

Appendix A: Maxell’s Response to Apple’s Appendix 1 (Dkt. No. 161-20)

Page No. (D.I. 136)	Maxell’s Characterization	Apple’s Expert	Maxell’s
3, 5	<p><i>“Both parties’ experts agree that the term connotes sufficient structure to a person of ordinary skill¹ in the art in the form of one or more known hardware and/or software solutions.”</i> (citing to Menasce Decl. at ¶ 63)</p> <p>“In fact, both parties’ experts were able to identify a number of software and hardware solutions for implementing the capacity detector, <i>confirming that the term itself conveys ‘a variety of structures’</i> to persons skilled in the art.”</p>	<p>Menasce Decl. (Simmons Decl., Ex. A) at ¶ 63:</p> <p>And even if the “capacity detector” is limited to those devices that perform the function of “detecting a remaining battery capacity of [a] battery,” <i>this does not sufficiently describe a structure for such devices</i>. This is because there can be many different classes of structures that could perform the function of “detecting a remaining capacity of [a] battery.” <u>For example, this function could be performed by a software that implements an algorithm that determines the remaining capacity of a battery. This function could be performed by a specialized hardware component specifically built for the purposes of determining the remaining capacity of a battery. This function could be performed by an analog circuit designed to output a signal that corresponds to the remaining capacity of a battery. This function could also be performed by a digital circuit that turns on or off based on the remaining capacity of a battery. This function could be performed by any combination of the hardware or software devices that are listed above. Therefore, a person of ordinary skill in the art around the filing of the ’794 patent would not have known what structure is intended for a</u></p>	<p>As the underlined expert (Dr. Menasce) testified, there are four structures of capacity detectors that a POSITA would know that a “capacity detector” has sufficient structure and also that there is evidence that a person of ordinary skill would know the plain meaning of this term. Menasce’s conclusions support his opinions (unlike Maxell’s) and support Maxell’s</p>

¹Bold and italics were included in the original by Apple. Underlining has been added by Maxell.

Page No. (D.I. 136)	Maxell's Characterization	Apple's Expert	Maxell's
	(citing to Menasce Decl. at ¶ 63)	<i>“capacity detector” recited in the '794 patent, claims 1 and 9.</i>	
5	<p>“Another of Apple’s experts in this case even conceded that ‘battery capacity detector’ has a ‘much more’ <i>specific structure</i> than the claim term ‘device.’” (citing to Paradiso Dep. Tr. at 48:24- 49:1)</p>	<p>Paradiso Dep. Tr. (Simmons Decl., Ex. L) at 47:21-48:5, 48:20-49:9 (objections omitted):</p> <p>Q. What do you mean by the fact that these terms do not connote any specific structure? A. A device can be anything. It can be an abacus, it can be a palmtop computer or phone. It’s a very generic term, so it’s very open. And in a patent, when you interpret a patent, you need to define what the device is, what you mean by “device.” And this is something that PTAB agreed with, also you guys agreed with in the former IPR</p> <p>...</p> <p>Q. Would a term like, for example, “GPS” provide sufficient structure? A. “GPS receiver” would.</p> <p>Q. <u>Would you -- something like a “battery capacity detector” provide sufficient structure?</u> A. <i>For a device, and not in this context.</i> You’re talking about a totally different patent, perhaps.</p> <p>Q. Different context, yeah. A. <i>I think it depends. There are so many ways of doing a battery capacity detector, <u>but that is much more specific than “device,” I’ll give you that.</u></i></p>	<p>As the underlined expert (Dr. Paradiso) says, “battery capacity detector” is “much more specific than device.” He even says “I’ll give you that.”</p> <p>Maxell’s has cited Dr. Paradiso stating that a battery capacity detector is “much more specific than device.”</p>

