

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

MAXELL, LTD.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Civil Action No. 5:23-CV-00092-RWS

**DEFENDANTS SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG
ELECTRONICS AMERICA, INC.'S RENEWED MOTION FOR JUDGMENT AS A
MATTER OF LAW AND MOTION FOR A NEW TRIAL**

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Pursuant to Fed. R. Civ. P. 50 and 59, Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) respectfully request judgment as a matter of law (“JMOL”) or, in the alternative, a new trial on all issues tried to the jury; namely, infringement, willful infringement, invalidity, and damages related to United States Patent Nos. 8,982,086 (“the ’086 patent”), 10,176,848 (“the ’848 patent”), and 11,017,815 (“the ’815 patent”) (collectively “the asserted patents”). For the reasons below, Samsung is entitled to JMOL or, in the alternative, a new trial.

I. INTRODUCTION

Samsung is entitled to JMOL on the issues of infringement, willful infringement, invalidity, and damages because “a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue.” Fed. R. Civ. P. 50(a)(1). Maxell failed at trial to offer a legally sufficient basis to find infringement of any asserted claim of the three asserted patents. Indeed, Samsung presented compelling evidence of noninfringement of each asserted patent, even though Samsung does not bear the burden of proving noninfringement. Samsung also presented compelling evidence that it had no specific intent to infringe the asserted patents, whereas Maxell presented no evidence that could support Samsung’s specific intent. As a result, no reasonable jury could have found that Samsung willfully infringed.

Samsung also presented clear and convincing evidence that claim 1 of the ’086 patent is invalid for lack of written description. Samsung also presented clear and convincing evidence that claim 1 of the ’815 patent is invalid as obvious in view of the iPhone 8 and claims 21 and 24 are obvious in view of the Galaxy S10 running the Netflix application. In light of this evidence, no reasonable jury could have rejected these invalidity defenses.

Finally, no reasonable jury could find that Maxell proved damages based on the one percent royalty rate on which the jury’s verdict is expressly based. Maxell’s attempt to prove

damages violates Federal Circuit precedent in several ways, leaving Maxell without competent evidence to support the jury's damages verdict. As a result, the Court should grant JMOL in Samsung's favor on all issues or, in the alternative, a new trial.

II. LEGAL STANDARDS

A. Judgment as a Matter of Law

JMOL is warranted when “a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue.” Fed. R. Civ. P. 50(a)(1). In other words, the moving party is entitled to judgment as a matter of law if “no reasonable juror could return a contrary verdict.” *Int'l Ins. Co. v. RSR Corp.*, 426 F.3d 281, 296 (5th Cir. 2005). “The grant or denial of a motion for judgment as a matter of law is a procedural issue not unique to patent law, reviewed under the law of the regional circuit in which the appeal from the district court would usually lie.” *Summit Tech, Inc. v. Nideck Co., Ltd.*, 363 F.3d 1219, 1223 (Fed. Cir. 2004). To survive a Rule 50 motion and present a question for the jury, the party opposing the motion must establish a conflict in substantial evidence on each essential element of its claim. *Anthony v. Chevron United States*, 284 F.3d 578, 583 (5th Cir. 2002) (citing *Boeing Co. v. Shipman*, 411 F.2d 365, 374 (5th Cir. 1969) (*en banc*) (mere scintilla of evidence insufficient to present a question for the jury)). In other words, the evidence must be sufficient so that a jury will not ultimately rest its verdict on mere speculation and conjecture. *Id.* (citing *Gulf Coast Real Estate Auction Co. v. Chevron Indus., Inc.*, 665 F.2d 574, 577 (5th Cir. 1982)).

B. New Trial

“Rule 59 of the Federal Rules of Civil Procedure confirms the trial court's historic power to grant a new trial based on its appraisal of the fairness of the trial and the reliability of the jury's verdict.” *Smith v. Transworld Drilling Co.*, 773 F.2d 610, 612-13 (5th Cir. 1985); *see also* Fed. R. Civ. P. 59. A trial court may grant a new trial if the verdict is against the great weight of

the evidence, the trial was unfair, or prejudicial error was committed in its course. *Smith*, 773 F.2d at 613. When determining whether the verdict is “clearly contrary to the weight of the evidence,” the trial court weighs all the evidence, but need not view it in the light most favorable to the prevailing party. *Id.* A new trial can be justified even if a directed verdict would not, and even if there is substantial evidence to support the verdict. *See, e.g., Rousseau v. Teledyne Movable Offshore, Inc.*, 812 F.2d 971, 972 (5th Cir. 1987) (*per curiam*). While the trial court may not “simply substitute its opinion for the jury’s, ‘[i]f the trial judge is not satisfied with the verdict of a jury, he has the right—and indeed the duty—to set the verdict aside and order a new trial.’” *Smith*, 773 F.2d at 613 (quoting CHARLES ALAN WRIGHT, *FEDERAL COURTS* 633 (4th ed. 1983)) (alteration in original).

III. THE '086 PATENT

A. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Infringement of the '086 Patent.

Samsung is entitled to JMOL of noninfringement of claim 1 of the '086 patent, the only asserted claim of that patent. For two independent reasons, there is no legally sufficient evidentiary basis to find for Maxell on the question of infringement of claim 1. In the alternative, Samsung is entitled to a new trial on this issue.

1. Samsung’s Products Do Not Have Two “Registering Modes,” as Required by Claim 1.

At trial, Maxell failed to present sufficient evidence that limitations [1.f] and [1.g] are implemented in the representative Samsung accused product, the Galaxy S23 smartphone. These disputed limitations require two different registering modes, one for inputting input information by a finger pad and one for inputting input information by an end of the finger:

[I]n said registering mode, there are provided a first registering mode for inputting input information by a pad of the finger, and a

second registering mode for inputting input information by an end of the finger ...

PX-003 at 8:54-57.¹ The undisputed evidence at trial showed that the Galaxy S23 has only one fingerprint registering mode, not two, as limitations [1.f] and [1.g] require.

There was no dispute at trial about how the Galaxy S23 operates. The experts agreed that the “enroll diagram” in the Samsung [REDACTED] Specification (PX-45 at 13 (Fig. 9)) shows how the relevant portions of the fingerprint registration process operate in the Galaxy S23. Trial Tr. at 569:20-570:16, 904:18-905:7. Maxell’s expert, Dr. Wobbrock, confirmed that the diagram shows that there is only one algorithm for the fingerprint registration process in the Galaxy S23, and that this algorithm “loops until the phone has a complete template of somebody’s finger.” Trial Tr. at 573:12-18, 574:10-15. In other words, the Galaxy S23 uses a single algorithm to create a single template for one fingerprint. *Id.* The experts also agreed that the fingerprint enrollment algorithm used in the Galaxy S23 can neither identify nor recognize the finger portions captured during registration (or, indeed, if a finger is actually being used in the first instance). Trial Tr.² at 573:19-574:9, 955:15-956:10.

Maxell presented no evidence that the single fingerprint enrollment algorithm in the Galaxy S23 includes more than one registration mode as claim 1 requires. Although Dr. Wobbrock testified that [REDACTED] [REDACTED] he presented no evidence to support his claim. Trial Tr. (Sealed Portion No. 5) at 112:24-114:13, 116:21-121:14. Maxell offered no evidence at trial that simply repeating steps of the same algorithm is a different “mode.” Dr. Wobbrock’s

¹ All citations to “PX-” or “DTX-” are to exhibits admitted into evidence in this proceeding as reflected in the Parties’ Final Trial Exhibit Lists at Docket Nos. 347 and 348.

² All citations to “Trial Tr.” are to the trial transcript for this proceeding filed at Docket Nos. 354 - 365, 369, 370, 384, 387, 388.

testimony is contrary to that of another of Maxell's experts, Dr. Balakrishnan. Dr. Balakrishnan, Maxell's expert on the '848 patent (who has expertise in the same field of human-computer interaction as Dr. Wobbrock) confirmed that for "two modes to be different, they have to be running different algorithms[.]" Trial Tr. at 665:7-14. Because the fingerprint registration process on the Galaxy S23 is a single algorithm that collects input in a single mode for generating a single fingerprint template, the uncontroverted evidence conclusively proves the Galaxy S23 uses a single mode, not two modes as claim 1 requires.

The Galaxy S23 therefore cannot meet the multiple "mode" limitations [1.f] and [1.g], and Samsung is entitled to JMOL of noninfringement of asserted claim 1 of the '086 patent or, in the alternative, a new trial on infringement.

2. Samsung's Products Do Not Have a Mode for Inputting Input Information by "An End of the Finger," as Required by Claim 1.

Samsung also is entitled to JMOL of noninfringement of the '086 patent because the Galaxy S23 does not have a registering mode for inputting information by "an end of the finger," as limitations [1.f] and [1.g] require. Maxell presented no evidence at trial that the Galaxy S23 has a specific fingerprint registration mode for inputting input information by an end of the finger. Indeed, all evidence was to the contrary. Dr. Wobbrock conceded that none of the evidence he considered or presented includes an instruction to the user to provide input information in a mode that uses an end of the user's finger. Trial Tr. (Sealed Portion No. 6) at 40:25-41:9 (agreeing that the Galaxy S23 screen does not contain text instructing users to provide a fingertip input), 51:16-20 (confirming he has "not seen an instruction to a user in anything that [he] reviewed that instructs a user to use the tip of their finger to register a fingerprint on a Samsung device"). It was also undisputed that the single fingerprint registration algorithm of the Galaxy S23 cannot identify or recognize what portion of the fingerprint is being

used for input, let alone that the user is using an end of their finger. Trial Tr. at 573:19-574:9, 955:15-956:10. The Galaxy S23 User Manual further confirms this fact given that it (a) instructs the user to “press with the pad of your finger,” (b) contains no instruction to use the tip or end of the finger, and (c) in fact specifically advises against using a fingertip, stating “if you ... use a fingertip, the device may not recognize your fingerprints.” PX-56 at 150. Even Dr. Wobbrock’s video of his testing of the Galaxy S23 (PX-48) shows 13 consecutive failed attempts to register a fingerprint using the end of a finger. Trial Tr. (Sealed Portion No. 6) at 35:3-38:3. Although there may be instances in which the fingerprint registration process in the Galaxy S23 may recognize some portion of the fingerprint at the end of the finger, the evidence uniformly supports that there is no specific mode for inputting this information from an end of the finger as claim 1 requires. Thus, no reasonable jury could find infringement of claim 1 of the ’086 patent, and Samsung is entitled to JMOL of noninfringement or, in the alternative, a new trial on this issue.

B. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Invalidity of Claim 1 of the ’086 Patent.

Samsung is entitled to JMOL that claim 1 of the ’086 patent is invalid for lack of written description under 35 U.S.C. § 112. The ’086 patent specification does not disclose using fingerprint information. Maxell’s expert Dr. Wobbrock offered *ipse dixit* testimony in response, but this testimony lacks support from the patent specification and therefore cannot refute Samsung’s case under settled law. In the alternative, Samsung is entitled to a new trial on this affirmative defense.

At trial, Samsung presented its case for invalidity of claim 1 of the ’086 patent. The relevant claim elements are the “first information” and “second information” terms from limitations [1.b] and [1.f], which the Court held during claim construction should be afforded

their plain and ordinary meaning, which encompasses “fingerprint information.” Docket No. 107, at 23-27. The limitations are reproduced below with the relevant elements underlined:

[1.b] a detector configured to detect first information necessary for an identification of the user when the contact is detected between the touch panel and the finger of the user;

[1.d] memory that is configured to store second information relating to the identification of the user, which is stored in advance;

PX-003 at claim 1 (emphasis added). JMOL is warranted because the undisputed evidence proved that the '086 patent lacks written description support for the “first information” and “second information” terms if those terms are broad enough to encompass fingerprint information.

