

Case IPR2017-00041
Patent No. 7,157,456

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS, INC.

Petitioner,

v.

BAYER INTELLECTUAL PROPERTY, GMBH,

Patent Owner.

Case No. IPR2017-00041

Patent No. 7,157,456

PATENT OWNER'S PRELIMINARY RESPONSE

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CASES

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*Sequenom, Inc. v. Board of Trustees of the Leland Stanford Junior
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American Inventors Protection Act of 1999, Pub. L. No. 106-113, 113 Stat. 1501A-552	12, 15, 23
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