

# EXHIBIT 7

**CONFIDENTIAL – ATTORNEYS’ EYES ONLY**

**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**

**DEFENDANT APPLE INC.’S SECOND AMENDED  
INITIAL AND ADDITIONAL DISCLOSURES**

In accordance with Fed. R. Civ. P. 26(a)(1) and Paragraphs 1 and 3 of the Court’s June 25, 2019 Discovery Order for Patent Cases [ECF 42], Defendant Apple Inc. (“Apple”) provides the following second amended initial and additional disclosures of information to Plaintiff Maxell, Ltd. (“Maxell”). These disclosures are based upon Apple’s current knowledge and upon information that is reasonably available to Apple at this time and within Apple’s possession, custody, or control as of the present date. This investigation is ongoing, however, and Apple expressly reserves the right to supplement these disclosures. Apple’s disclosures are made without waiver of, or prejudice to, any objections that Apple may have regarding the subject matter of these disclosures and any documents or individuals identified herein.

**I. INITIAL DISCLOSURES REQUIRED UNDER THE COURT’S DISCOVERY ORDER**

**A. The Correct Names of the Parties to the Lawsuit**

The correct name of Apple is: Apple Inc. Apple refers to Maxell’s disclosures regarding the correct names of other parties to the lawsuit.

**CONFIDENTIAL – ATTORNEYS’ EYES ONLY**

**B. The Name, Address, and Telephone Number of Any Potential Parties**

Apple is not currently aware of any potential additional parties to this lawsuit. Because the identities of potential parties may be revealed through discovery in this matter, Apple specifically reserves the right to identify and seek to join, upon a showing of good cause, potential parties as discovery proceeds, if necessary.

**C. The Legal Theories and Factual Bases of the Disclosing Party’s Claims or Defenses**

Apple is currently aware of the legal theories and factual bases of its claims and defenses listed below. Apple incorporates its Answer in this case [ECF 118] and incorporates by reference the responses and defenses asserted therein. Apple further incorporates by reference its responses to Maxell’s interrogatories, including interrogatory number 10. Discovery is ongoing, and Apple reserves the right to assert additional defenses. Apple also reserves the right to modify or supplement its theories and/or the factual bases for its claims or defenses:

**Non-infringement.** Apple has not directly or indirectly infringed, either literally or under the doctrine of equivalents, any valid and enforceable claim of any of U.S. Patent Nos. 6,748,317 (“317 Patent”); 6,580,999 (“999 Patent”); 8,339,493 (“493 Patent”); 7,116,438 (“438 Patent”); 6,408,193 (“193 Patent”); 10,084,991 (“991 Patent”); 6,928,306 (“306 Patent”); 6,329,794 (“794 Patent”); 10,212,586 (“586 Patent”); and 6,430,498 (“498 Patent”) (collectively, the “Patents-in-Suit”). Apple does not manufacture, use, sell, or offer to sell in the United States, or import into the United States, any product that includes each and every element of any asserted claim of the Patents-in-Suit, or an equivalent, to the extent that Maxell is entitled to any equivalent. Specifically, accused Apple products (and the operation thereof) are missing or do not perform one or more elements or steps required by the asserted claims of the Patents-in-Suit. Further, Apple products have substantial non-infringing uses. Apple also does not contribute to or induce

**CONFIDENTIAL – ATTORNEYS’ EYES ONLY**

another’s infringement, and Apple has no intent to induce any alleged infringement. Moreover, at least because Apple cannot be liable for infringement of any claims, Apple cannot be liable for willfully infringing the Patents-in-Suit.

**Invalidity.** The asserted claims of the Patents-in-Suit are invalid under 35 U.S.C. §§ 101, 102, 103, 111, 112, 115, 116, 119, 132, 251, 256, and/or 282. Apple will provide detailed invalidity contentions, prior art, and expert reports on invalidity in the time and manner provided in the Patent Rules for the Eastern District of Texas and the Court’s scheduling orders.

**Limitation on Damages.** To the extent Maxell is entitled to any recovery under the Patents-in-Suit, Maxell’s recovery is limited under 35 U.S.C. § 286 and because of Maxell’s failure to comply with § 287 and/or § 288.

**Estoppel, Waiver, Acquiescence, Patent Misuse and Unclean Hands.** To the extent Maxell is entitled to any recovery under the Patents-in-Suit, Maxell’s recovery is limited by the equitable doctrines of estoppel, waiver, acquiescence, patent misuse, and unclean hands, including because Maxell’s claims were waived and/or estopped, in whole or in part, by discussions between and/or prior agreements entered between Maxell (or a related entity) and Apple.

**No Willful Infringement.** Maxell is not entitled to a finding of willful infringement because Maxell cannot demonstrate that infringement occurred. Even if Maxell were able to demonstrate that infringement had occurred, Maxell would still not be entitled to a finding of willful infringement, including because, among other reasons, Maxell will not be able to show that any alleged infringement by Apple constituted egregious misconduct. In addition, through prior agreements and/or discussions, Maxell has waived in whole or in part its right to seek enhanced damages for willful infringement.

**CONFIDENTIAL – ATTORNEYS’ EYES ONLY**

| Name  | Subject(s)   | Contact Information   |
|---|--|---|
| <p>Townsend and Townsend and Crew LLP</p> <p>Named prosecution firm for the '306 Patent</p> | <p>Prosecution of the '306 Patent and related patents and patent applications.</p>   | <p>On information and belief, contact information is:</p> <p>Two Embarcadero Center<br/>8th Floor<br/>San Francisco, CA 94111<br/>Tel: (415) 576-0200; (650) 326-2400<br/>Fax: (415) 576-0300; (650) 326-2422</p> |
| <p>McDermott, Will &amp; Emery</p> <p>Named prosecution firm for the '794 Patent</p>        | <p>Prosecution of the '794 Patent and related patents and patent applications.</p>   | <p>On information and belief, contact information is:</p> <p>600 13th Street, N.W.<br/>Washington, DC 20005<br/>Tel: (202) 756-8000<br/>Fax: (202) 756-8087</p>   |
| <p>Baker Botts L.L.P.</p> <p>Named prosecution firm for the '586 Patent</p>                 | <p>Prosecution of the '586 Patent and related patents and patent applications.</p>   | <p>On information and belief, contact information is:</p> <p>30 Rockefeller Plaza<br/>44th Floor<br/>New York, NY 10112<br/>Tel: (212) 408-2561</p>   |
| <p>Maxell, Ltd.</p>   | <p>Investigations, communications, opinion, and/or negotiations relating to Apple's alleged infringement of the Patents-in-Suit; invalidity and unenforceability of the Patents-in-Suit; Plaintiff's alleged ownership of the Patents-in-Suit; licenses and settlement agreements related to the Patents-in-Suit; and acquisitions and valuations of the Patents-in-Suit.</p> <p>Alleged conception, reduction to practice, development, subject matter, and scope of the inventions claimed in and prosecution of the Patents-in-</p> | <p>On information and believe, Maxell, Ltd. is located in Kyoto, Japan.</p>   |

# 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.