

**IN 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

[REDACTED]

**DEFENDANTS SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG
ELECTRONICS AMERICA, INC.'S REPLY IN SUPPORT OF ITS RENEWED MOTION
FOR JUDGMENT AS A MATTER OF LAW AND MOTION FOR A NEW TRIAL
[DOCKET NO. 390]**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE '086 PATENT	1
A. '086 Patent Noninfringement.....	1
1. No Evidence of Two “Registering Modes” as Claim 1 Requires.	1
2. No Evidence of a Mode for Inputting Input Information by “an End of the Finger.”	3
B. '086 Patent Invalidity.....	4
1. Samsung Did Not Forfeit its Written Description Defense.	4
2. No Written Description Support for Using Fingerprint Information.	6
III. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE '815 PATENT	7
A. Claim 1 Noninfringement	7
B. Claims 21 And 24 Noninfringement	9
1. No Evidence “Continue Watching” Meets the “Character” Limitation of 21[f]	9
2. No Evidence that Miyagi-Do Icon Is a Unicode Character.	10
C. '815 Patent Invalidity.....	10
1. No Waiver of Samsung’s New Trial Motion.....	10
2. No Disclosure of the “No Deletion” Limitation.	11
3. No Disclosure of the “Encrypted” Limitation.	11
IV. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE '848 PATENT	12
V. SAMSUNG IS ENTITLED TO JMOL OR A NEW TRIAL ON WILLFULNESS	14
A. Legally Insufficient Evidence Of Pre-Suit Knowledge Of Infringement	14
B. Samsung Lacked Specific Intent To Infringe The Asserted Patents	15
VI. SAMSUNG IS ENTITLED TO JMOL OR A NEW TRIAL ON DAMAGES	17
A. Maxell Concedes The Damages Verdict Is Based On A One Percent Royalty.	17
B. The EcoFactor And Super Lighting Decisions Support JMOL Here.....	17
C. Maxell’s Unapportioned One Percent Rate Requires JMOL.....	18
D. Maxell’s One Percent Portfolio Rate Is At Best An Unaccepted Offer.....	19
E. In The Alternative, A New Trial Or Remittitur On Damages Is Warranted.....	20
VII. CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Allergan USA, Inc. v. MSN Labs. Priv. Ltd.</i> , 111 F.4th 1358 (Fed. Cir. 2024)	6
<i>Apple Inc. v. Wi-LAN Inc.</i> , 25 F.4th 960 (Fed. Cir. 2022)	18, 20
<i>Baisden v. I'm Ready Prods., Inc.</i> , 693 F.3d 491 (5th Cir. 2012)	20
<i>Bayer Healthcare LLC v. Baxalta Inc.</i> , 989 F.3d 964 (Fed. Cir. 2021).....	15
<i>Blitzsafe Texas, LLC v. Volkswagen Grp. Of Am., Inc.</i> , 2016 WL 4778699 (E.D. Tex. Aug. 19, 2016)	16
<i>Cascades Computer Innovation, LLC v. Samsung Elecs. Co.</i> , 77 F. Supp. 3d 756 (N.D. Ill. 2015)	15
<i>Dominion Energy, Inc. v. Alstom Grid LLC</i> , 725 F. App'x 980 (Fed. Cir. 2018)	8, 11, 13
<i>EcoFactor, Inc. v. Google LLC</i> , 137 F.4th 1333 (Fed. Cir. 2025) (<i>en banc</i>)	17, 18, 19, 20
<i>Evolved Wireless, LLC v. Samsung Elecs. Co.</i> , No. CV 15-545-SLR-SRF, 2016 WL 1019667 (D. Del. Mar. 15, 2016), <i>report</i> <i>and recommendation adopted</i> , No. 15-545-SLR-SRF, 2016 WL 1381765 (D. Del. Apr. 6, 2016)	5, 14
<i>Gustafson, Inc. v. Intersystems Indus. Prods., Inc.</i> , 897 F.2d 508 (Fed. Cir. 1990).....	17
<i>Jiaxing Super Lighting Elec. App. Co. v. CH Lighting Tech Co., Ltd.</i> , Case No. 23-1715, 2025 WL 2100650 (Fed. Cir. July 28, 2025).....	17, 18, 19, 20
<i>MacArthur v. Univ. of Texas Health Ctr. Tyler</i> , 45 F.3d 890 (5th Cir. 1995)	5
<i>Packet Intelligence LLC v. NetScout Sys.</i> , 965 F.3d 1299 (Fed. Cir. 2020).....	16
<i>Packet Intelligence LLC v. NetScout Sys., Inc. et al.</i> , No. 2-16-cv-00230 (E.D. Tex. Sept. 7, 2018).....	16

