| UNITED STATES PATENT AND TRADEMARK OFFICE  |
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| BEFORE THE PATENT TRIAL AND APPEAL BOARD   |
|  |
| HYUNDAI MOTOR AMERICA, INC., HYUNDAI MOTOR COMPANY, KIA MOTORS CORPORATION, and KIA MOTORS AMERICA, INC.  Petitioner |
| V.   |
| PAICE LLC and THE ABELL FOUNDATION, INC.  Patent Owner   |
|  |
| Case IPR2016-00246 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 IPR2014-01415; IPR2014-01416; IPR2015-00606; IPR2015-00722; IPR2015-00758; IPR2015-00784; IPR2015-00785; IPR2015-00787; IPR2015-00790; IPR2015-00791; IPR2015-00792; IPR2015-00794; IPR2015-00795; IPR2015-00799; IPR2015-00800; IPR2015-00801; IPR2016-00247; IPR2016-00248; IPR2016-00249; IPR2016-00250; IPR2016-00251 and IPR2016-00272.

In addition, final decisions in IPR2014-00570, IPR2014-00571, and IPR2014-00579 are on appeal before the United States Court of Appeals for the Federal Circuit; a decisions adverse to Patent Owner, in whole or in part, were rendered in IPR2014-00785, IPR2014-00884, and IPR2014-0904; and IPR2014-00568, IPR2014-00852, and IPR2015-00767 were not instituted.

### 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                      |
|-----------------------------------|--------------------------------------|
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### 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, IPR36351-

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Respectfully submitted,

Date: December 16, 2015 /Brian J. Livedalen/

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