

Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC Paper
Date: January 21, 2014

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMMER HOLDNGS,
INC. and ZIMMER, INC.
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC

Patent Owner

Case: IPR2014-00321

Patent 7,806,896

Pursuant to 37 C.F.R. § 42.8, Patent Owner, BONUTTI SKELETAL INNOVATIONS LLC, submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 7,806,896 (hereinafter the “896 patent”).

1. Real Party-In-Interest

In accordance with 37 C.F.R. § 42.8(b) (1), Patent Owner identifies the real party-in-interest as the assignee Bonutti Skeletal Innovations LLC. Bonutti Skeletal Innovations LLC is a subsidiary of Advanced Skeletal Innovations LLC, which is a subsidiary of Acacia Research Group LLC, which in turn is a subsidiary of Acacia Research Corporation.

2. Related Matters

In accordance with 37 C.F.R. § 42.8(b) (2), Patent Owner identifies the following related proceedings which may affect or be affected by a decision in this proceeding: *Bonutti Skeletal Innovations LLC v. Zimmer Holdings Inc. et al.*, Civil Action No. 1:2012cv01107 (D. Del. 2012); *Bonutti Skeletal Innovations LLC v. Wright Medical Group Inc. et al.*, Civil Action No. 1:2012cv01110 (D. Del. 2012); *Bonutti Skeletal Innovations LLC v. ConforMIS Inc.*, Civil Action No. 1:2012cv01109 (D. Del. 2012); *Biomet Inc v. Bonutti Skeletal Innovations LLC*, Civil Action No. 3:2013cv00176 (N.D. In. 2013); and *Bonutti Skeletal Innovations v. DePuyMitek, Inc.*, Civil Action No. 1:2012cv11667 (D. Mass 2012); which

concerns the '896 patent which is the subject of this proceeding.

Patent Owner further identifies IPR2013-00629 and IPR2014-00354, which seek *inter partes* review of the '896 patent which is the subject of this proceeding.

Patent Owner further identifies IPR 213-00605, IPR 2014-00191, and IPR 2014-00311, which seek *inter partes* review of United States Patent Nos. 7,749,229, 7,837,736, and 7,959,635 respectively all of which are at issue in *Bonutti Skeletal Innovations LLC v. Zimmer Holdings Inc. et al.*, Civil Action No. 1:2012cv01107 (D. Del. 2012).

The Patent Owner also identifies the following patents that claim the benefit of the priority of the filing date of the '896 patent or that the '896 patent claims priority from: U.S. Patent Nos. 7,104,996, 6,770,078, 6,702,821, 6,503,277, 6,635,073, 6,503,267, 6,423,063, 6,575,982, 6,620,181, 6,468,289, and 8,425,522.

3. Lead and Back-Up Counsel

In accordance with 37 C.F.R. § 42.8(b)(3), Patent Owner identifies

Cary Kappel as lead counsel and William Gehris as back-up counsel:

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4. Service Information

In accordance with 37 C.F.R. § 42.8(b) (4), Patent Owner identifies the following service information:

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Respectfully submitted,

January 21, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of January, 2014, a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES was served by electronic mail and U.S. Post Office Express Mail, upon the following counsel of record for Petitioners ZIMMER HOLDINGS, INC. and ZIMMER, INC.:

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