At trial, Samsung presented intrinsic evidence that conclusively proved the lack of written description support for claim 1. Samsung’s expert, Dr. Nielson, presented evidence from the '086 patent specification that (1) the claims and specification never use the word “fingerprint” (Trial Tr. at 925:6-13, 1178:3-14 (Dr. Wobbrock agreeing)), and (2) in the few instances when the patent refers to “information for identification of the user,” it does so in the context of a simple passcode that can consist of numbers, letters, figures, and/or symbols in combination with touch inputs that are distinguished entirely on the basis of the size of the input itself (namely, whether one touch is larger or smaller than the other), not fingerprints. Trial Tr. at 925:14-931:19; PX-003 at Figs. 1A, 1B, 5A, 5B, Abstract, 1:38-46, 3:1-13.

Dr. Nielson also presented evidence that the simple capacitive sensors described and depicted in the patent as distinguishing the size of a touch input are inconsistent with the “fine-grained sensors” that would be required to capture the ridges, loops, and whorls of a user’s fingerprint. Trial Tr. at 931:11-933:12. Dr. Nielson established—and Dr. Wobbrock did not refute—that not all capacitive sensors can detect fingerprints, as evidenced by the Samsung

Galaxy S23 phone itself, which has a capacitive touchscreen that does not detect fingerprints and obtains fingerprint information using a separate ultrasonic sensor (which is not capacitive). Trial Tr. at 932:3-934:7. Finally, Dr. Nielson presented the file history of a related patent application with the same specification as the '086 patent, where Maxell sought to obtain nearly identical claims to those of asserted claim 1 that expressly recited “fingerprint information,” but cancelled those proposed claims in view of an examiner rejection that the specification did not contain written description support for claims that encompass fingerprint information. Trial Tr. at 936:2-941:20; DTX-94 at 561-62, 876-77.

Dr. Wobbrock’s attempts to refute this evidence were untethered to the '086 patent specification, rendering JMOL appropriate. For example, with respect to the few references in the patent to “information for identification of the user” that Dr. Wobbrock claimed support the written description of fingerprints, Dr. Wobbrock’s testimony showed that, despite his conclusion, “information for identification of the user” in the specification does not refer to fingerprints. Dr. Wobbrock pointed to the same '086 patent disclosure of “information for identification of the user” as Dr. Nielson. But Dr. Wobbrock conceded that this disclosure explains that “identification information, including letters, figures, and symbols,” which is not touch input, is displayed on the apparatus. Trial Tr. at 1165:1-1166-8; PX-003 at Abstract. He then argued that “other pieces [of identification information] come from the user’s finger,” but admitted that these other pieces of purported identification information, such as touch input and fingerprint information, “would not be displayed[.]” Trial Tr. at 1165:1-1166-8. Because the touch input and fingerprint information is not displayed, the disclosures in the specification about identification information that is displayed cannot support Dr. Wobbrock’s written description opinion. Thus, the fact that Dr. Wobbrock used the disclosure about the displayed pieces of

identification information—letters, figures, and symbols, which he conceded is not associated with the touch input—as the basis for his assertion that fingerprints can also be identification information, leaves his opinion unsupported. Trial Tr. at 1166:9-1167:6; PX-003 at Abstract; PX-40 at .259, .206.

Dr. Wobbrock also opined that, in his view, the specification’s discussion of capacitive sensors for the purpose of discerning larger or smaller touch inputs could be viewed as a disclosure of capacitive sensors that detect fingerprints. Trial Tr. at 1167:7-1172:11. But Dr. Wobbrock’s only support for this opinion was a statement in the specification that the capacitance of “sensor 4” changes or varies when the user’s finger contacts the touch panel. *Id.* (citing PX-003 at 3:17-20, 3:30-32). Dr. Wobbrock admitted prior to trial that not all capacitive sensors can detect fingerprint information (Docket No. 124-5 at 212:1-213:13, 218:18-24), and he did not address or refute Dr. Nielson’s similar testimony that capacitive sensors can be used for many purposes other than fingerprint imaging. Nor did Dr. Wobbrock explain why a person of skill in the art would understand the disclosures about capacitive sensors to cover anything other than what the patent expressly teaches; namely, that capacitive sensors can be used to distinguish large and small touch inputs (finger pad and tip inputs). Moreover, Dr. Wobbrock never addressed the examiner’s conclusion in the related file history that the ’086 patent specification lacked written description support for claims that encompass fingerprint information.

Thus, although Dr. Wobbrock opined that the specification provides written description support for using fingerprint information, his opinion had no foundation in the specification and thus cannot defeat Samsung’s evidence at trial. *See Allergan USA, Inc. v. MSN Labs. Priv. Ltd.*, 111 F.4th 1358, 1376 (Fed. Cir. 2024) (“But without some basis in the specification that the

invention would be understood to *require* a glidant, expert testimony cannot be used to fill that gap. Reliance on such testimony, untethered to the inventors' own description of the invention, would improperly take the written description inquiry outside the four corners of the specification.") (emphasis in original). Samsung therefore is entitled to JMOL that the '086 patent claims are invalid for lack of written description. In the alternative, Samsung is entitled to a new trial on this affirmative defense.

IV. THE '815 PATENT

A. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Infringement of Claim 1 of the '815 Patent.

Samsung is entitled to JMOL of noninfringement of claim 1 of the '815 patent. The jury's infringement verdict is not supported by substantial evidence, and therefore no reasonable jury could have found that the Samsung Galaxy S23 infringes claim 1. In the alternative, Samsung is entitled to a new trial on this issue.

1. Limitations [1.j] and [1.k] Require Selection of a Character.

At trial, Maxell failed to present a legally sufficient evidentiary basis that limitations [1.j] and [1.k] (the "Character Selection" limitations) are implemented in the Gallery app on the Galaxy S23:

[1.j] wherein user selection of the first character enables the display of a first group of thumbnails corresponding to the first group of video information in the second area,

[1.k] wherein user selection of the second character enables the display of a second group of thumbnails corresponding to the second group of video information in the second area,

The Character Selection limitations require selecting a first/second character in a first area of a display in order to display a group of thumbnails corresponding to video information in a second area of the screen. The Court construed "character" as "a letter, number, punctuation mark, or

other symbol or control code that is represented to a computer by one unit of information.”

Docket No. 107. Thus, the Character Selection limitations are not satisfied by selecting an area of a display because that is not a “character.”

2. Both Experts Agreed on the Primacy of Source Code.

The parties did not dispute the evidentiary primacy of source code in software such as the Gallery app. At trial, Maxell’s expert Dr. Singh testified that Samsung produced its source code for him to review and agreed that the source code would show whether the phone is programmed to “recognize the selection of a single character,” stating that “[i]f it was there, it would be in the code[.]” Trial Tr. at 751:8-15. Dr. Singh agreed that the Galaxy S23 smartphone is “run by software . . . ” which is defined by source code. Trial Tr. at 751:18-752:1. He further agreed that “if it’s not in the source code, it will never happen on the phone” and acknowledged that if the relevant instructions are in the code and the required conditions are met, the function will happen. Trial Tr. at 752:2-13. Dr. Singh agreed that “the source code never lies” (*id.*), and agreed that it is a “very reliable source of information” for both him and the jury. Trial Tr. at 752:14-16. He confirmed that he had reviewed the source code. Trial Tr. at 752:17-19.

Samsung’s expert Dr. Kia agreed with Dr. Singh about the primacy of the source code in software. Trial Tr. at 1007:14-23. Dr. Kia affirmed that “the source code is never wrong” and that if the software were programmed to recognize a character, “it would be in the source code somewhere.” *Id.* Dr. Kia made clear that the source code is the definitive record of what the software is designed to do, stating that “the clicking of the item would clearly be shown” if such functionality existed. *Id.* When asked what it means if something is not in the source code, he responded: “That means it’s not present in the accused products.” *Id.* His testimony underscores the critical role of source code evidence in an infringement analysis for software-implemented functionality such as the Gallery app.

3. Samsung's Expert Dr. Kia Provided Source Code-Based Technical Analysis that Proved Noninfringement.

Unlike Dr. Singh, who ignored the source code, Dr. Kia grounded his opinion in detailed analysis of the source code for the Gallery app. His testimony was clear, detailed, and directly aligned with the Court's construction of "character."

Dr. Kia testified that the source code does not show selecting a "character" as construed by the Court. Dr. Kia conducted a detailed review of the source code and showed that [REDACTED] [REDACTED], not a "character." Trial Tr. at 1003:22-1004:2; 1006:11-1008:22; Trial Tr. (Sealed Portion No. 14) at 3:4-6:11. Dr. Kia showed source code to the jury and explained in detail that the source code [REDACTED] [REDACTED]. *Id.* He emphasized that [REDACTED] [REDACTED] *Id.* He also showed the jury another part of the source code, which deals only with [REDACTED], not characters. *Id.*

Specifically, Dr. Kia testified that the relevant portion of the source code "processes the click when the user clicks on one of those albums" through a function called "[REDACTED]" Trial Tr. (Sealed Portion No. 14) at 3:6-4:16. He explained that this function is triggered by a [REDACTED] [REDACTED] [REDACTED] [REDACTED] *Id.* This distinction was central to his noninfringement opinion, because an area is "certainly more than one unit of information, as required by Court's construction," and the

absence of character-level selection is important “because that is what is required for the claim element to be satisfied.” *Id.*

Furthermore, Dr. Kia testified that he reviewed additional source code to confirm his opinion regarding how the software determines which album is selected during a drag-and-drop interaction. Trial Tr. (Sealed Portion No. 14) at 4:17-6:11. He explained that in this process, the user “selects the thumbnail, and don’t [sic] let go of the screen,” dragging it to an album and releasing it. *Id.* The code then i [REDACTED]

[REDACTED] *Id.* Dr. Kia emphasized that this mechanism again confirms that selection is based on “area,” not individual characters. *Id.* He stated that the use of [REDACTED]

[REDACTED] and reiterated that there is nothing in the code that has anything to do with selecting a “character.” *Id.* He concluded that this was significant because selecting “the character is what’s required by the claim element.” *Id.* Dr. Kia also confirmed that he reviewed other source code and did not see anything about selecting a “character,” as construed. *Id.* Dr. Kia also noted that Dr. Singh did not point to any source code showing the selection of an individual character in connection with opening an album. *Id.*

The selection of the area rather than individual characters is no coincidence. Dr. Kia explained why it must be area-based—the phone’s interface [REDACTED] [REDACTED] Trial Tr. at 1006:11-1007:9. He testified that both his testing and source code analysis confirm that the system responds to touches within these graphical areas, not to specific characters. *Id.* [REDACTED]

██████████. *Id.* This ██████████ reinforces that character-level selection is neither intended nor implemented. *Id.* Dr. Kia’s testimony provided source-code-based evidence that the accused functionality does not meet the Character Selection limitations.

4. Dr. Kia’s Product Testing at Trial Confirmed His Source Code Analysis.

At trial, Dr. Kia showed the jury that his product testing supports his source code analysis, highlighting (as explained further below) that Dr. Singh’s product testing was insufficient to establish infringement. Dr. Kia used a Galaxy S23 running the Gallery app to demonstrate to the jury that the phone’s behavior is based solely on touch location, not character selection. Trial Tr. at 1009:9-1014:3. In a live demonstration using an overhead camera, he showed how touching a first area on the touch display with the thumbnail and album title in various states of display (thumbnail and album title fully visible, album title not visible and thumbnail partially visible, album title not visible and only sliver of thumbnail visible, and both album title and thumbnail completely off-screen) all triggered the same response. Trial Tr. at 1012:2-1013:19. This confirmed that the source code responds to touch within a defined area, not to the selection of specific characters like the letter “C” or the word “carpet,” directly supporting the conclusion that “character” selection, as construed, plays no role in the phone’s operation. *Id.* Dr. Singh offered no testimony as to how or why this behavior could satisfy the Character Selection limitations.

