An award of punitive damages to punish Defendants for their egregious, intentional and malicious conduct;

72. An award of attorney's fees and other costs incurred in connection with this lawsuit;

73. An order requiring Defendants to cease their fraudulent conduct and to take all necessary steps to remedy the harm caused to Plaintiff and other affected parties;

74. An order compelling Defendants to provide a full and accurate accounting of all funds and assets obtained through their fraudulent conduct;

75. An order enjoining Defendants from engaging in similar fraudulent conduct in the future;

*Appendix D*

76. An order requiring Defendants to disgorge any ill-gotten profits obtained through their fraudulent conduct;

77. Any further relief that this Honorable Court deems just and proper.

**COUNT III – FRAUD**

78. Plaintiff repeats and re-alleges all of the paragraphs 1-77 above as if fully set forth herein.

79. Defendants (ThermoFisher and the Attorneys) made material misrepresentations, and misrepresentations by omission, to Plaintiff. During the *Cornell Case* the Defendants stated that they would represent Plaintiff and in fact did represent Plaintiff in preparing and defending his deposition.

80. Defendants made false statements that Plaintiff's interest and ThermoFisher's interest were aligned and therefore he didn't need his own attorney.

81. Defendants made false statements that even if Plaintiff retained his own counsel, that counsel would not be allowed to participate in the litigation.

82. Defendants intended that Plaintiff rely on these statements so that he would not hire his own attorneys to protect his interest in the intellectual property plaintiff had created and Illumina incorporated into its own patents and products.

*Appendix D*

83. Defendants intended that Plaintiff relied on these statements so that he would not hire his own attorney to be involved in the negotiation of a settlement agreement between ThermoFisher and alumina, that directly affected Plaintiff's rights in his intellectual property.

84. Plaintiff reasonably relied upon the assertions of ThermoFisher and its lawyers regarding the alignment of interest and the ThermoFisher lawyers' ability to represent Plaintiff's interests during the litigation and settlement of the Cornell case.

85. As a result of Plaintiff's reasonable reliance under the false statement of ThermoFisher and its lawyers Plaintiff lost his right to be a party too, and compensated under, the settlement agreement in the Cornell case which included his intellectual property.

86. The Plaintiff suffered further damage in a subsequent lawsuit against Illumina to enforce his rights when it was determined that the Defendants' fraudulent and purposeful delay in Plaintiff asserting claims against Illumina time-barred his recovery of rightful royalties.

87. In doing the acts alleged herein, Defendants acted with fraud, oppression and/or malice entitling Plaintiff to punitive damages according to proof at trial.

*Appendix D*

**PRAYER FOR RELIEF COUNT III**

**WHEREFORE**, Plaintiff's pray for judgment as follows:

88. Compensatory damages in an amount to be determined at trial, plus prejudgment interest;

89. Punitive damages in an amount to be determined at trial;

90. Costs, disbursements, and reasonable attorneys' fees incurred in this action under applicable law;

91. Other relief that this Honorable Court deems just and proper.

**COUNT IV – CIVIL CONSPIRACY**

Plaintiff alleges that Defendants: (1) a combination of two or more persons; (2) acting in concert to commit an unlawful act or commit a lawful act by unlawful means; (3) an agreement between the parties to inflict a wrong against or injury upon another; and (4) an overt act resulting in damages. See, Banco Popular N. Am. v. Gandi, 184 N.J. 161, 183 (2005). “Under New Jersey law, a claim for civil conspiracy cannot survive without a viable underlying tort. . . .” Id. at 177-78.

92. Plaintiff re-alleges and reincorporates paragraphs 1 through 91 as though fully set forth herein.

*Appendix D*

93. Defendants in combination with one another, acting in concert, conspired to commit an unlawful act that deprived the Plaintiff of his intellectual property rights and did so while pretending to be engaged in a legitimate fight within the confines of a court case over the intellectual property.

94. Defendants Illumina and Thermo Fisher had an agreement between each other to inflict harm upon Plaintiff by constructing an agreement that would make it impossible for Plaintiff to enforce his right to his intellectual property.

95. Defendants ThermoFisher and their counsel Rip Finst, Sean Boyle, Roger Chin, and Douglas Lumish would feign to be averse to Illumina while at the same time working together to usurp Plaintiff's Intellectual Property Rights for their own use and benefit.

96. Defendants ThermoFisher and their counsel Rip Finst, Sean Boyle, Matthew A. Pearson, Angela Verrecchio, Roger Chin and Douglas Lumish failed to represent Plaintiff's interests in the settlement agreement of April 2017.

97. Defendants ThermoFisher and their counsel Rip Finst, Sean Boyle, Roger Chin, and Douglas Lumish would overtly use a series of court proceedings and settlements to damage the Plaintiff and secure his Intellectual Property for themselves.

*Appendix D*

98. Defendants' Thermo Fisher and their counsel Rip Finst, Sean Boyle, Matthew A. Pearson, Roger Chin, and Douglas Lumish acts would provide Illumina and Thermo Fisher with a duopoly that has made the companies billions of dollars in profit and market cap over the last decade and has deprived the Plaintiff of the same during that time.

99. In doing the acts alleged herein, Defendants acted with fraud, oppression and/or malice entitling Plaintiff to punitive damages according to proof at trial.

**PRAYER FOR RELIEF COUNT IV**

**WHEREFORE**, Plaintiff's pray for judgment as follows:

100. Compensatory damages in an amount to be determined at trial, plus prejudgment interest;

101. Punitive damages in an amount to be determined at trial;

102. Costs, disbursements, and reasonable attorneys' fees incurred in this action under applicable law;

103. Other relief that this Honorable Court deems just and proper.

*Appendix D*

**JURY DEMAND**

The Plaintiff demands trial by a jury on all the triable issues of this complaint.

Respectfully submitted,

LORIUM LAW  
Counsel for Plaintiffs  
101 NE 3rd Ave, Suite 1800  
Fort Lauderdale, FL 33301  
Telephone: (954) 462-8000  
Facsimile: (954) 462-4300

By: /s/ Joseph D. Garrity  
**JOSEPH D. GARRITY, ESQ.**  
Florida Bar No. 87531  
Primary Email  
igarrity@loriumlaw.com  
Secondary Service Email  
GLT@loriumlaw.com

**Soliman & Associates, PC**  
*Counsel for Plaintiffs*  
923 Haddonfield Rd., Ste. 300  
Cherry Hill, NJ 08002  
Telephone: (856) 324-8313  
Facsimile: (856) 324-9080

By: /s/ Ahmed Soliman  
**AHMED SOLIMAN, ESQ.**  
NJ Bar No. 016572010  
Primary Email  
soliman@solimanlegal.com

**APPENDIX E — Exhibit 3 to the Complaint:  
First Amendment to Joint Development Agreement  
(Applied Biosystems—Illumina), dated March 27, 2001**

**First Amendment to Joint Development Agreement**

This first amendment (“First Amendment”), entered into as of March 27, 2001, (“First Amendment Date”), is by and between ILLUMINA, INC., a Delaware corporation located at 9390 Towne Centre Drive, Suite 200, San Diego, CA 92121-3015 (“Illumina”), and PE CORPORATION (NY), a New York corporation, through its PE Biosystems Group, now known as its Applied Biosystems Group, located at 850 Lincoln Centre Drive, Foster City, CA 94404 (“PEB”).

**Recitals**

The parties have entered into a Joint Development Agreement (“Original Agreement”) having an Effective Date of November 8, 1999.

This First Amendment, entered into pursuant to Section 13.7 of the Original Agreement, serves to amend the Original Agreement by providing for the development and commercialization of Tag Sequence technology.

NOW, THEREFORE, in consideration of the mutual obligations in this First Amendment and in the Original Agreement, and for other good and valuable consideration, the receipt and sufficiency of which are acknowledged, the parties to this First Amendment agree as follows:

**CONFIDENTIAL  
TREATMENT REQUESTED**

*Appendix E*

**Amendment**

1. *Definitions:* Any words with initial capitalization that are used and not defined in this First Amendment will have the meanings set forth in the Original Agreement.
2. Add new Section 1.33 immediately after Section 1.32 of the Original Agreement as follows:

1.33 “Tag Sequence” means a set of oligonucleotide probes, developed pursuant to the Original Agreement or this First Amendment, which act independently of any target-sequence-specific analytical chemical reactions to allow the physical addressing of the products of a chemical reaction to locations on a solid support, such as the “addressable array-specific portion” of the oligonucleotide probes and their complements described in International Patent Application No. WO97/31256, and that are designed for use in the Collaboration Product. The Parties will agree on the selection Tag Sequences to be used in the Collaboration Product, subject to the approval of the Joint Steering Committee.

