

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

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

Case IPR2016-00820

U.S. Patent No. 7,064,197

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 2035 and 2037-2041 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 2035 and 2037-2041 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 2035 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 2035 is an invention record and report kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2035 was a regular practice of Enzo and its scientists in connection with regularly conducted research and development activities.

10. Exhibit 2037 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 2037 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 2037 contains laboratory notebook records kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2037 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 2037 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 2038 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 2038 contains laboratory notebook records kept by Enzo in the ordinary course of regularly conducted research and development activities. The preparation of Exhibit 2038 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 2038 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 2038 at 10-12.

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.