

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIMPSON STRONG-TIE COMPANY INC.
Petitioner

v.

COLUMBIA INSURANCE COMPANY
Patent Owner

Case No. PGR2023-00049
U.S. Patent No. 11,649,626

**MANDATORY NOTICES OF THE PATENT OWNER
UNDER 37 C.F.R. § 42.8**

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Columbia Insurance Company is the assignee of U.S. Patent No. 11,649,626 (“the ‘626 patent”). Simpson Strong-Tie Company Inc. filed its petition for Post Grant Review as to the ‘626 patent on August 17, 2022. Columbia Insurance Co. submits the following mandatory notices under 37 C.F.R. § 42.8:

A. Real Parties-In-Interest (37 C.F.R. § 42.8(b)(1)):

Columbia Insurance Company is a subsidiary of BH Columbia, Inc., which is a subsidiary of Berkshire Hathaway Inc.

MiTek Inc. is the exclusive licensee of the ‘626 patent. MiTek Inc. is a subsidiary of MiTek Holdings, Inc., which is a subsidiary of MiTek Industries, Inc., which is a subsidiary of Berkshire Hathaway Inc.

B. Related Matters (37 C.F.R. § 42.8(b)(2)):

The ‘626 Patent is involved in PGR2023-00047 and PGR2023-00048 which were filed concurrently with PGR2023-00049. The ‘626 Patent is also involved in a civil action in *Columbia Insurance Company et al v. Simpson Strong-Tie Company Inc.*, 4:23-cv-02432, currently pending in the United States District Court for the Northern District of California.

The ‘626 Patent is a continuation of U.S. Patent No. 11,021,867 (“the ‘867 Patent”). The ‘867 patent was involved in PGR2021-00109, which is currently pending an appeal in *Simpson Strong-Tie Company Inc. v. Columbia Insurance*

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Company, in Case No. 23-1944 in the United States Court of Appeals for the Federal Circuit.

The ‘867 Patent is a continuation of U.S. Patent No. 10,316,510 (“the ‘510 patent”). The ‘510 patent was involved in PGR2019-00063, which was the subject of an appeal and cross-appeal in *Columbia Insurance Company v. Simpson Strong-Tie Company Inc.*, Appeal Nos. 2021-2145, 2021-2157 in the United States Court of Appeals for the Federal Circuit. The ‘510 patent is also involved in a civil action in *Columbia Insurance Company et al v. Simpson Strong-Tie Company Inc.*, 3-19-cv-04683, currently pending in the United States District Court for the Northern District of California.

Pending U.S. Patent Application No. 18/112,843, filed February 22, 2023, claims the benefit of the ‘626 Patent.

C. Lead and Back-Up Counsel (37 C.F.R. § 42.8(b)(3)):

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A power of attorney is being filed with Columbia Insurance Company's
Mandatory Notices pursuant to 37 C.F.R. § 42.10(b).

D. Service Information (37 C.F.R. § 42.8(b)(4)):

Columbia Insurance Company consents to service by email to lead and
backup counsel, using the email addresses above.

Case No. PGR2023-00049
U.S. Patent No. 11,649,626
Dated: September 7, 2023

Respectfully submitted,

/Kurt F. James/

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CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e), the undersigned certifies that on September 7, 2023, a copy of the Mandatory Notices of the Patent Owner under 37 C.F.R. § 42.8 was served via email on the following:

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