

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

NEONODE SMARTPHONE LLC,

Plaintiff,

v.

APPLE INC.,

Defendants.

Civil Action No. 6:20-cv-00505-ADA

JURY TRIAL DEMANDED

**PLAINTIFF NEONODE SMARTPHONE LLC’S AMENDED MOTION FOR ISSUANCE
OF AN AMENDED LETTER OF REQUEST FOR INTERNATIONAL JUDICIAL
ASSISTANCE PURSUANT TO THE HAGUE CONVENTION OF 18 MARCH 1970 ON
THE TAKING OF EVIDENCE ABROAD IN CIVIL OR COMMERCIAL MATTERS,
AND RESPONSE TO THE STOCKHOLM DISTRICT COURT’S ADVISORY LETTER**

Plaintiff Neonode Smartphone LLC (“Neonode”) hereby moves for issuance of a response to the Advisory (“Advisory”) from the Stockholm District Court (“Stockholm Court”) entered into the docket in this action on June 30, 2021. (Dkt. #64). The Advisory states that the Stockholm Court’s initial assessment of discovery requests from Neonode, Apple Inc., (“Apple”) and Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) was that the requests would fall under the exemption concerning pre-trial discovery of documents, which under Swedish law could cause the request to be denied. The Advisory further states that the Stockholm Court will give this Court an opportunity to address the question of pre-trial discovery by providing a statement by no later than September 30, 2021. Neonode therefore requests that this Court issue a response and amended Letter of Request for International Judicial Assistance Pursuant to the Hague Convention of March 18, 1970 on the Taking of Evidence

Abroad in Civil or Commercial Matters as set forth in the attached Exhibit A (“the Amended Letter of Request and Response”). This response clarifies and amends this Court’s previously-issued Letter of Request for International Judicial Assistance Pursuant to the Hague Convention of March 18, 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters (the “Letter of Request”), significantly narrowing the discovery sought by Neonode.

Neonode requests that the Court expeditiously rule on this Motion, as any response must reach the Stockholm Court by **September 30, 2021**. Neonode’s counsel, assisted by Swedish counsel, will provide this Court’s response to the Stockholm District Court immediately following this Court’s entry of an order granting this motion.

On February 9, 2021, Neonode moved for issuance of the Letter of Request. The Letter of Request was attached as Exhibit A to Neonode’s moving papers. The Letter of Request seeks deposition testimony on specified topics and production of certain specified documents and categories of documents from two residents of Sweden, Magnus Goertz and Thomas Eriksson. Mr. Goertz is the inventor of the patents at issue in this litigation – U.S. Patent Nos. 8,095,879 (“the ‘879 Patent”) and 8,812,993 (“the ‘993 Patent” collectively, “the Patents in Suit”). Mr. Goertz co-founded, with Mr. Eriksson, a company in Sweden in 2000, which was later renamed Neonode AB, to develop and commercialize a mobile phone that would integrate an innovative gestural user interface with touch screen technology. Messrs. Goertz and Eriksson referred to this user interface as the “Neno” technology, and it is the subject of the Patents in Suit. Mr. Eriksson co-founded this company with Mr. Goertz, worked with him to commercialize the technology, and presented a prototype of what later became the Neonode N1 mobile phone at a trade show in Germany in March 2002 – evidence that Mr. Goertz had conceived of and had diligently worked

to reduce the patented technology to practice long before he filed the application to which the Patents in Suit claim priority, on December 10, 2002.

The deposition testimony and documents that Neonode seeks to obtain are directed to, among other things, (i) Mr. Goertz's conception and reduction to practice of the inventions claimed in the '879 and '993 Patents, (ii) secondary considerations of nonobviousness, such as the commercial success of the Neonode N1, N1m and N2 mobile phones that incorporated the patented Neno user interface, and industry praise for the Neno interface, and (iii) the value of the patented technology, as reflected in a (now expired) license agreement that Neonode Sweden AB entered into with Samsung Electronics Co., Ltd., on or about July 13, 2005, and that Mr. Goertz signed on behalf of the Swedish Neonode entity, pursuant to which Samsung was licensed under the patent application that later matured into the '879 Patent and to which the '993 Patent claims priority. (Case No. 6:20-cv-00507, Dkt. #1, ¶ 17).

Accordingly, the requested discovery is pertinent to, among other things, the priority date of the '993 Patent. This is a highly material issue in the Inter Partes Review proceeding initiated by Apple and Samsung and currently pending with respect to the '993 Patent (IPR2021-00145), because the primary reference in one of Defendants' two asserted obviousness combinations – JP Published Patent Appl. No. 2002-55750 (“the Hisatomi reference”) – has a priority date of February 20, 2002, just three weeks prior to the date on which Goertz and Eriksson were demonstrating a functional prototype of the Neonode N1 smartphone incorporating the patented user interface at the Cebit trade show in Hannover, Germany. Since it would not have been possible to design and construct a functional prototype incorporating the user interface in less than three weeks, the only reasonable inference to draw from these facts is that Goertz conceived of the patented user interface and worked to reduce it to practice prior to Hisatomi's priority date, which

if proven would eliminate Hisatomi as prior art in the pending IPR. Neonode's Letter of Request seeks testimony and documents concerning Goertz's conception and reduction to practice of the patented user interface.

By the Response to the Stockholm Court attached hereto as Exhibit A, Neonode seeks to amend the Letter of Request, clarifying and narrowing the scope of its document requests in an effort to address the Stockholm Court's concerns regarding the breadth of the requested discovery.

The Stockholm District Court did not object to the deposition testimony sought by Neonode, so there is no change to that portion of Neonode's request (see Attachment A to Exhibit A hereto). Although Neonode's counsel drafted discovery requests that were substantially more focused than the norm under procedure in U.S. federal courts, the Stockholm District Court did object to Neonode's request for production of documents, on the ground that it appears to seek document discovery sufficiently broad as to exceed the bounds of what Sweden will enforce pursuant to the Hague Convention. Accordingly, Neonode has drastically narrowed the scope of the requested discovery, withdrawing all documents requests directed to Thomas Eriksson, reducing the number of requested categories of documents and things directed to Magnus Goertz from fourteen to three, and narrowing even the three remaining requests so they are more tightly focused on documents that Mr. Goertz undoubtedly has in his possession. These revisions are reflected at pages 6-7 of Exhibit A, and in Attachment B to Exhibit A.

Accordingly, the Court should grant Neonode's motion and issue the attached Response to the Stockholm Court. In the event the Court grants this motion, Neonode requests that the Court execute the Amended Letter of Request and Response with the Court's signature and seal and provide an original of the executed Amended Letter of Request and Response to Neonode's

undersigned counsel. Neonode's counsel will then transmit the Response to the appropriate Swedish authority.

Counsel for Neonode has attempted to confer with Apple's counsel regarding the relief requested in this motion. On August 27, 2021, Neonode's counsel sent Apple's counsel an email informing Apple of Neonode's intent to file this motion and requesting that Apple's counsel advise as to whether Apple would oppose the motion. Apple's counsel requested a draft of the proposed response to the Stockholm District Court. Neonode's counsel provided a draft of the proposed response, as well as of this motion and all supporting papers, on August 31, 2021, along with a second request that Apple's counsel advise as to whether Apple would oppose the motion. Apple's counsel did not respond. Accordingly, Neonode's counsel filed the motion on September 1. Neonode's counsel then followed up with another request that Apple's counsel advise as to whether Apple would oppose the motion, and was again met with silence. Neonode then filed this amended motion on September 3, adding the content reflected in this paragraph.

DATED: September 3, 2021

By: /s/ Philip J. Graves

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