

Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC Paper _____
Date: October 16, 2013

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.

Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC

Patent Owner

Case: IPR2013-00629

Patent 7,806,896

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. 7,806,896 (hereinafter the “’896 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 ’896 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) IPR2013-00604 regarding U.S. Patent No. 7,087,073, (iii) IPR2013-00620 regarding U.S. Patent

No. 6,702,821, (iv) IPR2013-00605 regarding U.S. Patent No. 7,749,229, 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 patents that claim the benefit of the priority of the filing date of the '896 patent or that the '896 patent claims priority from: U.S. Patent Nos. 7,104,996, 6,770,078, 6,702,821, 6,503,277, 6,635,073, 6,503,267, 6,423,063, 6,575,982, 6,620,181, 6,468,289, and 8,425,522.

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 16, 2013

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BONUTTI SKELETAL INNOVATIONS
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CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of October, 2013, a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES was served by electronic mail and U.S. Post Office Express Mail, upon the following counsel of record for Petitioner Smith and Nephew, Inc.:

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