PUBLIC VERSION

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
	
	PUBLIC VERSION

MAXELL, LTD.'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE PORTIONS OF DEFENDANT APPLE INC.'S REBUTTAL EXPERT REPORTS BASED ON UNTIMELY CLAIM CONSTRUCTION POSITIONS

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TABLE OF CONTENTS

Apple's Opposition confirms Maxell's position. Despite fighting for the ability to construe additional claim terms and having received that ability from the Court, Apple developed a strategy of not seeking constructions for terms it wanted its experts to interpret narrowly in their rebuttal non-infringement expert reports under the guise of "plain and ordinary meaning." This strategy has allowed Apple to: (1) keep the scope of the claims broad for purposes of pursuing its invalidity goals in front of the PTAB or the jury; and (2) confuse the jury by disguising these claim construction positions as "factual disputes." If Apple's experts truly believed that the plain and ordinary meanings of these terms are as stated in their non-infringement expert reports, surely they would have mentioned these meanings in their invalidity expert reports or in the IPRs. But Apple's experts deliberately mentioned these alleged "plain and ordinary meanings" for the first time in their non-infringement expert reports. This approach should be stopped in its tracks.

I.   Dr. Bederson's Rebuttal Expert Reports – the '306 and '991 Patents

'306 Patent. Apple is mischaracterizing Dr. Bederson's clear claim construction argument as plain and ordinary meaning. In his non-infringement report, Dr. Bederson stated:

██
██
████████████████████

Opp. at Ex. 2, Bederson Rpt. at ¶ 51 (emphasis added). Dr. Bederson is unequivocally opining that the accused products do not meet the ringing sound generator claim element because the accused products include a single memory. But the claim does not "recite" multiple memories. This is the same argument Apple unsuccessfully offered at the *Markman* hearing by requiring ringing sound generator to include multiple memories, and now Apple is attempting to make that same argument by requiring at least two sound sources to mean at least two memories. *See* Opp.

at Ex. 2, Bederson Rpt. at ¶¶ 56-67 (including paragraphs of opinions that read like a claim construction declaration discussing how the specification discloses multiple memories). Dr. Bederson goes even further and opines on how the specification discloses specific types of coding methods in the sound sources, concluding that the claim is not met because the accused products do not "alert the user of an incoming call via synthesizing any sounds." *Id*. at ¶¶ 62-67. It is clear that Dr. Bederson is limiting the claims to require multiple memories and specific types of coding requiring synthesizing of sound, despite the fact that Dr. Bederson's invalidity reports try to invalidate the same claims without mentioning memory once. Mot. at 4.

'991 Patent. As Apple admits, Dr. Bederson argues that the accused products do not meet the "videophone function-added TV receiver" limitation because of the "lack of a TV tuner and inability to receive and decode broadcast program signals transmitted according to television standards." Opp. at 4. Thus, Dr. Bederson is construing "videophone function-added TV receiver" to necessarily require a TV tuner compliant with television standards, even though the Court's construction never mentions TV tuner or TV standards and the '991 Patent discloses accessing a video on demand server to access content over the Internet. *See* D.I. 404 at 9-11; *see also* D.I. 422 at 11-15.

With respect to the term "display configured to display at least the first and the second digital information," Apple admits they are adding a temporal limitation (Opp. at 5) and with respect to "pauses," Apple admits that it is construing "pauses" to exclude stops. Opp. at 5.

II.   Dr. Paradiso's Rebuttal Expert Report – the '317, '498, and '999 Patents

"Direction" Limitations. Both Apple's Opposition and Dr. Paradiso at his deposition confirm that he is construing the claim to exclude embodiments disclosed in Figure 3. Ex. 15, Paradiso Dep. Tr., at 85:21-86:9 ("**interpreting** this with the assistance of figures 3(a) through 3(b)"); *see also* Opp. at 6 ("Maxell objects that Dr. Paradiso did not consider Figures 3(c)-(f) in

determining the scope of the 'direction' limitations. Mot. at 7. But those embodiments are **not relevant**.") (emphasis added). Figures 3(c)-(f) are absolutely relevant as the '317 Patent addresses Figure 3 collectively without characterizing (a)-(f) as being directed to different embodiments where one excludes the others. Ex. 14, '317 Patent, 4:51-53 ("FIG. 3 shows how data compression is controlled for the "Route Guidance Service" by the portable terminal…with the function of walking navigation"). Nothing in the claim requires a "straight line or arrow."

PHS Requirement. The Court's construction does not require the entire PHS; it requires a component of a PHS (device for data communication). *See* D.I. 404 at 6-9. Apple admits that Dr. Paradiso is relying on extrinsic evidence to limit the meaning of PHS to exclude cellular communication protocols and limit to using PSTN or ISDN only networks. Opp. at 7-8. And yet Dr. Paradiso admits that the specification does not limit PHS in such a way. Mot. at 8. Indeed, the '317 Patent explicitly discloses relying on cellular networks. Ex. 14, '317 Patent at 5:64-67 ("cellular"), 9:21-26 ("wireless network"), 1:45-52 and 2:44-49 (Internet communications).[1]

III.   Dr. Bims' Rebuttal Expert Report – the '193 Patent

Apple's Opposition confirms that Dr. Bims is construing "connected to" in the asserted claims to necessarily require "separate discrete dedicated analog components for 'receiver' 'transmitter' 'encoder/decoder' and 'controller'" and that a "**dedicated** encoder/decoder apparatus that is **outside** of and connected to the controller" needs to be present. Mot. at 8. But "discrete or dedicated are not expressly found in the claim" or the patent. Ex. 21, Bims Dep. Tr. at 89:3-7, 92:7-13. Apple fails to address several of Maxell's arguments in its Opposition. First, the '193 Patent explicitly teaches away from limiting the claims in this way. Ex. 17, '193 Patent

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[1] If this was truly a plain and ordinary meaning dispute, Apple or Dr. Bederson would have mentioned PHS's when arguing invalidity of the same claim elements. Instead, in its IPR Apple does not even mention PHS for these came claim elements let alone a PHS limited to non-cellular communications, instead construing the term to **not** require a PHS. Ex. 25, IPR2020-00409 Pet. at 29-31; Ex. 26, IPR2020-00409 Expert Decl. Ex. 1003 at ¶¶ 106-108; Ex. 27, IPR2020-00407 Pet. at 16; *id.* at 40-41.

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