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

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

APPLE'S FINAL ELECTION OF PRIOR ART

Pursuant to the Court's Order Focusing Patent Claims and Prior Art to Reduce Costs (D.I. 44) and Docket Control Order (D.I. 46, 232), Defendant Apple Inc. ("Apple") hereby discloses its Final Election of Prior Art for the elected claims of U.S. Patent Nos. 6,329,794 ("'794 patent"), 6,408,193 ("'193 patent"), 6,430,498 ("'498 patent"), 6,580,999 ("'999 patent"), 6,748,317 ("'317 patent"), 6,928,306 ("'306 patent"), 7,116,438 ("'438 patent"), 8,339,493 ("'493 patent"), 10,212,586 ("'586 patent"), and 10,084,991 ("'991 patent") (collectively, the "Asserted Patents") disclosed by Plaintiff Maxell, Ltd. ("Maxell").

Maxell's Infringement Contentions wholly fail to put Apple on notice of Plaintiff's theories of infringement for reasons set forth in, for example, Apple's Motion to Compel Compliant Infringement Contentions under P.R. 3-1(g) (D.I. 123, 154), the Court's Order Granting Apple's Motion to Compel (D.I. 204), and Apple's letter to Maxell on this issue sent on March 31, 2020. As of the date of this disclosure, Apple has yet to receive infringement contentions compliant with the local Patent Rules that set forth Maxell's infringement theories

with respect to the source code produced by Apple. Thus, Apple's election of prior art is based only on information known to date, including Apple's current understanding of Maxell's deficient infringement contentions. Apple reserves the right to amend its election of prior art as appropriate, including in response to any further amendments and/or supplement to Maxell's Infringement Contentions (if any is permitted by the Court) or to any disclosure of infringement theories in Maxell's expert reports for which Apple has not received fair notice.

The Court's Order Focusing Patent Claims and Prior Art to Reduce Costs states: "For purposes of [the] Final Election of Asserted Prior Art, each obviousness combination counts as a separate prior art reference." D.I. 204 at 2. Pursuant to the Court's Order, Apple discloses the following election of prior art.

Final Election of Asserted Prior Art

The '317, '498, and '999 Patents:

1. The CyberGuide system ("CyberGuide")[1] in combination with U.S. Patent No. 6,067,502 to Hayashida et al. ("Hayashida").

2. Hayashida in combination with Japanese Patent Publication No. JPH10-197277 to Maruyama et al. ("Maruyama")[2].

3. The Garmin NavTalk system ("NavTalk") in combination with Hayashida.

4. NavTalk in combination with Maruyama.

[1] The Court's Focusing Order specifies that "a prior art instrumentality (such as a device or process) and associated references that describe that instrumentality shall count as one reference." D.I. 44 at 1 n. 1. Accordingly, nothing about this election should be read to limit the sources of evidence on which Apple intends to rely to prove that such instrumentalities/systems are invalidating prior art.

[2] Apple has produced certified translations of all non-English publications identified in its Final Election of Prior Art and intends to rely on said translations at trial.

The '493 Patent:

5. U.S. Patent No. 7,903,162 ("Juen '162")[3] in combination with U.S. Patent No. 6,563,535 ("Anderson '535").

6. Juen '162 and Anderson '535 in combination with U.S. Patent No. 5,444,482 ("Misawa '482").

7. The Sony MVC-FD83/MVC-FD88 digital cameras ("MVCFD83").

8. MVCFD83 in combination with Misawa '482.

The '794 Patent:

9. U.S. Patent No. 6,363,266 to Nonogaki ("Nonogaki") in combination with U.S. Patent No. 5,870,685 ("Flynn '685").

10. Japanese Utility Model Publication No. U306314 to Tagoshi ("Tagoshi").

The '193 Patent:

11. U.S. Patent No. 5,548,616 ("Mucke '616") in combination with Japanese Patent Application Publication No. H10-285059 ("Nakayama '059").

12. U.S. Patent No. 6,236,863 ("Waldroup '863") in combination with Mucke '616.

The '306 Patent:

13. U.S. Patent No. 6,122,347 ("Borland '347").

14. Borland '347 in combination with U.S. Patent No. 6,763,105 ("Miura '105").

15. International Patent Publication No. WO 1996/027974 ("Van der Salm '974") in combination with Miura '105.[4]

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[3] Apple served an interrogatory seeking Maxell's contention as to whether it disputes that Juen '162 qualifies as prior art to the '493 Patent. Maxell did not dispute the prior art status of Juen '162. *See* Maxell's Objections and Responses to Apple's Interrogatory No. 20 (served March 30, 2020). To the extent Maxell contests the prior art status of Juen '162, Apple also elects Japanese Patent Application Publication No. H10-108121, published on April 24, 1998 ("Juen '121"), which was filed by the same inventor and contains the same disclosure as Juen '162. The Court's Focusing Order specifies that "closely related work of a single prior artist" counts as a single reference. D.I. 44 at 1 n. 1.

[4] Apple has filed a petition for *inter partes* review of the '306 patent. *See* IPR2020-00204. If the Patent Trial and Appeal Board institutes IPR2020-00204, Apple will withdraw the Van der Salm '974 and Miura '105 combination from this litigation and will not present the Van der Salm '974 and Miura '105 combination in the district court trial.

The ’991 Patent:

16. U.S. Patent No. 7,565,680 (“Asmussen ’680”) in combination with U.S. Patent Application Publication No. 2003/0041333 (“Allen ’333”).

The ’438 Patent:

17. Japanese Patent Publication No. 2003-006110 (“Yamazaki ’110”).

18. Yamazaki ’110 in combination with U.S. Patent Application Publication No. 2003/0149874 (“Balfanz ’874”).

The ’586 Patent:

19. U.S. Patent No. 6,871,063 (“Schiffer ’063”).

20. Schiffer ’063 in combination with U.S. Patent Application Publication No. 2006/0041746 (“Kirkup ’746”).

April 7, 2019 */s/ Luann L. Simmons*

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