

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY

Petitioner,

v.

MASSACHUSETTS INSTITUTE OF TECHNOLOGY,

Patent Owner, and

ETHANOL BOOSTING SYSTEMS, LLC,

Exclusive Licensee

Case No. IPR2019-01400

U.S. Patent No. 8,069,839

**PATENT OWNER'S MANDATORY NOTICE INFORMATION
PURSUANT TO 37 C.F.R. § 42.8**

Massachusetts Institute of Technology, the Patent Owner, respectfully submits this Mandatory Notice Information pursuant to 37 C.F.R. § 42.8:

1. Real Parties in Interest - 37 C.F.R. § 42.8(b)(1)

The real parties-in-interest are Massachusetts Institute of Technology, the Patent Owner, and Ethanol Boosting Systems, LLC, the Exclusive Licensee. In addition to being the Exclusive Licensee of U.S. Patent No. 8,069,839 (“the ’839 Patent”), Ethanol Boosting Systems, LLC has the right to sue for any infringement of the ’839 Patent, and the exclusive right to sublicense any alleged infringer of the ’839 Patent.

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

Patent Owner notes that the ’839 Patent is at issue in the following pending judicial matters or administrative matters that may affect, or be affected by, a decision in this proceeding:

- Ethanol Boosting Systems, LLC et al v. Ford Motor Company, Civil Action No. 1:19-cv-00196-CFC-SRF (D. Del.)

Patent Owner notes that petitions for IPR have been filed for related U.S. Patent No. 9,810,166 under the case heading IPR2019-01399; U.S. Patent No. 9,255,519 under the case heading IPR2019-01401; and U.S. Patent No. 10,138,826 under the case heading IPR2019-01402.

The '839 Patent is a continuation of U.S. Patent Application Ser. No. 12/815,842, filed on June 15, 2010, which issued as U.S. Patent No. 7,971,572, which is a continuation of U.S. Patent Application Ser. No. 12/329,729, filed on December 8, 2008, which issued as U.S. Patent No. 7,762,233, which is a continuation of U.S. Patent Application Ser. No. 11/840,719, filed on August 17, 2007, which issued as U.S. Patent No. 7,740,004, which is a continuation of U.S. Patent Application Ser. No. 10/991,774, filed November 18, 2004, which issued as U.S. Patent No. 7,314,033.

Two pending U.S. Patent Applications, Ser. No. 16/251,658, filed on January 18, 2019, and Ser. No. 16/424,471, filed on May 28, 2019, claim priority to the same application to which the '839 Patent claims priority, namely, U.S. Patent Application Ser. No. 10/991,774, filed November 18, 2004, which issued as U.S. Patent No. 7,314,033.

Other issued U.S. Patents also claim priority to U.S. Patent Application Ser. No. 10/991,774, filed November 18, 2004, which issued as U.S. Patent No. 7,314,033, as follows:

U.S. Patent Application Ser. No. 14/982,086, filed on December 29, 2015, which issued as U.S. Patent No. 9,695,784;

U.S. Patent Application Ser. No. 14/478,069, filed on September 5, 2014, which issued as U.S. Patent No. 9,255,519;

U.S. Patent Application Ser. No. 14/249,806, filed on April 10, 2014, which issued as U.S. Patent No. 8,857,410;

U.S. Patent Application Ser. No. 13/956,498, filed on August 1, 2013, which issued as U.S. Patent No. 8,733,321;

U.S. Patent Application Ser. No. 13/629,836, filed on September 28, 2012, which issued as U.S. Patent No. 8,522,746;

U.S. Patent Application Ser. No. 13/368,382, filed on February 8, 2012, which issued as U.S. Patent No. 8,302,580;

U.S. Patent Application Ser. No. 13/282,787, filed on October 27, 2011, which issued as U.S. Patent No. 8,146,568;

U.S. Patent Application Ser. No. 11/100,026, filed April 6, 2005, which issued as U.S. Patent No. 7,225,787;

U.S. Patent Application Ser. No. 12/701,034, filed on February 5, 2010, which issued as U.S. Patent No. 8,468,983;

U.S. Patent Application Ser. No. 15/919,175, filed on March 12, 2018, which issued as U.S. Patent No. 10,221,783;

U.S. Patent Application Ser. No. 14/807,125 filed on July 23, 2015, which issued as U.S. Patent No. 9,708,965;

U.S. Patent Application Ser. No. 11/229,755 filed on September 19, 2005, which issued as U.S. Patent No. 7,444,987;

U.S. Patent Application Ser. No. 12/942,133 filed on November 9, 2010,
which issued as U.S. Patent No. 8,353,269;

U.S. Patent Application Ser. No. 13/410,373 filed on March 2, 2012, which
issued as U.S. Patent No. 8,276,565;

U.S. Patent Application Ser. No. 16/170,648 filed on October 25, 2018, which
issued as U.S. Patent No. 10,344,689;

U.S. Patent Application Ser. No. 11/871,384, filed on October 12, 2007, which
issued as U.S. Patent No. 7,640,915;

U.S. Patent Application Ser. No. 12/621,425 filed on November 18, 2009,
which issued as U.S. Patent No. 7,841,325;

U.S. Patent Application Ser. No. 12/907,163 filed on October 19, 2010, which
issued as U.S. Patent No. 8,171,915;

U.S. Patent Application Ser. No. 13/895,713 filed on May 16, 2013, which
issued as U.S. Patent No. 8,707,913;

U.S. Patent Application Ser. No. 15/463,425 filed on March 20, 2017, which
issued as U.S. Patent No. 9,810,166, which is the subject of one of the petitions for
IPR mentioned above under the case heading IPR2019-01399;

U.S. Patent Application Ser. No. 14/478,069 filed on September 5, 2014,
which issued as U.S. Patent No. 9,255,519, which is the subject of one of the
petitions for IPR mentioned above under the case heading IPR2019-01401;

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