

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

MAXELL, LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

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Case No. 5:19-cv-0036-RWS

JURY TRIAL DEMANDED

**SECOND ADDENDUM TO PROTECTIVE ORDERS**

Plaintiff Maxell, Ltd. and Defendant Apple Inc. hereafter referred to as “the Parties,” have worked together to allow for certain confidential documents produced in this case to be used in the German Proceedings between Maxell and Apple. The Court entered an Agreed Protective Order on July 2, 2019 (“the Original Protective Order”) (Docket No. 45), a Joint Supplemental Protective Order between Intel, Plaintiff, and Defendant on October 28, 2019 (Docket No. 112), and a COVID-19 Addendum to the Protective Order on June 25, 2020 (Docket No. 353) (collectively with this Second Addendum, “the Protective Orders”). The parties now have filed a motion for entry of an agreed Second Addendum (Docket No. 620). The Court **GRANTS** the motion. It is hereby stipulated among the Parties and **ORDERED** that:

1. This Second Addendum to the Protective Orders shall be effective immediately upon entry. Except as modified herein, all other provisions of the Protective Orders shall remain in full force and effect.

2. Defined terms in this Second Addendum have the meaning established in the Protective Orders entered in this action unless otherwise modified pursuant to this Second Addendum. In addition, pursuant to the provisions of this Second Addendum, “German Proceedings” means the proceedings pending between the Parties in the District Court of Düsseldorf, Civil Chamber 4c, styled: *In the matter of Maxell Ltd.*, 4c O 14/20 (EP 1 286 174 B1); *In the matter of Maxell Ltd.*, 4c O 11/20 (EP 2 061 230); *In the matter of Maxell Ltd.*, 4c O 12/20 (EP 2 403 266 B1); *In the matter of Maxell Ltd.*, 4c O 10/20 (EP 1 482 508 B1); *In the matter of Maxell Ltd.*, 4c O 15/20 (EP 2 579 587 B1); *In the matter of Maxell Ltd.*, 4c O 13/20 (EP 1 936 974 B1); and *In the matter of Maxell Ltd.*, 4c O 45/19 (EP 1 324 539 B1); and “Court” means this Court and the District Court of Düsseldorf.

3. Notwithstanding anything to the contrary, the following paragraphs shall be appended to Paragraph 1 of the Original Protective Order, amending it as follows:

1(c) **Export Documents.** Not more than 25 documents (collectively, “Export Documents”)<sup>1</sup> consisting of non-Source Code Protected Material (i.e. Protected Material which is not “Source Code,” not designated “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” or not designated “INTEL CONFIDENTIAL - ATTORNEYS’ EYES’ ONLY SOURCE CODE”) may be transmitted to Maxell’s German Counsel, subject to the remaining provisions of the Protective Orders, including without new Paragraphs 1(d) (governing dispute resolution) and 10 (governing secure means of transmission). Aside from the foregoing, the Export Documents shall not be used directly or indirectly for any other purpose whatsoever.

1(d) **Export Document Designation Process.** Apple shall have three (3) days from the date on which the Export Documents are identified to object to their transmission, including on the basis that such transmission would be unlawful

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<sup>1</sup> For the avoidance of doubt, “Export Documents” encompasses both the documents themselves and the information contained therein, such that a limitation on disclosure of the Export Documents themselves also limits disclosure of any part of their contents.

under federal export control law.<sup>2</sup> Within two (2) days of receipt of the objection from Apple, the Parties shall meet-and-confer in good faith to resolve such objections. Absent agreement, Apple may file a motion for a protective order with this Court within three (3) days of the meet-and-confer.<sup>3</sup> Export Documents shall not be transmitted unless and until the Court denies such a motion or Apple withdraws its objections.

1(e) **Pre-conditions of Transmission of Export Documents.** Subject to the remaining provisions of the Protective Orders, Maxell may transmit an encrypted or otherwise password-protected copy of the Export Documents to Maxell's German Counsel. Five business days prior to the transmission of any Export Documents, each of Maxell's German Counsel who may have any access to the Export Documents shall execute and serve on Apple a copy of the Confidentiality Agreement attached to this Order as Exhibit A.<sup>4</sup> Maxell shall also execute and serve on Apple a copy of the Access Waiver attached to this Order as Exhibit B. The terms of Exhibit A and B are incorporated into the Protective Orders, and the terms of executed copies of Exhibit A or Exhibit B shall be enforceable as orders of this Court.

4. The following paragraph shall be appended to Paragraph 2 of the Original Protective Order, amending it as follows:

2(c) "Maxell's German Counsel" is limited to (i) outside counsel who appear on the pleadings as counsel for Maxell in the German Proceedings and (ii) outside counsel who are partners, associates, and staff of the counsel in 2(c)(i), to whom it is reasonably necessary to disclose the information for this litigation. Counsel who appear as Maxell's German Counsel after the transmission of the Export Documents may not receive any access to the Export Documents unless they comply with the provisions of the Protective Orders.

5. Paragraph 6(a) of the Original Protective Order shall be amended as follows:

(a) **Basic Principles.** All Protected Material shall be used solely for this case or any related appellate proceeding. Notwithstanding that, Export Documents may also be used as confidential submissions in the German Proceedings. Aside from the foregoing, the Export Documents shall not be used directly or indirectly for any

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<sup>2</sup> To the extent Apple's object is based on federal export control law, Apple shall provide the applicable Export Control Classification Number ("ECCN") and any other information relevant to its determination that an export is prohibited.

