

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2023-00316

U.S. Patent No. 8,170,394

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 ’394 Patent was the subject of IPR2019-00089. The Board terminated the proceeding due to a Settlement Agreement. The ’394 Patent is currently the subject of pending IPR2022-01348. The ’394 Patent is currently asserted against Lenovo Group Ltd., Lenovo (United States) Inc., and Motorola Mobility LLC in *In re Certain Mobile Electronic Devices*, Inv. No. 337-TA-1324 (U.S.I.T.C.) and *Maxell, Ltd. v. Lenovo Group Ltd., et al.*, No. 6:22-cv-00334 (W.D. Tex.). The ’394 Patent is currently asserted against VIZIO, Inc. in *In re Certain Smart Televisions*, Inv. No. 337-TA-1338 (U.S.I.T.C.). The ’394 Patent was asserted against Blackberry Corp. and Blackberry Ltd. in *Maxell, Ltd. v. Blackberry Corp., et al.*, No. 1:17-cv-01446 (D. Del.), and against Lenovo Group Ltd., Lenovo (US) Inc., and Motorola Mobility LLC in *Certain*

Mobile Electronic Devices, Inv. No. 337-TA-1312 (U.S.I.T.C.).

III. Lead and Back-up Counsel

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

<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	<u>Back-Up Counsel</u> Amanda S. Bonner Registration No. 65,224 Luiz Miranda Registration No. 74,762 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 Facsimile: 312-706-8144 asbonner@mayerbrown.com lmiranda@mayerbrown.com
	<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

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 service by email: rpluta@mayerbrown.com, and Maxell-Vizio-Service@mayerbrown.com.

Dated: March 23, 2023

Respectfully submitted,

/Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Case IPR2023-00316
Patent No. 8,170,394
Mandatory Notices

CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of March, 2023, a copy of the attached **PATENT OWNER'S MANDATORY NOTICES UNDER 37 C.F.R. § 42.8** was served by electronic mail to the attorneys of record, at the following addresses:

Cono A. Carrano
ccarrano@akingump.com
C. Brandon Rash
brandon.rash@akingump.com
Ryan S. Stronczer
rstronczer@akingump.com
Brock F. Wilson
bfwilson@akingump.com
Clark Gordon
cgordon@akingump.com
AG-VIZIO-MAXELL-ITC-1338@akingump.com

Respectfully submitted,

Date: March 23, 2023

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)