

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLOGIC, INC.,)	
)	
Petitioner,)	
)	
vs.)	Case IPR2016-00820
)	Case IPR2016-00822
ENZO LIFE SCIENCES, INC.,)	
)	
Patent Owner.)	
_____)	

CONFIDENTIAL - ATTORNEYS' EYES ONLY

VIDEO DEPOSITION OF NORMAN NELSON, PH.D.
WEDNESDAY, DECEMBER 21, 2016
SAN DIEGO, CALIFORNIA

REPORTED BY:
LISA MOSKOWITZ
CA-CSR 10816, RPR, CRR, CLR
Job No. 17750

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1 Video deposition of NORMAN NELSON, PH.D.,
 2 taken before Lisa Moskowitz, a Certified Shorthand
 3 Reporter for the State of California, Registered
 4 Professional Reporter, Certified Realtime Reporter,
 5 Certified LiveNote Reporter, NCRA Realtime Systems
 6 Administrator, commencing at 9:09 a.m. on Wednesday,
 7 December 21, 2016, in the offices of Hologic, Inc.,
 8 at 10210 Genetic Center Drive, San Diego, California.
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1 APPEARANCES
 2
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 10 the 820 IPR
 11 1002 Declaration of Dr. Norman Nelson in 200
 12 the 822 IPR
 13 1006 Article Titled "A Sensitive Solid 50
 14 Phase Microradioimmunoassay for
 15 Anti-Double Stranded DNA Antibodies
 16 1007 Article Titled "Nucleic Acid 215
 17 Hybridization Using DNA Covalently
 18 Coupled to Cellulose"
 19 1008 Article Titled "In Situ 160
 20 Hybridization of DNA Sequences in
 21 Human Metaphase Chromosomes
 22 Visualized by an Indirect
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 3 1028 Article Titled "Effects of 215
 4 Mobilization on the Kinetics of
 5 Enzyme-Catalyzed Reactions. I.
 6 Glucose Oxidase in a Recirculation
 7 Reactor System
 8 2019 U.S. Patent Application Number 238
 9 2016/0017392
 10 2119 U.S. Patent Application Number 238
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1 SAN DIEGO, CALIFORNIA, WEDNESDAY, DECEMBER 21, 2016
 2 9:09 A.M.
 3
 4 THE VIDEOGRAPHER: Good morning.
 5 This is tape number 1 of the videotaped
 6 deposition of Dr. Norman Nelson in the
 7 matter of Hologic, Incorporated versus Enzo
 8 Life Sciences, Incorporated, in the United
 9 States Patent and Trademark Office, Case
 10 Number IPR2016-00820. This deposition is
 11 being held at 10210 Genetic Center Drive,
 12 San Diego, California on December 21, 2016,
 13 at 9:09 a.m.
 14 My name is Marina Hernandez from the
 15 firm of TransPerfect Legal Solutions, and I
 16 am the legal video specialist. The court
 17 reporter is Lisa Moskowitz in association
 18 with TransPerfect Legal Solutions.
 19 Will counsel please introduce
 20 themselves.
 21 MR. STADNICK: Michael Stadnick from
 22 the Desmarais law firm, representing Enzo,
 23 and with me here today is Kerri-Ann
 24 Limbeek.
 25 MR. BARKER: Paul Barker from

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1 Finnegan, representing Hologic. I'm here
 2 with Arpita Bhattacharyya, who's also from
 3 Finnegan, and Chuck Cappellari, in-house at
 4 Hologic.
 5 THE VIDEOGRAPHER: Thank you. Will
 6 the court reporter please swear in the
 7 witness.
 8
 9 NORMAN NELSON, PH.D.,
 10 called as a witness,
 11 was examined and testified as follows:
 12
 13 THE REPORTER: And Counsel, just to
 14 let you know, I can already tell I need
 15 everybody way louder than when you
 16 introduced yourselves. Thank you.
 17 MR. STADNICK: Before we begin, I
 18 just want to note for the record I believe
 19 the IPR caption you read in was just for
 20 the 820-case, but we're here today jointly
 21 in both IPR2016-00820 and IPR2016-00822.
 22 Agreed?
 23 MR. BARKER: That's correct.
 24 ///
 25 ///

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EXAMINATION

1 BY MR. STADNICK:
 2
 3 Q Okay. Good morning, Dr. Nelson.
 4 A Good morning.
 5 Q Can we begin by having you state
 6 your full name for us?
 7 A Norman C. Nelson.
 8 Q Where do you live?
 9 A San Diego, California.
 10 Q What do you do for a living?
 11 A I'm a consultant in biotechnology.
 12 Q You understand that you're here
 13 today to provide sworn testimony in some patent
 14 office proceedings involving a patent owned by
 15 my client Enzo; correct?
 16 A Yes.
 17 Q You understand there are two
 18 separate patent office proceedings currently?
 19 A Yes.
 20 Q One is, we just mentioned a few
 21 moments ago, is IPR2016-820, which we'll call
 22 the 820 IPR, if that's okay with you?
 23 A Yes.
 24 Q And the other one is IPR2016-822,
 25 which we'll call the 822 IPR. Is that fair?

