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

[redacted]

APPLE INC.'S RESPONSE TO MAXELL, LTD.'S MOTION FOR EXTENSION OF TIME TO SUPPLEMENT INFRINGEMENT CONTENTIONS PURSUANT TO P.R. 3-1(G)

Outside of simply producing all source code in the entire company for each of the accused products and for every accused operating system version Apple has released for those products over the last six years, which is plainly not required, there was no way for Apple to ever satisfy Maxell's goalpost-moving approach to source code discovery in this case. This approach has allowed Maxell to successfully delay its compliance with Patent Rule 3-1(g) by six months from its September 13, 2019 deadline to amend under Patent Rule 3-1(g). *See* D.I. 46 at 8. Now faced with an order requiring them to finally produce compliant source code contentions, which also specifically contemplates that Apple is continuing to produce source code to satisfy Maxell's serial requests for source code, Maxell is trying to delay its compliance even further. Fact discovery closes at the end of this month, depositions of Apple's technical witnesses are underway, and Maxell has still not told Apple in which, of the [redacted] source code files that Apple has produced in this case, there is source code that relates to more than 110 claim limitations that Maxell has conceded are source code-relevant limitations, in compliance with the Patent Rules. Prejudice to Apple's ability to prepare its defense is plain, and Maxell should not be excused from its Patent Rule 3-1(g) obligations or the Court's order any further.

According to Patent Rule 3-4, on August 14, 2019, Apple made available more than [redacted] source code files that were plainly sufficient to describe the features Maxell accused in its Patent Rule 3-1 disclosures. After Apple agreed to extend the time for Maxell to comply with Patent Rule 3-1(g), it finally served source code infringement contentions on October 15. But as this Court has now determined, Maxell's citations to "large number of undifferentiated source code files and folders" were not "sufficiently focused" and did not comply with its obligations under the Local Patent Rules. D.I. 204 at 5.

It remains Apple's position that the additional files Maxell has requested (and that Apple

has produced) following Apple's August 2019 production are not necessary to understand the relevant operation of the accused features, to comply with Patent Rule 3-1(g), or to prove any element of its case.[1] Nevertheless, Apple has worked diligently to produce all of the source code that Maxell has requested. On January 31, to avoid further disputes and to clarify the record, Apple sent Maxell a letter and chart detailing the status of all source code issues that Maxell had raised, and stated Apple's expectation that it has made, or will, make available all requested code by February 12. Ex. A, 1/31/20 Pensabene Ltr. & Exhibit. Apple then confirmed its satisfaction of the open items in a February 14 letter. Thus, it was Apple's understanding that, as of February 12, it had fully addressed all source code issues identified by Maxell in response to Apple's motion to compel, as well any others that had been raised since that time.

Rather than respond to Apple's letters, and before even inspecting what Apple had produced, Maxell ran to court and filed its February 14 motion to compel, which included 14 source code issues that it identified as allegedly having not been addressed. Because Maxell had not even inspected what Apple produced before filing its motion or had bothered to meet and confer with Apple, it is of no surprise that Maxell was largely mistaken in its motion. In fact, at least 9 of the 14 source code projects that Maxell identified in its motion had either already been produced or do not exist. Apple promptly addressed the remaining five projects, which Maxell first brought to Apple's attention in that motion to compel, in just a couple of days, just as Apple would have had Maxell simply picked up the phone or written to Apple to discuss them.

Maxell now seeks to delay supplementing its infringement contentions until March 23, roughly a week before the close of fact discovery, because just five projects of source code were

[1] Based on Maxell's argument that these files were all necessary, Apple expects that Maxell will cite to the specific relevant portions of these files in its infringement contentions.

missing from the [redacted] ***source code files*** Apple has produced in this case. But the Court's February 28 Order already clearly states how this issue is to be addressed:

> Maxell's deadline to serve revised infringement contentions pursuant to this Order is March 13, 2020. To the extent that Maxell demonstrates through its motion to compel that source code production is incomplete, Maxell may move for leave to supplement its contentions.

D.I. 204 at 5. The Court has, thus, already decided how Maxell is to handle any amendments necessitated by source code Apple produced after February 12. Consistent with that order, Maxell must serve supplemental contentions by March 13. And should Maxell desire to supplement its contentions after that, with source code from within any of the five projects Apple produced after February 12, Maxell may seek leave of court to do so. But as Apple told Maxell before it filed this motion, Apple will promptly consider such a request with the expectation that the issue should be capable of resolution with an unopposed motion. Maxell's piecemeal requests for additional code does not excuse its wholesale failure to provide compliant infringement contentions for all 10 asserted patents and the dozens of accused products based on the massive amount of source code Apple produced prior to February 12, the vast majority of which have no connection to five source code projects produced just a couple of days after February 12. Patent Rule 3-1(g) would be meaningless if a plaintiff could simply circumvent compliance by making serial demands for additional source code.

Maxell's remaining excuse is also meritless. Maxell did not serve Interrogatory No. 12—seeking information about source code project names and operating systems—until October 4, 2019, ***51 days after*** Apple made its source code available in this case, and ***3 weeks after*** the original deadline for Maxell's Patent Rule 3-1(g) supplemental infringement contentions. Regardless, Apple has responded to Interrogatory No. 12 and repeatedly supplemented that response on a rolling basis, including on December 12, January 31, February 6, March 3, and

most recently, March 5, in response to Maxell's continuing source code demands. Despite Apple's diligent supplementation, at no time has Maxell updated its infringement contentions to incorporate any of this information or the additional code it has demanded be produced in this litigation.

For these reasons, Apple respectfully asks that the Court deny Maxell's motion.

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