

**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

**APPLE INC.'S SUR-REPLY IN OPPOSITION TO MAXELL'S MOTION TO STRIKE
PORTIONS OF DEFENDANT APPLE'S INVALIDITY EXPERT REPORTS**

I. INTRODUCTION

Apple's Opposition demonstrated, in detailed side-by-side comparisons, that each alleged "new" theory identified by Maxell had in fact been disclosed in Apple's contentions. Chastened by Apple's clear showing, Maxell resorts to mischaracterizing Apple's contentions and the patent claims, and feigning an inability to understand Apple's contentions. But Maxell has not shown any violation of any rules. Simply put, there is nothing to strike.

II. ARGUMENT

Maxell does not even address, let alone rebut Apple's response to, more than twenty of the complaints in its original Motion. *Compare* Motion at 5–6 with Reply at 2–3. Apple, therefore, understands that Maxell has withdrawn those complaints, or has no substantive response to Apple's clear showing. Maxell's motion should be denied as to all such complaints.

The few remaining complaints that Maxell continues to press in its Reply are equally without merit and should also be denied. Apple responds to each of these below.

A. Apple's Reports Do Not Contain New Written Description Theories

Dr. Bims's Report – Contrary to Maxell's mischaracterization, Dr. Bims did **not** opine that the claims are invalid for lack of written description; he opined that, for purposes of his § 103 analysis, he would not adopt Maxell's new, and impermissible, claim construction. He explained that he disagreed with Maxell's new claim interpretation because it lacked support in the specification. Ex. 2 at ¶173 (explaining that, "if the receiver is required to output a signal that controls the gain of the variable amplitude amplifier or the bias of the power amplifier," **then** the claim would lack written description). Further, as Dr. Bims explicitly states in his report (*id.* at ¶167), his opinions on this issue were in direct response to new claim construction arguments presented **by Maxell** for the first time in a Patent Owner Preliminary Response ("POPR") that Maxell filed in a related IPR in April 2020, four months after the parties filed

their claim construction briefs and only four weeks before expert reports were due. *Id.* (“In [Maxell’s POPR], Maxell appears to argue that the ‘receiver’ must be the component that outputs the signal.”). Tellingly, Maxell asks the Court to strike paragraphs 168–173 without even mentioning paragraph 167. Motion at 4.

PerdiemCo v. Industrack LLC is instructive here. Case No. 2:15-cv-00727-JRG-RSP, Dkt. 256 at 4 (E.D. Tex. Oct. 24, 2016). In *PerdiemCo*, the defendant’s expert explained that he did not apply the plaintiff’s infringement expert’s claim interpretation in his non-infringement analysis because that interpretation would render the claim invalid. *Id.* The plaintiff argued that this was a late invalidity opinion because it used the word “invalid.” *Id.* The court saw through the semantics and held that this was a proper non-infringement opinion regarding why the expert disagreed with the infringement expert’s analysis. *Id.* Similarly, Dr. Bims’s explanation for rejecting Maxell’s claim interpretation for his § 103 analysis is proper and should not be struck.

Dr. Menascé Report – Maxell’s entire argument is premised on the notion that “[t]he individual steps and the overall flow are separate considerations.” Reply at 2. This is incorrect. As explained in Apple’s opposition, the “flow” of these claims is recited as an integral part of the individual steps, which Maxell does not dispute were addressed in Apple’s contentions. Opp. at (citing Ex. 8 at 127–128 (addressing the “flow” of claim elements, such as “**when** conditions are met,” “wherein the conditions ... **after** the mobile terminal is in the locked state,” and “wherein conditions include ... **after** the performing, receiving, by the controller”)). Maxell has no response to this disclosure. Reply at 2. Instead, tacitly acknowledging this flaw in its argument, Maxell raises a new argument in Reply that Apple’s contentions did not challenge the sufficiency of the written description for each step within the flow. *Id.* This new argument is nonsensical. If two of three steps of a flow are not described in the patent, the entire flow was not described. Even if Maxell’s argument made sense logically, it is factually incorrect. Ex. 8 at 127–128.

