

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUPIN LTD. AND LUPIN PHARMACEUTICALS INC.,
Petitioner

v.

HORIZON THERAPEUTICS, INC.,
Patent Owner

Case IPR2016-00829
Patent 9,095,559

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. 9,095,559 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) IPR2015-01117, petition filed April 29, 2015, by Par Pharmaceutical, Inc., directed at U.S. Patent No. 8,642,012, which is also owned by Horizon Therapeutics, Inc. and has one common inventor with the '559 Patent at issue in this case. The Board instituted trial in an institution decision dated November 4, 2015.
- (b) IPR2015-01127, petition filed April 29, 2015, by Par Pharmaceutical, Inc., directed at U.S. Patent 8,404,215, which is the parent of the '559 Patent at issue in this case. The Board instituted trial in an institution decision dated November 4, 2015.

- (c) IPR2016-00283, directed at the '012 Patent. The petition was filed December 4, 2015 by the present Petitioners with a motion to join IPR2015-01117.
- (d) IPR2016-00284, directed at the '215 Patent. The petition was filed December 4, 2015 by the present Petitioners with a motion to join IPR2015-01127.
- (e) *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 '215 Patent. On December 14, 2015, the district court stayed that case pending resolution of IPR2015-01117 and IPR2015-01127.
- (f) *Horizon Therapeutics Inc. v. Lupin Ltd. and Lupin Pharmaceuticals Inc.*, Civil Action No. 1:15-cv-07624-RBK-JS (D. N.J. filed Oct. 19, 2015). The Patent Owner's original complaint accused the Petitioners of infringing the '012 Patent, the '215 Patent, and the '559 Patent. An amended complaint filed April 6, 2016 accuses the Petitioners of infringing just the '559 Patent.
- (g) Pending U.S. Patent Appl. No. 14/816,674, filed August 3, 2015, which claims benefit of the '559 Patent.

- (h) Pending U.S. Patent Appl. No. 14/958,259, filed December 3, 2015, which claims benefit of the '559 Patent.
- (i) Pending U.S. Patent Appl. No. 15/074,625, filed March 18, 2016, which claims benefit of the '559 Patent.
- (j) Pending U.S. Patent Appl. No. 15/074,666, filed March 18, 2016, which claims benefit of the '559 Patent.
- (k) Pending U.S. Patent Appl. No. 15/074,691, filed March 18, 2016, which claims benefit of the '559 Patent.
- (l) Pending U.S. Patent Appl. No. 15/074,716, filed March 18, 2016, which claims benefit of the '559 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:

LEAD COUNSEL

Robert Green (Reg. No. 27,555)
Green, Griffith & Borg-Breen, LLP
NBC Tower, Suite 3100
455 North Cityfront Plaza
Chicago, Illinois 60611
Phone: (312) 883-8000
Fax: (312) 883-8001
rgreen@greengriffith.com

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.