IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Shenzhen Waydoo Intelligence Technology Co., Ltd.,
Petitioner,

v.

MHL Custom, Inc.
Patent Owner

Case IPR2024-00999
U.S. Patent No. 9,586,659

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

EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Patent Application No. 90/015,269 (Ex Parte Reexamination of U.S. Patent No. 9,586,659), *Notice of Intent to Issue Ex Parte Reexamination Certificate*, June 24, 2024.
2002	U.S. Patent Application No. 90/015,269 (Ex Parte Reexamination of U.S. Patent No. 9,586,659), Allowed Claims 1-28.

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. 9,586,659 ("the '659 Patent") and the only real party-in-interest.

II. RELATED MATTERS

Certain of the challenged claims (*i.e.*, claims 1 and 2) of the '659 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 '659 Patent (D. Del. 1:21-cv-00091). 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).

The '659 Patent is the subject of an *ex parte* reexamination (Appl. No. 90/015,269) before the USPTO. On June 24, 2024 the USPTO issued a Notice of

Intent to Issue Ex Parte Reexamination Certificate for the ‘659 Patent confirming the patentability of claims 1-15 and allowing amended claims 16-20 and newly presented claims 21-28. EX2001, p. 1 and 3. Allowed claims 1-28 are attached as EX2002.

The ‘659 Patent claims the benefit of the priority of the filing date of U.S. Patent No. 9,359,044 (“the ‘044 Patent”). Petitioner Foil Boarding Company, Inc. has filed a petition for *Inter Partes* Review of the ‘044 Patent (IPR2024-00086).

III. COUNSEL

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IV. SERVICE INFORMATION

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Dated: June 27, 2024

Respectfully submitted,

/Megan E. Gibson/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on June 27, 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: June 27, 2024

/Megan E. Gibson/
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