B. Apple Disclosed Its Combinations And Motivations to Combine

In Reply, Maxell focuses on one motivation to combine. For the rest of its motivation to combine complaints, Maxell ignores the clear disclosures that Apple mapped in its Opposition and makes the bald contention that the motivations are still “new.” Opposition at 4–6. Maxell’s request to strike these other motivations should be denied as Maxell does not even attempt to support its position, and Apple’s objective evidence has proven Maxell’s complaints wrong.

For Dr. Bims’s opinion that a POSITA would be motivated by “[a]pplication of TDMA system to improve CDMA device,” Apple disclosed this motivation in its **Nakayama** chart and said “The known work of Nakayama in the field of TDMA transmission power control would prompt a variation thereof in the field of CDMA transmission power control.” Ex. 20 at 1, 11. Both Waldroup and Mucke are CDMA art. Ex. 10 at 2 (“The present invention relates ... to the field of output power control in code division multiple access (CDMA) wireless telephones”), Ex. 26 at 2 (“radiotelephones that are compatible with a code division, multiple access (CDMA) protocol.”). Further, the sentence that follows in the contentions makes clear that the opinions are not limited to any one CDMA prior art reference, but would apply to any CDMA reference, such as Mucke: “Additionally, such a receiver is a necessary part of **any CDMA telephone ...**” *Id.* at 11. It is thus irrelevant that the specific sentence Maxell points to uses Waldroup as an example. Apple’s contentions made clear this motivation would equally apply to Mucke.

C. Apple Disclosed Its Invalidity Grounds

Menascé re ’438 Patent – Maxell does not dispute that Apple disclosed and charted Yamazaki, or that the relevant disclosure of Yamazaki was charted for the limitations in question. Instead, Maxell complains that Dr. Menascé uses different words (“attachment” and “dialog”) to “characterize” elements of Yamazaki, which were indisputably disclosed in the contentions. Reply at 3; Ex. 15 at 33–34. There is no rule limiting expert reports to the

vocabulary that appeared in invalidity contentions. Maxell's complaint is baseless.

Bederson re '306 Patent – Maxell complains that Apple's contentions were insufficient because Apple did not chart a POSITA's knowledge with Borland. Reply at 3. First, there is no requirement to chart a POSITA's knowledge. *Elbit Sys. Land & C4I Ltd. v. Hughes Network Sys., LLC*, No. 2:15-cv-00037-RWS-RSP, at *2 (E.D. Tex. July 4, 2017). Second, if there was uncertainty (there wasn't), Maxell should have sought clarity during discovery rather than waiting to strike Apple's reports after the fact. *See Fenner Invs., Ltd. v. Hewlett-Packard Co.*, No. 6:08-cv-273, 2010 WL 786606, at *3 (E. D. Tex. Feb. 26, 2010) (“If Defendants were unclear as to the scope of the contentions, it was their responsibility to work with Plaintiff, informally or through motion practice, to clarify the issue.”).

Apple charted combinations – Maxell seeks to rewrite this District's rules in two ways. First, Maxell counts the **same** prior art combination as two separate combinations if asserted against two limitations of the **same claim** of the **same patent**. Reply at 4. This is simply not the rule, and Maxell cites no support for this incredible, novel theory. Second, Maxell argues that a defendant must identify in invalidity contentions which reference of a disclosed combination supplies each limitation of the asserted claim. *Id.* This, too, is not the law. *Elbit Sys. Land & C4I Ltd. v. Hughes Network Sys., LLC*, No. 2:15-CV-37-RWS-RSP, 2016 WL 9307563, at *3 (E.D. Tex. Sept. 27, 2016) (invalidity contentions “need not identify which reference supplies which limitation in the combination,” it is sufficient to chart each reference individually).

It is undisputed that Apple charted **each** reference to **each** limitation as required by P.R. 3-3(c), and disclosed the combinations of these references as required by P.R. 3-3(b). The fact that Apple went beyond the requirements of the local rules and provided extra details in some charts for some limitations does not somehow eviscerate this undeniable compliance.

Bovik re '493 Patent – Maxell's Motion complained that Apple did not disclose “Sony

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