

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORMFACTOR, INC.,  
Petitioner,

v.

TECHNOPROBE S.P.A.,  
Patent Owner.

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Case IPR2024-00933  
Patent No. 11,035,885

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**PATENT OWNER'S MANDATORY NOTICES**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Technoprobe S.p.A. provides the following mandatory notices.

**I. Real Party-in-Interest - 37 C.F.R. § 42.8(b)(1)**

The real party-in-interest is Technoprobe S.p.A.

**II. Related Matters - 37 C.F.R. § 42.8(b)(2)**

U.S. Patent No. 11,035,885 (the '885 patent) has been asserted in *Technoprobe S.p.A. v. FormFactor, Inc.*, Case No. 1:23-cv-00842-JCG (D. Del.), filed August 4, 2023.

The '885 patent was filed as U.S. Patent Application No. 16/442,385, which is a continuation in-part of PCT/EP2017/082180, filed December 11, 2017, which claims priority to Italian Patent Application No. IT 10216000127581, filed December 16, 2016 and to Italian Patent Application No. IT 10217000021389, filed February 24, 2017.

U.S. Patent Application No. 17/325,783, filed May 20, 2021 (now U.S. Patent No. 11,808,788), is a continuation of U.S. Patent Application No. 16/442,385 that issued as the '885 patent.

U.S. Patent Application No. 18/329,475, filed June 5, 2023 (now U.S. Patent No. 11,921,133), is a continuation of U.S. Patent Application No. 17/325,783, filed May 20, 2021 (now U.S. Patent No. 11,808,788), which is a continuation of U.S. Patent Application No. 16/442,385 that issued as the '885 patent. U.S. Patent No.

11,921,133 is asserted in *Technoprobe S.p.A. v. FormFactor, Inc.*, Case No. 1:24-cv-00650-JCG (D. Del.), filed May 31, 2024.

U.S. Patent Application No. 18/416,771, filed January 18, 2024, is a continuation of U.S. Patent Application No. 18/329,475, filed June 5, 2023 (now U.S. Patent No. 11,921,133), which is a continuation of U.S. Patent Application No. 17/325,783, filed May 20, 2021 (now U.S. Patent No. 11,808,788), which is a continuation of U.S. Patent Application No. 16/442,385 that issued as the '885 patent.

Taiwanese Patent No. TW I713807 filed December 7, 2017 is related to the '885 patent and claims priority to Italian Patent Application No. IT 10216000127581, filed December 16, 2016 and to Italian Patent Application No. IT 10217000021389, filed February 24, 2017. An Invalidation was requested on July 9, 2024 for Taiwanese Patent No. TW I713807 by Chunghwa Precision Test Tech. Co., Ltd. from Taiwan Intellectual Property Office in Taiwan.

The following foreign patents, each of which claims priority to PCT/EP2017/082180, filed December 11, 2017, are also related to the '885 patent: China Patent No. CN 110073224; Vietnam Patent No. VN 36861; Japan Patent No. JP 7228517; Singapore Patent No. SG 11201904738; Korea Patent No. KR 102470313; and Malaysia Patent No. MY-202696-A. Of these, Vietnam Patent No. VN 36861 has been abandoned.

In addition, the following foreign patent applications, each of which claims priority to PCT/EP2017/082180, filed December 11, 2017 are also related to the '885 patent: EPO Patent Application No. EP 3555638; Thailand Patent Application No. TH 1901003659; and Philippines Patent Application No. PH 12019501351.

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

Patent Owner designates the following lead and back-up counsel:

Lead Counsel	Back-up Counsel
Houtan K. Esfahani, Reg. No. 41,893 houtan.esfahani@finnegan.com Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue NW Washington, DC 20001-4413 Phone: 202-408-4106 Fax: 202-408-4400	Joshua L. Goldberg, Reg. No. 59,369 joshua.goldberg@finnegan.com Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue NW Washington, DC 20001-4413 Phone: 202-408-6092 Fax: 202-408-4400  Daniel C. Tucker, Reg. No. 62,781 daniel.tucker@finnegan.com Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 1875 Explorer Street, 8th Floor Reston, VA 20190-6023 Phone: 571-203-2793 Fax: 202-408-4400  Abhay A. Watwe, Reg. No. 59,461 abhay.watwe@finnegan.com Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 1875 Explorer Street, 8th Floor Reston, VA 20190-6023 Phone: 571-203-2716 Fax: 202-408-4400

A power of attorney from Technoprobe S.p.A. to Finnegan, Henderson, Farabow, Garrett & Dunner, LLP (Customer Number 22,852) is being filed concurrently with these mandatory notices in compliance with 37 C.F.R. § 42.10(b).

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

Please send all correspondence to the lead and back-up counsel at the addresses shown above. Patent Owner consents to electronic service by email at the email addresses listed above.

Respectfully submitted,

Dated: July 19, 2024

/Houtan K. Esfahani/  
Houtan K. Esfahani, Reg. No. 41,893  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP

Lead Counsel for Patent Owner  
Technoprobe S.p.A.

**CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the foregoing **Patent Owner's Mandatory Notices** was served electronically via email on July 19, 2024, in its entirety on the following:

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Petitioner has consented to service by email.

Dated: July 19, 2024

/William Esper/  
William Esper  
Legal Assistant and PTAB Coordinator  
Finnegan, Henderson, Farabow,  
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