

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Bombardier Recreational Products Inc.
Petitioner,

v.

MHL Custom, Inc.
Patent Owner

Case IPR2024-01391
U.S. Patent No. 9,586,659

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. 9,586,659 (“the ‘659 Patent”) and the only real party-in-interest.

II. RELATED MATTERS

Foil Boarding Company, Inc. (“Foil”) has filed a petition for *Inter Partes* Review directed to different claims of the ‘659 Patent (IPR2024-00085), which has been instituted, and Petitioner Bombardier Recreational Products Inc. has filed a motion to join IPR2024-00085. Further, Shenzhen Waydoo Intelligence Technology Co., Ltd. has also filed a petition for *Inter Partes* Review directed to different claims of the ‘659 Patent (IPR2024-00999), also with a motion to join the instituted Foil IPR (IPR2024-00085).

Certain of the challenged claims (*i.e.*, claims 16-20) of the ‘659 Patent were at issue in *MHL Custom, Inc. v. Waydoo USA, Inc., et al.* (D. Del. 1:21-cv-00091).

These claims were held by the court to be invalid for lack of written description. The parties have cross-appealed to the Federal Circuit, which includes Patent Owner's appeal of the district court's invalidation of claims 16-20 of the '659 Patent. *See MHL Custom, Inc. v. Waydoo USA, Inc.* (Fed. Cir. No. 2024-2116).

The '659 Patent was the subject of an *ex parte* reexamination (Appl. No. 90/015,269) before the USPTO. On August 6, the USPTO issued an 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.

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 Bombardier Recreational Products Inc. has filed a petition for *Inter Partes* Review of the '044 Patent (IPR2024-01108).

III. COUNSEL

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IV. SERVICE INFORMATION

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Dated: October 8, 2024

Respectfully submitted,

/Megan E. Gibson/

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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 October 8, 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: October 8, 2024

/Megan E. Gibson/

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