

From: [Zeilberger, Daniel](#)
To: [Chen, Joe](#); [Yusem, Max](#)
Cc: [bluebird-IPR-PH](#); [Glynn, Michael W.](#); [French-Brown, Wanda D.](#); [Suh, Howard S.](#); [McConnell, James H.](#); [De La Cruz, Gilda](#)
Subject: RE: bluebird v. Sloan Kettering - IPR2023-00070, -74
Date: Wednesday, September 20, 2023 10:03:22 AM
Attachments: [Bluebird - DRAFT Joint Stip to Revise Scheduling Order \(IPR2023-00070\).docx](#)
[Bluebird - DRAFT Joint Stip to Revise Scheduling Order \(IPR2023-00074\).docx](#)
[image001.png](#)

Joe,

We are fine with adjusting the sur-reply deadline as you have requested. Draft stipulations are attached; please confirm we have your authorization to file them. Please also confirm what time Dr. Sadelain's deposition will begin.

Your position regarding Dr. Luzzatto, where you are not making him available for deposition but also not withdrawing reliance on his declaration, is improper, and we reserve all rights. *See, e.g., Mexichem Amanco Holdings S.A. de C.V. v. Honeywell International, Inc.*, IPR2013-00576, Paper No. 36 at 2-3 (P.T.A.B. Sept. 5, 2014) (explaining that "if [the party submitting a declaration] does not produce [the declarant] for cross-examination, we will give that Declaration little to no weight as [the other side] has not been offered a fair opportunity to challenge his testimony," even where the witness "may reside [abroad] ... where such action may require a court subpoena and/or invoke the Hague Convention"); Consolidated Trial Practice Guide, Nov. 2019, at 23 ("[A] party presenting a witness's testimony by affidavit should arrange to make the witness available for cross-examination.").

Regards,
Dan

From: Chen, Joe <joechen@foxrothschild.com>
Sent: Monday, September 18, 2023 2:48 PM
To: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

--- External Email ---

Hi Dan,

We can agree to a one-week extension for the petitioner's reply due date (i.e., from October 24 to October 31) if you also agree to a one-week extension for the patent owner's sur-reply due date (i.e., from December 5 to December 12).

Regarding Dr. Luzzatto, as stated in our replies on 9/7/2023 and 9/11/2023, he will not be available for deposition and currently we have no plan to withdraw reliance on his declaration.

Thanks.

Best regards,
Joe

Joe Chen, J.D., Ph.D.

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From: Zeilberger, Daniel <danielzeilberger@paulhastings.com>

Sent: September 18, 2023 7:26 AM

To: Chen, Joe <joechen@foxrothschild.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

Joe,

We are available on October 20 to take the deposition of Dr. Sadelain. However, October 20 is only four days before the current due date for the petitioner's reply. Therefore, we can only agree to an October 20 deposition if you can agree to a one-week extension for the petitioner's reply due date (i.e., from October 24 to October 31). Please let us know.

We also look forward to a response to our question regarding Dr. Luzzatto.

Regards,
Dan

From: Chen, Joe <joechen@foxrothschild.com>
Sent: Friday, September 15, 2023 1:58 PM
To: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

--- External Email ---

Hi Dan,

Dr. Sadelain is available on **October 20, 2023** for his deposition at WilmerHale's New York office (250 Greenwich St 45th floor, New York, NY 10007). This is the only date he is available in the near term due to his very busy work schedule and upcoming conferences. Please confirm as soon as possible if the date works for you so we can ask him to save the date. Thanks.

Best regards,
Joe

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From: Zeilberger, Daniel <danielzeilberger@paulhastings.com>
Sent: September 12, 2023 4:16 PM
To: Chen, Joe <joechen@foxrothschild.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

Joe,

We are a bit puzzled by your email because you previously stated that SRT will not make Dr. Luzzatto available for deposition. If you now are making arrangements for Dr. Luzzatto to be available for deposition, please let us know when you expect to provide his

availability.

Regards,
Dan

From: Chen, Joe <joechen@foxrothschild.com>
Sent: Monday, September 11, 2023 11:58 AM
To: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

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Hi Dan,

We have no plan to withdraw reliance on Dr. Luzzatto's declaration at this stage.

We can confirm that no translator is needed for the depositions of Dr. May, Riley, and Rivella. We will inform you of Dr. Sadelain's availability as soon as practically possible.

Thanks.

Best regards,
Joe

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From: Zeilberger, Daniel <danielzeilberger@paulhastings.com>
Sent: September 8, 2023 8:31 AM
To: Chen, Joe <joechen@foxrothschild.com>; Yusem, Max <maxyusem@paulhastings.com>
Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

Joe,

In view of your email, please confirm that patent owner is withdrawing any reliance on Dr. Luzzatto's declaration.

