

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Mercedes-Benz USA, LLC,
Petitioner

v.

American Vehicular Sciences LLC
Patent Owner

Patent No. 6,738,697

Filing Date: July 3, 2002

Issue Date: May 18, 2004

Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

Inter Partes Review No. 2014-00645

**AMERICAN VEHICULAR SCIENCES LLC'S
MANDATORY NOTICES UNDER 37 C.F.R. 42.8(a)(2)**

Patent Owner, American Vehicular Sciences LLC hereby files mandatory notices pursuant to 37 C.F.R. § 42.8(a)(2).

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

American Vehicular Sciences LLC is the owner of the entire interest in U.S. Patent No. 6,738,697 (“the ‘697 Patent”), and thus is a real-party-in-interest.

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

The Patent Owner identifies the following judicial and/or administrative matters that may affect, or may be affected by, a decision in this *Inter Partes* Review:

The '697 patent is asserted by the Patent Owner in the following litigations pending in the U.S. District Court for the Eastern District of Michigan:

American Vehicular Sciences LLC v. Hyundai Motor Co., et al., no. 2:14-cv-13247, filed August 21, 2014 (originally filed in 2012 in E.D. Tex.); *American Vehicular Sciences LLC v. Kia Motors Corp., et al.*, no. 2:14-cv-13249 (originally filed August 21, 2014 in E.D. Tex.); *American Vehicular Sciences LLC v. American Honda Motor Co., Inc. et al.*, no. 2:14-cv-13251 (E.D. Mich.) (originally filed August 21, 2014 in E.D. Tex.). Patent Owner is not aware of any other litigations involving the '697 patent.

The '697 patent was previously the subject of two IPR petitions (IPR2013-00412, -00413) filed by Toyota Motor Corp. on July 8, 2013. Toyota and AVS reached a settlement agreement, and the petitions were dismissed pursuant to U.S.C. § 317. The '697 patent is also the subject of an IPR petition (IPR2014-00634) filed by American Honda Motor Co. on April 15, 2014 and an IPR petition

(see IPR2014-01543) filed by Hyundai Motor Co. on September 25, 2014, which was joined with IPR2014-00634.

The following applications claim the benefit of the '697 patent application's filing date and are pending: Application Nos. 11/930,590, 11/940,669, 12/020,684, 13/464,841 13/848,755, 13/964,143, 14/084,924, 14/275,003, 14/332,615, 14/332,622, 14/332,647.

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

Patent Owner designates the following counsel:

| Lead Counsel | Back-Up Counsel |
|--|---|
| Name Thomas J. Wimbiscus (Reg. No. 36,059) (twimbiscus@mcandrews-ip.com) Direct: 312-775-8109 | Name Scott P. McBride (Reg. No. 42,853) (smcbride@mcandrews-ip.com) Direct: 312-775-8131 |
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D. Service Information (37 C.F.R. § 42.8(b)(4))

Please direct all correspondence regarding this proceeding to the lead

counsel at the address listed above. Patent Owner also consents to electronic service by e-mail to AVS-IPR@mcandrews-ip.com.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with this proceeding to Deposit Account 13-0017 (Customer ID 23446).

Dated: November 19, 2014

Respectfully submitted,

By: /Thomas J. Wimbiscus/
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CERTIFICATE OF SERVICE

I hereby certify that American Vehicular Sciences LLC's Mandatory Notices Under 37 C.F.R. 42.8(a)(2) were served on this 19th day of November by electronic mail to the following:

| Lead Counsel | Back-up Counsel |
|--|---|
| Scott W. Doyle (Reg. No. 39176) scott.doyle@shearman.com Shearman & Sterling LLP 801 Pennsylvania Ave., NW Ste. 900 Washington, DC 20004 T: (202) 508-8000 | Jonathan R. DeFosse (<i>pro hac</i> to be requested) jonathan.defosse@shearman.com Shearman & Sterling LLP 801 Pennsylvania Ave., NW Ste. 900 Washington, DC 20004 T: (202) 508-8000 |

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