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**

APPLE INC.'S SUR-REPLY IN OPPOSITION TO MAXELL, LTD.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NO INVALIDITY OF U.S. PATENT NOS. 6,748,317, 6,580,999, AND 6,430,498 IN VIEW OF ABOWD AND CYBERGUIDE

Apple's opposition presents substantial evidence to support the public availability of the Abowd article and related Cyberguide system before the July 12, 1999 critical date. For Abowd, Apple cites library "MARC" records and supporting testimony from Apple's librarian expert Mr. Jacob Munford, to show that Abowd was publicly available at the University of Pittsburgh library by October 1997. Opp. at 3-5, 7-8. For Cyberguide, as described in the related Abowd article, prototypes practicing the asserted patents' claimed features were presented at open houses at Georgia Tech in 1996. *Id*. at 5, 11-12. In its reply, Maxell confirms that its motion rests merely on "doubts about Apple's evidence." Reply at 1. But Maxell's "doubts" do not support summary judgment; rather, they only confirm the presence of fact disputes that preclude it.

Indeed, in challenging the public availability of Abowd, Maxell relies on unsupported and false speculation that a library holding with a "Do Not Circulate" label is secret, and that accessibility by hundreds of thousands of individuals affiliated with the University of Pittsburgh is insufficient to show public availability. But as public webpages cited in Apple's opposition explain, "Do Not Circulate" merely denotes a library holding that cannot be used *outside* the library, and accessibility by at least anyone affiliated with the University of Pittsburgh is sufficient for public availability. Maxell's objection to the webpages as not produced earlier in discovery is unavailing. Courts permit non-moving parties to cite webpages to respond to arguments raised by a moving party's summary judgment motion.

Third, for the Cyberguide system, Maxell's contention that prototypes are not prior art because they were not "fully developed" before the critical date and later improved misapprehends the legal requirements for public use. And Maxell's complaints that there are insufficient "details" about each prototype's technical features and the extent of their public use merely present fact disputes. For these reasons, the Court should deny Maxell's motion.

I. Abowd's Public Availability Is Supported By Expert Opinion And Library Records

As Apple's librarian expert Mr. Munford explained, the best indicator of when a library holding first becomes publicly available is the date in its "MARC" record. Opp. at 8. For the *Wireless Networks* journal in which Abowd was published, the University of Pittsburgh library's MARC record shows the library began cataloguing issues of the journal on April 3, 1995. From then on, the library would have received each issue of *Wireless Networks* as of the date of its publication, including the October 1997 issue in which Abowd was included. *Id*.

Maxell's reply mischaracterizes Apple's statements about the MARC record as "attorney argument." Reply at 2-3. In truth, Apple's statements follow directly from the opinions of Mr. Munford which is competent evidence, sufficient to defeat summary judgment. Opp. at 8 (citing Munford Report, Dkt. 429-3 at ¶¶10-15); *see Metaswitch Networks Ltd. v. Genband US LLC*, No. 2:14-cv-744-JRG, 2016 WL 943601, at *3 (E.D. Tex. Mar. 17, 2016) ("Summary judgment is rarely appropriate where an expert's opinion supports the non-movant"). Specifically, in his expert report, Mr. Munford explained that for periodicals like *Wireless Networks*, a date of April 3, 1995 in MARC field "008" means that the University of Pittsburgh library would have received all issues of that periodical after that date as they were published. Dkt. 429-3 at ¶13. Mr. Munford confirmed that his understanding of the typical library practice for periodicals applied specifically to the *Wireless Networks* journal at the University of Pittsburgh library using (1) the library's holdings information for *Wireless Networks*, which showed that the library held issues of the journal dated between 1996 to 2003, and (2) the book bindery sticker for the October 1997, Volume 3 issue of *Wireless Networks*, which has a January-March 1998 date range, meaning the library must have held that issue before that date range. *Id*.

Although Maxell and its putative expert Mr. Stoll—who has no background in library practices (*see* Dkt. 357)—disagree with Mr. Munford's expert opinions about what the MARC

record and book bindery sticker represent (Reply at 3-4), their disagreements constitute fact disputes that make summary judgment inappropriate. *See, e.g.*, *Candela Corp. v. Palomar Med. Techs., Inc*., No. 9:06-CV-277, 2008 WL 11441909, at *2 (E.D. Tex. Sept. 24, 2008) ("conflicting expert opinions are sufficient to make summary judgment inappropriate.").

