

Filed on behalf of:

Patent Owner

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Paper No. _____

Date: February 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOKI HOLDINGS AMERICA LTD.

Petitioner,

v.

KYOCERA SENCO INDUSTRIAL TOOLS, INC.

Patent Owner.

Case IPR2025-00261

Patent 11,034,007

**PATENT OWNER'S MANDATORY NOTICE
UNDER 37 C.F.R. § 42.8**

Patent Owner respectfully submits the following Mandatory Notice under 37 C.F.R. § 42.8(a)(2).

I. REAL PARTY-IN-INTEREST UNDER 37 C.F.R. § 42.8(b)(1)

Kyocera Senco Industrial Tools, Inc., is a United States company with its principal place of business at 8450 Broadwell Road, Cincinnati, Ohio, 45244, USA. Kyocera Senco Industrial Tools, Inc. is the current owner of all right, title, and interest in and to U.S. Patent No. 11,034,007 (“the ‘007 Patent”).

II. RELATED MATTERS UNDER 37 C.F.R. § 42.8(b)(2)

Pursuant to 37 C.F.R. § 42.8(b)(2), records of the U.S. Patent and Trademark Office indicate that the ‘007 Patent issued June 15, 2021, from U.S. Patent Application Serial No. 17/090,018, filed on November 5, 2020; which is a continuation of Serial No. 16/389,944, filed on April 30, 2019, which is a continuation of Serial No. 15/583,202, filed on May 1, 2017; which is a continuation of Serial No. 14/077,313, filed on November 12, 2013; which is a divisional of Serial No. 13/770,481, filed on February 19, 2013; which is a continuation of Serial No. 12/913,049, filed on October 27, 2010; which is a divisional of Serial No. 12/243,693, filed on October 1, 2008; which claims priority to provisional patent application Serial No. 60/977,678, filed on October 5, 2007.

The ‘007 Patent has not been previously asserted; however, related patents from the same patent family are involved in litigation. U.S. Patent Nos. 8,267,296, 8,267,297, 8,286,722, 8,387,718, and 8,602,282 are the subject of a patent infringement action in the United States

District Court for the District of Delaware, captioned *Kyocera Senco Industrial Tools, Inc. v. Koki Holdings America, LTD.*, Case No. 1:17-cv-00598, filed on May 23, 2017.

Petitioner also filed papers to commence an *inter partes* review proceeding related to U.S. Patent Nos. 10,478,954 (IPR2025-00262), 11,241,776 (IPR2025-00263), and 11,845,167 (IPR2025-00264).

III. LEAD AND BACK-UP COUNSEL UNDER 37 C.F.R. § 42.8(b)(3)

Pursuant to 37 C.F.R. §§ 42.8(b)(3) and 42.10(a), Patent Owner provides the following designation of counsel.

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IV. SERVICE INFORMATION UNDER 37 C.F.R. § 42.8(b)(4)

Pursuant to 37 C.F.R. § 42.8(b)(4), service information (by e-mail, postal mailing, or hand delivery) for Patent Owner is provided in the designation of Lead and Back-up Counsel, above. Patent Owner consents to electronic service by e-mail.

Respectfully submitted,

Date: February 3, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 3rd day of February, 2025, I caused to be served a true and correct copy of the foregoing **PATENT OWNER'S MANDATORY NOTICE UNDER 37 C.F.R. § 42.8** by e-mail on the following counsel of record (as agreed in the Service Information section of the Petition):

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