

**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

FILED UNDER SEAL

AMENDED JOINT FINAL PRE-TRIAL ORDER

Pursuant to the Court’s Amended Docket Control Order (Dkt. No. 623) and Rule 16 of the Federal Rules of Civil Procedure. The following parties submit this Amended Joint Pretrial Order: Plaintiff Maxell, Ltd. (“Plaintiff” or “Maxell”) and Defendant Apple Inc. (“Defendant” or “Apple”).

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B. STATEMENT OF JURISDICTION

This is a civil action arising under the Patent Laws of the United States, 35 U.S.C. § 101, *et seq.* The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a). Jurisdiction is not contested by any party.

C. NATURE OF ACTION

Maxell's Statement

This is a suit for patent infringement under 35 U.S.C. § 271. Apple infringes, literally or under the doctrine of equivalents, one or more claims of U.S. Patent Nos. 6,748,317 (the “317 Patent”), 6,580,999 (the “999 Patent”), 8,339,493 (the “493 Patent”), 7,116,438 (the “438 Patent”), 6,329,794 (the “794 Patent”), and 6,430,498 (the “498 Patent”) (collectively, the “Patents-in-Suit”).¹ Further, Apple’s infringement is and has been willful. Maxell seeks an injunction and both pre- and post-verdict damages to compensate Maxell for Apple’s acts of infringement, but in no event less than a reasonable royalty for the infringement. Maxell also seeks enhanced damages pursuant to 35 U.S.C. § 284 and recovery of its attorneys’ fees pursuant to 35

¹ In its Complaint, Maxell also asserted infringement of U.S. Patent Nos. 6,408,193 (the “193 Patent”), 10,084,991 (the “991 Patent”), 6,928,306 (the “306 Patent”), and 10,212,586 (the “586 Patent”). In compliance with the Court’s Order on narrowing (Dkt. No. 619), Maxell has not selected these patents for presentation at the March 2021 trial scheduled for this case.

U.S.C. § 285, as well as its costs.

Apple's Statement

Maxell's claims are without merit. Apple does not infringe any asserted claim of the Patents-in-Suit, either literally or under the doctrine of equivalents. Moreover, Apple's alleged infringement of the Patents-in-Suit has not been, and is not, willful. Additionally, each of the asserted claims of the Patents-in-Suit is invalid as anticipated or obvious under 35 U.S.C. §§ 102 and/or 103. Further, the '317 patent, the '498 patent, and the '999 patent are invalid for failing to claim patent-eligible subject matter under 35 U.S.C. § 101.

Maxell is not entitled to any relief, including injunctive relief or monetary damages. Maxell is not entitled to enhanced damages, nor is this an exceptional case entitling Maxell to its attorneys' fees and costs. Apple, however, is entitled to recovery of its attorneys' fees under 35 U.S.C. § 285, as well as its costs, and any other relief the Court deems appropriate.

D. CONTENTIONS OF THE PARTIES

The parties set forth below a summary of their contentions for trial. The parties do not necessarily agree with each other's summaries and contentions and reserve all objections.

Maxell's Statement of Its Contentions

By providing these contentions, Maxell does not waive any of its motions *in limine*, motions for summary judgment, *Daubert* motions, and/or motions to strike which, if granted, would resolve some or all of these issues. Furthermore, Maxell's contentions in this case are detailed, in part, in its pleadings, infringement contentions, discovery responses and deposition testimony, the expert reports and depositions of Maxell's experts, and its motion briefing and responses to Apple's pending and anticipated motions, which are all incorporated by reference herein.

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