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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 OPPOSED MOTION TO STRIKE PORTIONS OF
DEFENDANT APPLE INC.'S OPENING EXPERT REPORTS BASED
ON UNDISCLOSED OR UNELECTED INVALIDITY THEORIES**

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TABLE OF ABBREVIATIONS

Abbreviation	Description
Maxell	Plaintiff Maxell, Ltd.
Apple	Defendant Apple Inc.
POSITA/PHOSITA	Person of Ordinary Skill in the Art
Bederson Rpt.	Opening Expert Report of Dr. Benjamin B. Bederson Regarding Invalidity of U.S. Patent Nos. 6,928,306 and 10,084,991 (Relevant Excerpts at Ex. 1)
Bims Rpt.	Opening Expert Report of Dr. Harry V. Bims Regarding Invalidity of U.S. Patent No. 6,408,193 (Relevant Excerpts at Ex. 2)
Bovik Rpt.	Opening Expert Report of Dr. Alan C. Bovik Regarding Invalidity of U.S. Patent No. 8,339,493 (Relevant Excerpts at Ex. 3)
Menascé '438/'586 Rpt.	Opening Expert Report of Dr. Daniel A. Menascé Regarding U.S. Patent Nos. 7,116,438 and 10,212,586 (Relevant Excerpts at Ex. 4)
Paradiso Rpt.	Opening Expert Report of Dr. Joseph A. Paradiso Regarding Invalidity of U.S. Patent Nos. 6,748,317, 6,580,999, 6,430,498 (Relevant Excerpts at Ex. 5)
Menascé '794 Rpt.	Opening Expert Report of Dr. Daniel A. Menascé Regarding U.S. Patent No. 6,329,794 (Relevant Excerpts at Ex. 6)
Final Election	Apple's Final Election of Prior Art served April 7, 2020 (Ex. 7)
Invalidity Contentions	Defendant Apple Inc.'s Invalidity Contentions Pursuant to Patent Local Rules 3-3 and 3-4 served August 14, 2019 and Defendant Apple Inc.'s First Supplemental Invalidity Contentions Pursuant to Patent Local Rules 3-3 and 3-4 served March 4, 2020 and exhibits thereto (Relevant Excerpts at Exs. 8-18)

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The Local Patent Rules require early disclosure of all prior art references, combinations of references, and motivations to combine, along with invalidity theories based on enablement or written description. This is in order to guide and narrow discovery in patent cases. To further narrow this case, the parties agreed to a Focusing Order (D.I. 44), requiring the parties to narrow the asserted claims and prior art before expert discovery. Though purporting to comply with this Order, Apple's invalidity reports contain many opinions that exceed the scope Apple's Invalidity Contentions or Final Election of Asserted Prior Art. Having failed to timely disclose and elect these positions, Apple should not be permitted to circumvent the rules and rely on them now. Thus, the Court should exclude any expert testimony relating to the previously undisclosed or unelected invalidity positions and preclude Apple from relying on such positions at trial. In addition, the deadline for rebuttal validity reports (June 4¹) will occur before briefing on this Motion is complete. As such, should the Court grant Maxell's Motion, Maxell also requests the Court award Maxell its attorneys' fees and costs for the prejudice it has suffered in addressing Apple's untimely theories.

I. STATEMENT OF FACTS

Local Patent Rule ("P.R.") 3-3 requires timely disclosure of all prior art references and combinations of references alleged to render an asserted claim invalid as well as invalidity theories based on enablement or written description. For each disclosed combination of references, P.R. 3-3 further requires timely disclosure of the alleged motivation to combine such references. On the date set forth by the Docket Control Order (D.I. 46) for such disclosures (August 14, 2019), Apple served its Invalidity Contentions. Such contentions were supplemented once, with leave of Court, on March 4, 2020. (Collectively, "Invalidity Contentions").

¹ Pursuant to this Court's May 8, 2020 Order (D.I. 325), rebuttal expert reports regarding the '794 Patent are due June 11, 2020.

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