5. The Unrebutted Evidence Proved That Product Testing Alone Is Inadequate to Establish Infringement.

Dr. Kia’s source code analysis and live product testing proved that actions other than selecting a character result in the display of thumbnails in the second area in the Gallery app. In particular, Dr. Kia’s source code analysis proved that the display of thumbnails in the second area of the screen was not the result of selecting anything that could qualify as a “character” under the

Court's construction, but rather was based on position of the touch and dynamically defined areas corresponding to albums. Dr. Kia confirmed his source code analysis by showing that thumbnails would be displayed in the second area of the screen even when a user touches a part of the first area that was completely empty. This evidence proved that selection of something other than a character (*i.e.*, an empty area) results in the display of thumbnails in the second area of the screen as required by the Character Selection limitations. In light of this undisputed evidence, product testing showing that thumbnails are displayed in the second area when a user touches the display over an album title did not prove infringement, because that touch does not result in selection of a "character," as construed.

6. Dr. Singh's Analysis Was Not Sufficient to Support the Jury's Infringement Verdict on Claim 1.

Despite agreeing to the primacy of source code, Dr. Singh did not show or explain any Samsung source code to the jury for the Character Selection limitations. Trial Tr. at 753:24-754:8. Rather, Dr. Singh relied on product testing, claiming it is "common knowledge." Trial Tr. at 755:21-756:7. When asked whether source code is necessary to determine if a character like "F" or "C" is being selected, Dr. Singh responded that it is not, asserting that observing the device's behavior is sufficient. Trial Tr. at 775:4-8. On redirect, Maxell's counsel attempted to minimize the importance of source code by asking Dr. Singh whether it was necessary to examine source code to determine if a character such as "F" or "C" is being selected. *Id.* Dr. Singh responded that it was not, claiming that one could simply perform the action and observe the device's behavior to determine functionality. *Id.* However, this testimony relied solely on subjective observation. As a result, Dr. Singh's testimony lacks the technical foundation necessary to constitute substantial evidence of infringement.

The Federal Circuit’s decision in *Mirror Worlds Technologies, LLC v. Meta Platforms, Inc.*, 122 F.4th 860 (Fed. Cir. 2024) underscores the principle that source code is the most authoritative evidence of software functionality. In *Mirror Worlds*, the plaintiff similarly relied on product testing and device behavior to support its infringement theory, while the defendant presented source code and expert testimony to prove noninfringement. *See id.* at 870. The district court held that the plaintiff’s reliance on unauthenticated screenshots and expert opinion based solely on UI behavior was insufficient to create a genuine dispute of material fact to avoid summary judgment of noninfringement. *Id.* at 873. The district court noted that “[t]he content of the underlying story, in fact, is not even input or otherwise provided to the source code responsible for creating the contextual dialog box, and thus, it cannot take that content into account when generating” the UI behavior. *Id.* at 870. The Federal Circuit affirmed, holding that the source code showed the accused system did not perform the claimed functionality, and that UI behavior alone could not override the absence of supporting code. *See, e.g., id.* at 862.

The same reasoning applies here. As in *Mirror Worlds*, Dr. Singh relied exclusively on product testing and failed to present any source code to the jury that proved character-level selection as required by the Court’s construction. In contrast, Samsung’s expert, Dr. Kia, provided detailed source code analysis showing that the Gallery app responds to spatial input (screen coordinates), not character input. Dr. Kia corroborated that analysis by proving that the accused functionality in the Gallery app does not involve the selection of “a letter, number, punctuation mark, or other symbol or control code that is represented to a computer by one unit of information,” as required by the construction of “character.”

The Federal Circuit’s holding in *Mirror Worlds* confirms that where source code contradicts UI-based inferences, the source code controls. The court held that “[i]f there is a

single data unit received or generated by the specified computer system that does not get put into the corresponding main stream, the limitation is not met.” *Mirror Worlds*, 122 F.4th at 870.

Similarly, here, if the source code does not implement character-level selection, the Character Selection limitations are not met, regardless of what the UI appears to do. Thus, no reasonable jury could have found infringement of claim 1 of the ’815 patent.

B. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Infringement of Claims 21 and 24 of the ’815 Patent.

Samsung is entitled to JMOL of noninfringement of claims 21 and 24 of the ’815 patent. No substantial evidence supports the jury’s infringement verdict on claims 21 and 24, and no reasonable jury could have found that the Netflix app running on the Galaxy S23 infringes claims 21 and 24. In the alternative, Samsung is entitled to a new trial on this issue.

1. Claims 21 and 24 Require That a “Character” Be Represented by One Unit of Information.

Claims 21 and 24 require, among other things:

[D]isplaying, in response to the selection, a second user interface for a user to select desired video information to be reproduced from among the first video information, the second user interface being associated with the first user profile and displaying the first character, the first character associated with a first group of video information and indicating an identity of the user of the first user profile.

The claims therefore require a first “character,” which the Court construed as “a letter, number, punctuation mark, or other symbol or control code that is represented to a computer by one unit of information.” Docket No. 107 at 31. Maxell failed to present any evidence that the Netflix app running on the Galaxy S23 satisfies the “character” requirement, as construed.

2. The Miyagi-Do Icon Is Not a “Character” as Construed.

Dr. Singh identified only the Miyagi-Do Karate icon in the Netflix app as the alleged first “character,” and did not identify anything else that could allegedly satisfy the Court’s

construction. He testified that the Galaxy S23 detects a press on the overall graphical image, not specifically on the letter “M.” Trial Tr. at 782:16-19. On redirect, he testified that the Miyagi-Do icon includes an “M” and that the “M” is literally a letter, but critically did not testify that the “M” was represented to the computer by one unit of information. Trial Tr. at 776:10-24. His testimony therefore failed to prove that the Miyagi-Do icon, or any part of it, is represented to the computer as a single unit of information, as required by the Court’s construction.

Dr. Singh also admitted that he did not present the Netflix source code to the jury, relying instead on the visual appearance of the Miyagi-Do icon. Trial Tr. at 764:18-22. He acknowledged that the icon is a single integrated graphical image composed of 455 pixels, each stored as three bytes of information—totaling more than a thousand bytes. Trial Tr. at 769:21-771:5. His admission contradicts the claim requirement that a “character” be represented by one unit of information. No reasonable jury could find that a 455-pixel image, represented by more than a thousand bytes, constitutes a “character” under the Court’s construction.

In contrast, Dr. Kia provided clear and technically grounded testimony that the Miyagi-Do icon used in the Netflix app is not a “character.” Trial Tr. at 1018:8-1020:19. Dr. Kia explained that the icon is a composite image made up of hundreds to thousands of pixels, each with multiple values, and therefore cannot be considered a single unit of information. He emphasized that the entire icon, not any individual letter or portion, responds to user interaction, reinforcing that the image functions as a unified graphical object. Dr. Kia further testified that even the letter “M” within the icon is merely a visual arrangement of “tens to hundreds of pixels” each of which includes brightness and color values and thus is represented to the computer by much more than one unit of information. Trial Tr. at 1019:11-1020:2.

Samsung's source code expert, Ryan West, corroborated this conclusion. Based on his review of prior art Netflix source code, [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] Mr. West's analysis of the prior art code aligned with Dr. Kia's testimony and confirmed that the image is not represented to the computer as a single character or unit of information.

Taken together, the testimony of Dr. Kia and Mr. West proved that the Miyagi-Do icon is not a "character" under the Court's construction, and therefore the accused functionality in the Netflix app on Samsung devices does not meet the limitations of the asserted claims. Samsung is therefore entitled to JMOL of noninfringement of claims 21 and 24 of the '815 patent.

3. Dr. Singh's Infringement Theory Relied on a Phone That Did Not Have Netflix Preinstalled, Contrary to His Testimony.

Dr. Singh testified that his opinion for claim 21 relies on the Netflix app being preinstalled on a Samsung phone, and he admitted that his expert report attempts to show infringement by Samsung only for Galaxy phones sold with the Netflix app preinstalled. Trial Tr. at 757:17-758:1. However, the jury was not presented with any Galaxy S23 phone that had Netflix preinstalled. Although Dr. Singh claimed that the Galaxy S23 phone he presented to the jury had the Netflix app preinstalled (Trial Tr. (Sealed Portion No. 9) at 117:23-118:16), his assertion was contradicted by the testimony of Samsung's expert, Dr. Kia (Trial Tr. at 1015:24-1017:7). Dr. Kia testified that he examined the same phone and confirmed through the app information screen that the Netflix app had been downloaded from the Google Play Store, not preinstalled. Trial Tr. at 1015:24-1017:7.

Dr. Kia also testified that none of the three Galaxy S23 phones discussed at trial—including the one tested by Dr. Singh and the two Dr. Kia personally purchased and analyzed—had the Netflix app preinstalled. *Id.* He explained that he had to manually download the Netflix app on both of his devices, one from the Galaxy App Store and the other from the Google Play Store. Trial Tr. at 1015:1-18. Thus, all physical samples presented at trial and in evidence had a Netflix app that had been downloaded, not preinstalled.

Dr. Singh's infringement opinion for claim 21 (and by extension for dependent claim 24) was limited to Galaxy phones with a preinstalled Netflix app, and he offered no infringement opinion about any phone without a preinstalled Netflix app. Despite this, Maxell offered no evidence at trial of any Galaxy S23 phone with a Netflix app preinstalled and therefore failed to meet its burden of proof. The jury was not presented with substantial evidence from which it could reasonably conclude that the accused Galaxy S23 devices were sold with the Netflix app preinstalled. Dr. Singh's unsupported assertion was directly refuted by Dr. Kia's detailed and unrebutted technical analysis. Samsung is entitled to JMOL or, in the alternative, new trial on the question of infringement of claims 21 and 24.

4. Maxell Did Not Present the “Continue Watching” Feature in its Case-in-Chief, So it Cannot Support a Finding of Infringement.

Recognizing the insufficiency of its infringement case, Maxell tried to introduce a new infringement theory at trial related to the “first character” limitation. Specifically, Maxell argued that the display of usernames followed by the “Continue Watching” text on the home screen of the Netflix app running on the Galaxy S23 satisfies the requirement that the second user interface display a “first character ... indicating an identity of the user of the first user profile.” However, Maxell did not present this infringement theory through its own expert during its case-in-chief. Rather, Maxell improperly tried to raise this new theory during the cross-examination of Dr. Kia.

Dr. Singh never identified or relied upon the “Continue Watching” feature in his analysis of claims 21 and 24. He did not refer to it during his testimony, did not include it in any exhibits, and never rendered an opinion that this feature infringes any asserted claim. Maxell made no attempt to establish infringement based on this feature through its own evidence or expert testimony. Instead, Maxell’s counsel asked a hypothetical question of Dr. Kia during cross-examination: “If you have the exact same functioning on Galaxy S23, continue watching for kids, wouldn’t that infringe?” Trial Tr. at 1085:16-20. Confronted with a hypothetical feature he had not previously analyzed, Dr. Kia responded only that it “potentially” could infringe. *Id.* He did not testify that it did infringe, nor did he offer any definitive or affirmative opinion on the matter. His use of the word “potentially” reflects the hypothetical nature of the question and the absence of any technical analysis or evidentiary foundation. *Id.*

Dr. Kia’s noncommittal response to a hypothetical question does not constitute substantial evidence of infringement. A “potential” infringement theory raised for the first time during cross-examination of the opposing party’s expert—without any supporting analysis, documentation, or expert opinion from Maxell—falls far short of the substantial evidence standard required to support a jury verdict. The jury was never presented with any evidence showing how the “Continue Watching” feature functions on the Galaxy S23, let alone how it satisfies each limitation of claim 21, including the requirement that the second user interface display a “first character” indicating the identity of the user.

