

# EXHIBIT M

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

MAXELL, LTD.,

Plaintiff,

v.

ZTE CORPORATION, ZTE USA INC.,

Defendants.

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CIVIL ACTION NO. 5:16-CV-00179-RWS

**SEALED**

**ORDER**

On May 2, 2018, the Court heard oral argument on a variety of motions. Based on the parties’<sup>1</sup> briefing and argument, the Court rules as follows:

- ZTE’s Motion to Exclude Portions of Expert Opinion Testimony (Docket No. 154) is **DENIED**;
- ZTE’s Motion for Summary Judgment Regarding Non-Infringement under Doctrine of Equivalents (Docket No. 152) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- ZTE’s Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,396,443 (Docket No. 151) is **DENIED AS MOOT**;
- ZTE’s Motion for Summary Judgment of Noninfringement of U.S. Patent Nos. 5,396,443 and 6,748,317 (Docket No. 153) is **DENIED AS MOOT** with respect to the ’443 patent and **DENIED** with respect to the ’317 patent;

<sup>1</sup> The parties in this matter are Maxell, Ltd. (“Maxell”) and ZTE USA, Inc. (“ZTE”). The patents discussed in this order include: U.S. Patent Nos. 5,396,443 (“the ’443 patent”); 6,748,317 (“the ’317 patent”); 6,329,794 (“the ’794 patent”); 8,339,493 (“the ’493 patent”); 8,736,729 (“the ’729 patent”); 6,408,193 (“the ’193 patent”); 6,816,491 (“the ’491 patent”) and 8,098,695 (“the ’695 patent”).

- Maxell's First Daubert Motion to Exclude Mr. Scott Andrews' Untimely Opinions On Indefiniteness and Unreliable Opinions On Obviousness of U.S. Patent No. 6,748,317 (Docket No. 147) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- ZTE's Motion for Summary Judgment of Invalidity of U.S. Patent Nos. 6,748,317 and 6,329,794 (Docket No. 143) is **DENIED**;
- Maxell's Motion for Partial Summary Judgment of No Invalidity under 35 U.S.C. § 103 of Claims 1-3 and 5-14 of U.S. Patent No. 6,329,794 (Docket No. 146) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- Maxell's Motion For Partial Summary Judgment of No Invalidity under 35 U.S.C. § 103 of Claims 5-6 of U.S. Patent No. 8,339,493 and Claims 1-2 of U.S. Patent No. 8,736,729 (Docket No. 144) is **DENIED**;
- Maxell's Second Daubert Motion To Exclude Dr. Barmak Mansoorian's Conclusory Opinions on Obviousness of U.S. Patent Nos. 8,339,493 and 8,736,729 Pursuant to Fed. R. Evid. 702 (Docket No. 148) is **DENIED**;
- Maxell's Motion For Partial Summary Judgment of No Invalidity under 35 U.S.C. § 103 of Claims 1-7 of U.S. Patent No. 6,408,193 (Docket No. 145) is **DENIED AS MOOT**;
- Maxell's Third Daubert Motion To Exclude Dr. Zhi Ding's Unreliable Opinions On Obviousness of U.S. Patent No. 6,408,193 (Docket No. 149) is **DENIED**;
- ZTE's Motion For Summary Judgment of Noninfringement U.S. Patent No. 6,408,193 (Docket No. 155) is **DENIED**;
- ZTE's Motion for Summary Judgment of Noninfringement of U.S. Patent Nos. 6,816,491 and 8,098,695 (Docket No. 156) is **GRANTED-IN-PART** and **DENIED-IN-PART**; and

- Maxell’s Fourth Daubert Motion To Exclude Portions of The Expert Report of Dr. Ketan Mayer-Patel Concerning U.S. Patents Nos. 6,816,491 and 8,098,695 (Docket No. 150) is **DENIED**.

***I. ZTE’s Motion to Exclude Portions of Expert Opinion Testimony (Docket No. 154)***

ZTE moves to exclude the opinion testimony of Maxell’s damages expert, Carla Mulhern, based on (1) her reliance on a one percent high-end per-unit royalty rate; (2) apportionment; (3) reliance on consumer surveys; and (4) failure to consider comparable, reliable licenses. Mulhern’s opinion. Docket No. 154. ZTE’s concerns about Mulhern’s opinions relate more to the credibility of the evidence, not its admissibility. Accordingly, ZTE’s motion is **DENIED** with memorandum opinion to follow.

***II. ZTE’s Motion for Summary Judgment Regarding Non-Infringement under Doctrine of Equivalents (Docket No. 152)***

ZTE moves for summary judgment of noninfringement based on the doctrine of equivalents for each patent-in-suit. Docket No. 152. Maxell responds that considering its experts’ literal infringement opinions in conjunction with the doctrine of equivalence opinions provides sufficient basis to withstand summary judgment. Docket No. 60.

“[A] patentee must ... provide particularized testimony and linking argument as to the ‘insubstantiality of the differences’ between the claimed invention and the accused device or process, or with respect to the function, way, result test when such evidence is presented to support a finding of infringement under the doctrine of equivalents. Such evidence must be presented on a limitation-by-limitation basis.” *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed.Cir.1996). This rule applies in the summary judgment context. *AquaTex Indus., Inc. v. Techniche Sols.*, 479 F.3d 1320, 1328 (Fed. Cir. 2007).

Having reviewed the expert reports, the Court finds that Maxell's experts have not provided sufficient linking testimony regarding the '491 and '695 patents. *See Cambrian Sci. Corp. v. Cox Commc'ns, Inc.*, 617 F. App'x 989, 994 (Fed. Cir. 2015). For the '491 patent, Plaintiff's expert, Dr. Robert Maher, only states his ultimate conclusion:

[T]o the extent that ZTE argues that the demultiplexer from element [1.b] extracts the method of compression and encoding which is applied for compressing the audio data sequence from anything other than header information, it is my opinion that that the extracts the method of compression and encoding in a manner that is substantively equivalent to the use of header information.

Docket No. 60-7 at 44. Dr. Maher does not support this statement, however, with references to any specific facts. Likewise, for the '695 patent, Dr. Maher makes the same statement. *Id.* at 45. Because Dr. Maher's opinion on equivalence is insufficient, ZTE's motion for summary judgment is **GRANTED** with respect to the '491 and '695 patents. In light of the parties' stipulation (Docket No. 115) and representations at the hearing, the motion is **DENIED** as moot with respect to the '443 and '193 patents. The motion is **DENIED** in all other respects with memorandum opinion to follow.

**III. ZTE's Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,396,443 (Docket No. 151)**

In light of the parties' stipulation that Maxell's claim of infringement and ZTE's counterclaim for noninfringement and invalidity are dismissed (Docket No. 115), this motion is **DENIED AS MOOT**.

**IV. ZTE's Motion for Summary Judgment of Noninfringement of U.S. Patent Nos. 5,396,443 and 6,748,317 (Docket No. 153)**

ZTE moves for summary judgment of noninfringement as to the '443 and '317 patents. In light of the parties' stipulation, the motion is **DENIED AS MOOT** with respect to the '443 patent.

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