

**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  
CONCLUSORY TESTIMONY AND OPINIONS OF MAXELL'S EXPERTS  
RELATING TO DOCTRINE OF EQUIVALENTS AND SOURCE CODE**

Maxell's experts Drs. Maher, Vojcic, Madisetti, Rosenberg, Brogioli, Bystrom, and Williams proffer conclusory doctrine-of-equivalents and/or source code opinions that lack analysis and factual support. Similarly, Maxell's opposition does nothing more than restate its experts' conclusions, without citing any relevant supporting analysis to demonstrate the admissibility of the challenged opinions, tacitly admitting that none exists. Without supporting analysis or facts, these opinions are unreliable and irrelevant and should be excluded.

**I. DRS. MAHER, VOJCIC, MADISETTI, AND ROSENBERG'S CHALLENGED DOCTRINE OF EQUIVALENTS OPINIONS ARE UNSUPPORTED**

It is well-settled that sufficient doctrine of equivalents opinions require an articulation of how the differences between the claimed invention and the accused device are insubstantial. *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334, 1343 (Fed. Cir. 2016); *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1567 (Fed. Cir. 1996); *Colucci v. Callaway Golf Co.*, 748 F. Supp. 2d 629, 632 (E.D. Tex. 2010). Maxell's opposition is unable to point to any such articulation. Tellingly, Maxell's single use of any variation of the word "insubstantial" in its opposition is tantamount to the conclusory nature of the challenged opinions. *See* Opp. at 3 (quoting Dr. Madisetti's opinion that "[t]he evidence I've cited in this section proves these functions, ways, and results are insubstantially different"). As in *Genband US LLC v. Metaswitch Networks Corp.*, Maxell's experts' "conclusory opinions," "unsupported by 'facts or data' and based on no discernable 'principles and methods,'" "are not admissible under Fed. R. Evid. 702." No. 2:14-CV-33-JRG-RSP, 2016 WL 3475688, at \*2 (E.D. Tex. Jan 7, 2016); *see also Eolas Techs. Inc. v. Amazon.com, Inc.*, No. 6:15-CV-1038-RWS, 2016 WL 7666160, at \*3 (E.D. Tex. Dec. 5, 2016) ("Plaintiff's blanket statement that elements not literally infringed are 'infringed under the doctrine of equivalents because the difference between the claimed inventions and Defendants' infringement, if any, are insubstantial and the accused

instrumentalities perform the same function in the same way to achieve the same result as such limitations’ does not meet the requirement of [P.R. 3-1(d)].”<sup>1</sup>

Unable to point to any non-conclusory doctrine of equivalents opinions, Maxell resorts to arguing these opinions are sufficient based on their literal infringement analysis. *See* Opp. at 2-6 (“Apple ... ignor[es] the ... preceding infringement testimony”), (“Dr. Madisetti provides a detailed infringement analysis regarding claim limitation 6[b] of the ’493 Patent. Relying on this same analysis, ... paragraphs 633-635 address why Apple’s products also infringe under the doctrine of equivalents.”). Unless Maxell is admitting that Apple does not literally infringe the Asserted Patents, it is nonsensical for Maxell to rely on its experts’ literal infringement analyses as evidence of their articulation of the differences between the claimed invention and the accused device and the insubstantiality of those differences. *See, e.g., Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340, 1382 (Fed. Cir. 2009) (“[E]vidence and argument on the doctrine of equivalents cannot merely be subsumed in plaintiff’s case of literal infringement.”); *see also Eolas Techs.*, 2016 WL 7666160, at \*3 (“In light of Plaintiff’s admission that its contentions relate to literal infringement,” “Plaintiff’s current ICs do not cover DOE claims.”). Because the challenged opinions are devoid of any factual support or analysis, they should be excluded.

## **II. DR. BROGIOLI’S CHALLENGED DOCTRINE OF EQUIVALENTS OPINIONS MISAPPLY THE LAW OF PROSECUTION HISTORY ESTOPPEL**

Maxell’s opposition misrepresents the scope of surrender that arose from the redrafting of application claim 5, which was revised as shown below to overcome the Eiraku reference and obtain the ’794 Patent (non-underlined portions represent the dependent claim as originally filed

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<sup>1</sup> If such blanket statements are insufficient for infringement contentions, then Maxell’s experts’ blanket statements are certainly insufficient for expert testimony, where the bar is higher. *See, e.g., ROY-G-BIV Corp. v. ABB, Ltd.*, 63 F. Supp. 3d 690, 699 (E.D. Tex. 2014) (explaining the higher standard for expert reports as compared to infringement contentions).

and underlined portions represent the additions to transform the claim into independent form).