Certain confidential portions of this Exhibit were omitted by means of blackout of the text (the “Mark”). This Exhibit has been filed separately with the Secretary of the Commission without the Mark pursuant to the Company’s

*Appendix E*

Application Requesting Confidential Treatment under Rule 24b-2 under the 1934 Act.

3. Add the following to Section 3.1 of the Original Agreement immediately before the last sentence of Section 3.1:

The Parties will share responsibility for defining and developing Tag Sequences for the Collaboration Product which will attempt to avoid third party intellectual property rights or other encumbrances.

4. Add new Sections 4.1.5 and 4.1.6 immediately after Section 4.1.4 of the Original Agreement as follows:

4.1.5 *Manufacture of Tag Sequences.* It is understood that the Tag Sequences comprise complementary sets of oligonucleotides one set of which will reside on the Assembled Arrays, and a second, complementary set which will be provided as part of the Reagents. In the Collaboration Field, Illumina will manufacture Tag Sequences for the Assembled Arrays and for use in decoding arrays; and PEB will manufacture Tag Sequences for the Reagents.

4.1.6 *Use of Tag Sequences.* The Parties agree that Tag Sequences will be used in the Collaboration Field by the Parties and purchasers of Collaboration Product. Tag Sequences may not be used by third

*Appendix E*

parties outside the Collaboration Field unless the use is approved by the Joint Steering Committee.

5. Add new Section 6.1.4 immediately after section 6.1.3 of the Original Agreement as follows:
  - 6.1.4 The Parties agree that any Intellectual Property Rights concerning Tag Sequences conceived after the Effective Date of the Original Agreement whether Collaboration PEB Intellectual Property, Collaboration Joint Intellectual Property, or Collaboration Illumina Intellectual Property, including the methods by which such Tag Sequences are designed, selected or made, as well as any compositions directed to such Tag Sequences, shall be deemed Collaboration Joint Intellectual Property.
6. *Continued Effect of Original Agreement.* All provisions of the Original Agreement except as modified by this First Amendment, shall remain in full force and effect and are hereby reaffirmed. Other than as stated in this First Amendment, this First Amendment will not operate as a waiver of any condition or obligation imposed on the Parties under the Original Agreement.
7. *Interpretation of Amendment.* In the event of any conflict, inconsistency, or incongruity between any provision of this First Amendment and any provision of the Original Agreement, the provisions of this First Amendment will govern and control.

*Appendix E*

8. *Entire Agreement.* This First Amendment, along with the Original Agreement constitute the sole agreements between the Parties relating to the subject matter hereof and supersede all previous writings and understandings. Confidential disclosures made under previously executed Confidentiality Agreements between the Parties will remain subject to the terms of those Confidentiality Agreements. No Party has been induced to enter into this Agreement by, nor is any Party relying on, any representation or warranty outside those expressly set forth in this Agreement.
9. *Counterparts.* This First Amendment may be executed in any number of counterparts, and each counterpart will be deemed an original instrument, but all counterparts together will constitute one agreement.

[Signature page follows.]

ILLUMINA, INC.

PE CORPORATION (NY),  
THROUGH ITS APPLIED  
BIOSYSTEMS GROUP

By: <u>John R. Stuelpnagel</u>	By: <u>Elaine J. Heron</u>
Name: <u>John R. Stuelpnagel</u>	Name: <u>Elaine J. Heron</u>
Title: Vice President, Business Development	Title: Vice President, Applera Corporation General Manager, Molecular Biology Divisi Applied Biosystems
Date: <u>4/2/01</u>	Date: <u>3/29/01</u>

**APPENDIX F — Exhibit 4 to the Complaint:  
Motion to Vacate and Rescind Settlement pursuant  
to Rule 60(b)(6), Cornell Univ. v. Illumina, Inc., No.  
1:10-cv-00433-LPS-MPT (D. Del. filed June 21, 2017)**

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

C.A. No. 10-433-LPS-MPT

CORNELL UNIVERSITY, CORNELL  
RESEARCH FOUNDATION, INC., LIFE  
TECHNOLOGIES CORPORATION AND  
APPLIED BIOSYSTEMS, LLC,

*Plaintiffs,*

v.

ILLUMINA, INC.,

*Defendant.*

Filed June 21, 2017

PLAINTIFFS CORNELL UNIVERSITY AND  
CORNELL RESEARCH FOUNDATION, INC.'S  
OPENING BRIEF IN SUPPORT OF MOTION  
TO VACATE STIPULATION OF DISMISSAL  
PURSUANT TO RULE 60 AND TO RESCIND  
SETTLEMENT DOCUMENTS OR,  
[REDACTED] ALTERNATIVELY,  
FOR LEAVE TO CONDUCT DISCOVERY

ORAL ARGUMENT REQUESTED  
REDACTED PUBLIC VERSION

[TABLES INTENTIONALLY OMITTED]

*Appendix F***NATURE AND STAGE OF THE PROCEEDINGS**

Plaintiffs Cornell University and Cornell Research Foundation, Inc. (referred to collectively as “Cornell” and individually as “Cornell University” and “CRF”) are plaintiffs in this action, jointly with Life Technologies Corporation and Applied Biosystems, LLC (collectively “Life Tech”). The plaintiffs brought this lawsuit (the “Action”) against defendant Illumina, Inc. (“Illumina”) alleging infringement of certain patents. The parties entered into a Settlement Agreement effective April 14, 2017 (the “Settlement Agreement”), and a stipulation of dismissal pursuant to the Settlement Agreement [D.I. 598] (the “Dismissal”) was entered on April 24, 2017. Cornell now files this opening brief in support of its Motion to Vacate the Dismissal Pursuant to Rule 60 and to Rescind Settlement Documents [REDACTED] or, alternatively, for Leave to Conduct Discovery.

**SUMMARY OF THE ARGUMENT**

1. Pursuant to Rule 60 of the Federal Rules of Civil Procedure, Cornell seeks vacatur of the Dismissal entered in this Action [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

*Appendix F*

2. As the Court is aware, Cornell and Life Tech are co-plaintiffs in this Action directed against specific Illumina products (the “Accused Products”), that plaintiffs believe infringe certain patents owned by CRF and exclusively licensed to Life Technologies Corporation (the “Asserted Patents”).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

3. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

4. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

5. [REDACTED]

[REDACTED]

*Appendix F*

[REDACTED]

**STATEMENT OF FACTS****A. The Parties, This Action**

[REDACTED]

As the Court is aware, this Action was filed in 2010 with Cornell and Life Tech as co-plaintiffs. Dorn ¶ 9. Throughout this Action, the co-plaintiffs have been represented by outside counsel selected by Life Tech. Dorn ¶ 13.

[REDACTED] As discussed further below, Latham & Watkins was also counsel for Life Tech in a patent infringement lawsuit brought by Illumina against Life Tech in California. *Id.* ¶ 14. [REDACTED]

[REDACTED]

*Appendix F*

This Action is directed against specified Illumina products which plaintiffs assert infringe 15 patents licensed to Life Technologies Corporation D.I.[ 298/299], and which will be referenced herein as the “CRF patents.” Dorn in 2, 10; Kelly 711, 6; Li “in 1, 6. In addition, Cornell believes [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

**B. The Settlement Discussions**

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

## Appendix F

The figure consists of four stacked bar charts, one for each age group: 18-24, 25-34, 35-44, and 45-54. Each bar chart represents the percentage of respondents who have heard of ten different topics. The topics are listed on the y-axis and include: The concept of climate change, Global warming, The Kyoto Protocol, The Stern Review, Carbon trading, Carbon taxes, Renewable energy, Energy efficiency, Biofuels, and Carbon footprints. The bars are stacked, with the bottom bar representing the 18-24 age group and the top bar representing the 45-54 age group. The percentage of respondents who have heard of each topic generally decreases as the age group gets older.

Age Group	The concept of climate change	Global warming	The Kyoto Protocol	The Stern Review	Carbon trading	Carbon taxes	Renewable energy	Energy efficiency	Biofuels	Carbon footprints
18-24	95	92	88	85	82	78	75	72	68	65
25-34	92	88	85	82	78	75	72	68	65	62
35-44	88	85	82	78	75	72	68	65	62	58
45-54	85	82	78	75	72	68	65	62	58	55

### C. The Dismissal Of The Action

Pursuant to the Settlement Agreement, on April 18, 2017, the Dismissal was submitted to the Court along with the parties' joint proposed stipulation to vacate the claim construction order and decisions in this Action. [D.I. 595 and 596]. The Court held a telephonic hearing on April 24, 2017 to discuss the Dismissal and the proposed joint

*Appendix F*

stipulation to vacate the claim construction order and decisions. Dorn ¶47. During that teleconference, Delaware counsel of record for Life Tech and Cornell represented that in the context of the settlement, Cornell was seeking to preserve its rights, including by vacatur of the Court’s claim construction order and decisions, to avoid “a possible preclusive effect on them in any other litigation unrelated to Illumina or the case that is before Your Honor.” [D.I. 600, Tr. at 4]. *Id.* The Court entered the Dismissal that same day [D.I. 598], but declined to vacate the claim construction order and decisions. *Id.*

[REDACTED]

D. [REDACTED]

[REDACTED]

[REDACTED]

## Appendix F

On that date, Illumina and Life Tech filed a Joint Motion to Dismiss a patent lawsuit brought by Illumina against Life Tech in the Southern District of California. *Id.*; Kelly ¶ 25. See *Illumina, Inc. v. Life Technologies Corp. et al.*, No. 11-CV-03022 (S.D. Cal.) (the “Illumina California Action”), stating that the: “parties have reached a Settlement Agreement to resolve this dispute without further litigation,” (Case No. 11CV-03022, D.I. 91 at 2). *Id.* Latham & Watkins was counsel of record for Life Tech in the Illumina California Action. Dorn ¶ 51.

