

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

MAXELL, LTD.,	§	
	§	
Plaintiff,	§	CIVIL ACTION NO. 5:19-CV-00036-RWS
	§	
v.	§	
	§	
APPLE INC.,	§	
	§	
Defendant.	§	
	§	

ORDER

Before the Court are Plaintiff Maxell, Ltd.’s Motions *in Limine* (Docket No. 547), Defendant Apple Inc.’s Motions *in Limine* (Docket No. 548) and Maxell’s Additional Motion *in Limine* (Docket No. 602). The Court heard argument on all but the additional motion on November 12, 2020.¹ For the following reasons, the motions are **GRANTED-IN-PART** and **DENIED-IN-PART**. The Court takes each dispute in turn.

I. Maxell’s MIL #1

Maxell asks the Court to preclude Apple from “entering into evidence, or offering testimony based upon, unauthenticated Sony MVC-FD83 and MVC-FD88 cameras” under Federal Rules of Evidence 901, 401–02, and 403. Docket No. 547 at 1. Maxell submits that Apple’s expert intends to offer invalidity opinions for the ’493 patent based on these cameras, as well as related product manuals, magazine advertisements and Sony sales data. *Id.* Maxell contends that

¹ The parties presented argument on the initial motions *in limine* at the pretrial conference on November 12, 2020. Docket No. 582. Due to the COVID-19 global pandemic, jury trial in this matter was reset to March 22, 2021. Docket No. 593. Maxell filed its additional motion *in limine* (Docket No. 602) on December 21, 2020, and supplemental authority for its motion on January 8, 2021 (Docket No. 611). Apple has filed a response (Docket No. 616).

“Apple has not presented evidence establishing that the manual, advertisements, and sales data are tied to the specific camera samples” and has not provided any other evidence of the cameras’ authenticity. *Id.* at 2–3. Maxell argues that the cameras must be excluded as unauthenticated evidence under FRE 901, as irrelevant under FRE 402 and as prejudicial and confusing under FRE 403. *Id.* at 4.

Maxell’s MIL #1 is **DENIED**. In substance, this motion is duplicative of Maxell’s motion for summary judgment of no invalidity regarding the ’493 patent (Docket No. 370), which the Court denied. *See* Docket No. 586. Further, Maxell’s objections to the cameras under the Federal Rules of Evidence are not appropriate as a motion *in limine*. To the extent that Maxell objects to the authenticity or relevance of the Sony cameras, it may submit an exhibit objection.

II. Maxell’s MIL #2

Maxell moves to exclude “improper expert testimony or supplementation of facts from Dr. Gregory Abowd.” Docket No. 547 at 5. Maxell submits that Dr. Abowd, as author of the prior art Cyberguide system, must confine his testimony to facts in evidence only and may not be portrayed by Apple as “someone knowledgeable in the art, an expert in his field, or anything of the like.” *Id.* at 6. Maxell argues that “even presenting his background and experience will suggest to the jury that Dr. Abowd must be listened to with particular care given his particularized knowledge.” *Id.* Apple responds that Dr. Abowd is a fact witness who will testify as to the “bounds” of the prior art Cyberguide system based on his personal knowledge of that system and will not offer any expert opinions. Docket No. 563 at 3–6.

Maxell’s MIL #2 is **GRANTED-IN-PART** and **DENIED-IN-PART**. Apple has agreed that Dr. Abowd is a fact witness only and will not provide any expert testimony or opinions. Dr. Abowd may provide facts regarding prior art Cyberguide systems “that he personally perceived,”

provide facts regarding the prior art Abowd article, including “why, when, where, and to whom it was published,” and testify as the “bounds” of the Cyberguide system as a topic within his personal knowledge. Docket No. 563 at 6–7. Apple shall not refer to Dr. Abowd as an expert witness and he may not provide any opinions that deviate from his personal knowledge or would require an expert report under FRE 702. FED. R. EVID. 701.

But Dr. Abowd may testify regarding his background and experience in order to provide an appropriate foundation for his fact testimony. *See* FED. R. EVID. 602 (a witness must lay a foundation establishing personal knowledge of the facts forming the basis of his or her testimony). Maxell may raise an objection at trial to any testimony it feels is unduly prejudicial, and the Court will entertain proposals for a limiting instruction regarding Dr. Abowd’s role as a fact witness, if necessary.

