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-00036-RWS **JURY TRIAL DEMANDED**

MAXELL'S REPLY IN SUPPORT OF MOTION TO STRIKE PORTIONS OF APPLE'S REBUTTAL EXPERT REPORT OF DR. DANIEL A. MENASCÉ REGARDING NON-INFRINGEMENT OF U.S. PATENT NO. 6,329,794 FOR OFFERING LEGAL OPINIONS

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

...

I. INTRODUCTION

Unable to justify the inexplicable decision by its expert to opine on legal issues, Apple attempts to reframe the opinions as factual analyses and the dispute as one of credibility and weight. A plain review of the challenged opinions tells a different story, and exposes Apple's arguments as deflection and obfuscation, nothing more.

First, Apple ignores Dr. Menascé's misapplication of the law on prosecution history estoppel. Dr. Menascé is unequivocal in his opinion that a claim amendment made during prosecution bars all doctrine of equivalents opinions for that claim, regardless of scope. Of course, Dr. Menascé is wrong. The estoppel must be commensurate with the scope of the surrendered subject matter. Yet, Dr. Menascé fails to attempt such a proof, much less establish that Dr. Brogioli's equivalents opinions (covering two distinct theories and claim limitations) reside in the surrendered territory between the original and amended claim. Even if a presumption of estoppel does apply, this would necessarily mean that the rationale underlying the amendment bears no more than a tangential relation to the equivalent.

Second, Apple's argument that Maxell's challenges go to the weight of Dr. Menascé's opinions is a red herring and should not be countenanced. This is not a matter of two experts disagreeing on a technical issue, but rather one expert proffering opinions—legal conclusions—that are beyond his area of expertise and are in any event erroneous.

Third, Apple's excuses are belied by its June 30, 2020 Motion to Exclude Conclusory Testimony and Opinions of Maxell's Experts Relating to Doctrine of Equivalents and Source Code (Dkt. 367), where Apple asks this Court to exclude one of Dr. Brogioli's equivalents theories based on prosecution history estoppel. Apple knows this is a legal issue, yet attempts to proffer similar conclusions under the guise of technical expert testimony. Dr. Menascé's

opinions on the subject would only confuse the jury and empower it to decide an issue that is not within its province to consider—all to the substantial prejudice of Maxell.

Paragraphs 380-389 should be stricken in their entirety.

II. ARGUMENT

A. Apple ignores Dr. Menascé's legal conclusions

Apple's characterization of the challenged paragraphs conveniently ignores the very opinions that are the source of the impropriety. Apple sidesteps the first sentence of paragraph 386, which serves one undeniable purpose: inviting the jury to categorically dismiss all doctrine of equivalents opinions by way of prosecution history estoppel. Paragraph 386 also conveys and relies upon a misstatement and misapplication of controlling case law. Well aware that Dr. Menascé is unqualified to provide such opinions, Apple shifts attention elsewhere, and casts the lot of the challenged opinions as factual analysis or legal background. While portions of the challenged opinions fit this mold, Apple cannot divorce the opinions from the context and purpose in which they are provided.

Apple summarizes paragraph 386 from Dr. Menascé's rebuttal report as follows:

> Paragraph 386 recites Dr. Menascé's understanding of the three criteria evaluated by courts in determining whether a patentee can rebut the presumption of surrender to avoid prosecution history estoppel—and thus invoke the doctrine of equivalents—and notes that Dr. Brogioli failed to consider any of these criteria. Maxell does not argue that Dr. Menascé's recitation of the relevant criteria is incorrect or dispute that Dr. Brogioli failed to consider the criteria. **This paragraph does not state any legal opinion.**

Dkt. 402 at 5 (emphasis added). Lost in this summary is the first sentence of paragraph 386, which states: "[b]ecause the scope of independent claim 2 of the '151 Application was narrowed by rewriting the dependent claim 5 into independent form and by adding the application claim 14, the doctrine of equivalents is not available for '794 Patent Claims 1 and 9." Dkt. 364, Ex. 1 (Menascé Reb. Rep.) at ¶ 386.

DOCKET ALARM

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.