## UNITED STATES PATENT AND TRADEMARK OFFICE

# BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHN CRANE, INC., JOHN CRANE PRODUCTION SOLUTIONS, INC. & JOHN CRANE GROUP CORP., Petitioner,

v.

FINALROD IP, LLC, Patent Owner.

Case IPR2016-01786 TITLE: SUCKER ROD APPARATUS AND METHOD Patent 9,045,951

# PATENT OWNER'S MANDATORY NOTICE INFORMATION

UNDER 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8, Patent Owner Finalrod IP, LLC hereby submits its mandatory notice information pertaining to the Petition for *Inter Partes* Review, No. IPR2016-01786, of U.S. Patent No. 9,045,951 ("the '951 Patent"). These notices are being timely filed within 21 days of service of the Petition, which service occurred on September 15, 2016.

#### I. REAL PARTY-IN-INTEREST (37 C.F.R. § 42.8(b)(1))

The real party-in-interest for the Patent Owner is Finalrod IP, LLC ("Finalrod" or "Patent Owner"). R2R & D, LLC d/b/a Superod is the exclusive licensee of the '951 Patent.

## **II. RELATED MATTERS (37 C.F.R. § 42.8(b)(2))**

#### **A. Judicial Matters**

The following district court litigation may affect, or be affected by, a decision in this proceeding: *Finalrod IP*, *LLC and R2R & D*, *LLC d/b/a Superod v*. *John Crane, Inc. and John Crane Production Solutions, Inc.*, Civil Action No. 7:15-cv-00097 (W.D. Tex. 2015).

#### **B.** Administrative Matters

U.S. Patent No. 9,045,951 claims the benefit of U.S. Application No. 13/385,410 filed on February 17, 2012, now issued as U.S. Patent No. 9,181,757, which claims the priority of U.S. Application No. 13/136,715 filed on August 9,

2011, now issued as U.S. Patent No. 8,851,162 ("the '162 Patent"). The '162 Patent was the subject of *Inter Partes* Review Proceeding No. IPR2016-00521, which was denied in its entirety by the PTAB.

The '951 Patent is also the subject of *Inter Partes* Review Proceeding No. IPR2016-01827, which includes the same parties as the present proceeding.

## III. DESIGNATION OF LEAD AND BACK-UP COUNSEL (37 C.F.R. § 42.8(b)(3))

Patent Owner hereby designates the following lead counsel and back-up counsel:

- 1. John D. Holman Reg. No. 71,746 (Lead Counsel) Direct Dial: 713-358-4248
- 2. Josh Shamburger Reg. No. 67,837 (Back-Up Counsel)
- 3. Holly Barnes *pro hac vice* motion forthcoming (Back-Up Counsel)
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## IV. SERVICE INFORMATION (37 C.F.R. § 42.8(b)(4))

Please direct all correspondence regarding this proceeding to Lead Counsel

at the address listed above. Patent Owner also consents to electronic service by

email to:

jholman@matthewsfirm.com jshamburger@matthewsfirm.com hbarnes@matthewsfirm.com kterrell@matthewsfirm.com

## V. PATENT OWNER PRELIMINARY RESPONSE

Patent Owner reserves the right to file a preliminary response at a later date

pursuant to 37 C.F.R. § 42.107.

Dated: October 5, 2016

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Respectfully submitted,

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Lead Counsel for Patent Owner Finalrod IP, LLC

## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 5,

2016, a complete copy of the foregoing was served on counsel of record for the

Petitioner by filing this document through the Patent Review Processing System

and by sending this document via electronic mail to the following address:

Dion M. Bregman (Lead Counsel) Jason C. White (Back-up Counsel) Ryan B. McBeth (Back-up Counsel) Nicholas A. Restauri (Back-up Counsel) Nicholas E. Floyd (Back-up Counsel) **Morgan, Lewis & Bockius LLP** 1400 Page Mill Road Palo Alto, CA 94304 TEL: 650-843-4000 FAX: 650-843-4001 JohnCrane-FinalrodIPRs@morganlewis.com

Dated: October 5, 2016

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Respectfully submitted,

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