

PUBLIC VERSION

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

MAXELL, LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 5:19-cv-00036-RWS

JURY TRIAL DEMANDED

PUBLIC VERSION

**MAXELL, LTD.'S SUR-REPLY TO APPLE INC.'S MOTION FOR PARTIAL
SUMMARY JUDGMENT LIMITING MAXELL'S CLAIM FOR DAMAGES FOR
THE '999, '498, '493, AND '317 PATENTS UNDER 35 U.S.C. § 287(a) AND FOR
NO ENHANCED DAMAGES UNDER 35 U.S.C. § 284**

PUBLIC VERSION

TABLE OF CONTENTS

I.	GENUINE ISSUES OF MATERIAL FACT REMAIN REGARDING ACTUAL NOTICE.....	1
II.	GENUINE ISSUES OF MATERIAL FACT REMAIN AS TO ENHANCED DAMAGES.....	3
A.	Apple’s Motion for No Enhanced Damages is Not Ripe.....	3
B.	Apple’s Conduct Favors an Enhanced Damages Award	4

PUBLIC VERSION

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Amsted Indus. Inc. v. Buckeye Steel Castings Co.</i> , 24 F.3d 178 (Fed. Cir. 1994).....	1
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	3
<i>Gart v. Logitech</i> , 254 F.3d 1334 (Fed. Cir. 2001).....	1, 2, 3
<i>Massachusetts Institute of Technology v. Abacus Software, Inc.</i> , No. 5:01-cv-344, 2004 WL 5268125 (E.D. Tex. Sept. 29, 2004).....	1
<i>Meridian Manufacturing, Inc. v. C & B Manufacturing, Inc.</i> , 340 F.Supp.3d 808 (N.D. Iowa 2018).....	5
<i>SRI Int’l, Inc. v. Advanced Tech. Labs., Inc.</i> , 127 F.3d 1462 (Fed. Cir. 1997).....	2
<i>WesternGeco L.L.C. v. ION Geophysical Corp.</i> , 837 F.3d 1358 (Fed. Cir. 2016).....	4

..

PUBLIC VERSION

Genuine issues of material fact exist here. Apple cannot establish otherwise through unsupported say-so or by ignoring the facts themselves. But that is plainly Apple's strategy—even to the point of deliberately quoting the wrong part of a document, when the right part of the document is harmful to Apple's position. When the facts are measured against the law and viewed in the light most favorable to Maxell—as they must be here—there is no question that genuine disputes as to material facts remain.

I. Genuine Issues of Material Fact Remain Regarding Actual Notice

Apple again suggests that a party must explicitly allege infringement for actual notice to be found. Apple ignores the law. As Maxell showed in its Opposition, courts have held that an offer to license can be deemed actual notice because “[t]he whole point of offering a license is to insulate a licensee from infringement charges by the licensor.” *Gart v. Logitech*, 254 F.3d 1334, 1346 (Fed. Cir. 2001). The June 2013 letter [REDACTED]

[REDACTED] Ex. C (AM00712194). In other words, Maxell's predecessor [REDACTED]

[REDACTED] than the letters at issue in the cases Apple cited, which merely provided notice of ownership of the patents and, at most, invited the letter recipient to review the patent(s) to gauge any potential interest in a license which the patentee was willing to make available. *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 186-87 (Fed. Cir. 1994); *Massachusetts Institute of Technology v. Abacus Software, Inc.*, No. 5:01-cv-344, 2004 WL 5268125, at *2 (E.D. Tex. Sept. 29, 2004). Here, the infringement assertion is clear enough from the fact that [REDACTED]

This can mean nothing other than: Apple is infringing these patents and needs to take a license.

PUBLIC VERSION

Apple's attempt to distinguish Maxell's cited case law by asserting that *Gart*, for example, found actual infringement where the need for a license was *combined* with additional infringement allegations (Reply at 2), fails as such a combination is also present here. As Maxell explained in detail, the June 2013 materials [REDACTED]

[REDACTED]. Opp. at 6-7. The materials even showed [REDACTED]. Opp. at 6-7. Apple tries to divert the Court's attention from these statements made by Hitachi (and relied upon by Maxell in its Opposition) by pointing instead to a different portion of the June 2013 letter.¹ Cf. Reply at 2 (quoting [REDACTED]

[REDACTED]) with Opp. at 6 (quoting [REDACTED]). The fact that [REDACTED]

[REDACTED] does not nullify that the June 2013 materials also contained everything required for actual notice—*i.e.*, it informed Apple of the identity of the patent and the activity that is believed to be an infringement and contained a proposal to abate the infringement. *SRI Int'l, Inc. v. Advanced Tech. Labs., Inc.*, 127 F.3d 1462, 1470 (Fed. Cir. 1997). Ignoring the disputed materials facts is not the same as having no disputed material facts.

¹ Apple also argues that identification of [REDACTED] is distinguishable from other cases where identification of “water tank products” and “mobile telecommunications and infrastructure technologies” were sufficient to survive summary judgment. Reply at 2-3. Apple's conclusory statement that the two are different cannot erase a dispute of material fact. The only entity that can decide whether identification [REDACTED] is enough for actual notice is the jury.

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.