

**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 REPLY IN SUPPORT ITS MOTION TO EXCLUDE
THE TESTIMONY OF ROBERT L. STOLL (D.I. 357)**

Maxell's opposition confirms that Mr. Stoll is not qualified to offer opinions about the public accessibility or contents of the Abowd, Cyberguide, NavTalk, or Sony Cameras prior art references, and his opinions should be excluded. Maxell admits that Mr. Stoll has no expertise in interpreting the types of documents on which he bases his opinions (*e.g.*, library records, sale records, mailing labels, prior art). D.I. 397 at 13 (acknowledge that "he does not purport to be an expert" in these documents). And his USPTO experience does not replace substantive expertise in the relevant fields of library science, navigation devices, and camera technologies. Just as a patent examiner is not *de facto* qualified to explain the terminology of engineering documents as an expert in litigation based on her prosecution experience, Mr. Stoll is not qualified to offer expert testimony on library records, sales records, mailing labels, or the prior art simply because he held various USPTO positions or because these types of documents might be reviewed in prosecution. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356, 1362 (Fed. Cir. 2008).

Despite his undisputed lack of expertise, Maxell claims Mr. Stoll will opine on "what Apple's experts [allegedly] should have done (but failed to do) to meet their obligations for public accessibility according to USPTO practices and procedures." D.I. 397 at 8. He purports to explain the "sufficiency (or lack thereof)" of Apple's evidence as it would be perceived by the USPTO. *Id.* at 13. But this is not a proceeding before the USPTO. Nor is it a case about USPTO procedures. Mr. Stoll's purported opinions about USPTO practices relate to legal standards for determining public accessibility that are not the same as this Court's, and are therefore irrelevant and inappropriate in this context. D.I. 357 at 9; Ex. 4, Stoll Tr. 126:18-127:1, 168:19-169:5 ("I believe they are similar, but I'm not sure they are identical"); D.I. 397 at 8 (clear and convincing in this litigation); *In re Epstein*, 32 F.3d 1559, 1563 (Fed. Cir. 1994) (preponderance of the evidence to prove public accessibility before USPTO). Even if Apple

were to cross-examine Mr. Stoll and show that Apple had satisfied USPTO practices, it would be the wrong legal standard for this Court. Such testimony would serve only to confuse the jury.

That Mr. Stoll seeks to usurp the jury by applying the law to determine the “sufficiency” of Apple’s evidence—in a hypothetical USPTO proceeding based on inapplicable legal standards—more than justifies excluding his opinions about the prior art status of Abowd, Cyberguide, NavTalk, and Sony Cameras.¹ D.I. 357 at 10; *Estate of Sowell v. United States*, 198 F.3d 169, 171-72 (5th Cir. 1999) (excluding attorney testimony applying the law to determine “what a hypothetical estate executor, faced with the identical facts” should have acted). Further reasons to exclude his opinions about these references are described below.

I. Mr. Stoll Is Unqualified To Opine On Whether Abowd Was Publicly Accessible

Maxell admits that Mr. Stoll does not have any “specific credentials in the field of library science” (D.I. 397 at 9), but purports that his testimony is nonetheless admissible because Mr. Stoll will testify on the sufficiency of Apple’s evidence based on his “experience performing similar analyses at the USPTO.” *Id.* at 9-10. But how the USPTO would analyze public accessibility is not an issue in this case. Moreover, Mr. Stoll has already attempted to mislead the Court with his lay testimony, alleging that “Do Not Circulate” means Abowd was kept hidden from the public. D.I. 382 at 7-8. An expert with knowledge of library circulation rules would know that language merely denotes materials that cannot be take home from the library. Ex. 5. Library records do not “speak for themselves,” but instead require someone with subject matter expertise to help guide the jury. D.I. 357 at 9-10. Mr. Stoll has no such expertise, and his

¹ Maxell concedes that testimony about patent law principles, claim construction, inequitable conduct, and undisclosed opinions about prosecution are improper. D.I. 357 at 5-8; D.I. 397 at 7. Maxell also is unable to genuinely dispute that Mr. Stoll’s opinions about third-party IPRs are improper, instead resorting to trying to draw legally incorrect parallels to Apple’s experts’ technical analyses, including whether their art had been considered by the USPTO. D.I. 397 at 7.

lay testimony on the public accessibility of Abowd must be excluded.

