EXHIBIT 2

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

MAXELL, LTD.,	
Plaintiff,	Case No. 5:19-cv-00036-RWS
v.	**JURY TRIAL DEMANDED**
APPLE INC.,	
Defendant.	

MAXELL, LTD.'S MOTION *IN LIMINE* NO. 10 TO
EXCLUDE EVIDENCE OR ARGUMENTS REGARDING PRIOR ART
NOT ELECTED IN DEFENDANTS' FINAL ELECTION OF PRIOR ART

I.   INTRODUCTION[1]

At the beginning of this case, at Apple's request, the parties agreed and jointly moved to

focus the asserted claims and prior art to be addressed in this litigation in order to "streamline[]

the issues in this case to promote a 'just, speedy, and inexpensive determination' of this action."

See (D.I. 44) at 1 ("Focusing Order"). Maxell agreed to narrow its infringement case to twenty

claims, and Apple agreed to narrow its invalidity case to twenty prior art references. *Id.*

Notwithstanding this agreement and Order, Apple served a notice pursuant to 35 U.S.C. § 282 that

identifies hundreds of alleged prior art references on which it intends to rely at trial. Apple's clear

intentions necessitate this motion to limit Apple's trial evidence to the twenty references Apple

elected. *See* Apple's Final Election of Prior Art (Ex. 1).[2]

II.   BACKGROUND

35 U.S.C. § 282(c) requires an accused infringer to disclose the prior art on which it intends

to rely at trial for "anticipation" or "showing the state of the art," i.e., everything made available

to the public before the date of the patent. It serves as merely a notice function so that the patent

owner is not surprised at trial, and is required "at least thirty days before the trial." This Court's

Local Patent Rules make a § 282 notice superfluous, as they require the same information for the

same purpose. Notwithstanding, Apple served its notice on November 6, 2020.

Apple's § 282 notice, however, was not confined to the twenty prior art references on which

Apple elected to rely for trial pursuant to the Focusing Order. Instead, Apple lists fifty-four patents,

thirty-five printed publications, six prior art products and systems, and incorporates by reference

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[1] During the parties meet and confer, the parties agreed to a five page briefing limit and Apple requested that it be given until January 15, 2020 to file a reply. Maxell does not oppose Apple's request for an extension of time to file a five page reply.

[2] Maxell raised its concerns with the Court during the Pre-Trial Conference. The Court encouraged the parties to meet and confer on the issue and indicated that the Court authorized Maxell's motion to the extent the parties do not reach agreement on this issue. *See* Pre-Trial Tr. at 76:9-21.

hundreds of others, including "any prior art cited during…prosecution," "Apple's invalidity contentions and references cited therein," "invalidity contentions served on Maxell, Ltd. by any other company…and the references cited therein," "[e]ach IPR petition….and the references cited therein," and prior art cited in Apple's expert reports or invalidity expert reports served in other cases involving the patents-in-suit. *Id*. Apple's § 282 notice (Ex. 2) at 1-7.

Maxell immediately objected, noting that Apple's notice violated the Local Patent Rules and this Court's Focusing Order, and that it improperly expanded Apple's invalidity case. *See* Email from S. Siddiqui to M. Jay (Ex. 3), November 6, 2020. Without explanation, Apple replied indicating that it disagreed and will not withdraw the notice. *See* Email from M. Jay to S. Siddiqui (Ex. 4), November 9, 2020. In a related exchange with the PTAB, however, Apple indicated that it intends to rely on prior art listed in its § 282 notice "to establish the state of the art relevant to Petitioner's 35 U.S.C. § 101 defense." *See* Email from P. Hart to PTAB (Ex. 5), November 11, 2020. Then again during the Pre-Trial Conference, and on the parties' numerous meet and confers on this issue, Apple confirmed its intent to rely on unelected prior art based on opinions set forth in its experts' invalidity reports related to "the state of the art." *See* Pre-Trial Tr. at 74:6-14.

III.   ARGUMENT

The Focusing Order requires each side to narrow its case. For Apple, that required the narrowing of prior art to 20 references or products/systems. Focusing Order (D.I. 44). Though Apple ostensibly made a final election (Ex. 1), it has no intent of limiting its case to the elected art. Rather, Apple seeks to present to the jury art already dropped **and** art Apple never identified in this case.[3] Such use would unfairly prejudice Maxell and confuse and mislead the jury. Thus,

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[3] The identified exhibits only represent the alleged prior art Apple may seek to enter into evidence. It does not limit the art that Apple may seek to discuss without such entry.

the Court should preclude Apple from introducing evidence or arguments based on **unelected** prior art under Fed. R. Evid. 403 and as violative of the Court's Focusing Order.

Apple states that it will use the references solely for the purpose of showing the "state of the art" and/or to pursue invalidity under § 101.[4] But that is a distinction without a difference. First, the Focusing Order does not distinguish between prior art references used to anticipate a claim or establish the state of the art. It simply and clearly refers to the total number of prior art references Apple may assert in total and against any single patent (D.I. 44). Apple's "explanation" that it intends to use the prior art to show the "state of the art" and/or to pursue invalidity under § 101 does not somehow insulate Apple from violating the Focusing Order. Moreover, much of the prior art cited in Apple's notice is relevant only to patents where Apple does not even assert a 101 defense anyway, and the Court's ruling on dispositive motions renders moot Apple's 101 defense for the '306 and '794 patents.

Second, courts have held that a notice under 35 U.S.C. § 282 cannot be used to circumvent the local patent rules or other scheduling order requirements (*e.g.*, Focusing Order requirements). *See ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 550–51 (Fed. Cir. 1998) (finding that § 282 does not supersede the Federal Rules of Civil Procedure or the Patent Standing Order and Case Scheduling Order). Further, courts have specifically rejected the "state of the art" argument Apple is pursuing, noting that the "state of the art is a subset of the prior art." *see also Emcore Corp. v. Optium Corp.*, No. CIV. A. 7-326, 2009 WL 3381800, at *2 (W.D. Pa. Oct. 16, 2009) (confirming that the state of the art is a subset of prior art and preventing defendant from expanding on its invalidity positions through a § 282 notice). Apple seems "to think that under 35 U.S.C. § 282(c), [it] can put in

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[4] Noteworthy, much of the prior art cited in Apple's § 282 notice is relevant only to patents where Apple does not even assert a 101 defense and the Court's ruling on dispositive motions renders moot Apple's 101 defense for the '306 and '794 patents.

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