

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAR PHARMACEUTICAL, INC.,
Petitioner

v.

HORIZON THERAPEUTICS, LLC,
Patent Owner

Case IPR2017-01768
Patent 9,095,559

PATENT OWNER'S UPDATED MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a), the Patent Owner submits the following updated mandatory notices. Specifically, related matters are updated as follows:

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

The following judicial and administrative matters may affect or be affected by a decision in this proceeding:

- (a) IPR2015-01127, petition filed April 29, 2015, by the present Petitioner, directed at U.S. Patent 8,404,215, which is the parent of the patent at issue in this case. The Board instituted trial in an institution decision dated November 4, 2015, and issued a final written decision on September 29, 2016.
- (b) IPR2016-00284, directed at U.S. Patent 8,404,215. The petition was filed December 4, 2015 by Lupin Ltd. and Lupin Pharmaceuticals, Inc. and joined with IPR2015-01127.
- (c) IPR2016-00829, directed at U.S. Patent 9,095,559, the patent at issue in this case. The petition was filed April 1, 2016, by Lupin Ltd. and Lupin Pharmaceuticals, Inc. The Board instituted trial in an institution decision dated September 30, 2016, and issued a final written decision on September 26, 2017.
- (d) IPR2017-01159, directed at U.S. Patent 9,254,278, which is a child of the patent at issue in this case. The petition was filed March 27, 2017

by Lupin Ltd. and Lupin Pharmaceuticals, Inc. The Board instituted trial in an institution decision dated September 28, 2017, and granted the parties' Joint Motion to Terminate on July 26, 2018.

- (e) IPR2017-01160, directed at U.S. Patent 9,326,966, which is a grandchild of the patent at issue in this case. The petition was filed March 27, 2017 by Lupin Ltd. and Lupin Pharmaceuticals, Inc. The Board instituted trial in an institution decision dated September 28, 2017, and granted the parties' Joint Motion to Terminate on July 26, 2018.
- (f) IPR2017-01767, petition filed the same date as this petition, by the present Petitioner, directed at U.S. Patent 9,254,278, which is a child of the patent at issue in this case. The Board instituted trial in an institution decision dated January 30, 2018.
- (g) IPR2017-01769, petition filed the same date as this petition, by the present Petitioner, directed at U.S. Patent 9,326,966, which is a grandchild of the patent at issue in this case. The Board instituted trial in an institution decision dated January 30, 2018.
- (h) *Horizon Therapeutics, LLC v. Iancu*, Appeal No. 2018-1225 to the Federal Circuit from the Board's Final Written Decision in IPR No.

IPR2016-00829 concerning U.S. Patent 9,095,559, the patent at issue in this case.

- (i) *Hyperion Therapeutics Inc. v. Par Pharmaceutical, Inc.*, Civil Action No. 2:14-cv-00384-JRG-RSP (E.D. Tex. filed April 23, 2014). The Complaint asserts infringement of U.S. Patent No. 8,404,215, which is the parent of the patent at issue in this case, and unrelated U.S. Patent No. 8,642,012. On December 14, 2015, the district court stayed that case pending resolution of IPRs. On March 30, 2017, the district court continued the stay pending the resolution of Par's Appeal No. 2017-1451. On August 9, 2018, Horizon filed a voluntary dismissal without prejudice.
- (j) *Horizon Therapeutics Inc. v. Par Pharmaceutical Inc.*, Civil Action No. 1:16-cv-03910-RBK-JS (D.N.J. filed June 30, 2016). The Complaint asserts infringement of U.S. Patent Nos. 9,095,559, 9,254,278; and 9,326,966. On November 15, 2016, the district court stayed that case pending resolution of IPR2016-00829. On October 5, 2017, the district court continued the stay pending resolution of Horizon's Appeal No. 2018-1225.
- (k) *Horizon Therapeutics Inc. v. Lupin Ltd. and Lupin Pharmaceuticals, Inc.*, Civil Action No. 1:15-cv-07624-RBK-JS (D.N.J. filed Oct. 19,

2015). The Complaint asserts infringement of U.S. Patent No. 9,095,559. On July 10, 2018, the case was dismissed pursuant to a joint stipulation.

- (l) *Horizon Therapeutics Inc. v. Lupin Ltd. and Lupin Pharmaceuticals, Inc.*, Civil Action No. 1:16-cv-04438-RBK-JS (D.N.J. filed Jul. 21, 2016). The Complaint asserts infringement of U.S. Patent Nos. 9,254,278 and 9,326,966. On July 10, 2018, the case was dismissed pursuant to a joint stipulation.
- (m) U.S. Patent No. 9,999,608, issued June 19, 2018, which claims benefit of the patent under review.
- (n) U.S. Patent No. 9,962,358, issued May 8, 2018, which claims benefit of the patent under review.
- (o) U.S. Patent No. 9,962,359, issued May 8, 2018, which claims benefit of the patent under review.
- (p) U.S. Patent No. 10,045,958, issued on August 14, 2018, which claims benefit of the patent under review.
- (q) U.S. Patent No. 10,045,959, issued on August 14, 2018, which claims benefit of the patent under review.
- (r) Pending U.S. Patent Appl. No. 15/699,209, filed September 8, 2017, which claims benefit of the patent under review.

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