

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**HOLOGIC, INC.,
Petitioner**

v.

**ENZO LIFE SCIENCES, INC.,
Patent Owner**

Case IPR2016-00822

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

DECLARATION OF BARRY W. WEINER

I, Barry W. Weiner, a resident of New York, New York over 18 years of age, hereby declare as follows:

1. I have personal knowledge of all of the matters about which I testify in this declaration.

2. I am currently a Vice President of Enzo Life Sciences, Inc. (“Enzo”) and have been the President of its parent company, Enzo Biochem, Inc., since 1996. From 1976 until 1996 I was a Vice President of Enzo Biochem, Inc. As Vice President, I was responsible for managing the operations of Enzo, and I was aware of Enzo’s program to develop technologies involving nucleic acid hybridization and detection using non-porous solid supports in the early 1980s.

3. During the period spanning January of 1982 to September of 1982, I was knowledgeable about the research and development activities of Enzo scientists Dollie Kirtikar, Ph.D., Barbara Thalenfeld, Ph.D., Elazar Rabbani, Ph.D., Jannis Stavrianopoulos, Ph.D., and Kenneth Johnston, Ph.D.—the co-inventors identified on U.S. Patent No. 7,064,197 (“the ‘197 Patent”). I will hereinafter refer to those particular scientists collectively as “the Co-Inventors”. During that period, Dr. Rabbani was Chief Executive Officer of Enzo Biochem and each of the other Co-Inventors was an employee of Enzo Biochem.

4. From January of 1982 to September of 1982, the Co-Inventors conducted research and development activities related to nucleic acid hybridization

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and detection in Enzo BioChem's facility located at 325 Hudson Street, New York, New York, 10113. Among the research and development activities conducted by the Co-Inventors were efforts to develop technologies involving nucleic acid hybridization and detection using non-porous solid supports. Those efforts resulted in the inventions that are now claimed in the '197 Patent.

5. During the period from January of 1982 to September of 1982, it was the regular practice of all Enzo scientists to keep laboratory notebooks that recorded the procedures and results of the experiments they performed. Each entry in those laboratory notebooks was made at or near the time of the experiment and was recorded by the Enzo scientists performing or overseeing the experiment. Each entry in those laboratory notebooks was made in the course of Enzo's regularly conducted activities, namely research and development of nucleic acid technologies.

6. The Co-Inventors followed this regular practice of recording their research and development activities regarding nucleic acid hybridization and detection technology using non-porous solid supports (that led to the inventions of the '197 Patent) in laboratory notebooks and other documents. Among those laboratory notebooks and other documents are Exhibits 2135 and 2137-2141 attached to this Declaration.

7. Since at least January 1982, Enzo has maintained the laboratory notebooks of Enzo scientists in the ordinary course of business, storing those laboratory notebooks at Enzo facilities.

8. Exhibits 2135 and 2137-2141 are documents, including lab notebooks of certain Co-Inventors, that were created in 1982 and stored at either Enzo's facilities or its counsel's office since that time. Those exhibits were provided to Enzo's counsel in connection with an on-going litigation regarding the '197 Patent in approximately August of 2013.

9. Exhibit 2135 is true and correct copy of "Invention Record and Report for the '469 Application" made by Barbara Thalenfeld and Kenneth Johnston, who had knowledge of the research and development activities described therein, at or near the time those activities took place in February through May of 1982. Exhibit 2135 is an invention record and report kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2135 was a regular practice of Enzo and its scientists in connection with regularly conducted research and development activities.

10. Exhibit 2137 is true and correct copy of a laboratory notebook made by Dollie Kirtikar, who had knowledge of the experiments described therein, at or near the time those experiments took place in May through August of 1982. Exhibit 2137 contains Dollie Kirtikar's laboratory notebook records which were

recorded in a binder entitled “T4 Expts” behind a tab entitled “Lectin Binding to t4 DNA.” Exhibit 2137 contains laboratory notebook records kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2137 was a regular practice of Enzo and its scientists in connection with regularly conducted research and development activities.

11. Some of the pages of Exhibit 2137 included records that were folded or stapled to the handwritten pages. In order to provide a full view of the information contained on each page, multiple copies of these pages are provided so that all data and information can be observed.

12. Exhibit 2138 is true and correct copy of a laboratory notebook made by Barbara Thalenfeld, who had knowledge of the experiments described therein, at or near the time those experiments took place in July through August of 1982. Exhibit 2138 contains laboratory notebook records kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2138 was a regular practice of Enzo and its scientists in connection with regularly conducted research and development activities.

13. Some of the pages of Exhibit 2138 included records that were folded or stapled to the handwritten pages. In order to provide a full view of the information contained on each page, multiple copies of these pages are provided so that all data and information can be observed. *See e.g.* Exhibit 2138 at 10-12.

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