

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC.
Petitioner

v.

LIMESTONE MEMORY SYSTEMS LLC
Patent Owner

Case No. IPR 2016-01567

U.S. Patent 5,894,441
Filed March 31, 1998
Issued April 13, 1999

Title: SEMICONDUCTOR MEMROY DEVICE WITH REDUNDANCY
CIRCUIT

Customer No: 22242

**LIMESTONE MEMORY SYSTEMS LLC'S MANDATORY
NOTICES PURSUANT TO 37 C.F.R. §42.8(a)(2)**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Patent Owner Limestone Memory Systems LLC (“Limestone”) hereby files its Mandatory Notices pursuant to 37 C.F.R. §42.8(a)(2) for the above-captioned proceeding.

I. Real Parties-In-Interest Under 37 C.F.R. §42.8(b)(1)

The real parties-in-interest are Limestone Memory Systems LLC and Acacia Research Group LLC.

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

Patent Owner notes the following matters that may affect or be affected by a decision in this proceeding:

A. Related Administrative Matters

There are no U.S. patent applications that claim priority to U.S. Patent No. 5,894,441 (“the ‘441 patent”), and the ‘441 patent does not claim priority from another U.S. patent or patent application. There are no pending U.S. patent applications related to the ‘441 patent.

Petitioner Apple has filed two concurrent IPR petitions against patents owned by Limestone. The patents at issue in each of these concurrent proceedings are unrelated except by their common assignment to Limestone and by having been asserted in lawsuits involving Limestone and Petitioner. In addition to the current matter, these matters include the following case numbers and patents:

| Case No. | Patent No. |
|----------------|---|
| IPR 2016-01561 | U.S. Patent No. 6,233,181 (“the ‘181 patent”) |
| IPR 2016-01567 | U.S. Patent No. 5,894,441 (“the ‘441 patent”) |

The ‘441 patent was subject of a prior IPR petition, filed by Micron Technology, Inc. (“Micron”) on October 27, 2015 as IPR2016-00094. That Micron petition was one of five concurrent IPR petitions filed against patents owned by Limestone, which are similarly unrelated except by their common assignment to Limestone and by having been asserted in lawsuits involving Limestone and Micron.

| Case No. | Patent No. |
|----------------|---|
| IPR 2016-00093 | U.S. Patent No. 5,805,504 (“the ‘504 patent”) |
| IPR 2016-00094 | U.S. Patent No. 5,894,441 (“the ‘441 patent”) |
| IPR 2016-00095 | U.S. Patent No. 5,943,260 (“the ‘260 patent”) |
| IPR 2016-00096 | U.S. Patent No. 6,233,181 (“the ‘181 patent”) |
| IPR 2016-00097 | U.S. Patent No. 6,697,296 (“the ‘296 patent”) |

Limestone filed preliminary responses in which it disclaimed certain claims of the ‘441 patent and the ‘296 patent. Upon review of Micron’s petitions and Limestone’s preliminary responses, the Board denied Micron’s petitions at least in part as to the ‘504 patent, the ‘441 patent, and the ‘181 patent. To avoid delay from *inter partes* review arising from Micron’s petitions, Limestone filed statutory disclaimers as to certain claims of the ‘260 patent, the ‘181 patent, and the ‘296

patent; which ultimately terminated *inter partes* review of these claims. Limestone continues to assert the remaining claims from the ‘504 patent, the ‘441 patent, and the ‘181 patent against Micron and other defendants, including Petitioner, in related District Court Litigation discussed below.

With respect specifically to the ‘441 patent, Micron’s petition in IPR2016-00094 asserted two grounds of invalidity, as follows:

| Claims | Alleged Grounds for Invalidity |
|---------------|--|
| 1–3, and 5 | 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,270,975, to McAdams (“McAdams”), |
| 3, and 6–15 | 35 U.S.C. § 103 as obvious over McAdams in view of Japanese Patent Application No. H06-052696 (“Minami”) |

In its preliminary response, Limestone disclaimed claims 1–3, and 5 of the ‘441 patent. The Board subsequently denied Micron’s petition as to claims 6–15. Further, the Board denied Micron’s subsequent request for rehearing as to claims 6–15.

B. Related Judicial Matters

The patent at issue in the current matter, U.S. Patent 5,894,441 (“the ‘441 patent”), is asserted in the following pending lawsuits:

- *Limestone Memory Systems LLC v. Micron Technology, Inc.*, No. 8:15-CV-00278 (filed February 17, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);
- *Limestone Memory Systems LLC v. Dell, Inc.*, No. 8:15-CV-00648 (filed April 23, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);
- *Limestone Memory Systems LLC v. Lenovo United States Inc.*, No. 8:15-CV-00650 (filed April 23, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);
- *Limestone Memory Systems LLC v. Hewlett-Packard Company*, No. 8:15-CV-00652 (filed April 23, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);
- *Limestone Memory Systems LLC v. Acer America Corporation*, No. 8:15-CV-00653 (filed April 23, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);
- *Limestone Memory Systems LLC v. Kingston Technology Co., Inc.*, No. 8:15-CV-00654 (filed April 23, 2015 C.D. Cal.) (asserts the ‘504, ‘441, ‘260, ‘181, and ‘296 patents);

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