*Appendix F***ARGUMENT****A. Standards Under Rule 60 And Delaware Law On Rescinding A Contract****1. Rule 60 Standards**

Rule 60(b) provides that a party may file a motion for relief from a final judgment for numerous reasons, including:

[REDACTED]  
[REDACTED]  
[REDACTED] or (6) any other reason that justifies relief. Fed. R. Civ. P. 60(b) (2017). A motion filed pursuant to Rule 60(b) is addressed to the sound discretion of the trial court guided by accepted legal principles applied in light of all relevant circumstances. *Pierce Assoc. Inc. v. Nemours Found.*, 865 F.2d 530, 548 (3d Cir. 1988); *Lasky v. Cont'l Prods. Corp.*, 804 F.2d 250, 256 (3d Cir. 1986).

[REDACTED]  
[REDACTED]  
[REDACTED] As a result, Cornell seeks relief under Rule 60(b)(6), which “is a catch-all provision that allows relief for any other reason justifying relief from the operation of the judgment.” *United States v. Witco Corp.*, 76 F. Supp. 2d 519, 527 (D. Del. 1999) (quotation marks omitted). A motion for relief under Rule 60(b)(6)

## Appendix F

is appropriate “when the movant shows any . . . reason justifying relief from the operation of the judgment other than the more specific circumstances set out in Rules 60(b)(1)-(5).” *Gonzalez v. Crosby*, 545 U.S. 524, 528 (2005) (citation and quotation marks omitted). Cases under Rule 60(b) have required “a movant seeking relief under Rule 60(b)(6) to show ‘extraordinary circumstances’ justifying the reopening of a final judgment.” *Id.* at 535 (citation and quotation marks omitted).

## 2. Jurisdiction Over Settlement Documents

“It is well settled that a federal court has the inherent power to enforce and to consider challenges to settlements entered into in cases originally filed therein.” *Fox v. Consol. Rail Corp.*, 739 F.2d 929, 932 (3d Cir. 1984) (quoting *Pearson v. Ecological Sci. Corp.*, 522 F.2d 171 (5th Cir. 1975); cf. *Washington Hosp. v. White*, 889 F.2d 1294, 1298-99 (3d Cir. 1989). The Court can do this without inquiring into, or requiring, an independent grounds for subject matter jurisdiction for the enforcement/challenge suit. See *Aro Corp. v. Allied Witan Co.*, 531 F.2d 1368, 1371 (6th Cir. 1976). Accordingly, this Court is empowered to consider both vacating the Dismissal and rescinding the agreements entered into in connection with the settlement.

3.

*Appendix F*

[REDACTED]

[REDACTED]

[REDACTED]

**B. The Dismissal Should Be Vacated [REDACTED]**

[REDACTED]

1.

[REDACTED]

[REDACTED]

## Appendix F

a. [REDACTED]

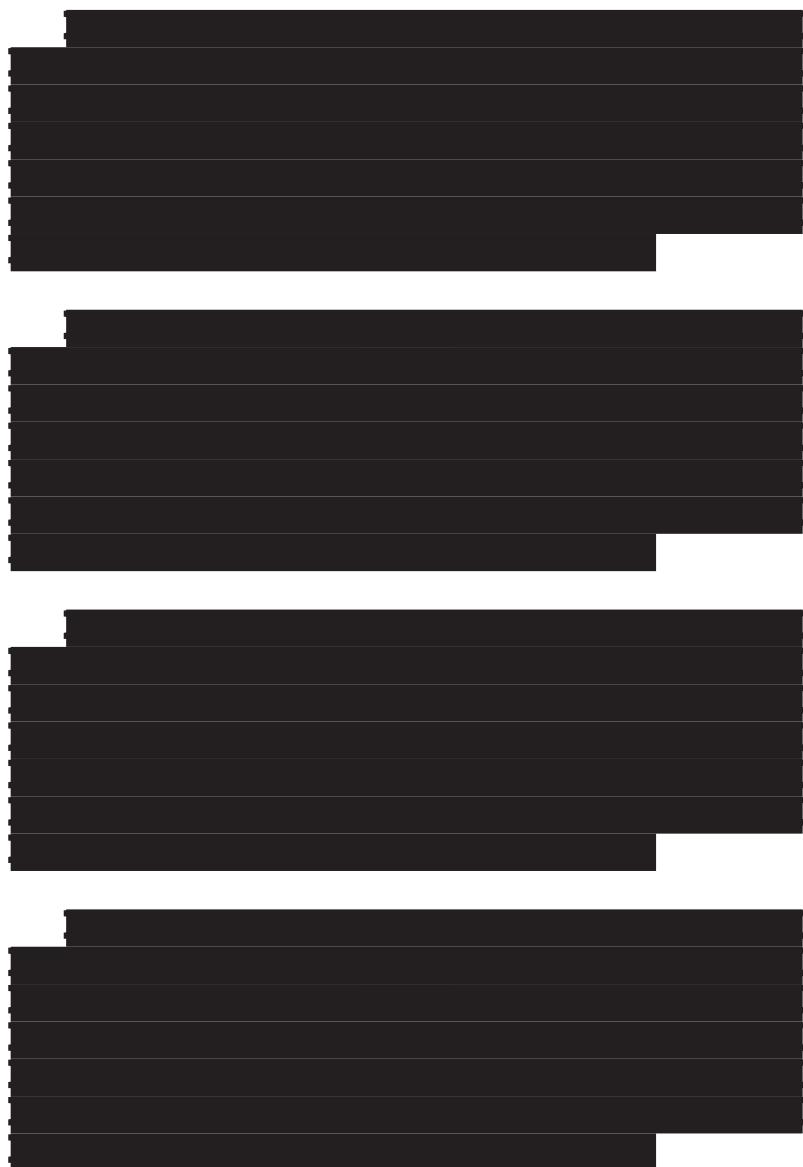
1. **What is the primary purpose of the proposed legislation?**

2. **How will the proposed legislation affect the current regulations?**

3. **What are the key provisions of the proposed legislation?**

4. **What is the timeline for the proposed legislation?**

5. **What are the potential consequences of non-compliance with the proposed legislation?**

*Appendix F*

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

## Appendix F

b.

2.

a.

1.

2.

*Appendix F*

Exhibit B-1 to Dorn Exhibit B is the same as the Dismissal entered in this Action. *Id.* Thus, there can be no dispute that the Dismissal was submitted pursuant to the Settlement Agreement. [REDACTED]

[REDACTED]

**b. Extraordinary Circumstances Are Present And Cornell Cannot Obtain Relief Under Any Other Provision of Rule 60**

To vacate a judgment under Rule 60(b)(6), the movant needs to show “extraordinary circumstances.” *Gonzalez*, 545 U.S. at 535. The circumstances here are certainly extraordinary. [REDACTED]

[REDACTED]

*Appendix F***C. If The Court Believes Further Evidence Is Needed To Support The Relief Requested, Cornell Should Be Granted Leave To Conduct Discovery**

However, Cornell has had no opportunity to seek discovery on Life Tech's conduct to obtain further evidence. Cornell has presented more than sufficient proofs to support the relief sought in this motion; however, if the Court believes more evidence should be presented, Cornell respectfully requests that the Court grant it the opportunity to conduct discovery into the issues presented in this motion. [REDACTED]

Courts have repeatedly granted requests for discovery in the context of Rule 60 motions. [REDACTED]

[REDACTED]

*Appendix F*

[REDACTED] Many other courts have found that discovery is wanted when there is a dispute on the facts relating to relief requested under Rule 60. *See, e.g., Sheng v. Starkey Labs., Inc.*, 53 F.3d 192, 194 (8th Cir. 1995) (holding that evidentiary hearing had to be held to resolve both Rule 60 motions); *Southerland v. Irons*, 628 F.2d 978, 979 (6th Cir. 1980) (court scheduled evidentiary hearing on Rule 60 motion); *Midwest Franchise Corp. v. Metromedia Rest. Grp., Inc.*, 177 F.R.D. 438, 441 (N.D. Iowa 1997) (holding that plaintiff had made necessary showing to want post-trial deposition of witness pursuant to Rule 60(b) (2) motion); [REDACTED]  
[REDACTED]  
[REDACTED]

*Appendix F*

**CONCLUSION**

For the above reasons, the Dismissal should be vacated and the Settlement Agreement and the [REDACTED] or in the alternative, Cornell should be granted leave to conduct discovery before the Court rules on this motion.