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1 A Yes.
 2 Q I'm going to mark a number of the
 3 exhibits here today, and in most cases, the
 4 exhibits will bear the same number in both of
 5 those IPR proceedings. If there's any reason to
 6 deviate from that process, I'll let you know,
 7 but otherwise, you can assume that the exhibit
 8 I'm giving you is an exhibit in both
 9 proceedings. Fair?
 10 A Yes.
 11 Q You understand that the two IPR
 12 proceedings we're here in connection with today,
 13 the 820 and the 822, involve one of Enzo's
 14 United States patents which is number 7,064,197
 15 or the '197 patent; correct?
 16 A Yes.
 17 Q You've been hired by Hologic to
 18 offer certain opinions concerning the validity
 19 of the '197 patent. True?
 20 A I'm not sure I'm offering validity
 21 of the patent in regards to if that's a legal
 22 determination. I'm here as an expert witness in
 23 the field.
 24 Q You've been hired by Hologic to
 25 offer opinions as to whether certain pieces of

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1 prior art anticipate or are obvious in Enzo's
 2 '197 patent; correct?
 3 A Correct.
 4 Q In connection with your work for
 5 Hologic on these IPR matters, you submitted two
 6 declarations in support of petitions for
 7 institutions of IPR proceedings; correct?
 8 A Correct.
 9 Q I think you submitted both of those
 10 petitions back in March of 2016.
 11 Does that sound right?
 12 A That is correct. Whether it was
 13 March or they were submitted early April, I'm
 14 not sure, but that is the correct time frame.
 15 Q Let's just say first half of 2016.
 16 You submitted your declarations in connection
 17 with these IPR proceedings in the first half of
 18 this year; right?
 19 A Correct.
 20 Q Since that time, has anything come
 21 to your attention that's contained in either of
 22 those declarations that you want to change or
 23 you've come to realize is incorrect.
 24 A No.
 25 Q Have you ever had your deposition

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1 taken before?
 2 A Yes.
 3 Q How many times?
 4 A Twice before.
 5 Q Without getting into the details of
 6 the matters, could you give me some indication
 7 of what your role was in each of those prior
 8 depositions?
 9 A I believe it's called just a fact
 10 witness where I was giving testimony to the
 11 facts in regards to the scientific nature of
 12 those two cases.
 13 Q How long ago were those two
 14 depositions?
 15 A I don't recall exactly, but
 16 somewhere between 10 and 15 years ago. Although
 17 I do not recall exactly.
 18 Q Is it fair to say that your prior
 19 deposition testimony as a fact witness related
 20 to your employment at Gen-Probe?
 21 A To the best of my recollection, that
 22 is correct.
 23 Q Do you recall if the prior
 24 depositions that you provided 10 to 15 years ago
 25 in connection with your work at Gen-Probe

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1 related to patent infringement litigation?
 2 A I believe they were in regards to
 3 patents. I don't recall if it was an
 4 infringement case.
 5 Q Did any of your testimony in either
 6 of your two prior depositions while you were
 7 employed at Gen-Probe relate in any way to the
 8 technology that's at issue in your analysis for
 9 the purposes of these IPR proceedings?
 10 A I don't recall precisely, but I
 11 don't believe so.
 12 Q So you do understand that you're
 13 testifying under oath here today; correct?
 14 A Yes.
 15 Q You understand that your testimony
 16 here today is under oath in the same way it
 17 would be if you were testifying in a court
 18 proceeding. Fair?
 19 A Yes.
 20 Q There's a court reporter here who's
 21 going to be making a written transcript of our
 22 questions and answers.
 23 Do you understand that?
 24 A Yes.
 25 Q There's a videographer here who's

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1 taking a video of the proceedings.
 2 You're aware of that; correct?
 3 A Yes.
 4 Q Is there any reason you can think of
 5 why you're unable today to provide full and
 6 accurate testimony in response to my questions?
 7 A No.
 8 Q I have a bit of a cold; so if I'm
 9 too quiet and you can't hear one of my questions
 10 or for any other reason you think that one of my
 11 questions doesn't make sense or you're not sure
 12 you understand what I'm asking you, I'd
 13 appreciate it if you'd let me know; so we can
 14 have a clear record.
 15 Does that sound fair?
 16 A Yes.
 17 Q And finally, to have a clear record,
 18 it's important that you and I make a concerted
 19 effort to try to not talk over each other. I
 20 know I've violated that rule already at least
 21 once here today, but if we can try to do that,
 22 it will be easier for the court reporter to make
 23 sure she gets an accurate record of our
 24 discussion here today. Fair?
 25 A Yes.

