

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAINTEQ, LLC,

Petitioner,

v.

ORTHOCISION, INC.,

Patent Owner.

Case IPR2023-00477

Patent No. 11,083,511

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner Orthocision, Inc.

(“Orthocision” or “Patent Owner”) submits the following mandatory notices.

I. Real Parties-in-Interest

Orthocision and Omnia Medical, LLC, the exclusive licensee of the subject patent, U.S. Patent No. 11,083,511 (the “’511 Patent”), are the real parties-in-interest in this proceeding.

II. Related Matters

Patent Owner identifies the following judicial and administrative matters that may affect, or be affected by, a decision in this proceeding:

- *Omnia Medical, LLC v. PainTEQ, LLC*, No. 8:22-cv-00145-VMC-TGW (M.D. Fla.). The ’511 Patent is at issue in this pending district court litigation.
- *PainTEQ, LLC v. Orthocision, Inc.*, IPR2023-00451 (P.T.A.B.). This pending *inter partes* review proceeding challenges the patentability of claims 1-23 of the ’511 Patent, which are the same claims that are being challenged in this proceeding.
- *PainTEQ, LLC v. Orthocision, Inc.*, IPR2022-00335 (P.T.A.B.). This pending *inter partes* review proceeding challenges the patentability of claims 26-28 and 31 of U.S. Patent No. 10,426,539, which claims priority to the same parent application as the ’511 Patent.

- U.S. Patent Application 17/364,906 (the “’906 Application”). The ’906 Application claimed priority to the application that issued as the ’511 Patent. The ’906 Application has been abandoned.

III. Lead and Back-up Counsel

Patent Owner designates the following lead and back-up counsel:

LEAD COUNSEL	BACK-UP COUNSEL
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A Power of Attorney naming the above lead and back-up counsel as attorneys of record is being filed concurrently with this paper.

IV. Service Information

Please address all correspondence and service to lead and back-up counsel counsel. Patent Owner consents to service by email.

Dated: February 9, 2023

Respectfully submitted,

/s/ James J. Pingor

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Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT
OWNER'S MANDATORY NOTICES was served on February 9, 2023 by email
on the following counsel of record for Petitioner:

Stephen E. Kelly (Stephen.Kelly@hwhlaw.com)

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Thomas J. Banks (Thomas.Banks@hwhlaw.com)

Dated: February 9, 2023

Respectfully submitted,

/s/ James J. Pingor

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Attorney for Patent Owner