

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDIVIS, INC.  
Petitioner

v.

NOVARAD CORP.  
Patent Owner

US Patent No. 11,004,271

*Inter Partes* Review No. IPR2023-00042

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**PETITIONER'S UPDATED MANDATORY NOTICES  
PURSUANT TO CFR § 42.88**

**1. Real Party-in-Interest**

The real party in interest for this petition for *inter partes* review (IPR) is Medivis, Inc., of 174 5th Avenue, Suite 505, New York, NY, 10010.

**2. Related Matters**

On October 13, 2021, Novarad filed a complaint in the District of Delaware alleging that Medivis infringes U.S. Patent No. 11,004,271 (the ‘271 Patent) and U.S. Patent No. 10,945,807 (the ‘807 Patent). The Delaware case is designated C.A. No. 21-1447-GBW. Novarad served the complaint on Medivis on October 14, 2021.

Along with the petition for review of the ‘271 Patent, Medivis also filed a petition for review of the ‘807 Patent. Like the ‘271 Patent, the ‘807 patent is owned by Novarad, lists the same two inventors, and is generally directed to similar AR-assisted surgical navigation methods. Nonetheless, the ‘807 Patent is not part of the ‘271 Patent family.

Medivis filed its petitions while discovery in the Delaware litigation was in its early stages. For example, claim construction still has not been briefed, let alone argued or decided. On December 6, 2022, the parties agreed to stay the litigation, without prejudice, pending final disposition of the *inter partes* review proceedings IPR2023-00042 and IPR2023-00045. The next day, December 7, 2022, the Court ordered the stipulated stay. Thus, the Delaware litigation is now

stayed pending final disposition of the IPR2023-00042 and IPR2023-00045 proceedings.

The '271 Patent results from a second continuation of an application that matured into U.S. Patent 9,892,564. The first continuation of the original parent matured into U.S. Patent 10,475,244. The '271 Patent itself appears to have two continuations: (1) Application No. 17/316,222 (now U.S. Patent 11,481,987); and (2) Application No. 17/972,489, filed on October 24, 2022, and is currently pending.

### 3. Counsel and Service Information

Lead Counsel	Back-Up Counsel
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All of the foregoing counsel are attorneys at McCarter & English, LLP, 265 Franklin Street, Boston, MA 02110. Medivis consents to service by email at all of the foregoing email addresses.

Respectfully submitted,

Dated: February 2, 2023

By:           /s/ Kia Freeman /s/            
Kia L. Freeman  
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Attorney for Petitioner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing was served on February 2, 2023 by transmitting a copy to the patent owner at the email addresses identified in the Patent Owner's Mandatory Notices dated November 2, 2022:

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By:           /s/ John Curran /s/            
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