

**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 NAVTALK**

Apple's opposition presented substantial evidence demonstrating that NavTalk was sold before the July 12, 1999 critical date and that the example unit of NavTalk that Apple produced as APL-MAXELL_P01 is a representative specimen of units sold before that date. Maxell's reply arguments about the sale date of just APL-MAXELL_P01 itself are irrelevant because the asserted prior art reference is NavTalk, not APL-MAXELL_P01 alone. And Maxell's doubts about APL-MAXELL_P01's features versus those of other NavTalk units ignore the testimony of former Garmin engineer Mr. Kent Broddle and tests performed by both parties' experts. Even if credited, Maxell's doubts present fact disputes precluding, not supporting, summary judgment. Maxell's remaining arguments—that Apple's evidence is “unreliable” or “inconclusive”—similarly evince fact disputes that preclude summary judgment. Further, Maxell's arguments hinge on its continued disregard for much of the record, including contemporaneous news articles from January to March 1999 describing ongoing sales of NavTalk. Maxell's motion should be denied.

I. Apple's Sample NavTalk Unit Is Representative Of Units Sold Before July 12, 1999

In its opposition, Apple explained that the asserted prior art reference is the NavTalk product, many hundreds of which were sold before the July 12, 1999 critical date, thereby qualifying NavTalk as prior art under § 102(a). Opp. at 9-12. The example unit produced as APL-MAXELL_P01 is not itself the asserted prior art reference—rather, it is one piece of evidence that demonstrates the features of NavTalk. Avoiding the merits of this evidence, Maxell's reply doubles down on its motion's approach of arguing against APL-MAXELL_P01. But even crediting Maxell's arguments, they amount to nothing more than putative fact disputes about whether APL-MAXELL_P01 is representative of NavTalk units sold before the critical date. *Id.*

Maxell's arguments fail in any event because the record shows that APL-MAXELL_P01 is representative in all material respects of NavTalk units sold before July 1999. For example, Maxell argues that APL-MAXELL_P01 has a “1999-2000” copyright date for its software,

implying that the software changed after 1999. Reply at 2. But Mr. Broddle explained that any software updates for NavTalk were to “fix bugs” or “errors” and “the functionality did not change at all.” Dkt. 428-4 at 274:19-276:11. Thus, the “initial software release” in “early 1999” reflected the features of later NavTalk units and the features described in the NavTalk User Manual. *Id.*

Notwithstanding the undisputed fact that Mr. Broddle wrote software for NavTalk, *id.* at 18:21-22:2, 24:4-13, Maxell argues his testimony that NavTalk’s software changes were not “substantial” is vague and “not corroborated” by other evidence. Reply at 1-2. To the contrary, Mr. Broddle’s testimony regarding software updates was clear on its face—“There’s no substantive functionality change. It would be to correct minor errors and minor features.” Dkt. 428-4 at 275:11-23. And the record is replete with corroborating evidence, including from Maxell’s own expert Dr. Rosenberg. Dr. Rosenberg tested the copy produced as APL-MAXELL_P01 and described those tests as “confirm[ing]” the features of NavTalk as described in the NavTalk User Manual and Mr. Broddle’s testimony. Dkt. 428-12 at ¶¶221-222, 268, 367, 386. Dr. Rosenberg identified no inconsistencies between APL-MAXELL_P01’s features in his tests versus the features described in other evidence. In addition, a copy of the NavTalk User Manual that came with APL-MAXELL_P01 has the same part number (“190-00147-00 Rev. A”) and “January 1999” copyright date as the manual that Garmin approved for public release in February 1999, according to Garmin’s records and Mr. Broddle’s testimony. Dkt. 428-7; Dkt. 428-2 at GARMIN_000001 (¶5), GARMIN_000006; Dkt. 428-4 at 128:10-129:11, 132:2-7. In view of the substantial evidence that APL-MAXELL_P01 is representative of NavTalk units sold before July 1999 and that qualify as prior art under § 102(a), Maxell’s reply—at best—does no more than raises fact disputes that preclude summary judgment.