III. Maxell’s MIL #3

Maxell moves to exclude “[a]ll references, evidence, testimony (including expert testimony), or argument regarding, or inquiries about or eliciting any testimony suggesting that Google Maps is a non-infringing alternative to the asserted patents.” Docket No. 547 at 7. While Maxell has not specifically accused Google Maps of infringing the asserted patents, Maxell submits that this does not mean that it is a non-infringing alternative, as Apple’s experts claim. *Id.* at 8. Apple responds that Maxell’s motion is baseless, as its experts do not intend to provide any opinions regarding Google Maps and have not referenced Google Maps in their expert reports. Docket No. 563 at 7.

At the pretrial conference, the parties appeared to have reached agreement on the substance of this motion. *See* Docket No. 590 at 26:22–30:16. The parties are ordered to meet and confer

and file a joint status report confirming their agreement with the Court or briefly describing the nature of any remaining dispute no later than Monday, March 8, 2021, at 5 p.m. CST.

IV. Maxell's MIL #4

Maxell moves to prohibit Apple from introducing “any references, evidence, testimony (including expert testimony), or argument regarding, or inquir[ing] about or elicit[ing] any testimony comparing any accused instrumentality to any purported prior are device, prior art patent, or any other prior art.” Docket No. 547 at 8. Apple responds that none of its experts intend to assert a “practicing the prior art” defense, and that, to the extent that Maxell takes issue with its experts invalidity theories, those disputes are untimely *Daubert* challenges. Docket No. 563 at 7–8. Apple contends that its experts will apply the asserted claims to the prior art references under Maxell’s experts’ reading of the claims and the Court’s claim construction, and that it will argue based on this evidence “that were the claims broad enough to be infringed as Maxell asserts, they are invalid.” *Id.* at 7. This, Apple argues, is a permissible, “limitation-by-limitation anticipation analysis.” *Id.* (citing *HSM Portfolio LLC v. Elpida Memory Inc.*, No. 11-770-RGA, 2016 WL 561179, at *13 (D. Del. Feb. 11, 2016)).

At the pretrial conference, counsel for Maxell informed the Court that the parties had reached agreement on this motion. Docket No. 590 at 31:4–6 (“I’ll let [Apple’s counsel] confirm that to be sure, but I think we have reached agreement on this MIL.”). Apple’s counsel then indicated that the parties had reached agreement that Apple’s expert would not be offering a “practicing the prior art” defense. *Id.* at 31:14-18 (“I think as long as the agreement is limited to that, then I think there’s no dispute here.”). The parties are ordered to meet and confer and file a joint status report confirming their agreement with the Court or briefly describing the nature of any remaining dispute no later than Monday, March 8, 2021, at 5 p.m. CST.

V. Maxell's MIL #5

Maxell moves to exclude any evidence, testimony or argument “concerning the quality of the United States Patent and Trademark Office’s (“USPTO”) examination process or its examiners or the percentages of patents that are invalidated in re-examinations or *Inter Partes* Review.” Docket No. 547 at 10. Maxell submits that any testimony regarding overwork, quotas, awards or promotions at the USPTO would be irrelevant and unfairly prejudicial. *Id.* Because “[t]he law mandates that patents are presumed valid,” Maxell argues that any testimony that attempts to cast doubt on that presumption should be excluded. *Id.* at 11. Apple responds that it has “no intention of ‘attacking’ the Patent Office or its examiners.” Docket No. 563 at 9. Apple does intend to argue that the Patent Office did not have the opportunity to consider its prior art references asserted in this case and make “generalizations that the examiner was in error.” Docket No. 563 at 9. Apple also contends that if Maxell argues that the Patent Office “got it right” after “years” of analyzing Maxell’s patent applications, then Apple is entitled to a rebuttal. *Id.* at 10.

Based on counsels’ presentations at the pretrial conference, the parties generally agree on the substance of this motion. Apple agreed not to elicit testimony implying that the Patent Office or its examiners are overworked or overburdened, refer to quotas or promotions, or otherwise “attack” the USPTO or its examiners. Docket No. 563 at 9–10; Docket No. 590 at 35:13–20. But if Maxell attempts to bolster the USPTO or its examiners or imply that the USPTO always issues patents correctly, Apple intends to contradict that testimony. Docket No. 563 at 10; Docket No. 590 at 35:13–36:2 (“But if Mr. Stoll gets up on the stand and says that the Patent Office is great, they take a long time to examine patents—in this particular instance, they spent three, four, five years examining the patent, then we have to cross-examine him on the basis of those statements.”). Maxell indicated that Mr. Stoll’s testimony would not bolster the USPTO or its examiners, and

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