UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.

Petitioner

v.

BT AMERICAS INC.

Patent Owner

Case IPR2023-00889
Patent 7,895,641

**PATENT OWNER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8(a)(3)**

***Mail Stop "PATENT BOARD"***
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.8(a)(3), Patent Owner BT Americas Inc. hereby files the following Updated Mandatory Notices to advise the Board of a request for *ex parte* reexamination filed by Petitioner Palo Alto Networks, Inc.

## I. REAL PARTY-IN-INTEREST

In accordance with 37 C.F.R. § 42.8(b)(1), Patent Owner identifies BT Americas, Inc. and British Telecommunications plc as the real parties-in-interest for Patent Owner.

## II. RELATED MATTERS

In accordance with 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following related matters:

- *Fortinet Inc. v. BT Americas Inc.*, IPR2019-01324 (PTAB) (institution denied)
- *Fortinet Inc. v. BT Americas Inc.*, IPR2019-01325 (PTAB) (institution denied)
- *British Telecommunications PLC and BT Americas, Inc. v. Fortinet, Inc.*, 1:18-cv-01018-CFC-MPT (D. Del.) (settled)
- *British Telecommunications PLC and BT Americas, Inc. v. Palo Alto Networks, Inc.*, 1:22-cv-01538 (D. Del.)
- *Palo Alto Networks, Inc. v. BT Americas, Inc.*, IPR2023-00888 (PTAB)

- Reexamination Control No. 90/019,422 filed on February 16, 2024

## III. LEAD AND BACK-UP COUNSEL

In accordance with 37 C.F.R. § 42.8(b)(3), Patent Owner identifies the following lead and back-up counsel:

**Lead Counsel**

Nolan M. Goldberg (Reg. No. 54,126)
PROSKAUER ROSE LLP
Eleven Times Square
New York, NY 10036-8299
Tel. (212) 969-3472
Fax. (212) 969-2900
NGoldbergPTABMatters@proskauer.com

**Back-Up Counsel**

Baldassare Vinti (Reg. No. 43,970)
PROSKAUER ROSE LLP
Eleven Times Square
New York, NY 10036-8299
Tel. (212) 969-3249
Fax. (212) 969-2900
BVinti@proskauer.com

Jonathan A. Roberts (Reg. No. 68,565)
NIXON & VANDERHYE P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203-1808
Tel. (703) 816-4414
Fax. (703) 816-4100
jr@nixonvan.com

**Back-Up Counsel (cont'd.)**

Raymond Y. Mah (Reg. No. 41,426)
NIXON & VANDERHYE P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203-1808
Tel. (703) 816-4044
Fax. (703) 816-4100
rym@nixonvan.com

Joseph A. Rhoa (Reg. No. 37,515)
NIXON & VANDERHYE P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203-1808
Tel. (703) 816-4043
Fax. (703) 816-4100
jar@nixonvan.com

## IV. SERVICE INFORMATION

Patent Owner consents to electronic service by email to the following addresses:

NGoldbergPTABMatters@proskauer.com
BVinti@proskauer.com
jr@nixonvan.com
jar@nixonvan.com
rym@nixonvan.com

Respectfully submitted,

Dated: February 23, 2024

/Jonathan A. Roberts/

Jonathan A. Roberts
Reg. No. 68,565
Counsel for Patent Owner
BT Americas Inc.

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing Patent Owner's Updated Mandatory Notices was served on Petitioner on February 23, 2024, by emailing a copy to counsel at the email addresses listed below:

Jonathan Tuminaro
Daniel S. Block
Michael D. Specht
Steven M. Pappas
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

jtuminar-PTAB@sternekessler.com
mspecht-PTAB@sternekessler.com
dblock-PTAB@sternekessler.com
spappasPTAB@sternekessler.com
PTAB@sternekessler.com.

/Jonathan A. Roberts/

Jonathan A. Roberts
Reg. No. 68,565