

Filed on behalf of Patent Owner Genentech, Inc. by:

David L. Cavanaugh (Reg. No. 36,476)
Rebecca A. Whitfield (Reg. No. 73,756)
Robert J. Gunther, Jr. (*Pro Hac Vice*)
Lisa J. Pirozzolo (*Pro Hac Vice*)
Kevin S. Prussia (*Pro Hac Vice*)
Andrew J. Danford (*Pro Hac Vice*)
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Ave., NW
Washington, DC 20006

Adam R. Brausa Reg. No.
60,287
Daralyn J. Durie (*Pro Hac Vice
to be filed*)
Durie Tangri LLP
217 Leidesdorff Street
San Francisco, CA 94111

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PFIZER, INC.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-01489
U.S. Patent 6,407,213

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

PATENT OWNER'S UPDATED MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner Genentech, 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. 08/146,206, which issued as U.S. Patent No. 6,407,213:

- Patent Cooperation Treaty Application No. PCT/US92/05126, which was filed on June 15, 1992, is the parent international application of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 07/715,272, which was filed on June 14, 1991 and is now abandoned, is the parent application of international application PCT/US92/05126, which is the parent international application of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 08/439,004, which was filed on May 11, 1995 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,407,213;

IPR2017-01489
Patent Owner's Updated Mandatory Notices

- U.S. Patent Application No. 09/115,800, which was filed on July 15, 1998 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 09/705,392, which was filed on November 2, 2000 and issued as U.S. Patent No. 6,719,971, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 09/705,686, which was filed on November 2, 2000 and issued as U.S. Patent No. 6,639,055, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 09/705,398, which was filed on November 2, 2000 and issued as U.S. Patent No. 6,800,738, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 10/835,641, which was filed on April 30, 2004 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 11/444,791, which was filed on June 1, 2006 and is now abandoned, claims the benefit of the priority date of U.S. Patent No. 6,407,213;
- U.S. Patent Application No. 11/969,430, which was filed on January 4, 2008 and issued as U.S. Patent No. 8,075,890, claims the benefit

of the priority date of U.S. Patent NO. 6,407,213.

Additionally, Patent Owner identifies the following matters that relate or may relate to U.S. Patent Application No. 08/146,206, which issued as U.S. Patent No. 6,407,213:

- U.S. Patent No. 6,407,213 is the patent at issue in Celltrion, Inc. v. Genentech, Inc., IPR2017-01373, which is pending;
- U.S. Patent No. 6,407,213 is the patent at issue in Celltrion, Inc. v. Genentech, Inc., IPR2017-01374, which is pending;
- U.S. Patent No. 6,407,213 is the patent at issue in Pfizer, Inc. v. Genentech, Inc., IPR2017-01488, which is pending;
- U.S. Patent No. 6,407,213 is the patent at issue in Boehringer Ingelheim Pharmaceuticals, Inc. v. Genentech Inc., IPR2017-02031 which is pending;
- U.S. Patent No. 6,407,213 is the patent at issue in Boehringer Ingelheim Pharmaceuticals, Inc. v. Genentech Inc., IPR2017-02032 which is pending;
- U.S. Patent No. 6,407,213 is the patent at issue in Samsung Bioepis Co., Ltd. v. Genentech, Inc., IPR2017-02139, which is pending, Petitioner has moved to join IPR2017-01488;

- U.S. Patent No. 6,407,213 is the patent at issue in Samsung Bioepis Co., Ltd. v. Genentech, Inc., IPR2017-02140, which is pending, Petitioner has moved to join IPR2017-01489;
- U.S. Patent No. 6,407,213 was the patent at issue in Mylan Pharmaceuticals Inc. v. Genentech, Inc., IPR2016-01693, which has been terminated;
- U.S. Patent No. 6,407,213 was the patent at issue in Mylan Pharmaceuticals Inc. v. Genentech, Inc., IPR2016-01694, which has been terminated;
- U.S. Patent No. 6,407,213 is a patent at issue in Genentech, Inc. et al. v. Amgen Inc. (D. Del.) 1:17-cv-01407-GMS, which is pending;
- U.S. Patent No. 6,407,213 is a patent at issue in Genentech, Inc. et al. v. Amgen Inc. (C.D. Cal.) 2:17-cv-07349-GW-AGR, which is pending; and
- U.S. Patent No. 6,407,213 is a patent at issue in Genentech, Inc. et al. v. Pfizer, Inc. (D. Del.) 1:17-cv-01672, which is pending.

Patent Owner does not concede that any of the above-identified patents, applications, or proceedings, aside from U.S. Patent No. 6,407,213, would affect, or be affected by, a decision in the present IPR.

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.