

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 MANDATORY NOTICES
INFORMATION 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 Mandatory Notices.

I. REAL PARTY IN INTEREST

The real parties in interest are OSI Pharmaceuticals, LLC (“OSI”); Astellas US LLC; Astellas US Holding, Inc.; Astellas Pharma Inc.; and Genentech, Inc.

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. 6,900,211;
- 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 is a patent-in-suit in *OSI Pharms. LLC. et al. v. Apotex Inc. et al.*, Case No. 1:15-cv-00772-SLR (D. Del. Sept. 2, 2015) and *OSI Pharms. LLC. et al. v. Breckenridge Pharms. Inc. et al.*, Case No. 1:15-cv-01063-SLR (D. Del. Nov. 17, 2015), which are consolidated in lead Case No. 1:15-00772-SLR, and remain pending.

III. COUNSEL

Lead Counsel:

Emily R. Whelan, Reg. No. 50,391

Back-up Counsel:

Jonathan B. Roses, Reg. No. 61,115

Kevin M. Yurkerwich, Reg. No. 71,195

Powers of attorney are being filed concurrently with these Mandatory Notices.

IV. SERVICE INFORMATION

Electronic mail address:

Emily.Whelan@wilmerhale.com

Jonathan.Roses@wilmerhale.com

Kevin.Yurkerwich@wilmerhale.com

Electronic service on lead and back up counsel is approved and preferred.

Postal Mail, Courier or Hand Delivery:

Wilmer Cutler Pickering Hale and Dorr LLP

60 State St.

Boston, MA 02109

Emily.Whelan@wilmerhale.com

Telephone: 617-526-6567

Facsimile: 617-526-5000

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.