

EXHIBIT O

**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

**REBUTTAL EXPERT REPORT OF CRAIG ROSENBERG, PH.D.
CONCERNING VALIDITY OF U.S. PATENT NOS. 6,748,317,
6,430,498, AND 6,580,999**

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A. Dr. Paradiso Has Failed to Prove Clearly and Convincingly That NavTalk in view of Maruyama Render Obvious Any of the Asserted Claims of the ’317/’999/’498 patents. 40

1. Dr. Paradiso Has Not Proven That the NavTalk (APL-MAXELL_P01) Device Referenced in His Report Was Actually Sold And/or Known in the United States Prior to July 12, 1999 and Was Sold with the User Manual Produced at APL-MAXELL_00713773 40

2. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Is A Portable Terminal With a Function of Walking Navigation..... 48

3. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [1(a)] “a device for getting location information denoting a present place of said portable terminal” 65

4. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim

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Element [1(b)] “a device for getting a direction information denoting an orientation of said portable terminal” 70

5. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [1(e)] of the ’317 Patent “said display displays positions of said destination and said present place, and a relation of said direction and a direction from said present place to said destination” 90

6. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [1(f)] of the ’317 Patent “said display changes according to a change of said direction of said portable terminal orientation for walking navigation” 93

7. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [15(a)] of the ’317 Patent “a device for retrieving a route from said present place to said destination” 95

8. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [15(b)] of the ’317 Patent “said display displays said route and displays a direction of movement by the arrow” 98

9. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [17(a)] of the ’317 Patent “wherein said display displays said route with a bent line using symbols denoting starting and ending points and displays symbols denoting said present place on said route” 98

10. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [1(d)] of the ’999 Patent “wherein a direction from said present place to the location of said another portable terminal is displayed with the distance information between said locations to supply route guidance information as said walking navigation information.” 102

11. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [3(a)] of the ’999 Patent “wherein said direction from said present place to the location of said another portable terminal is displayed using the symbols denoting the said present location and said location of another portable terminal” 103

12. Dr. Paradiso Has Not Shown by Clear and Convincing Evidence That the Garmin NavTalk Device in view of Maruyama Renders Obvious Claim Element [1(c)] of the ’498 Patent “wherein a direction and a distance of a destination from said present place are denoted with an orientation and a length of a line that is distinguished between starting and ending points to

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650. Accordingly, secondary considerations further support that the claims at issue here are not obvious.

F. Additional Potential Grounds

651. It is my understanding that Apple was required to elect a certain number of prior art reference and combinations to for its invalidity case and elected the following grounds:

The '317, '498, and '999 Patents:

1. The CyberGuide system (“CyberGuide”)¹ in combination with U.S. Patent No. 6,067,502 to Hayashida et al. (“Hayashida”).
2. Hayashida in combination with Japanese Patent Publication No. JPH10-197277 to Maruyama et al. (“Maruyama”)².
3. The Garmin NavTalk system (“NavTalk”) in combination with Hayashida.
4. NavTalk in combination with Maruyama.

Apple’s Final Election of Prior Art, April 7, 2020

652. Dr. Paradiso has presented these grounds and I have addressed/rebutted each one of these grounds. Nevertheless, Dr. Paradiso also states in his report that “all of the Asserted Claims of the Asserted Patents are invalid as being either anticipated, or rendered obvious by the prior art references, in combination with the knowledge of one of ordinary skill, as discussed below in this Report.” Paradiso Inv. Rep. ¶27. It is my understanding that Dr. Paradiso is not allowed to and/or has not set forth any invalidity grounds based on anticipation.

653. Nevertheless, to the extent Dr. Paradiso asserts that any of the prior art anticipates a particular claim, it is my opinion that this prior art will not anticipate the claims or the same reasons as noted above with respect to non-obviousness.

654. Further, to the extent that Dr. Paradiso relies on Maruyama as an anticipation reference as or as a preliminary reference, I note that Maruyama also has significant deficiencies as note about and would not anticipate and/or render obvious the asserted claims for the '317/'999/'498 patents for the reasons discussed above.

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