

**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 MOTION FOR
PARTIAL SUMMARY JUDGMENT OF SUBJECT MATTER INELIGIBILITY
UNDER 35 U.S.C. § 101 FOR U.S. PATENT NOS. 6,928,306 AND 6,329,794**

Simply applying an abstract idea to a generic, physical device does not make the idea patentable. Indeed, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l* expressly held “that a computer ‘necessarily exist[s] in the physical, rather than purely conceptual, realm,’ . . . is beside the point.” 573 U.S. 208, 223-24 (2014). Maxell does not dispute at *Alice* step one that the ’306 Patent’s claims are performed using “general-purpose computer equipment,” and similarly that the ’794 Patent merely invokes generic devices. At *Alice* step two, unable to cite anything in the patents or even its own experts to support an inventive concept, Maxell instead resorts to conclusory attorney arguments that fail to create a genuine dispute of material fact. Because the ’306 and ’794 Patents’ claims fail both steps of *Alice*, they are invalid under § 101.

I. The ’306 Patent Is Directed To An Abstract Idea, Not Improving Computers

At *Alice* step one, Maxell articulates that the ’306 Patent is directed to using “multiple sound sources or sound generation protocols” “to generate the ringing sound.” Opp. at 3-6, 8-11. But this is simply the abstract idea of combining sounds from two or more sources (i.e., “multiple sound sources” or “protocols”) to convey a signal (i.e., “the ringing sound”). Mot. at 7.

Simply applying the ’306 Patent’s abstract idea to a generic computer device does not transform the idea into a patent-eligible improvement. Maxell concedes that “the claims can be performed using general-purpose computer equipment,” but argues that this deficiency is “of no moment” to the question of patentability. Opp. at 6. But an abstract idea is not made patentable by virtue of tying it to a physical device or component. To the contrary, the Federal Circuit has repeatedly held that the invocation of “off-the-shelf, conventional computer” devices is “not even arguably inventive.” *Elec. Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016). Further, none of the recited components are limited to specific structures and thus the claims are not directed to improved hardware. See D.I. 235 at 28 (rejecting means-plus-function constructions limiting term to specific structures). Rather, the “controller” and “ringing sound

generator” limitations have their plain meanings that specify only what functions these components perform, but do not define any new or improved structure, either individually or in combination. Accordingly, the claims’ invocation of “general-purpose computer equipment” fails to disclose an improvement to computer capabilities. For the same reasons, Maxell’s citation to *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303 (Fed. Cir. 2020) is inapposite. Opp. at 6-7. There, the Federal Circuit found that claims enabling reduced latency disclosed a technological improvement. 957 F.3d at 1307. No such technological improvement exists here.

Indeed, Maxell fails to identify any technological improvement imparted by the claims. Its argument that the patent discloses an improvement because it uses “multiple” sound sources or protocols to generate a ringing sound, instead of one, only supports Apple’s position. See Opp. at 3-6, 8-11. First, the argument simply rephrases the abstract idea of combining sounds from two or more sources to convey a signal. Second, it is undisputed that the sound sources or protocols contemplated by the patent (e.g., FM, PCM, MIDI, and MP3) were already known. Third, Maxell concedes that generating a sound using a single sound source or protocol was also known. *Id.* at 4, 10. Thus, using at least two—instead of one—sound sources or protocols to generate a sound simply uses known technology to carry out an abstract idea; it does not advance the technology.

Maxell also argues that the patent eliminates the need for increased memory capacity. *Id.* at 3-4, 6, 10. But as Maxell concedes, the patent’s solution is to mix multiple sound sources or protocols to generate a ringing sound, rather than pre-recording and storing that sound. *Id.* at 10. Thus, the alleged benefit of not needing to store sounds arises not from any technological improvement, but “flow[s] from performing an abstract idea”—generating a sound using two or more sources. *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1288 (Fed. Cir. 2018).