OF COUNSEL:  
LECLAIRRYAN,  
A Professional Corporation  
Andrew P. Zappia  
70 Linden Oaks, Suite 210  
Rochester, NY 14625  
(585) 270-2100  
Andrew.Zappia@leclairryan.com

LECLAIRRYAN  
By: s/ Andrew L. Cole  
Andrew L. Cole. (No. 5712)  
800 North King Street, Suite 303  
Wilmington, DE 19801  
(302) 394-6817  
Andrew.Cole@leclairryan.com

Counsel for Plaintiffs  
Cornell University  
and Cornell Research  
Foundation, Inc.

Counsel for Plaintiffs  
Cornell University  
and Cornell Research  
Foundation, Inc.

June 21, 2017

**APPENDIX G — Findings of Fact, Conclusions  
of Law, and Order dated September 27, 2023**

UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY

Civil Action No. 23-1997 (MCA) (JSA)

MONIB ZIRVI, M.D., Ph.D.,

*Plaintiff,*

v.

ILLUMINA, INC., *et al.*,

*Defendants.*

**FINDINGS OF FACT, CONCLUSIONS OF LAW,  
AND ORDER ON MOTION TO SEAL**

**THIS MATTER** having come before the Court by way of Defendant Thermo Fisher Scientific's ("Thermo") motion, (ECF No. 13), for an order to seal Exhibits 6, 7, and 8 attached to Plaintiff Monib Zirvi's ("Plaintiff") Complaint at ECF No. 1-1 (sometimes the "Materials"); and the Court having carefully considered the parties' respective submissions in support of and in opposition thereto, (ECF Nos. 13 & 17, respectively); and no oral argument having been heard pursuant to Fed. R. Civ. P. 78(b); and for the reasons set forth below; and for good cause shown; the following shall constitute the findings of fact and conclusions of law and Order of the Court:

*Appendix G*

**FINDINGS OF FACT**

1. On April 8, 2023, Plaintiff filed the instant action and Complaint against Thermo and several other defendants in connection with disputed patents. (ECF No. 1).
2. Plaintiff attached several exhibits to the Complaint, including Exhibits 6, 7, and 8. (*Id.*)
3. On April 13, 2023, Thermo submitted a letter, seeking a temporary order sealing the Materials based on assertions of privilege and directing Plaintiff to seek removal of these Materials from publicly available databases. (ECF No. 10-1).
4. On the same date, Plaintiff submitted a letter, opposing Thermo's request. (ECF No. 11).
5. On the same date, this Court issued a Temporary Order to Seal the Materials, pursuant to Local Civil Rule 5.3(c)(9), given the nature of the parties' purported privilege dispute over the Materials and to provide the parties with an opportunity to formally brief whether there are grounds to seal the Materials under Local Civil Rule 5.3(c). (ECF No. 12).
6. On April 27, 2023, Thermo filed its motion to permanently seal the Materials, which they assert contain confidential business information and attorney-client privileged case assessments and communications prepared by outside counsel for a co-Plaintiff in a separate

*Appendix G*

civil action, *Cornell/Life Tech. v. Illumnia*. (ECF Nos. 13-1 & 13-2 – Walsh Decl. ¶ 3 and Ex. 1).

7. Plaintiff opposes the motion, contending Thermo has failed to meet its burden of demonstrating the common interest privilege shields the Materials or that they are protected by the attorney-client privilege. (ECF No. 17). Plaintiff further argues that Thermo has not identified the public interest at stake, the clearly defined injury that would result if the relief was not granted, or why a less restrictive alternative to sealing is not available. (*Id.*).

8. Exhibits 6 and 7 are case assessments prepared by outside counsel for an entity named Life Tech. They contain Defendant's commercially sensitive, proprietary, and confidential business information. They also reflect internal strategies and are marked "PRIVILEGED & CONFIDENTIAL." Exhibit 8 contains correspondence to and from outside counsel for Life Tech that likewise reflects Defendant's confidential business information and internal strategies. (ECF No. 13-2 at ¶¶3-6 and Ex. 1).

9. In short, the Materials reveal, contain, and reflect commercially sensitive business information about the patents at issue and internal strategies.

10. Thermo has a legitimate interest in maintaining the confidentiality of the Materials, as Thermo has stated that the information sought to be sealed is unavailable to the public and Thermo has taken substantial efforts to ensure that the Materials remain secret. The disclosure of this information would provide the public insight into

*Appendix G*

the private business strategies and give competitors an unfair advantage. (ECF Nos. 13-1 & 13-2).

11. The clearly defined and serious injuries that would result if the Materials were not sealed include allowing competitors to undercut or harm Thermo's commercial performance. (*Id.*).

12. Disclosure of the confidential Materials to the public is irreversible and thus such information can no longer be confidential once revealed to the public.

**CONCLUSIONS OF LAW**

13. The common law right of public access to judicial proceedings and records is well settled. *In re Cendant Corp.*, 260 F.3d 183, 192 (3d Cir. 2001) (citing *Littlejohn v. BIC Corporation*, 851 F.2d 673, 677-78 (3d Cir. 1988)); *Leucadia, Inc. v. Applied Extrusion Technologies, Inc.*, 998 F.2d 157, 161 (3d Cir. 1993). The presumption of public access has been applied "to a wide variety of civil records and documents," including "pleadings, orders, notices, exhibits and transcripts filed." *Leucadia, Inc.*, 998 F.2d at 162 (citations and internal quotation marks omitted). A narrow exception has been carved out for discovery materials as well as "discovery motions and their supporting documents." *Id.* at 165.

14. "[W]hen a moving party seeks an order sealing court records, it must demonstrate that 'good cause' exists to overcome the presumption in favor of public access." *China Falcon Flying Ltd. v. Dassault Falcon Jet Corp.*,

*Appendix G*

Civ. No. 15-6210, 2017 U.S. Dist. LEXIS 138651, at \*4 (D.N.J. Aug. 29, 2017) (citing *Securimetrics, Inc. v. Iridian Techs., Inc.*, Civ. No. 03-4394, 2006 U.S. Dist. LEXIS 22297 (D.N.J. Mar. 30, 2006)). The “good cause” standard requires a “particularized showing that disclosure will cause a ‘clearly defined and serious injury to the party seeking closure.’” *Securimetrics, Inc.*, U.S. Dist. LEXIS 22297, at \*7 (quoting *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 786 (3d Cir. 1994)). “This standard was incorporated into this District’s Local Civil Rule 5.3, which sets forth the requirements for a motion to seal.” *City of Sterling Heights Gen. Employees’ Ret. Sys. v. Prudential Fin., Inc.*, Civ. No. 12-5275, 2016 U.S. Dist. LEXIS 5856, at \*4 (D.N.J. Jan. 15, 2016).

15. Local Civil Rule 5.3(c) requires the reviewing Court to consider the following factors: (a) “the nature of the materials or proceedings at issue”; (b) “the legitimate private or public interest which warrants the relief sought”; (c) “the clearly defined and serious injury that would result if the relief sought is not granted”; and (d) “why a less restrictive alternative to the relief sought is not available.” L. Civ. R. 5.3(c)(3).

16. This Court has the power to seal where confidential information may be disclosed to the public and harm a party’s competitive standing in the marketplace, including “trade secret[s] or other confidential research, development, or commercial information.” See *Zenith RadioCorp. v. Matsushita Elec. Indus. Co., Ltd.*, 529 F. Supp. 866, 889-91 (E.D. Pa. 1981); Fed. R. Civ. P. 26(c)(1)(G); see, e.g., *Littlejohn v. BIC Corp.*, 851 F.2d 673, 678 (3d

*Appendix G*

Cir. 1988); *Goldenberg v. Indel, Inc.*, No. 09-5202, 2012 U.S. Dist. LEXIS 479, at \*8-12 (D.N.J. Jan. 3, 2012).

17. Courts have recognized that the presumption of public access is not absolute and may be rebutted. *Leucadia v. Applied Extrusion Technologies, Inc.*, 998 F.2d 157, 164 (3d Cir. 1993); *Republic of Philippines v. Westinghouse Elec. Corp.*, 949 F.2d 653, 662 (3d Cir. 1991).

