

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner

v.

EMPIRE TECHNOLOGY DEVELOPMENT LLC
Patent Owner

IPR Trial No. IPR2024-00896
U.S. Patent No. 8,798,120

**PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8(a)(2)**

Pursuant to 37 C.F.R. § 42.8(a)(2), patent owner Empire Technology Development LLC (“Empire”) hereby provides its mandatory notices.

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

U.S. Patent No. 8,798,120 (the “’120 Patent”) is assigned to the Board of Regents of the University of Texas System, and Empire is the exclusive licensee with all substantial rights to the ’120 Patent, which includes the right to enforce for past, current, and future infringement, and the right to defend. *See* Ex. 2001 (Master License Agreement), ¶¶ 3.3(b), 5.3, 6.1; Ex. 2002 (Assignment and Assumption Agreement); Ex. 2003 (Amendment No. 2 to the Master License Agreement). Therefore, Empire is the real party-in-interest to this proceeding. *See Motorola Mobility LLC v. Michael Arrouse*, IPR2013-00010, Paper 27 at 4-5 (P.T.A.B. Apr. 5, 2013) (finding that licensee with “all substantial rights” to the challenged patent was the real party-in-interest).

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

The ’120 Patent is asserted in the following related civil suit: *Empire Technology Development LLC v. Samsung Electronics Co.*, No. 2:23-cv-00427-JRG-RSP (E.D. Tex.).

III. LEAD AND BACK-UP COUNSEL UNDER 37 C.F.R. § 42.8(b)(3)

Empire designates the following lead and back-up counsel in this matter.

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IV. SERVICE INFORMATION UNDER 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to the addresses listed for lead and back-up counsel above. Empire consents to electronic service by email to the email addresses listed above for lead and back-up counsel.

V. CONCLUSION

Empire believes that this submission fulfills the requirements of 37 C.F.R. § 42.8(a)(2). Please contact the undersigned counsel if any additional information is required.

Dated: July 3, 2024

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Certificate of Service

I hereby certify, pursuant to 37 C.F.R. §42.6(e), that a complete copy of the above document is being served on July 3, 2024, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon Petitioner by serving via electronic mail to the following:

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