

Case IPR2016-00820
U.S. Patent No. 7,064,197

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLOGIC, INC.,
Petitioner

v.

ENZO LIFE SCIENCES, INC.,
Patent Owner

Case IPR2016-00820

U.S. Patent No. 7,064,197
TITLE: SYSTEM, ARRAY AND NON-POROUS SOLID SUPPORT
COMPRISING FIXED OR IMMOBILIZED NUCLEIC ACIDS
Issue Date: June 20, 2006

**ENZO'S UNOPPOSED MOTION FOR *PRO HAC VICE* ADMISSION OF
KERRI-ANN LIMBEEK**

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S EXHIBIT LIST

Enzo Exhibit No.	DESCRIPTION
2001	Declaration of Gregory Buck, Ph.D.
2002	Declaration of Dollie M.W. Kirtikar, Ph.D., submitted in U.S. Patent App. No. 08/486,070 (Oct. 28, 2003).
2003	Robberson, D. L. and Davidson, N., <i>Biochemistry</i> 11, 533 (1972).
2004	Schott, Herbert, "Special Methods for the Immobilization of RNA and Polyribonucleotides," in <i>Affinity Chromatography</i> , Chromatographic Science Series, Vol. 27 (allegedly 1984).
2005	Petitioner's Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,064,197 in Case IPR2016-00822.
2006	Anish Desai, Christopher Marando, & Amanda Do Couto, <i>PTAB Approaches To Accessibility Of Printed Publication</i> , LAW360 (Oct. 3, 2016), http://www.law360.com/articles/845934/print?section=ip .
2007	Michael R. Weiner, <i>APJs Dispute Requirements for a Reference to Qualify as a Printed Publication</i> , PTABWATCH (Oct. 15, 2015), http://www.ptabwatch.com/2015/10/apjs-dispute-requirements-for-a-reference-to-qualify-as-a-printed-publication .
2008	Affidavit of Michael P. Stadnick.
2009	Affidavit of Justin P.D. Wilcox.
2010	Affidavit of Kerri-Ann Limbeek.
2011	Herzer, Sibylle and Englert, David, "Nucleic Acid Hybridization," Ch. 14 from <i>Molecular Biology Problem Solver: A Laboratory Guide</i> (Gerstein, Alan ed.) (2001).
2012	Spiegelman, George <i>et al.</i> , "Kinetics of Ribonucleic Acid-Deoxyribonucleic Acid Membrane Filter Hybridization," <i>Biochemistry</i> , Vol. 12, No. 6, 1234-1242 (1973).
2013	Söderlund, H., "DNA Hybridization: Comparison of Liquid and Solid Phase Formats," <i>Ann. Biol. Clin.</i> , 48, 489-491 (1990).
2014	Reed, Ken and Mann, David, "Rapid Transfer of DNA From Agarose Gels to Nylon Membranes," <i>Nucleic Acid Research</i> , Vol. 13, No. 20, 7207-7221 (1985).
2015	Kahn, Michael, "The Effect of Thymine Dimers on DNA: DNA Hybridization," <i>Biopolymers</i> , Vol. 13, 669-675 (1974).
2016	Smith, G.L.F. <i>et al.</i> , "'Reverse' DNA Hybridization Method for the

