

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

**QUALCOMM INCORPORATED**

**Petitioner**

**v.**

**REMBRANDT WIRELESS TECHNOLOGIES, LP**

**Patent Owner**

**CASE NO. IPR2020-00510**

**U.S. PATENT 8,023,580**

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

Pursuant to 37 C.F.R. §42.8(a)(3), Petitioner Qualcomm Incorporated provides these Updated Mandatory Notices, which have been updated below to reflect the following developments:

On March 26, 2020, the following two related matters were dismissed with prejudice:

- *Rembrandt Wireless Technologies, LP v. Broadcom Incorporated et al.*, Case No. 8:19-cv-708 (C.D. Cal.); and
- *Rembrandt Wireless Techs., LP v. Apple Inc.*, Case No. 2:19-cv-025 (E.D. Tex.).

On April 9, 2020, the following related matter was stayed:

- *Rembrandt Wireless Techs., LP v. Qualcomm Incorporated*, Case No. 8:19-cv-705 (C.D. Cal.).

On April 16, 2020, the following four related IPR matters were terminated prior to institution:

- *Apple Inc. v. Rembrandt Wireless Technologies, LP.*, Case Nos. IPR2020-00033, -00034, -00036, and -00037 (P.T.A.B.).

In the interest of completeness, these Mandatory Notices are also updated to include the additional closed matters addressed in the Petition, and related patents, also included in Patent Owner's Mandatory Notices.

**B. Related Matters (37 C.F.R. §42.8(b)(2))**

**Open Matters**

The '580 Patent is involved in the following proceedings that may affect or be affected by a decision in this proceeding:

- *Rembrandt Wireless Techs., LP v. Qualcomm Incorporated*, Case No. 8:19-cv-705 (C.D. Cal.) [Stayed].

U.S. Patent No. 8,457,228 (“’228 Patent”), which is a continuation of the ’580 Patent, is involved in the same district court proceeding and in:

- *Qualcomm Incorporated v. Rembrandt Wireless Techs., LP.*, Case Nos. IPR2020-00509 (P.T.A.B.).

**Closed Matters**

The ’580 Patent was involved in the following proceedings:

- *Rembrandt Wireless Techs., LP v. Broadcom Incorporated et al.*, Case No. 8:19-cv-708 (C.D. Cal.) [Dismissed];
- *Rembrandt Wireless Techs., LP v. Apple Inc.*, Case No. 2:19-cv-025 (E.D. Tex.) [Dismissed];
- *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co. Ltd.*, Case Nos.:
  - 2:16-cv-00170 (E.D. Tex.) [Dismissed]; and
  - 16-1729 (Fed. Cir.) [Aff’d In-Part, Rev’d In-Part, Remanded].

- *Apple Inc. v. Rembrandt Wireless Techs., LP.*, Case Nos.
  - IPR2020-00033 (P.T.A.B.) [Terminated Pre-Institution]; and
  - IPR2020-00034 (P.T.A.B.) [Terminated Pre-Institution].
- *Samsung Elecs. Co. Ltd. v. Rembrandt Wireless Techs. LP*, Case Nos.:
  - IPR2014-00889 (P.T.A.B.) [Not instituted];
  - IPR2014-00890 (P.T.A.B.) [Not instituted];
  - IPR2014-00891 (P.T.A.B.) [Not instituted];
  - IPR2014-00892 (P.T.A.B.) [Final Written Decision];
  - IPR2014-00893 (P.T.A.B.) [Final Written Decision];
  - IPR2014-00895 (P.T.A.B.) [Final Written Decision]; and
  - IPR2015-00555 (P.T.A.B.) [Not Instituted]; and
- *Ex Parte* Reexam. No. 90/013,809 [Reexam. Certificate Issued].

The '228 Patent was involved in the same closed district court and appeal proceedings, and was also involved in the following closed USPTO proceedings:

- *Apple Inc. v. Rembrandt Wireless Techs., LP.*, Case Nos.
  - IPR2020-00036 (P.T.A.B.) [Terminated Pre-Institution]; and
  - IPR2020-00037 (P.T.A.B.) [Terminated Pre-Institution].

- *Samsung Elecs. Co. Ltd. v. Rembrandt Wireless Techs., LP*, Case Nos.:
  - IPR2014-00514 (P.T.A.B.) [Not instituted];
  - IPR2014-00515 (P.T.A.B.) [Not Instituted];
  - IPR2014-00518 (P.T.A.B.) [Final Written Decision];
  - IPR2014-00519 (P.T.A.B.) [Final Written Decision];
  - IPR2015-00114 (P.T.A.B.) [Not Instituted];
  - IPR2015-00118 (P.T.A.B.) [Not Instituted]; and
- *Ex Parte* Reexam. No. 90/013,808 [Reexam. Cert. Issued].

**Related Applications & Patents**

Provisional App. No. 60/067,562, filed on Dec. 5, 1997 [Expired];

App. No. 09/205,205 / Patent No. 6,614,838 [Expired];

App. No. 10/412,878 / Patent No. 7,248,626 [Expired];

App. No. 11/774,803 / Patent No. 7,675,965 [Expired];

App. No. 13/198,568 / Patent No. 8,457,228 (the '228 Patent) [Expired];

App. No. 13/899,227 , filed May 21, 2013 [Abandoned];

App. No. 14/549,064 / Patent No. 9,432,172 [Expired]; and

App. No. 15/226,595, filed Aug. 2, 2016 [Abandoned].

Dated: April 20, 2020

Respectfully submitted,

/Eagle H. Robinson/  
Eagle H. Robinson (Reg. No. 61,361)  
*Lead Counsel for Petitioner*

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.