18. Courts may deny public access and seal a document when it encompasses business information that may harm a party's competitive standing. See *Littlejohn*, 851 F.2d at 678 (citations omitted). The District of New Jersey has recognized that the inclusion of trade secrets and other confidential information warrants sealing of such documents. *In re Gabapentin*, 312 F. Supp. 2d 653, 664 (D.N.J. 2004) (citations omitted). As such, “[t]he presence of trade secrets or other confidential information weighs against public access and, accordingly, documents containing such information may be protected from disclosure.” *Id.* (citations omitted).

19. This Court has discretion to balance the factors for and against access to court documents. See *Pansy v. Borough of Stroudsburg*, 23 F.3d 772, 781 (3d Cir. 1994).

20. Courts have recognized that protection of a party's interest in confidential commercial information is a sufficient threat of irreparable harm. See *Publicker Indus., Inc. v. Cohen*, 733 F.2d 1059, 1071 (3d Cir. 1984).

21. Thermo's request to seal the Materials, which are only three exhibits to the publicly filed Complaint,

*Appendix G*

is narrowly tailored to the specific confidential and proprietary information. Accordingly, a less restrictive alternative is not available in that redactions would be so extensive as to render the documents meaningless. (*Id.*)

22. The Court finds good cause exists for protecting the Materials.

23. The Court finds that the confidential commercially sensitive informed contained in or referenced by the Materials satisfy the standards set forth in Local Civil Rule 5.3.

24. Having found the Materials contain and/or reflect confidential commercially sensitive business information, which serves as an independent basis for sealing these Materials, the Court declines to reach the merits of Thermo's argument that the Materials also are privileged and/or reveal privileged communications as another basis to seal.

**THEREFORE**, for the reasons stated above and for good cause shown,

**IT IS** on this 27th day of September 2023,

**ORDERED** that Thermo's Motion to Seal (ECF No. 13), pursuant to Local Civil Rule 5.3(c), is

**GRANTED**; and it is further

*Appendix G*

**ORDERED** that the Clerk of the Court shall maintain under seal Exhibits 6, 7, and 8 attached to Plaintiff's Complaint at ECF No. 1-1; and it is further

**ORDERED** that the Clerk of the Court is directed to terminate the Motion filed as ECF No. 13.

s/Jessica S. Allen  
JESSICA S. ALLEN, U.S.M.J.

cc: Hon. Madeline Cox Arleo, U.S.D.J.

**APPENDIX H — Exhibit 9 to the Complaint:  
Affidavit of Dr. Francis Barany,  
submitted February 6, 2023**

1. My name is Dr. Francis Barany. I make this affidavit based on my own personal knowledge.

2. I am a Professor of Microbiology at Weill Cornell Medicine, I am best known for inventing the ligase chain reaction (LCR), ligase detection reaction (LDR), and Universal DNA arrays currently used worldwide to diagnose genetic diseases, detect infectious pathogens, and identify cancer mutations and other diseases using DNA microarrays and targeted next-generation sequencing (NGS). As of this writing, I hold 74 (US) and over 100 (international) patents widely used in molecular diagnostic and sequencing.

3. I am a National Academy of Inventors fellow (2016). I was also named to the 2004 “Scientific American 50”—Scientific American magazine’s prestigious annual list recognizing leadership in science and technology from the past year. I was included as “Research Leader in Medical Diagnostics,” for my leadership role in the development of a universal array genomic chip that allows for the rapid and accurate detection of cancers and other diseases —especially breast and colon cancer. The Universal Zip Code DNA array, unlike previous mutation-detection methods of its kind, is the first programmable DNA array. It does not require a redesign each time a new gene is discovered. The universal array’s unique design may use ligation primers that guide a fluorescence-labeled signals to array “addresses” that indicate disease. This Universal

*Appendix H*

Zip Code DNA array and other technologies developed in my laboratory were licensed to Applied Biosystems.

4. Dr. Monib Zirvi, MD/PhD, graduated with a PhD from my laboratory at Weill Cornell Medicine in January of 1999. He joined my laboratory in August of 1994. Dr. Zirvi is a co-inventor of the “Universal Zip Code DNA array” and is a co-inventor of 20 issued US patents with me. Furthermore, at my request after he had graduated from my lab, Dr. Zirvi designed sets of Zip Code DNA sequences for use in creating Universal DNA Arrays. Using his expertise in Computer Engineering and programming, Dr. Zirvi designed and selected both a 4633 Zip Code set and a 465 Zip Code set for creation of large Universal Zip Code Arrays. He did this on his time and using his own equipment and I have retained copies of that work since 1999 which he helped me label on my computer. As such he is the primary co-author of those sets and a co-inventor of Universal Zip Code DNA arrays as described in international patent application WO97/31256.

5. These Zip Code sets in electronic files were shared in confidence with Applied Biosystems and somehow wound up in the hands of Illumina. In August 2015, Dr. Zirvi and I were shocked to discover that Illumina had submitted a patent application to the USPTO falsely declaring that they had invented Illumacodes (one of many pseudonyms they use for Zip Code sequences to obfuscate the true origin of this intellectual property). In fact, Illumacodes 1 through 16 were verbatim copies of 16 Zip Code sequences from one of Dr. Zirvi’s 465 Zip Code *unpublished* files. Further, Dr. Zirvi found that Illumina

*Appendix H*

used the word “ZipCode” multiple times in their DMAP software to decode all Illumina arrays.

6. Dr. Zirvi diligently attempted to help Cornell and ThermoFisher (which now owns Applied Biosystems) in *Cornell v Illumina* (1:10-cv-00433-LPS) case to obtain rightful royalties and recognition as inventors of the Zip Code technology from Illumina for this infringement of our intellectual property. Throughout this litigation, the academic inventors were told that attorneys Matthew Pearson of Akin Gump and Roger Chin and Douglas Lumish of Latham and Watkins represented the inventors’ interests, and that all interests were aligned.

7. However, while the *Cornell v Illumina* case was taking place, Illumina and ThermoFisher were secretly working together on a product called “Ampliseq for Illumina” while pretending to be adversaries in the case. On information and belief this collaboration was initiated at least as early as January 2015, prior even to the Markman hearing, and did not become publicly known until January of 2018. This fraud was kept hidden from Cornell, which filed a Rule 60(b) motion against both Illumina and ThermoFisher.

8. Illumina has used Zip Code technology to obtain a dominant position in genomics and DNA sequencing. Illumina has employed a strategy of “efficient infringement” against academic inventors by refusing to pay royalties and filing IPRs and ex partes to overwhelm intellectual property right holders with legal costs. This strategy is used as a sword and shield to avoid “third party

*Appendix H*

intellectual property rights and other encumbrances,” as Illumina stated in the unredacted First Amendment Agreement obtained from the SEC.

9. Tellingly, during and after the time that Illumina and ThermoFisher were colluding to defraud Cornell in the *Cornell v Illumina* case, both companies were working with security forces of the Chinese Communist government to differentiate Uyghurs from Han Chinese, as part of their apartheid efforts to subjugate and detain the Muslim Uyghur minorities in modern day concentration camps. (See: <https://www.justsecurity.org/64605/scientists-are-aiding-apartheid-in-china/>). As a son of two survivors of Nazi concentration camps, this begs the question: Can these companies be trusted with huge databases of confidential DNA information from US Citizens?

10. Now, Illumina/Grail is attempting to use their monopoly position in NGS and lobbying efforts to influence the US Congress and Senate to allow them to obtain control of the nascent, and yet unproven, Multi-Cancer Early Detection liquid biopsy technology (MCED). These tests claim to identify early cancers from a blood sample, yet there is currently no evidence of clinical utility, in other words, no evidence that they will save any lives. Briefly, the reasons are that the Illumina/Grail MCED assay:

- i. Misses most of the truly early cancers,
- ii. Some cancers would be detected anyway due to symptoms, and

*Appendix H*

iii. Most cancers they do detect are late-stage cancers where the patient eventually dies, so the patient doesn't benefit from the "early" detection.

11. Illumina is trying to force its acquisition of Grail, despite a standstill order by antitrust regulators. Illumina is attempting to extract ~\$60 billion annually from US taxpayers, or about 7% of the current Medicare budget. This is despite the risk of adverse outcomes from unnecessary invasive procedures from the up to 60% false positive results from Illumina/Grail tests. In the interest of the future of academic research and, more importantly, the economic viability and future of the national healthcare system, I am compelled to file this affidavit in support of Dr. Zirvi's legal action.

Respectfully submitted on February 6, 2023:

/s/ Francis Barany  
Professor Francis Barany  
National Academy of Inventors Fellow  
Dept. of Microbiology & Immunology  
Weill Cornell Medicine

Tel 212.746.6509 or 6507 or 6524  
barany@med.cornell.edu

Mobile 917.957.3976

**APPENDIX I — Exhibit 14 to the Complaint:  
Affidavit of Merit, United States District Court for  
the District of New Jersey, dated March 24, 2023**

IN THE UNITED STATE DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY

MONIB ZIRVI, M.D. Ph.D.,

*Plaintiff,*

v.

