

EXHIBIT A

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

MAXELL, LTD.,

Plaintiff

v.

APPLE INC.,

Defendant.

NO. 5:19-cv-00036-RWS

JURY TRIAL DEMANDED

REQUEST FOR INTERNATIONAL JUDICIAL ASSISTANCE (LETTER ROGATORY)

The United States District Court for Eastern District of Texas presents its compliments to the appropriate Judicial Authority in Japan and has the honor to request your competent Court by directing its constable or bailiff to serve the enclosed documents pertaining to a civil dispute on Hitachi, Ltd. (“Hitachi”) to be used in the civil proceedings before this court in the above captioned matter.

I. REQUEST FOR JUDICIAL ASSISTANCE

The undersigned, Honorable Robert W. Schroeder III, District Judge for the United States District Court for the Eastern District of Texas, requests the assistance described herein as necessary in the interests of justice. In particular, the undersigned requests that you cause, by your proper and usual process, the inspection by representatives of Defendant Apple Inc. (“Apple”), certain documents in the possession of Hitachi with its place of business at:

6-6, Marunouchi 1-chome

Chiyoda-ku

Tokyo, 100-8280

Japan

The evidence sought is outlined in Attachment A (attached hereto). **Responses and evidence returned to this court may be submitted as evidence at trial and may be necessary for the conclusion of these proceedings.** As allowed by the internal laws of Japan, please have all returned evidence verified and/or certified as to completeness and authenticity.

If any portion of this Request is deemed to be unacceptable under the laws of Japan, please disregard that portion and continue to comply with as much of the Request as legally permissible.

II. FACTS OF THE CASE

Complainant Maxell, Ltd. (“Maxell”) alleges that defendant Apple Inc. (“Apple”) has infringed ten of Maxell’s United States patents in violation of 35 U.S.C. § 271.¹ Hitachi was the original assignee of all ten patents or parent applications thereto (“the asserted patents”). Hitachi assigned the asserted patents in 2009 to Hitachi Consumer Electronics Co., Ltd., which then assigned the asserted patents in 2013 to Hitachi Maxell, Ltd., when then later assigned the asserted patents to Maxell Ltd.

While Hitachi still owned the asserted patents, it engaged in communications with Apple related to potential sale and/or license of certain patents. Hitachi also entered into license

¹ The patents alleged to be infringed by Apple include: 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”); and 6,430,498 (“the ’498 Patent”).

agreements with companies that supply components to Apple that are accused of infringing. Thus, it appears that Hitachi possesses information of relevance to this litigation, including documents related to the conception and reduction to practice of the asserted patents, marking, communications related to licensing and/or sale of the asserted patents, and licenses. Maxell has also represented that these documents are not within its possession, custody, or control. Apple therefore desires to obtain from Hitachi all documents in its possession, custody, or control related to the document requests enumerated in Attachment A.

III. EVIDENCE

The documents to be produced are identified in Attachment A.

IV. PROTECTIVE ORDER

In this matter, a Protective Order has been entered that governs the production of documents, testimony and any record of the testimony. A copy of this order is attached hereto as Attachment B. Because this action involves confidential and propriety business information, the Protective Order serves to protect such information from public disclosure. Accordingly, the United States District Court for the Eastern District of Texas requests that any document obtained in response to this Letter of Request be treated in accordance with the provisions of the Protective Order to protect confidential and propriety information.

For the protection of the privacy of information in this case in Japan, this court requests the Japanese Judge to issue a corresponding order to provide similar confidentiality protection in Japan of the testimony and any other documents, transcripts, etc. produced and/or recorded in response to this request.

V. RECIPROCITY

The United States District Court for Eastern District of Texas is willing and able to provide similar assistance to the judicial authorities of Japan, should a similar Request for International Assistance be received from those authorities.

VI. REIMBURSEMENT FOR COSTS

Should there be any costs associated with the service herein, it will be the responsibility of the attorneys for Apple to reimburse the appropriate Judicial Authority in Japan concerning the same. Costs in the amount of \$750.00 U.S. are hereby authorized and authorization for greater expenses should be requested directly. Please direct any correspondence or communications concerning costs to:

Luann Simmons
O'Melveny and Myers LLP
Two Embarcadero Center, 28th Floor
San Francisco, CA 94111
Telephone: 415-984-8700
Facsimile: 415-984-8701
Email: lsimmons@omm.com

Date: _____

(SEAL OF COURT)

The Honorable Robert W. Schroeder III
UNITED STATES DISTRICT JUDGE
EASTERN DISTRICT OF TEXAS
500 North State Line Avenue
Texarkana, TX 75501

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.