

EXHIBIT 23

**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**

- “display calling message” (Claim 5).

4. Improper Dependent Claims Under 35 U.S.C. § 112, ¶ 4

The Asserted Claims of the '991 patent fail to satisfy the requirements of § 112, ¶ 4 because the following claims represent improper dependent form:

- “The communication apparatus according to claim 3, wherein when the processor receives the inbound videophone call notice while displaying the first digital information on the display, the processor switches a function of processing video information of the first digital information to a function of processing video information of the second digital information of the videophone call” (Claim 4);
- “The method according to claim 10, further comprising the step of: upon receiving the inbound videophone call notice while displaying the first digital information, switching a function of processing video information of the first digital information to a function of processing video information of the second digital information of the videophone call” (Claim 11).

E. Invalidity Under 35 U.S.C. § 101

The Asserted Claims of the '991 patent are invalid under § 101 because they are directed to the ineligible abstract idea of pausing one task to complete another, and claim implementations of this abstract idea using only conventional technology, as shown by the prior art identified above. The claims thus fail to disclose an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible invention. Instead, the claim recites performing the abstract idea using broad functional language at a high level of generality without providing any specificity.

VII. '306 PATENT

The '306 patent was filed with the United States Patent and Trademark Office on January 4, 2001. In its Infringement Contentions, Maxell claims a priority date of January 7, 2000. Apple

reserves the right to serve additional or modified invalidity contentions should Maxell be permitted to amend or modify its claimed priority date.

A. Prior Art

Apple identifies the following prior art now known to Apple to anticipate and/or render obvious one or more claims of the '306 patent under at least 35 U.S.C. §§ 102(a), (b), (e), (g), and/or 103.

1. Prior Art Patents and Publications

The following patents and publications are prior art for Asserted Claims of the '306 patent under at least 35 U.S.C. §§ 102(a), (b), (e), and/or (g). Invalidity claim charts for these references are attached as Exhibits F1 through F6.

1. U.S. Patent No. 6,122,347 (“Borland ’347”), filed on November 13, 1997, and issued on September 19, 2000 to David J. Borland.
2. U.S. Patent No. 6,216,017 (“Lee ’017”), filed on August 13, 1998, and issued on April 10, 2001 to Ki-Tae Lee et al.
3. U.S. Patent No. 4,330,780 (“Masaki ’780”), filed on January 3, 1980, and issued on May 18, 1982 to Masaru Masaki.
4. International Patent Publication No. WO 1996/027974 (“Van der Salm ’974”), filed on March 8, 1996 by Peter Van der Salm et al., and published on September 12, 1996.
5. U.S. Patent No. 5,007,076 (“Blakley ’076”), filed on November 3, 1989, and issued on April 9, 1991 to James R. Blakley.
6. U.S. Patent No. 4,894,649 (“Davis ’649”), filed on January 7, 1988, and issued on January 16, 1990 to Walter L. Davis.
7. U.S. Patent No. 6,373,925 (“Guercio ’925”), filed on September 24, 1997, and issued on April 16, 2002 to David J. Guercio et al.
8. UK Patent Application No. GB 2323245 (“Hastrup ’245”), filed on March 14, 1997 by Jan Hastrup et al., and published on September 16, 1998.
9. CN Patent No. 1190303A (“Huang ’303”), filed on December 19, 1997 by Bazhong Huang, and published on August 12, 1998.

10. U.S. Patent No. 5,646,979 (“Knuth ’979”), filed on December 20, 1995, and issued on July 8, 1997 to Stephen B. Knuth.
11. U.S. Patent No. 5,526,406 (“Luneau ’406”), filed on September 9, 1994, and issued on June 11, 1996 to David J. Luneau.
12. U.S. Patent No. 3,686,635 (“Millington ’635”), filed on June 9, 1971, and issued on August 22, 1972 to Raymond J. Millington et al.
13. U.S. Patent No. 6,763,105 (“Miura ’105”), filed on November 13, 1998, and issued on July 13, 2004 to Nazomi Miura et al.
14. *Motorola Telecommunications Device Data* by Motorola Inc. (“MC3417/18 Datasheet”). Based on information available to Apple, Apple believes that this reference was published in the U.S. by Motorola Inc. in 1984.
15. U.S. Patent No. 6,328,570 (“Ng ’570”), filed on June 10, 1998, and issued on December 11, 2001 to Kai Kong Ng.
16. European Patent Application Publication No. EP 0848533 (“Peters ’533”), filed on December 2, 1997 by Daniel V. Peters, and published on June 17, 1998.
17. U.S. Patent No. 4,924,499 (“Serby ’499”), filed on February 25, 1988, and issued on May 8, 1990 to Victor M. Serby.
18. International Patent Publication No. WO 1996/002999 (“Sremac ’999”), filed on July 19, 1995 by Steve Sremac, and published on February 1, 1996.

Apple’s investigation into prior art patent and publication references remains ongoing and Apple reserves the right to identify and rely on additional patent or publication references that describe or are otherwise related to the prior art systems identified below based on information obtained through discovery.

2. Prior Art Systems

The following systems are anticipatory prior art for the Asserted Claims of the ’306 patent under at least 35 U.S.C. §§ 102(a), (b) and/or (g):

1. Products, components, systems, and methods invented, designed, developed, reduced to practice, and/or in public use or on sale related to CIDney Voice Announce Systems (“CIDney Voice Announce Systems”), as exemplified in claim charts in Exhibit F5. As part of these Invalidity Contentions, Apple has produced documents relating to CIDney Voice Announce Systems. Based on information available to Apple, Apple believes that this system was in public use and/or on sale

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