ILLUMINA INC., THERMO FISHER SCIENTIFIC,  
GUMP STRAUSS HAUER & FELD LLP, LATHAM  
& WATKINS, RIP FINST, SEAN BOYLE,  
MATTHEW A. PEARSON, ANGELA VERRECCHIO,  
ROGER CHIN, AND DOUGLAS LUMISH,

*Defendants.*

Dated March 24, 2023

**AFFIDAVIT OF MERIT**

I, Jeffrey B. Oster, submit this Affidavit of Merit pursuant to N.J.S.A. 2A:53A-27. which provides that “the person executing the Affidavit shall be licensed in this or any other State; have particular expertise in the general area of specialty involved in the action . . . for a period of at least five years”.

*Appendix I*

1. I am an attorney currently admitted in Washington (State) to which I was admitted on May 31, 1988. I was admitted as an attorney in New York in 1986 and I believe I'm currently listed as an out-of-state attorney in New York. And I was admitted in New Jersey (in 1986) where I resided at the time, but did not renew my admission in New Jersey after relocating to Washington in late 1987.
2. I am admitted at the US Patent and Trademark Office (Registration No. 32,585).
3. I have 37 years of experience in both law firm and in-house positions practicing law, including: (1) IP litigation in Federal Courts; (2) post-grant procedures at the PTAB (Patent Trial and Appeal Board and predecessor administrative panels including successfully defending patent validity challenges filed by defendant Illumina (both Zebala/Syntrix patent and The Scripps Research Institute DNA bar coding patent) and defendant Thermo Fisher Scientific (Life Technologies) for the Black Hole Quencher patents and various second generation PCR patents; (3) the Opposition Division of the European Patent Office (dual citizen of the United States and Germany) including multiple European oppositions filed against Thermo Fisher Scientific (Affymetrix); (4) in patent preparation and prosecution matters; (5) and general legal corporate and securities matters, including a dissident directors slate proxy campaign opposed to Latham & Watkin (defendants Chin and Lumish) representing existing Board of Sorrento.

*Appendix I*

4. My more recent legal experience in federal courts includes, but is not limited to, providing intellectual property expertise in: (i) *The Syntrix Biosystems, Inc. v. Illumina Inc*, W.D. Wash No. 3\_10-cv-05870, at the time, the largest patent litigation damage award in Washington, (ii) *The Scripps Research Institute v. Illumina* D. Calif No. 3:16-cv-00661-JLS, where one of the inventors won a Nobel Prize, including being the sole Attorney for Scripps on IPR PR2016-01619; and (iii) *Troll Busters LLV v. Roche Applied Sciences et al.* S.D. Calif No. 3:-cv-00056 wherein both Therm Fisher and Life Technologies were defendants (case dropped when lobbyist (upon information and belief, it was a Life Technology lobbyist) inserted a retroactive clause in a provision of the America Invents Act of 2012). Thus, I have the experience to evaluate this professional malpractice claim for reasonability.

5. I received a B.A. degree from Johns Hopkins University, Ph.D. degree in pharmacology from the University of Pennsylvania, and a JD degree from Rutgers Law School Newark (evening program).

6. I have reviewed the complaint for legal malpractice in this case as it relates to the Plaintiff, Dr. Monib Zirvi's claims that, as an inventor of intellectually property at the center of the case of *Cornell et al v Illumina*, Case 1:10-cv-00433-LPS-MPT, the actions and legal advice by the lawyers who represented Dr. Zirvi fell outside the acceptable professional standards for Attorneys engaged in the practice of law for a patent infringement case in a Federal Court.

*Appendix I*

7. Upon information and belief Dr. Zirvi has made allegations that state a claim, which evidences a reasonable probability that the licensed attorney Defendants' actions deviated from accepted standards of care for an attorney representing Dr. Zirvi in *Cornell et al v Illumina* ("The Case"). Dr. Zirvi's attorneys breach of professional conduct included:

- a. Upon information and belief, all the inventors, including Dr. Zirvi were told that they did not need separate representation because the inventors' interest were aligned with the Thermo Fisher (then Life Technologies as licensee of Cornell) for The Case. The defendant lawyers should have advised the inventors of a clear conflict of interest either before indicating the need for separate representation or during the representation when the defendant lawyers were clearly aware of the negotiation and collaboration going on between Life Technologies (The Case plaintiff) and Illumina (The Case defendant) and that there may be reasons for retaining separate counsel to advise them during the litigation.
- b. During the litigation of The Case and upon information and upon belief, the defendant lawyers made representations and took actions that established an attorney client relationship including providing documents marked 'Privileged' for The Case plaintiff, Life Technologies (now Thermo Fisher) for whom all of the lawyer defendants worked for as either

*Appendix I*

outside counsel or in-house counsel. Moreover, upon information and belief, the Thermo Fisher lawyers would not allow separate representation for Cornell (licensor) or the inventor (including the current Plaintiff) as no other lawyer would be allowed to participate, or view discovery, under a protective order.

- c. Upon information and belief throughout the representation the defendant lawyers were provided access to discovery or The Case and/or in “The Other Case’ (*Illumina, Inc. v. Life Technologies Corporation et al*, 3\_11-cv-03022). This “Zip Code Discovery” was not shared or even brought to the attention of Dr. Zirvi. Upon information and belief the Zip Code Discovery indicated Illumina’s use of Zip Codes including electronic file and other evidence that Illumina was using the identical Zip Codes invented by Dr. Zirvi internally for years. The defendant lawyers, who were also representing Dr. Zirvi, never brought the issue to Dr. Zirvi, or even acted in a professional manner if this created a clear conflict of interest.
- d. During the course of defendant lawyers alleged representation of Dr. Zirvi, there was an ongoing secret joint “Ampliseq for Illumina’s project, which involved a collaboration between Illumina and Thermo Fisher Scientific. This information was discovered by Dr. Zirvi after The Case was settled in light of public disclosures by Illumina

*Appendix I*

of this secret joint project happening at a time before the start of the Markman hearing in The Case. Upon information and belief the defendant lawyers failed to disclose this conflict of interest and act in accordance with this conflict of interest.

- e. Upon information and belief, defendant Matthew Pearson (of Aiken Gump, outside counsel for Therm Fisher at the time) falsely stated to Cornell inventors and Dr. Zirvi that the unredacted First Amendment Agreement between Illumina and P.E. Biosystems (now Thermo Fisher) was not relevant to The Case or the inventors. Upon information and belief, the unredacted First Amendment Agreement was not provided to the Cornell inventors or Dr. Zirvi at any time before during or after the Markman Hearing in The Case when it clearly states Tag Sequences are defined as described in WO97/31256, which Plaintiff is a co-inventor of.
- f. Upon information and belief, new Council of Record for The Case, Roger Chin and Douglas Lumish of Latham Watkins, were simultaneously representing Thermo Fisher in The Other Case *Illumina, Inc. v. Life Technologies Corporation et al*, 3\_11-cv-03022). Upon Information and belief defendants Chin and Lumish failed to advise their client Dr. Zirvi that (1) they had a conflict of interest; and (2) the unredacted First Amendment Agreement was produced as part of the Zip Code Discovery and admits that the term

*Appendix I*

“Tag Sequences” are defined as described in Dr. Zirvi’s co-invention WO97/31256, which is a clear admission against interest by defendant Illumina and evidences a failure of zealous representation of Dr. Zirvi and failure to disclose a conflict of interest between Thermo Fisher and Dr. Zirvi.

- g. Upon information and belief, in-house counsel defendant Rip Finst independently ruled without outside counsel filed an incorrect document with the Court in The Case *Cornell et al v Illumina*, Case 1:10-cv-00433-LPS-MPT. Upon information and belief never before and never after in The Case did Rip Finst file a similar document in the Court without outside counsel. Upon information and belief, this was also done without informing or consulting the Cornell inventors or Dr. Zirvi, which was the procedure for other documents filed by outside counsel in The Case.
- h. Lastly, upon information and belief and without consulting their clients, the Cornell inventors and Dr. Zirvi, the defendant lawyers settle The Case on terms that provided no compensation to Cornell or Dr. Zirvi. Upon information and belief at no point in time was Dr. Zirvi advised of the settlement negotiations, asked to participate or be represented in the settlement negotiations, advised of any secret quid pro quos as consideration for the settlement of The Case or ever advised of any attorney conflicts of interest on the part of the defendant attorneys.

*Appendix I*

8. In my opinion and upon the information provided to me, the clear conflict of interest of the lawyer defendants as attorneys for The Case and The Other case, obfuscation of The Case discovery information in light of the discovery evidence from The Other Case, the failure to act for the interest of Dr. Zirvi and misleading statements are a deviation from the standard of care, lack of zealous representation, and conflicts of interest attorneys are required to abide by.

