Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC Paper Date: July 18, 2014

By: Cary Kappel, Lead Counsel William Gehris, Backup Counsel Davidson, Davidson & Kappel, LLC 485 Seventh Avenue New York, NY 10018 Telephone (212) 736-1257 (212) 736-2015 Facsimile (212) 736-2427 E-mail: ckappel@ddkpatent.com wgehris@ddkpatent.com

DOCKE.

Δ

# 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: IPR2014-01078

Patent 7,837,736

INNOVATIONS LLC, submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 7,837,736 (hereinafter the "736 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.*, Case No.12-cv-01107 (D. Del.); and IPR2014-00191, both of which concern the '736 patent which is the subject of this proceeding.

The Patent Owner also identifies the following applications and patents that claim the benefit of the priority of the filing date of the '736 patent, or that the '736 patent claims priority from: U.S. Patent Nos. 7,635,390, 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, and 6,468,289.

## 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:

Cary Kappel Davidson, Davidson & Kappel, LLC 485 Seventh Avenue New York, NY 10018 Tel: (212) 736-1257 Fax: (212) 736-2427 Email: ckappel@ddkpatent.com Registration No.: 36,561

William Gehris Davidson, Davidson & Kappel, LLC 485 Seventh Avenue New York, NY 10018 Tel: (212) 736-2015 Fax: (212) 736-2427 Email: wgehris@ddkpatent.com Registration No.: 38,156

DOCKET

Δ

#### 4. Service Information

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

following service information:

Cary Kappel Davidson, Davidson & Kappel, LLC 485 Seventh Avenue New York, NY 10018 Tel: (212) 736-1257 Fax: (212) 736-2427 Email: ckappel@ddkpatent.com wgehris@ddkpatent.com

Respectfully submitted,

July 18, 2014

DOCKET

By: /Cary Kappel/

Cary Kappel, Reg. 36,561 William Gehris, Reg. 38,156 Davidson, Davidson & Kappel, LLC 485 Seventh Avenue New York, NY 10018

*Counsel for Patent Owner* BONUTTI SKELETAL INNOVATIONS LLC

Case: IPR2014-01078 Patent 7,837,736

### **CERTIFICATE OF SERVICE**

I hereby certify that on this 18<sup>th</sup> day of July, 2014, a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES was served by electronic mail pursuant to Petitioner's consent to email service, upon the following counsel of record for Petitioners ZIMMER HOLDINGS, INC. and ZIMMER, INC.:

> Walter C. Linder Faeger Baker Daniels, LLP 2200 Wells Fargo Center 90 S. Seventh Street Minneapolis, MN 55402 Walter.linder@FaegreBD.com

Daniel Lechleiter Faeger Baker Daniels, LLP 300 N. Meridian St. Suite 2700 Indianapolis, IN 46204-1750 Daniel.Lechleiter@FaegreBD.com

> /Cary Kappel/ Cary Kappel

DOCKE