

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIGITAL CHECK CORP. d/b/a ST IMAGING,
Petitioner,

v.

E-IMAGEDATA CORP.
Patent Owner.

Case IPR2017-00346
Patent 9,197,766 B2

MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

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

Patent Owner e-ImageData Corp. submits the following mandatory notices under 37 C.F.R. § 42.8.

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

The real party-in-interest is e-ImageData Corp., the owner of U.S. Patent No. 9,197,766. e-ImageData Corp. has a place of business at 340 Grant St, Hartford, WI 53027.

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

The '766 Patent is a continuation of U.S. Patent No. 9,179,019, which is a continuation of U.S. Patent No. 8,537,279, which is a continuation of U.S. Patent No. 8,269,890. U.S. Patent Application No. 14/931,583 claims the benefit of the '766 Patent.

Petitioner Digital Check Corp. filed a petition for *inter partes* review of U.S. Patent No. 8,537,279. This proceeding is currently pending as IPR2017-00177. Petitioner also filed a petition for *inter partes* review of U.S. Patent No. 9,179,019. This proceeding is currently pending as IPR2017-00178.

e-ImageData Corp. sued Konica Minolta Business Solutions U.S.A., Inc., Naviant, Inc., and Indus International, Inc. for infringement of the U.S. Patent No. 8,537,279 and U.S. Patent No. 8,269,890 in the United States District Court for the Western District of Wisconsin in case numbers 13-cv-721-bbc and 12-cv-686-bbc. The Court consolidated these two cases into a single case numbered 13-cv-721.

The parties stipulated to dismissal of this case with prejudice on January 5, 2015 and the Court closed the case on January 6, 2015.

e-ImageData Corp. sued Petitioner Digital Check Corp. for infringement of the '766 Patent and U.S. Patent Nos. 8,537,279 and 9,179,019 in the Eastern District of Wisconsin. e-ImageData Corp.'s claims for patent infringement were originally filed in case number 15-cv-658-RTR. The Court severed the patent infringement claims from case number 15-cv-658, and e-ImageData Corp. refiled the patent infringement claims as case number 16-cv-576-WED. This case is currently pending and may be affected by a decision in this proceeding.

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

The Lead Counsel for this proceeding is:

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The Back-Up Counsel for the instant proceeding are:

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D. Service Information (37 C.F.R. § 42.8(b)(4))

Service information is as follows, with the postal mailing address being identical to the hand-delivery address:

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Respectfully submitted,

/s/ Johanna M. Wilbert

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