

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T CORP., AT&T COMMUNICATIONS LLC, AT&T SERVICES, INC.,
AT&T MOBILITY LLC, AND AT&T MOBILITY II LLC,
Petitioner,

v.

DALI WIRELESS, INC.,
Patent Owner.

Case IPR2023-00646
Patent 8,682,338

PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8, Patent Owner Dali Wireless, Inc. (“Patent Owner”) hereby submits the following Mandatory Notices information.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(A)(2)

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

The real party in interest is Dali Wireless, Inc.

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

1. Judicial Matters

The ’338 patent is presently the subject of the following patent infringement lawsuits brought by Patent Owner:

- *Dali Wireless, Inc. v. AT&T Corp. et al.*, 22-cv-00012 (EDTX);
- *Dali Wireless, Inc. v. Verizon Corp. Svs Group et al.*, 23-cv-00060 (WDTX);
- *Dali Wireless, Inc. v. Cellco Partnership et al.*, 23-cv-00002 (EDTX);
- *Dali Wireless, Inc. v. Ericsson, Inc. et al.*, 22-cv-01313 (WDTX);
- *Dali Wireless, Inc. v. T-Mobile US, Inc. et al.*, 22-cv-00414 (EDTX);

The ’338 patent was previously the subject of patent infringement lawsuits brought by Patent Owner as follows:

- *Dali Wireless, Inc. v. CommScope Technologies LLC et al.*, 19-cv-952, (DDE) which was terminated on March 24, 2022, but is currently on appeal (*Dali Wireless, Inc. v. CommScope Technologies LLC et al.*, 22-1699 (CAFC)); and
- *Dali Wireless, Inc. v. Corning, Inc. et al.*, 22-cv-1314, (WDTX) which was terminated on January 17, 2023.

- *Dali Wireless, Inc. v. Cellco Partnership, et al.*, 22-cv-0104, (WDTX) which was terminated on January 27, 2023.

2. Administrative Matters

Additionally, the '338 patent was also the subject of PTAB proceedings in 2020, IPR2020-01466, for which institution was denied. The '338 patent is the subject of parallel PTAB proceedings, in IPR2022-01212, for which institution was granted.

3. Related Patents/Applications

Country	App. No.	Filed	Patent No.	Status
US	17/313,658	5/6/2021		Pending
US	17/713,094	4/4/2022		Pending
US	17/713,937	4/5/2022		Pending
US	17/845,870	6/21/2022		Pending
US	12/928,931	12/21/2010	8,804,870	Patented
US	12/928,933	12/21/2010	8,730,786	Patented
US	12/928,934	12/21/2010	8,351,877	Patented
US	12/928,943	12/21/2010	8,542,768	Patented
US	13/211,236	8/16/2011	8,848,766	Patented
US	13/211,243	8/16/2011	8,682,338	Patented
US	13/211,247	8/16/2011	8,737,300	Patented
US	13/705,022	12/4/2012	8,467,747	Patented
US	13/894,987	5/15/2013	8,903,337	Patented
US	13/913,207	6/7/2013	9,148,324	Patented
US	14/020,425	9/6/2013	8,824,595	Patented
US	14/169,719	1/31/2014	9,419,714	Patented
US	14/248,597	4/9/2014	9,106,453	Patented
US	14/260,145	4/23/2014	9,137,078	Patented
US	14/335,647	7/18/2014	9,048,797	Patented
US	14/337,004	7/21/2014	9,866,414	Patented
US	14/479,875	9/8/2014	9,826,508	Patented
US	14/553,828	11/25/2014	9,379,745	Patented
US	14/703,579	5/4/2015	9,948,332	Patented
US	14/754,908	6/30/2015	9,814,053	Patented
US	14/800,515	7/15/2015	9,419,837	Patented

US	14/949,405	11/23/2015	9,531,473	Patented
US	15/205,820	7/8/2016	9,820,171	Patented
US	15/223,819	7/29/2016	10,080,178	Patented
US	15/391,408	12/27/2016	10,159,074	Patented
US	15/718,469	9/28/2017	10,153,789	Patented
US	15/786,396	10/17/2017	10,334,567	Patented
US	15/827,794	11/30/2017	10,728,066	Patented
US	16/059,434	8/9/2018	10,334,499	Patented
US	16/175,520	10/30/2018	10,701,695	Patented
US	16/406,252	5/8/2019	11,297,603	Patented
US	16/410,860	5/13/2019	11,006,343	Patented
US	16/737,419	1/8/2020	11,368,957	Patented
US	16/868,748	5/7/2020	10,743,317	Patented
US	16/944,028	7/30/2020	11,026,232	Patented
US	17/000,188	8/21/2020	11,013,005	Patented

C. Lead and Back-Up Counsel and Service Information Under 37 C.F.R. § 42.8(b)(3) and (4)

Lead Counsel: David D. Schumann (Reg. No. 53,569) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: david.schumann@foliolaw.com Tel: (206) 880-1802	First Back-up Counsel: Palani P. Rathinasamy (Reg. No. 63,541) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: palani@foliolaw.com Tel: (206) 880-1802
Back-up Counsel: Moses Xie (Reg. No. 74,491) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: moses.xie@foliolaw.com Tel: (206) 880-1802	Back-up Counsel: Timothy Dewberry (Reg. No. 62,947) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: timothy.dewberry@foliolaw.com Tel: (206) 880-1802

Petitioner consents to electronic service by delivering the documents to the email addresses of primary and backup counsel.

Respectfully submitted,

Date: March 21, 2023

By: /s/ Moses Xie

Moses Xie (Reg. No. 74,491)

Folio Law Group PLLC

Email: moses.xie@foliolaw.com

Tel: (206) 880-1802

Attorney for Patent Owner

CERTIFICATE OF SERVICE

As authorized by Petitioner's Mandatory Notices, I hereby certify that on March 21, 2023, a copy of this document has been served in its entirety by electronic mail on Petitioner's lead and backup counsel.

Patrick D. McPherson
pdmcperson@duanemorris.com

Patrick Muldoon
pcmuldoon@duanemorris.com

Joseph English
djenglish@duanemorris.com

Date: March 21, 2023

By: /s/ Moses Xie
Moses Xie (Reg. No. 74,491)
Folio Law Group PLLC
Email: moses.xie@foliolaw.com
Tel: (206) 880-1802

Attorney for Patent Owner