Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY, Patent Owner.

Case IPR2017-00211 Patent 7,116,710

CALIFORNIA INSTITUTE OF TECHNOLOGY'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

DOCKET A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>. Pursuant to 37 C.F.R. § 42.8, California Institute of Technology ("Caltech")

timely files these mandatory notices with the Patent Trial and Appeal Board.

I. REAL PARTY IN INTEREST (37 C.F.R. § 42.8(b)(1))

The real party in interest is California Institute of Technology. Caltech is

the owner of all right to U.S. Patent No. 7,116,710 ("the '710 patent"). Evidence

supporting Caltech's status as the owner of the '710 patent is found at reel/frame

012225/0885 showing assignment of the '710 patent to Caltech.

II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))

Caltech identifies the following district court and PTAB proceedings

involving the '710 patent:

- *The California Institute of Technology v. Broadcom Limited et al.*, Case No. 2:16-cv-03714 (C.D. Cal.), filed on May 26, 2016;
- Petition for *Inter Partes* Review No. IPR2016-00210, filed by Apple Inc. on November 15, 2016; and
- Petition for *Inter Partes* Review No. IPR2016-00219, filed by Apple Inc. on November 15, 2016.

Caltech further identifies the following concluded district court and PTAB

proceedings involving the '710 patent:

- The California Institute of Technology v. Hughes Communications, Inc. et al, Case No. 2:15-cv-01108 (C.D. Cal.), filed on February 17, 2015;
- *The California Institute of Technology v. Hughes Communications, Inc. et al*, Case No. 2:13-cv-07245 (C.D. Cal.), filed on October 1, 2013;

- Petition for *Inter Partes* Review No. IPR2015-00067, filed by Hughes Communications Inc. on October 14, 2014; and
- Petition for *Inter Partes* Review No. IPR2015-00068, filed by Hughes Communications Inc. on October 14, 2014.

III. LEAD AND BACKUP COUNSEL (37 C.F.R. § 42.8(b)(3))

Caltech provides the following designation of counsel:

- Lead Counsel: Kevin P.B. Johnson Registration No. 38,927 QUINN EMANUEL URQUHART & SULLIVAN LLP 555 Twin Dolphin Dr., 5th Floor Redwood Shores, CA 94065 Telephone: (650) 801-5000 Email: kevinjohnson@quinnemanuel.com
- Back-up Counsel: Todd M. Briggs Registration No. 44,040 QUINN EMANUEL URQUHART & SULLIVAN LLP 555 Twin Dolphin Dr., 5th Floor Redwood Shores, CA 94065 Telephone: (650) 801-5000 Email: toddbriggs@quinnemanuel.com

IV. SERVICE INFORMATION

Caltech consents to service by electronic mail at

kevinjohnson@quinnemanuel.com and toddbriggs@quinnemanuel.com.

Case IPR2017-00211 Patent No. 7,116,710

Date: December 6, 2016

Signed: /Todd M. Briggs/

Todd M. Briggs Registration No. 44,040 Quinn Emanuel Urquhart & Sullivan LLP 555 Twin Dolphin Dr., 5th Floor Redwood Shores, CA 94065

Counsel for Patent Owner California Institute of Technology

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Mandatory Notices of The California Institute of Technology were served on counsel of record for the Petitioner, Richard Goldberg and Brian M. Seeve, on December 6, 2016, at the following email address:

richard.goldenberg@wilmerhale.com

Date: December 6, 2016

Signed: <u>/Todd M. Briggs/</u> Todd M. Briggs Registration No. 44,040

> Counsel for Patent Owner California Institute of Technology