9. I have no financial interest in the outcome of this case. But, in view of the Thermo Fisher (Life Technologies at the time) lobbying activity to add a retroactive provision to the America Invents Act (which if done at my other country of citizenship, the German Parliament would have been a violation of the foreign Corrupt Practice Act), I would like to see justice served here.

10. Accordingly, in my professional opinion, within reasonable probability, the legal services rendered by the Thermo Fisher in-house counsel Rip Finst, Matthew Pearson of Akin Gump, Roger Chin of Latham & Watkins and Douglas Lumish of Latham & Watkins are well below the acceptable professional standards of care and ethical requirements.

Signed: Jeffrey B. Oster      Dated: March 24, 2023  
Jeffrey B. Oster, Ph.D., J.D.  
WSBA# 17709

**APPENDIX J — Exhibit 1 to October 2,  
2023 PLAINTIFF'S RESPONSE BRIEF IN  
OPPOSITION OF DEFENDANTS' MOTIONS  
TO DISMISS [ECF NO. 82-1] and [ECF NO. 84-1]  
doc 92-1Privileged Communications and Emails  
Demonstrating Representation**

**Subject** Privileged

**From** Pearson, Matthew  
<mpearson@AKI NGUMP.com>

**To** George Barany <barany@umn.edu>,  
Robert Hammer  
<rphammer@gmail.com>, Maria  
Kempe <maria.kempe@med.lu.se>,  
Matthew Lubin  
<lubingenetics@me.com>, Monib  
Zirvi <matzirvi@yahoo.com>

**Cc:** Francis Barany  
(barany@med.cornell.edu)  
<barany@med.cornell.edu>, Valerie  
Cross Dorn <vlc1@cornell.edu>

**Date** Dec 13, 2016 at 4:01 PM

*Privileged*

Dear all -

I have attached a summary of a hearing that we had with the on November 29 in the case against Illumina. Please let us know if you have any questions.

Best,  
Matt Pearson

*Appendix J*

**Matthew A. Pearson**  
**GUMP STRAUSS HAUER & FELD LLP**  
[REDACTED] [mpearson@akingpump.com](mailto:mpearson@akingpump.com) |  
[akingump@com](mailto:akingump@com) | Bio

The information contained in this e-mail message is intended only for the personal and confidential use of the recipient(s) named above. If you have received this communication in error, please notify us immediately by e-mail, and delete the original message.

*Appendix J*

**Akin Gump**  
STRAUSS HAUER & FELD LLP

M E M O R A N D U M

**ATTORNEY-CLIENT PRIVILEGED**

December 13, 2016

**To:** Francis Barany and Coinventors

**From:** Akin Gump

**Re:** November 29, 2016 Hearing

On November 29, 2016, the Parties appeared before Judge Stark to address their Objections to the Report and Recommendations on Claim Construction issued by Magistrate Judge Thynge, as well as Illumina's Motion to Amend its Answer to plead inequitable conduct.

The majority of the argument focused on claim construction issues. In particular, the parties addressed three terms or groups of terms at issue in the litigation:

**1. Solid Support/Linker**

[REDACTED]

**ATTORNEY CLIENT PRIVILEGED**

Francis Barany and Coinventors

December 13, 2016

Page 2

*Appendix J*

**2. Capture Oligonucleotide**

[REDACTED]

**ATTORNEY CLIENT PRIVILEGED**

Francis Barany and Coinventors

December 13, 2016

Page 3

**3. The 25% Difference Terms**

[REDACTED]

**Motion to Amend**

Finally, the parties addressed Illumina's Motion to Amend to plead inequitable conduct as a defense. [REDACTED]

**ATTORNEY CLIENT PRIVILEGED**

Francis Barany and Coinventors

December 13, 2016

Page 4

[REDACTED]

We have no control over when the Court will make a decision on the issues it heard, but we continue to prepare for the trial (scheduled to begin on July 10, 2017). We do not anticipate the need for the inventors to do anything case-related over the holidays, but we will follow up with appropriate individuals in the new year as needs arise during our pre-trial preparation.

*Appendix J*

**Subject** Privileged

**From** Pearson, Matthew  
<mpearson@AKI NGUMP.com>

**To** ‘George Barany’  
<barany@umn.edu>, Francis Barany  
(barany@med.cornell.edu)  
<barany@med.cornell.edu>, ‘Robert  
Hammer’ <rphammer@gmail.com>,  
‘Maria Kempe’  
<maria.kempe@med.lu.se>,  
‘Matthew Lubin’  
<lubingenetics@me.com>, ‘Monib  
Zirvi’ <matzirvi@yahoo.com>

**Date** Jan 13, 2017 at 9:40 AM

*Privileged*

Dear all -

I have attached a summary of the order we received this week from the judge in our case. Please let us know if you have any questions.

Happy New Year,

**Matthew A. Pearson**  
**GUMP STRAUSS HAUER & FELD LLP**  
[REDACTED] mpearson@akingpump.com |  
akingump@com | Bio

*Appendix J*

The information contained in this e-mail message is intended only for the personal and confidential use of the recipient(s) named above. If you have received this communication in error, please notify us immediately by e-mail, and delete the original

*Appendix J*

**Akin Gump**  
STRAUSS HAUER & FELD LLP

M E M O R A N D U M

**ATTORNEY-CLIENT PRIVILEGED**

January 13, 2017

**To:** Francis Barany, George Barany, Robert Hammer, Maria Kempe, Matthew Lubin, and Monib Zirvi

**From:** Akin Gump

**Re:** Claim Construction and Illumina's Motion to Amend

On January 10, 2017, Judge Stark issued an Order addressing our objections to the Report and Recommendation on Claim Construction issued by Magistrate Judge Thynge, as well as Illumina's Motion to Amend its Answer to plead inequitable conduct. We summarize the major points below.

**Claim Construction**

Judge Stark rejected some parts of Magistrate Judge Thynge's claim construction report and accepted others. Specifically, Judge Stark agreed with Cornell's construction of the term "solid support" and of all terms related to the linker and ways of attaching or coupling to the support. Judge Stark therefore rejected Magistrate Judge Thynge's report on that point.

*Appendix J*

Judge Stark accepted Illumina's construction of "capture oligonucleotide," all terms related to the 25% difference limitation, and "ligase detection reaction." Illumina will still maintain its arguments for these other elements. Although we would have obviously preferred that the Court adopt Cornell's proposed construction on all claim terms, we are very pleased that the Court agreed with our position for the solid support.

Illumina's proposed construction of solid support, which has now been rejected, required a "single-unitary substrate." And Illumina argued that its bead arrays did not meet that definition. The new construction adopted on Tuesday requires only a "solid-phase substrate." The change to the construction of solid support makes our argument more straightforward that bead arrays have solid supports.

**Inequitable Conduct**

Judge Stark also agreed that Illumina should not be able to argue that there was inequitable conduct during prosecution of the patents related to LDR-PCR.

*Appendix J*

**Akin Gump**  
STRAUSS HAUER & FELD LLP

**ATTORNEY CLIENT PRIVILEGED**

Francis Barany and Coinventors

Francis Barany, George Barany, Robert Hammer, Maria Kempe, Matthew Lubin, and Monib Zirvi

January 13, 2017

Page 2

To review, Illumina sought to add a defense that the LDR-PCR patents are unenforceable because of alleged inequitable conduct by the inventors and attorneys during prosecution of the patents. The sole basis for Illumina's claim was that a declaration filed during prosecution allegedly stated that the invention had been reduced to practice before a certain date, and that was not true. We argued that the declaration is, at worst, ambiguous, and that, in light of the other evidence showing that the inventors and prosecuting attorneys did not intend to deceive the Patent Office, Illumina would never be able to show that there was inequitable conduct.

A few months ago Magistrate Judge Thyngre recommended that Illumina be permitted to amend its Answer to raise the inequitable conduct defense.

On Tuesday, Judge Stark rejected Magistrate Judge Thyngre's recommendation and agreed with Cornell that, based on the evidence Illumina presented, Illumina would not be able to prove that the inventors or attorneys committed inequitable conduct. Accordingly, Judge

*Appendix J*

Stark dismissed Illumina’s motion and the question of inequitable conduct is no longer a part of the case.

We were very pleased with Judge Stark’s ruling—he essentially agreed that Illumina’s evidence that the prosecuting attorneys and inventors deceived the Patent Office was so insufficient that it would be futile for Illumina even to be permitted to raise inequitable conduct as a possible defense.

\* \* \*

We do not expect that any of the above will significantly change the existing schedule/plans, and we will proceed as previously discussed. There is nothing that requires anyone’s immediate attention, but we will be in touch over the coming months to the extent we need assistance in our trial preparation.

**APPENDIX K — Federal Rule of Appellate  
Procedure 28(j) Letters submitted to the United  
States Court of Appeals for the Third Circuit,  
filed September 2, 2025**

Case No. 24-2644

IN THE UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

MONIB ZIRVI, M.D., Ph.D.,

*Plaintiff-Appellant,*

v.

