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 MOTION TO COMPEL COMPLETE RESPONSES TO INTERROGATORY NOS 6, 10, 12, 17, AND 19

TABLE OF AUTHORITIES

Page

According to Maxell, Apple should be forced to respond substantively and completely to Maxell's interrogatories, but the same type of response is not required of Maxell. Indeed, Maxell has not even deigned to provide the same level of response that it has demanded (and has convinced the Court to order) from Apple for the interrogatories that are the subject of this motion. Maxell's continued delay in meeting its basic written discovery obligations materially prejudices Apple's ability to defend itself in this case. Apple therefore requests that the Court order Maxell to provide complete responses within two weeks of this Court's decision.

I. ARGUMENT

A. Maxell's Has Not Responded (At All) To Interrogatory Nos. 6, 12, and 19

Interrogatory No. 6 asks Maxell to identify the portion(s) of the Asserted Patents that Maxell contends evidence that the written description and enablement requirements are met:

> For each claim limitation of the asserted claims of the Asserted Patents, explain and identify in chart or table format, by column and line number(s) (or by page and paragraph if the document does not include line numbers), the portion(s) of the Asserted Patents and any other documents or things that you contend evidence that each claim limitation meets each of the written description and enablement requirements of 35 U.S.C. § 112, Paragraph 1.

The information responsive to this interrogatory is unquestionably relevant as Apple has specifically alleged—in its Patent Rule 3-3 invalidity disclosures—that the asserted patents are invalid for lack of written description and lack of enablement under section 112. Yet, Maxell provides no response to this interrogatory. *Sol IP, LLC v. AT&T Mobility LLC*, No. 2:18-cv-00526-RWS-RSP, 2020 WL 60140, at *2 (E.D. Tex., Jan. 5, 2020) and *Finjan, Inc. v. ESET, LLC*, No. 17CV183 CAB (BGS), 2018 WL 4772124, at *5 (S.D. Cal. Oct. 3, 2018), *review denied*, No. 317CV00183CABBGS, 2018 WL 6075797 (S.D. Cal. Nov. 21, 2018) do not excuse Maxell's failure to answer for at least two reasons.

First, the patentee in *Sol IP* "provided citations to the pages and figures of those

applications" and included "ample information from which defendants can evaluate how the earlier applications support plaintiff's claimed priority dates." *Sol IP*, 2020 WL 60140, at *2. Maxell has provided no response whatsoever. Ex. A, 2/21/20 Maxell's Second Suppl. Response to Apple's First Set of Interrogatories at 23-24. Second, in both *Sol IP* and *Finjan* the courts found that the requested discovery had either already been provided or other discovery vehicles were available, including, for example, a deposition. *Finjan*, 2018 WL 6075797, at *3; *Sol IP*, 2020 WL 60140, at *2. [redacted] Because this information is only available to Apple by interrogatory, a substantive and complete response is warranted.

Interrogatory No. 12 asks Maxell to state the date that it—and its predecessor-in-interest Hitachi—first became aware that Apple was making, using, importing, offering for sale or selling each accused product and to identify the person(s) most knowledgeable of that awareness:

> For each Apple product you contend infringes any of the Asserted Patents, state the date that you first became aware that Apple was making, using, importing, offering for sale or selling each such product, describe how you obtained such awareness, and identify the person(s) most knowledgeable regarding such initial awareness.

But Maxell's response is limited to Maxell's knowledge, and doesn't include Hitachi's knowledge. Ex. A, 2/21/20 Maxell's Second Suppl. Response to Apple's First Set of Interrogatories at 40. What is more, Maxell's response as to its own knowledge states only when it became aware of Apple's alleged awareness of the patents.[1] Such a response "does not properly address when ***[the patentee]*** first became aware of ***the products***." *See FatPipe Networks India Ltd. v. XRoads Networks, Inc.*, No. 2:09-CV-186, 2010 WL 3064369, at *3 (D.

[1] [redacted]

Utah Aug. 3, 2010) (ordering patentee to identify specific dates and individuals who first discovered the products) (emphasis added). Maxell does not, and cannot, dispute that the interrogatory seeks relevant information, *e.g.*, acquiescence and exceptional case. *See, e.g., id.; UltimatePointer, L.L.C. v. Nintendo Co.*, No. 6:11-CV-496-LED, 2014 WL 12521379, at *3 (E.D. Tex. June 4, 2014) (ordering patentee to state the "specific dates" it first learned of each accused product). A substantive and complete response is warranted.

Interrogatory No. 19 asks Maxell to provide the bases for its contention that it has complied with 35 U.S.C. § 287, or to state its contention that compliance is not required:

> To the extent Maxell contends that Maxell has complied with 35 U.S.C. § 287 with respect to the Subject Products or that its compliance with 35 U.S.C. § 287 for the Subject Products was not required, state the complete factual and legal bases for such contention. . . .

[redacted] Ex. C, 2/24/20 Maxell's First Suppl. Response to Apple's Second Set of Interrogatories at 8. [redacted] And should Maxell fail to prove actual notice, Maxell may not seek pre-suit damages unless it proves compliance with section 287. *See Huawei Techs. Co. v. T-Mobile US, Inc.*, No. 216CV00052JRGRSP, 2017 WL 4183103, at *2 (E.D. Tex. Sept. 4, 2017), *report and recommendation adopted*, No. 216CV00052JRGRSP, 2017 WL 4251365 (E.D. Tex. Sept. 20, 2017). So long as the parties dispute actual notice, and so long as Maxell seeks pre-suit damages, Apple is entitled to a response on whether Maxell can prove that it has complied with section 287—the only way, outside of actual notice, that Maxell can obtain pre-suit damages. As Maxell must prove compliance with section 287 absent actual notice, Maxell stating simply that

DOCKET ALARM

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.