Enzo Exhibit No.	DESCRIPTION
	Rapid Identification of Subgingival Microorganisms,” Oral Microbiology Immunology, 4: 141-145 (1989).
2017	Deposition Transcript of Norman Nelson, Ph.D., taken in <i>Hologic, Inc., v. Enzo Life Sciences, Inc.</i> , IPR Case Nos. 2016-00820 and 2016-00822 on Dec. 21, 2016.
2018	Meinkoth, Judy and Wahl, Geoffrey, “Review: Hybridization of Nucleic Acids Immobilized on Solid Supports,” Analytical Biochemistry, 138, 267-284 (1984).
2019	U.S. Patent Application Publication No. US2016/0017392 to Arnold <i>et al.</i> , published Jan. 21, 2016.
2020	<i>Excerpt from</i> File History for U.S. Patent No. 7,064,197 – June 30, 2004 Amendment.
2021	<i>Excerpt from</i> File History for U.S. Patent No. 7,064,197 – May 25, 2005 Amendment.
2022	Diagram of Cell Structure, obtained from: http://training.seer.cancer.gov/anatomy/cells_tissues_membranes/cells/structure.html .
2023	<i>Excerpt from</i> File History for U.S. Patent No. 7,064,197 – Nov. 26, 2004 Office Action.
2024	U.S. Patent No. 4,732,847 to Stuart <i>et al.</i> , issued Mar. 22, 1988.
2025	Sigma-Aldrich Particle Size Conversion Table, obtained from: http://www.sigmaaldrich.com/chemistry/stockroom-reagents/learning-center/technical-library/particle-size-conversion.html .
2026	Whatling, Carl <i>et al.</i> , “Expression Microarrays,” Ch. 2 from <i>Microarrays & Microplates – Applications in Biomedical Sciences</i> (Ye, S. and Day, I.N.M. eds.) (2003).
2027	Enzo Biochem, Inc. SEC Form 8-K dated July 20, 2015.
2028	Enzo Biochem, Inc. SEC Form 8-K dated Oct. 9, 2015.
2029	Enzo Biochem, Inc. SEC Form 8-K dated Jan. 6, 2016.
2030	Enzo Biochem, Inc. SEC Form 8-K dated July 1, 2016.

Enzo Exhibit No.	DESCRIPTION
2031	Plaintiff's Supplemental Infringement Charts for Siemens Healthcare Diagnostics, served on Sept. 30, 2014 in C.A. No. 12-cv-505-LPS (D. Del.) (cover pleading only).
2032	Plaintiff's Supplemental Infringement Charts for Affymetrix, served on Sept. 30, 2014 in C.A. No. 12-cv-433-LPS (D. Del.) (cover pleading only).
2033	Plaintiff's Supplemental Infringement Charts for Agilent Technologies, served on Sept. 30, 2014 in C.A. No. 12-cv-434-LPS (D. Del.) (cover pleading only).
2034	Plaintiff's Supplemental Infringement Charts for Illumina, served on Sept. 30, 2014 in C.A. No. 12-cv-435-LPS (D. Del.) (cover pleading only).
2035	Enzo "Invention Record and Report," Barbara Thalenfeld and Kenneth Johnston (May 1982).
2036	Weetall, H.H. and Filbert, A.M., "Porous Glass for Affinity Chromatography Applications," from <i>Methods in Enzymology, Volume XXXIV, Affinity Techniques, Enzyme Purification: Part B</i> (Jakoby, W. and Wilchek, M. eds.) (1974).
2037	Enzo Laboratory Notebook, Dollie M.W. Kirtikar, entitled "T4 Expts," (1982).
2038	Enzo Laboratory Notebook (Number 126), Barbara Thalenfeld, (July-August 1982).
2039	Enzo Laboratory Notebook (Number 127), Barbara Thalenfeld, (July-September 1982).
2040	Enzo Experiment Record, Barbara Thalenfeld and Kenneth Johnston, (June 1982).
2041	Enzo Laboratory Notebook Pages, Barbara Thalenfeld, (May-August 1982).
2042	Declaration of Gregory Buck, Ph.D.
2043	Declaration of Barry Weiner.

I. RELIEF REQUESTED

Patent Owner Enzo Life Sciences, Inc. (“Enzo”) hereby respectfully moves the Patent Trial and Appeal Board for the *pro hac vice* admission of Kerri-Ann Limbeek as back-up counsel for Enzo in Case IPR2016-00820. Enzo has conferred with counsel for Petitioner, who confirmed that Petitioner does not oppose this motion.

II. GOVERNING LAW, RULES, AND PRECEDENT

Under 37 C.F.R. § 42.10(c),

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.

The Patent Trial and Appeal Board established its current procedure for moving for *pro hac vice* admission in *inter partes* reviews in *Unified Patents, Inc. v. Parallel Iron LLC*, Case IPR2013-00639, Paper 7 (“Order – Authorizing Motion For *Pro Hac Vice* Admission – 37 C.F.R. § 42.10”) (PTAB Oct. 15, 2013). Specifically, a motion for *pro hac vice* admission must 1) be filed no sooner than

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.