

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCK SHARP & DOHME CORP.,
Petitioner,

v.

GENENTECH, INC. AND CITY OF HOPE,
Patent Owners.

Case IPR2016-01373
U.S. Patent 6,331,415

**PATENT OWNERS' MANDATORY NOTICES
UNDER 37 C.F.R. §42.8**

PATENT OWNERS' MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owners Genentech, Inc. and City of Hope respectfully submit the following Mandatory Notices.

I. REAL PARTY IN INTEREST

The real parties in interest are Genentech, Inc. and City of Hope.

II. RELATED MATTERS

Patent Owners identify the following U.S. patent applications and issued patents that relate to U.S. Patent Application No. 07/205,419, which issued as U.S. Patent No. 6,331,415:

- U.S. Patent Application No. 06/483,457, which was filed on April 8, 1983 and issued as U.S. Patent No. 4,816,567, is the parent application of U.S. Patent Application No. 07/205,419;
- U.S. Patent Application No. 08/422,187, which was filed on April 13, 1995 and issued as U.S. Patent No. 7,923,221, claims the benefit of the priority date of U.S. Patent No. 6,331,415;
- U.S. Patent Application No. 08/931,121, which was filed on September 16, 1997 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,331,415; and

- U.S. Patent Application No. 08/909,611, which was filed on August 12, 1997 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,331,415.

Additionally, Patent Owners identify the following matters that relate or may relate to U.S. Patent Application No. 07/205,419, which issued as U.S. Patent No. 6,331,415:

- U.S. Patent Application No. 07/205,419 was at issue in Patent Interference No. 102,572, which has concluded;
- U.S. Patent Application No. 07/205,419 was at issue in *Genentech, Inc. v. Celltech Ltd.*, 3:1998-cv-03926 (N.D. Cal. Oct. 9, 1998), which is now closed;
- U.S. Patent Application No. 08/422,187, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, was at issue in Patent Interference No. 105,531, which has concluded;
- U.S. Patent No. 6,331,415 was the subject of Reexamination Control No. 90/007,542 (July 7, 2005), which has concluded;
- U.S. Patent No. 6,331,415 was the subject of Reexamination Control No. 90/007,859 (January 23, 2006), which has concluded;

- U.S. Patent No. 6,331,415 was a patent-in-suit in *MedImmune, Inc. v. Genentech, Inc.*, Case No. 2:03-cv-2567 MRP (C.D. Cal. Apr. 11, 2003); which is now closed;
- U.S. Patent No. 6,331,415 was a patent-in-suit in *Centocor, Inc. v. Genentech, Inc.*, Case No. 2:08-cv-03573 MRP (C.D. Cal. May 30, 2008), which is now closed:
- U.S. Patent No. 6,331,415 was a patent-in-suit in *Glaxo Group Limited v. Genentech, Inc.*, Case No. 2:10-cv-02764 MRP (C.D. Cal. Feb. 17, 2010), which is now closed;
- U.S. Patent No. 6,331,415 and U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, were both patents-in-suit in *Human Genome Sciences, Inc. v. Genentech, Inc.*, Case No. 2:11-cv-06519 MRP (C.D. Cal. Apr. 12, 2011), which is now closed;
- U.S. Patent No. 6,331,415 and U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, were both patents-in-suit in *Genentech, Inc. v. Glaxo Group Limited*, Case No. 2:11-cv-03065 MRP (C.D. Cal. Apr. 12, 2011), which is now closed;

- U.S. Patent No. 6,331,415 and U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, were both patents-in-suit in *Eli Lilly & Co. v. Genentech, Inc.*, Case No. 2:13-cv-07248 MRP (C.D. Cal. Feb. 28, 2013), which is now closed;
- U.S. Patent No. 6,331,415 and U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, were both patents-in-suit in *Bristol-Myers Squibb Co. v. Genentech, Inc.*, Case No. 2:13-cv-05400 MRP (C.D. Cal. May 3, 2013), which is now closed;
- U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, is the patent-in-suit in *Sanofi-Aventis U.S. LLC v. Genentech, Inc.*, Case No. 2:15-cv-05685 GW (C.D. Cal. July 27, 2015), which is pending;
- U.S. Patent No. 7,923,221, which claims the benefit of the priority date of U.S. Patent No. 6,331,415, is the patent-in-suit in *Genzyme Corporation v. Genentech, Inc. and City of Hope*, Case No. 2:15-cv-09991 (C.D. Cal. December 30, 2015), which is pending;

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