

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETNUT LTD.,

Petitioner

v.

LUMINATI NETWORKS LTD.,

Patent Owner

Case IPR2021-00465

Patent 9,742,866

**MANDATORY NOTICE OF PATENT OWNER
PURSUANT TO 37 C.F.R. §42.8(a)(2)**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Board:

Pursuant to 37 C.F.R. §42.8(a)(2), Patent Owner Luminati Networks LTD.
hereby provides the following mandatory notices in connection with
this proceeding:

I. Real Party-In-Interest Pursuant to 37 C.F.R. § 42.8(b)(1)

Patent Owner certifies that Luminati Networks LTD. is the real party in-
interest.

II. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)

Petitioner filed the following IPR petitions within several days of one
another:

Patent No. 9,742,866: IPR2021-00465 (this IPR); and

Patent No. 9,241,044: IPR2021-00458.

Patent No. 9,742,866 is based upon a divisional of the application that issued
as U.S. Patent No. 9,241,044.

Related district court cases involving Patent No. 9,742,866 and Patent No.
9,241,044:

Luminati Networks Ltd. v. UAB Tesonet, No. 2:18-cv-299 (E.D. Texas)

(closed)

Luminati Networks Ltd. v. BI Science Inc., No. 2:18-cv-483 (E.D. Texas)

(final judgment recently entered, entering appeal stage)

Luminati Networks Ltd. v. IP Ninja Ltd., No. 2-19-cv-196 (E.D. Texas)

(closed)

Besides the cases listed above, there is one other district court case between Patent Owner Luminati Networks LTD. and Petitioner NetNut LTD. involving Luminati patents other than Patent Nos. 9,742,866 and 9,241,044.

NetNut LTD. has also filed Requests for Reexamination with the USPTO on Luminati patents other than Patent Nos. 9,742,866 and 9,241,044.

Patent Nos. 9,742,866 and 9,241,044 were also subject of prior IPRs filed by BI Science (2009) LTD., namely IPR 2020-00166 for Patent No. 9,241,044 and IPR 2020-00167 for Patent No. 9,742,866. These IPRs were terminated by settlement.

III. Lead and Back-Up Counsel Pursuant 37 C.F.R. § 42.8(b)(3)

Lead Counsel	Back-Up Counsel
Thomas M. Dunham RuyakCherian LLP 1901 L Street NW, Suite 700 Washington, D.C. 20036 Tel. (202) 838-1567 Fax (202) 478-1715 tomd@ruyakcherian.com USPTO Customer No. 144371 USPTO Reg. No. 39,965	Don F. Livornese RuyakCherian LLP 222 N. Sepulveda Blvd, Suite 2000 El Segundo, California 90245 Tel. (310) 586-7689 Fax (202) 478-1715 donl@ruyakcherian.com USPTO Customer No. 144371 USPTO Reg. No. 32,040

IV. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)

Please direct all correspondence to lead and back-up counsel at the above addresses. Patent Owner authorizes electronic service to each of the following email addresses:

tomd@ruiakcherian.com

donl@ruiakcherian.com

Luminati_IPRs@ruiakcherian.com

Respectfully submitted,

Date: February 12, 2021

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

Don F. Livornese

Reg. No. 32,040

RUYAKCHERIAN LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEYS FOR PATENT OWNER
LUMINATI NETWORKS LTD.

Certificate of Service

The undersigned certifies service pursuant to 37 C.F.R. § 42.6(e) on the undersigned date on Petitioner by email as authorized by the Petitioner at the following email addresses:

ron.abramson@listonabramson.com

ari.jaffess@listonabramson.com

michael.lewis@listonabramson.com

Respectfully submitted,

Date: February 12, 2021

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

Don F. Livornese

Reg. No. 32,040

RUYAKCHERIAN LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEYS FOR PATENT OWNER
LUMINATI NETWORKS LTD.