

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENEDX, INC.
Petitioner

v.

UNIVERSITY OF UTAH RESEARCH FOUNDATION ET AL.
Patent Owners

Case IPR2014-01316
Patent 5,753,441

**PATENT OWNERS UNIVERSITY OF UTAH RESEARCH FOUNDATION
ET AL.
MANDATORY NOTICES**

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

Pursuant to 37 C.F.R. § 42.8, the patent owners, UNIVERSITY OF UTAH RESEARCH FOUNDATION and the DEPARTMENT OF HEALTH AND HUMAN SERVICES OF THE UNITED STATES OF AMERICA (“Patent Owners”), hereby submit the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 5,753,441.

1. Real Party-In-Interest under 37 CFR § 42.8(b)(1)

UNIVERSITY OF UTAH RESEARCH FOUNDATION and the DEPARTMENT OF HEALTH AND HUMAN SERVICES OF THE UNITED STATES OF AMERICA are the patent owners and real parties-in-interest in this proceeding. Other real parties-in-interest are University of Utah and Myriad Genetics, Inc.

2. Related Matters under 37 CFR § 42.8(b)(2)

The following judicial or administrative matters may affect or be affected by a decision in this proceeding:

Administrative matters: Petitioner, GeneDx, has filed IPR petitions against the following patents that are either owned or licensed by Myriad Genetics:

1. U.S. 7,838,237 (IPR 2014-01296);
2. U.S. 7,670,776 (IPR 2014-01298);

3. U.S. 7,563,571 (IPR 2014-01299);
4. U.S. 7,622,258 (IPR 2014-01301);
5. U.S. 5,654,155 (IPR 2014-01310);
6. U.S. 6,033,857 (IPR 2014-01311);
7. U.S. 6,083,698 (IPR 2014-01312);
8. U.S. 6,051,379 (IPR 2014-01313);
9. U.S. 6,951,721 (IPR 2014-01314);
10. U.S. 7,470,510 (IPR 2014-01315).

Judicial matters: The '441 patent was asserted against GeneDx in *Univ. of Utah Research Found. et al., v. GeneDx, Inc.*, No. 2:13-CV-00954-RJS (D. Utah), filed on October 16, 2013. The '441 patent is also currently involved in the following judicial proceedings: *Univ. of Utah Research Found., et al. v. Ambry Genetics Corp.*, 2:13-cv-00640- RJS (D. Utah); *Quest Diagnostics Inc. et al. v. Myriad Genetics, Inc.*, No. 13-CV-1587-AG (C.D. Cal.); *Univ. of Utah Research Found., et al. v. Quest Diagnostics Inc. et al.*, 2:13-CV-00967-RJS (D. Utah); *Counsyl Inc. v. Myriad Genetics, Inc.*, No. 5:13-cv-04391-EJD (N.D. Cal.); *InVitae Corp. v. Myraid Genetics, Inc.*, 3:13-cv-05495 (N.D. Cal.); *Univ. of Utah Research Found., et al. v. Laboratory Corp. of America Holdings*, 2:13-cv-01069-RJS (D. Utah); and *Univ. of Utah Research Found., et al. v. Pathway Genomics Corp.*, 2:14-cv-000442-RJS (D. Utah). The above actions have been transferred to and

consolidated for pretrial proceedings in the District of Utah by the Judicial Panel on Multidistrict Litigation. *In re: BRCA1- and BRCA2-Based Hereditary Cancer Test Patent Litigation*, MDL Case No. 2:14-MD-02510-RJS.

3. Lead and Back-Up Counsel, under 37 CFR § 42.8(b)(3)

The Patent Owner designates the following lead and back-up counsel:

LEAD COUNSEL	BACK-UP COUNSEL
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4. Service Information under 37 CFR § 42.8(b)(4)(i) *et seq.*

Please address all correspondence and service to both counsel as listed above. Patent Owner consents to service by email at IPR28496-0025IP1@fr.com (ref.: Docket No. 28496-0025IP).

Respectfully submitted,

Date: September 22, 2014/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on September 22, 2014, a complete and entire copy of this Patent Owner UNIVERSITY OF UTAH RESEARCH FOUNDATION ET AL. Mandatory Notices and Power of Attorney were provided via email, to the Petitioner by serving the correspondence address of record as follows:

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