5. (Amended) An information processing device [according to claim 2] comprising:  
at least two function devices equipped with independent functions; and  
a power supply circuit for supplying power to each of said function devices, said  
power supply circuit including a battery, a capacity detector for detecting a remaining  
capacity of said battery, and a controller for controlling operation of said function  
devices based on said remaining capacity;  
 wherein when said capacity detector detects [a] remaining battery [capacity]  
 capacities NA and NB (where NA>NB) **said controller sends a power consumption**  
**reduction instruction to each function device included in a set GA [function devices or a**  
**set GA of function devices having a lower usage priority] if NA is detected, each function**  
device of the set GA having a lower usage priority, and to each function device of a set  
GB [function devices not included in said set GA or to a set GB of function devices] if  
NB is detected, each function device of set GB is not included in said set GA.

Dkt. 367-08 at MAXELL\_APPLE0000296 ('794 Patent File History Excerpts) (highlights added). The limitations present in the original dependent claim 5 (*i.e.*, the non-underlined portions) are subject to prosecution history estoppel. *See Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1183 (Fed. Cir. 2009) (“[T]he cancellation of original independent claim 1 coupled with the rewriting of original dependent claim 7 as independent claim 14 gave rise to a presumption of surrender applicable to all limitations ... that correspond to the limitations of claim 7.”). There is no dispute that the challenged opinions are directed to the highlighted portions of the claim—all of which is subject to the presumption of surrender. Nor is there any dispute that the amendment was made for the purpose of securing the patent, as Dr. Brogioli himself admitted. *See* Ex. 10 (Brogioli Rebuttal Report) at ¶ 71 (“[T]he applicants were clear that the purpose of their claim amendments ... was to secure allowance of all claims, per the guidance of the Examiner.”). The presumption of surrender arises regardless of whether the amendment was made to avoid an asserted prior art reference under § 102 (*i.e.*, *Eiraku*) or merely to “secure allowance.” *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 736, (2002) (estoppel is not limited to narrowing amendment made for purposes of avoiding

prior art, but applies to any “narrowing amendment made to satisfy any requirement of the Patent Act”).

### **III. DR. ROSENBERG’S CHALLENGED STRUCTURAL EQUIVALENTS OPINIONS ARE UNSUPPORTED**

Maxell’s opposition attempts to supplement Dr. Rosenberg’s opinions on structural equivalents by arguing that “WiFi and cellular functionality” were not “after arising technologies” to the ’317 and ’999 Patents because the “original WiFi 802.11 standard was published in 1997” and “CDMA systems were known ‘by the spring of 1990.’” *See Opp.* at 10. But in making these arguments, Maxell merely highlights what’s missing from Dr. Rosenberg’s report—any opinions about structural equivalents and its exclusion of “after arising technology.” None of Maxell’s arguments are found in Dr. Rosenberg’s report. Indeed, to support its arguments, Maxell cites not to Dr. Rosenberg, but to testimony of an Apple expert (Dr. Bims) regarding patents unrelated to the ’317 and ’999 Patents that Dr. Rosenberg considered. *Id.*

Dr. Rosenberg’s report has no infringement opinions based on structural equivalents, and the deposition portions Maxell cites fail to help its cause. *Id.* at 11. For example, Dr. Rosenberg admitted he was “not aware of the after-arising technology” exclusion and “never addressed” it in his report because he “didn’t think it was relevant.” Dkt. 367-5 at 121:14-122:22.

Accordingly, Dr. Rosenberg’s opinions regarding structural equivalents should be excluded.

### **IV. DRS. MADISETTI, BYSTROM, MAHER, AND WILLIAMS’ CHALLENGED SOURCE CODE OPINIONS LACK ANALYSIS**

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

*See Opp.* at 11. Tellingly, in support of its analysis, Maxell provides zero citations to its experts’

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