

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

U.S. Patent No. 9,955,551

Case No.: IPR2023-00318

**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. U.S. Reissue Application 16/858,342 (Reissue of U.S. Patent

9,955,551, pending).

4. *Ex Parte* Reexamination 90/014,815 (Reexamination of U.S. Patent U.S. Patent 9,955,551, concluded).

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*, IPR2023-00336 (IPR of U.S. Patent 9,955,551, pending).

Patents in the same patent family as the '551 patent have been subject to multiple patent office proceedings:

1. *Unified Patents v. Torchlight Technologies LLC*, IPR2022-01500 (IPR of U.S. Patent 11,208,029, pending).
2. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2022-01586 (IPR of U.S. Patent 11,208,029, pending).
3. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00197 (IPR of U.S. Patent 10,894,503, pending).
4. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00328 (IPR of U.S. Patent 10,894,503, pending).
5. *Volkswagen Group of America, Inc., v. Yechezkal Evan Spero*, IPR2023-00335 (IPR of U.S. Patent 10,894,503, 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:

Lead Counsel	First Back-Up Counsel
Sangeeta G. Shah (Reg. No. 38,614) BROOKS KUSHMAN P.C. 1000 Town Center, 22nd Floor Southfield, MI 48075 Telephone (248) 358-4400 Facsimile (248) 358-3351 sshah@brookskushman.com	Andrew B. Turner (Reg. No. 63,121) BROOKS KUSHMAN P.C. 1000 Town Center, 22nd Floor Southfield, MI 48075 Telephone (248) 358-4400 Facsimile (248) 358-3351 aturner@brookskushman.com
Back-Up Counsel	
Bernard P. Tomsa (Reg. No. 60,121) BROOKS KUSHMAN P.C. 1000 Town Center, 22nd Floor Southfield, MI 48075 Telephone (248) 358-4400 Facsimile (248) 358-3351 btomsa@brookskushman.com	

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: TRCH0115IPR@brookskushman.com.

Respectfully submitted,

Dated: April 18, 2023

/ Sangeeta G. Shah /

Sangeeta G. Shah (Reg. No. 38,614)
Andrew B. Turner (Reg. No. 63,121)
Bernard P. Tomsa (Reg. No. 60,121)
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Service

The undersigned hereby certifies that on April 18, 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:

LEAD COUNSEL	BACK-UP COUNSEL
Michael D. Specht (Reg. No. 54,463) STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 New York Avenue, N.W. Washington, D.C. 20005 Tel.: 202-371-2600 Fax: 202-371-2540 mspecht-PTAB@sternekessler.com	Jason A. Fitzsimmons (Reg. No. 65,367) Daniel E. Yonan (Reg. No. 53,812) Ian Soule (Reg. No. 74,290) Trevor M. O'Neill (Reg. No. 72,981) STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 New York Avenue, N.W. Washington, D.C. 20005 Tel.: 202-371-2600 Fax: 202-371-2540 jfitzsimmons-PTAB@sternekessler.com dyonan-PTAB@sternekessler.com isoule-PTAB@sternekessler.com toneill-PTAB@sternekessler.com PTAB@sternekessler.com

Respectfully submitted,

/Sangeeta G. Shah/
Sangeeta G. Shah (Reg. No. 38,614)
Andrew B. Turner (Reg. No. 63,121)
Bernard P. Tomsa (Reg. No. 60,121)
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner