

Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC      Paper \_\_\_\_\_  
Date: October 15, 2013

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SMITH & NEPHEW, INC.

Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC

Patent Owner

Case: IPR2013-00604

Patent 7,087,073

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**PATENT OWNER'S MANDATORY NOTICES**

Pursuant to 37 C.F.R. § 42.8, Patent Owner, BONUTTI SKELETAL INNOVATIONS LLC, submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 7,087,073 (hereinafter the “’073 patent”).

### **1. Real Party-In-Interest**

In accordance with 37 C.F.R. § 42.8(b) (1), Patent Owner identifies the real party-in-interest as the assignee Bonutti Skeletal Innovations LLC. Bonutti Skeletal Innovations LLC is a subsidiary of Advanced Skeletal Innovations LLC, which is a subsidiary of Acacia Research Group LLC, which in turn is a subsidiary of Acacia Research Corporation .

### **2. Related Matters**

In accordance with 37 C.F.R. § 42.8(b) (2), Patent Owner identifies the following related proceedings which may affect or be affected by a decision in this proceeding: *Bonutti Skeletal Innovations LLC v. Smith & Nephew, Inc.*, Civil Action No. 12-1111-GMS (D. Del.), which concerns the ’073 patent which is the subject of this proceeding.

The Patent Owner also identifies the following Inter Partes Reviews which relate to patents which are also involved in the afore-mentioned litigation: (i) IPR2013-00603 regarding U.S. Patent No. 5,980,559, (ii) IPR2013-00620

regarding U.S. Patent No. 6,702,821, (iii) IPR2013-00605 regarding U.S. Patent No. 7,749,229, (iv) IPR2013-00629 regarding U.S. Patent No. 7,806,896, and (v) IPR2013-00621 regarding U.S. Patent No. 8,133,229.

The Patent Owner does not object to the Petitioner's request that the Patent Trial and Appeals Board ("PTAB") have a single Administrative Panel address these six Inter Partes Reviews.

The Patent Owner also identifies the following applications and patents that claim the benefit of the priority of the filing date of the '073 patent, or that the '073 patent claims priority from: U.S. Patent Nos. 6,635,073 and 6,592,609, U.S. Patent Application Serial Nos. 11/460,650, filed July 28, 2006, 11/461,110 filed July 31, 2006, and 11/930,621, filed October 31, 2007, and 14/035,316 filed on September 24, 2013.

### **3. Lead and Back-Up Counsel**

In accordance with 37 C.F.R. § 42.8(b)(3), Patent Owner identifies Cary Kappel as lead counsel and William Gehris as back-up counsel:

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#### **4. Service Information**

In accordance with 37 C.F.R. § 42.8(b) (4), Patent Owner identifies the following service information:

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Respectfully submitted,

October 15, 2013

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*Counsel for Patent Owner*  
BONUTTI SKELETAL INNOVATIONS  
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**CERTIFICATE OF SERVICE**

I hereby certify that on this 15th day of October, 2013, a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES was served by electronic mail and First-Class U.S. Mail, upon the following counsel of record for Petitioner Smith and Nephew, Inc.:

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