

Case IPR2016-00822
U.S. Patent No. 7,064,197

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLOGIC, INC., and BECTON, DICKINSON AND COMPANY,
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

ENZO'S MOTION TO EXCLUDE EVIDENCE

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I. INTRODUCTION

Patent Owner Enzo Life Sciences, Inc. (“Patent Owner” or “Enzo”) moves to exclude certain paragraphs of and the Attachment to Petitioner’s Exhibit 1037—a declaration submitted by Petitioner’s back-up counsel (hereinafter also referred to as “declarant”) in support of Petitioner’s reply—under Federal Rule of Evidence (“FRE”) 602 because the declarant lacks the requisite personal knowledge of the matters in those paragraphs and the Attachment. In that declaration, Petitioner’s back-up counsel attempted to authenticate a laboratory protocol—mentioned but not described or detailed in the 2001 Diehl reference itself—that is supposedly currently available on a website. Petitioner’s back-up counsel testified, among other things, that the laboratory protocol described in a website printout that she made on April 5, 2017 (attached as Attachment A to her declaration), is purportedly the same protocol identified in the 2001 Diehl reference. (Ex. 1037 ¶¶ 3, 5, Attachment A; *see also* Ex. 1032.) But Petitioner’s back-up counsel fails to provide any testimony that would establish she has personal knowledge of the laboratory protocol or that it is the same protocol cited in the 2001 Diehl article. Based upon that lack of personal knowledge, paragraphs 3 and 5 and Attachment A of her declaration should be excluded under FRE 602.

Pursuant to 37 C.F.R. § 42.64(c), Enzo confirms that the bases for this motion to exclude were timely raised in Enzo's objections to evidence filed on April 12, 2017. (Paper 35.)

II. BACKGROUND

Petitioner relies on the 2001 Diehl reference to argue that one of its primary anticipation references—the 1981 Fish reference—inherently discloses a nucleic acid strand in “hybridizable form” attached to a PLL coated support. (Petition, 23-25.) But Diehl does not disclose or detail the laboratory protocol used to prepare PLL coated slides in the purported hybridization experiments discussed in the reference. (Ex. 1021, 1) In comparing the disclosure in Fish to the laboratory protocol allegedly used in the Diehl reference, Petitioner and its expert, Dr. Norman Nelson, rely upon Exhibit 1032, a purported website printout of a laboratory protocol. (Petition, 23-24 (citing Ex. 1002 ¶¶ 58, 59 (citing Ex. 1032 and Ex. 1033)); Petitioner Reply, 7 n. 1 (“*See* Ex. 1037 addressing Enzo’s concern about Ex.1032.”).) Petitioner’s expert, Dr. Nelson, alleges that the printout marked as Exhibit 1032 is the laboratory protocol cited in the 2001 Diehl reference and lists the web address where it was purportedly accessed as http://cmgm.stanford.edu/pbrown/protocols/1_slides.html. (Ex. 1002 ¶ 58 (citing Ex. 1021, 1).) However, Diehl cites a different web address for the laboratory

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