

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Aurobindo Pharma USA Inc.
Petitioners,

v.

Andrx Labs, LLC
Patent Owner

Case IPR2018-00530
U.S. Patent No. 6,790,459

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

PATENT OWNER MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Patent Owner Andrx Labs, LLC, respectfully submits the following Mandatory Notices.

I. REAL PARTY IN INTEREST

Based on the Patent Owner's current understanding, the real parties-in-interest ("RPI") are Andrx Labs, LLC, Teva Pharmaceuticals USA Inc., and Shionogi Inc. The Patent Owner continues its investigation regarding entities which should be named as RPIs and will update these Mandatory Notices if and as needed.

II. RELATED MATTERS

IPR2017-01673 challenged claims in U.S. Patent No. 6,790,459. The Decision on Institution dated December 29, 2017, denied institution and the IPR is now terminated. Additionally, the Petitioner has filed IPR2017-01648 (currently pending) challenging claims in U.S. Patent No. 6,866,866. The Patent Owner identifies U.S. Patent No. 6,866,866 patent herein for the sake of completeness and does not concede that any matters identified below involving U.S. Patent No. 6,866,866 would affect or be affected by the outcome of this proceeding.

Patent Owner is unaware of any U.S. patent applications and issued patents that relate to U.S. Patent Application No. 09/705,625, which issued as U.S. Patent No. 6,790,459.

Additionally, Patent Owner identifies the following matters that relate or may relate to U.S. Patent Application No. 09/705,630, which issued as U.S. Patent No. 6,866,866 and U.S. Patent Application No. 09/705,625, which issued as U.S. Patent No. 6,790,459:

- U.S. Patent No. 6,866,866 was a patent-in-suit in *Sciele Pharma Inc. et al. v. Lupin Ltd., et al.*, 1:09-cv-00037 (D. Del. Jan. 15, 2009), which is now closed;
- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Sciele Pharma, Inc. et al v. Lupin Ltd. et al.*, No. 1-09-cv-00105 (D. Md. Jan. 16, 2009), which is now closed;
- U.S. Patent No. 6,866,866 was a patent-in-suit in *Shionogi Pharma Inc. et al. v. Mylan Inc., et al.*, 1:10-cv-00135 (D. Del. Feb. 18, 2010), which is now closed;
- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Takeda Pharmaceutical Company Limited et al v.*

Mylan, Inc. et al., No. 1-12-cv-00024 (S.D. N.Y. Jan. 3, 2012), which is now closed;

- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Takeda Pharmaceutical Co., Ltd., et al. v. Mylan, Inc., et al.*, No. 2-12-cv-00026 (W.D. Pa. Jan. 6, 2012), which is now closed;
- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Takeda Pharmaceutical Company Limited et al v. Mylan, Inc. et al.*, No. 1-12-cv-02038 (S.D. N.Y. Mar. 20, 2012), which is now closed;
- U.S. Patent No. 6,866,866 was a patent-in-suit in *Sciele Pharma Inc. et al. v. Lupin Ltd., et al.*, No. 2012-1228 (Fed. Cir. July 2, 2012), which is now closed;
- U.S. Patent No. 6,866,866 was a patent-in-suit in *Shionogi Inc. et al. v. Nostrum Laboratories, Inc., et al.*, 1:12-cv-04402 (D. N.J. July 13, 2012), which is now closed;
- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Shionogi Inc. and Andrx Labs, L.L.C. v. Aurobindo Pharma Ltd. et al.*, Civ. Act. No. 1:17-cv-00072-MSG (D. Del. Jan. 25, 2017), which remains pending; and

- U.S. Patent No. 6,866,866 and U.S. Patent No. 6,790,459 were patents-in-suit in *Shionogi Inc. and Andrx Labs, L.L.C. v. Qingdao Baheal Pharmaceutical Co. Ltd.*, Civ. Act. No. 1:17-cv-1347-MSG (D. Del. Sept. 22, 2017), which remains pending.

III. COUNSEL

Lead Counsel:

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

Back-up Counsel:

Jonathan B. Roses, Reg. No. 61,115

David A. Chavous, Reg. No. 66,047

David A. Giordano, Reg. No. 64,480

IV. SERVICE INFORMATION

Electronic mail addresses:

David.Cavanaugh@wilmerhale.com

Jonathan.Roses@wilmerhale.com

dchavous@chavousiplaw.com

davidg@giordanolawllc.com

Electronic service on lead and back up counsel is approved and preferred.

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.