<i>Polanco v. City of Austin</i> , 78 F.3d 968 (5th Cir. 1996)	5
<i>Powell v. Home Depot U.S.A., Inc.</i> , 663 F.3d 1221 (Fed. Cir. 2011).....	13
<i>Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.</i> , 904 F.3d 965 (Fed. Cir. 2018).....	18
<i>In re Robertson</i> , 169 F.3d 743 (Fed. Cir. 1999).....	11
<i>Smith v. Transworld Drilling Co.</i> , 773 F.2d 610 (5th Cir. 1985)	4, 7, 9, 14
<i>Summit 6, LLC v. Samsung Elecs. Co.</i> , 802 F.3d 1283 (Fed. Cir. 2015).....	19
<i>Taylor Publ’g Co. v. Jostens, Inc.</i> , 216 F.3d 465 (5th Cir. 2000)	5
<i>Team Worldwide Corp. v. Acad., Ltd.</i> , No. 2:19-cv-00092-JRG-RSP, 2021 WL 1897620 (E.D. Tex. May 3, 2021)	16
<i>ZitoVault, LLC v. Int’l Bus. Machines Corp.</i> , 2018 WL 2971131 (N.D. Tex. Mar. 29, 2018).....	16
Other Authorities	
Fed. R. Civ. P. 50(a)	4, 5
Fed. R. Civ. P. 50(b)	5, 10
Fed. R. Civ. P. 59	6, 10

I. INTRODUCTION

The Samsung Defendants respectfully submit this reply in support of their Renewed Motion for Judgment as a Matter of Law and Motion for a New Trial (Docket No. 390) (“Mot.”). The baseless arguments presented in Maxell’s Opposition brief (Docket No. 401) confirm that the Court should enter judgment in Samsung’s favor on the issues of non-infringement, invalidity, no willful infringement, and damages or, at a minimum, order a new trial on all these issues.

II. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE ’086 PATENT

A. ’086 Patent Noninfringement.

1. No Evidence of Two “Registering Modes” as Claim 1 Requires.

The crux of Maxell’s argument is that the Galaxy S23 has two fingerprint registering modes because the fingerprint registration process in the Galaxy S23 requires the user to repeatedly place her finger on the fingerprint sensor. Opp. at 4-8. Maxell asserts that each time a user places her finger on the sensor is a separate “registration mode.” But other than Dr. Wobbrock’s conclusory and unsupported say-so at trial, there is no evidence supporting this assertion.

There is no dispute about how the Galaxy S23 operates. The experts agree the “enroll diagram” in the fingerprint authentication specification (PX-45 at 13 (Fig. 9)) shows how the fingerprint registration process operates. Trial Tr. at 569:20-570:16, 904:18-905:7. Dr. Wobbrock confirmed the diagram shows only one algorithm for the process, 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. The Galaxy S23 performs the same steps each time a user places her finger on the sensor. *Id.* It uses that single registration algorithm to create a single template for one fingerprint. *Id.*

Maxell’s argument that repeating the same steps satisfies limitations [1.f] and [1.g] would read “first registering mode” and “second registering mode” out of claim 1. Dr. Wobbrock never explained how the fingerprint specification shows that the fingerprint registration process uses

No. 5) at 115:25-121:14). At no point did he testify that the evidence shows anything different than what is seen in the fingerprint interface specification; namely, each time a user places her finger on the sensor, the device performs the same steps of a single algorithm for the entire registration process. Trial Tr. at 573:12-18, 574:10-15.

Maxell tries to obscure its lack of evidence by arguing that Samsung has advanced a claim construction argument “that the two registering modes in Claim 1 require two distinct algorithms.” Opp. at 4. Samsung has not done so. Instead, Samsung and Dr. Nielson demonstrated that the fact the Galaxy S23 fingerprint registration process uses a single algorithm to create a single fingerprint template proves there is only one registration mode in the Galaxy S23. There is nothing in the registration process that could constitute a second input mode. That is consistent with Samsung’s and Dr. Nielson’s position in the IPR, where they contend claim 1 requires two “input modes.” Maxell Ex. 2 at 16-19. In contrast, Maxell’s and Dr. Wobbrock’s positions on “first registering mode” and “second registering mode” contradict their IPR positions that the “first registering mode” is “a first operational state for registering” and the “second registering mode” is “a second operational state for registering.” Ex. A, at ¶¶ 82-92; Ex. B, at pp. 10-21, 35-47. The claim language expressly requires two distinct registering modes—a “first registering mode” and “second registering mode.” Maxell did not present any evidence that the Galaxy S23 uses two different registering modes; all of the evidence is to the contrary. Trial Tr. at 569:20-570:16, 573:12-18, 574:10-15, 904:18-905:7.

