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. 9,633,139

Case No. IPR2025-00255

PATENT OWNER'S UPDATED 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 updated mandatory notices in connection with this proceeding.

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

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

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

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. 9,633,139 ("the '139 patent") and family member U.S. Patent Nos. 7,370,035 ("the '035 patent"), 10,552,490 ("the '490 patent"), and 8,498,977 ("the '977 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 the '977 patent and family member U.S. Patent No. 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, terminated April 28, 2025.

PTAB

Microsoft is concurrently challenging the ’035 patent in IPR2025-00253 and the ’490 patent in IPR2025-00254.

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

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***
Lori Gordon (Reg. No. 50,633) GOODWIN PROCTER LLP 1900 N St. N.W. Washington, D.C. 20036 Phone: (202) 346-4000 Fax: (202) 346-4444 Gordon-ptab@goodwinlaw.com	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
	Christie L. Larochelle (Reg. No. 75,020) GOODWIN PROCTER LLP 100 Northern Avenue Boston, MA 02210 Phone: (617) 570-1000 Fax: (617) 523-1231 clarochelle@goodwinlaw.com

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: May 29, 2025

By: */Christie L. Larochelle/*

Christie L. Larochelle (Reg. No. 75,020)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
clarochelle@goodwinlaw.com

Attorney for Patent Owner

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:

Todd M. Siegel, Reg. No. 73,232
todd.siegel@klarquist.com
Msft-X1-IPRs@klarquist.com

Amy C. Haspel, Reg. No. 78,385
amy.haspel@klarquist.com

Andrew M. Mason, Reg. No. 64,034
andrew.mason@klarquist.com

Samuel B. Thacker, Reg No. 78,633
samuel.thacker@klarquist.com

KLARQUIST SPARKMAN, LLP
121 SW Salmon Street, Suite 1600
Portland, Oregon, 97204
503-595-5300 (phone)
503-595-5301 (fax)

Attorneys for Microsoft Corporation

Dated: May 29, 2025

By: /Christie L. Larochelle/

Christie L. Larochelle (Reg. No. 75,020)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
clarochelle@goodwinlaw.com

Attorney for Patent Owner