Thus, because Maxell failed to present any infringement theory based on “Continue Watching” in its case-in-chief, and because Dr. Kia’s noncommittal testimony does not constitute substantial evidence, no reasonable jury could find infringement on this basis. Samsung therefore entitled to JMOL on claims 21 and 24.

C. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Invalidity of Claim 1 of the '815 Patent.

Samsung is entitled to JMOL of invalidity of claim 1 of the '815 patent. Dr. Kia presented evidence establishing that the Apple iPhone 8 was on sale and in public use on September 22, 2017 (Trial Tr. at 1031:11-17, citing DTX-77), and that each limitation of claim 1 is either disclosed or would have been obvious in view of the Apple iPhone 8 (Trial Tr. at 1032:2-1044:25). That evidence stands unrebutted. Trial Tr. at 1204:25-1205:10. The only dispute raised at trial regarding the invalidity of claim 1 was whether the iPhone 8 constitutes prior art, and the only dispute on that issue is whether claim 1 is entitled to a priority date earlier than November 9, 2017. Trial Tr. at 1206:1-23. Based on the evidence at trial, no reasonable jury could find that the '815 patent is entitled to any earlier priority date. Samsung therefore is entitled to JMOL of invalidity or, in the alternative, a new trial on this issue.

1. There Is No Written Description Support for the “No Deletion” Limitation Prior to November 9, 2017.

Dr. Singh asserted that the '815 patent claims priority to a chain of U.S. applications stretching back to August 11, 2015. Trial Tr. at 676:19-677:3 and 1195:5-16; *see also* PX-006 ('815 patent) at 1-2 (“Related U.S. Application Data”). It is undisputed that if any application in that chain lacks written description support for any limitation of claim 1 (a break in the chain), claim 1 is not entitled to priority to that application or any earlier application in the chain. Trial Tr. at 1209:14-1211:4; *see also Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.”). To comply with the written description requirement, an application must disclose a limitation either expressly or inherently.

See Jury Instructions at 16 (“The specification must describe the full scope of the claimed invention, including each element thereof, either expressly or inherently.”).

The dispute about the correct priority date for claim 1 turns on the single issue of whether the great-grandparent application, U.S. Application No. 15/176,435 filed on June 8, 2016 (the “Great-Grandparent Application”), satisfies the written description requirement for the limitation quoted below, referred to as the “No Deletion Limitation”:³

[U]pon one video information stored on the recording medium included in both the first group of video information and the second group of video information being deleted from the first group of video information, the one video information continues to be included in the second group of video information and the processor controls the display to display a thumbnail corresponding to the one video information as one of the second group of thumbnails when the second character is selected....

Samsung proved that the “No Deletion Limitation” is neither expressly nor inherently disclosed in the Great-Grandparent Application.

Dr. Kia testified that determining the priority date of a patent claim involves several well-established principles. First, each claim must be evaluated on its own, meaning that different claims within the same patent can have different priority dates. Trial Tr. at 1025:6-1026:25. Second, every limitation in a claim must be disclosed in the patent’s written description, either expressly or inherently. *Id.* An express word-for-word disclosure is not required, but there must be clear and unambiguous language that a person skilled in the art would understand. *Id.* In contrast, an inherent disclosure exists only if the limitation is the only possible implementation—if multiple alternatives are possible, it cannot be considered inherent. *Id.* Finally, it is not enough

³ Unlike the Great-Grandparent Application, the grandparent application, U.S. Pat. App. No. 15/808,175 filed on November 9, 2017, was filed with an original claim that included the No Deletion Limitation and thus satisfies the written description requirement. DTX-61 at 11.

for a limitation to be merely obvious to someone skilled in the art; it must be explicitly or inherently disclosed in the patent documentation. *Id.*

Dr. Kia testified that neither the specification nor Figures 6 and 7 expressly disclose what happens to a video (*e.g.*, item 502) in one folder (*e.g.*, “father”) when it is deleted from another folder (*e.g.*, “mother”). Trial Tr. at 1028:22-1029:5. Dr. Kia further testified that there was no inherent disclosure of the No Deletion Limitation because the system discussed in the ’815 patent could be configured to implement the deletion of an item such as item 502 from the Mother folder in Figure 6 in at least two ways that are different from what is required in the No Deletion Limitation: (1) the system could be configured to delete the item from both the Mother and Father folder, or (2) the system could be configured to ask the user to identify from which folders the item should be deleted. Trial Tr. at 1029:6-17.

2. Dr. Singh Failed to Show Written Description Support For the No Deletion Limitation.

In light of this evidence from Dr. Kia, Maxell bore the evidentiary burden to show entitlement to priority to an earlier application. *Tech. Licensing Corp. v. Videotek Inc.*, 545 F.3d 1316, 1328-29 (Fed. Cir. 2008); *PowerOasis, Inc. v. T-Mobile USA, Inc.* 522 F.3d 1299 (Fed. Cir. 2007). Dr. Singh’s testimony was insufficient to rebut Dr. Kia’s testimony or to support a finding that the Great-Grandparent Application provided written description support for the No Deletion Limitation. The entirety of Dr. Singh’s analysis of the disclosure of the Great-Grandparent Application is as follows:

Well, as an example, here we see the description of Figure 6 from the patent around Column 6, 19 through 40, and it shows a mother folder dedicated to herself where a user can freely register and delete data to be reproduced.

And then further down in the passage using near identical language, there’s an example in Figure 7 of a father folder where video data can be freely registered and deleted.

So these disclosures, taken together with that Level 3 data structure that the patent has designed to provide independent management for videos, playlists, and users without interference from each other, it clearly discloses that when a video is removed from a folder, group, or playlist, it is not removed or deleted from any other folder, group, or playlist that it might appear in.

Tr. at 1193:25-1194:14. Nothing in the quoted testimony established an express or inherent disclosure of the No Deletion Limitation. Dr. Kia did not identify any express disclosure in the passage at 6:19-40. *Id.*

This failure became even more apparent on cross-examination, where Dr. Singh confirmed that to support a limitation, the specification must either expressly or inherently disclose it (Trial Tr. at 1212:11-17), and an express disclosure must be specific and unambiguous (*id.* at 1213:8-11). He also acknowledged that inherent disclosure requires the limitation to be the only possible implementation. *Id.* at 1213:21-1214:1. Dr. Singh conceded that Figures 6 and 7 of the '815 patent do not disclose the No Deletion Limitation or what happens to video information in another folder if it is deleted from one folder. Trial Tr. at 1214:2-19. He agreed that while the passage of the specification at 6:19-40 allows users to manage their own content, that passage does not state that users can interact with folders independently or "without interference." Trial Tr. at 1217:6-1218:7. He further agreed that the specification does not explain what happens to item 502 in Figure 6 when it is deleted in Figure 7. *Id.* Dr. Singh offered no testimony that would establish inherent disclosure of the No Deletion Limitation and did nothing to rebut Dr. Kia's testimony that there was no inherent disclosure because the '815 patent system could be implemented to delete an item from the Mother or Father folders in ways other than practicing the No Deletion Limitation.

At one point, Dr. Singh stated that the passage at 6:19-40 expressly discloses the No Deletion Limitation. Trial Tr. at 1215:24-1216:2. That testimony is not sufficient to support the

jury's verdict for two reasons. First, Dr. Singh later admitted that there was no express disclosure of what happens in the Father folder when an item such as 502 is deleted from the Mother folder. Trial Tr. at 1217:12-17. Second, the jury must disregard this statement because the '815 patent and the Great-Grandparent Application, which were both in evidence, clearly contradict it. The passage at 6:19-40 does not expressly disclose the No Deletion Limitation because it does not state what will happen in the Father folder when an item is deleted from the mother folder or vice-versa. The jury is not free to ignore this evidence. *Novartis Pharm. Corp. v. Accord Healthcare*, 38 F.4th 1013, 1018 (Fed. Cir. 2022) ("The contrary testimony of Novartis' second physician expert, Dr. Steinman, is inconsistent with the plain text of the specification and therefore carries no weight.").

Because there is no substantial evidence supporting a priority date earlier than November 9, 2017 for claim 1, and because Maxell has failed to meet its burden under 35 U.S.C. § 112, the Court should enter JMOL establishing that the priority date for claim 1 is no earlier than November 9, 2017, which in turns renders claim 1 invalid.

D. Samsung Is Entitled to JMOL or, in the Alternative, New Trial on the Question of Invalidity of Claims 21 and 24.

Samsung is entitled to JMOL of invalidity on claims 21 and 24 of the '815 patent. Dr. Kia established that both the Galaxy S10 and the Netflix app were in public use prior to May 26, 2020. Trial Tr. at 1050:19-24 (citing DTX-52 stating that the Galaxy S10 was released on March 8, 2019), 1051:9-19 (citing DTX-73 stating that the Netflix app was released on February 17, 2019). Dr. Kia also demonstrated that the Galaxy S10 running the Netflix app renders obvious all limitations of claims 21 and 24. Trial Tr. at 1051:20-1065:1. Maxell did not rebut this evidence at trial. Trial Tr. at 1204:10-18; 1205:11-25. Similar to claim 1, the only dispute raised at trial about the invalidity of claims 21 and 24 was whether the Samsung Galaxy S10 running the Netflix app

constitutes prior art, and the only dispute there is whether claims 21 and 24 are entitled to a priority date earlier than the date on which the '815 patent was filed on May 26, 2020. Trial Tr. at 1206:1-23. No reasonable jury could find that the '815 patent is entitled to any earlier priority date. In the alternative, Samsung is entitled to a new trial on this issue.

1. There Is No Written Description Support for the “Encrypted” Limitation Prior to May 26, 2020.

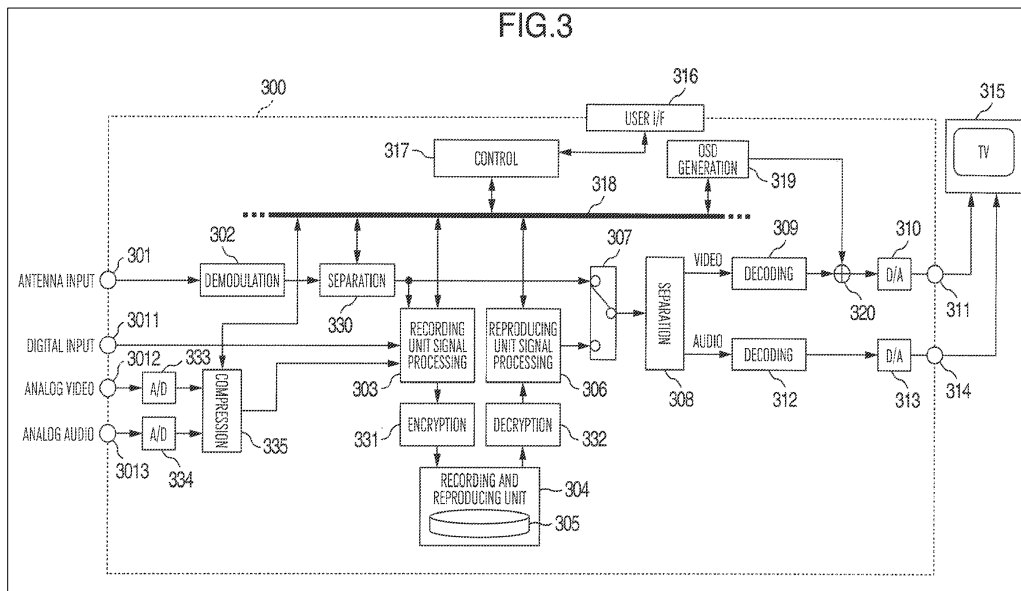
The Encrypted Limitation first appeared in the claims of the '815 application filed on May 26, 2020. Trial Tr. at 1045:7-1046:9. Thus, the dispute about the correct priority date for claims 21 and 24 turns on the single issue of whether the specifications of the earlier-filed applications to which the '815 patent claims priority (exclusive of their original claims) satisfies the written description requirement for the limitation below, referred to as the “Encrypted Limitation”:

[R]eceiving ... first video information wirelessly from a device external to the information processing apparatus, the first video information being received including second video information that is encrypted

'815 patent (PX-006) at 6:6-10. At trial, Dr. Kia testified that claim 21 requires that the second video information be “in encrypted form at the time that it was received,” which is consistent with the Court’s construction of “receiving first video information including second video information that is encrypted.” Trial Tr. at 1046:19-25. Dr. Kia confirmed that under the Court’s construction, the claim requires “encrypt then receive.” *Id.* at 1047:1-6.

