PUBLIC VERSION

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD., *Plaintiff*, v. APPLE INC., *Defendants*.	Civil Action No. 5:19-cv-00036 **JURY TRIAL DEMANDED** PUBLIC VERSION

MAXELL, LTD.'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF NO INVALIDITY UNDER 35 U.S.C. §§ 102 AND 103 OF CLAIMS 7, 16, AND 17 OF U.S. PATENT NO. 10,212,586

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Apple's opposition brief (Dkt. 427, "Opp.") to Maxell's motion for summary judgment of no invalidity of the asserted claims of U.S. Patent No. 10,212,586 (Dkt. 366, "Mot.") attempts to distract the Court from the simple conclusion that the "memory" limitations **as claimed** are simply not present in Schiffer. Apple attempts to salvage its obviousness case by pointing to a hodgepodge of citations to Dr. Menascé's report and alleging that Maxell "mischaracterize[ed]" Dr. Menascé's opinions. Maxell did nothing of the sort. Rather, Dr. Menascé's only statement of obviousness as to the memory limitations for Schiffer alone is boilerplate and unsupported. Further, Apple's reliance on Kirkup to allegedly fill in the gaps fails because neither Apple nor Dr. Menascé demonstrate how Kirkup discloses the memory limitation as claimed—at best, Kirkup is redundant to Schiffer. Because neither primary art reference discloses the "memory" limitations, no reasonable jury could conclude that Apple's prior art anticipates or rendered obvious the asserted claims. Accordingly, the Court should grant Maxell's Motion.[1]

I. ARGUMENT

A. There Are No Genuine Disputes of Material Fact Regarding Anticipation.

To concoct disputes of fact where none exist, Apple ignores the plain language of the claims and asserts that "information about" can mean essentially anything to fit its invalidity theories, contradicting its own expert in the process. *See* Opp. at 8-9.

Apple states that "Dr. Menascé explains that [redacted]." Opp. at 9; *see id.* at 8 (claiming Maxell is wrong for "apparently assuming that information 'about' the mobile phone cannot also be about the computer"). But

[1] Granting Maxell's "Motion" does not "eliminate Apple's invalidity case" (Opp. at 1)—Apple is free to make its written description arguments against the '586 Patent. *See* Dkt. 444 at 3.

merely because information about the first mobile terminal—in Schiffer's case, the "access code"—may be located on the second mobile terminal does not mean the information is "about" the second mobile terminal. The information is "about" the first mobile terminal, not the second, and the claims require that the information be "about" not "at" a second mobile terminal.

Schiffer is clear that the access code may be one of two things: (1) "subscriber identity number" of the mobile phone (*i.e.*, first terminal); or (2) an alternate value that may be encrypted using all or some portion of the subscriber identity value. Mot. at Ex. 2, App. D at 9. Neither the subscriber identity value nor the alternate value disclosures of Schiffer, including the "other security code," provide any evidence that these values are "information about an another mobile terminal," *i.e.*, computer system 110. *See generally* Mot. at 5-7. As such, none of the disclosure of Schiffer or Dr. Menascé's opinions present any factual dispute that would lead a POSITA to believe that the "access code" is "information about an another mobile terminal," *i.e.*, computer system 110 as the claims require.[2] *See Scripps Clinic v. Genentech, Inc.*, 927 F.2d 1565, 1576-77 (Fed. Cir. 1991) (the purpose of extrinsic evidence in an anticipation analysis "is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference.").

Moreover, Apple's malleable interpretation—and rewriting—of the claims is contrary to Dr. Menascé's interpretation in his non-infringement report: "[T]o show infringement, I understand that Maxell must show that [redacted]

[2] Apple's reliance on *Medical Instrumentation*, for example, is inapposite. Opp. at 7-8. There, the Federal Circuit reversed the district court and noted that the reference at issue was found to be "'ambiguous,' which suggests to us that the issue of exactly what the reference teaches is something that should have been resolved by the jury." *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221 (Fed. Cir. 2003). But Schiffer's disclosure is not ambiguous—it does not disclose the memory limitation as claimed, despite Apple's attempted rewriting of the claim language.

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