UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

Petitioner,

v.

NORTHSTAR SYSTEMS LLC,

Patent Owner.

Patent No. 8,805,416
Filing Date: February 14, 2008
Issue Date: August 12, 2014

Inventor: Scott C. Harris
Title: METHOD AND SYSTEM FOR MOBILE DEVICE SELECTIVELY REPORTING OF GPS POSITION INFORMATION TO OTHERS

PATENT OWNER'S MANDATORY NOTICES

Case No. IPR2023-01191

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner, NorthStar Systems LLC ("NorthStar"), hereby files its Mandatory Notices. These notices are timely filed within 21 days of the purported date of service of the petition, August 3, 2023.

I. 37 C.F.R § 42.8(b)(1) – REAL PARTY-IN-INTEREST

The patent owner and real party-in-interest is NorthStar Systems LLC.

II. 37 C.F.R § 42.8(b)(2) – RELATED MATTERS

Pursuant to 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following related matters concerning U.S. Patent No. 8,805,416 (the "'416 Patent"):

Case No.	Petitioner(s)	Patent Owner	Status
IPR2023-01049	BMW of North America, LLC	NorthStar Systems LLC	Pending

Patent Owner identifies the following pending district court cases:

- *NorthStar Systems LLC v. Volkswagen AG*, 2:22-cv-00486-JRG (Lead Case) (E.D. Tex.);
- *NorthStar Systems LLC v. Bayerische Motoren Werke AG*, Case No. 2:22-cv-00496-JRG (Member Case) (E.D. Tex.); and
- *BMW of North America, LLC v. NorthStar Systems LLC*, Case No. 6:23-cv-00456-ADA (W.D. Tex.).

III. 37 C.F.R § 42.8(b)(3) – DISCLOSURE OF COUNSEL

Pursuant to 37 C.F.R § 42.8(b)(3), Patent Owner identifies lead and back-up counsel as follows:

Lead Counsel	Back-up Counsel
Vincent J. Rubino, III (Reg. No. 68,594) FABRICANT LLP 411 Theodore Fremd Avenue, Suite 206 South Rye, New York 10580 Tel. 212-257-5797 Fax. 212-257-5796 ptab@fabricantllp.com vrubino@fabricantllp.com	John Rubino (Reg. No. 71,543) RUBINO IP 51 J.F.K. Parkway Short Hills, New Jersey 07078 Telephone: (201) 341-9445 jarubino@rubinoip.com

IV. 37 C.F.R § 42.8(b)(4) – CORRESPONDENCE

Pursuant to 37 C.F.R § 42.8(b)(4), Patent Owner requests that all correspondence be directed to lead counsel and back-up counsel identified in Section III above. Patent Owner also consents to electronic service at the following e-mail addresses: ptab@fabricantllp.com.

Respectfully submitted,

Dated: August 24, 2023 By: /*Vincent J. Rubino, III* /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797

Fax. 212-257-5796
Email: vrubino@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Mandatory Notices has been served on Petitioner's counsel of record as follows:

Lionel M. Lavenue
Email: lionel.lavenue@finnegan.com
Email: BMW-NorthStar-IPRs@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER LLP
1875 Explorer Street, Suite 800
Reston, VA 20190-6023

Kara A. Specht
Email: kara.specht@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER LLP
271 17th Street, NW, Suite 1400
Atlanta, GA 30363-6209

Cory C. Bell
Email: cory.bell@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER LLP
2 Seaport Lane
Boston, MA 02210-2001

Safiya Aguilar
Email: safiya.aguilar@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER LLP
901 New York Avenue NW
Washington, D.C. 20001-4413

Attorneys for BMW of North America, LLC

August 24, 2023

By: /*Vincent J Rubino, III*/

Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796