

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALBAAD MASSUOT YITZHAK, LTD. AND ALBAAD USA, INC.,
Petitioner,

v.

EDGEWELL PERSONAL CARE BRANDS, LLC,
Patent Owner.

Case IPR2017-00694
Patent 6,432,075 B1

UPDATED MANDATORY NOTICE PURSUANT TO 37 C.F.R. § 42.8(b)(1)

Pursuant to 37 C.F.R. § 42.8(b)(1), the exclusive licensee, Edgewell Personal Care Brands, LLC (“Edgewell”), hereby submits this Updated Mandatory Notice to supplement the “Real Party-In-Interest” requirement. The Updated Mandatory Notice is in response to the Order issued on April 21, 2017 (Paper 8) by the Board in the present proceeding, and based on advice received from Mr. Andrew Kellogg, Supervisory Paralegal, in an e-mail communication dated April 26, 2017.

Edgewell concurrently submits Ex. 2001, which provides evidence that it has the right and authority to participate in the present proceeding and to defend U.S. Patent No. 6,432,075 (“the ‘075 patent”). See Ex. 2001 (“Confirmation of Exclusive Licensee Edgewell Personal Care Brands, LLC’s Authority to Conduct *Inter Partes* Review”). In the Order (Paper 8 at 3), the Board stated that “the record before us includes no evidence to support the assertion that Edgewell is an exclusive licensee to the ‘075 patent, with a right to participate in this proceeding, or that Edgewell is otherwise authorized to act on behalf of the owner of the ‘075 patent.” The Confirmation in Ex. 2001 provides the sought evidence.

As stated in the initial Mandatory Notice submitted on February 9, 2017, Uni-Charm is the owner of the ‘075 patent by virtue of assignments that have been duly and properly recorded with the U.S. Patent and Trademark Office on November 8, 2000. However, Edgewell is the exclusive licensee with all

substantial rights in the ‘075 patent, including the right to enforce and defend the ‘075 patent in the present *inter partes* review proceedings and in the parallel proceeding for patent infringement that is pending in the United States District Court for the District of Delaware (Case 1:15-cv-01188-RGA). Ex. 2001; *see also* Ex. 2002, Plaintiff’s Second Amended Complaint, ¶¶ 41-42 (Sep. 6, 2016).

The Confirmation provides the evidence sought by the Board to “support the assertion that Edgewell is an exclusive licensee to the ‘075 patent, with a right to participate in this proceeding, or that Edgewell is otherwise authorized to act on behalf of the owner of the ‘075 patent.” IPR2017-00694, Paper 8 at 3. In *ZTE (USA), Inc. v Elec. & Telecomm. Research Instit.*, the Board accepted a similar confirmation document as sufficient evidence that the exclusive licensee had the right to participate in the *inter partes* review on behalf of the patent owner. IPR2015-00029, Paper 12 at 2, n. 1 (PTAB Mar. 20, 2015).

Thus, Edgewell is the effective “patentee” or “patent owner” having the right to participate in the present *inter partes* review proceedings, including the filing of the Patent Owner Preliminary Response. *See also, e.g., Motorola Mobility LLC v. Michael Arnouse*, IPR2013-00010, Paper 27 at 3-4 (PTAB Apr. 5, 2013); *Id.*, Paper 30 at 6 (PTAB Apr. 19, 2013); *Prima Tek II, L.L.C. v. A-Roo Co.*, 222

F.3d 1372 (Fed. Cir. 2000) (holding that an exclusive licensee with all substantial rights is deemed the effective “patentee”).

Respectfully submitted,

Date: April 28, 2017

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EXHIBIT LIST

<u>Exhibit No.</u>	<u>Description</u>
2001	Confirmation of Exclusive Licensee Edgewell Personal Care Brands, LLC's Authority to Conduct <i>Inter Partes</i> Review
2002	Second Amended Complaint in Civil Action No. 1:15-cv-01188-RGA (D. Del.)

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