Dr. Kia testified that the original patent specification, including Figure 3, discloses the opposite; that is, a system in which video is first received by the phone and then encrypted internally. Trial Tr. at 1047:10-18. Dr. Kia testified that, according to Figure 3, the video is not encrypted when it is outside of the device. *Id.* at 1048:2-18. He explained that the encryption occurs only after the video enters the device, specifically within the encryption circuit 331,

which is part of the device's internal architecture 300 and which encrypts the video before being recorded for later retrieval. *Id.* Dr. Kia further testified that Figure 3, along with the accompanying written description in the specification, does not support the requirements of claim 21. *Id.* In fact, he stated that it discloses the opposite of what claim 21 requires. *Id.*



'815 patent, Fig. 3.

In addition to the absence of any express or implied disclosure of encryption in the '815 patent, Dr. Kia testified that encryption is also not inherent. He testified that the ATSC (Advanced Television Systems Committee) standard, which governs over-the-air television broadcasts in the United States, confirms that such video signals are “always unencrypted and is currently unencrypted.” Trial Tr. at 1048:19-1049:7. Thus, the video entering the device, as described in the original specification, is not encrypted, again contradicting the claim's requirement under the Court's construction. *Id.* Finally, Dr. Kia confirmed that the figures and specification have “always been the same over all of these years,” and that the encrypted video limitation was introduced for the first time in the claims filed on May 26, 2020. Trial Tr. at 1049:9-1050:3. He testified that the Encrypted Limitation was first disclosed to the Patent Office through that application. *Id.*

2. Dr. Singh Failed to Show Written Description Support For the Encrypted Limitation.

Dr. Singh failed to rebut Dr. Kia's showing that there was neither express nor inherent written description support for the Encrypted Limitation as construed. Moreover, on cross-examination, Dr. Singh admitted that there was no such support. With respect to express disclosure, Dr. Singh admitted on cross-examination that encryption is expressly discussed in the '815 patent only in connection with element 331 of Figure 3. Trial Tr. at 1220:18-1221:4; 1222:17-23. As shown in Figure 3, element 331 is an internal component of the device 300 and thus could not possibly encrypt any signal before it was received by device 300. Dr. Singh further admitted that there was no implied disclosure of video being received in encrypted form because it was possible for video to be received in unencrypted form. Trial Tr. at 1223:17-21; 1225:11-1226:8. These admissions are fatal because they establish that there is no express or implied disclosure in the '815 patent that video broadcasts are received in encrypted form, and thus there is no written description support for the Encrypted Limitation.

Dr. Singh made two assertions in an attempt to show written description for the Encrypted Limitation. He testified that digital broadcasts of video were "typically" encrypted and that the discussion of digital broadcasts "implied" encryption. Trial Tr. at 1221:5-1222:2; 1225:7-10; *see also* Trial Tr. at 1198:21-1199:8. Neither is sufficient to establish written description support, which requires either express or implied disclosure. "Digital broadcast" is simply not an explicit disclosure that the broadcast is encrypted. Dr. Singh's assertion that it is (Trial Tr. at 1221:17-20) is contrary to the plain meaning of explicit and contrary to Dr. Singh's admission that nothing in the description of Figure 3 explicitly discloses that video is received in encrypted form. His testimony therefore must be accorded no weight. *Novartis*, 38 F.4th at 1018. Dr. Singh's testimony about implied disclosure is not sufficient because the Federal Circuit has

rejected the notion that the written description requirement can be satisfied by implicit disclosure. *Id.* at 1017, n. 2. “Typically” is not sufficient to establish inherent disclosure because inherent disclosure requires that the limitation necessarily be present. Jury Instructions at 16; *PowerOasis*, 522 F.3d at 1306. Additionally, there is no support for Dr. Singh’s assertion that the encryption element 331 in Figure 3 “essentially passes the data on” if it is encrypted. *Compare* Trial Tr. 1223:5-9 with ’815 patent (PX-006) at 5:7-27. Finally, Dr. Singh’s assertion that a person of skill in the art “would know that it’s what makes sense that streaming data ... would be in encrypted form upon receipt” is nothing more than an assertion that encryption was obvious, which is not sufficient to satisfy the written description requirement. *Lockwood*, 107 F.3d at 1571-72.

Because the original specification does not support the Encrypted Limitation of claims 21 and 24, and because this limitation was first introduced in the May 26, 2020 application, no reasonable jury could find that these claims are entitled to an earlier priority date or that the ’815 patent is not invalid. Samsung therefore is entitled to JMOL of invalidity of claims 21 and 24.

V. THE ’848 PATENT

Samsung is entitled to JMOL of noninfringement of claims 11 and 12 of the ’848 patent. There was no legally sufficient evidentiary basis to find infringement, because Samsung’s products do not have a “first setting mode,” as required by claim 8 (upon which claims 11 and 12 depend). In the alternative, Samsung is entitled to a new trial on this issue.

The disputed limitations, reproduced below, require two different modes for registering a person as a specific person:

[8.g] register a person in the image information as a specific person in a mode selected from a first setting mode and a second setting mode, wherein, when the first setting mode is selected, a person with a face is obtained by newly photographing the person in a

photographing mode and thereafter registered as the specific person,

[8.h] and, when the second setting mode is selected, a person with a face in the image information is selected from a plurality of faces in the image information recorded in the recording medium and thereafter registered as the specific person;

PX-005 at 15:51-16:9. JMOL is warranted because the evidence proves that the representative Samsung products, the Galaxy S23 and Galaxy S23 Ultra, do not include the “first setting mode” required by limitation [8.g]. In the “first setting mode,” a person is “newly photograph[ed],” and the image information from the newly captured photo is thereafter used to register the person as “the specific person.” PX-005 at 15:66-16:2. This is distinguished from the “second setting mode,” which requires selecting a person from a plurality of people whose faces appear in image information that already has been recorded in the recording medium, and the image information of the selected person is used to register the selected person as “the specific person.” PX-005 at 16:3-7. In short, the claims require that that “first setting mode” registers a person using a newly captured photo and the “second setting mode” registers a person using a saved photo.

Maxell’s evidence showed that the Galaxy S23 and S23 Ultra have only a “second setting mode” for registering a person using photographs already saved on the devices, not a “first setting mode” that registers a person from a newly-captured photograph. Indeed, there was no evidence at trial that the Galaxy S23 or S23 Ultra are capable of registering a person from a newly-captured photograph. Under Maxell’s infringement theory, a person (Hawah) is first registered as a specific person by creating an auto-updating album for her in the Gallery app. Trial Tr. at 652:21-653:5, 654:4-656:24, 657:16-658:21; PDX-6.54. The parties did not dispute at trial that the auto-updating album was created using photographs of Hawah already saved on the device. *Id.* It is also undisputed that because this process registered the person (Hawah) from photographs saved on the device, it was a “second setting mode” under limitation [8.h]. *Id.*

Critically, the creation of the auto-updating album (*i.e.*, the “second setting mode”) happens before the alleged “first setting mode” step ever occurs. *Id.*

For the alleged “first setting mode,” Maxell and Dr. Balakrishnan pointed to the taking of new photographs of Hawah and then observing that the photographs, which were immediately saved to the Gallery app, were subsequently sorted into the already-created auto-updating album for Hawah. Trial Tr. at 659:18-661:7, 664:17-22, 995:7-11. It is undisputed that this sorting takes place once the Gallery app recognizes that the face in the new picture belongs to the already-registered person Hawah, a process that could take as long as 24 hours. *Id.* There was no dispute that, at the time of what Dr. Balakrishnan calls the “first setting mode,” the person (Hawah) had already been “registered once in the second setting mode.” Trial Tr. at 658:16-21. There was also no dispute that the functions alleged to be part of the “first setting mode” operate on photos saved in the Gallery app, which could have been saved on the device for a day or more before the devices’ automatic sorting functionality takes effect. Trial Tr. at 658:22-659:21, 664:17-22. No reasonable jury could find from this evidence that the Galaxy S23 and S23 Ultra infringe the asserted claims of the ’848 patent.

Despite the uncontroverted evidence of how the Galaxy S23 and S23 Ultra operate, Dr. Balakrishnan testified that because the already-registered person’s “face gets recognized every time a picture gets taken,” the person is being “reregister[ed]” every time the Gallery app’s face-recognition software sorts a new photo into an existing auto-updating album. Trial Tr. at 661:1-7, 662:17-663:1. That testimony, however, cannot establish that the Galaxy S23 and S23 Ultra meet limitation [8.g]. Sorting a photograph using face recognition technology is not registration according to the “first setting mode” of limitation [8.g]. Registration is an act of enrollment,

which Maxell's expert Dr. Wobbrock⁴ concedes, and enrollment of a person as "a specific person" on the Samsung products is only performed from photographs saved to memory in the Gallery app. Trial Tr. (Sealed Portion No. 5) at 96:7 (Dr. Wobbrock: "Now, enrollment is the same thing as registering."); Trial Tr. at 971:9-16, 992:15-993:21. Under the plain language of limitations [8.g] and [8.h], that can only be a "second setting mode." PX-005 at 15:51-16:9. Even if one were to accept Dr. Balakrishnan's claim that the "first setting mode" he identified in the accused products constitutes registering a person as a specific person, it still cannot meet limitation [8.g] because this sorting process is applied to photos saved in the Gallery app, not to a newly-captured photograph. Trial Tr. at 659:18-661:7, 664:17-22, 995:7-11.

Dr. Balakrishnan repeatedly testified that sorting new photographs constitutes "reregistration." Trial Tr. at 661:1-7, 662:17-663:1. But his own admissions and Maxell's statements at trial indicate, at most, that what Dr. Balakrishnan calls "reregistration" in a "first setting mode" is the Samsung phones using face recognition in the Gallery app to save a photograph to a designated place in the device's memory (such as the auto-updating album created in the "second setting mode"). Trial Tr. at 658:22-659:21, 1321:16-1322:5 (Closing: "Dr. Kia suggests that the person is somehow sorted into the auto-updating album without facial recognition. That can't be the case. The photo must be processed for facial recognition through that registration process."). Neither of these functions—performing face recognition or saving a photo to a specific location in the device's memory—constitute "registration" under limitations [8.g] and [8.h], especially given that both of those functions are recited as separate claim elements in limitations [8.d] and [8.e]. PX-005 at claim 8 (reciting "recording the image

⁴ Dr. Wobbrock identified himself as an expert in human-computer interaction, the same field of expertise as Dr. Balakrishnan. Trial Tr. at 430:12-13, 590:12-14.

information in a recording medium” and “executing a face-recognizing process on the image information to recognize a face” as separate limitations from the registration claim elements). Maxell’s infringement theory does not hold up under the plain language of the asserted claims.

Maxell presented no evidence of a “first setting mode” apart from Dr. Balakrishnan’s unsupported say-so, which contradicts both the claim language and the evidence at trial. Samsung therefore is entitled to JMOL or, in the alternative, new trial on the question of infringement of the ’848 patent.

