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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG BIOEPIS CO., LTD.,
Petitioner,

v.

GENENTECH, INC.,
Patent Owner.

Case IPR2017-02139
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 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;

IPR2017-02139
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 Pfizer, Inc. v. Genentech, Inc., IPR2017-01489, 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., IPR2017-02140, 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.

III. COUNSEL

Explore Litigation Insights

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Sync your system to PACER to automate legal marketing.