

Filed on behalf of:

Patent Owner

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Paper No. _____

Date: October 16, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

SIONYX, LLC,
Patent Owner.

Case IPR2024-01430
Patent 11,069,737 B2

**PATENT OWNER'S MANDATORY NOTICE
UNDER 37 C.F.R. § 42.8**

Patent Owner respectfully submits the following Mandatory Notice under 37 C.F.R. § 42.8(a)(2).

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

Pursuant to 37 C.F.R. § 42.8(b)(1), SiOnyx, LLC, 100 Cummings Center, Suite 243F, Beverly, Massachusetts, and as the current owner of all right, title and interest in and to U.S. Patent No. 11,069,737 (“the ’737 Patent”), is a real party-in-interest.

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

Pursuant to 37 C.F.R. § 42.8(b)(2), records of the U.S. Patent and Trademark Office indicate that the ’737 Patent issued July 20, 2021, from U.S. Patent Application Serial No. 16/505,283, filed July 8, 2019;

- which is a Continuation of U.S. Patent Application Serial No. 15/614,256, filed June 5, 2017, which issued as U.S. Patent No. 10,347,682 on July 9, 2019;
- which is a Continuation of U.S. Patent Application Serial No. 14/884,181, filed October 15, 2015, which issued as U.S. Patent No. 9,673,250 on June 6, 2017;
- which is a Continuation of U.S. Patent Application Serial No. 14/084,392, filed November 19, 2013, which issued as U.S. Patent No. 9,209,345 on December 8, 2015;

- which claims priority from U.S. Provisional Patent Application No. 61/841,326, filed June 29, 2013.

The '737 Patent is the subject of a pending proceeding filed in the Eastern District of Texas captioned *SiOnyx, LLC v. Samsung Electronics, Co., Ltd.*, Case No. 2:24-cv-00291 and a pending proceeding filed with the International Trade Commission captioned *Sensors with Pixels and Products Containing the Same*, Inv. No. 337-TA-1403.

Petitioner has filed a parallel petition for *inter partes* review of U.S. Patent Nos. 11,069,737 (IPR2024-01431), which challenges the same claims (with the exception of claim 30).

These cases may affect, or be affected by, decisions in these proceedings.

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

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

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

Pursuant to 37 C.F.R. § 42.8(b)(4), service information (by e-mail, postal mailing or hand delivery) for Patent Owner is provided in the designation of Lead and Back-up Counsel, above. Patent Owner consents to electronic service by e-mail.

Respectfully submitted,

Date: October 16, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 16th day of October, 2024, I caused to be served a true and correct copy of the foregoing **PATENT OWNER'S MANDATORY NOTICE UNDER 37 C.F.R. § 42.8** by e-mail on the following counsel of record (as agreed in the Service Information section of the Petition):

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