VI. WILLFUL INFRINGEMENT

Samsung is entitled to JMOL on willful infringement. Maxell failed to present legally sufficient evidence to support a finding that Samsung knew or should have known that its actions constituted an unjustifiably high risk of infringement of a valid and enforceable patent. The jury’s willful infringement verdict therefore is not supported by substantial evidence. In the alternative, Samsung is entitled to a new trial on willful infringement.

A. Legal Standards for Willful Infringement

“[A] proper claim of willful infringement requires factual allegations that suffice to show both (1) ‘knowledge of the asserted patents’ and (2) ‘culpable conduct or any set of facts supporting an inference of culpable conduct.’” *Daedalus Prime LLC v. MediaTek, Inc.*, No. 2:24-CV-00235-JRG, 2025 WL 825188, at *2 (E.D. Tex. Mar. 13, 2025) (citing *Fractus, S.A. v. TCL Corp.*, No. 2:20-CV-00097-JRG, 2021 WL 2483155, at *4 (E.D. Tex. June 2, 2021)). The burden is on the plaintiff to show, by a preponderance of the evidence, that the defendant had knowledge of the patent alleged to be infringed. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1341 (Fed. Cir. 2016) (citation omitted) (“Knowledge of the patent alleged to be willfully infringed is a prerequisite to enhanced damages.”). The burden is also on the plaintiff to prove subjective willfulness; that is, “proof that the defendant acted despite a risk of infringement that was ‘either

known or so obvious that it should have been known to the accused infringer.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1371 (Fed. Cir. 2017) (citations omitted). “For an accused infringer to willfully infringe, the risk of infringement must either be ‘known or so obvious that it should have been known to the accused infringer.’” *Team Worldwide Corp. v. Acad., Ltd.*, No. 2:19-cv-00092-JRG-RSP, 2021 WL 1897620, at *3 (E.D. Tex. May 3, 2021), *order clarified sub nom. Team Worldwide Corp. v. Acad., Ltd.*, No. 2:19-cv-00092-JRG-RSP, 2021 WL 1854302 (E.D. Tex. May 10, 2021), *adopted sub nom. Team Worldwide Corp. v. Acad., Ltd.*, No. 2:19-cv-00092-JRG-RSP, 2021 WL 1985688 (E.D. Tex. May 18, 2021), and *report and recommendation adopted*, No. 2:19-cv-00092-JRG-RSP, 2021 WL 1985688 (E.D. Tex. May 18, 2021).

For willful infringement, the key inquiry is whether there is evidence, in addition to the defendant’s pre-suit knowledge of the patents, that proves the defendant’s “infringement was ‘egregious,’ ‘deliberate,’ ‘wanton,’ or otherwise characteristic of the type of infringement that warrants the Court exercising its discretion to impose the ‘punitive’ sanction of enhanced damages.” *Erfindergemeinschaft UroPep GbR v. Eli Lilly & Co.*, No. 2:15-CV-1202-WCB, 2017 WL 2190055, at *3 (E.D. Tex. May 18, 2017) (citing *Continental Circuits LLC v. Intel Corp.*, No. CV 16-2026, 2017 WL 679116, at *11 (D. Ariz. Feb. 21, 2017) (after *Halo*, “awareness of the patent and continued use of the infringing product despite ‘an objectively high likelihood’ of infringement or ‘reckless disregard’ of that risk no longer compel a finding of willfulness”)); *Vehicle IP, LLC v. AT&T Mobility LLC*, 227 F. Supp. 3d 319, 331 (D. Del. 2016) (“[A] party’s pre-suit knowledge of a patent is not sufficient, by itself, to find ‘willful misconduct’ of the type that may warrant an award of enhanced damages.”); *Greatbatch Ltd. v. AVX Corp.*, C.A. No. 13-723, 2016 WL 7217625, at *3 (D. Del. Dec. 13, 2016).

B. Maxell Failed to Offer Legally Sufficient Evidence of Willful Infringement.

Maxell had the burden to prove that Samsung “actually knew or should have known that its actions constituted an unjustifiably high risk of infringement.” *Arctic Cat*, 876 F.3d at 1371. Knowledge of a risk of infringement requires subjective knowledge that a particular product infringes, or an explanation of the specific activity that is allegedly infringing. *See id.*; *see also Optis Wireless Tech., LLC v. Huawei Techs. Co.*, No. 2:17-cv-00123-JRG-RSP, 2018 WL 3375195, at *6-8 (E.D. Tex. July 11, 2018); *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994) (“Actual notice requires the affirmative communication of a specific charge of infringement by a specific accused product or device.”). Here, Maxell did not offer legally sufficient evidence that Samsung willfully infringed any of the asserted patents.

1. Maxell’s Evidence of Notice of Infringement Was Legally Insufficient to Prove Willful Infringement.

The evidence Maxell presented at trial of Samsung’s notice of patent infringement was limited to two letters Maxell sent to Samsung in July 2021 (PX-20) and December 2021 (PX-29) and a citation to an unspecified patent application. Trial Tr. (Sealed Portion No. 4) at 32:22-33:16. This evidence is not legally sufficient to meet Maxell’s burden to prove that it communicated to Samsung a specific charge of infringement by specific products such that Samsung had knowledge of a clear risk of infringement.

The July 2021 letter identified two of the asserted patents (the ’086 and ’848 patents) among an undifferentiated list of more than 200 other patents. *See* PX-20; Trial Tr. at 355:3-11. The July 2021 letter identified the application for the ’815 patent, but to establish willful infringement, notice of a patent cannot be communicated through notice of a patent application. *See Software Research, Inc. v. Dynatrace LLC*, 316 F. Supp. 3d 1112, 1133-34 (N.D. Cal. 2018); *see also State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985) (“Filing an

application is no guarantee any patent will issue and a very substantial percentage of applications never result in patents. What the scope of the claims in patents that do issue will be is something totally unenforceable.”).

The December 2021 letter identified the '815 patent as part of an undifferentiated list of 22 more patents. *See* PX-29. Together, the two letters identified more than 200 patents that purportedly covered an array of technology including “imaging/camera components, image processor, proximity sensors, touch screen, power management, wireless communications including Bluetooth, Wi-Fi, NFC, and cellular communications, biometric authentication, positioning, user interfaces, [and] content management.” *See* PX-20 at 31. Neither of the letters provided claim charts or any specific identification of the three asserted patents among the 200-plus other patents. Trial Tr. at 355:16-22. Instead, Maxell demanded that Samsung consult “publicly available” information about the patents from “various other litigations.” PX-20 at 31-32; Trial Tr. (Sealed Portion No. 4) at 51:2-9; Trial Tr. at 355:16-22. Maxell deemed this information “equivalent to a claim chart.” Trial Tr. at 358:15-21.

Mr. Yamamoto’s passing reference during trial that Samsung seemingly must have known about the asserted patents because the '086 and '848 patents were cited in the specification of unspecified Samsung patent applications (Trial Tr. (Sealed Portion No. 4) at 33:3-13) is likewise legally insufficient. *See Bayer Healthcare LLC v. Baxalta Inc.*, 989 F.3d 964, 987 (Fed. Cir. 2021) (awareness of patent application that issued as asserted patent not sufficient for a finding of willful infringement). At most, this supports the contested proposition that Samsung may have had knowledge of Maxell’s patents—which issued prior to the expiration to the parties’ license agreement in 2012 and 2013, respectively. But it provides no evidence for the required showing that Samsung would have known that specific products infringe specific claims of Maxell’s

patents in 2021, when Maxell sent its letters. *See id.* Maxell's evidence therefore is legally insufficient to support the jury's verdict of willful infringement.

2. Samsung Proved at Trial That It Lacked Specific Intent to Infringe the Asserted Patents.

Willful infringement requires proof of a specific intent to infringe at the time of the challenged conduct. *Bayer Healthcare LLC*, 989 F.3d at 987. Additional evidence, such as acting against the advice of counsel, deliberately copying a competitor's product, monitoring the plaintiff's products and patent applications, or similar behavior, also is required. *See Eli Lilly*, 2017 WL 2190055, at *2-3 (defendant's failure to respond to notice letter and stating that sale of the defendant's product "appears to require a license" to the patent was insufficient circumstantial evidence to support willful infringement because it did not demonstrate conduct extreme enough to qualify as "egregious"). Maxell's assertion that Samsung allegedly continued to infringe in response to receiving Maxell's July and December 2021 letters or Samsung's alleged citation to patents in another patent application is legally insufficient to support a finding that Samsung acted with a specific intent to infringe any of the asserted patents.

On the contrary, all of the evidence proved that no reasonable jury would have a legally sufficient evidentiary basis to find for Maxell on the issue of Samsung's specific intent to infringe the asserted patents. First, following receipt of Maxell's July 2021 letter, Samsung immediately contacted Maxell to discuss the letter and request claim charts. Trial Tr. at 821:19-23; Trial Tr. (Sealed Portion No. 4) at 50:17-22. Samsung witness Youngho Kim testified that

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Mr. Kim testified that it is standard practice in the industry for

a patent holder to provide claim charts under such circumstances, especially when the enumerated list of alleged infringed patents is so large. *Id.* at 822:23-823:3. Mr. Kim testified that it was unusual that Maxell refused to provide claim charts, which caused Samsung to conclude that Maxell did not have confidence in its patents. *Id.* at 823:4-11.

Despite Samsung's three written requests, Maxell refused to provide claim charts. *See* PX-32, PX-29, PX-30; Trial Tr. (Sealed Portion No. 4) at 51:2-3; Trial Tr. at 359:4-360:24. Mr. Yamamoto testified that when Samsung requested claim charts, Maxell expected Samsung to "examine the contents of the letter." Trial Tr. (Sealed Portion No. 4) at 51:2-9; Trial Tr. at 363:4-8. Mr. Yamamoto testified that, even without more information, Samsung should have known its products infringed Maxell's patents because "the product[s] of Samsung [are] similar to the other existing licensee's products" and the existing licensee's litigation "contains a lot of information." Trial Tr. (Sealed Portion No. 4) at 53:6-12.

Second, the evidence at trial was that Maxell sent its July and December 2021 letters to Samsung more than five years after the term license specified in the 2011 Patent Sale Agreement had expired in July 2016. *See* PX-350 at §§ 1.12, 5.1; Trial Tr. (Sealed Portion No. 4) at 16:2-4, 35:12-17; Trial Tr. at 819:12-820:4. As Mr. Kim testified, Samsung thought that it [REDACTED]. Trial Tr. (Sealed Portion No. 13) at 109:20-110:9. Mr. Kim also testified that Samsung expected that, if Maxell had wanted to renew the license or believed it had patents that covered Samsung's products, Maxell would have reached out to Samsung to raise the issue sooner. Trial Tr. at 820:17-821:5. However, Mr. Yamamoto confirmed that Maxell did not contact Samsung at all between 2016 and 2021. Trial Tr. (Sealed Portion No. 4) at 35:18-22; Trial Tr. at 343:12-344:4. Mr. Yamamoto testified that, during this time, Maxell was analyzing and evaluating its patents

against Samsung's products. Trial Tr. (Sealed Portion No. 4) at 35:23-36:2. Yet, despite taking five years to evaluate whether any of Samsung's products infringed Maxell's patents, Maxell did not share any claim charts with Samsung to substantiate Maxell's claims.

