UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

_____

U.S. Patent No. 10,894,503 B2

Case No.: IPR2023-00197

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PATENT OWNER YECHEZKAL EVAN SPERO'S MANDATORY NOTICE

I. Mandatory Notices under 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8, the patent owner, Yechezkal Evan Spero ("Patent Owner"), hereby submits the following Mandatory Notice to satisfy the requirements of 37 C.F.R. § 42.8. Patent Owner reserves its rights to supplement or modify these Notices.

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

Pursuant to 37 C.F.R. § 42.8(b)(1), the real parties in-interest are the patent owner, Yechezkal Evan Spero and Torchlight Technologies LLC, the exclusive licensee of the challenged patent.

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

Patent Owner identifies the following related current and/or former proceedings involving the patent-at-issue:

1. *Torchlight Techs. LLC v. Daimler AG et al.*, Civil No. 1:22-cv-00751 (D. Del.), filed June 7, 2022. Petitioner, Volkswagen Group of America, Inc., was voluntarily dismissed without prejudice from this civil action on September 23, 2022 (pending).

2. *Torchlight Techs. LLC v. General Motors LLC et al*., Civil No. 1:22-cv-00751 (D.Del.), filed June 7, 2022 (pending).

3. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00328 (IPR of U.S. Patent 10,894,503, pending).

4. Volkswagen *Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00335 (IPR of U.S. Patent 10,894,503, pending).

Patents in the same patent family as the '503 patent have been subject to multiple patent office proceedings:

1. U.S. Reissue Application 16/858,342 (Reissue of U.S. Patent 9,955,551, pending).
2. *Ex Parte* Reexamination 90/014,815 (Reexamination of U.S. Patent 9,955,551, concluded).
3. *Unified Patents v. Torchlight Technologies LLC,* IPR2022-01500 (IPR of U.S. Patent 11,208,029, pending).
4. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2022-01586 (IPR of U.S. Patent 11,208,029, pending).
5. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00315 (IPR of U.S. Patent 9,955,551, pending).
6. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00318 (IPR of U.S. Patent 9,955,551, pending).
7. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00336 (IPR of U.S. Patent 9,955,551, pending).

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

The Patent Owner identifies the following lead and back-up counsel:

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Pursuant to 37 C.F.R. § 42.10(b), an appropriate Power of Attorney is filed concurrently.

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

Service information for lead and back-up counsel is provided in the designation of lead and back-up counsel above. Patent Owner consents to service by email at the following email address: TRCH0111IPR@brookskushman.com.

Respectfully submitted,

Dated: March 21, 2023

/ Sangeeta G. Shah /
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Certificate of Service

The undersigned hereby certifies that on March 21, 2023, a complete and entire copy of **Patent Owner's Mandatory Notice**, was served via electronic mail by serving the correspondence email address of record as follows:

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