

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOEHRINGER INGELHEIM PHARMACEUTICALS, INC.
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02032
U.S. Patent 6,407,213

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

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner Genentech, Inc. respectfully submits the following Mandatory Notices.

I. REAL PARTY IN INTEREST

The real party in interest is Genentech, Inc.

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;

- 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:

- Petitioner has simultaneously challenged U.S. Patent No. 6,407,213 in Boehringer Ingelheim Pharmaceuticals, Inc. v. Genentech Inc., IPR2017-02031;
- 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 Pfizer, Inc. v. Genentech, Inc., IPR2017-01489, which is pending;
- 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.

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.

III. COUNSEL

Lead Counsel:

David L. Cavanaugh, Reg. No. 36,476

Back-up Counsel:

Robert J. Gunther, Jr., *Pro Hac Vice* motion to be submitted

Owen K. Allen, Reg. No. 71,118

Adam R. Brausa, Reg. No. 60,287

Daralyn J. Durie, *Pro Hac Vice* motion to be submitted

Andrew J. Danford, *Pro Hac Vice* motion to be submitted

Lisa J. Pirozzolo, *Pro Hac Vice* motion to be submitted

Kevin S. Prussia, *Pro Hac Vice* motion to be submitted

A power of attorney is being filed concurrently with these Mandatory Notices.

IV. SERVICE INFORMATION

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