ILLUMINA, INC., *et al.*,

*Defendants-Appellees.*

**Rule 28(j) Letter**

Submitted via CM/ECF  
Date: September 2, 2025

Honorable Patricia S. Dodszuweit  
Clerk of Court  
United States Court of Appeals for the Third Circuit  
21400 U.S. Courthouse  
601 Market Street  
Philadelphia, PA 19106

Dear Ms. Dodszuweit:

Pursuant to FRAP Rule 28(j), Appellant submits  
the Third Circuit's precedential decision in *Johnson v.*

*Appendix K*

*Mazie*, Nos. 24-1946 & 24-2056 (3d Cir. July 11, 2025), the USDOJ’s July 31, 2025, announcement of a \$9.8 million False Claims Act settlement in *United States ex rel. Lenore v. Illumina Inc.*, No. 1:23-cv-00372 (D.R.I.), and the Verified Amended Stockholder Derivative Complaint in *Pavers & Road Builders Benefit Funds v. DeSouza*, C.A. No. 2024-1337 (Del. Ch. Aug. 18, 2025) as supplemental authorities.

In *Johnson*, this Court reaffirmed that the judiciary’s inherent authority to sanction attorney misconduct “survives” jurisdictional or Rule 12 dismissals because sanctions are a collateral issue the court is duty-bound to address. Slip op. at 12 (quoting *Willy v. Coastal Corp.*, 503 U.S. 131, 138 (1992)). The decision confirms this duty is non-discretionary; ignoring misconduct is error.

The District Court dismissed without addressing record evidence that Akin Gump—despite undisclosed, unwaivable conflicts—concealed material agreements and misused privilege to shield malpractice. Under *Johnson*, that omission requires remand for sanctions investigation to preserve the integrity of this Court’s process.

The USDOJ’s July 2025 settlement and the Verified Stockholder Complaint show Illumina’s misrepresentations in government agency filings lead to serious repercussions. These filings independently corroborate Appellant’s allegations of systemic concealment. Akin Gump’s orchestration of the 2017 settlement, central to inventorship and royalty rights, unjustly absolved Illumina.

*Appendix K*

Three acts require sanctions review:

1. Appellees quoted from a February 21, 2017 email (A-595) but excluded the sentence, “Akin Gump did an excellent job of representing you,” thereby denying the attorney-client relationship acknowledged in writing.
2. On October 31, 2015 (ECF 107-7 at 192–93), Dr. Zirvi emailed Matthew Pearson stating, “As my attorney, this communication is protected by Attorney-Client Privilege.” Pearson, who promised “interests were aligned,” never disclaimed that representation.
3. Akin Gump misrepresented about the First Amendment Agreement and withheld production of the secret 2017 settlement – both dispositive to inventorship and royalty rights.

*Johnson* removes any procedural shield. Remand is necessary to affirm that calculated abuse of privilege, concealment of material evidence, and distortion of the record will not be tolerated in the Third Circuit.

Respectfully submitted,

/s/ Joseph D. Garrity  
Joseph D. Garrity

*Appendix K*

LORIUM LAW  
101 NE 3rd Avenue, Suite 1800  
Fort Lauderdale, FL 33301  
Tel: (954) 859-6600  
Email: [jgarrity@loriumlaw.com](mailto:jgarrity@loriumlaw.com)  
Counsel for Plaintiff-Appellant Dr. Monib Zirvi

[CERTIFICATE INTENTIONALLY OMITTED]

## Appendix K

LAW OFFICES  
WILLIAMS & CONNOLLY LLP  
725 TWELFTH STREET, N.W.  
WASHINGTON, D. C. 20005-5901  
(202) 434-5000  
FAX (202) 434-5029

DAVID RANDALL J. RISKIN  
(202) 434-5789  
[driskin@wc.com](mailto:driskin@wc.com)

EDWARD BENNETT WILLIAMS  
(1920-1988)  
PAUL R. CONNOLLY (1922-1978)

September 5, 2025

## VIA ECF

Patricia S. Dodszuweit, Clerk of Court  
United States Court of Appeals  
for the Third Circuit  
21400 United States Courthouse  
601 Market Street  
Philadelphia, PA 19106-1790

Re: *Zirvi v. Illumina, Inc.*, No. 24-2644

Dear Ms. Dodszuweit:

The authorities Dr. Monib Zirvi offers in his Rule 28(j) letter (ECF 43) have no bearing on this appeal, and his letter is procedurally improper for multiple reasons.

None of the settlement in *United States ex rel. Lenore v. Illumina, Inc.*, No. 23-cv-00372 (D.R.I.), the complaint in *Pavers & Road Buildings Benefit Funds v. DeSouza*,

*Appendix K*

No. 2024-1337 (Del. Ch. Aug. 18, 2025), or *Johnson v. Mazie*, 144 F. 4th 146 (3d Cir. 2025), addresses any of the issues the appeal presents. That much is plain from the fact Zirvi does not (as he must) “refer[] . . . to the page of [his] brief” to which the supplemental citations purportedly relate. Fed. R. App. P. 28(j).

Neither the settlement in *Lenore* nor the complaint in *Pavers* are legal authority (or, indeed, even admissible evidence). And Zirvi’s assertion that *Lenore* and *Pavers* involve “systematic concealment” by Illumina Inc. is irrelevant given that Zirvi dropped his claims against Illumina in exchange for Illumina forgoing its sanctions motion against him (A-30), as well as because those actions had nothing to do with the *Cornell v. Illumina* case on which Zirvi’s malpractice theory rests (ECF 33 at 14).

The only legal authority Zirvi offers, *Johnson*, held that a district court must resolve a collateral sanctions motion before entering a final judgment on the merits. 144 F.4th at 150. Here, however, Zirvi filed no sanctions motion against Akin, rendering *Johnson* inapplicable. (If Zirvi’s theory is that his malpractice claim against the firm was a “sanctions motion,” the district court considered and rejected it on multiple bases when the court dismissed it with prejudice.) Zirvi also is wrong on the facts and in suggesting any “sanctionable” conduct occurred.

Nothing in Zirvi’s letter is relevant to the issues in dispute, let alone a “pertinent and significant authorit[y].” Certainly none of *Lenore*, *Pavers*, or *Johnson* remedy Zirvi’s failure to address dispositive aspects of the district

*Appendix K*

court's decision below, and the Court can affirm the district court based on forfeiture alone. (ECF 33 at 1–2.) Or the Court can affirm the district court for the multiple merits reasons Akin detailed.

Respectfully submitted,

/s/ David Randall J. Riskin

David Randall J. Riskin  
*Counsel for Akin Gump Strauss  
Hauer & Feld LLP, Matthew A.  
Pearson, and Angela Verrecchio*

*Appendix K*

Case No. 24-2644

IN THE UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

MONIB ZIRVI, M.D., Ph.D.,

*Plaintiff-Appellant,*

v.

ILLUMINA, INC., *et al.*,

*Defendants-Appellees.*

**Rule 28(j) Letter Clarification**

Submitted via CM/ECF  
Date: September 5, 2025

Honorable Patricia S. Dodszuweit  
Clerk of Court  
United States Court of Appeals for the Third Circuit  
21400 U.S. Courthouse  
601 Market Street  
Philadelphia, PA 19106

Dear Ms. Dodszuweit:

Pursuant to FRAP 28(j), Appellant clarifies that the supplemental authorities cited in ECF 44 relate directly to Appellees' arguments at ECF 33 pp. 32–33,

*Appendix K*

where Appellees contend no attorney-client relationship existed and deny misconduct. *Johnson v. Mazie*, Nos. 24-1946 & 24-2056 (3d Cir. July 11, 2025), confirms the District Court was required to resolve collateral issues of misconduct raised by the record, including A-595 and ECF 107-7, before entering judgment. This authority supports Appellant's position that claim preclusion does not bar malpractice claims and the reasonable belief of the existence of an implied attorney-client relationship. See Appellant's Opening Brief (ECF 27) at pp. 28-29 and Reply Brief (ECF 36) at pp. 12-15. False Claims Act settlement in *United States ex rel. Lenore v. Illumina Inc.*, No. 1:23-cv-00372 (D.R.I.), and the Verified Amended Stockholder Derivative Complaint in *Pavers & Road Builders Benefit Funds v. DeSouza*, C.A. No. 2024-1337 (Del. Ch. Aug. 18, 2025) corroborate Appellant's allegations of systemic concealment already briefed, demonstrating why sanctions review and remand are warranted. See ECF 27 at pp. 14, 17, 22-23, 28; ECF 36 at pp. 4-6, 9-11, 15.

Respectfully submitted,

/s/ Joseph D. Garrity  
Joseph D. Garrity