II. Mr. Stoll Is Unqualified To Opine On Cyberguide's Public Availability

Experts who opine on the functions and components of a prior art device must have expertise in the relevant scientific field. *Sundance*, 550 F.3d at 1364. Yet Maxell claims that Mr. Stoll will use “his USPTO expertise to interpret specific language in Abowd” and opine on “features,” “purposes,” and “components” of the Cyberguide prior art. D.I. 397 at 10-11. Maxell’s claim that Mr. Stoll’s opinions are not “based on technical evidence” is contradicted by his report, testimony, and Maxell’s opposition. D.I. 357 at 11. Maxell suggests, for example, that Mr. Stoll will claim, based on his reading of the prior art, a prototype was “undeveloped ‘proof of concept’” and that a smiley face was a placeholder for later development. D.I. 397 at 11. To determine if a prototype is “undeveloped” requires an understanding of what features a skilled artisan would have considered sufficient for functioning. And technical expertise is required to explain the stage of development of a prior art’s user interface. The Federal Circuit does not permit unqualified lawyers to testify about the scope of public use and whether it was enabling to avoid misleading “the jury to seemingly sound conclusions without ever providing a well-grounded factual basis in the pertinent art.” *Sundance*, 550 F.3d at 1365 & n.8.

III. Mr. Stoll's Testimony About NavTalk's Public Use Should Be Excluded

Mr. Stoll’s opinions on the sufficiency of evidence showing that NavTalk and its manual were publicly accessible should be excluded for similar reasons. Maxell admits that Mr. Stoll is not an expert in electronic devices. D.I. 397 at 11. His efforts to instruct the jury on the part numbers for the NavTalk device, manual, and packaging in prior art user manuals from the 1990s constitutes technical testimony for which Mr. Stoll has no expertise. Ex. 4, Stoll Tr. 140:6-141:3 ([REDACTED]).

And Maxell admits that Mr. Stoll has no training to review sale records and bill of materials.

D.I. 397 at 11. If, as Mr. Stoll claims, these are plain English documents that do not require expertise to understand, then his testimony “interpret[ing] documents which are clear on their face” is unhelpful for the jury. *Ningbo Bonny Decorative Material Co. v. E. Sys., Inc.*, No. 17-114, 2020 WL 1333164, at *5 (N.D. Miss. Mar. 23, 2020) (excluding testimony about invoices that “speak for themselves”); D.I. 357 at 9-10. Mr. Stoll further admits that his reading of Garmin’s declaration and deposition is based on his experiences as a lawyer. D.I. 357 at 12 (acknowledge that patent examiners are not trained to read depositions). Fifth Circuit courts require, however, “that a proffered expert bring to the jury more than the lawyers can offer in argument.” *Robroy Indus.-Texas, LLC v. Thomas & Betts Corp.*, No. 15-512-WCB, 2017 WL 1319553, at *10 (E.D. Tex. Apr. 10, 2017). Contrary to Maxell’s claim, *Robroy* stands for more than the narrow proposition that “one cannot become an expert by simply reading deposition[s]” (D.I. 397 at 12), but “[m]ore generally” that an expert cannot simply read transcripts that a jury can understand for themselves. *Robroy*, 2017 WL 1319553, at *9.

Mr. Stoll disclaims subject matter knowledge. The Court should therefore exclude his opinion because he is either offering legal analyses as a lawyer or offering lay testimony as someone who lets the documents speak for themselves, either of which is improper.

IV. Mr. Stoll’s Testimony About Sony Cameras’ Public Sale Should Be Excluded

Mr. Stoll’s testimony about Sony Cameras should be excluded for two reasons. First, Mr. Stoll testified that the USPTO does not review actual prior art devices and that his comparisons of the cameras in this case is based on his legal training to analyze “infringement type of issues.” D.I. 357 at 13. To the extent a jury needs guidance on labels and UL stickers to determine if two cameras are the same model, only an expert with knowledge of cameras can offer that type of infringement analysis. *See Sundance*, 550 F.3d at 1363. Claiming that no expertise is needed, Mr. Stoll alleges the camera markings “speak for themselves” and that “[i]t’s clear that there are

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