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

MAXELL, LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 5:19-cv-00036-RWS

JURY TRIAL DEMANDED

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**MAXELL, LTD.'S OPPOSITION TO APPLE INC.'S MOTION TO COMPEL
COMPLETE RESPONSES TO INTERROGATORY NOS. 6, 10, 12, 17, AND 19**

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Apple's motion is an attempt to show it is an aggrieved party, to distract the Court from Apple's own discovery misconduct. While Maxell has spent well over half a year pushing Apple for relevant discovery regarding the design and operation of the accused products and functionalities, Apple has demanded discovery that is plainly outside the scope of the case, or very clearly outside Maxell's possession, custody and control, to deflect from the relevant discovery it has and continues to improperly withhold. Here, for example, Apple (1) demands that Maxell provide a basis for a position Maxell does not hold and is not asserting and (2) insists again that Maxell provide information that is Hitachi's and not Maxell's (or within Maxell's possession, custody or control). Finally, Apple requested Maxell provide all communications between Maxell and certain other entities, but then claims Maxell's production of these very communications is not responsive and now demands Maxell summarize these for Apple.

Apple's motion is a clear attempt to distract from its own discovery misconduct by lobbing accusations at Maxell. These allegations are unsupported by the record and should be rejected.

A. Maxell Has Appropriately Responded to Interrogatory Nos. 6, 12, and 19

Interrogatory No. 6 requests that Maxell provide, "for each claim limitation of the asserted claims," "in chart or table format," support for the contention that each claim limitation meets the written description and enablement requirements of 35 U.S.C. § 112, ¶ 1. The request relates to every claim limitation of every asserted claim. But the Asserted Patents are presumed valid, and Apple has not alleged lack of enablement or written description for each asserted limitation. *See* Ex. A (Excerpts of Apple Invalidity Contentions). Apple's demand that Maxell provide support for claim limitations that even Apple has not challenged improperly seeks to shift the burden to Maxell to demonstrate validity and is overly broad, unduly burdensome, and not proportional to the needs of the case. Maxell should not have to defend against claims that have not been put at issue.

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Courts facing similar interrogatories have not required responses. One such court held:

Although this interrogatory is framed in terms of claim-by-claim priority dates, the request for mapping claim elements to particular portions of specifications, albeit to justify the associated priority dates, seems to make it more like some sort of written description contentions. And, although the Court does not find parties are absolutely precluded from seeking discovery in a chart format..., the Court recognizes that demanding this level of specificity in a claim chart, particularly the mapping it demands, is a significant burden. It ... is the type of “scorched earth,” “no stone unturned” (potentially numerous times) approach to discovery the changes to Rule 26 were intended to curb. Given the other avenues for discovering this information already provided and the burden imposed in responding to it, the Court finds no further response to the interrogatory is required.

Finjan, Inc. v. ESET, LLC, No. 3:17-cv-00183-CAB-BGS, 2018 WL 4772124, at *5 (S.D. Cal. Oct. 3, 2018), adopted by, No. 3:17-CV-00183-CAB-BGS, 2018 WL 6075797 (S.D. Cal. Nov. 21, 2018)). Building off such rationale, and relying on the fact that the defendants did not limit their interrogatory to the claims for which they asserted § 112 support to be lacking, this Court has similarly held that such element-by-element mapping is not proportional to the needs of the case. *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). Noteworthy, both of these cases dealt with the establishment of priority dates, not the broader blanket validity analysis Apple is pushing here.¹

Interrogatory No. 12 asks that Maxell state the date that it first became aware of Apple’s manufacture, use, or sale each accused product. Although Apple’s heading asserts “Maxell Has Not Responded (At All) To” Interrogatory No. 12, even the body of Apple’s motion demonstrates that to be untrue. Maxell **has** responded as to Maxell’s first awareness: “Maxell became aware of [Apple’s infringement] when it took over the negotiations with Defendant and continued its investigation thereafter, resulting in the filing of the Complaint for this litigation Maxell

¹ Apple complains that Maxell’s fact witnesses do not have information responsive to this interrogatory, but Maxell made inventors available for deposition, who could have been questioned on these topics. Experts will also be available to address the issue to the extent raised by Apple in its expert reports.

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further incorporates herein by reference its response, including any supplements or amendments thereto, to Defendant's Interrogatory No. 1." D.I. 224 at Ex. A ("Page 40"). Apple's complaint is not that Maxell has not responded, but rather that Maxell has not identified when **Hitachi** became aware of the accused products. But, outside of the information regarding the first licensing meeting in June 2013 that was transferred to Maxell from Hitachi Consumer Electronics (HCE) and Maxell's subsequent actions (all of which was detailed in Maxell's response to Interrogatory No. 1, incorporated by reference), Maxell is not in possession, custody, or control of information related to Hitachi's investigation and knowledge. This issue was already addressed by the Court in its denial of Apple's prior motion to compel. D.I. 202.

Interrogatory No. 19 states "To the extent Maxell contends that Maxell has complied with 35 U.S.C. § 287 with respect to [Practicing/Licensed Products] or that its compliance with 35 U.S.C. § 287 for the [Practicing/Licensed Products] was not required, state the complete factual and legal bases for such contention." Importantly, this interrogatory covers only constructive notice through marking and Maxell very clearly responded that it is not relying on constructive notice under 35 U.S.C. § 287 in this litigation:

Maxell is not relying on compliance with the marking of its products or its licensees' products to satisfy 35 U.S.C. § 287 for purposes of notice in this litigation. As noted in responses to other interrogatories and in its Complaint, Maxell has relied on the notice provision of 35 U.S.C. § 287.

D.I. 224. at Ex. C ("Page 8"). Maxell also clarified this in correspondence and during a meet and confer. *See, e.g.*, Ex. B, 2/19/20 Ltr. Beaber to Pensabene ("Given Maxell's position that it is not 'contending' that it complied with the marking requirement or that compliance was not required for purposes of notice in this litigation, no further information in response was required."). Maxell should not be forced to address how it can prove constructive notice when it has committed not to rely on constructive notice. As it states in its response, Maxell has relied on the actual notice

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