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 IPR2016-00249 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; IPR2016-00246; IPR2016-00247; IPR2016-00248; 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:

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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: <u>December 16, 2015</u> /Br

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