Page No. (D.I. 136)	Maxell's Characterization	Apple's Expert	Maxell's
7	<p>“Apple’s expert justifies this by arguing that the sound generator could be confused with ‘electric generators, engine generators, gas generators, motor generators, signal generators,’ or even a ‘cow bell.’” (citing to Bederson Decl. at ¶ 32)</p>	<p>Bederson Decl. (Simmons Decl., Ex. B) at ¶¶ 32-33:</p> <p>At the outset, I note that one of ordinary skill in the art would not understand the term “generator” to denote sufficiently definite structure. Instead, the “generator” term <u>would be understood as anything that performs the function of generating.</u> <i>Indeed, in different contexts, the word “generator” can be used to refer to entirely different classes of structures. Some examples include <u>electric generators, engine generators, gas generators, motor generators, signal generators, and many others.</u></i></p> <p>Further, one of ordinary skill in the art would not understand the term “ringing sound generator” to convey any definite structure or device. Although the term does not use the “means for...” formulation, the term “ringing sound generator” is merely a descriptive term that repeats its intended function, <i>i.e.</i>, to generate a ringing sound. <i>Thus, one of ordinary skill in the art would understand that a “ringing sound generator” could be anything that generates a ringing sound.</i> For example, <u>a person ringing a cow bell could be a “ringing sound generator.”</u></p>	<p>As the underlined expert (Dr. Bederson) explains, this term “would include anything that performs the function of generating . . .” This includes electric generators, gas generators, motor generators, signal generators, and many others. Dr. Bederson further opined that a cow bell could be a ringing sound generator.”</p> <p>Maxell’s has quoted these examples verbatim.</p>
10-11	<p>Even Apple’s own expert opines that a person of ordinary skill in the art would</p>	<p>Menasce Decl. (Simmons Decl., Ex. A) at ¶ 79:</p> <p>The term “input unit” is not a term of art used in the field relevant to the ’438 patent. <i>There is no</i></p>	<p>As the underlined expert (Dr. Menasce) explains, he is aware of the term “input unit” in the art.</p>

Page No. (D.I. 136)	Maxell's Characterization	Apple's Expert	Maxell's
	<p>understand that <i>“input unit” corresponds to known structures</i> such as a “mouse, keyboard, touch screen, touch-pen, [and] voice-activated inputs. (citing to Menasce Decl. at ¶ 79 and Menasce Dep. Tr. at 85:12-18 and 86:13-15)</p>	<p><i>commonly understood structure for an “input unit.” This is because many different classes of structure can act as an “input unit.”</i> For example, “input unit” could refer to a wide variety of structures implemented by many possible hardware/software alternatives (e.g., <u>mouse, keyboard, touch screen, touch-pen, voice-activated inputs</u>). Some of these input mechanisms are more appropriate for some applications as compared to others. For example, touch-pen is more appropriate for inputting handwritten text, drawings, and voice-activated inputs may be more appropriate for people with some types of disabilities. <i>Therefore, a person of ordinary skill in the art around the filing of the ’438 patent would not have known what structure is intended for an “input unit for receiving an input entered by a user.”</i></p> <p>Menasce Dep. Tr. (Simmons Decl., Ex. J) at 84:24-85:18 and 86:13-16: (objections omitted):</p> <p>Q. And a person of ordinary skill in the art would understand the touch screen is <i>a type of input</i>; right?</p> <p>...</p> <p>A. Well, it’s -- at the time we had -- a person of ordinary skill in the art at that time would probably not have touch screens. Touch screens, I believe, were not that prevalent at the time of</p>	<p>keyboard, touch [and] voice-acti</p> <p>During his depo even confirmed would recognize mouse, and voice example of an i</p> <p>These examples that a POSITA understood “inp known structure evidence that a know the plain meaning of this</p>

Page No. (D.I. 136)	Maxell's Characterization	Apple's Expert	Maxell
		<p>the '438 patent. So, if you told that person that touch screen is an <u>input device</u>, they may not have understood that properly.</p> <p>Q. Right. What about a keyboard?</p> <p>A. <u>Keyboard, that's an example.</u></p> <p>Q. What about a mouse?</p> <p>A. <u>That's another example –</u></p> <p>Q. Voice recognition?</p> <p>A. -- of an input device.</p> <p>...</p> <p>Q. Did you have to do any special research to come up with these examples of input units?</p> <p>A. No. These are examples that I know about based on my experience.</p>	
13	<p>“Likewise, Apple attempts to limit the claimed “comment” to “written content” only. <i>But even Apple's expert admits that lay persons would understand the meaning of ‘comment’ and that a comment as it is generally understood would not be limited just to written content.</i>”</p>	<p>Menasce Dep. Tr. (Simmons Decl., Ex. J) at 98:3-10, 99:22-100:2, 102:10-22 (objections omitted):</p> <p>Q. The way you're interpreting comment, is that sort of the lay person's understanding of comment, like any person on the street would understand the term?</p> <p>A. As I said before, comment is not a term of art. <i>So it depends on the context. You have to qualify what you mean by comment.</i></p> <p>...</p> <p>Q. Is that context narrower than how a lay person would understand the word comment?</p>	<p>As the underlini Menasce did tes that a lay person necessarily unde be limited to wr that a lay person sorts of answers comment is bec would understand</p>

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.