

**NOIN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION**

MAXELL, LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

CASE NO. 5:19-CV-00036-RWS

**DEFENDANT APPLE INC.'S NOTICE OF PATENT OFFICE INSTITUTION ON
ALL ASSERTED CLAIMS OF ALL ASSERTED PATENTS**

On March 4, 2021, Defendant Apple Inc. filed its reply brief in support its pending motion to stay, requesting that this action be stayed because, at the time, four of the six currently asserted patents were subject to post-grant review, and decisions for the remaining two patents were expected soon. *See* D.I. 644. Since the filing of its reply brief, Apple has received notice that the Patent Office granted *ex parte* reexamination of the asserted claims of U.S. Patent No. 7,116,438 and U.S. Patent No. 6,430,498. Therefore, as the chart below shows, all asserted claims of all currently asserted patents are now involved in post-grant review proceedings:

Asserted Patent	EPR or IPR Case Number	Institution Date
U.S. Patent No. 6,430,498	EPR No. 90/014,673	3/8/2021
U.S. Patent No. 7,116,438	EPR No. 90/014,678	3/4/2021
U.S. Patent No. 6,748,317	EPR No. 90/014,639 EPR No. 90/014,662	2/12/2021 2/12/2021
U.S. Patent No. 6,580,999	EPR No. 90/014,661 EPR No. 90/014,640	2/26/2021 1/12/2021
U.S. Patent No. 8,339,493	EPR No. 90/014,628	1/28/2021
U.S. Patent No. 6,329,794	IPR2020-00199	6/19/2020

A copy of the institution decision for the '438 patent is attached to this notice as Exhibit 1. A copy of the '498 patent reexamination status is attached as Exhibit 2, and Apple will provide a full copy of the '498 reexamination decision as soon as it is publicly available. The institution decisions for the remaining asserted patents were attached to Apple's reply brief (D.I. 644) as Exhibits 1-6.

Furthermore, the Patent Office also has instituted post-grant review proceedings on the previously asserted claims of the four non-elected Maxell patents, as follows:

Non-Elected Patent	EPR or IPR Case Number	Institution Date
U.S. Patent No. 6,408,193 (non-elected)	EPR No. 90/014,632	2/1/2021
U.S. Patent No. 10,084,991 (non-elected)	IPR2020-00200	7/15/2020
U.S. Patent No. 6,928,306 (non-elected)	IPR2020-00204	6/19/2020
U.S. Patent No. 10,212,586 (non-elected)	IPR2020-00202	7/15/2020

Dated: March 8, 2021

Respectfully Submitted

By: /s/ Mark D. Fowler

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 8th day of March 2021, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3). Any other counsel of record will be served by a facsimile transmission and/or first-class mail.

/s/ Mark D. Fowler

Mark D. Fowler