

From: [Edwards, Jeremy](#)
To: [Daniel L. Shores](#)
Cc: [Maddox, Steven](#); [Adam M. Nicolais](#)
Subject: RE: [EXTERNAL] RE: Hongene v. ChemGenes
Date: Monday, February 5, 2024 11:07:42 AM
Attachments: [image001.jpg](#)

Dan,

I was traveling with my family on Friday and am just this morning coming to your email.

I am still reviewing the documents you are requesting and discussing your request with Hongene. Given that they are in China, this could not have been resolved on Friday, and will not be resolved today.

As I've mentioned, the documents you are requesting are confidential to Hongene. I am not currently authorized to produce any of them. I do not know yet whether Hongene will agree to voluntarily producing any of them. But I'm working on it. It would help if you would propose confidentiality terms and a draft protective order. Are you asking for production on a strict outside counsel eyes only basis, or something less restrictive?

In the meantime, please explain how the documents you are requesting meet the standard for discovery in these IPRs, and provide any authority you wish us to consider. I do not think that the documents you are requesting are relevant or properly discoverable in these IPRs. You questioned Dr. Baran at length about the Hongene SAB during his deposition and he answered what he could without divulging Hongene's confidential information. Along the way, he testified that his service on the SAB has never had anything to do with his service as an expert witness in the IPRs, and they he has never discussed with the people he has been in contact with in connection with the SAB even the *existence* of the IPRs or his role in them – let alone the *substance* of anything in the IPRs. He also explained that the SAB was newly-formed and involves other participants.

As for your insinuation that the fact of Dr. Baran's service on the Hongene SAB has been withheld, that is unwarranted and incorrect. As Dr. Baran explained, it did not come about until after the IPR petitions were filed. And since at least as early as last October, it has been public information (readily available from the headline results of a simple google search) that Hongene formed SAB including Dr. Baran. <https://www.bio-itworld.com/pressreleases/2023/10/26/new-expert-advisory-board-appointments-set-to-drive-growth-and-innovation-at-hongene>.

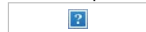
I will continue to engage with my client to determine which, if any of these documents they are willing to produce voluntarily, and get back you when I know more.

Sincerely,

Jeremy

JEREMY J. EDWARDS
PARTNER

P. 202.830.0540 C. 410.627.6833 | jeremy.edwards@procopio.com
1901 L. Street, N.W., Suite 620, Washington, DC 20036
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From: Daniel L. Shores <DShores@rfem.com>
Sent: Friday, February 2, 2024 11:35 AM
To: Edwards, Jeremy <Jeremy.Edwards@procopio.com>
Cc: Maddox, Steven <Steven.Maddox@procopio.com>; Adam M. Nicolais <anicolais@rothwellfigg.com>
Subject: Re: [EXTERNAL] RE: Hongene v. ChemGenes

*** EXTERNAL EMAIL - Please use Caution. ***

Hi Jeremy,

We requested that Hongene provide specific documents to us without the need to trouble the Board, i.e., the Agreement, Emails, and Minutes relating to Dr. Baran's appointment to Hongene's Advisory Board that Dr. Baran testified he was looking at during his deposition. We made this narrowly-tailored request for specific documents over a week ago and over 10 days after his deposition. Hongene has still failed to provide these documents.

As you know, our Patent Owner Response and other papers in the 569 and 707 IPRs are due on Monday. Your delay in producing these discrete documents that you state are currently in your possession (and we know are in Dr. Baran's possession) is prejudicial to ChemGenes. This is especially troubling given that neither Hongene nor Dr. Baran disclosed in any of their papers that Dr. Baran has an independent and paid engagement with Hongene totaling at least \$70,000 per year that commenced during and runs parallel to the three IPRs Hongene filed against ChemGenes.

Please produce at least the Agreement and Emails today. We can meet and confer regarding the Minutes and any other relevant documents early next week. Please advise if you are available on Tuesday at 10 or 11 am.

Thanks,
Dan

On 2/2/24, 7:47 AM, "Edwards, Jeremy" <Jeremy.Edwards@procopio.com <<mailto:Jeremy.Edwards@procopio.com>>> wrote:

Dan,

I have just now today begun to receive the documents you have requested and will be reviewing and discussing with Hongene.

CHEMGENES EXHIBIT 2046
Shanghai Hongene v. ChemGenes
Case IPR2023-00875

I can tell already that SAB meeting materials (minutes/notes and power point slides) contain highly confidential strategic business planning information. I very much doubt that Hongene would be willing to voluntarily produce such information.

Nor do I think such information is properly discoverable in these IPRs.

But I will be in touch next week after I have completed my collection and review and consulted with Hongene.

Sincerely,

Jeremy

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From: Daniel L. Shores <DShores@rfem.com <<mailto:DShores@rfem.com>>>

Sent: Thursday, February 1, 2024 4:41:15 PM

To: Edwards, Jeremy <Jeremy.Edwards@procopio.com <<mailto:Jeremy.Edwards@procopio.com>>>

Cc: Maddox, Steven <Steven.Maddox@procopio.com <<mailto:Steven.Maddox@procopio.com>>>; Adam M. Nicolais <anicolais@rothwellfigg.com <<mailto:anicolais@rothwellfigg.com>>>

Subject: Re: [EXTERNAL] RE: Hongene v. ChemGenes

* EXTERNAL EMAIL - Please use Caution. *

Hi Jeremy,

I am following up to check on the status of this. Could you please advise?

