

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERACTIVE COMMUNICATIONS INTERNATIONAL, INC.,
Petitioner,

v.

BLACKHAWK NETWORK INC.,
Patent Owner.

IPR2024-00465
Patent 11,488,451 B2

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8, Blackhawk Network Inc. submits the following Mandatory Notices in response to the Petition for *Inter Partes* Review Under 37 C.F.R. § 42.100.

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

Blackhawk Network Inc. is the owner by assignment of all substantial interests in U. S. Patent No. 11,488,451 (“the ‘451 Patent”).

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

There is no other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding. IPR2023-01235 is a pending IPR proceeding that involves U.S. Patent No. 9,865,135, which is related to the '451 Patent at issue, here. The PGR proceedings to which the Petitioner cites have concluded.

Blackhawk Network, Inc. v. SL Card Company Inc., No. CV-051638 (Superior Court of Arizona, Maricopa County), does not involve infringement or validity of U.S. Patent No. 11,488,451. In that case, Patent Owner alleges breach of a Product Distribution Agreement by SL Card Company Inc. (“SL Card”), a company that is affiliated with and effectively controlled by Petitioner. As part of its breach, Petitioner and its affiliate SL Card filed patent applications to subject matter that represent modifications and derivations of Patent Owner’s intellectual property. Under the Product Distribution Agreement, all such modifications and derivations are to be owned by Patent Owner.

III. LEAD AND BACKUP COUNSEL AND SERVICE INFORMATION
(37 C.F.R. §§ 42.8(B)(3)-(4))

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Patent Owner provides the following designation of counsel:

Robert L. Hails (Reg. No. 39,702) (lead counsel)
Baker Hostetler LLP
1050 Connecticut Ave., N.W. Suite 1100
Washington, DC 20036-5304
Tel. 202.861.1500 | Fax. 202.861.1783
rhails@bakerlaw.com

Jason F. Hoffman (pro hac vice filed herewith)
Baker Hostetler LLP
1050 Connecticut Ave., N.W. Suite 1100
Washington, DC 20036-5304
Tel. 202.861.1500 | Fax. 202.861.1783
jhoffman@bakerlaw.com

Service Information: Please address all correspondence to lead counsel. Patent Owner also consents to e-mail service at Blackhawk451IPR@bakerlaw.com.

IV. PAYMENT OF FEES UNDER 37 C.F.R. § 42.103

- The PTO is authorized to charge Deposit Account No. 23-3050 for all fees associated with this *inter partes* review proceeding.

Dated: February 20, 2024

Respectfully submitted,

/Robert L. Hails, Jr./

Robert L. Hails, Jr.

Registration No. 39,702

rhails@bakerlaw.com

Jason F. Hoffman

Pro hac vice to be filed

jhoffman@bakerlaw.com

BAKER & HOSTETLER LLP

Washington Square, Suite 1100

1050 Connecticut Avenue, N.W.

Washington, DC 20036-5403

Telephone: 202.861.1500

Facsimile: 202.861.1783

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on February 20, 2024, a copy of Patent Owner's Mandatory Notices was served via electronic mail upon counsel of record for Petitioners at the following addresses:

James M. Glass
jmglass@quinnemanuel.com

Quincy Lu
quincylu@quinnemanuel.com

/Robert L. Hails, Jr./
Robert L. Hails, Jr.