

EXHIBIT 8

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

MAXELL, LTD.,

Plaintiff,

vs.

APPLE INC.,

Defendant.

Civil Action No. 5:19-cv-00036-RWS

JURY TRIAL DEMANDED

DEFENDANT APPLE INC.'S FIRST SUPPLEMENTAL INVALIDITY CONTENTIONS
PURSUANT TO PATENT LOCAL RULES 3-3 AND 3-4

I. INTRODUCTION

Pursuant to the Court's Docket Control Order entered July 9, 2019 (D.I. 46) and Patent Local Rules 3-3 and 3-4, Defendant Apple Inc. ("Apple") provided its preliminary invalidity contentions to Maxell, Ltd. ("Maxell") for the asserted claims of U.S. Patent Nos. 6,748,317 ("the '317 patent"); 6,580,999 ("the '999 patent"); 8,339,493 ("the '493 patent"); 7,116,438 ("the '438 patent"); 6,408,193 ("the '193 patent"); 10,084,991 ("the '991 patent"); 6,928,306 ("the '306 patent"); 6,329,794 ("the '794 patent"); 10,212,586 ("the '586 patent"); 6,430,498 ("the '498 patent") (collectively, the "Asserted Patents") on August 14, 2019. Pursuant to the Court's February 24, 2020 Order Granting Apple's Motion for Leave to Amend Invalidity Contentions (D.I. 201), Apple provides these supplemental invalidity contentions ("First Supplemental Invalidity Contentions"), which are subject to Apple's Preliminary Election Of Prior Art, served on November 18, 2019.

Based on Maxell's First Supplemental Disclosure of Asserted Claims and Infringement Contentions ("Supplemental Infringement Contentions") served on October 15, 2019, Maxell is asserting claims 1-3, 5-15, 17, and 18 of the '317 patent; claims 1-6 of the '999 patent; claims 1, 3-6, 10, and 11 of the '493 patent; claims 1-7 of the '438 patent; claims 1, 6, and 7 of the '193 patent; claims 1-5 and 8-12 of the '991 patent; claims 2, 5, 6, and 12-15 of the '306 patent; claims 1-3 and 5-14 of the '794 patent; claims 1-2, 6-7, 9-10, 13-14, and 16-18 of the '586 patent; and claims 1, 3-5, 7-11, and 13 of the '498 patent (collectively, "the Asserted Claims"), which are subject to Maxell's Preliminary Election of Asserted Claims, served on November 6, 2019. Apple addresses the invalidity of the Asserted Claims in these First Supplemental Invalidity Contentions, and concludes with a description of its document production and identification of additional reservations and explanations.

These First Supplemental Invalidity Contentions are based on the claim constructions or

contain a written description of the invention” 35 U.S.C. § 112, ¶ 1. “To satisfy the written description requirement, a patent applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *ICU Medical, Inc. v. Alaris Medical Systems, Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009) (internal quotation marks and citations omitted); *see also Synthes USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1340 (Fed. Cir. 2013). “The test [for written description support] requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

The specification must describe the claimed invention in sufficient detail so that a PHOSITA can recognize what is claimed. “The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement.” *University of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 923 (Fed. Cir. 2004) (internal quotation marks and citations omitted).

The identified grounds noted below both individually and collectively render the Asserted Claims of the ’317, ’999, and ’498 patents invalid under the statutory requirements of § 112.

2. Indefiniteness Under 35 U.S.C. § 112, ¶ 2

The Asserted Claims of the ’317, ’999, and ’498 patents fail to satisfy the requirements of § 112, ¶ 2 because the scope of the following terms cannot be determined with reasonable certainty by a PHOSITA when reading the claims in light of the specification and prosecution history.

“said direction” (’317 patent, claims 1 and 10)

“said device connected to said server outputting said location information and said

direction information and receiving retrieved information based on said outputted information at said server” (’317 patent, claim 5)

“said information is stores or roads information” (’317, claim 7)

“said destination” (’317 patent, claims 10 and 18; ’498 patent, claim 10)

“said location of another portable terminal” (’317 patent, claims 11-14)

“said walking navigation information” (’498 patent, claims 1, 5, 8, and 10; ’999 patent, claims 1, 5-6)

3. Lack Of Enablement Under 35 U.S.C. § 112, ¶ 1

The Asserted Claims of the ’317, ’999, and ’498 patents fail to satisfy the requirements of § 112, ¶ 1 because the specification fails to provide an enabling disclosure for the following terms:

“said device connected to said server outputting said location information and said direction information and receiving retrieved information based on said outputted information at said server” (’317 patent, claim 5)

4. Lack Of Written Description Under 35 U.S.C. § 112, ¶ 1

The Asserted Claims of the ’317, ’999, and ’498 patents fail to satisfy the requirements of § 112, ¶ 1 because the specification fails to provide an adequate written description of the following terms:

“said device connected to said server outputting said location information and said direction information and receiving retrieved information based on said outputted information at said server” (’317 patent, claim 5)

E. Invalidity Under 35 U.S.C. § 101

To be valid under § 101, a claim must be directed to one of four eligible subject matter categories: “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C.

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