

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2020-00597

U.S. Patent No. 8,339,493

**PATENT OWNER'S MANDATORY NOTICES
UNDER 37 C.F.R. § 42.8**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.8, Patent Owner Maxell Ltd., (“Patent Owner”) hereby provides the following mandatory notices:

I. Real Parties-In-Interest

Maxell, Ltd. is the patent owner and real party-in-interest in this proceeding.

Maxell’s address is:

1 Koizumi, Oyamazaki,
Oyamazaki-cho,
Otokuni-gun, Kyoto
618-8525 Japan

II. Related Matters

Pursuant to 37 C.F.R. §42.8(b)(2), Patent Owner submits that the ’493 Patent was the subject of IPR2018-00236. The Board denied institution in IPR2018-00236 (Paper No. 9) (Judges Chung, McMillin and Hudalla). The ’493 Patent is currently asserted against Apple Inc. in *Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036 (E.D. Tex. March 15, 2019). The ’493 Patent was also asserted against ZTE Corp. and ZTE USA Inc. in *Maxell, Ltd. v. ZTE Corp. et. al.*, No. 5:18-cv-00034 (E.D. Tex. Mar. 2, 2018). The ’493 Patent was also subject to IPR2018-00904. The Board terminated the proceeding after preliminary response but before Institution Decision. *Olympus Corp. et al. v. Maxell, Ltd.*, IPR2018-00904, Paper 9 (PTAB December 26, 2018) (Judges Chung, McMillin, and Hudalla).

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Patent No. 8,339,493
Mandatory Notices

The '493 Patent is a continuation of U.S. Patent Application No. 10/660,710, filed September 12, 2003, now U.S. Patent No. 8,059,177 (the '177 Patent) which is a division of U.S. Patent Application No. 09/520,836, filed March 8, 2000, now U.S. Patent No. 6,765,616 (the '616 Patent). The '177 Patent was subject to IPR2018-00910, the proceeding of which was terminated after preliminary response but prior to decision on Institution. IPR2018-00910, Paper 9 (PTAB December 16, 2018). The '616 Patent was subject to IPR2019-00087, the proceeding of which was terminated after preliminary response but prior to decision on Institution. IPR2019-00087, Paper 14 (PTAB March 5, 2019) (Judges Zecher, McMillin, and Hudalla).

The '493 Patent is also a priority application to U.S. Patent Application No. 13/681,495, filed November 20, 2012, now U.S. Patent No. 8,736,729 ('729 Patent); U.S. Patent Application No. 14/264,243, filed April 29, 2014, now U.S. Patent No. 9,100,604 ('604 Patent); U.S. Patent Application No. 14/661,227, filed March 18, 2015, now U.S. Patent No. 9,544,517 ('517 Patent); U.S. Patent Application No. 15/386,656, filed December 21, 2016, now U.S. Patent No. 10,554,917 ('917 Patent); and U.S. Patent Application No. 15/959,774, filed April 23, 2018, now U.S. Patent No. 10,462,403 ('403 Patent).

The '729 Patent was subject to IPR and Institution was denied. IPR2018-00238, Paper 8 (PTAB June 1, 2018) (Judges Chung, McMillin, and Hudalla)

The '517 Patent and the '604 Patent were also, respectively, subject to IPRs but were terminated prior to Institution after preliminary response. IPR2019-00069, Paper 10 (PTAB April 22, 2019) (Judges Zecher, Trock, and Hudalla); IPR2018-00908, Paper 9 (PTAB December 26, 2018) (Judges Pettigrew, Chung, and McMillin), IPR2018-00909, Paper 9 (PTAB December 26, 2018) (Judges Chung, McMillin, and Hudalla); IPR2019-00097, Paper 13 (PTAB April 29, 2019) (Judges Chung, McMillin, and Hudalla)

III. Lead and Back-up Counsel

Pursuant to 37 C.F.R. § 42.8(b)(3), Patent Owner provides the following designation of counsel:

<p><u>Lead Counsel</u> Robert G. Pluta Registration No. 50,970 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-701-8641 Facsimile: 312-706-8144 rpluta@mayerbrown.com</p>	<p><u>Back-Up Counsel</u> Amanda S. Bonner Registration No. 65,224 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 Facsimile: 312-706-8144 asbonner@mayerbrown.com</p>
	<p><u>Back-Up Counsel</u> James A. Fussell Registration No. 54,885 Bryan C. Nese Registration No. 66,023 Saqib J. Siddiqui Registration No. 68,626 Mayer Brown LLP 1999 K Street NW Washington, D.C. 20006 Telephone: 202-263-3000 jfussell@mayerbrown.com bnese@mayerbrown.com ssiddiqui@mayerbrown.com</p>

IV. Service Information

Pursuant to 37 C.F.R. §42.8(b)(4), Patent Owner identifies the following service information: Please direct all correspondence regarding this proceeding to lead counsel at the address identified above. Patent Owner consents to electronic

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