

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 IPR2024-00086
U.S. Patent No. 9,359,044

PATENT OWNER'S 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 mandatory notices.

I. REAL PARTY-IN-INTEREST

Patent Owner MHL Custom, Inc. is the sole owner of U.S. Patent No. 9,359,044 (“the ‘044 Patent”) and the only real party-in-interest.

II. RELATED MATTERS

Certain of the challenged claims (*i.e.*, claims 1, 2, 5, and 6) of the ‘044 Patent were at issue in *MHL Custom, Inc. v. Waydoo USA, Inc., et al.* (D. Del. 1:21-cv-00091) and not found to be invalid by the Court. The Court also found that Waydoo infringed the ‘044 Patent (D. Del. 1:21-cv-00091). Patent Owner has also alleged infringement of the ‘044 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).

U.S. Patent No. 9,586,659 (“the ‘659 Patent”) claims the benefit of the priority of the filing date of the ‘044 Patent. Petitioner Foil Boarding Company,

Inc. has filed a petition for *Inter Partes* Review of the '659 Patent (IPR2024-00085).

III. COUNSEL

Lead Counsel: Robert J. Theuerkauf (Registration No. 55,843)

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Backup Counsel: Eric S. Barr (Registration No. 60,150)

IV. SERVICE INFORMATION

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Dated: November 16, 2023

Respectfully submitted,

/Eric S. Barr/

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ATTORNEYS FOR PATENT OWNER

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on November 16, 2023, 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: November 16, 2023

/Eric S. Barr/

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