

**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

**APPLE INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF SUBJECT
MATTER INELIGIBILITY UNDER 35 U.S.C. § 101 FOR U.S. PATENT NOS. 6,928,306
AND 6,329,794**

TABLE OF CONTENTS

	Page
I. STATEMENT OF ISSUES	1
II. STATEMENT OF UNDISPUTED MATERIAL FACTS	1
A. U.S. Patent No. 6,928,306 (“the ’306 Patent”).....	1
1. Summary Of The ’306 Patent	1
2. Prosecution History.....	3
3. State Of The Known Art.....	3
B. U.S. Patent No. 6,329,794 (“the ’794 Patent”).....	4
1. Summary Of The ’794 Patent	4
2. Maxell’s Prior Litigation Against ZTE.....	5
III. LEGAL STANDARDS	6
IV. ARGUMENT.....	6
A. The ’306 Patent Is Invalid For Claiming Ineligible Subject Matter	6
1. Step One: The ’306 Asserted Claims Are Directed To An Abstract Idea.....	6
2. Step Two: The ’306 Patent Asserted Claims Do Not Disclose An Inventive Concept.....	10
B. The ’794 Patent Is Invalid For Claiming Ineligible Subject Matter	11
1. Step One: The ’794 Asserted Claims Are Directed To An Abstract Idea.....	11
2. Step Two: The ’794 Patent Asserted Claims Do Not Disclose An Inventive Concept.....	14
V. CONCLUSION.....	15

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Alice Corp. v. CLS Bank Int’l</i> , 134 S. Ct. at 2347 (2014).....	6, 15
<i>Credit Acceptance Corp. v. Westlake Servs.</i> , 859 F.3d 1044 (Fed. Cir. 2017)	8
<i>Cyberfone Sys. LLC v. CNN Interactive Grp.</i> , 558 Fed.Appx. 988 (Fed. Cir. 2014).....	14
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014)	8
<i>Digitech Image Tech’s v. Electronics for Imaging</i> , 758 F.3d 1344 (Fed. Cir. 2014)	8
<i>Enfish LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	9
<i>FairWarning IP, LLC v. Iatric Sys., Inc.</i> , 839 F.3d 1089 (Fed. Cir. 2016)	7, 8
<i>In re TLI Commc'ns LLC Patent Litig.</i> , 607 (Fed. Cir. 2016).....	14
<i>Internet Patents Corp. v. Active Network, Inc.</i> , 790 F.3d 1343 (Fed. Cir. 2015)	7
<i>Maxell, Ltd. v. ZTE Corp., et al.</i> , No. 5:16-cv-00179-RWS (E.D. Tex.).....	6
<i>TAGI Ventures, LLC v. Turner Sports Interactive, Inc.</i> , No. 1:16-CV-3412-MHC, 2017 WL 3469528 (N.D. Ga. Feb. 17, 2017)	14
<i>Thales Visionix Inc. v. United States</i> , 850 F.3d 1343 (Fed. Cir. 2017)	9, 13
Statutes	
35 U.S.C. § 101.....	1, 6
Rules	
Fed. R. Civ. P. 56(a)	6

Defendant Apple Inc. moves for summary judgment that the asserted claims of two asserted patents—U.S. Patent Nos. 6,928,306 (“the ’306 Patent”) and 6,329,794 (“the ’794 Patent”)—are directed to ineligible subject matter under 35 U.S.C. § 101 and *Alice*.

The ’306 Patent is directed to the abstract idea of combining sounds from at least two sound sources to convey a signal. Humans have long combined sounds from two sources—e.g., singing and clapping—to generate a new sound. There is nothing inventive about generating a sound from “at least two” sound sources as opposed to one. What’s more, the ’306 Patent carries out this basic human activity by combining sounds using a generic “sound generator,” “controller,” and “sound sources,” techniques that the patent and Maxell’s expert admit were “already known.”

The ’794 Patent is directed to the abstract idea of prioritizing tasks for allocation of resources in a battery-operable device. Prioritizing tasks and allocating time and energy to higher priority tasks is a basic human activity. According to the patent, in “conventional” technologies, a human user had to manually stop using a lower priority function (e.g., video calling) in order to conserve power for higher priority functions (e.g., audio communication). The only purported “improvement” is to use generic components (e.g., “a controller”) to automate what was previously done manually. But simply automating human activities is not eligible subject matter, particularly where, as here, the claims lack any implementation details and the patent claims no improvements to any of the recited components. Accordingly, the ’306 and ’794 Patents are invalid under § 101.

I. STATEMENT OF ISSUES

Whether Claims 12 and 15 of the ’306 Patent and Claims 1 and 14 of the ’794 Patent are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

II. STATEMENT OF UNDISPUTED MATERIAL FACTS

A. U.S. Patent No. 6,928,306 (“the ’306 Patent”)

1. Summary Of The ’306 Patent

1. The '306 Patent claims priority to January 7, 2000. '306 Patent (Ex. A) at Cover.

2. The alleged invention is “[a] portable mobile unit for alerting on incoming of a signal by a ringing sound.” *Id.* at Abstract, 1:5-10, 1:62-2:56. The specification admits that “generat[ing] the ringing sound for alerting of incoming phone calls” was already known in “conventional cellular telephones.” *Id.* at 1:10-23. The alleged deficiency was simply that a user could “confus[e] ... the incoming call” with that of other cellular phones, such that there was a need for “discriminating or differentiating the ringing sound of each [of] the cellular phone[s] from others.” *Id.*; see Ex. E at ¶ 43. Yet, the patent admits that technologies for discriminating ringing sounds in cellular phones already existed. For example, the patent admits that a “melody generator ... capable of producing different melodies” was “popular,” “widely prevailed,” and could “discriminate” ringing sounds. '306 Patent at 1:22-29. The patent also admits that using a “FM [Frequency Modulation] sound source” or a “PCM [Pulse Code Modulation] sound source” to synthesize alerting sounds was “already known.” *Id.* at 1:42-53.

3. The patent’s purported solution is not an improved portable device with improved performance or processing capacity. Nor is it an improved controller, sound source, or sound generation protocol. Instead, the purported “invention” is merely to create sounds by combining sounds from at least two sound sources. *Id.* at Abstract, 1:5-2:56. These “sound sources” include a “FM sound source,” “PCM sound source,” and “sound data ... of the MIDI method” or “MP3 method,” which the patent admits were “already known.” *Id.* at 1:42-53, 4:34-65, 5:6-7.

4. Asserted Claim 12 recites:

A portable mobile unit capable of alerting on incoming of a signal by a ringing sound, comprising:

a ringing sound generator for generating the ringing sound in accordance with a plurality of patterns made of combination of at least two sound sources; and

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.