Finally, there is no relevance to Maxell's new argument that 35 U.S.C. § 102(b) requires sales "more than one year" before the priority date, which would be July 12, 1998. Reply at 1 n.1. Apple is asserting NavTalk as prior art under § 102(a)—which has no one-year bar—because NavTalk was sold in the U.S. before July 12, 1999, meaning that it was "known or used by others" in the U.S. before that date. Maxell's attempt to shift the critical date one year earlier implicitly concedes that NavTalk predates July 12, 1999, and therefore qualifies as prior art under § 102(a).

II. Maxell's Attacks On Mr. Ayres's Credibility Cannot Support Summary Judgment

As detailed in Apple's opposition, Garmin in-house attorney, Mr. David Ayres, provided sworn testimony regarding NavTalk's public availability by March 1999 and supported his statements with six exhibits, including specification control drawings, a sales record, and a press release. Dkt. 428-2 and 428-3; GARMIN_000001-148 (Exhibits 1 to 6). Maxell's reply tries to recast its motion's criticisms of Mr. Ayres, but its criticisms boil down to just attacking his credibility, while identifying nothing actually wrong with Mr. Ayres's statements.

Although Maxell does not dispute that at summary judgment, "a court must . . . avoid credibility determinations and weighing of the evidence," Maxell asserts that it is not making "a general attack on [the] credibility' of Mr. Ayres." Reply at 3; *Domain Prot., LLC v. Sea Wasp, LLC*, 426 F. Supp. 3d 355, 370 (E.D. Tex. 2019). But Maxell's actual arguments belie its assertion. Maxell argues that Mr. Ayres's declaration is "unreliable" because it appears copied from a prior declaration and is not based on his "personal knowledge," and that Mr. Ayres's sworn statement that his declaration is "based on his review of Garmin's company records" cannot be trusted. Reply at 3-4. In effect, Maxell is asking the Court to find that Mr. Ayres is either not sufficiently knowledgeable to make the statements in his declaration, or, worse, lying about his review of Garmin records. Dkt. 428-2 at GARMIN_000001 (¶2). In either case, Maxell is asking the Court to make a credibility determination, which is not permitted at summary judgment.

Moreover, while disparaging Mr. Ayres, Maxell does not actually contest the truth of any statement in his declaration concerning NavTalk. Nor could it, as every statement in the declaration is based on an attached exhibit from Garmin's company records (as Mr. Ayres states in his declaration) and was also independently verified by Mr. Broddle in his deposition. Dkt. 428-2 and 428-3 at GARMIN_000001-5 (¶¶5-10); GARMIN_000005-148 (Exhibits 1 to 6); Dkt. 428-4 at 128:10-129:11, 132:2-7, 146:10-148:25. Indeed, Maxell's lone attack against the substance of the declaration is not against any statement by Mr. Ayres; instead, Maxell merely notes as curious the "10/09/13" date that appears on the cover of the Exhibit 5 sales record for NavTalk shipments in March 1999. Reply at 3; Dkt. 428-3 at GARMIN_0000146. But Maxell does not articulate any reason for why the "10/09/13" date makes the sales record unreliable. And both Mr. Ayres and Mr. Broddle confirmed that Exhibit 5 is a true and correct copy of a Garmin sales record for NavTalk in March 1999. Dkt. 428-2 at GARMIN_0000003 (¶9); Dkt. 428-4 at 145:17-148:25. Any lingering questions Maxell has about that date only raise fact disputes that should be decided at trial, not at summary judgment.

III. Maxell's Assertion Of "Inconclusive" Evidence Warrants Denying Summary Judgment And Ignores Large Parts Of the Record

Apple's opposition presents several pieces of documentary evidence—news articles, copies of the NavTalk User Manual, and the exhibits attached to Mr. Ayres's declaration—supporting NavTalk's public availability before July 12, 1999. Opp. at 7-9. In its reply, Maxell characterizes Apple's documentary evidence as "inconclusive" because it is not "contemporaneous evidence." Reply at 4-5. Even if Apple's evidence were "inconclusive," that would merely confirm the presence of fact disputes making summary judgment inappropriate.

At any rate, Maxell's characterization of Apple's evidence as not "contemporaneous" is simply false and hinges on Maxell's continuing refusal to acknowledge substantial parts of the

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.