

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

MAXELL, LTD.,

Plaintiff,

v.

APPLE INC.,

Defendants.

Case No. 5:19-cv-00036-RWS

JURY TRIAL DEMANDED

**MAXELL, LTD.'S UNOPPOSED MOTION TO DISMISS
WITHOUT PREJUDICE THE '794 PATENT**

Pursuant to Fed. R. Civ. P. 41(a)(2), and in an effort to streamline issues for the above-captioned case, Plaintiff Maxell, Ltd. (“Maxell”) hereby agrees to dismiss without prejudice certain claims from these actions.

Specifically, Maxell agrees to dismiss without prejudice its claims of infringement of U.S. Patent No. 6,329,794 (the “’794 patent”). Apple does not object to Maxell reducing its damages total based on this dismissal by reducing the total number of accused units.

In addition to dismissing without prejudice its remaining claims of infringement of the ’794 patent against Apple, Maxell agrees not to institute any legal action or administrative proceeding against Apple or any Apple products on the ’794 patent until the conclusion of the *inter partes* review proceedings on that patent (IPR2020-00199), which for avoidance of doubt also includes any appeals from the PTAB’s Final Written Decision in IPR2020-00199. Maxell further agrees that no Apple product shall be used to satisfy any claim or claim element of the ’794 patent asserted by Maxell or its successors and assigns against any party until the conclusion of IPR2020-00199, including any appeals from the PTAB’s Final Written Decision.

Apple does not oppose this Motion.

At this time, Maxell maintains all claims and defenses not specifically enumerated above.

Dated: March 19, 2021

By: /s/ Jamie B. Beaber

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Counsel for Plaintiff Maxell, Ltd.

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that counsel for Plaintiff met and conferred with counsel for Defendant on this issue on March 18-19, 2021. Counsel for Defendant indicated that it is unopposed to the relief sought in this motion.

/s/ Jamie B. Beaber
Jamie B. Beaber

/s/ Geoff Culbertson
Geoff Culbertson

CERTIFICATE OF SERVICE

The undersigned certifies that all counsel of record who are deemed to have consented to electronic service are being served this 19th day of March, 2021 with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3)

/s/ Jamie B. Beaber
Jamie B. Beaber