

# EXHIBIT J

**From:** [Wisnia, Howard N.](#)  
**To:** [Fussell, Tripp](#); [Eric Findlay](#)  
**Cc:** [Geoff Culbertson](#); [US-CLIENT-HM-ZTE-Service](#); [ZTE Hitachi](#)  
**Subject:** RE: Maxell v. ZTE  
**Date:** [Tuesday, June 12, 2018](#) 4:33:10 PM

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Tripp, we are still considering your note below. We respond as to the '317 patent specifically here.

ZTE will no longer assert with respect to the '317 Patent:

- U.S. Patent No. 5,781,150 (“Norris”) (Dkt. #185)
- Japanese Publication No. H10-232992 (“Nojima”) (Dkt. #185)
- U.S. Patent No. 6,125,326 (“Ohmura”) (Dkt. #185)
- U.S. Patent No. 5,543,789 (“Behr”) (Steve Moore’s Feb. 2 email)

However, ZTE does still plan to assert the following with respect to the '317 Patent:

- U.S. Patent No. 6,266,614 (“Alumbaugh”) anticipates Claim 1, 2, 3, 6, 7, 15; and
- Alumbaugh in combination with U.S. Patent No. 5,592,382 (“Colley”) renders obvious Claim 17

Maxell did not move to strike these particular timely-asserted invalidity contentions, *see* Dkt. 141 at 2, and therefore the Court’s Order did not address them. They were disclosed in ZTE’s invalidity contentions served on April 17, 2017. *See* Ex. Y to Andrews Report; *see also* Chart B-3 dated July 2017. These contentions were further included in Scott Andrews’s expert report itself. *See* Andrews Report, ¶¶ 136-154; 565-641; 646-741; *see also* Ex. E, I to Andrews Invalidity Report.

We have now provided you with a narrowing of the '317 Patent invalidity assertions. You have previously represented that you would be further narrowing the asserted claims for this patent. Please provide that by return email today. Thanks, Howard

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**From:** Fussell, Tripp <JFussell@mayerbrown.com>  
**Sent:** Monday, June 11, 2018 7:06 PM  
**To:** Wisnia, Howard N. <howard.wisnia@pillsburylaw.com>; Eric Findlay <EFindlay@FindlayCraft.com>  
**Cc:** Geoff Culbertson <gpc@texarkanalaw.com>; US-CLIENT-HM-ZTE-Service <HM-ZTE-Service@mayerbrown.com>  
**Subject:** Maxell v. ZTE

Howard and Eric:

In light of the meet and confer today, Judge Schroeder's order denying ZTE's Motion to Amend Invalidity Contentions, and Steve Moore's February 2 email (attached), we understand that the following prior art references are not part of this case:

'794 Patent

- ACPI (Howard's representation on today's meet and confer)
- U.S. Patent No. 6,360,327 ("Hobson") (Steve Moore's Feb. 2 email)
- U.S. Patent No. 5,560,022 ("Dunstan") (Steve Moore's Feb. 2 email)

'491 & '695 Patents

- Japanese Patent Application Publication No. Hei 6-295195 ("Hirose") (Dkt. #185)
- U.S. Patent No. 5,765,136 ("Fukuchi") (Steve Moore's Feb. 2 email)

'493 & '729 Patents

- U.S. Patent No. 5,502,484 ("Okada") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,497,191 ("Yoo") (Howard's representation on today's meet and confer)

'193 Patent

- U.S. Patent No. 5,107,225 ("Wheatley 225") (Dkt. #185)
- U.S. Patent No. 5,056,109 ("Gilhousen 109") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,603,106 ("Toda") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,559,471 ("Black") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,752,171 ("Akiya") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,128,629 ("Trinh") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,423,081 ("Thiele") (Howard's representation on today's meet and confer)
- U.S. Patent No. 3,486,128 ("Lohrmann") (Howard's representation on today's meet and confer)
- Nielsen Article (Howard's representation on today's meet and confer)
- Fujita Article (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,617,060 ("Wilson") (Howard's representation on today's meet and confer)
- U.S. Patent No. 5,420,536 ("Faulkner") (Howard's representation on today's meet and confer)
- U.S. Patent No. 4,901,307 ("Gilhousen 307") (Howard's representation on today's meet and

confer)

'317 Patent

- U.S. Patent No. 5,781,150 ("Norris") (Dkt. #185)
- Japanese Publication No. H10-232992 ("Nojima") (Dkt. #185)
- U.S. Patent No. 6,125,326 ("Ohmura") (Dkt. #185)
- U.S. Patent No. 5,592,382 ("Colley") (Dkt. #185)
- U.S. Patent No. 6,266,614 ("Alumbaugh") (Dkt. #185)
- U.S. Patent No. 5,543,789 ("Behr") (Steve Moore's Feb. 2 email)

In addition, we confirm that Maxell is proceeding to trial on the following claims:

- Claims 1, 2, and 9 of the '794 Patent
- Claims 1 and 8 of the '491 Patent
- Claim 1 of the '695 Patent
- Claims 5 and 6 of the '493 Patent
- Claims 1 and 2 of the '729 Patent

Further, while you were unprepared today to provide to us which specific combinations ZTE will be relying upon at trial for invalidity (including for the '193 patent, which currently has many dozens of possible combinations that ZTE could use), you indicated that ZTE would endeavor to provide us this information as soon as possible (in particular for the '193 patent) but in no event later than Thursday. We informed you at that time we would likewise provide to you the claims we intend to assert at trial.

If you disagree with any of the above, please let us know by no later than 9am tomorrow Central time so that we can inform the court of the result of the meet and confer.

Regards,  
Tripp

**James A. Fussell, III (Tripp)**

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