

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner

v.

NEONODE SMARTPHONE LLC,

Patent Owner

Case IPR2021-01041

U.S. Patent No. 8,095,879

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 Google LLC's Petition for Inter Partes Review of U.S. Patent No. 8,095,879, Case IPR2021-01041.

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 '879 patent. The '879 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.

The '879 patent is also the subject of an *inter partes* review petition brought by Samsung Electronics Co. Ltd., Samsung Electronics America, Inc. and Apple, Inc., assigned case number IPR2021-00144, which was denied institution June 15, 2021. These parties are also engaged in an *inter partes* review IPR2021-00145 against related U.S. Patent No. 8,812,993, 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
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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: July 7, 2021

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CERTIFICATE OF SERVICE

It is certified that on July 7, 2021, the foregoing document has been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail at Erika.arnier@finnegan.com, kevin.rodkey@finnegan.com, yi.yu@finnegan.com, wei.yuan@finnegan.com, and Google-Neonode-IPR@finnegan.com.

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