UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners

v.

MAXELL, LTD.,
Patent Owner

Inter Partes Review No.: IPR2024-00867
U.S. Pat. No. 10,176,848

PETITIONER'S NOTICE OF INTENT TO DESIGNATE MICHAEL D. JAY AS A PROVISIONALLY RECOGNIZED PTAB ATTORNEY ELIGIBLE FOR AUTOMATIC *PRO HAC VICE* ADMISSION AS BACK-UP COUNSEL PURSUANT TO 37 C.F.R. § 42.10

Pursuant to 37 C.F.R. § 42.10, Petitioners Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. ("Petitioners") respectfully file a notice of intent to designate Michael D. Jay as a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission as backup counsel in this proceeding. The facts, supported by the attached Declaration of Michael D. Jay in Support of Notice of Intent to Designate a Provisionally Recognized PTAB attorney as Back-up Counsel ("Jay Decl."), establish Mr. Jay as a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission in this proceeding.

1. STATEMENT OF FACTS

Lead counsel for Petitioners, James Heintz, is a registered practitioner (Reg. No. 41,828) and experienced in *inter partes* proceedings in the USPTO. James Heintz represents Petitioners in connection with the pending district court action captioned *Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.,* Case No. 5:23-cv-00092 (EDTX).

Mr. Jay has experience in numerous patent infringement litigation matters in the federal court system. Mr. Jay has experience in trials and *Markman* hearings. Mr. Jay has experience conducting technical infringement and validity analysis, working with technical experts to prepare reports on infringement and validity issues, preparing for depositions of technical experts and fact witnesses, briefing claim construction issues, preparing for Markman hearings, drafting dispositive

motions on a range of technical issues, and representing clients in patent litigation trials and hearings before district courts around the country.

Mr. Jay has an established familiarity with the subject matter at issue in this proceeding. Petitioners wish to continue using Mr. Jay as counsel in this proceeding and have executed a Power of Attorney designating Mr. Jay as backup counsel.

Mr. Jay is a member in good standing of the State Bar of California and the United States District Courts of Central, Eastern, and Southern District Courts of California. (*Id.* at ¶ 3.)

He has never been suspended or disbarred from practice before any court or administrative body. (*Id.* at ¶ 4.) He has never had an application for admission to practice before any court or administrated body denied. (*Id.*) Nor has any court or administrative body imposed sanctions or contempt citations against him. (*Id.*)

Mr. Jay has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of 37 C.F.R. (*Id.* at ¶ 5.) He attests to satisfying all requirements set forth by the Board for *pro hac vice* recognition of a provisionally recognized PTAB attorney. (*Id.* at ¶ 1.) He also acknowledges and agrees to be subject to the USPTO Code of Professional Responsibility set forth in 37 C.F.R. §§ 11.101 et seq., and to disciplinary jurisdiction under 37 C.F.R. §11.19(a). (*Id.* at ¶ 5.)

Mr. Jay has previously applied to appear *pro hac vice* before the Office and has previously been recognized pro hac vice in a Board proceeding in IPR2013-00596. (*Id.* at ¶ 6.) He has also not been subsequently denied permission to appear *pro hac vice* in a Board proceeding. (*Id.*)

II. ANALYSIS

The facts contained in the Statement of Facts above and Mr. Jay's Declaration establish that Mr. Jay is a provisionally recognized PTAB attorney and eligible for automatic *pro hac vice* admission in this proceeding under 37 C.F.R. § 42.10 as backup counsel. Lead counsel James Heintz is a registered practitioner and experienced in *inter partes* proceedings in the USPTO. Mr. Jay is an experienced patent litigation attorney, and he has an established familiarity with the subject matter at issue in this proceeding.

III. CONCLUSION

For the foregoing reasons, Petitioners respectfully file a notice of intent to designate Michael D. Jay as a provisionally recognized PTAB attorney eligible for automatic *pro hac vice* admission in this proceeding.

Petitioners' Mandatory Notices will be filed identifying Mr. Jay as backup counsel.

Date: July 10, 2025

Respectfully submitted,

/s/ James Heintz
James Heintz

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Attorney for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Notice of Intent to Designate Michael D. Jay as a Provisionally Recognized PTAB Attorney Eligible for Automatic *Pro Hac Vice* Admission as Back-Up Counsel Pursuant to 37 C.F.R. § 42.10 and Exhibit 1019 have been served via electronic mail upon the following on July 10, 2025:

rpluta@mayerbrown.com

maxell-samsungservice@mayerbrown.com

Date: July 10, 2025

Respectfully submitted,

/s/ James Heintz

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