| UNITED STATES PATENT AND TRADEMARK OFFICE |
|---|
| |
| BEFORE THE PATENT TRIAL AND APPEAL BOARD |
| |
| FORD MOTOR COMPANY Petitioner |
| V. |
| PAICE LLC & THE ABELL FOUNDATION, INC. Patent Owner |
| |
| Case IPR2014-01416 Patent 7,237,634 |

PATENT OWNER PAICE LLC & THE ABELL FOUNDATION, INC. MANDATORY NOTICES



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

Pursuant to 37 C.F.R. § 42.8, the patent owners, Paice LLC & The Abell Foundation, Inc. ("Patent Owners"), hereby submit the following Mandatory Notices in response to the Petition for *Inter Partes* Review of U.S. Patent No. 7,237,634 ("the '634 patent").

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

Paice LLC & The Abell Foundation, Inc. are the Patent Owners and the Real Parties-In-Interest in this proceeding.

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:

Paice LLC et al. v. Ford Motor Company, Case Number 1-14-cv-00492 filed on February 19, 2014 in the District of Maryland, Baltimore Division.

Paice LLC et al. v. Hyundai Motor America, et al., Case Number 1:2012-cv-00499, District of Maryland, Baltimore Division filed on February 16, 2012.



Patents in the same family as the '634 patent are subject to *inter partes review* petitions in IPR2014-00568, IPR2014-00570, IPR2014-00571, IPR2014-00579, IPR2014-00852, IPR2014-00875, IPR2014-00884, IPR2014-00904 and IPR2014-01415.

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 |
|-----------------------------------|----------------------------------|
| Timothy W. Riffe, Reg. No. 43,881 | Kevin E. Greene, Reg. No. 46,031 |
| 3200 RBC Plaza | 3200 RBC Plaza |
| 60 South Sixth Street | 60 South Sixth Street |
| Minneapolis, MN 55402 | Minneapolis, MN 55402 |
| Tel: (202) 783-5070 | Tel: (202) 783-5070 |
| Fax: (202) 783-2331 | Fax: (202) 783-2331 |
| Email: Riffe@fr.com | Email: Greene@fr.com |
| <u>IPR36351-0015IP2@fr.com</u> | <u>IPR36351-0015IP2@fr.com</u> |
| | |
| | |

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 Riffe@fr.com, Greene@fr.com, and IPR36351-0015IP2@fr.com (ref.: Docket No. 36351-0015IP2).



Respectfully submitted,

Date: 9/19/14 /Kevin E. Greene/

Kevin E. Greene Reg. No. 46,031

Customer Number 26171 Fish & Richardson P.C.

Telephone: (612) 337-2508 Facsimile: (612) 288-9696



CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on September 19, 2014, a complete and entire copy of this Patent Owner Paice LLC's & The Abell Foundation, Inc.'s Mandatory Notices and Power of Attorney were provided via email by serving the correspondence email address of record as follows:

Frank A. Angileri
John E. Nemazi, John P. Rondini, Erin K. Bowles
Brooks Kushman P.C.
1000 Town Center
Twenty-Second Floor
Southfield, Michigan 48075

Email: FPGP0104IPR3@brookskushman.com

Lissi Mojica Kevin Greenleaf Dentons US LLP 233 South Wacker Drive, Suite 7800 Chicago, IL 60606-6306

Email: lissi.mojica@dentons.com
Email: leven.greenleaf@dentons.com
Email: iptdocketchi@dentons.com

/ Susan C. Johnson/

Susan C. Johnson Fish & Richardson P.C. 60 South Sixth Street, Suite 3200 Minneapolis, MN 55402 (214) 292-4086

