

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALKERMES PHARMA IRELAND LTD.
and ALKERMES, INC.,
Petitioner,

v.

OTSUKA PHARMACEUTICAL CO., LTD.,
Patent Owner.

Case IPR2017-00287
Patent 9,125,939 B2

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner Otsuka Pharmaceutical Co., Ltd. (“Otsuka”) provides the following mandatory notices.

I. Real Party-in-Interest - 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is Otsuka Pharmaceutical Co., Ltd., the owner of U.S. Patent No. 9,125,939. The original assignment to Otsuka Pharmaceutical Co., Ltd. of U.S. Patent Application No. 10/556,600 that led to U.S. Patent No. 9,125,939 was recorded in the Office on August 2, 2006, at reel 018201, frame 0916.

II. Related Matters – 37 C.F.R. § 42.8(b)(2)

Otsuka Pharmaceutical Co., Ltd. (“Otsuka”) asserted U.S. Patent No. 9,125,939 (“the ’939 patent”) against Defendants Stason Industrial Corp. (“Stason Industrial”), Stason Pharmaceuticals Inc. (collectively, “Stason”), Zhejiang Jinhua Conba Bio-Pharm Co., Ltd. (“Zhejiang Jinhua”), Tai Heng Industry Co., Ltd. (“Tai Heng”) and Breckenridge Pharmaceutical, Inc. (“Breckenridge”) in *Otsuka Pharmaceutical Co., Ltd. v. Stason Industrial Corp., et al.*, No. 1:16-cv-00557-JBS-KMW in the United States District Court for the District of New Jersey. This case has been voluntarily dismissed with no prejudice to Otsuka.

U.S. Application No. 14/795,963 (pending) claims benefit of priority to the application that issued as U.S. Patent No. 9,125,939. Patent Owner is not aware of any other related matters that would affect or be affected by this proceeding.

III. Lead and Back-Up Counsel – 37 C.F.R. § 42.8(b)(3)

Pursuant to 37 C.F.R. §§ 42.8(a)(3) and 42.8(b)(3)-(4), Patent Owner designates the following counsel to transact all business in the United States Patent and Trademark Office associated with the above-captioned proceeding.

| Lead Counsel | Back-Up Counsel |
|--|--|
| Erin M. Sommers (Reg. No. 60,974) | James B. Monroe (Reg. No. 33,971) |
| Finnegan, Henderson, Farabow, Garrett & Dunner, LLP | Finnegan, Henderson, Farabow, Garrett & Dunner, LLP |
| 901 New York Avenue, N.W. | 901 New York Avenue, N.W. |
| Washington, D.C. 20001-4431 | Washington, D.C. 20001-4431 |
| Telephone: (202) 408-4292 | Telephone: (202) 408-4159 |
| Fax: (202) 408-4400 | Fax: (202) 408-4400 |
| Email: erin.sommers@finnegan.com | Email: james.monroe@finnegan.com |

IV. Service Information – 37 C.F.R. § 42.8(b)(4)

Please send all correspondence to the lead counsel at the address shown above. Under 37 C.F.R. § 42.6(e), Patent Owner consents to electronic service by e-mail to erin.sommers@finnegan.com and james.monroe@finnegan.com.

Please address all correspondence regarding this proceeding to lead and back-up counsel.

Respectfully submitted,

Dated: December 8, 2016

By: /Erin M. Sommers/
Erin M. Sommers, Reg. No. 60,974
James B. Monroe, Reg. No. 33,971
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413
(202) 408-4000

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PATENT OWNER'S MANDATORY NOTICES** was served on December 8, 2016, via electronic mail directed to counsel of record for the Petitioner at the following:

Theresa C. Kavanaugh
Nicholas K. Mitrokostas
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
tkavanaugh@goodwinlaw.com
nmitrokostas@goodwinlaw.com

Carolyn S. Elmore
Elmore Patent Law Group, P.C.
484 Groton Road
Westford, MA 01886
celmore@elmorepatents.com

Petitioner has agreed to electronic service.

Dated: December 8, 2016

By: /Erin M. Sommers/
Erin M. Sommers, Reg. No. 60,974

FINNEGAN, HENDERSON,
FARABOW, GARRETT &
DUNNER, LLP