

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENEDX, INC.
Petitioner

v.

MYRIAD GENETICS, INC.
Patent Owner

Case 2014-01313
Patent 6,051,379

**PATENT OWNER MYRIAD GENETIC'S
MANDATORY NOTICES**

**PATENT OWNER'S MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, the patent owner, MYRIAD GENETICS, INC. (“Patent Owner”), hereby submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 6,051,379.

1. Real Party-In-Interest under 37 CFR § 42.8(b)(1)

MYRIAD GENETICS, INC. is the Patent Owner and the Real Party-In-Interest in this proceeding.

2. Related Matters under 37 CFR § 42.8(b)(2)

The following judicial or administrative matters may affect or be affected by a decision in this proceeding:

Judicial matters: The '379 patent has been asserted against GENEDX in *Univ. of Utah Research Foundation et al. v. GeneDx*, No. 2-13-cv-00954 (D. Utah Oct. 16, 2013) and against others in cases consolidated into: *In Re: BRCA1- and BRCA2- Based Hereditary Cancer Test Patent Litigation*, No. 2-14-md-02510 (D. Utah Feb. 25, 2014); *Invitae Corporation v. Myriad Genetics, Inc.*, No. 3-13-cv-05495 (N. D. Cal. Nov. 26, 2013); *Quest Diagnostics Inc. et al. v. Myriad Genetics, Inc.*, No. 8-13-cv-01587 (C. D. Cal. Oct. 10, 2013); *Counsyl, Inc v. Myriad Genetics, Inc.*, 5-13-cv-04391 (N. D. Cal. Sep. 20, 2013); *Univ. of Utah Research Foundation et al v. Gene by Gene, Ltd.*, No. 2-13-cv-00643 (D. Utah Jul.

10, 2013). GDX1030. Administrative matters: Petitioner GeneDx filed Petitions for IPR on August 18, 2014 of U.S. Patent Nos. 5,654,155; 5,753,441; 6,033,857; 6,083,698; and 6,951,721 concurrently with the '379 petition.

3. Lead and Back-Up Counsel, under 37 CFR § 42.8(b)(3)

The Patent Owner designates the following lead and back-up counsel:

LEAD COUNSEL	BACK-UP COUNSEL
Dorothy P. Whelan, Reg. No. 33,814 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: (612) 337-2509 Email: Whelan@fr.com Fax: (202) 783-2331	J. Patrick Finn, III, Reg. No. 44,109 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: (612) 337-2509 Email: IPR28496-0022IP1@fr.com Fax: (202) 783-2331

4. Service Information under 37 CFR § 42.8(b)(4)(i) et seq.

Please address all correspondence and service to both counsel as listed above. Patent Owner consents to service by email at IPR28496-0022IP1@fr.com (ref.: Docket No. 28496-0022IP).

Respectfully submitted,

Date: September 8, 2014/

/Dorothy P. Whelan/
Dorothy P. Whelan
Reg. No. 33,814

Customer Number 26171
Fish & Richardson P.C.
Telephone: (612) 337-2508
Facsimile: (612) 288-9696

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on September 8, 2014, a complete and entire copy of this Patent Owner MYRIAD GENETIC's Mandatory Notices and Power of Attorney were provided via email, to the Petitioner by serving the correspondence address of record as follows:

Eldora L. Ellison
Deborah A. Sterling
Ralph W. Powers III
Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, NW
Washington, DC 20005

Email: eellison-PTAB@skgf.com
dsterlin-PTAB@skgf.com
tpowers-PTAB@skgf.com

/Susan C. Johnson/

Susan C. Johnson
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(214) 292-4086