

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METRICS, INC., MAYNE PHARMA, and
JOHNSON MATTHEY, INC.

Petitioners

v.

SENJU PHARMACEUTICAL CO., LTD., BAUSCH & LOMB, INC., and
BAUSCH & LOMB PHARMA HOLDINGS CORP.

Patent Owners

Case IPR2014-01043

Patent 8,669,290

Before PATRICK E. BAKER, *Trial Paralegal*

CORRECTED Petition for *Inter Partes* Review of U.S. Patent No. 8,669,290
Pursuant to the Patent Trial and Appeal Board's July 22, 2014 Notice of
Filing Date Accorded to Petition and Time for Filing Patent Owner
Preliminary Response

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CERTIFICATE OF SERVICE

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Cases

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