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-0036-RWS **JURY TRIAL DEMANDED**

ORDER FOCUSING PATENT CLAIMS AND PRIOR ART TO REDUCE COSTS

The Court ORDERS as follows:

1. This Order supplements all other discovery rules and orders. It streamlines the issues in this case to promote a "just, speedy, and inexpensive determination" of this action, as provided by Federal Rule of Civil Procedure 1.

Phased Limits on Asserted Claims and Prior Art References

2. By the date set in the Court's Docket Control Order governing the above captioned case, the patent claimant shall serve a Preliminary Election of Asserted Claims, which shall assert no more than ten (10) claims from each patent and not more than a total of [Apple proposes 25

claims[1]; Maxell proposes 60 claims[2]].[3] By the date set in the Court's Docket Control Order governing the above captioned case, the patent defendant shall serve a Preliminary Election of Asserted Prior Art, which shall assert no more than twelve (12) prior art references against each patent and not more than a total of [Apple proposes 31 references[4]; Maxell proposes 70 references[5]].[6]

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[1] The language highlighted in blue is proposed by Apple and disputed by Maxell. Apple proposes limits that are only slightly lower than in the Model Order to account for the fact that three of the 10 asserted patents are in a single family. Maxell, meanwhile, proposes *expanding* the case from 46 claims identified in the Complaint to 60 claims in its Preliminary Election—nearly double the limit of the Model Order. There is no justification for such a drastic departure, and Maxell cannot reasonably intend to try anywhere close to 32 claims (its proposed Final Election limit). Indeed, in Maxell's recent case against ZTE, Maxell asserted close to the same number of patents as here but went to trial with only 16 claims at trial and stipulated to partial dismissal of four claims from the '317 Patent (also asserted here) several months before trial. Maxell has shown that it can narrow its case and should do so here to allow the parties to efficiently and effectively present their claims and defenses to the jury.

[2] Language highlighted in green is proposed by Maxell and disputed by Apple. Because this case involves ten (10) patents (only three of which are in the same family) and covers a range of diverse technologies and accused products, Maxell believes that the circumstances in this case warrant expanding the limits as set forth in the Model Order. Maxell's proposal of 60 claims represents a substantial reduction considering the 132 total claims included in the asserted patents.

[3] Apple proposes including the following footnote: "For purposes of this Order, if the patent claimant asserts a dependent claim, the independent claim from which it depends shall also be counted against the total number of allowed claims, whether it is asserted or not." If Maxell asserts a dependent claim at trial, it must necessarily prove infringement of the corresponding independent claim, regardless of whether it is formally asserted; it is, therefore, fair and reasonable to count that independent claim against the limit. Maxell disputes the inclusion of this footnote, which is not present in the Court's Model Order, as it would unreasonably restrict the number of asserted claims available to Maxell.

[4] Apple proposes limits on prior art that are proportional to its proposed limits on asserted claims. Maxell does not dispute Apple's proposal, but believes it is appropriate to raise the limit on prior art references commensurate with the proposed raised limit on asserted claims.

[5] Language highlighted in green is proposed by Maxell and disputed by Apple.

[6] For purposes of this Order, a prior art instrumentality (such as a device or process) and associated references that describe that instrumentality shall count as one reference, as shall the closely related work of a single prior artist.

3. By the date set in the Court's Docket Control Order governing the above captioned case, the patent claimant shall serve a Final Election of Asserted Claims, which shall identify no more than five (5) asserted claims per patent from among the ten previously identified claims and no more than a total of [Apple proposes 10 claims[7]; Maxell proposes 32 claims[8]]. By the date set in the Court's Docket Control Order governing the above captioned case, the patent defendant shall serve a Final Election of Asserted Prior Art, which shall identify no more than six (6) asserted prior art references per patent from among the twelve prior art references previously identified for that particular patent and no more than a total of [Apple proposes 16 references[9]; Maxell proposes 32 references[10]]. For purposes of this Final Election of Asserted Prior Art, each obviousness combination counts as a separate prior art reference.

4. If the patent claimant asserts infringement of only one patent, all per-patent limits in this order are increased by 50%, rounding up.

Modification of this Order

5. Subject to Court approval, the parties may modify this Order by agreement, but should endeavor to limit the asserted claims and prior art references to the greatest extent possible. Absent agreement, post-entry motions to modify this Order's numerical limits on asserted claims

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[7] Language highlighted in blue is proposed by Apple and disputed by Maxell. Apple believes its proposed limits are appropriate for the reasons stated above.

[8] Language highlighted in green is proposed by Maxell and disputed by Apple. Maxell believes that the circumstances in this case as noted above warrant expanding the limits.

[9] Language highlighted in blue is proposed by Apple. Apple believes its proposed limits are appropriate for the reasons stated above. Maxell does not dispute Apple's proposal, but believes it is appropriate to raise the limit on prior art references commensurate with the proposed raised limit on asserted claims.

[10] Language highlighted in green is proposed by Maxell and disputed by Apple.

and prior art references must demonstrate good cause warranting the modification. Motions to modify other portions of this Order are committed to the sound discretion of the Court.[11]

IT IS SO ORDERED.

[11] This Order contemplates that the parties and the Court may further narrow the issues during pretrial proceedings in order to present a manageable case at trial.