

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 MANDATORY NOTICES
PURSUANT 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 mandatory notice information in connection with Petitioner Google Inc.’s Petition for *Inter Partes* Review of U.S. Patent No. 8,078,396 (Case IPR2014-01341).

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

The real party-in-interest is Visual Real Estate, Inc., the assignee of record for U.S. Patent No. 8,078,396 (“the ‘396 Patent”).

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

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. The Board has not decided whether to institute any of the two *inter partes* reviews.

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 recently 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 is currently 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.

C. 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 lead and back-up counsel, as well as their respective service information.

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: cmacedo@arelaw.com	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: VRE-IPR@arelaw.com

Pursuant to 37 C.F.R. § 42.10(b), a Power of Attorney accompanies this designation.

D. 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.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with this submission by Patent Owner to Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
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Dated: September 8, 2014

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 8th day of September, 2014, a copy of the foregoing PATENT OWNER'S MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8 was served via EXPRESS MAIL[®] on counsel for Petitioner at the following correspondence address:

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Michael T. Hawkins
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Dated: September 8, 2014

By: /Charles R. Macedo/
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