

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CATALYST ORTHOSCIENCE INC.,
Petitioner,

v.

SHOULDER INNOVATIONS, INC.,
Patent Owner.

Case PGR2024-00042
Patent 11,771,561

**PETITIONER CATALYST ORTHOSCIENCE INC.'S
UPDATED MANDATORY NOTICES UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Petitioner Catalyst OrthoScience Inc. ("Petitioner") respectfully submits the following updated mandatory notices in response to the Board conditionally granting Petitioner's Motions for Admission *pro hac vice* of John F. Bennett and Ava. M Bowden.

A. REAL PARTY-IN-INTEREST

The real party-in-interest is Petitioner, Catalyst OrthoScience Inc.

B. RELATED MATTERS

Patent Owner has asserted the '561 Patent against Petitioner in *Shoulder Innovations, Inc. v. Catalyst OrthoScience Inc.*, C.A. No. 24-00266-JPM (D. Del.). Petitioner filed counterclaims for non-infringement and invalidity of the '561 Patent in that case. On October 11, 2024, Petitioner filed a PGR petition challenging the claims of U.S. Patent No. 12,023,254 ("the '254 Patent"), which Patent Owner has also asserted against Petitioner in the Lawsuit. *See Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc.*, No. PGR2025-00001 (PTAB) ("the '254 Petition"). The '254 Patent and the '561 Patent both claim priority to application serial no. 17/435,333, filed as PCT/US2020/022094 on March 11, 2020, and to provisional application no. 62/816,708, filed on March 11, 2019. As of the filing of this updated Mandatory Notice, PTAB has not made an institution decision regarding the '254 Petition. The Challenged Claims in this petition are nearly identical to those in the '254 Petition. The prior art relied on here significantly overlaps the prior art relied

on in the '254 Petition. Based on information Patent Owner included in its Mandatory Notices filed in connection with the '254 Petition, U.S. Patent Application No. 18/761,202 is related to the '254 Patent and is currently pending before the Office. Petitioner is not aware of any other judicial or administrative matters that would affect, or be affected by, a decision in this proceeding.

C. LEAD AND BACK-UP COUNSEL

Petitioner designates the following counsel as its representatives for this proceeding and has filed a power of attorney herewith to this effect:

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D. SERVICE INFORMATION

Petitioner consents to electronic service by email of all documents and correspondence related to this proceeding. Any information related to this

proceeding should be sent to Petitioner's lead and back-up counsel using the contact information above.

Dated: November 18, 2024

/Paul M. Ulrich/

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Updated Mandatory Notices

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that a copy of the foregoing UPDATED MANDATORY NOTICES has been served via electronic mail upon the following counsel of record for the Patent Owner:

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