

**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

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**APPLE INC.'S MOTION TO COMPEL INFRINGEMENT CONTENTIONS
COMPLIANT WITH PATENT RULE 3-1(G) OR, IN THE ALTERNATIVE, TO
PRECLUDE MAXELL'S RELIANCE ON SOURCE CODE FOR INFRINGEMENT**

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I. INTRODUCTION

The Local Patent Rules, through P.R. 3-1(g), plainly required Maxell to provide “pinpoint citations to source code” in its infringement contentions to give Apple “adequate notice” of Maxell’s infringement theories. *UltimatePointer, LLC v. Nintendo Co.*, No. 6:11-CV-496-LED, 2013 WL 6253767, at *3 (E.D. Tex. Dec. 3, 2013). Maxell has not done so, and is now refusing to supplement its contentions, despite the fact that Apple first made source code available for Maxell’s inspection in August and Apple tolled—at Maxell’s request—the deadline for Maxell to provide its P.R. 3-1(g) contentions. Maxell’s refusal to supplement contravenes the purpose of the Local Patent Rules, which are designed to provide “all parties with adequate notice and information with which to litigate their cases” and deter “litigation by ambush.” *Computer Acceleration Corp. v. Microsoft Corp.*, 503 F. Supp. 2d 819, 822 (E.D. Tex. 2007).

Instead of providing pinpoint citations to source code, Maxell chose merely to list source code file and folder names for each limitation it contends is practiced by software—identifying more than hundreds and even thousands of files as relevant for each “software” limitation. It never tried to identify any “single structure, process, algorithm, feature or function” alleged to infringe these software limitations. *Connectel, LLC v. Cisco Sys., Inc.*, 391 F. Supp. 2d 526, 528 (E.D. Tex. 2005). And it never explained how it contends the source code allegedly satisfies each claim limitation. Maxell’s bulk listing of source code gives Apple no notice of Maxell’s source code-based infringement theories. Thus, Apple respectfully requests the Court require that Maxell immediately provide compliant infringement contentions or preclude Maxell from relying on source code evidence for its infringement case.

II. MATERIAL FACTS

In its original infringement contentions, Maxell alleged that every currently asserted claim includes one or more “software limitations” governed by P.R. 3-1(g). This Rule required

Maxell to “identify, on an element-by-element basis for each asserted claim, what source code ... allegedly satisfies the software limitations” within 30 days of source code production. D.I. 42 at 2. Based on Maxell’s broad designations, Apple made available for inspection approximately 900,000 files in 185 clearly named directories on August 14, 2019. And at Maxell’s request, Apple tolled the time for Maxell to comply with Rule 3-1(g) by a month.¹ But, when Maxell served its Supplemental Infringement Contentions (“SIC”), instead of providing pinpoint citations to source code—as required under the Patent Rules—Maxell only identified long lists of file and folder names for each alleged software limitation.

For example, claim element 1(d) of U.S. Patent No. 8,339,493 recites “mixing or culling signal charges accumulated in the N number of vertically arranged pixel lines” Maxell contends that this is a P.R. 3-1(g) limitation that implicates software. But instead of identifying “what source code ... allegedly satisfies” this limitation, the SIC lists 47 pages of source code files and folder names—identifying 6 full folders and 682 individual files in other folders—just for this single limitation. *See* Ex. B (excerpt). One of the folders Maxell listed alone contains over 27,000 additional files. Thus, Maxell’s SIC identified tens of thousands of files (which would translate into hundreds of thousands of pages if printed), all without further explanation of the listed code, for a single software limitation. As another example, claim element 1(f) of U.S. Patent No. 10,084,991 recites “paus[ing] the displaying of the first digital information and render[ing] the camera operative.” Maxell asserted that this too is a P.R. 3-1(g) limitation, but

¹ Maxell did not even begin the process of clearing its experts for source code review—a process of which it was aware it must satisfy at least beginning when the parties first filed the protective order on June 26, 2019—until *after* Apple made its source code production in August. And, to date, Maxell has not printed a single page of code, nor has any of Maxell’s experts who are expected to offer infringement opinions even reviewed the produced code.

listed 74 full folders and more than 70 pages of file names. *See* Exs. A, C. Apple cannot divine from these long lists what portions of code Maxell contends satisfy the relevant limitations.²

Apple requested that Maxell correct its SIC, but Maxell refused. Simmons Decl. ¶ 6.

III. LEGAL STANDARD

P.R. 3-1 requires a patentee to disclose its “particular theories of infringement,” *Zix Corp. v. Echoworx Corp.*, No. 2:15-CV-1272-JRG, 2016 WL 3410367, at *1 (E.D. Tex. May 13, 2016), including the “single structure, process, algorithm, feature or function of any accused product” alleged to infringe, *Connectel*, 391 F. Supp. 2d at 528. Infringement contentions that fail to identify “what specific parts of the accused products practice the relevant software claim elements” may be stricken. *Zix*, 2016 WL 3410367, at *2. P.R. 3-1(g) is also plain on its face: requiring that Maxell identify the “source code” that “allegedly satisfies” the claim limitations.

Indeed, specific line-item identification of source code is the required practice in this District. *Michael S Sutton Ltd. v. Nokia Corp.*, No. 6:07-CV-203, 2009 WL 9051240, at *2 (E.D. Tex. Feb. 13, 2009) (explaining that a plaintiff must identify the “location of the [claimed elements] in the source code” and finding general citations to 83 pages of source code insufficient); *see also UltimatePointer, LLC*, 2013 WL 6253767, at *3 (requiring “pinpoint citations” to source code); *Wi-LAN, Inc. v. Acer, Inc.*, No. 2:07-CV-473-TJW, 2010 WL 9593050, at *1 (E.D. Tex. July 29, 2010) (requiring plaintiff to supplement by “identifying the source code lines”); *Treehouse Avatar LLC v. Valve Corp.*, No. C17-1860-RAJ, 2019 WL 917403, at *2 (W.D. Wash. Feb. 25, 2019) (“[T]he Northern District of California, Central District of California, and Eastern District of Texas, generally hold that in software cases, once

² These are just two of many examples of Maxell’s bulk listing of source code, including substantially overlapping 45+ page lists of file names for each asserted claim of the ’493 patent. The SIC lists 10 or more pages of source code folders and file names (*i.e.*, hundreds of files) each for 57 claim elements, including 25 or more pages for 39 claim elements.

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