

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FRESENIUS KABI USA, LLC and
FRESENIUS KABI SWISSBIOSIM GMBH,
Petitioners,

v.

AMGEN INC. and AMGEN MANUFACTURING, LIMITED,
Patent Owner.*

Case IPR2020-00314
Patent 9,856,287

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

* The Petition's caption listed Amgen, Inc. and Amgen Manufacturing, Limited together as the "Patent Owner." Amgen Manufacturing, Limited, however, is an exclusive licensee.

Pursuant to 37 C.F.R. §42.8, Patent Owner Amgen Inc. and its exclusive licensee, Amgen Manufacturing, Limited (together “Amgen”), hereby submit this Mandatory Notice.

I. REAL PARTIES-IN-INTEREST (37 C.F.R. § 42.8(b)(1))

The real parties-in-interest are Patent Owner Amgen Inc. and its exclusive licensee, Amgen Manufacturing, Limited.

II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))

Amgen identifies the following judicial and administrative matters that concern or concerned the '287 patent:

- *Amgen Inc. et al. v. Accord Biopharma*, Case No. 0:18-cv-61828-WPD (S.D. Fla.) (stipulated dismissal approved Nov. 15, 2019);
- *Amgen Inc. et al. v. Kashiv BioSciences, LLC et al.*, Case No. 2:18-cv-03347-CCC-MF (D.N.J.) (stipulated dismissal so-ordered Nov. 25, 2019);
- *Amgen Inc. et al. v. Tanvex BioPharma USA, Inc. et al.*, Case No. 3:19-cv-01374-H-AHG (S.D. Cal.) (joint motion to dismiss granted Dec. 19, 2019);
- *Fresenius Kabi USA, LLC et al. v. Amgen Inc. et al.*, Case IPR2019-00971 (institution denied Oct. 16, 2019) (Paper 13); and

- *Adello Biologics LLC et al. v. Amgen Inc. et al.*, Case PGR2019-00001 (adverse judgment entered against two petitioners Oct. 4, 2019; review terminated due to settlement Dec. 6, 2019) (Papers 23 and 28).

Additionally, related patents are currently being prosecuted. Specifically, the '287 patent application is a continuation of pending U.S. Patent Application No. 14/793,590, which is a continuation of pending U.S. Patent Application No. 14/611,037, which is a divisional of U.S. Patent Application No. 12/820,087, which issued as U.S. Patent No. 8,952,138, and also claims the benefit of U.S. Provisional Application No. 61/219,257. Also, pending U.S. Patent Application No. 15/889,559 claims the benefit of the '287 patent application.

Amgen is not aware of any other judicial or administrative matters that might affect, or be affected by, a decision in the proceeding.

III. LEAD AND BACK-UP COUNSEL (37 C.F.R. § 42.8(b)(3))

Amgen identifies the following lead and back-up counsel:

Lead Counsel

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IV. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))

Amgen consents to service through the counsel identified above. Electronic service of documents must be sent to each of the listed email addresses of the counsel and the group email service address identified above.

To the extent physical documents are served on Amgen, please address any such correspondence to lead counsel and back-up counsel at the following mailing address:

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Dated: January 10, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 10, 2020, I caused a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES UNDER 37 C.F.R. § 42.8 to be served by email on Petitioners' counsel at the addresses listed below:

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