2. No Evidence of a Mode for Inputting Input Information by “an End of the Finger.”

Maxell’s argument that the Galaxy S23 meets the requirement in limitation [1.g] of a “second registering mode for inputting input information by an end of the finger” is based solely on the fact that the device may read fingerprint information from the end of the finger during the

fingerprint registration process. Opp. at 8-9. Although there are instances when the registration process may recognize some portion of the fingerprint at the end of the finger, that is not enough. Limitation [1g] requires not only that the device be capable of “inputting input information by an end of the finger,” but that there be a mode that is distinct from the mode for inputting fingerprint information by a pad of the finger. PX-003 at 8:54-57. No such separate mode exists.

Maxell does not cite any evidence that the Galaxy S23 has a fingerprint registration mode for inputting input information by an end of the finger. Opp. at 8-9. All evidence is to the contrary. In fact, Dr. Wobbrock conceded that none of the evidence he presented includes an instruction to the user to provide input information in a mode that uses an end of the user’s finger, and it is undisputed that the Galaxy S23 fingerprint registration algorithm cannot recognize what portion of the fingerprint is being used for input, let alone that the user is using an end of her finger. Mot. at 5-6. The evidence Maxell cites shows nothing more than instances in which the fingerprint registration process may recognize some portion of the fingerprint at the end of the finger. Opp. at 8-9. That falls far short of showing that there is a specific mode for inputting information from an end of the finger as claim 1 requires.

For this additional reason, the Court should grant Samsung JMOL of noninfringement of the ’086 patent or, in the alternative, order a new trial on the issue of infringement. *Smith v. Transworld Drilling Co.*, 773 F.2d 610, 612-13 (5th Cir. 1985).

B. ’086 Patent Invalidity.

1. Samsung Did Not Forfeit its Written Description Defense.

Maxell wrongly contends Samsung forfeited its written description arguments for the ’086 patent because it did not raise the issue in its affirmative Rule 50(a) argument. Samsung properly addressed its opening Rule 50(a) arguments to issues on which Maxell bore the burden of proof, namely, infringement, willful infringement, and damages. Trial Tr. at 1234:22-1246:20. Maxell

then raised arguments about issues on which Samsung bore the burden of proof; namely, invalidity. *Id.* at 1249:8-1260:21. Maxell ignores the fact that, when Samsung responded to Maxell's arguments on invalidity, Samsung also argued that the evidence of the examiner's rejections in the 2020 timeframe was "undisputed" and "dispositive of the written description issue." *Id.* at 1263:12-1264:14. Samsung thus argued not only that Maxell could not obtain JMOL on the issue, but also that a judgment of no adequate written description was appropriate as a matter of law. *Id.* The mere fact that Samsung made this point while responding to Maxell's argument, rather than in its opening set of JMOL arguments, is immaterial. Maxell does not and cannot point to any requirement that all JMOL grounds be presented in the same segment of the Rule 50(a) argument.

Maxell's "forfeiture" argument is thus one of form over substance, especially given that the Fifth Circuit construes Rule 50(b) liberally. *Polanco v. City of Austin*, 78 F.3d 968, 974 (5th Cir. 1996). Accordingly, even if Samsung had strayed from Rule 50(a) during trial (which it did not), the rule's purpose was satisfied. *Id.* at 974 (no waiver where the defendant's failure to renew its motion qualified as a "de minimis" departure from Rule 50(b)); *Taylor Publ'g Co. v. Jostens, Inc.*, 216 F.3d 465, 471-73 (5th Cir. 2000) (same). In the Fifth Circuit, Rule 50(b) serves "two basic purposes: to enable the trial court to re-examine the sufficiency of the evidence as a matter of law if, after verdict, the court must address a motion for judgment as a matter of law, and to alert the opposing party to the insufficiency of his case before being submitted to the jury." *MacArthur v. Univ. of Texas Health Ctr. Tyler*, 45 F.3d 890, 897 (5th Cir. 1995). Here, Samsung alerted Maxell to the insufficiency of its case-in-chief before it was submitted to the jury, and Samsung raised the inadequacy of Maxell's response to Samsung's written description challenge, so the Court can reexamine the sufficiency of the evidence as a matter of law. In addition, as Maxell concedes (Opp. at 12), Samsung has raised written description with the Court multiple times before, both during

claim construction and on summary judgment. Maxell's "forfeiture" argument is therefore wrong on procedure and substance. Finally, the same underlying arguments support Samsung's alternative motion for a new trial under Rule 59, which does not require any preservation at trial.

