

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLUEBIRD BIO, INC.,
Petitioner,

v.

SLOAN KETTERING INSTITUTE FOR CANCER RESEARCH,
Patent Owner.

Case No. IPR2023-00074
Patent No. 8,058,061

PATENT OWNER'S UPDATED MANDATORY NOTICE

The named patent owner in the above-referenced proceeding, Sloan Kettering Institute for Cancer Research (“SKI” or the “Patent Owner”), by and through its exclusive licensee, provides this updated notice without waiving any of Patent Owner’s rights.

SKI granted San Rocco Therapeutics, LLC (“SRT”), formerly known as Errant Gene Therapeutics, LLC, an exclusive license, with all substantial rights, to U.S. Patent Nos. 7,541,179 (“the ’179 Patent”) and 8,058,061 (“the ’061 Patent”). On October 19, 2022, the Patent Owner informed SRT that, as the exclusive licensee of the ’179 Patent, it expects SRT to defend the challenged claims at SRT’s expense. In response, on October 20, 2022, SRT affirmed its responsibility to defend the validity of the ’179 Patent at its own expense because SRT is the exclusive licensee and holder of all substantial rights pursuant to an exclusive license agreement with the Patent Owner.

As the exclusive licensee, with all substantial rights to the ’179 Patent, SRT provides this notice without waiving any of the Patent Owner’s or SRT’s rights.

1. Real Party in Interest (§ 42.8(b)(1)).

The real parties in interest are SRT, located at 308 East Emily Street, Tampa, Florida 33603; SKI, located at 1275 York Avenue, New York, New York 10065; and Memorial Sloan-Kettering Cancer Center (“MSKCC”), located at 1275 York Avenue, New York, New York 10065.

2. Related Matters (§ 42.8(b)(2)).

A. Matters Involving Petitioner.

On November 2, 2020, the Patent Owner granted SRT an exclusive license with all substantial rights to the '179 Patent, including the right to assert the '179 Patent against infringers and to defend the validity of the '179 Patent before the Patent Trial and Appeal Board. On October 21, 2021, SRT filed a complaint against bluebird bio, Inc. (“bluebird”) in the District of Delaware alleging infringement of the '179 and '061 Patents. *See Errant Gene Therapeutics, LLC v. Bluebird Bio, Inc.*, 1-21-cv-01478, (D. Del. October 21, 2021) (“Delaware Action”), D.I. 1. On November 17, 2021, SRT amended its complaint to include Third Rock Ventures, LLC (“TRV”) as a defendant because TRV, knowingly and willfully, induced and continues to induce infringement of the '179 Patent. *See id.*, at D.I. 9. Subsequently, bluebird and TRV filed a motion to dismiss or, in the alternative, stay proceedings and compel arbitration. *See id.*, at D.I. 15.

In the Delaware Action, on July 26, 2022, Judge Richard G. Andrews granted, in part, bluebird and TRV’s motion to compel arbitration and denied their motion to dismiss SRT’s second amended complaint. *Id.*, at D.I. 76. Specifically, Judge Andrews: (i) held that the court must determine whether SRT has constitutional and statutory standing following arbitration of threshold issues; and (ii) noted that his decision does not compel arbitration of SRT’s patent infringement claims. *Id.* SRT subsequently filed a Demand for Arbitration and Statement of Claim with the American Arbitration Association, and the arbitration has been assigned Case No.

01-22-0003-6927. On October 18, 2022, Petitioner filed IPR2023-00070 against the '179 Patent and IPR2023-00074 (the instant action) against the '061 Patent.

B. Additional Matters Involving the '061 Patent

On October 5, 2021, SRT filed a complaint for declaratory judgment seeking a declaration that (i) recombinant vectors SNS23.B87.A1 and SNS23.2.B87.A1 (collectively, the “SNS23 Vectors”) are covered by a claim of the '179 and/or '061 Patent; and (ii) transduced cells containing SNS23 Vectors are covered by a valid claim of the '179 and/or '061 Patent. *See Errant Gene Therapeutics, LLC v. Memorial Sloan-Kettering Cancer Center and Sloan Kettering Institute of Cancer Research*, 1-21-cv-08206 (S.D.N.Y) (“SDNY Action”), D.I. 1. The SDNY Action is currently pending before Judge Vernon S. Broderick.

B. Continuity and Priority.

The '179 and '061 Patents claim priority to U.S. Provisional Application No. 60/301,861 filed on June 29, 2001, U.S. Provisional Application No. 60/302,852 filed on July 2, 2001, and U.S. Non-Provisional Application No. 10/188,221 (“the '221 Application”) filed on July 1, 2002. The '061 Patent also claims priority to U.S. Non-Provisional Application No. 12/433,412, which is a divisional of the '221 Application and which was filed on April 30, 2009.

3. Designation of Lead and Backup Counsel (§ 42.8(b)(3)).

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Additional counsel for Patent Owner may seek *pro hac vice* admission for the IPR Proceeding referenced herein.

4. Service Information.

Service on Patent Owner may be made by electronic mail to Patent Owner's counsel at the email addresses above. Alternatively, service may be made by mail

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