UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,
v.

X1 DISCOVERY, INC.,
Patent Owner

U.S. Patent No. 10,552,490

Case No. IPR2025-00254

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

Pursuant to 37 C.F.R. § 42.8(a)(3), Patent Owner X1 Discovery, Inc. ("Patent Owner") hereby provides the following mandatory notices in connection with this proceeding.

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

The real party-in-interest to this proceeding is X1 Discovery, Inc.

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

Pursuant to 37 C.F.R. § 42.8(b)(2), Patent Owner identifies the following judicial or administrative matters that would affect, or may be affected by, a decision in this proceeding:

District Court

Patent Owner has asserted U.S. Patent No. 10,552,490 490 ("the '490 patent") and family member U.S. Patent Nos. 7,370,035 ("the '035 patent") and 9,633,139 ("the '139 patent") against Petitioner Microsoft Corporation ("Microsoft") in the following district court litigation:

- *X1 Discovery, Inc. v. Microsoft Corp.*, Civil Action No. 8:23-cv-02415 (C.D. Cal.), file December 19, 2023.

Patent Owner has asserted family member U.S. Patent Nos. 8,498,977 (the '977 patent") and 8,856,093 ("the '093 patent") against Microsoft customers Acer Inc. and Acer America Corporation; ASUSTek Computer Inc. and ASUS Computer International; and Dell Technologies Inc. and Dell Products L.P. in the

following district court cases:

- *X1 Discovery, Inc. v. Acer Inc.*, Civil Action No. 2:23-cv-10674 (C.D. Cal.), filed December 20, 2023.
- *X1 Discovery, Inc. v. ASUSTeK Computer Inc.*, Civil Action No. 2:23-cv-10672 (C.D. Cal.), filed December 20, 2023.
- *X1 Discovery, Inc. v. Dell Technologies Inc.*, Civil Action No. 2:24-cv-04109 (C.D. Cal.), filed December 20, 2023.

ITC

Patent Owner has asserted the ’977 and ’093 patents against Acer Inc. and Acer America Corporation; ASUSTek Computer Inc. and ASUS Computer International; and Dell Technologies Inc. and Dell Products L.P. in the following International Trade Commission proceeding:

- *Certain Computing Devices Utilizing Indexed Search Systems and Components Thereof*, International Trade Commission Inv. No. 337-TA-1389, filed December 19, 2023.

PTAB

Microsoft is concurrently challenging the ’035 patent in IPR2025-00253 and the ’139 patent in IPR2025-00255.

III. 37 C.F.R. § 42.8(b)(3) – DISCLOSURE OF COUNSEL

Pursuant to 37 C.F.R. § 42.8(b)(3), Patent Owner identifies lead and back-up counsel as follows:

Lead Counsel	***Back-up Counsel***
Sanjeet K. Dutta (Reg. No. 46,145) sdutta@goodwinlaw.com GOODWIN PROCTER LLP 601 Marshall St. Redwood City, CA 94063 Tel: (650) 752-3100 Fax: (650) 853-1038	Amadou K. Diaw (*pro hac vice* forthcoming) GOODWIN PROCTER LLP 1900 N St. NW Washington, DC 20036 Phone: (202) 346-4191 Fax: (202) 204-7272 adiaw@goodwinlaw.com
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IV. 37 C.F.R. § 42.8(b)(4) – CORRESPONDENCE

Pursuant to 37 C.F.R. § 42.8(b)(4), Patent Owner requests that all electronic correspondence be directed to lead counsel and back-up counsel identified in Section III above. Patent Owner consents to electronic service at the following e-

mail address: DG-X1-IPR@goodwinlaw.com.

Dated: January 10, 2025

By: */Sanjeet K. Dutta/*

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CERTIFICATE OF SERVICE

A copy of this Patent Owner's Submission of Mandatory Notices Under 37 C.F.R. § 42.8(a)(2) has been served on Petitioner's attorneys of record as follows via electronic mail:

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