

Filed on behalf of Rembrandt Wireless Technologies, LP

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED
Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP
Patent Owner.

Case IPR2020-00510
U.S. Patent No. 8,023,580

**PATENT OWNER'S UPDATED MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8**

In accordance with 37 C.F.R. §42.8, Patent Owner, Rembrandt Wireless Technologies, LP (“Rembrandt”), hereby submits the following updated mandatory notices directed to updating the status of related matters.

As described in more detail below: (i) two *inter partes* review proceedings initiated by third party Apple Inc. against Patent Owner and involving U.S. Patent No. 8,023,580 (“the ’580 patent”) have been terminated; (ii) two *inter partes* review proceedings initiated by third party Apple Inc. against Patent Owner and involving related U.S. Patent No. 8,457,228 (“the ’228 patent”), which is a child of the ’580 patent, have been terminated; (iii) two district court actions involving both the ’580 patent and related ’228 patent have been terminated; and (iv) the district court action between Rembrandt and Qualcomm Incorporated (*Rembrandt Wireless Technologies, LP v. Qualcomm Incorporated*, Case No. 8:19-cv-705 (C.D. Cal.)) involving the same two patents has been stayed.

RELATED MATTERS

Provided below are matters related to the present *inter partes* review proceeding involving the ’580 patent.

Patent Applications

- U.S. Provisional Patent Application No. 60/067,562, filed on Dec. 5, 1997;

- U.S. Patent Application No. 09/205,205, filed on Dec. 4, 1998, now Pat. No. 6,614,838;
- U.S. Patent Application No. 10/412,878, filed on Apr. 14, 2003, now Pat. No. 7,248,626;
- U.S. Patent Application No. 11/774,803, filed on Jul. 9, 2007, now Pat. No. 7,675,965;
- U.S. Patent Application No. 13/198,568, filed August 4, 2011, now Pat. No. 8,457,228;
- U.S. Patent Application No. 13/899,227, filed on May 21, 2013, abandoned;
- U.S. Patent Application No. 14/549,064, filed on Nov. 20, 2014, now Pat. No. 9,432,172; and
- U.S. Patent Application No. 15/226,595, filed on Aug. 2, 2016, abandoned.

U.S. Patent and Trademark Office Proceedings

- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00514 (P.T.A.B.) – Not instituted;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00515 (P.T.A.B.) – Not instituted;

- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00518 (P.T.A.B.) – Partially Instituted/Final Written Decision;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00519 (P.T.A.B.) – Partially Instituted/Final Written Decision;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2015-00114 (P.T.A.B.) – Not instituted;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2015-00118 (P.T.A.B.) – Not instituted;
- *Apple Inc. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2020-00033 (P.T.A.B.) – Terminated April 16, 2020 (Paper No. 18);
- *Apple Inc. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2020-00034 (P.T.A.B.) – Terminated April 16, 2020 (Paper No. 18); and
- *Ex Parte* Reexamination Control No. 90/013,808 – Reexamination Certificate Issued.

Federal Court Proceedings

- *Rembrandt Wireless Technologies, LP, v. Samsung Electronics Co., Ltd., et al.*, Case No. 2:13–CV–213 (E.D. Tex) – Terminated;

- *Rembrandt Wireless Technologies, LP v. Apple Inc.*, Case No. 2:19-cv-025 (E.D. Tex.) – Terminated March 26, 2020;
- *Rembrandt Wireless Technologies, LP v. Broadcom Incorporated et al.*, Case No. 8:19-cv-708 (C.D. Cal.) – Terminated March 26, 2020;
- *Rembrandt Wireless Technologies, LP v. Qualcomm Incorporated*, Case No. 8:19-cv-705 (C.D. Cal.) – Stayed by Order dated April 9, 2020; and
- *Rembrandt Wireless Technology, LP v. Samsung Electronics Co. Ltd. Et al.*, No. 16-1729 (Fed. Cir.) – Terminated.

Other Matters

Patent Owner also notes the following proceedings involving the related '228 patent, which is a child of the '580 patent.

- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00889 (P.T.A.B.) – Not instituted;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00890 (P.T.A.B.) – Not instituted;
- *Samsung Electronics Co. Ltd., et al. v. Rembrandt Wireless Technologies, LP*, Case No. IPR2014-00891 (P.T.A.B.) – Not instituted;

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