II. Apple's Citation To Webpages To Rebut New Arguments Is Permissible

Maxell's motion injected baseless challenges to Abowd, suggesting that a "Do Not Circulate" label on a copy of Abowd meant it was a non-public library holding and that accessibility by at least anyone affiliated with the University of Pittsburgh is insufficient to show public availability under § 102. Opp. at 9-11. To refute Maxell's challenges, Apple's opposition cited public webpages for the basic, non-controversial facts that "Do Not Circulate" denotes a library holding that cannot be used outside of a library, but can still be accessed inside the library, and that the University of Pittsburgh has about 400,000 students, faculty, and alumni. *See* Dkt. 429-5, 429-6, 429-13, 429-14, 429-15. Maxell asks the Court to disregard the webpages as untimely and inadmissible because Apple did not produce them during discovery. Reply at 1-2.

Maxell's request finds no legal basis and its cited cases provide none. *Advanceme, Inc. v. Rapidpay* is inapposite. There, a court denied a defendant's motion to supplement the record with documents about a prior art reference just weeks before trial. No. 6:05-CV-424, 2007 U.S. Dist. LEXIS 117675, at *12-13 (E.D. Tex. July 9, 2007). Similarly, in *Cummins-Allison Corp. v. Glory Ltd*., a court denied a defendant's attempt to rely on late-produced technical documents about its own accused products to support non-infringement. No. 2:03-CV-358, 2006 U.S. Dist. LEXIS 105083, at *5 (E.D. Tex. Jan. 23, 2006). And in *Intergraph Corp. v. Intel Corp.*, a court denied a defendant's motion to amend its invalidity contentions. No. 2:01-cv-160, 2002 U.S. Dist. LEXIS 29660, at *2 (E.D. Tex. June 18, 2002). None of Maxell's cases even relate to the context of

summary judgment and each involved a defendant attempting to supplement the record with late-produced documents to support substantive non-infringement or invalidity defenses.

Apple is doing no such thing here. Rather, Apple cited public webpages to rebut new and frivolous arguments that Maxell made in its summary judgment motion regarding "Do Not Circulate" and the University of Pittsburgh. Opp. at 9-11. Courts permit parties opposing summary judgment to cite public webpages and other evidence in responding to arguments injected by the movant's motion. *Mobile Telecommunications Techs., LLC v. United Parcel Serv., Inc.*, No. 1:12-cv-03222-AT, 2015 WL 11199065, at *3-4 (N.D. Ga. Mar. 25, 2015) (permitting non-moving party to cite a "website" and other un-produced documents to respond to issues "first put into dispute in [a party's] MSJ"); *Alford v. Access Indus., Inc.*, No. 1:15-CV-59, 2016 WL 3460775, at *8 (E.D. Tex. Feb. 8, 2016). Moreover, Maxell raised these arguments for the first time in its rebuttal expert reports, and did not ask Apple experts about them in deposition before reiterating those arguments in its summary judgment motion. Apple thus had no opportunity or reason to cite the webpages before its opposition brief. And critically, Maxell does not contest the webpages' authenticity or the veracity of their statements. Reply at 1-2. Thus, the five webpages are admissible evidence that should be considered in support of Apple's opposition.

III. Maxell's Attacks Against Cyberguide Are Legally And Factually Flawed

As discussed in Apple's opposition, Cyberguide is prior art because functioning prototypes of the system were used by visitors at open houses at Georgia Tech's GVU center by 1996. Opp. at 11-12. Maxell's reply fails to show otherwise. It instead simply reiterates the flawed arguments from Maxell's motion that: (1) Cyberguide prototypes used at the open houses cannot be prior art because they were not "fully developed" before the critical date and Cyberguide was "later-improved"; and (2) there are insufficient "details as to the nature of the public access" at the GVU open houses. Reply at 5. Neither of Maxell's arguments have merit or support summary judgment.

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