Thanks,

Dan

From: "Edwards, Jeremy" <Jeremy.Edwards@procopio.com <<mailto:Jeremy.Edwards@procopio.com>>>

Date: Tuesday, January 30, 2024 at 9:15 AM

To: "Daniel L. Shores" <DShores@rfem.com <<mailto:DShores@rfem.com>>>

Cc: "Maddox, Steven" <Steven.Maddox@procopio.com <<mailto:Steven.Maddox@procopio.com>>>, "Adam M. Nicolais" <anicolais@rothwellfigg.com <<mailto:anicolais@rothwellfigg.com>>>

Subject: RE: [EXTERNAL] RE: Hongene v. ChemGenes

Dan,

Sincerely,

JEREMY J. EDWARDS
PARTNER

P. 202.830.0540 C. 410.627.6833 | jeremy.edwards@procopio.com <<mailto:jeremy.edwards@procopio.com>>
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LinkedIn<[https://www.linkedin.com/public-profile/settings?](https://www.linkedin.com/public-profile/settings?trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTl7ksTueVN%2F7clu3PBO%3D%3D)
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[trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTl7ksTueVN%2F7clu3PBO%3D%3D>](https://www.linkedin.com/public-profile/settings?trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTl7ksTueVN%2F7clu3PBO%3D%3D>)>
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I am following up to check on the status of this. Could you please advise?

3

Dan

On Jan 25, 2024, at 4:35 PM, Edwards, Jeremy <Jeremy.Edwards@procopio.com<<mailto:Jeremy.Edwards@procopio.com>><<mailto:Jeremy.Edwards@procopio.com>><<mailto:Jeremy.Edwards@procopio.com>>>> wrote:

Dan,

We will consider your request and get back to you in due course. Tomorrow is too soon, and we are not available tomorrow anyway.

Sincerely,

Jeremy

JEREMY J. EDWARDS
PARTNER

—
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[trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTI7ksTueVN%2F7cJu3PBQ%3D%3D](https://www.linkedin.com/public-profile/settings?trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTI7ksTueVN%2F7cJu3PBQ%3D%3D)>
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[trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTI7ksTueVN%2F7cJu3PBQ%3D%3D](https://www.linkedin.com/public-profile/settings?trk=d_flagship3_profile_self_view_public_profile&lipi=urn%3Ali%3Apage%3Ad_flagship3_profile_self_edit_contact_info%3B8OkTI7ksTueVN%2F7cJu3PBQ%3D%3D)>>
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From: Daniel L. Shores <DShores@rfem.com<<mailto:DShores@rfem.com>><<mailto:DShores@rfem.com>><<mailto:DShores@rfem.com>>>>
Sent: Thursday, January 25, 2024 1:13 PM
To: Edwards, Jeremy <Jeremy.Edwards@procopio.com<<mailto:Jeremy.Edwards@procopio.com>><<mailto:Jeremy.Edwards@procopio.com>>>>
Cc: Maddox, Steven <Steven.Maddox@procopio.com<<mailto:Steven.Maddox@procopio.com>><<mailto:Steven.Maddox@procopio.com>>>>; Adam M. Nicolais <anicolais@rothwellfigg.com<<mailto:anicolais@rothwellfigg.com>><<mailto:anicolais@rothwellfigg.com>>>>
Subject: Hongene v. ChemGenes

* EXTERNAL EMAIL - Please use Caution. *

Dear Jeremy,

During Dr. Baran's January 22, 2024 deposition, he testified that Hongene hired him to serve on its Advisory Board and is paying him \$70,000 per year. (Baran Draft 1/22/2024 Dep. Tr. at 122:6-8, 124:9-10.) He also testified that he is in possession of a copy of an agreement ("Agreement"), email communications ("Emails"), and meeting minutes ("Minutes") regarding his service on the Advisory Board. (Id. at 123:8-17, 124:9-15, 129:16-130:15.) It was apparent during the deposition that Dr. Baran was looking at some of these materials during the deposition while he was giving testimony and the documents were readily available to him. (Id. at 122:22-123:17, 124:9-15, 129:16-130:15.)

We respectfully request immediate production of the Agreement, Emails and Minutes, along with all other documents and communications that relate to Dr. Baran's relationship with Hongene in connection with the Hongene Advisory Board and otherwise.

The Parties are allowed to agree to such additional discovery under 37 C.F.R. § 42.51(b)(2). Please advise as to your agreement to produce these documents. If you refuse, or otherwise seek to discuss this matter, we would be available to confer on this tomorrow (Friday) at 9 am, 11 am, and 3 pm.

Thanks,

Dan

<image004.png>

Daniel L. Shores, Esq.

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Thu Jan 25 2024 13:35:55

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