

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN TECHNOLOGIES, INC.

Petitioner

v.

NOVEN PHARMACEUTICALS, INC.

Patent Owner.

Case No. IPR2018-01119

U.S. Patent No. 9,833,419

**NOVEN PHARMACEUTICALS, INC.'S
MANDATORY NOTICES UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Noven Pharmaceuticals, Inc. (“Noven”) provides this Mandatory Notice within 21 days of service of the Petition (Paper 2) on May 18, 2017.

I. Real Party-in-Interest Pursuant to 37 C.F.R. § 42.8 (b)(1):

Noven is the sole owner of U.S. Patent No. 9,833,419 (the “’419 patent”).

Noven Pharmaceuticals, Inc., a wholly owned subsidiary of Hisamitsu Pharmaceutical Co., Inc., and Hisamitsu Pharmaceutical Co., Inc. are the real parties-in-interest with respect to the Patent Owner in IPR2018-01119.

II. Related Matters Pursuant to 37 C.F.R. § 42.8 (b)(2):

Noven is aware of the following judicial or administrative matters that would affect, or be affected by, a decision in the instant proceeding:

The ’419 patent is being asserted in the following patent infringement lawsuits currently pending in the United States District Court for the District of Delaware: (1) *Noven Pharmaceuticals, Inc. v. Alvogen Pine Brook LLC et al.*, C.A. No. 1-17-cv-01429-LPS (D. Del.); (2) *Noven Pharmaceuticals, Inc. v. Mylan Technologies Inc. et al.*, C.A. No. 1-17-cv-01777-LPS (D. Del.); (3) *Noven Pharmaceuticals, Inc. v. Amneal Pharmaceuticals LLC*, C.A. No. 1-18-cv-00699-LPS (D. Del.); and (4) *Noven Pharmaceuticals, Inc. v. Actavis Laboratories UT, Inc.*, C.A. No. 1-18-cv-00758-LPS (D. Del.).

The '419 patent is a continuation of U.S. Patent Application No. 14/738,255, which is a continuation of U.S. Patent Application No. 14/024985, now U.S. Patent No. 9,724,310 (“the '310 patent”). The '310 patent claims benefit of U.S. Patent Application No. 13/553,972, now U.S. Patent 9,730,900 (“the '900 patent”). The '310 patent and the '900 patent are each being asserted in each of the above-listed lawsuits. The '310 patent also is the subject of a petition for *Inter Partes* Review, IPR2018-00173, filed on December 4, 2017, and the '900 patent is the subject of a petition for *Inter Partes* Review, IPR2018-00174, also filed on December 4, 2017.

The '900 patent is a continuation of U.S. Patent Application No. 12/216,811, now U.S. Patent No. 8,231,906 (the '906 patent”). The '906 patent was asserted in the following patent infringement lawsuits currently pending in the United States District Court for the District of Delaware: (1) *Noven Pharmaceuticals, Inc. v. Actavis Laboratories UT Inc.*, C.A. No. 1-15-cv-00249-LPS (D. Del.); (2) *Noven Pharmaceuticals, Inc. v. Actavis Laboratories UT Inc.*, C.A. No. 1-16-cv-00465-LPS (D. Del.); and (3) *Noven Pharmaceuticals, Inc. v. Amneal Pharmaceuticals LLC*, C.A. No. 1-18-cv-00699-LPS (D. Del.). The '906 patent also was the subject of the following patent infringement lawsuits which have terminated: (1) *Alvogen Pine Brook LLC v. Noven Pharmaceuticals, Inc.*, C.A. No. 1-16-cv-00395-LPS (D. Del.); (2) *Noven Pharmaceuticals, Inc. v. Mylan Technologies Inc. et al.*, C.A. No.

1-15-cv-00069 (N.D.W. Va.); and (3) *Noven Pharmaceuticals, Inc. v. Mylan Technologies Inc. et al.*, C.A. No. 1-15-cv-00328-LPS (D. Del.).

U.S. Patent Application No. 14/738,255 is a pending continuing patent application that claims the benefit of the '906, '310, and '900 patents and is the immediate parent application of the '419 patent.

III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. §§ 42.8(b)(3):

Noven designates the following Lead and Back-up Counsel. Since the designated counsel is already counsel of record in the subject patent, a power of attorney is not being concurrently submitted pursuant to 37 C.F.R. § 42.10(b).

Lead Counsel	Back-up Counsel
Courtenay C. Brinckerhoff Reg. No. 37,288 Foley & Lardner LLP 3000 K Street, N.W. , Suite 600 Washington, D.C. 20007-5109 CBrinckerhoff@foley.com Tel: 202-295-4094 Fax: 202-672-5399	Jason N. Mock Reg. No. 69,186 Foley & Lardner LLP 3000 K Street, N.W. , Suite 600 Washington, D.C. 20007-5109 JMock@foley.com Tel: 202-295-4775 Fax: 202-672-5399

IV. Service Information Pursuant to 37 C.F.R. §§ 42.8(b)(4):

Pursuant to the requirements of 37 C.F.R. § 42.8(b)(4), Noven may be served by postal mailing or hand-delivery as follows:

Courtenay C. Brinckerhoff
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Noven also consents to service by electronic mail at:

CBrinckerhoff@foley.com

JMock@foley.com and

FIRM-Novon-MylanIPRs@foley.com.

Any questions concerning this paper may be directed to lead counsel.

Respectfully submitted,

Dated: June 7, 2018

/ Courtenay C. Brinckerhoff/
Courtenay C. Brinckerhoff
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