

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAHLE BEHR CHARLESTON INC.,
Petitioner,

v.

FRANK AMIDIO CATALANO,
Patent Owner,

Patent No. RE47,494 to Catalano

Issue Date: July 9, 2019

Title: ELECTROLYSIS PREVENTION DEVICE AND METHOD OF USE

Inter Partes Review No.: IPR2023-00861

PETITIONER'S UPDATED MANDATORY NOTICES

I. MANDATORY NOTICES UNDER 37 C.F.R. §42.8

B. Notice of Related Matters

As identified in the Petition, the '494 Patent is the subject of the following matter, which may be affected by a decision in this proceeding: *Electrolysis Prevention Solutions LLC v. Daimler Trucks North America LLC*, 3:21-cv-171 (W.D.N.C.), filed on April 19, 2021. *See* Paper 1, pp. 2–6. Petitioner reiterates that it is not, and has never been, a party to nor in control of that proceeding. *See id.*

On October 26, 2023, Daimler Trucks North America LLC (“DTNA”) and Electrolysis Prevention Solutions LLC (“EPS”) filed a joint motion to stay pre-trial deadlines. *Electrolysis Prevention Solutions LLC v. Daimler Trucks North America LLC*, 3:21-cv-171 (W.D.N.C.), Dkt. 223, p. 1. On October 27, 2023, the court granted the joint motion, stayed all remaining pretrial deadlines, and canceled the trial that was scheduled for January 2, 2024. *Electrolysis Prevention Solutions LLC v. Daimler Trucks North America LLC*, 3:21-cv-171 (W.D.N.C.), Dkt. 225, p. 1. No trial date has since been set.

On May 6, 2024, DTNA filed a motion to stay the entire case stating that “DTNA’s request is that the Court enter a stay—and particularly, not set a new

trial date—until resolution is reached on the IPR.” *Electrolysis Prevention*

Solutions LLC v. Daimler Trucks North America LLC, 3:21-cv-171 (W.D.N.C.),

Dkt. 238, p. 1. EPS then filed a motion for extension of time within which to

respond to DTNA’s motion to stay of two weeks (*Electrolysis Prevention*

Solutions LLC v. Daimler Trucks North America LLC, 3:21-cv-171 (W.D.N.C.),

Dkt. 239, p. 1), which the court granted on May 17, 2024. Accordingly, no trial

date is set, a motion to stay has been entered (of all pretrial deadlines), and a

motion to stay of the entire case is before the court and will be decided shortly

after the Board’s deadline for issuing a Decision on Institution.

Respectfully submitted,

By: / Jeanne M. Gills /

Dated: May 20, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Updated Mandatory Notices together with all exhibits and other papers filed therewith was served on May 20, 2024 to Patent Owner's counsel:

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Petitioner's Updated Mandatory Notices
U.S. Patent No. RE47,494

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