

Filed on behalf of:

Patent Owner

By: Alison L. McCarthy (Lead Counsel)

Alison.McCarthy@Troutman.com

Dustin N. Ferzacca (First Back-up Counsel)

Dustin.Ferzacca@Troutman.com

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 IPR2024-01431
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 (IPR2024-01430), 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.

Alison L. McCarthy (Lead Counsel)
Registration No. 51,998
Troutman Pepper Hamilton Sanders LLP
125 High Street, 19th Floor
Boston, MA 02110
Tel: (617) 204-5100
Fax: (617) 204-5150
E-mail: alison.mccarthy@troutman.com

Dustin N. Ferzacca (Back-up Counsel)
Registration No. 76,449
Troutman Pepper Hamilton
Sanders LLP
125 High Street, 19th Floor
Boston, MA 02110
Tel: (617) 204-5124
Fax: (617) 204-5150
E-mail: Dustin.Ferzacca@Troutman.com

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

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998

Troutman Pepper Hamilton Sanders LLP
125 High Street, 19th Floor
Boston, MA 02110
Tel: (617) 204-5100
Fax: (617) 204-5150
E-mail: Alison.McCarthy@Troutman.com

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):

Scott C. Weidenfeller (Lead Counsel)
Reg. No. 54,531
COVINGTON & BURLING LLP
One CityCenter
850 Tenth Street, NW
Washington, DC 20001
Tel: (202) 662-5923
Fax: (202) 778-5923
Service email:
sweidenfeller@cov.com
Samsung-SiOnyx-IPR-Cov@cov.com

Counsel for Petitioner

Nitin Subhedar (Back-up Counsel)
Reg. No. 42,175
COVINGTON & BURLING LLP
415 Mission Street, Ste. 5400
San Francisco, CA 94150-2533
Tel: (415) 591-7040
Fax: (415) 955-6540
Service email:
nsubhedar@cov.com

Alice J. Ahn (Back-up Counsel)
Reg. No. 79,829
COVINGTON & BURLING LLP
415 Mission Street, Ste. 5400
San Francisco, CA 94150-2533
Tel: (415) 591-7091
Fax: (415) 955-6591
Service email:
aahn@cov.com

Counsel for Petitioner

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998