In addition, please let us know when we can expect to receive Dr. Sadelain's availability, as well as when you can confirm whether any of the depositions will require a translator.

Regards,
Dan

From: Chen, Joe <joechen@foxrothschild.com>
Sent: Thursday, September 7, 2023 5:53 PM
To: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; Yusem, Max <maxyusem@paulhastings.com>

Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

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Dear Dan:

Given that Dr. Luzzatto will not be traveling to the U.S. for deposition due to his age/health, and due to his status as an Italian citizen, presently in Italy, requiring arrangements with the Italian courts prior to his deposition, Dr. Luzzatto will not be available for deposition.

Thanks.

Best regards,
Joe

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From: Zeilberger, Daniel <danielzeilberger@paulhastings.com>

Sent: September 6, 2023 9:16 AM

To: Chen, Joe <joechen@foxrothschild.com>; Yusem, Max <maxyusem@paulhastings.com>

Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>

Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

Joe,

We understand from your email that Dr. Luzzatto is now no longer in Tanzania and has relocated to Italy. As you know, Italy is a party to the Hague convention. Therefore, please confirm that Dr. Luzzatto is a U.S. citizen and/or that patent owner will be making arrangements and taking responsibility for complying with all applicable laws for depositions with a deponent in Italy, including but not limited to arranging for someone properly authorized to swear in such a deponent. Assuming you can confirm, then September 20 and 9am ET will work for us. If you cannot confirm, then we cannot agree to such a remote international deposition, and Patent Owner will need to seek Board authorization. Please let us know by the end of the day today, September 6.

In response to your question about the length of the deposition, we do not anticipate needing the full time allotted under the rules for the deposition. We do note, however, that we offered to begin at 8am ET if the end time is a concern for you.

We look forward to receiving Dr. Sadelain's availability.

Finally, please let us know if any of the depositions will require a translator.

Regards,
Dan

From: Chen, Joe <joechen@foxrothschild.com>

Sent: Tuesday, September 5, 2023 4:55 PM

To: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; Yusem, Max <maxyusem@paulhastings.com>

Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>
Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

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Dan,

The location in NYC would be our NY office (located at 101 Park Ave 17th floor, New York, NY 10178), and the location in Philadelphia would be our Philly office (located at 2000 Market Street, 20th Floor, Philadelphia, PA 19103). The depositions for Drs. Riley, May, and Rivella may start at 9 am local time.

Dr. Luzzatto is now located in Sicily, Italy, and can be available remotely from Italy on September 20, 2023, at 9 am Eastern / 3 pm Italy. Please let us know how long you intend the deposition to go, given that Dr. Luzzatto is accommodating your request to start the deposition in the morning Eastern time.

We disagree with your characterization of the remote deposition. Please be advised that Dr. Luzzatto is unable to travel to the United States given that he is 86 years old (not in the best of health) and has work conflicts. Regarding Dr. Hsieh-Yee, we offered to take the deposition at a location convenient to Dr. Hsieh-Yee but Petitioner refused (see 5/22/23 email from H. Suh). In your prior correspondence about Dr. Hsieh-Yee, you cited 37 C.F.R. § 42.53: "Uncompelled deposition testimony outside the United States may only be taken upon agreement of the parties or as the Board specifically directs." The same applies with respect to Dr. Luzzatto. We trust this resolves the issue.

We will provide Dr. Sadelain's availability as soon as we can. Thanks.

Best regards,
Joe

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From: Zeilberger, Daniel <danielzeilberger@paulhastings.com>

Sent: September 5, 2023 2:42 PM

To: Chen, Joe <joechen@foxrothschild.com>; Yusem, Max <maxyusem@paulhastings.com>

Cc: bluebird-IPR-PH <bluebird-IPR-PH@paulhastings.com>; Glynn, Michael W. <mglynn@foxrothschild.com>; French-Brown, Wanda D. <WFrench-Brown@foxrothschild.com>; Suh, Howard S. <HSuh@foxrothschild.com>; McConnell, James H. <JMcConnell@foxrothschild.com>; De La Cruz, Gilda <gdelacruz@foxrothschild.com>

Subject: [EXT] RE: bluebird v. Sloan Kettering - IPR2023-00070, -74

Joe,

We are still waiting to hear back from you regarding Dr. Luzzatto and Dr. Sadelain's depositions. Please get back to us as soon as possible so that appropriate arrangements can be made.

In addition, you indicated that the depositions for Drs. Riley and May could be held in New York, and Dr. Rivella's could be held in Philadelphia. Please let us know what specific locations you had in mind so that we can prepare deposition notices. We would be happy to host the New York depositions in our New York office if you prefer. Please also let us know what time they would prefer to start. Note that we will select October 6 from the two dates you provided for Dr. May.

Regards,

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