

I. INTRODUCTION

Defendant ZTE (USA) Inc. (“Defendant” or “ZTE”) respectfully submits this response in opposition to Plaintiff Hitachi Maxell, Ltd.’s (“Plaintiff” or “Maxell”) Motion for Partial Summary Judgement of No Invalidity under 35 U.S.C. §103 of Claims 1-7 of U.S. Patent No. 6,408,193 (Dkt. No. 199.)

II. RESPONSES TO THE STATEMENT OF ISSUES

1. Should partial summary judgment of no invalidity be granted for an obviousness argument when an expert fails to address a limitation of the claims for that obviousness argument?

Response: Is Maxell entitled to summary judgment on an issue for which there is no longer a case or controversy?

III. RESPONSES TO THE STATEMENT OF UNDISPUTED MATERIAL FACTS

1. In his expert report on invalidity, Dr. Zhi Ding opines that “Claims 1, 6, 7 [sic] are obvious in view of the AAPA to the ’193 Patent.” (Declaration of Bryan Nese in Support of Plaintiff Maxell, Ltd.’s Motion For Partial Summary Judgment of No Invalidity Under 35 U.S.C. § 103 of Claims 1-7 of U.S. Patent No. 6,408,193 Dkt. No. 199 (“Nese Decl.”), Ex. A, ¶ 408.)

Response: Undisputed.

2. Claim 1 of the ’193 Patent recites “said controller includes a central processing unit and a memory” (“limitation 1(g)(ii)”). (Nese Decl., Ex. C, 11:21-22.)

Response: Undisputed.

3. Dr. Ding’s report does not show how the AAPA teaches “limitation 1(g)(ii)” of claim 1 of the ’193 Patent. (*See* Nese Decl., Ex. A, 264-77.) His report fails to relate the AAPA to this limitation at all. *See Id.*

Response: Disputed but now moot.

4. Claim 7 of the '193 Patent recites “wherein said transmitter includes a variable amplitude amplifier and a power amplifier, said power amplifier includes a maximum power detector, said controller includes a central processing unit and a memory, said controller controls said transmitter so that an open-loop power control is performed and then a closed-loop power control is performed according to said power control signal so as to control the transmitted power to converge into a range required by said cell-site station, said controller controls a gain of said variable amplitude amplifier using a function defining a relation between bias data and gain data stored in said memory, and said maximum power detector controls and output power of said power amplifier” (“limitation 7(g)”). (Nese Decl., Ex. C, 12:34-47.)

Response: Undisputed.

5. Dr. Ding’s report does not show how the AAPA teaches “limitation 7(g)” of claim 7 of the '193 Patent. (See Nese Decl., Ex. A, ¶¶ 345-74.) His report fails to relate the AAPA to this limitation at all. *See Id.*

Response: Disputed but now moot.

6. Claims 2-6 of the '193 Patent each depend, directly or indirectly, from claim 1 of the '193 Patent. (Nese Decl., Ex. C, 11:32-12:7.)

Response: Undisputed.

IV. ARGUMENT

In order to streamline issues for trial, ZTE is no longer asserting that claim 1-7 of the '193 patent are obvious in view of the AAPA to the '193 Patent. (Nese Decl., Ex. A, ¶408.) Maxell’s motion for partial summary judgment seeks a dispositive judgment on an issue for which there is no longer a case or controversy, and Maxell cites to no case law holding that such

relief is appropriate. Case law in this District indicates that courts should not grant summary judgment on issues that are not to be presented at trial. *See, e.g., VirnetX Inc. v. Apple Inc.*, 925 F. Supp. 2d 816, 849 (E.D.Tex.2013) (“The Court encourages and requires the parties to narrow their case for trial. Accordingly, the Court will not penalize such attempts to narrow issues by entering judgment on issues not presented at trial.”).

Maxell’s motion should be denied as moot.

V. CONCLUSION

For all the foregoing reasons, the Court should deny Maxell’s motion.

Respectfully submitted,

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Dated: March 26, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was served upon counsel of record via CM/ECF and electronic mail, pursuant to the Federal Rules of Civil Procedure and the Local Rules for the Eastern District of Texas, on March 26, 2018.

/s/ Nicole S. Cunningham

Nicole S. Cunningham