

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APOTEX INC., APOTEX CORP., APOTEX PHARMACEUTICALS
HOLDINGS INC., AND APOTEX HOLDINGS, INC.,
Petitioners,

v.

OSI PHARMACEUTICALS, INC.,
Patent Owner.

Case IPR2016-01284
U.S. Patent No. 6,900,221

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

PATENT OWNER MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner OSI Pharmaceuticals, LLC, the successor in interest to OSI Pharmaceuticals, Inc., respectfully submits the following updated Mandatory Notices.

I. REAL PARTY IN INTEREST

No change.

II. RELATED MATTERS

Patent Owner identifies the following U.S. patent applications and issued patents that relate to U.S. Patent Application No. 09/711,272, which issued as U.S. Patent No. 6,900,221:

- U.S. Provisional Application No. 60/164,907, which was filed on November 11, 1999, and is expired;
- U.S. Provisional Application No. 60/193,191, which was filed March 30, 2000, and is expired;
- U.S. Provisional Application No. 60/206,420, which was filed on May 23, 2000, and is expired;
- U.S. Application No. 09/711,272, which was filed on November 9, 2000, and issued into U.S. Patent No. 6,900,221;

- U.S. Patent No. 6,900,221, which issued May 31, 2005, remains active;
- U.S. Application No. 10/992,266, which was filed November 18, 2004, and issued into U.S. Patent No. 7,087,613; and
- U.S. Patent No. 7,087,613, which issued August 8, 2006, remains active.

Additionally, Patent Owner identifies the following matters that relate or may relate to U.S. Patent Application No. 09/711,272, which issued as U.S. Patent No. 6,900,221:

- U.S. Patent No. 6,900,221 was a patent-in-suit in *OSI Pharms. Inc. et al. v. Teva Pharms. USA, Inc.*, Case No. 1:09-cv-00185-SLR (D. Del. Mar. 19, 2009) and *OSI Pharms. Inc. et al. v. Mylan Pharms., Inc.*, Case No. 1:09-cv-00186 (D. Del. Mar. 19, 2009), which were consolidated in Case No. 1:09-cv-00185-SLR, which is now closed;
- U.S. Patent No. 6,900,221 was a patent-in-suit in *OSI Pharms. LLC. et al. v. Roxane Labs., Inc.*, Case No. 1:12-cv-00465-SLR (D. Del. Apr. 13, 2012), which is now closed;
- U.S. Patent No. 6,900,221 was a patent-in-suit in *OSI Pharms. LLC. et al. v. Roxane Labs., Inc.*, Case No. 2:12-cv-02384-DMC

(D.N.J. Apr. 20, 2012), which was transferred to the District of Delaware and opened as *OSI Pharms. LLC. et al. v. Roxane Labs., Inc.*, Case No. 1:12-cv-00644-SLR (D. Del. May 23, 2012), which is now closed;

- U.S. Patent No. 6,900,221 was a patent-in-suit in *OSI Pharms. LLC. et al. v. Roxane Labs., Inc.*, Case No. 1:12-cv-01669-SLR (D. Del. Dec. 7, 2012), which is now closed;
- U.S. Patent No. 6,900,221 was a patent-in-suit in *OSI Pharms. LLC. et al. v. Breckenridge Pharms. Inc. et al.*, Case No. 1:15-cv-01063-GMS (D. Del. Nov. 17, 2015), which is now closed.
- U.S. Patent No. 6,900,221 is a patent-in-suit in *OSI Pharms. LLC. et al. v. Apotex Inc. et al.*, Case No. 1:15-cv-00772-GMS (D. Del. Sept. 2, 2015), which remains pending, but currently is stayed.

III. COUNSEL

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