

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. IPR2020-00013

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

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

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

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

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) (UPDATED)

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.)
- Ethanol Boosting Systems, LLC et al. v. Ford Motor Company, No. 2020-1472 (Fed. Cir.)

Patent Owner notes that another petition for IPR has been filed for the ’839 Patent under the case heading IPR2019-01400; and that petitions for IPR have been filed for related U.S. Patent No. 9,810,166 under the case headings IPR2019-01399 and IPR2020-00010; for U.S. Patent No. 9,255,519 under the case headings

IPR2019-01401 and IPR2020-00011; and for U.S. Patent No. 10,138,826 under the case headings IPR2019-01402 and IPR2020-00012.

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. 14/133,974 filed December 19, 2013, which
issued as U.S. Patent No. 8,997,711;

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. 16/662,429 filed on October 24, 2019, which will issue on April 14, 2020 as U.S. Patent No. 10,619,580;

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