II. The ’306 Patent Does Not Disclose An Inventive Concept

At *Alice* step two, Maxell advances nothing more than unsupported attorney arguments

that fail to create a genuine dispute of material fact. Maxell summarily concludes that the patent’s use of multiple “sound sources” implements “a technological solution.” Opp. at 11. But Maxell’s alleged solution is simply an application of the patent’s abstract idea—combining sounds from two or more sources to convey a signal—to generic mobile devices. *Id.* This is insufficient to qualify as an inventive concept. *See BSG Tech*, 899 F.3d at 1290-91 (“[i]f a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea”). Indeed, as Maxell’s own expert conceded, the claims simply “tak[e] the known methods for generating ringing sound[s] and combin[e] them.” D.I. 360, Ex. Q at 25:23-26:1, 185:7-14, 186:16-187:14.

Similarly, Maxell argues that the patent discloses an “inventive concept” by reducing the space required for storing sound. Opp. at 10. But the fact that a ringing sound “is generated when the signal comes in as opposed to being stored” is not inventive, as the specification admits that the generation of sounds without storage was already known in the prior art. *See* ’306 at 1:12-60; *see also* D.I. 360, Ex. C at 15:1-64 (describing a prior art device that generated a signal upon an incoming call by combining a telephone’s ringer and a caller’s self-announcement); Ex. D at 9:12-28, 17:1-12, 17:34-18:5, 18:7-31. Thus, the ’306 Patent fails to disclose an inventive concept.

III. The ’794 Patent Is Directed To An Abstract Idea Without A Specific Solution

At *Alice* step one, Maxell contends that the ’794 Patent “assign[s] different priorities to the function devices within the information processing device [] and control[s] the individual operation of the function devices based on remaining battery capacity.” Opp. at 12-13. But that characterization is simply a rephrasing of the abstract idea of prioritizing tasks (i.e., “function devices”) for allocation of resources (i.e., “battery capacity”) in a battery-operable device.

Maxell’s generic, vague assertion that the claims provide “an improvement” “that plainly allow it to do things it could not do before” fails. Opp. at 12. This assertion skirts what the ’794

Patent is about: using generic, functional devices to automate what was previously performed by a human—i.e., “stopping function devices with low priorities first based on the remaining capacity in the battery.” ’794 at 1:59-63, 1:39-41. Neither the specification nor the claims disclose any specific implementation details for *how* this automation is achieved, and Maxell cites to none. Instead, Claims 1 and 14 simply recite generic, functional components—e.g., “a battery [for] supplying power,” “a capacity detector for detecting remaining [battery] capacity,” and “a controller” for “controlling operation” of function devices. Simply invoking generic devices as tools to carry out an abstract idea is not “inventive.” *BSG Tech*, 899 F.3d at 1290-91.

Maxell also fails to support its assertion that the use of a “capacity detector” provides a technological improvement. Opp. at 13. Again, simply pointing to a physical component is insufficient to transform an abstract idea into a patentable invention. Maxell cannot explain what is unique or inventive about a “capacity detector.” Indeed, during *Markman*, Maxell’s expert Dr. Brogioli admitted that the recited “capacity detector” can be implemented using generic, off-the-shelf “Battery Management IC” chips from known vendors. D.I. 235 at 22-23; D.I. 136, Ex. 1 at ¶ 32. Further, Dr. Brogioli also admitted that combining a “capacity detector,” a “controller,” and software is not inventive, but is well known to those skilled in the art. In his *Markman* declaration, Dr. Brogioli stated that “[a] person of ordinary skill in the art . . . would have understood how to integrate software into a ‘capacity detector’ for detecting the remaining capacity of a battery,” and would have known how to connect such a component to a “commercially available” “microcontroller” for controlling the claimed operation. D.I. 136, Ex. 1 at ¶ 33. Likewise, the patent’s inventor admitted that the patent is “not limited to [any] specific devices.” D.I. 360, Ex. K at 82:1-7. Thus, there can be no dispute that the claimed “capacity detector,” whether individually or combined with other recited claim elements, fails to provide a technological

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