

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
Petitioner

v.

VISUAL REAL ESTATE, INC.,  
Patent Owner

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Case IPR2014-01341  
Patent 8,078,396

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**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). On February 23, 2015, the Board instituted *inter partes* review with respect to Claims 1 and 3-11 of the ‘181 Patent in Case IPR2014-01338. *See Google Inc. v. Visual Real Estate, Inc.*, IPR2014-01338, Paper 11 (PTAB Feb. 23, 2015).

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. On February 27, 2015, the Board instituted *inter partes* review with respect to Claims 1-4, 10, 11, 13-15, and 18 of the ‘800 Patent in Case IPR2014-01340. *See Google Inc. v. Visual Real Estate, Inc.*, IPR2014-01340, Paper 11 (PTAB Feb. 27, 2015).

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.

#### **Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)**

The information relating to back-up counsel for Patent Owner is updated as follows. Lead counsel for Patent Owner remains the same as follows.

Lead Counsel	Back-Up Counsel
Charles R. Macedo (Reg. No. 32,781) Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 Telephone: (212) 336-8074 Facsimile: (212) 336-8001 E-mail: <a href="mailto:cmacedo@arelaw.com">cmacedo@arelaw.com</a>	Brian A. Comack (Reg. No. 45,343) Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 Telephone: (212) 336-8098 Facsimile: (212) 336-8001 E-mail: <a href="mailto:VRE-IPR@arelaw.com">VRE-IPR@arelaw.com</a>
	Joseph P. Kincart (Reg. No. 43,716) Ideation Law, PLLC P.O. Box 936 Vails Gate, NY 12584 Telephone: (917) 962-0263 E-mail: <a href="mailto:JKincart@ideationlaw.com">JKincart@ideationlaw.com</a>

The new back-up counsel designated above is already counsel of record in the subject patent, U.S. Patent No. 8,078,396. Accordingly, no additional power of attorney accompanies the designation of additional back-up counsel pursuant to 37 C.F.R. § 42.10(b).

**Service Information Under 37 C.F.R. § 42.8(b)(4)**

Service information (by e-mail, postal mailing, or hand-delivery) for lead and back-up counsel is provided in the above designation of lead and back-up counsel. Patent Owner also consents to electronic service by e-mail at [VRE-IPR@arelaw.com](mailto:VRE-IPR@arelaw.com) with cc to [cmacedo@arelaw.com](mailto:cmacedo@arelaw.com) and [JKincart@ideationlaw.com](mailto:JKincart@ideationlaw.com).

Respectfully submitted,

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Dated: March 10, 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 10<sup>th</sup> day of March, 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:

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Dated: March 10, 2015

By: /Charles R. Macedo/  
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