

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., and
Apple, Inc.,
Petitioner

v.

Neonode Smartphone LLC,
Patent Owner

Case IPR2021-00145
U.S. Patent No. 8,812,993

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner Neonode Smartphone LLC, hereby submits the following mandatory notices in connection with Samsung Electronics Co. Ltd.'s, Samsung Electronics America, Inc.'s, and Apple, Inc.'s Petition for Inter Partes Review of U.S. Patent No. 8,812,993, Case IPR2021-00145.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

A. 37 C.F.R. § 42.8(b)(1): Real Party-in-Interest

Patent Owner identifies the following real parties-in-interest: Neonode Smartphone LLC.

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

Patent Owner is not aware of any disclaimers, reexamination certificates or petitions for *inter partes* review for the '993 patent. The '993 patent is the subject of an ongoing litigation in *Neonode Smartphone LLC v. Apple Inc.*, 6:20-cv-00505 (W.D.Tex.) and *Neonode Smartphone LLC v. Samsung Electronics Co. Ltd. And Samsung Electronics America, Inc.*, 6:20-cv-00507 (W.D.Tex.) (together referred to as the "Texas Litigation"). The Texas Litigation may affect, or be affected by, decisions in this proceeding.

Petitioner has also petitioned for *inter partes* review of U.S. Patent No. 8,095,879, IPR2021-00144, which is owned by Real Party-in-Interest Neonode Smartphone LLC and has been asserted in the Texas Litigation.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioners provide the following designation of counsel.

Lead Counsel	Back-Up Counsel
Robert M. Asher Reg. No. 30,445 rashersunsteinlaw.com <u>Postal and Hand-Delivery Address:</u> Sunstein LLP 100 High Street Boston, MA 02110-2321 617 443 9292 (phone) 617 443 0004 (fax)	Bruce D. Sunstein Reg. No. 27,234 bsunsteinlaw.com <u>Postal and Hand-Delivery Address:</u> Sunstein LLP 100 High Street Boston, MA 02110-2321 617 443 9292 (phone) 617 443 0004 (fax)

Backup-Counsel	Back-Up Counsel
Wendy J. Demoracski Reg. No. 76,185 wdemoracski@sunsteinlaw.com <u>Postal and Hand-Delivery Address:</u> Sunstein LLP 100 High Street Boston, MA 02110-2321 617 443 9292 (phone) 617 443 0004 (fax)	Philip J. Graves (<i>pro hac vice</i> to be filed) philipg@hbsslaw.com <u>Postal and Hand-Delivery Address:</u> Hagens Berman Sobol Shapiro LLP 301 North Lake Avenue, Suite 920 Pasadena, CA 213 330 7150 (phone) 213 330 7152 (fax)
Backup-Counsel	Back-Up Counsel
Greer N. Shaw (<i>pro hac vice</i> to be filed) greers@hbsslaw.com <u>Postal and Hand-Delivery Address:</u> Hagens Berman Sobol Shapiro LLP 301 North Lake Avenue, Suite 920 Pasadena, CA 213 330 7150 (phone) 213 330 7152 (fax)	Mark S. Carlson (<i>pro hac vice</i> to be filed) marke@hbsslaw.com <u>Postal and Hand-Delivery Address:</u> Hagens Berman Sobol Shapiro LLP 1301 Second Avenue, Suite 2000 Seattle, WA 98101 206 623 7292 (phone) 206 623 0594 (fax)

D. 37 C.F.R. § 42.8(b)(4): Service Information

Patent Owner consents to electronic service by email. Please address all correspondence and service to counsel as listed above. All correspondences through email should also be directed to sunsteinip@sunsteinlaw.com.

Dated: December 8, 2020

/Robert M. Asher, #30,445/
Robert M. Asher
Reg. No. 30,445
Sunstein LLP
100 High Street
Boston, MA 02110-2321
617 443 9292 (phone)
617 443 0004 (fax)

CERTIFICATE OF SERVICE

It is certified that on December 8, 2020, the foregoing document has been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail at IPR50095-0016IP1@fr.com.

Dated: December 8, 2020

/Robert M. Asher, #30,445/

Robert M. Asher

Reg. No. 30,445

Sunstein LLP

100 High Street

Boston, MA 02110-2321

617 443 9292 (phone)

617 443 0004 (fax)