

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT,
Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,
Patent Owner.

Case No. IPR2024-00192
Patent No. 9,157,232

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

Specified Technologies Inc. (“Patent Owner”) provides the following mandatory notices pursuant to 37 C.F.R. §42.8:

I. Real Party-in-Interest under 37 C.F.R. § 42.8(b)(1)

Specified Technologies Inc., a Delaware corporation having its principal place of business in Somerville, NJ, is the Patent Owner and a real party-in-interest in this proceeding.

II. Related Matters under 37 C.F.R. § 42.8(b)(2)

A. U.S. District Court for the District of Delaware

Patent Owner has asserted U.S. Patent No. 9,157,232 (the “’232 Patent”) (see Ex. 1001) in *Hilti Aktiengesellschaft v. Specified Technologies Inc.*, No. 1:22-cv-01248-CFC (D. Del.) (the “Litigation”).

B. The U.S. Patent and Trademark Office

The cover page of the ’232 Patent states that the application from which the ’232 Patent issued, U.S. Patent Application No. 14/120,001 (the “’001 Appl.”), was filed on April 14, 2014. The ’001 Appl. claims the benefit of U.S. Provisional Patent Application No. 61/956,554 filed on June 11, 2013.

Petitioner has also filed the following Petition for Inter Partes Review of another patent owned by Patent Owner and asserted in the Litigation:

- *Hilti Aktiengesellschaft v. Specified Technologies Inc.*, IPR2024-00193 challenging claims of U.S. Patent No. 10,143,868.

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

A. Lead Counsel

Patent Owner identifies and designates the following as lead counsel:

Ryan North Miller
Reg. No. 68,262
Fox Rothschild LLP
2000 Market Street, 20th Floor
Philadelphia, PA 19103-3222
Tel: 215.299.2901
Fax: 215.299.2150
Email: rmiller@foxrothschild.com

A Power of Attorney for lead counsel is submitted with this Mandatory Notice.

A. Back-up Counsel

Patent Owner identifies and designates the following as back-up counsel:

Jeff E. Schwartz
Reg. No. 39,019
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.696.1470
Fax: 202.461.3102
Email: jeschwartz@foxrothschild.com

Carol E. Thorstad-Forsyth
Reg. No. 56,455
Fox Rothschild LLP
777 South Flagler Drive, Suite 1700
West Palm Beach, FL 33401
Tel: 561.804.4438
Fax: 561.835.9602
Email: cforsyth@foxrothschild.com

Lukas Toft
Reg. No. 75,311
Fox Rothschild LLP
33 South Sixth Street, Suite 3600
Minneapolis, MN 55402
Tel: 612.607.7336
Fax: 612.607.7100
Email: ltoft@foxrothschild.com

P. Marshall Ticer
Reg. No. 74,653
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.794.1237
Fax: 202.461.3102
Email: mticer@foxrothschild.com

Bradley T. Edgington
Reg. No. 77,575
Fox Rothschild LLP
500 Grant Street, Suite 2500
Pittsburgh, PA 15219
Tel: 419.394.5597
Fax: 412.391.6984
Email: bedgington@foxrothschild.com

John Edwin Ryan R. Guerrero
Reg. No. 82,155
Fox Rothschild LLP
2501 N. Harwood Street, Suite 1800
Dallas, TX 75201
Tel: 214.231.5741
Fax: 972.404.0516
Email: jguerrero@foxrothschild.com

A Power of Attorney for back-up counsel is submitted with this Mandatory Notice.

IV. Service Information under 37 C.F.R. § 42.8(b)(4)

Patent Owner consents to service of all documents via electronic mail. Please address all correspondence to lead and back-up counsel as listed above.

Respectfully submitted,

Dated: December 8, 2023

By: / Ryan N. Miller /

Ryan N. Miller

Reg. No. 68,262

Counsel for Patent Owner

Specified Technologies Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 8th day of December, 2023, a copy of

PATENT OWNER'S MANDATORY NOTICES

was served by electronic mail on Petitioner's counsel, lead and back-up, as follows:

Lead Counsel

Michael A. Dorfman, Reg. No. 46,669
mdorfman@gardellagrace.com

Back-up Counsel

Natalie J. Grace, Reg. No. 65,803
ngrace@gardellagrace.com

Counsel for Petitioner has consented to service of all documents via electronic email. *See* Petition, Paper 1 at 81.

Dated: December 8, 2023

By: / Ryan N. Miller /

Ryan N. Miller
Reg. No. 68,262
Counsel for Patent Owner
Specified Technologies Inc.