

**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 REPLY IN SUPPORT OF ITS *DAUBERT* MOTION
TO EXCLUDE TESTIMONY AND OPINIONS OF MAXELL'S EXPERTS FOR
IMPROPER APPLICATION OF THE COURT'S CLAIM CONSTRUCTION**

Maxell's Opposition (D.I. 404) to Apple's *Daubert* Motion on Claim Construction (D.I. 358) confirms that its experts did not follow the Court's *Markman* Order. Rather than defending its experts' actual testimony as staying within the four corners of the constructions, Maxell uses its opposition to challenge the merits of the Court's constructions or to distract the Court by pointing to unrelated expert testimony that is not the subject of Apple's motion. At bottom, Maxell and its experts are neither permitted to contradict the Court's constructions nor to argue claim construction directly to the jury. Thus, all opinions of Drs. Rosenberg, Bystrom, and Brogioli that are inconsistent with the Court's *Markman* Order should be excluded.

I. Dr. Rosenberg's Opinions That Fail To Apply The Court's Construction Of Means-Plus-Function Terms Requiring A PHS Should Be Excluded ('317, '999 Patents)

This Court's construction was "CPU 71 and device for data communication 76 of a portable telephone **and** a Personal Handyphone System (PHS) terminal." D.I. 235 at 18. Dr. Rosenberg's report repeatedly replaced the conjunctive "portable telephone **and** a [PHS] terminal" with the disjunctive "portable telephone **and/or** a PHS terminal," and he then testified in his deposition that he specifically did so to re-urge Maxell's rejected *Markman* position that a "PHS is not required" because "many different places" in the specification "use the word 'or' or use the word 'and/or' too." *See* D.I. 358 at 4-6 (citing Dr. Rosenberg's report and deposition). Maxell tries to rewrite Dr. Rosenberg's testimony, but no amount of obfuscation can avoid the fact that the Court's construction makes clear a PHS is required, and Maxell and Dr. Rosenberg should be prohibited from arguing to the jury that a PHS is optional.

The bulk of Maxell's Opposition is irrelevant to Apple's Motion. Maxell spends three pages piecing together excerpts from Dr. Rosenberg's report that account for a scenario where a PHS is required. D.I. 404 at 2-5. Dr. Rosenberg's report does include opinions that pay lip service to PHS as a requirement, but it also includes opinions treating PHS as optional. Apple's

Motion seeks to strike only those opinions “that expressly or implicitly contradict the Court’s constructions” by treating PHS as optional. D.I. 358 at 6. The subject of Apple’s motion is therefore the many opinions in paragraphs 519-522 and 657-660 of his report which, as he confirmed in his deposition, reflect his belief that a PHS is optional. D.I. 358 at 4-6. That some of Dr. Rosenberg’s other opinions do not violate the Court’s order is obviously irrelevant.

Maxell also attempts to justify Dr. Rosenberg’s use of “and/or” and his deposition testimony that a “PHS” is optional. D.I. 404 at 6-8. But Maxell’s explanation is riddled with contradicting statements. In one sentence, Maxell states that “Apple has mischaracterized [Dr. Rosenberg’s testimony] as evidence of Dr. Rosenberg treating the PHS as an optional requirement,” suggesting that Maxell agrees a PHS is required. *Id* at 7. But in the very next sentence, Maxell states that “Dr. Rosenberg explained that the Court’s construction does not require a PHS.” *Id*. Maxell cannot have it both ways—it must either acknowledge that the Court’s construction requires “PHS” or stand behind its expert’s opinion that PHS is optional.

As best as Apple can decipher Dr. Rosenberg’s position, he appears to argue that the Court’s construction only requires a “device for data communication,” and the portable telephone and PHS are just “two examples of devices for data communication.” D.I. 358, Ex. 2 at 88:16-89:4. Maxell attempts to justify (and modify) this position by analogizing the Court’s construction to requiring “brake pads of a car” and arguing that the “construction requires a device for data communication of a PHS (the brake pads), not the entirety of the PHS (the car).” D.I. 404 at 8. But Maxell’s apparent position that the latter half of the Court’s construction is irrelevant verbiage or mere examples contradicts the Court’s *Markman* Order. *See* D.I. 235 at 17 (citing “the clear disclosure of device for data communication 76’s structure: ‘an ordinary portable telephone and a PHS’”) (emphasis original). The Court’s construction plainly requires

that the “device for data communication” must be “of a portable telephone and a Personal Handyphone System (PHS) terminal.” *Id.* at 18. Thus, a “device for data communication” that only supports a portable telephone, but not a PHS, cannot satisfy the Court’s construction.