<sup>3</sup> The Parties agree that briefing would conclude with Maxell's Opposition, if any. No party shall submit a Reply or Sur-Reply.

<sup>4</sup> Counsel who appear as Maxell's German Counsel after the transmission of the Export Documents may not receive any access to the Export Documents until they execute and serve upon Apple such Confidentiality Agreement.

other purpose whatsoever, including without limitation any other litigation, patent prosecution or acquisition, patent reexamination or reissue proceedings, or any business or competitive purpose or function. Export Documents shall not be distributed, disclosed, or made available to anyone except as expressly provided in the Protective Orders.

6. Paragraph 6(c) of the Original Protective Order shall be amended as follows:

(c) Secure Storage, No Export. Protected Material must be stored and maintained by a Receiving Party at a location in the United States or Germany and in a secure manner that ensures that access is limited to the persons authorized under this Order. Certain Protected Material may be subject to laws and regulations relating to the export of technical data contained therein, including the release of such technical data to foreign persons or nationals in the United States or elsewhere. *See, e.g.*, 15 CFR 734.2. The Producing Party shall identify material that may be subject to export control regulations (“Export Control Material”), as described in 15 CFR 734.2 and the Commerce Control List. Subject to any exceptions under the law, no Export Control Material may leave the territorial boundaries of the United States of America or be made available to any foreign national who is not (i) lawfully admitted for permanent residence in the United States or (ii) identified as a protected individual under the Immigration and Naturalization Act (8 U.S.C. 1324b(a)(3)). Without limitation, this prohibition extends to Export Control Material (including copies) in physical and electronic form. The viewing of Export Control Material through electronic means outside the territorial limits of the United States of America is similarly prohibited. The restrictions contained within this paragraph may be amended through the consent of the producing Party to the extent that such agreed to procedures conform with applicable export control laws and regulations. Notwithstanding the foregoing, to the extent that (i) a Producing Party of Export Control Material makes a witness available for deposition outside the United States, the deposing party may, to the extent permitted by law, transport (subject to the restrictions set forth in this Protective Order) such Party’s Export Control Material reasonably necessary for the deposition and may use the Export Control Materials at the deposition and (ii) the Export Control Material is used in the German Proceedings, Maxell may, to the extent permitted by law, transport and use (subject to the restrictions set forth in the Protective Orders) Apple’s Export Control Material only in the German Proceedings. Should the Receiving Party not be able to use the Export Control Materials at the deposition due to any export control regulations of the constructions of this Order, the Producing Party will make the witness available for deposition in the United States.

7. Paragraph 6(d) of the Original Protective Order shall be amended as follows:

(d) Legal Advice Based on Protected Material. Nothing in this Protective Order shall be construed to prevent counsel from advising their clients with respect to this case or the German Proceedings based in whole or in part upon Protected Materials,

provided counsel does not disclose the Protected Material itself except as provided in this Order.

8. Paragraph 8(b)(iii) of the Original Protective Order shall be amended as follows:

(iii) Any outside expert or consultant retained by the Receiving Party to assist in this action or the German Proceedings, provided that disclosure is only to the extent necessary to perform such work; and provided that: (a) such expert or consultant has agreed to be bound by the provisions of the Protective Order by signing a copy of Exhibit A; (b) such expert or consultant is not a current officer, director, or employee of a Party or of a competitor of a Party, nor anticipated at the time of retention to become an officer, director or employee of a Party or of a competitor of a Party; (c) such expert or consultant accesses the materials in the United States only, and does not transport them to or access them from any foreign jurisdiction; and (d) no unresolved objections to such disclosure exist after proper notice has been given to all Parties as set forth in Paragraph 12 of the Original Protective Order;

9. Paragraph 9(b)(ii) of the Protective Order shall be amended as follows:

(ii) Any outside expert or consultant retained by the Receiving Party to assist in this action or the German Proceedings, provided that disclosure is only to the extent necessary to perform such work and provided that: (a) such expert or consultant has agreed to be bound by the provisions of the Protective Order by signing a copy of Exhibit A; (b) such expert or consultant is not a current officer, director, or employee of a Party or of a competitor of a Party, nor anticipated at the time of retention to become an officer, director, or employee of a Party or of a competitor of a Party; (c) such expert or consultant is not involved in competitive decision-making, as defined by *U.S. Steel v. United States*, 730 F.2d 1465, 1468 n.3 (Fed. Cir. 1984), on behalf of a Party or a competitor of a Party; (d) such expert or consultant accesses the materials in the United States only, and does not transport them to or access them from any foreign jurisdiction; and (e) no unresolved objections to such disclosure exist after proper notice has been given to all Parties as set forth in Paragraph 12 of the Original Protective Order;

10. To the extent authorized by the Protective Orders, Maxell shall be permitted to transmit electronic copies of Export Documents to Maxell's German Counsel pursuant to any of the following methods: (i) encrypted email using an encryption tool that has a passphrase of at least 20 characters in length and using at least 128-bit Advanced Encryption Standard (AES) cipher option; (ii) a secure FTP site that implements 256 bit AES encryption over SSL and

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