

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.
Petitioner

v.

ENDOTACH LLC
Patent Owner

Case IPR2014-00100
Patent 5,593,417

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

**ENDOTACH LLC'S MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, the Patent Owner submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review Under 37 C.F.R. § 42.100.

1. Real Party-In-Interest (37 C.F.R. § 42.8(b)(1))

Endotach LLC is the exclusive licensee of all substantial interests in U.S. Patent No. 5,593,417 (“the ’417 patent”). Endotach LLC is a wholly owned subsidiary of Acacia Research Corp., a publicly traded company.

The Marital Deduction Trust, created under the Valentine J. Rhodes Revocable Trust, is the owner of the ’417 Patent.

2. Related Matters (37 C.F.R. § 42.8(b)(2))

The following judicial matters, in which the ’417 patent is at issue, may affect or be affected by a decision in this proceeding:

(a) *Endotach LLC v. Cook Medical Incorporated*, Civil Action No. 1:13-cv-1135, pending in the Southern District of Indiana, Indianapolis Division;

(b) *Endotach LLC v. Medtronic, Inc. and Medtronic Vascular, Inc.*, Civil Action No. 5:13-cv-3292, pending in the Northern District of California, San Jose Division; and

(c) *Endotach LLC v. W.L. Gore & Associates, Inc.*, Civil Action No. 3:12-cv-00308, filed in the Northern District of Florida, Pensacola Division, now resolved.

3. Lead and Back-Up Counsel (37 C.F.R. § 42.8(b)(3))

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Patent Owner provides the following designation of counsel:

<p>Lead Counsel:</p> <p>Matthew Phillips (Reg. No. 43,403) Renaissance IP Law Group LLP 9600 S.W. Oak St. Suite 560 Portland, OR 97223 Phone: (503) 419-6425 Fax: (503) 517-9919 matthew.phillips@renaissanceiplaw.com</p>	<p>Back-up Counsel:</p> <p>Brett M. Pinkus (Reg. No. 59,980) Friedman, Suder & Cooke 604 E. Fourth Street, Suite 200 Fort Worth, TX 76102 Phone: (817) 334-0400 Fax: (817) 334-0401 pinkus@fsclaw.com</p> <p>Jonathan T. Suder (<i>pro hac vice</i> motion pending) Friedman, Suder & Cooke 604 E. Fourth Street, Suite 200 Fort Worth, TX 76102 Phone: (817) 334-0400 Fax: (817) 334-0401 jts@fsclaw.com</p>
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Pursuant to 37 C.F.R. § 42.10(b), Power of Attorneys for lead and back-up counsel are filed herewith.

A motion seeking *pro hac vice* admission for back-up counsel Jonathan T. Suder pursuant to 37 C.F.R. § 42.10(c) is filed herewith.

4. Service Information (37 C.F.R. § 42.8(b)(4))

Service of any documents via hand-delivery may be made at the postal mailing address for the respective lead or back-up counsel designated above with courtesy copies to each of their respective email addresses.

5. Payment of Fees under 37 C.F.R. § 42.103

The undersigned authorizes the U.S. Patent and Trademark Office to charge any applicable fees associated with this proceeding to Deposit Account No. 50-5836.

Respectfully submitted,

Date: 2013 Nov. 21

By: / M.C. Phillips /

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Lead Counsel for Patent Owner

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CERTIFICATE OF SERVICE

I hereby certify that on this the 21st day of November, 2013, a true and correct copy of the foregoing PATENT OWNER'S MANDATORY NOTICES UNDER 37 C.F.R. § 42.8, were served via electronic mail upon jack.barufka@pillsburylaw.com, ngai.zhang@pillsburylaw.com, and docket_ip@pillsburylaw.com and via EXPRESS MAIL® upon counsel of record for Petitioners at the following addresses:

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