

Paper No. 9
Filed: Sept. 20, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GRÜNENTHAL GMBH,

Petitioner

v.

ANTECIP BIOVENTURES II LLC,

Patent Owner.

Case PGR2019-00028
U.S. Patent No. 10,052,338

**PETITIONER'S FIRST UPDATED
MANDATORY NOTICES – 37 C.F.R. § 42.8(a)(3)**

Pursuant to 37 C.F.R. § 42.8(a)(3), Grünenthal GmbH (“Grünenthal”) submits the following update to its January 3, 2019 Mandatory Notices (Paper No. 2).

Real Party-in-Interest (§ 42.8(b)(1)):

The real party-in-interest information has not changed.

Related Matters (§ 42.8(b)(2)):

Petitioner has filed petitions for post-grant review against several U.S. patents owned by the Patent Owner, as shown in the following table:

Patent Number	PGR Number	Filing Date	Status
9,283,239	PGR2017-00008	December 14, 2016	Final written decision finding all challenged claims unpatentable
9,408,862	PGR2017-00022	May 8, 2017	Final written decision finding all challenged claims unpatentable
9,539,268	PGR2018-00001	October 10, 2017	Final written decision finding all challenged claims unpatentable; request for rehearing pending
9,707,245	PGR2018-00062	April 18, 2018	PGR instituted and currently pending; oral argument heard July 31, 2019
9,820,999	PGR2018-00092	August 21, 2018	PGR instituted and currently pending
9,867,839	PGR2019-00003	October 16, 2018	PGR instituted and currently pending

9,931,352	PGR2019-00026	January 3, 2019	PGR petition filed concurrently with the instant Petition; instituted and currently pending
10,039,774	PGR2019-00027	January 3, 2019	PGR petition filed concurrently with the instant Petition; instituted and currently pending

All of these matters are related to the instant PGR in that each of the above patents shares the same inventor as the '338 patent and, like the '338 patent, concerns the use of bisphosphonate drugs to treat pain conditions. The '338 patent issued from a continuation of the application that issued as U.S. Patent No. 9,931,352. Moreover, the '338 patent and some of the above patents are in the same or related patent families. In particular, the '338 patent purportedly claims priority to the patent application that issued as U.S. Patent No. 9,820,999 (PGR2018-00092). And the '338 patent, U.S. Patent Nos. 9,707,245 (PGR2018-00062), 9,283,239 (PGR2017-00008), and 9,867,839 (PGR2019-00003) each purportedly claims priority to many of the same applications, including Provisional Application No. 61/646,538 filed on May 14, 2012 and U.S. Patent Application No. 13/894,274, filed on May 14, 2013. Concurrently with the '338 patent Petition, Petitioner filed PGRs challenging U.S. Patent Nos. 10,093,774 (Ex. 1002) and 9,931,352 (Ex. 1001), which also claim methods of treating particular signs

and symptoms of CRPS. The '338 patent is a continuation of the application that issued as the '352 patent.

To Petitioner's best knowledge, the instantly challenged '338 patent is not currently involved in any other judicial or administrative matters that would affect, or be affected by, a decision in this proceeding.

Designation of Lead and Back-Up Counsel (§ 42.8(b)(3)):

The lead counsel information has not changed.

Grünenthal hereby notifies the Board that it is adding Katherine E. Adams as additional back-up counsel. All other counsel information remains the same.

Grünenthal's lead and back-up counsel:

Lead Counsel	Back-up Counsel
Daniel J. Minion Registration No. 53,329 VENABLE LLP 1290 Avenue of the Americas New York, NY 10104 Tel: 212-218-2538 Fax: 212-218-2200 dminion@venable.com	Bruce C. Haas Registration No. 32,734 VENABLE LLP 1290 Avenue of the Americas New York, NY 10104 Tel: 212-218-2290 Fax: 212-218-2200 bchaas@venable.com GrunenthalPGR@venable.com
	Katherine E. Adams Registration No. 73,758 VENABLE LLP 1290 Avenue of the Americas New York, NY 10104 Tel: 212-218-2106 Fax: 212-218-2200 keadams@venable.com

Service Information (§ 42.8(b)(4)):

Please direct all correspondence to lead and back-up counsel at the above addresses and to GrunenthalPGR@Venable.com. Petitioner also consents to electronic service to GrunenthalPGR@Venable.com and to the email addresses above.

Dated: Sept. 20, 2019

By: /Daniel J. Minion/
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