UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMVIE, INC. AND ZIMMER BIOMET SPINE, INC.,[1]
Petitioners

v.

ROGER P. JACKSON,
Patent Owner

Case IPR2023-01433
U.S. Patent No. 11,129,646

PETITIONERS' UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. §42.8(a)(3)

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[1] As described herein, after the filing of the Petition in this proceeding, Zimmer Biomet Spine, Inc. changed its corporate form from a corporation to a limited liability company. Petitioners respectfully request that the caption be changed to reflect that Zimmer Biomet Spine, LLC, rather than Zimmer Biomet Spine Inc., is a Petitioner. *See, e.g., Ring Central, Inc. v. Estech Systems IP, LLC*, IPR2021-00573, Paper 30 at 2 n.1 (PTAB Oct. 4, 2022) (changing case caption based on change in Patent Owner identified in Patent Owner Mandatory Notice). Petitioners are also agreeable to formally seeking authorization to file a motion to change the caption pursuant to 37 C.F.R. §42.20 *et seq.*

Pursuant to 37 C.F.R. § 42.8(a)(3), Petitioners submit the following updated mandatory notices reflecting: (1) the conversion of Zimmer Biomet Spine, Inc. to Zimmer Biomet Spine, LLC, and to list Zimmer Biomet Spine, LLC as a real-party-in-interest; and (2) the current status of related matters.

1. REAL PARTIES-IN-INTEREST **(UPDATED)**

Petitioners are the real parties-in-interest for this petition. Petitioner Zimmer Biomet Spine, Inc. converted to a Delaware limited liability company on February 20, 2024 and is now known as Zimmer Biomet Spine, LLC. Petitioner Zimmer Biomet Spine, LLC is a subsidiary of Petitioner ZimVie, Inc. No parties other than Petitioners are funding, controlling, or directing this petition.

2. RELATED MATTERS **(UPDATED)**

The ’646 Patent is subject to a pending lawsuit entitled *Jackson v. ZimVie Inc.*, No. 1:22-cv-00891-RGA (D. Del. Filed June 30, 2022) (the “Litigation”). In the Litigation, Patent Owner has asserted claims of infringement, and Petitioner ZimVie, Inc. is the defendant.

Concurrently with the filing of the petition for this IPR, Petitioners filed three additional petitions seeking inter partes review of related U.S. Patent Nos. 8,911,479 (EX1009); 10,548,641 (EX1010); and 10,898,233 (EX1011) (the “’479,” “’641,” and “’233 Patent,” respectively; collectively, “the Related Patents”). The ’479 Patent is the subject of IPR2023-01430, the ’641 Patent is the subject of IPR2023-

01431, and the ’233 Patent is the subject of IPR2023-01432. For IPR2023-01431 and IPR2023-01432, the Board has not yet issued decisions on institution. For IPR2023-01430, subsequent to the filing of the Petition, Patent Owner Roger P. Jackson filed a statutory disclaimer disclaiming all of the claims of the ’479 Patent, and thus the Board did not institute trial as to the ’479 Patent. *See* IPR2023-01430, Paper 8.

The Related Patents are also at issue in the Litigation. The ’646 Patent is a continuation of the Related Patents.

3. LEAD AND BACK-UP COUNSEL

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Petitioners hereby identify their lead and backup counsel as follows:

Lead	Backup
Victor P. Jonas Reg. No. 58,590 FAEGRE DRINKER BIDDLE & REATH LLP 2200 Wells Fargo Center 90 South Seventh Street Minneapolis, MN 55402-3901 VictorJonasPTAB@FaegreDrinker.com Telephone: (612) 766-7611 Facsimile: (612) 766-1600	**Kevin P. Wagner** FAEGRE DRINKER BIDDLE & REATH LLP 2200 Wells Fargo Center 90 South Seventh Street Minneapolis, MN 55402-3901 Kevin.Wagner@FaegreDrinker.com Telephone: (612) 766-6922 Facsimile: (612) 766-1600 *Admission pro hac vice to be Requested*
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Please address all correspondence to the lead and back-up counsels at the addresses shown above. Petitioners also consent to electronic service to all of the email addresses shown above.

FAEGRE DRINKER BIDDLE & REATH LLP

Dated: April 1, 2024

By: *__/ Victor P. Jonas /_____*

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on April 1, 2024, I caused a true and accurate copy of Petitioners' Updated Mandatory Notices to be served on counsel for Patent Owner via email, as follows:

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Patrick Muffo
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Dated: April 1, 2024

By: *__/ Victor P. Jonas /_____*

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