

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARROT S.A., PARROT DRONES S.A.S., and PARROT INC.,
Petitioners

v.

QFO LABS, INC.,
Patent Owner.

Case IPR2017-01400
Patent 9,645,580

PATENT OWNER'S UPDATED NOTICE,
PROVIDED UNDER 37 C.F.R. §42.8(a)(3) and §42.8(b)(2),
REGARDING RELATED MATTERS

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

Pursuant to 37 C.F.R. § 42.8(a)(3), the Patent Owner, QFO Labs, Inc.,
provides the following updated notice:

MANDATORY NOTICE UNDER 37 C.F.R § 42.8(a)(3):**B. Related Matters under 37 C.F.R. § 42.8(b)(2)****1. Related Patent Office Matters**

The Patent Owner is also party (a) to two *inter partes* reviews of claims of U.S. Patent No. 7,931,239 (Cases IPR2016-01550 and IPR2017-01089, in the latter of which, institution of trial was denied – Paper 15, September 28, 2017), to which the application that issued as Patent 9,645,580 is related through two intermediary applications (Application No. 14/791,253 and Application No. 13/092,940, which is now Patent 9,073,532), and is party (b) to two *inter partes* reviews of claims of U.S. Patent No. 9,073,532 (Cases IPR2016-01559 and IPR2017-01090, in the latter of which, institution of trial was denied – Paper 15, September 28, 2017), to which the application that issued as Patent 9,645,580 is related through intermediary Application No. 14/791,253. Patents 7,931,239, 9,073,532 and 9,645,580 share a common specification. The Petitioners and the Patent Owner are the same in the present IPR matter, and in the related IPR matters.

There is one pending related patent application:

U.S. Application No. 14/791,253 filed July 3, 2015 and titled “METHOD FOR OPERATING A RADIO-CONTROLLED FLYING HOVERCRAFT,” of which the application that issued as Patent 9,645,580 is a continuation application.

U.S. Application No. 14/791,253 claims priority, through a chain of intermediary applications (including the applications that issued as U.S. Patents 9,073,532 and 7,931,239), to U.S. Provisional Application No. 60/407,444 filed August 30, 2002. Application No. 14/791,253 is presently allowed.

2. Related Litigation Matters

There are six related litigation matters:

(1) A Delaware suit filed on August 8, 2016 by Petitioners for declaratory judgment against U.S. Patents 7,931,239 and 9,073,532, which was subsequently amended to include U.S. Patent 9,645,580: *Parrot S.A., et al. v. QFO Labs, Inc.*, Case No. 1:16-cv-00682-GMS (D. Del.).

(2) A Minnesota suit filed on October 12, 2016 by Patentee for infringement of U.S. Patents 7,931,239 and 9,073,532, which was subsequently amended to include U.S. Patent 9,645,580: *QFO Labs, Inc. v. Parrot S.A., et al.*, Case No. 16-cv-03443-JRT-HB (D. Minn.). On June 19, 2017, the complaint in Case 16-cv-03443 (JRT-HB) was dismissed without prejudice.

(3) A Minnesota suit filed on April 7, 2017 by Patentee for infringement of U.S. Patents 7,931,239 and 9,073,532, which was subsequently amended to include U.S. Patent 9,645,580: *QFO Labs, Inc. v. Brookstone Stores, Inc.*, Case No. 0:17-cv-01100-JNE-SR (D. Minn.). Following resolution of the dispute pursuant to a

Confidential Settlement Agreement and Release along with a License Agreement, a Notice of Voluntary Dismissal with Prejudice was filed on September 26, 2017, and the case was dismissed by the Court on September 29, 2017.

(4) A Minnesota suit filed on November 3, 2017 by Patentee for infringement of U.S. Patents 7,931,239, 9,073,532, and 9,645,580: *QFO Labs, Inc. v. Amazon.com, Inc.*, CASE 0:17-cv-05014-DWF-HB (D. Minn.).

(5) A Minnesota suit filed on November 3, 2017 by Patentee for infringement of U.S. Patents 7,931,239, 9,073,532, and 9,645,580: *QFO Labs, Inc. v. Best Buy Co., Inc.*, CASE 0:17-cv-05011-JNE-TNL (D. Minn.).

(6) A Minnesota suit filed on November 3, 2017 by Patentee for infringement of U.S. Patents 7,931,239, 9,073,532, and 9,645,580: *QFO Labs, Inc. v. Target Corporation*, CASE 0:17-cv-05012-JRT-DTS (D. Minn.).

Respectfully submitted,

Dated: November 13, 2017

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.*, the undersigned certifies that on November 13, 2017 a complete and entire copy of this “PATENT OWNER’S UPDATED NOTICE, PROVIDED UNDER 37 C.F.R. §42.8(a)(3) and §42.8(b)(2), REGARDING RELATED MATTERS” was served upon the Petitioners, by electronically serving the Petitioners’ appointed attorneys of record by e-mail at:

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Dated: November 13, 2017

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