Apple respectfully requests that the Court strike the opinions in paragraphs 519-522 and 657-660 of Dr. Rosenberg’s report referring to “portable telephone **and/or** a PHS terminal” and preclude Dr. Rosenberg from testifying at trial that PHS is optional.

II. Dr. Bystrom’s Opinions Disregarding The Court’s Construction Requiring “Videophone Function-Added TV Receiver” Should Be Excluded (’991 Patent)

Maxell attempts to justify Dr. Bystrom’s improper opinions by (1) attacking Apple’s factual evidence of non-infringement, and (2) re-arguing the construction of “communication apparatus” by citing embodiments from the ’991 Patent. D.I. at 404 at 9-11. Tellingly, Maxell’s Opposition presents no explanation on how Dr. Bystrom’s report adheres to the Court’s *Markman* Order, and, in fact, includes no citation to the Court’s order at all. *See id.*

Maxell begins by attacking the non-infringement opinions of Apple’s expert, Dr. Bederson. But Dr. Bederson’s analysis that the accused products do not include [REDACTED] [REDACTED] [REDACTED] is part of his factual analysis of the accused products’ design. *See* D.I. 404 at 9-10.¹ Maxell fails to explain how Dr. Bederson’s factual analysis on non-infringement (in his rebuttal report) somehow justifies Dr. Bystrom’s claim construction opinions (in her opening report) based on dictionaries and specification embodiments. *See* D.I. 358 at 8-9.

Second, Maxell only confirms that it is engaging in improper claim construction by citing the specification to argue that a “communication apparatus” must include the “video-on-demand

¹ While Dr. Bederson cited this evidence as part of his analysis that the accused products do not include a TV receiver, he did not opine that the any claim term should be construed to require [REDACTED] [REDACTED]. *See* Ex. 6 (Bederson Dep. Tr.) at 223:6-241:6.

(VOD)” embodiment. *See* D.I. 404 at 10-11. Maxell’s and Dr. Bystrom’s attempt to undo the Court’s construction of “communication apparatus” as a “videophone function-added TV receiver” based on a specific embodiment should not be permitted at trial. *See* D.I. 235 at 56; *Tinnus Enters., LLC v. Telebrands Corp.*, No. 6:16-cv-00033-RWS, 2017 WL 3457104, at *2-3 (E.D. Tex. Aug. 11, 2017) (excluding expert’s opinions that “constru[e] the Court’s construction” using “the specification” and other evidence).

Maxell’s argument that Apple is attempting to exclude the specification’s VOD embodiment from the Court’s construction is a strawman. *See* D.I. 404 at 10-11. Neither Apple nor its expert has argued that a “videophone function-added TV receiver” cannot have video-on-demand functionality. But just having video-on-demand functionality is insufficient to qualify a device as a “TV receiver” if it does not include television reception functionality. This is entirely consistent with ’991 Patent’s disclosure, which differentiates between “TV” and “VOD” functionality in all embodiments. *See, e.g.*, ’991 Patent at 9:13-24, 10:13-23, Fig. 4.

III. Dr. Brogioli’s Opinions That Fail To Apply The Court’s Construction Of Means-Plus-Function Terms Should Be Excluded (’794 Patent)

Maxell fails to identify any basis to justify Dr. Brogioli’s opinions that include common components within the scope of the “function/component devices” terms.

First, Maxell attempts to wiggle out of the Court’s constructions by arguing that they merely reflect “dicta” from the prior *Huawei* case. *See* D.I. 404 at 12-13. But the claim terms construed by this Court in *Huawei*—“function devices equipped with independent functions” (Claim 1) and “component devices for performing different functions in the device” (Claim 9)—are the exact terms at issue in Apple’s Motion. *See* D.I. 358 at 10. The parties agreed to adopt the Court’s prior constructions for these terms during *Markman* (D.I. 99 at 3), and the Court incorporated them in the *Markman* Order issued in this case. *See* D.I. 235 at 6-7. If Maxell

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