Third, Samsung conclusively proved it had a good faith belief in the invalidity and noninfringement of the asserted patents. As to invalidity, Samsung's good faith belief was evidenced by, among other things, the instituted IPR proceedings on all three asserted patents. Samsung filed these proceedings because Samsung believed the patents were invalid. *See* Trial Tr. at 823:15-20. The Patent Office instituted all of the IPRs filed against the three asserted patents. *See* Trial Tr. at 379:9-13, 823:15-24; DTX-242; DTX-243; DTX-244; DTX-245; *see also* *Contour IP Holding, LLC v. GoPro, Inc.*, No. 17-cv-04738, 2021 WL 75666, at *8 (N.D. Cal. Jan. 8, 2021) ("IPR evidence is of much more probative value regarding willfulness than it is in other contexts."); *Willis Elec. Co. v. Polygroup Ltd.*, No. 15-cv-3443 (JNE/DTS), 2024 WL 118443, at *10 (D. Minn. Jan. 9, 2024) ("[T]he Court finds the IPR history pertinent for the jury to assess the allegations of [defendant]'s willful infringement"); *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1300-01 (Fed. Cir. 2023) (affirming district court's decision not to enhance damages in part because PTAB canceled the asserted claim, negating willful infringement). In fact, the Patent Office found that Samsung demonstrated a reasonable likelihood that all three patents are invalid, and that Samsung's challenge to the '086 patent was "compelling" and "the Office erred in issuing the challenged claims." *See* DTX-245; Trial Tr. at 382:3-17, 823:15-24; *see also* DTX-244, DTX-243; Trial Tr. at 824:21-827:10. The institution decisions and Patent Office's accompanying findings support Samsung's good faith belief in the invalidity of the asserted patents. *See* Trial Tr. at 827:8-11. Further, Mr. Kim testified that he had statistics showing that nearly 80 percent of instituted claims are found unpatentable. Trial Tr. at 874:3-6.

As to noninfringement, Samsung's experts, Dr. Omid Kia and Dr. Seth Nielson, testified at length as to why Samsung's products do not infringe the asserted patents.

The burden was on Maxell to prove Samsung's subjective knowledge that its actions constituted an unjustifiably high risk of infringement of any valid and enforceable patent. But Maxell failed to offer legally sufficient evidence that Samsung ever believed there was a high risk of infringement or that the asserted patents were valid and enforceable. The Court should enter JMOL or, in the alternative, order a new trial on willful infringement.

VII. DAMAGES

Samsung is entitled to JMOL on damages because Maxell failed to offer legally sufficient evidence to support the jury's \$112 million damages verdict. The jury accepted Maxell's unapportioned and speculative one percent "standard" royalty rate, as evidenced by the handwritten note on the verdict form stating that the jury awarded a running royalty for each patent through trial "Based on 1%":

3B. If you awarded Maxell an amount for Question 3A, is this amount based on:

☐ A lump sum for the life of each patent, or

☒ A running royalty for each patent through trial?

Based on 1%

Docket No. 350 at 5 (emphasis added). But Maxell's damages expert, Mr. Jarosz, conceded that (1) none of his six so-called "most comparable" licenses state a one percent royalty rate, and (2) he could not identify any Maxell smartphone license containing a one percent royalty rate. That rate, therefore, was based solely on the say-so of Maxell's interested witness, Mr. Yamamoto. And further, the evidence at trial was undisputed that the one percent rate is, if anything, a license rate for Maxell's entire patent portfolio, not for a license to only the three asserted

patents. The jury's express use of an unapportioned, portfolio royalty rate—in addition to the other failures to apportion by Maxell and Mr. Jarosz detailed below—renders the jury's verdict contrary to established Federal Circuit law. Samsung therefore is entitled to JMOL on damages, a remittitur to Samsung's damages number, or a new trial on damages.

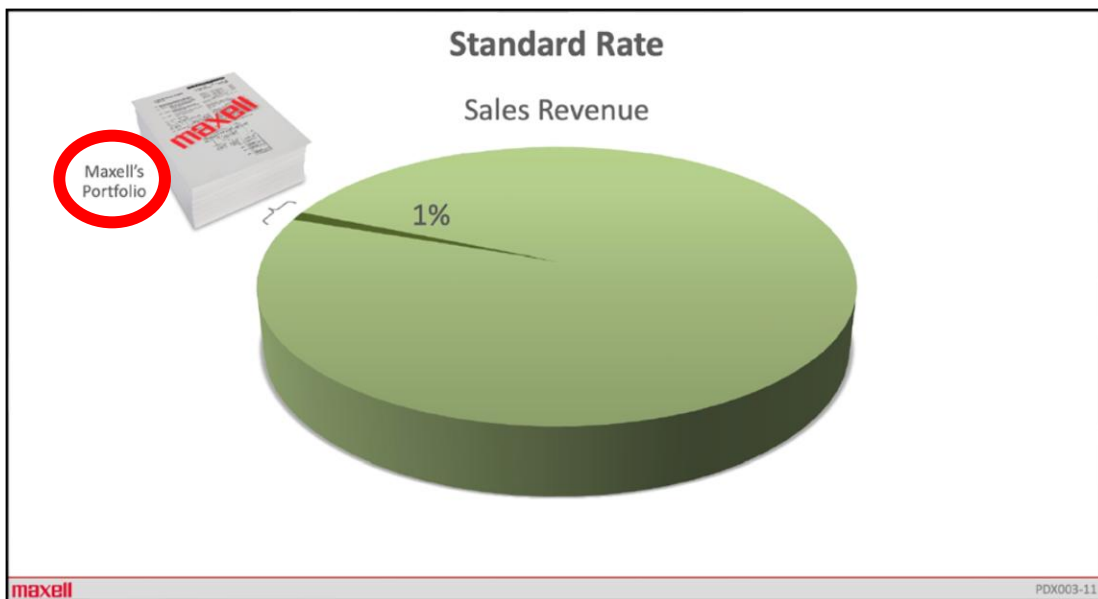
A. Samsung Is Entitled to JMOL Because the Jury's Damages Award Was “Based On” an Unapportioned and Speculative One Percent Royalty Rate.

JMOL is warranted on damages because the jury's verdict was expressly “based on” the unapportioned and speculative one percent royalty rate offered by Mr. Yamamoto and Mr. Jarosz. As part of his analysis, Mr. Jarosz identified what he claimed were the six “most relevant” licenses. Trial Tr. (Sealed Portion No. 11) at 24:9-26:13; Trial Tr. (Sealed Portion No. 12) at 75:16-76:4; *see also* PX-431, PX-416, PX-418, PX-419, PX-420, PX-422. Mr. Jarosz concluded that the parties would have agreed to a running royalty rate of between 0.4 and one percent, and the jury adopted the high end of that range in awarding damages, handwriting on the verdict form that damages were “Based on 1%.” Docket No. 350 at 5. But as demonstrated below, Maxell provided the jury with no legally sufficient evidentiary basis to calculate a reasonable royalty using a one percent royalty rate.

1. The Jury's One Percent Rate Is, at Best, a Portfolio Rate That Is Not Apportioned to the Three Asserted Patents.

In addition to the other apportionment problems detailed below (*see* Section VII.B), the one percent rate is at best a portfolio-wide rate that is not apportioned to the three asserted patents. Apportionment is required in every case, including where an expert's damages theory relies on purportedly “comparable licenses” that cover more than just the asserted patents. *See Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960, 971-74 (Fed. Cir. 2022) (“When relying on comparable licenses to prove a reasonable royalty, we require a party to ‘account for differences in the technologies and economic circumstances of the contracting parties.’”) (citing (*VirnetX, Inc. v.*

Cisco Sys., Inc., 767 F.3d 1308, 1330 (Fed. Cir. 2014)). Among other things, Maxell and Mr. Jarosz did nothing to account for the undisputed fact that Maxell’s purportedly “standard” one percent royalty rate applies to Maxell’s entire portfolio of approximately [REDACTED] patents, not to a license covering only the three asserted patents. Trial Tr. (Sealed Portion No. 4) at 36:17-18 (“You know, Maxell has a lot of patents, [REDACTED] patents, some smartphone portfolio.”); *see also* Trial Tr. at 270:16-20, 272:13-18, 273:5-18; Trial Tr. (Sealed Portion No. 11) at 35:5-15; Trial Tr. (Sealed Portion No. 12) at 81:3-8; PDX-008.24. During Mr. Yamamoto’s testimony, Maxell presented the following demonstrative to the jury, which emphasized that the one percent “Standard Rate” applies to “Maxell’s Portfolio” next to a stack of patents:



PDX-003.11 (red circle added). Indeed, each of Mr. Jarosz’s six purportedly “most relevant” licenses granted a license to [REDACTED], not a license to the three asserted patents. *See* PX-416 at .0004-.0005 (Sections 1.12, 1.13); PX-418 at .0023-.0024 (Sections 10, 12); PX-419 at .0002 (Section 1.9); PX-420 at .0002 (Sections 1.5, 1.6); PX-422 at .0002 (Sections 1.5, 1.6); PX-431 at .0012 (Section 1 (3), (4)). Despite this, Mr. Jarosz adopted that one percent rate as his high-end royalty rate without making any adjustments for the fundamental difference in

patent scope between his six chosen licenses and the hypothetical three-patent license between Maxell and Samsung. *See* Trial Tr. (Sealed Portion No. 12) at 59:13-60:9.

In *Wi-LAN*, the Federal Circuit concluded that the district court abused its discretion in denying a motion for a new trial on damages where the royalty rate did not reflect the realities of the record evidence and did not properly separate the value of the asserted patents from the rest of the licensed portfolio. *See Wi-LAN Inc.*, 25 F.4th at 971-74. The Federal Circuit vacated and remanded even though the expert had “reduced the royalty rate by 25 percent” to try to separate the value of the asserted patents from the licensed portfolio. *Id.* at 973. Here, unlike the expert in *Wi-LAN*, Mr. Jarosz made no adjustments to the one percent portfolio rate, rendering his analysis even more faulty than the analysis the Federal Circuit rejected in *Wi-LAN*. Thus, no reasonable jury could have adopted this unapportioned one percent royalty rate in reaching its verdict.

2. The Jury’s One Percent Rate Is Not Supported by Competent Evidence.

In addition to being unapportioned, the one percent rate adopted by the jury also was unsupported by competent evidence at trial. First, Mr. Jarosz cited six Maxell licenses with [REDACTED] as being the “most relevant” to his analysis, but admitted that none of those six licenses—and no licenses involving the asserted patents—state a one percent rate on their face:

[REDACTED]
[REDACTED]
[REDACTED]

[REDACTED]
[REDACTED]

Trial Tr. (Sealed Portion No. 12) at 80:19-23; *see also id.* at 76:11-80:18. He admitted that those six licenses include payment terms of [REDACTED]. *Id.* at 76:8-80:10. Julie Davis,

Samsung's damages expert, confirmed that none of Mr. Jarosz's six "most relevant" licenses include a one percent rate. Trial Tr. (Sealed Portion No. 19) at 3:13-11:11.

Second, other licenses Mr. Jarosz referenced in his testimony do not support the jury's one percent royalty rate, because those licenses (a) do not relate to smartphones, (b) do not involve the asserted patents, and (c) were not subject to any technical or economic comparability testimony at trial. Trial Tr. (Sealed Portion No. 12) at 81:12-83:15 (Jarosz "very cautious" in using the term "comparable" to describe those licenses). Mr. Jarosz confirmed that: (1) the

related to televisions; (2) the [REDACTED]; and (3) the [REDACTED] agreements were lump sum agreements that do not support a running royalty. Trial Tr. (Sealed Portion No. 12) at 81:5-83:15; Trial Tr. (Sealed Portion No. 19) at 11:12-13:23; PX-418; PX-421; PX-423; PX-424; PX-440; PX-441; PX-451. The Federal Circuit consistently holds that, when relying on comparable licenses, a party is required to account for the technological and economic differences. *See Wi-LAN Inc.*, 25 F.4th at 971 (citation omitted); *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 79 (Fed. Cir. 2012) (“When relying on licenses to prove a reasonable royalty, alleging a loose or vague comparability between different technologies or licenses does not suffice.”). Here, these licenses are neither technically nor economically comparable to the hypothetical license and therefore cannot support the jury’s one percent royalty rate.

