

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,
Petitioner,

v.

HYPERION THERAPEUTICS, INC.,
Patent Owner.

Case IPR2016-00283
Patent 8,642,012

PATENT OWNER'S INITIAL MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a), the Patent Owner submits the following initial mandatory notices.

1. Real Parties-In-Interest (37 C.F.R. § 42.8(b)(1))

U.S. Patent No. 8,642,012 is owned by Horizon Therapeutics, Inc. (f/k/a Hyperion Therapeutics, Inc.), a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 520 Lake Cook Road, Suite 520, Deerfield, Illinois, 60015. Pursuant to the requirements of 37 C.F.R. § 42.8(b)(1), the undersigned state that the real parties-in-interest are Horizon Therapeutics, Inc., as well its corporate parents (collectively, Horizon):

- Horizon Pharma, Inc., a corporation organized and existing under the laws of the State of Delaware having its principal place of business at 520 Lake Cook Road, Suite 520, Deerfield, Illinois, 60015, which is wholly owned by;
- Horizon Pharma Finance S.á r.l., an entity organized and existing under the laws of Luxembourg, having its principal place of business at 19 Rue de Bitbourg, Luxembourg, which is wholly owned by;
- Horizon Pharma Capital Limited, a corporation organized and existing under the laws of Ireland, having its principal place of business at Connaught House, 1st Floor, 1 Burlington Road, Dublin 4, Ireland, which is wholly owned by;

- Horizon Pharma Holdings Limited, a corporation organized and existing under the laws of Ireland, having its principal place of business at Connaught House, 1st Floor, 1 Burlington Road, Dublin 4, Ireland, which is wholly owned by; and
- Horizon Pharma plc, a corporation organized and existing under the laws of Ireland, having its principal place of business at Connaught House, 1st Floor, 1 Burlington Road, Dublin 4, Ireland.

2. Related Matters (37 C.F.R. § 42.8(b)(2))

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

- (a) *Hyperion Therapeutics Inc. v. Par Pharmaceutical, Inc.*, Civil Action No. 2:14-cv-00384-JRG-RSP (E.D. Tex. filed April 23, 2014). The Patent Owner has accused Par of infringing the same '012 Patent at issue in this IPR. On December 14, 2015, the district court stayed that case pending resolution of IPR2015-01117 and IPR2015-0127.
- (b) *Horizon Therapeutics Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:15-cv-076248-RBK-JS (D. N.J. filed Oct. 19, 2015). The Patent Owner has accused the Petitioners of infringing the same '012 Patent at issue in this IPR.

- (c) IPR2015-01117, petition filed April 29, 2015, by Par Pharmaceutical, Inc., directed at the same '012 Patent at issue in this case. The Board instituted trial in an Institution Decision dated November 4, 2015. The present Petitioners have filed a motion for joinder with IPR2015-01117.
- (d) IPR2015-01127, petition filed April 29, 2015, by Par Pharmaceutical, Inc., directed at U.S. Patent No. 8,404,215. The '215 Patent is also owned by Horizon Therapeutics, Inc. and has one common inventor with the '012 Patent at issue in this case. The Board instituted trial in an Institution Decision dated November 4, 2015.
- (e) IPR2016-00284, petition filed December 4, 2015, by the present Petitioners, directed at the '215 Patent.
- (f) Abandoned U.S. Patent Appl. No. 14/135,318, filed on December 19, 2013, claims benefit of the '012 Patent.
- (g) Abandoned U.S. Patent Appl. No. 13/061,509, filed on June 15, 2011, claims benefit of the '012 Patent.

3. Lead and Back-Up Counsel (37 C.F.R. § 42.8(b)(3))

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), the Patent Owner provides the following designation of counsel:

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