

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERMAX COMPANY,
Petitioner,

v.

ILLINOIS TOOL WORKS INC.,
Patent Owner.

Case IPR2024-00072
U.S. Patent 11,578,740

PATENT OWNER'S MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a)(3), Patent Owner Illinois Tool Works Inc. (“Patent Owner” and real party in interest), hereby submits the following mandatory notices in connection with Termax Company’s (“Termax”) Petition for inter partes review of United States Patent No. 11,578,740 (Case No. IPR2024-00072).

PATENT OWNER POWER OF ATTORNEY

A Power of Attorney appointing the undersigned and the undersigned’s firm is being filed concurrently with these Notices.

REAL PARTY-IN-INTEREST

Illinois Tool Works Inc. is the owner of the entire interest in U.S. Patent No. 11,578,740 (“the ‘740 Patent”), and thus is a real-party-in-interest.

RELATED MATTERS

Patent Owner identifies the following matters that may affect or be affected by a decision in the proceedings:

1. *Illinois Tool Works Inc. v. Termax Company*, Case No. 1-20-cv-05416 (N.D. Ill.), filed September 11, 2020, with Second Amended Complaint filed February 28, 2023.
2. To the extent they may be relevant, U.S. Patent Application No. 17/984,091 filed on November 9, 2022 (published as U.S. Patent Pub. No.

20230070447A1) and U.S. Patent Application No. 17/984,088 filed on November 9, 2022 (published as U.S. Patent Pub. No. 20230072112A1) are pending and claim common benefit with U.S. Patent No. 11,578,740.

3. To the extent they may be relevant, U.S. Patent No. 11,578,740 claims priority to U.S. Patent No. 10,683,882 (which was the subject of IPR2021-00724), U.S. Patent No. 9,982,694, PCT/US2013/073861, and Provisional Application NO. 61/739,604. U.S. Patent No. D897,826 also claims priority to U.S. Patent No. 10,683,882, U.S. Patent No. 9,982,694, PCT/US2013/073861, and Provisional Application NO. 61/739,604.

LEAD COUNSEL AND BACK-UP COUNSEL INFORMATION

Petitioner provides the following designation of counsel:

LEAD COUNSEL	BACK-UP COUNSEL
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SERVICE INFORMATION

Please address all correspondence to the lead counsel at the address provided

Patent Owner Mandatory Notices
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above. Petitioner also consents to electronic service by email at:

IPR2024-00072@mcandrews-ip.com.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Patent Owner Mandatory Notices** was served on November 8, 2023, via email to the Petitioner as indicated below:

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