

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

LG ELECTRONICS, INC. AND LG ELECTRONICS USA, INC.,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00392

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 subject to Reexamination Control No. 90/014,628 confirming the patentability of Claims 5-6. The ’493 Patent was also subject to. *Apple Inc. v. Maxell, Ltd.*, 21-1033 (CAFC) filed October 9, 2020; *Apple Inc. v. Maxell, Ltd.*, IPR2020-00597 (PTAB) filed March 17, 2020; *Maxell, Ltd. v. Apple Inc.*, 5-19-cv-00036 (EDTX) filed March 15, 2019; *Olympus Corporation et al v. Maxell, Ltd. f/k/a Hitachi Maxell, Ltd.*, IPR2018-00904 (PTAB) filed June 20, 2018; *Maxell Ltd. v. ZTE Corporation*, 5-18-cv-00080 (EDTX) filed June 15, 2018; *ZTE Corporation et al v. Maxell, Ltd. et al.*, IPR2018-00236 (PTAB) filed November 22, 2017 and *Maxell, Ltd. v. ZTE Corporation et al.*, 5-16-cv-00179 (EDTX) filed November 18, 2016. The ’493 Patent is currently subject to the following action: *Maxell, Ltd. v. LG*

Electronics Inc. et al., 5-23-cv-00152 E.D. Tex. filed December 29, 2023
(transferred) and *Maxell, Ltd. v. LG Electronics Inc. et al.*, 5-24-cv-04972 N.D. Cal.
filed August 9, 2024 (pending).

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> Nicholas H. Ciulla Registration No. 78,409 Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 Telephone: 312-782-0600 nciulla@mayerbrown.com
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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 nciulla@mayerbrown.com.

Dated: January 21, 2025

Respectfully submitted,

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

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of January, 2025, 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:

IPR18768-0217IP4@fr.com

PTABInbound@fr.com

Respectfully submitted,

Date: January 21, 2025

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