

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROBERT BOSCH LLC AND DAIMLER AG,

Petitioners

v.

ORBITAL AUSTRALIA PTY LTD
F/K/A ORBITAL ENGINE COMPANY (AUSTRALIA) PTY. LTD.,

Patent Owner

Case No. IPR2015-01258
U.S. Patent 5,655,365

NOTICE REGARDING SERVICE

In response to the Board’s request for an explanation regarding the address of service of the petition, Petitioners submit the following statement.

On June 16, 2015, Petitioners filed the petition and served it, along with the associated Powers of Attorney and Exhibits on the Patent Owner at the correspondence address of record listed on Public PAIR:

Charles Marmelstein
Robert Murray, Jr.
George Oram, Jr.
Nikaido Marmelstein Murray & Oram
655 15th Street, NW, Suite 330
Metropolitan Square, G Street Lobby
Washington, DC 20005

See Ex. 1012 at ¶ 2 (citing Appendices A and B). Service, however, could not be completed, as it was returned as “Incorrect Address - Recipient Moved.” Ex. 1012 at ¶ 5 (citing Appendix D); *see also id.* at ¶ 7 (citing Appendix B).

On June 17, 2015, Petitioners attempted again to properly serve the Patent Owner, by forwarding the service documents to Mr. Kevin C. Brown, the attorney who signed the issue fee transmittal for the ’365 patent, at the following address:

Kevin C. Brown
Burr & Brown, Attorneys at Law
101 South Salina Street
Seventh Floor
Syracuse, NY 13202

Ex. 1012 at ¶ 5 (citing Appendix E). However, Mr. Brown returned service, claiming that he “left the firm of Nikaido Marmelstein Murray & Oram in 1998, and [does]

not represent Orbital Engine Company PTY., Ltd.” Ex. 1012 at ¶ 6 (citing Appendix F).

Additionally, to ensure that the Patent Owner was properly served and received notice of the pending IPR Petition against the ’365 patent, Petitioner also served copies of the petition, associated Power of Attorney documents, and Exhibits on Patent Owner’s litigation counsel on June 16, 2015 at the following address:

Gregory D. Len
Pepper Hamilton LLP
19th Floor, High Street Tower
125 High Street
Boston, MA 02110-2736

Ex. 1012 at ¶ 3 (citing Appendix C).

Patent Owner, therefore, was properly served, at least by virtue of service effectuated on Gregory D. Len, litigation counsel for Orbital Australia Pty. Ltd. Although the Certificate of Service on the Petition for Inter Partes Review itself listed an incorrect address, this was merely a clerical error. Service was properly attempted on Patent Owner at the correspondence address of record for the ’365 patent listed on Public Pair. Ex. 1012 at ¶¶ 2, 8.

Respectfully submitted,

Dated: July 7, 2015

By: /Lionel M. Lavenue/
Lionel M. Lavenue, Lead Counsel
Reg. No. 46,859

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **NOTICE REGARDING SERVICE** was served on July 7, 2015, via email directed to counsel of record for the Patent Owner at the following:

David M. Magee
mageed@pepperlaw.com

Andrew W. Schultz
schultza@pepperlaw.com

/Ashley F. Cheung/
Ashley F. Cheung
Case Manager

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP