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

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

DEFENDANT APPLE INC.'S INVALIDITY CONTENTIONS PURSUANT TO PATENT LOCAL RULES 3-3 AND 3-4

I. INTRODUCTION

Pursuant to the Court's Docket Control Order entered July 9, 2019 (D.I. 46) and Patent Local Rules 3-3 and 3-4, Defendant Apple Inc. ("Apple") provides these preliminary invalidity contentions ("Invalidity Contentions") to Maxell, Ltd. ("Maxell") for the asserted claims of U.S. Patent Nos. 6,748,317 ("the '317 patent"); 6,580,999 ("the '999 patent"); 8,339,493 ("the '493 patent"); 7,116,438 ("the '438 patent"); 6,408,193 ("the '193 patent"); 10,084,991 ("the '991 patent"); 6,928,306 ("the '306 patent"); 6,329,794 ("the '794 patent"); 10,212,586 ("the '586 patent"); 6,430,498 ("the '498 patent") (collectively, the "Asserted Patents").

Based on Maxell's Disclosure of Asserted Claims and Infringement Contentions ("Infringement Contentions") served on June 12, 2019, Maxell is asserting claims 1-3, 5-15, 17, and 18 of the '317 patent; claims 1-6 of the '999 patent; claims 1, 3-6, 10, and 11 of the '493 patent; claims 1-7 of the '438 patent; claims 1, 6, and 7 of the '193 patent; claims 1-5 and 8-12 of the '991 patent; claims 2, 5, 6, and 12-15 of the '306 patent; claims 1-3 and 5-14 of the '794 patent; claims 1-2, 6-7, 9-10, 13-14, and 16-18 of the '586 patent; and claims 1, 3-5, 7-11, and 13 of the '498 patent (collectively, "the Asserted Claims"). Apple addresses the invalidity of the Asserted Claims in these Invalidity Contentions, and concludes with a description of its document production and identification of additional reservations and explanations.

These Invalidity Contentions are based on the claim constructions or interpretations likely to be advanced by Maxell (as reflected in Maxell's Complaint and Infringement Contentions), and are not necessarily based on what Apple contends are the proper constructions. By applying Maxell's apparent constructions and/or interpretations, Apple does not concede in any way that those constructions are correct, and instead expressly reserves the right to oppose those constructions. Apple expressly reserves the right to amend these Invalidity Contentions after the Court has construed all relevant claim terms under P.R. 3-6. Furthermore, some of Apple's

contentions herein are based on infringement allegations made by Maxell. Apple does not concede in any way that those infringement allegations are correct, but rather asserts the fundamental principle that whatever infringes a claim if later in time must anticipate if earlier in time. These Invalidity Contentions use the acronym "PHOSITA" to refer to a person having ordinary skill in the art to which the alleged invention pertains around the respective priority dates alleged by Maxell.

Apple hereby incorporates by reference all Invalidity Contentions against any of the Asserted Patents or their related patents from prior cases, including, but not limited to, the Invalidity Contentions served by the defendants in *Hitachi Maxell, Ltd. v. Huawei Device USA, Inc.*, Case No. 5:16-CV-00178-RWS (E.D. Tex.); *Hitachi Maxell, Ltd. v. ZTE Corp.*, Case No. 5:16-CV-00179-RWS (E.D. Tex.); *Maxell, Ltd. v. ASUSTEK Computer Inc.*, Case No. 2:17-cv-7528-R-MRW (C.D. Cal.); and *Maxell, Ltd. v. ASUSTEK Computer Inc.*, Case No. 3:18-cv-01788-VD (N.D. Cal.). Maxell is already in possession of these Invalidity Contentions and associated claim charts. Apple further incorporates by reference all prior art cited during prosecution of the Asserted Patents, and all *inter partes* review (IPR) petitions filed against the Asserted Patents and the prior art cited in these IPR petitions, including, but not limited to, IPR2018-00235, IPR2019-00071, IPR2018-00236, IPR2018-00904, IPR2018-00241, IPR2018-00237, and IPR2019-00640.

II. '317, '999, AND '498 PATENTS

The '498 patent was filed with the United States Patent and Trademark Office on July 11, 2000. The '999 patent was filed with the United States Patent and Trademark Office on June 18, 2002 as a continuation of Application No. 09/613,634 (filed on July 11, 2000; issued as the '498 patent). The '317 patent was filed with the United States Patent and Trademark Office on May 5, 2000 as a continuation of Application No. 10/173,423 (filed on June 18, 2001; issued as the '999 patent), which in turn was filed as a continuation of Application No, 09/613,634 (filed on July 11,

2000). In its Infringement Contentions, Maxell claims a priority date of July 12, 1999 for the '317, '999, and '498 patents. Apple reserves the right to serve additional or modified invalidity contentions should Maxell be permitted to amend or modify its claimed priority date.

A. Prior Art

Apple identifies the following prior art now known to Apple to anticipate and/or render obvious one or more claims of the '317, '999, and '498 patents under at least 35 U.S.C. §§ 102(a), (b), (e), (g), and/or 103.

1. Prior Art Patents and Publications

The following patents and publications are prior art for the Asserted Claims of the '317, '999, and '498 patents under at least 35 U.S.C. §§ 102(a), (b), (e), and/or (g). Invalidity claim charts for these references are attached as Exhibits A1 through A21.

1. Japanese Patent Publication No. JPH08-285613 to Akiyama et al. ("Akiyama"), published on November 1, 1996.
2. Japanese Patent Publication No. JPH10-197277 to Maruyama et al. ("Maruyama"), published on July 31, 1998.
3. U.S. Patent No. 5,781,150 to Norris ("Norris"), filed on October 13, 1995 and issued on July 14, 1998.
4. Cyberguide: A Mobile Context-Aware Tour Guide by Abowd et al. ("Abowd"), published on September 29, 1998.
5. PCT Application US98/17237 (WO 99/09374) to Knockeart, et al. ("Knockeart"), published on February 25, 1999.
6. U.S. Patent No. 6,067,502 to Hayashida et al. ("Hayashida"), filed on August 21, 1997 and issued on May 23, 2000.
7. U.S. Patent No. 5,815,411 to Ellenby, et al. ("Ellenby"), filed on September 10, 1993 and issued on September 29, 1998.
8. Japanese Patent Publication No. JPH09-311625 to Ikeda ("Ikeda"), published on December 2, 1997.
9. Japanese Patent No. JPH05-264711 ("Yokoyama" or the "'711 Patent"), published on October 12, 1993.

10. U.S. Patent No. 5,589,835 to Gildea et al. ("Gildea"), filed on December 20, 1994 and issued on December 31, 1996.

11. U.S. Patent No. 6,525,768 to Obradovich ("Obradovich"), filed on October 21, 1999 based on Provisional Application No. 60/105,050 ("the '050 Application") filed on October 21, 1998, and issued on February 25, 2003.[1]

12. U.S. Patent No. 5,592,382 to Colley ("Colley"), issued on January 7, 1997.

13. USRE42,927 to Want et al. ("Want") reissued from U.S. Patent No. 6,122,520, filed on February 13, 1998 and issued on September 19, 2000.

Apple's investigation into prior art patent and publication references remains ongoing and Apple reserves the right to identify and rely on additional patent or publication references that describe or are otherwise related to the prior art systems identified below based on information obtained through discovery.

2. Prior Art Systems

The following systems are anticipatory prior art for the Asserted Claims of the '317, '999, and '498 patents under at least 35 U.S.C. §§ 102(a), (b) and/or (g):

1. Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to the Seiko Epson Locatio ("Locatio"), as exemplified in claim charts in Exhibits A13-A15. As part of these Invalidity Contentions, Apple has produced documents relating to Locatio. Based on information available to Apple, Apple believes that this system was conceived and/or reduced to practice by engineers at Seiko Epson at least before

[1] The '050 Application is substantively identical to Obradovich, including the same written description of the invention and figures illustrating the same. Where, as here, "the specification of the provisional" satisfies 35 U.S.C. § 112 ¶ 1 for the "invention claimed in the non-provisional application," the non-provisional patent qualifies as prior art under 35 U.S.C. § 102(e) as of the date of the filing date of its provisional application. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015); *see also New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002) ("[F]or the non-provisional utility application to be afforded the priority date of the provisional application, ... the written description of the provisional must adequately support the claims of the non-provisional application."). Additionally, because the disclosures are substantively identical, all disclosures from Obradovich cited in these Invalidity Contentions are also contained in the '050 Application. Accordingly, Obradovich qualifies as prior art to the '317, '498, and '999 patents under at least 35 U.S.C. § 102(e) as of the '050 Application's filing date of October 21, 1998.

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