

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

DECLARATION OF LUANN L. SIMMONS IN SUPPORT OF
APPLE INC.'S RENEWED MOTION TO STAY PENDING DETERMINATION OF
INTER PARTES REVIEW OF THE PATENTS-IN-SUIT

I, Luann L. Simmons, hereby declare as follows:

1. I am an attorney at the law firm of O'Melveny & Myers LLP, counsel for Defendant Apple, Inc. ("Apple") in this matter filed by Plaintiff Maxell, Ltd. ("Maxell"). I have personal knowledge of the facts stated herein and if called to testify could and would competently testify thereto.

2. Attached as **Exhibit A** is a true and correct copy of the United States Patent Office's Patent Trial and Appeal Board Statistics, which contains data valid as of June 30, 2020. This document was retrieved from the USPTO's website (https://www.uspto.gov/sites/default/files/documents/Trial_Statistics_20200630_.pdf) on August 3, 2020.

3. Attached as **Exhibit B** is a true and correct copy of Lex Machina's Patent Trial and Appeal Board Statistics for trials listing Apple Inc. as the Petitioner, which contains data

valid as of August 3, 2020. This document was retrieved from Lex Machina's website on August 3, 2020.

4. Attached as **Exhibit C** is a true and correct copy of Lex Machina's Patent Trial and Appeal Board Statistics for trials listing Erise IP, PA as counsel for the Petitioner, which contains data valid as of August 3, 2020. This document was retrieved from Lex Machina's website on August 3, 2020.

5. Attached as **Exhibit D** is a true and correct copy of an excerpt from the Rebuttal Expert Report of Branimir Vojcic, Ph.D. Concerning Validity of U.S. Patent No. 6,408,193, dated June 4, 2020.

6. Attached as **Exhibit E** is a true and correct copy of the Decision Granting Institution of *Inter Partes* review for U.S. Patent No. 6,928,306 (IPR2020-00204), dated June 19, 2020.

7. Attached as **Exhibit F** is a true and correct copy of the Decision Granting Institution of *Inter Partes* review for U.S. Patent No. 6,329,794 (IPR2020-00199), dated June 19, 2020.

8. Attached as **Exhibit G** is a true and correct copy of the Decision Granting Institution of *Inter Partes* review for U.S. Patent No. 10,084,991 (IPR2020-00200), dated July 15, 2020.

9. Attached as **Exhibit H** is a true and correct copy of the Decision Granting Institution of *Inter Partes* review for U.S. Patent No. 10,212,586 (IPR2020-00202), dated July 15, 2020.

10. Attached as **Exhibit I** is a true and correct copy of Maxell's Final Election of Asserted Claims, dated March 17, 2020.

11. Attached as **Exhibit J** is a true and correct copy of Plaintiff Maxell, Ltd.'s Identification of Trial Witnesses, dated June 25, 2020.

12. Attached as **Exhibit K** is a true and correct copy of Apple Inc.'s Trial Witness List, dated June 25, 2020.

13. Attached as **Exhibit L** is a true and correct copy of Plaintiff Maxell, Ltd.'s Identification of Rebuttal Trial Witnesses, dated July 2, 2020.

14. Five of the 10 Patents-in-Suit—the '193, '493, '317, '999, and '498 Patents—have already expired. The '794 Patent will expire on September 7, 2020.

15. On June 12, 2019, Maxell served its Infringement Contentions, in which it asserted a total of 90 claims from the 10 Patents-in-Suit.

16. The parties and the Court agreed in the Court's Focusing Order that 90 claims, particularly given the wide range of technologies reflected in those claims, created far too broad of a scope for this case and both parties would need to narrow it by reducing asserted claims and prior art.

17. Apple, nonetheless, promptly began searching for and evaluating prior art for all 90 claims, and, within seven months, finished searching for and analyzing thousands of prior art references for each of the 90 claims at issue; prepared invalidity contentions, including 63 claim charts mapping prior art to asserted claims; coordinated with technical experts; and drafted and filed nine IPR petitions.

18. On November 6, 2019, Maxell made its Preliminary Election of Asserted Claims, reducing the number of asserted claims to 40.

19. Maxell's November 2019 narrowing dropped claims that recited several unique limitations, allowing Apple to narrow its search and analysis to only those claims still at issue.

20. On March 17, 2020, Maxell made its Final Election of Asserted Claims, reducing the number of asserted claims to 20.

21. Apple filed IPR2020-00199, challenging the validity of claims 1-3 and 5-14 of U.S. Patent No. 6,329,794, on December 19, 2019. The PTAB found that the challenged claims are reasonably likely to be unpatentable and instituted *inter partes* review on June 19, 2020.

22. Apple filed IPR2020-00204, challenging the validity of claims 2, 5, 6, and 12-15 of U.S. Patent No. 6,928,306, on December 20, 2019. The PTAB found that the challenged claims are reasonably likely to be unpatentable and instituted *inter partes* review on June 19, 2020.

23. Apple filed IPR2020-00201, challenging the validity of claims 1-7 of U.S. Patent No. 7,116,438, on December 19, 2019, and the PTAB denied institution on June 19, 2020.

24. Apple filed IPR2020-00203, challenging the validity of claims 1, 6, and 7 of U.S. Patent No. 6,408,193, on December 20, 2019, and the PTAB denied institution on July 6, 2020.

25. Apple filed IPR2020-00200, challenging the validity of claims 1-5 and 8-12 of U.S. Patent No. 10,084,991, on December 19, 2019. The PTAB found that the challenged claims are reasonably likely to be unpatentable and instituted *inter partes* review on July 15, 2020.

26. Apple filed IPR2020-00202, challenging the validity of claims 1-2, 6-7, 9-10, 13-14, and 16-18 of U.S. Patent No. 10,212,586, on December 19, 2019. The PTAB found that the challenged claims are reasonably likely to be unpatentable and instituted *inter partes* review on July 15, 2020.

27. Apple filed IPR2020-00407, -00408, and -00409 challenging the validity of the related '317, '498, and '999 Patents on January 13, 2020.

28. Apple filed IPR2020-00407, challenging the validity of claims 1-3, 5, 10-15, 17, and 18 of U.S. Patent No. 6,748,317, on January 13, 2020, and the PTAB's institution decision is due by August 12, 2020.

29. Apple filed IPR2020-00408, challenging the validity of claims 1, 3-5, 7-11, and 13 of U.S. Patent No. 6,430,498, on January 13, 2020, and the PTAB's institution decision is due by August 12, 2020.

30. Apple filed IPR2020-00409, challenging the validity of claims 1-6 of U.S. Patent No. 6,580,999, on January 13, 2020, and the PTAB's institution decision is due by August 12, 2020.

31. Apple filed IPR2020-00507, challenging the validity of claims 1, 3-6, and 10-11 of U.S. Patent No. 8,339,493, on March 17, 2020, and the PTAB's institution decision is due by September 25, 2020.

32. Apple's final petition, filed March 17, 2020, involved unique third-party discovery issues that required additional time to resolve.

I declare under the penalty of perjury that the foregoing is true and correct.

Executed in San Francisco, California, on this 3rd day of August, 2020.

/s/ Luann L. Simmons
Luann L. Simmons