Third, lacking support in his chosen licenses, Mr. Jarosz relied on self-serving testimony from Maxell’s corporate representative Mr. Yamamoto, who testified about Maxell’s purportedly “standard” one percent royalty rate:

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Trial Tr. at 272:4-12; *see also* Trial Tr. (Sealed Portion No. 4) at 35:5-23. Mr. Yamamoto testified that the [REDACTED] license purportedly supports a one percent royalty rate, rather than its explicit [REDACTED] percent rate, based on [REDACTED] purportedly received by Maxell without providing any additional detail or explanation. Trial Tr. (Sealed Portion No. 4) at 62:5-12; *see also* Trial Tr. (Sealed Portion No. 4) at 68:2:13 ([REDACTED] license); Trial Tr. (Sealed Portion No. 4) at 69:3-24 ([REDACTED] license). In each instance, Mr. Yamamoto offered no sales data or anything else to support his *ipse dixit* about the one percent rate that is not reflected in these licenses.

Mr. Jarosz's failure to rely on competent evidence to support the jury's one percent royalty rate runs afoul of *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333 (Fed. Cir. 2025) (*en banc*).⁵ There, the Federal Circuit held that a district court erred by failing to exclude damages expert testimony where the expert relied on licenses that were insufficient on their face to support the expert's royalty rate. The plaintiff's expert relied on (1) licenses that lacked the proposed royalty rate on their face, and (2) testimony from a corporate witness about how the proposed royalty rates purportedly were calculated. *Id.* at 1343. The Federal Circuit held that "this assertion by Mr. Kennedy [damages expert]—that prior willing licensees had agreed to the

⁵ In light of this new authority, Samsung renewed its objection to Mr. Jarosz's testimony before he testified, but the Court overruled that objection and deferred the issue until post-trial motions. Docket No. 325; Trial Tr. at 785:2-22.

\$X royalty rate—is not supported by the licenses.” *Id.* The Federal Circuit concluded: “The licenses, individually or in combination, do not support Mr. Kennedy’s opinion that the licensees were paying the \$X rate, agreed to pay the \$X rate, or agreed that the \$X rate was a reasonable royalty.” *Id.* The Federal Circuit further held that the testimony of EcoFactor’s CEO, Shaynan Habib, was “not supported by any record evidence” because (1) neither he, nor anyone at EcoFactor, had been given access to the subject sales data; and (2) nor did he “reference data from which any market predictions were made regarding past or projected sales for any of the licensees.” *Id.* at 1343-44. Mr. Jarosz’s testimony is similarly flawed as it relies only on the uncorroborated testimony of Mr. Yamamoto and therefore cannot and does not support the jury’s one percent royalty rate.

3. The Jury’s One Percent Rate Is, at Best, a Proposed But Unaccepted Offer.

Finally, as demonstrated above, the jury’s damages award is calculated from a royalty rate that was “based on a proposed, but unaccepted, license” and therefore runs afoul of *Whitserve, LLC v. Computer Packages, Inc.*, 694 F.3d 10, 29 (Fed. Cir. 2012). Using proposed but unaccepted royalty rates presents the risk that patentees “could artificially inflate the royalty rate by making outrageous offers.” *Id.* at 30 (proposed but unaccepted licensing rate was “based on pure conjecture and, like the 25% rule of thumb, is irrelevant”). A unilateral licensing “policy” is an example of a proposed, but unaccepted, license rate that is not probative of a reasonable royalty. *Omega Pats., LLC v. CalAmp Corp.*, 13 F.4th 1361, 1379 (Fed. Cir. 2021). Such offers are evidence of “nothing more than an unconsummated offer indicating what [Maxell] hoped to collect.” *On Track Innovations Ltd. v. T-Mobile USA, Inc.*, 106 F. Supp. 3d 369, 416 (S.D.N.Y. 2015).

Mr. Yamamoto's testimony confirms that Maxell offered a one percent rate, but licensees rejected that rate and ultimately licensed Maxell's patent portfolio at lower rates. Speculative testimony about unaccepted offers cannot support Mr. Jarosz's opinions that Samsung would have agreed to pay a one percent royalty. *See EcoFactor*, 137 F.4th at 1343-44; *see also Omega*, 13 F.4th at 1379 ("To hold otherwise would improperly permit [plaintiff] to hide behind its generic licensing arrangement to avoid the task of apportionment."); *Whitserve*, 694 F.3d at 30.

B. Maxell and Mr. Jarosz Failed to Perform the Required Apportionment, Requiring JMOL on the Jury's Damages Verdict.

In addition to the problems with the one percent royalty rate identified above, the jury's damages verdict based on Mr. Jarosz's opinions is not apportioned to the value of the allegedly patented features of Samsung's accused products. For starters, as demonstrated above, Mr. Jarosz failed to account for the difference in patent scope between the six licenses he selected ([REDACTED]) and the hypothetical license between Maxell and Samsung (a license to only the three asserted patents). That alone is worthy of JMOL. But the apportionment problems do not end there. Mr. Jarosz also failed to apportion out the value of unpatented technologies contained within allegedly patent-practicing components that he included in his royalty base. On the contrary, Mr. Jarosz used the entire value of those components to calculate damages without any apportionment. Mr. Jarosz claimed to use a "component cost approach" in which "one looks at the relative value of those components or the cost of those components to the cost of the whole product to determine the value of the patent." Trial Tr. (Sealed Portion No. 12) at 48:21-49:8. For the '086 patent, Mr. Jarosz testified that he conducted the following analysis:

Q. And can you walk us through -- we'll use the '086 patent as an example -- how you did this?

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Trial Tr. (Sealed Portion No. 12) at 49:12-23 (emphasis added). For the components purportedly “covered” by a particular patent, he simply added up the costs of those components to come up with an amount for each asserted patent:

Q. Now, you told us that you’re not a technical expert. So how did you know which components of the phone practice, each asserted patent?

A. The technical experts that the jury has heard from earlier in this trial gave me those inputs.

So, for instance, for the ’086 patent, if you look on the screen, they said the ’086 patent is related to certain components, the AP, AP/CP BB chipset, the fingerprint sensor, the DRAM and the -- and the NAND and the display.

So if I add up the cost of those components, I get \$ [REDACTED] And similarly for the other two patents.

Trial Tr. (Sealed Portion No. 12) at 49:24-50:10; *see also* PDX-008-34. Mr. Jarosz repeated this for each of the asserted patents. Trial Tr. (Sealed Portion No. 12) at 50:15-16; Trial Tr. (Sealed Portion No. 12) at 50:17-23.

Mr. Jarosz’s analysis failed to apportion out the value of unpatented technologies contained within the allegedly patent-practicing components that he included in his royalty base. By adding up Samsung’s cost to purchase each allegedly patent-practicing component, such as “AP, AP/CP, BB chipsets” for each asserted patent, Mr. Jarosz included in his royalty the value of unpatented technologies contained in those components as shown in his trial demonstrative:

Patent-Practicing Component Cost											
Patent	AP, AP/CP BB Chipset	CP Chipset	RF Chipset	Wi-Fi Chipset	Fingerprint Sensor	Camera Image Sensor		Memory Storage		Display	Total Cost
						Front	Rear	DRAM	NAND		
'086	X				X			X	X	X	
'848	X					X	X	X	X	X	
'815	X	X	X	X		X		X	X	X	

Jarosz Report, at Tab 49. Images produced using GenAI Tools (e.g., ChatGPT). An "X" denotes component costs attributable to each patent.

PDX008-34

PDX-008-34; Trial Tr. (Sealed Portion No. 12) at 49:24-52:17. Mr. Kim testified that Samsung does not have access to details of the technology supplied by Samsung's component suppliers, such as Qualcomm, which provide components to Samsung. Trial Tr. at 876:21-877:14. And Mr. Jarosz did not take those third-party supplier's contributions into account in his component analysis. Trial Tr. (Sealed Portion No. 12) at 49:24-52:17. Mr. Jarosz's apportionment method therefore is an impermissible attempt to claim damages from both "the patented feature and the unpatented features." *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 904 F.3d 965, 977 (Fed. Cir. 2018). As a court in this District ruled, merely labeling something as an "apportionment factor" is insufficient when it "is a poor substitute for the type of analysis one should undertake when parsing an alleged infringer's profits for patented versus unpatented features." *VirnetX Inc. v. Cisco Sys., Inc.*, Case No. 6:10-cv-417, 2013 WL 789288, at *2 (E.D. Tex. Mar. 1, 2013); *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1326 (Fed. Cir. 2014) (apportionment "ensure[s] that a reasonable royalty 'does not overreach and encompass components not covered by the patent.'" (quoting *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 70 (Fed. Cir. 2012))). Because Mr. Jarosz applied his flawed component cost-

based methodology to his damages conclusions, his expert testimony is not legally sufficient to support the jury's verdict.

C. In the Alternative, Samsung Is Entitled to Remittitur or a New Trial on Damages.

If the Court denies JMOL, it should order remittitur to Samsung's proposed damages number or, in the alternative, a new trial on damages. A new trial is warranted where "the verdict is against the weight of the evidence, the damages awarded is excessive, the trial was unfair or prejudicial error." *Seidman v. Am. Airlines, Inc.*, 923 F.2d 1134, 1140 (5th Cir. 1991); *see* Fed. R. Civ. P. 59(a)(1).⁶ Alternatively, with remittitur, the Court may condition the denial of a new trial motion on Maxell's acceptance of a lower damages award if the damages awarded are excessive. *Id.* The Fifth Circuit follows the maximum recovery rule in deciding the amount of a remittitur. *Longoria v. Hunter Express, Ltd.*, 932 F.3d 360, 364-65 (5th Cir. 2019). Under the maximum recovery rule, "the verdict must be reduced to the maximum amount *the jury* could properly have awarded." *United States ex rel Montcrief v. Peripheral Vascular Assocs., P.A.*, 133 F.4th 395, 408 (5th Cir. 2025) (quoting *Caldarera v. E. Airlines, Inc.*, 705 F.2d 778, 784 (5th Cir. 1983) (emphasis added in original)).

Based on Mr. Jarosz's and Mr. Yamamoto's testimony, the jury's damages award is excessive and unsupported by the properly admitted facts. *Seidman*, 923 F.2d at 1140; *LaserDynamics*, 694 F.3d at 77-79. As demonstrated above, the jury's express adoption of the one percent royalty rate cannot support the jury's award of \$112 million for the asserted patents. Thus, the Court should offer Maxell a remittitur of the damages award to no more than \$3,465,000, the maximum amount that the jury could have properly awarded consistent with the

⁶ The Federal Circuit applies regional circuit law in deciding to grant a new trial or remittitur. *See LaserDynamics*, 694 F.3d at 66.

evidence presented at trial through Ms. Davis's testimony. *See* Trial Tr. at 1113:8-12; *see also* *Unisplay, S.A. v. Am. Elec. Sign Co., Inc.*, 69 F.3d 512, 519 (Fed. Cir. 1995) ("[T]he use of remittitur enables parties to avoid the delay and expense of a new trial when a jury's verdict is excessive in relation to the evidence of record."); *Seidman*, 923 F.2d at 1140.

VIII. CONCLUSION

For the foregoing reasons, Samsung is entitled to JMOL or, in the alternative, a new trial on all issues decided by the jury and/or remittitur of the jury's damages verdict.

Dated: July 14, 2025

Respectfully submitted,

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CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that the conference required by Local Rule CV-7(h) occurred via teleconference on July 11, 2025 between counsel for Defendants, and counsel for Plaintiff. The parties disagree about the substance of the motion, thus discussions conclusively ended in an impasse, leaving an open issue for the Court to resolve.

/s/ Melissa R. Smith
Melissa R. Smith

CERTIFICATE OF SERVICE

The undersigned certifies that on July 14, 2025, all counsel of record who are deemed to have consented to electronic service are being served with a true and correct copy of the foregoing by email.

/s/ Melissa R. Smith

Melissa R. Smith