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1 Q Okay.
 2 (Exhibit Number 1001 was marked
 3 for identification.)
 4 BY MR. STADNICK:
 5 Q I handed you the first exhibit to
 6 your deposition today. It's been pre-marked as
 7 Exhibits 1001 in both the 820 and the 822 IPRs.
 8 Exhibit 1001 is a copy of U.S. Patent 7,064,197;
 9 correct?
 10 A Correct.
 11 Q And that's the Enzo patent that you
 12 analyzed in connection with your work for
 13 Hologic on the IPR matters; correct?
 14 A That is correct.
 15 Q When did you first -- when is the
 16 first time you ever saw the '197 patent?
 17 A I don't recall exactly. It's
 18 possible it was 2014. That's possible but
 19 certainly early this year in 2016. I don't
 20 recall the 2014 for sure.
 21 Q Let me try it a different way.
 22 Prior to getting involved in working with
 23 Hologic on these IPR matters, had you seen the
 24 '197 patent at all?
 25 A I honestly don't recall for sure.

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1 Q In what context do you suspect that
 2 you might have seen the '197 patent before
 3 getting involved with the IPR proceedings for
 4 Hologic?
 5 A I've worked in this industry for
 6 three decades; so it's possible that just in my
 7 normal course of researching literature that I
 8 have read it in the past. That's the part I
 9 just don't recall for sure.
 10 Q Is there something particular about
 11 the 2014 time frame that makes you think you may
 12 have come across it then?
 13 A I do recall that I did a brief
 14 amount of work, not as a -- hired as an expert,
 15 although I don't recall the exact title, but a
 16 small amount of work on another Enzo matter
 17 which may have been this same patent. It was
 18 brief, and that's why I don't recall for sure.
 19 It may have been this particular patent, but I
 20 just don't recall.
 21 Q The prior work you did on another
 22 Enzo matter, was that in your capacity as an
 23 independent consultant?
 24 A Correct.
 25 Q Who were you doing that work for?

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1 A You mean -- other than Hologic, you
 2 mean the specific individual that I worked with?
 3 Q No. Hologic is the answer I was
 4 looking for.
 5 A Oh.
 6 Q That work was also for Hologic?
 7 A Correct.
 8 Q Backing up to your role as an
 9 independent consultant, other than operating
 10 your own independent consultant business, are
 11 you employed by anybody currently?
 12 A I do contract work, work as a
 13 consultant, but it's all through my business.
 14 So I'm not employed by anyone else outside of my
 15 business.
 16 Q Do you hold any positions, executive
 17 positions, board positions, anything like that
 18 with any companies currently?
 19 A I do not.
 20 Q Okay. Going back to the '197
 21 patent, Exhibit 1001, could you please describe
 22 for me, in general terms, the subject matter of
 23 the '197 patent?
 24 A Can we pause for just a moment? I'm
 25 reconsidering my answer. I also work for a

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1 company here in San Diego termed -- named Aegea,
 2 and I do that as a consultant, but I also have
 3 an arrangement with them which I don't know if
 4 it's technically construed as an employee. I
 5 don't think so, but that is possible as I'm
 6 reconsidering my answer.
 7 Again, when I -- it's a small amount
 8 of work, and when I'm paid, it's always paid --
 9 I bill them as NCN Enterprises which is my
 10 business. I may have some sort of an employment
 11 agreement with them, but I don't recall the
 12 exact nature of that. Aegea is A-e-g-e-a.
 13 Q A-e-g-e-a?
 14 A Yes.
 15 Q What business is Aegea in?
 16 A It's also biotechnology. It's
 17 molecular.
 18 Q Does Aegea have any products?
 19 A No.
 20 Q Is Aegea currently developing any
 21 products with the intent to market them?
 22 A No. It's in just a research phase,
 23 not developing any products, feasibility
 24 research of technology.
 25 Q Is any of the work going on at

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