

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

VISUAL REAL ESTATE, INC.,
Patent Owner

Case IPR2014-01341
Patent 8,078,396

**PATENT OWNER'S UPDATED MANDATORY NOTICES
UNDER TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Visual Real Estate, Inc. (“Patent Owner” or “VRE”) hereby submits the following updated mandatory notice information.

Related Matters Under 37 C.F.R. § 42.8(b)(2)

U.S. Patent No. 8,078,396 (“the ‘396 Patent”) is the subject of litigation between Patent Owner and Petitioner in the U.S. District Court for the Middle District of Florida, namely, *Visual Real Estate, Inc. v. Google Inc.*, Case No. 3:14-cv-00274-TJC-JRK (“the Litigation”).

U.S. Patent No. 7,389,181 (“the ‘181 Patent”) issued from an application related to the ‘396 Patent family. The ‘181 Patent is also the subject of the Litigation. In addition, the ‘181 Patent is at issue in the two petitions for *inter partes* review filed by the Petitioner, Case IPR2014-01338 and Case IPR2014-01339. On January 26, 2015, the Board instituted *inter partes* review with respect to Claims 1 and 3-11 of the ‘181 Patent in Case IPR2014-01339. *See Google Inc. v. Visual Real Estate, Inc.*, IPR2014-01339, Paper 10 (PTAB Jan. 26, 2015). The Board has not decided whether to institute *inter partes* review in Case IPR2014-01338.

U.S. Patent No. 7,929,800 (“the ‘800 Patent”) issued from an application related to the ‘396 Patent family. The ‘800 Patent is also the subject of the Litigation. In addition, the ‘800 Patent is at issue in the *inter partes* review Case

IPR2014-01340, which was requested by the Petitioner. The Board has not decided whether to institute this *inter partes* review.

The parties in the Litigation stipulated that the Litigation shall be stayed pending the Board's decision regarding whether to institute the *inter partes* review of the '181, '800, and '396 Patents and filed a Stipulated Motion to Stay (Dkt. No. 45). The District Court granted the parties' Stipulated Motion to Stay on September 4, 2014, ordering that the Litigation is stayed until further order of the Court (Dkt. No. 46).

U.S. Patent No. 8,207,964 ("the '964 Patent") issued from an application related to the '396 Patent family. The '964 Patent was the subject of a reissue proceeding before the U.S. Patent Office (Reissue Application No. 13/861,336). The U.S. Patent Office issued a Notice of Allowance in this reissue proceeding on August 28, 2014. The reissue application issued as U.S. Patent No. RE45,264 on December 2, 2014.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
LLP

Attorneys for Patent Owner
90 Park Avenue
New York, NY 10016
(212) 336-8000

Dated: February 17, 2015

By: /Charles R. Macedo/
Charles R. Macedo
Registration No. 32,781

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on this 17th day of February, 2015, a copy of the foregoing PATENT OWNER'S UPDATED MANDATORY NOTICES UNDER TO 37 C.F.R. § 42.8 was served via e-mail on the counsel of record for Petitioner at the following e-mail addresses:

IPR19473-0325IP1@fr.com

John C. Phillips (phillips@fr.com)

Michael T. Hawkins (hawkins@fr.com)

Dated: February 17, 2015

By: /Charles R. Macedo/
Charles R. Macedo
Registration No. 32,781