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

<u>MANDATORY NOTICES FOR PATENT OWNER</u> <u>ENZO LIFE SCIENCES, INC.</u>

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<u>MANDATORY NOTICES FOR PATENT OWNER</u> <u>ENZO LIFE SCIENCES, INC.</u>

Patent Owner Enzo Life Sciences, Inc. hereby files its mandatory notices pursuant to 37 C.F.R. § 42.8. These notices are being timely filed within 21 days of service of the Petition, which service occurred on March 30, 2016.

I. REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(b)(1))

The real party-in-interest for the Patent Owner is Enzo Life Sciences, Inc. ("Enzo" or "Patent Owner").

II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))

A. Judicial Matters

The following district court litigations may affect, or be affected by, a decision in these proceedings: *Enzo Life Sciences, Inc.* v. *Hologic, Inc.*, Civil Action No. 1:15-cv-271 (D. Del.); *Enzo Life Sciences, Inc. v. Siemens Healthcare Diagnostics, Inc.*, Civil Action No. 1:12-cv-505 (D. Del.); *Enzo Life Sciences, Inc.* v. *Affymetrix, Inc.*, Civil Action 1:12-cv-433 (D. Del.); *Enzo Life Sciences, Inc. v. Affymetrix, Inc.*, Civil Action 1:12-cv-433 (D. Del.); *Enzo Life Sciences, Inc. v. Agilent Technologies Inc.*, Civil Action No. 1:12-cv-434 (D. Del.); *Enzo Life Sciences, Inc. v. Abbott Laboratories et al.*, Civil Action No. 1:12-cv-274 (D. Del.); *Enzo Life Sciences, Inc. v. Becton Dickinson and Company et al.*, Civil Action 1:12-cv-105 (D. Del.); *Enzo Life Sciences, Inc. v. Life Technologies Corp.*, 1:12-cv-105 (D.

Case IPR2016-00820 U.S. Patent No. 7,064,197 Del.); and *Enzo Life Sciences, Inc. v. Roche Molecular Systems Inc. et al.*, Civil

Action No. 1:12-cv-106 (D. Del.).

B. Administrative Matters

The following inter partes reviews may affect, or be affected by, a decision

in this proceeding: U.S. Patent No. 7,064,197 is the subject of Case IPR2016-

00822, in which the Petitioner is Hologic, Inc.

III. DESIGNATION OF LEAD AND BACK-UP COUNSEL (37 C.F.R. § 42.8(b)(3))

Patent Owner hereby designates the following lead counsel and back-up

counsel:

- 1. Kevin K. McNish Reg. No. 65,047 (Lead Counsel) Direct Dial: 212-808-2954
- 2. Michael P. Stadnick Pro Hac Vice forthcoming (Back-up Counsel)
- 3. Justin P.D. Wilcox *Pro Hac Vice* forthcoming (Back-up Counsel)
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IV. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))

Please direct all correspondence regarding this proceeding to Lead Counsel at the address listed above. Patent Owner also consents to electronic service by email to EnzoIPRService@desmaraisllp.com, kmcnish@desmaraisllp.com, mstadnick@desmaraisllp.com, and jwilcox@desmaraisllp.com.

V. PATENT OWNER PRELIMINARY RESPONSE

Patent Owner reserves the right to file a preliminary response at a later date pursuant to 37 C.F.R. § 42.107.

Dated: April 20, 2016

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Respectfully submitted,

<u>/kkm/</u> Kevin K. McNish (Reg. No. 65,047) kmcnish@desmaraisllp.com DESMARAIS LLP 230 Park Avenue New York, NY 10169 Telephone: 212-351-3400 Facsimile: 212-351-3401

Lead Counsel for Patent Owner Enzo Life Sciences, Inc.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 20, 2016, a complete copy of the foregoing was served on counsel of record for the Petitioner by filing this document through the Patent Review Processing System and by sending this document via electronic mail to the following addresses:

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