IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Foil Boarding Company, Inc.
Petitioner,

v.

MHL Custom, Inc.
Patent Owner

Case IPR2024-00085
U.S. Patent No. 9,586,659

PATENT OWNER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8, Patent Owner MHL Custom, Inc. ("Patent Owner") hereby provides the following updated mandatory notices.

As the Board is aware, Patent Owner has also alleged infringement of the '659 Patent against Petitioner Foil Boarding Company, Inc. in *MHL Custom, Inc. v. Foil Boarding Company, Inc., d/b/a Foil, f/k/a Get Foil* (N.D. Fla. 3:22-cv-21258). This updated notice is to inform the Board of a change in status of the above-referenced related case. The above-referenced related litigation has been stayed as of March 21, 2024 pending an institution decision and/or resolution of the instant proceeding with certain stipulations. The Stipulation and Order Staying the Proceedings is attached to this Notice as Appendix A.

Dated: April 4, 2024

Respectfully submitted,

/Megan E. Gibson/

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ATTORNEYS FOR PATENT OWNER

MHL CUSTOM, INC.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 4, 2024, a copy of this Patent Owner's Mandatory Notices Pursuant to 37 C.F.R. § 42.8 was served on the Petitioner's counsel at the email addresses provided in the Petition for service.

Dated: April 4, 2024

/Megan E. Gibson/
Megan E. Gibson
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APPENDIX A

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF FLORIDA
PENSACOLA DIVISION

MHL CUSTOM, INC.

Plaintiff,

v. Civil Action No. 3:22-cv-21258-MCR-ZCB

FOIL BOARDING COMPANY, INC.

Defendant.

STIPULATION AND ORDER STAYING PROCEEDINGS

WHEREAS, on October 26, 2023, Defendant, Foil Boarding Company, Inc. ("Defendant"), filed petitions for *Inter Partes* Review ("IPR") of U.S. Patent No. 9,359,044 ("the '044 Patent") and U.S. Patent No. 9,586,659 ("the '659 Patent"), with the U.S. Patent Trial and Appeal Board ("PTAB") ("the IPR Proceedings").

WHEREAS, on August 9, 2023, an *ex parte* reexamination was requested from the United States Patent and Trademark Office ("USPTO") regarding the '659 Patent ("the *Ex Parte* Proceedings").

WHEREAS, on February 29, 2024, Plaintiff, MHL Custom, Inc. ("Plaintiff"), filed its responses to the IPR petitions filed by Defendant with respect to the '044 and '659 Patents.

WHEREAS, on March 5, 2024, Defendant filed a motion to stay this litigation pending resolution of both the IPR Proceedings and the *Ex Parte* Proceedings. *See* DN 39.

WHEREAS, Plaintiff's Response to Defendant's Motion to Stay is due on March 19, 2024.

WHEREAS, the parties have met and conferred with respect to Defendant's Motion to Stay, and agreed to a proposed stay under the terms and conditions set forth herein.

WHEREAS, this Stipulation shall serve as Plaintiff's response to the Motion to Stay, and no other response need be filed by Plaintiff.

WHEREAS, Plaintiff agrees to a temporary stay of these proceedings, including but not limited to all pending claim construction deadlines, until such time as the PTAB renders its initial decision as to institution of the IPR Proceedings.

WHEREAS, Plaintiff agrees to a continued stay of these proceedings, until such time as the PTAB issues final written decisions (or provides other final resolution of the proceedings) in the event the PTAB was to institute both IPR Proceedings.

WHEREAS, Plaintiff agrees to a continued stay of these proceedings with respect to the '659 Patent, until such time as the USPTO issues a final decision on the merits in the *Ex Parte* Proceedings.

WHEREAS, the parties agree that should the PTAB institute IPR Proceedings on the '659 Patent, but not the '044 Patent, Plaintiff's agreement to a continued stay of proceedings with respect to the '044 Patent would no longer apply and Plaintiff reserves the right to seek to lift the stay and proceed with litigation on the '044 Patent.

WHEREAS, the parties agree that should the PTAB institute IPR Proceedings on the '044 Patent, but not the '659 Patent, and the USPTO issues a decision in favor of Plaintiff in the *Ex Parte* Proceedings, then Plaintiff's agreement to a continued stay of proceedings with respect to the '659 Patent would no longer apply and Plaintiff reserves the right to seek to lift the stay and proceed with litigation on the '659 Patent.

IT IS HEREBY STIPULATED by the parties, subject to the approval of the Court, and subject to the terms and conditions agreed upon above, that this litigation should be stayed under the terms set forth herein.

SO ORDERED this 21st day of March, 2024.

M. Casey Rodgers
United States District Judge

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