Filed: February 3, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROSELLINI SCIENTIFIC, LLC Petitioners,

v.

GRUNENTHAL GMBH Patent Owner.

Case IPR2016-00471 Patent No. 7,994,364

PATENT OWNER'S MANDATORY NOTICES

DOCKET

A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

Pursuant to 37 C.F.R. § 42.8, Patent Owner Grünenthal GmbH provides the following mandatory notices.

I. Real Party-in-Interest - 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is Grünenthal GmbH, the owner of U.S. Patent 7,994,364. Grünenthal GmbH is assignee of the entire right, title, and interest in U.S. Patent 7,994,364 by an assignment recorded at the U.S. Patent and Trademark Office at reel 19333, frame 830 on May 23, 2007 in U.S. Application No. 11/646,232, which is the grandparent of the application that issued as U.S. Patent 7,994,364.

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

Pending U.S. Patent Application No. 14/930,337, filed on November 2, 2015, claims benefit of priority to the application that issued as U.S. Patent 7,994,364.

U.S. Patent 7,994,364 is involved in the following litigations in the U.S. District Court for the District of New Jersey:

- 2:13-cv-04507-CCC-MF: Depomed, Inc. and Grünenthal GMBH v. Actavis Elizabeth LLC and Alkem Laboratories Limited;
- 2:13-cv-07803-CCC-MF: Depomed, Inc. and Grünenthal GMBH v. Alkem Laboratories Limited;
- 2:13-cv-06929-CCC-MF: Depomed, Inc. and Grünenthal GMBH v. Roxane Laboratories, Inc.;

- 2:14-cv-03941-CCC-MF: Depomed, Inc. and Grünenthal GMBH v. Roxane Laboratories, Inc.; and
- 2:14-cv-04617-CCC-MF: Depomed, Inc. and Grünenthal GMBH v. Actavis Laboratories UT, Inc.

Patent Owner is unaware of any other related matters that would affect or be

affected by this proceeding.

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

Patent Owner designates Anthony C. Tridico and Amanda K. Murphy as lead

counsel and back-up counsel:

DOCKE

Anthony C. Tridico, Ph.D., Lead Counsel Registration No. 45,958 Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 16 Old Bailey London EC4M 7EG United Kingdom Telephone: 011.44.207.864.2888 Email: anthony.tridico@finnegan.com

Amanda K. Murphy, Ph.D., Back-up Counsel Registration No. 59,387 Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue Washington, DC 20001-4413 Telephone: 202-408-4114 Facsimile: 202-408-4400 Email: amanda.murphy@finnegan.com A power of attorney from Grünenthal GmbH to Finnegan, Henderson,

Farabow, Garrett & Dunner, LLP (Customer Number 22,852) is being filed

concurrently with these mandatory notices in compliance with 37 C.F.R. § 42.10(b).

IV. Service Information - 37 C.F.R. § 42.8(b)(4)

Please send all correspondence to the lead counsel at the address shown above. Under 37 C.F.R. § 42.6(e), Patent Owner consents to electronic service by email to anthony.tridico@finnegan.com and amanda.murphy@finnegan.com.

Respectfully submitted,

Date: February 3, 2016

DOCKE

By: <u>/Anthony C. Tridico/</u> Anthony C. Tridico, Reg. 45,958 Amanda K. Murphy, Reg. No. 59,387 Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

> Counsel for Patent Owner Grünenthal GmbH

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing Patent Owner's

Mandatory Notices was served electronically via email on February 3, 2016, in its

entirety on the following:

Sarah E. Spires Skiermont Derby LLP 2200 Ross Ave. Ste. 4800W Dallas, TX 75201 sspires@skiermontderby.com

Dr. Parvathi Kota Skiermont Derby LLP 2200 Ross Ave. Ste. 4800W Dallas, TX 75201 pkota@skiermontderby.com

Paul J. Skiermont Skiermont Derby LLP 2200 Ross Ave. Ste. 4800W Dallas, TX 75201 pskiermont@skiermontderby.com

DOCKET

Petitioner has consented to electronic service.

<u>/Anthony C. Tridico/</u> Anthony C. Tridico Reg. No. 45,958

R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.