

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL IMAGING INDUSTRIES, LLC,

Petitioner,

v.

LEXMARK INTERNATIONAL, INC.,

Patent Owner.

Case IPR2019-01380
Patent 7,844,786 B2

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. §42.8(a)(2), Patent Owner Lexmark International, Inc., submits the following Mandatory Notices within 21 days of service of the above-captioned IPR petition filed by Petitioner Universal Imaging Industries, LLC.

1. Real Party-In-Interest

In accordance with 37 C.F.R. § 42.8(b)(1), the real party in interest of Patent Owner for this IPR petition is Lexmark International, Inc. and there are no other real parties in interest to the best knowledge of Patent Owner.

Lexmark International, Inc. is affiliated with other companies, including its 100% owner Apex Swiss Holdings SARL, and Ninestar Corporation which is an indirect owner of 51% of Apex Swiss Holdings SARL.

Patent No. 7,844,786 is fully owned by Lexmark International, Inc. and is subject to certain security interest by others as reflected in the public assignment record at the U.S. Patent Office:

<https://assignment.uspto.gov/patent/index.html#/patent/search/resultAbstract?id=7844786&type=patNum>

2. Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Lexmark International, Inc., identifies the following related matters at the time of this filing:

- 1) A civil action styled *Lexmark International, Inc. v. Universal Imaging Industries, LLC*, No. 8:18-cv-01047-EAK-AEP (M.D. Florida) which asserts U.S. Patent Nos: 8,225,021; 8,386,657; 8,850,079; 9,176,921; 7,844,786; 8,966,193; 9,245,591; 9,335,698; 9,400,764; and 9,837,136, all assigned to Patent Owner Lexmark International, Inc.;
- 2) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01368 on U.S. Patent No. 9,335,698;
- 3) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01369 on U.S. Patent No. 8,386,657;
- 4) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01378 on U.S. Patent No. 9,245,591;
- 5) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01380 on U.S. Patent No. 7,844,786;
- 6) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01381 on U.S. Patent No. 8,966,193;
- 7) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01383 on U.S. Patent No. 8,850,079;
- 8) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01385 on U.S. Patent No. 9,400,764;
- 9) Universal Imaging Industries' IPR petition under PTAB Case No.

IPR2019-01387 on U.S. Patent No. 9,176,921;

10) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01388 on U.S. Patent No. 9,837,136; and

11) Universal Imaging Industries' IPR petition under PTAB Case No. IPR2019-01389 on U.S. Patent No. 8,225,021.

3. Lead and Back-Up Counsel

In accordance with 37 C.F.R. § 42.8(b)(3), Lexmark International, Inc., appoints the following lead and back-up counsel:

LEAD COUNSEL	BACK-UP COUNSEL
Amy E. Simpson USPTO Reg. No. 54,688 Perkins Coie LLP 11452 El Camino Real, Suite 300 San Diego, California 92130 Phone: 858-720-5702 Fax: 858-720-5799 Simpson-ptab@perkinscoie.com	Babak Tehrani USPTO Reg. No. 55,937 Perkins Coie LLP 11452 El Camino Real, Suite 300 San Diego, California 92130 Phone: 858-720-5374 Fax: 858-720-5799 Tehranchi-ptab@perkinscoie.com
	Bing Ai USPTO Reg. No. 43,312 Perkins Coie LLP 11452 El Camino Real, Suite 300 San Diego, California 92130 Phone: 858-720-5707 Fax: 858-720-5799 Ai-ptab@perkinscoie.com

In accordance with 37 C.F.R. § 42.10(b), an executed Power of Attorney with the above designation of counsel is filed herewith.

4. Service Information

Please address all correspondence to the lead and back-up counsel at the addresses shown above. In accordance with 37 C.F.R. § 42.8(b)(4), Lexmark International, Inc., consents to electronic service and provides the following e-mail address for future services:

Perkins_Service_Lexmark-UII@perkinscoie.com

Lexmark International, Inc., identifies the following postal mailing and hand-delivery address:

Perkins Coie LLP
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Dated: August 12, 2019

Respectfully submitted,

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Lead Counsel
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Back-Up Counsel
Babak Tehrani, Reg. No.
Bing Ai, Reg. No. 43,312

Attorneys for Lexmark International, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on August 12, 2019, true and correct copies of the foregoing PATENT OWNER'S MANDATORY NOTICES and POWER OF ATTORNEY were served via electronic mail upon the following counsel of record for Petitioner:

Lead Counsel	Backup Counsel
Woodrow Pollack Reg. No. 58,908 wpollack@shutts.com Shutts & Bowen, LLP 4301 W Boy Scout Blvd, Suite 300 Tampa, Florida 33607	Ryan Santurri Reg. No. 61,894 rsanturri@allendyer.com Allen, Dyer, Doppelt + Gilchrist, PA PO Box 3791 Orlando, Florida 32802

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