2. No Written Description Support for Using Fingerprint Information.

Maxell's Opposition fails to refute that Samsung is entitled to JMOL that the '086 patent claims are invalid for lack of written description. Maxell largely ignores the intrinsic evidence Samsung presented at trial that conclusively proves the lack of written description support for claim 1. Opp. at 11-15. Instead, Maxell focuses on Dr. Wobbrock's reliance on the Handbook of Fingerprint Recognition (PX-40). Opp. at 13-14. Maxell claims that the Court "recognized at summary judgment that Dr. Wobbrock's citations to the Handbook are entirely appropriate." *Id.* at 14 (citing Docket No. 285 at 72-73). The Court's summary judgment order does not even reference the Handbook, let alone comment on the appropriateness of citing it. Docket No. 285 at 71-73. While the Court acknowledged that "the proper [written description] inquiry must be into the specification first and then *guided* by expert testimony" (*id.*), that expert testimony must still be tethered to the intrinsic record. *See Allergan USA, Inc. v. MSN Labs. Priv. Ltd.*, 111 F.4th 1358, 1376 (Fed. Cir. 2024). In any event, Samsung does not claim that Dr. Wobbrock's reliance on the Handbook is *per se* improper. Rather, it is the fact that Dr. Wobbrock's reliance on the Handbook is untethered to the '086 patent specification that renders his reliance on the Handbook ineffective in refuting Dr. Nielson's evidence of lack of written description.

Samsung also explained in its opening brief how Dr. Wobbrock's testimony does not refute that claim 1 lacks written description support. Maxell fails to address these arguments. For instance, Dr. Wobbrock's testimony showed that, despite his contrary conclusion, "information for identification of the user" in the patent specification does not refer to fingerprints. Mot. at 8-9. Dr. Wobbrock also admitted that not all capacitive sensors can detect fingerprint information, and he

did not contest Dr. Nielson’s testimony that capacitive sensors can be used for many purposes other than fingerprint imaging. Mot. at 9. Maxell does not address either point. Nor does Maxell address Dr. Wobbrock’s failure to explain why a person of ordinary skill would understand the disclosures about capacitive sensors to cover anything other than what the patent expressly teaches; namely, that they can be used to distinguish large and small touch inputs (finger pad and tip inputs). *Id.* These un rebutted points establish that JMOL or, in the alternative a new trial, is warranted on Samsung’s written description challenge to the ’086 patent. *Smith*, 773 F.2d at 612-13.

III. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE ’815 PATENT

A. Claim 1 Noninfringement

Maxell did not present any evidence of “character” selection for limitations [1.j] and [1.k]. Maxell’s citations to Dr. Singh’s testimony, product testing, and demonstratives underscore the fatal hole in its proof because they demonstrate only that a Galaxy S23 user can touch the screen where an album *title* is displayed, but fail to show *in any way* that this touch selects a “character” in the title as required by claim 1 and as construed by the Court. This absence of evidence contrasts with Dr. Kia’s *conclusive showing* at trial—based on source code analysis and his live demonstration of a Galaxy S23—of what actually happens when a user touches the screen, [REDACTED]

[REDACTED] Trial Tr. (Sealed Portion No. 14) at 3:6-6:11; 1009:9-1014:15.

Dr. Singh’s testimony at Trial Tr. at 100:19-101:21 (Opp. at 15) establishes only that the “Favorites” album has *a title* that is represented by a string of individual characters (*i.e.*, “f”, “a”, “v” etc.). That testimony does not address, much less show, the selection of any character in that string. Dr. Singh’s testimony at Trial Tr. 106:8-107:1 (Opp. at 15) only discusses selecting the “Favorites” album and again does not address *how* the Favorites album is selected, much less show that any character is selected. Dr. Singh’s demonstratives reproducing PX-108, PX-296, and PX-

276 (Opp. at 16) show nothing about how any album in the gold-bordered first area is selected, much less that the albums are selected through selection of a character as construed by the Court. Indeed, the demonstratives incorrectly equate the claimed first character with the album *titles* “Favorites” (PDX-7-44) and “Camera” (PDX-7-45), neither of which qualifies as a “character” as construed by the Court because they are represented to a computer by more than one unit of information. Trial Tr. at 750:20-23.

The additional portions of Dr. Singh’s testimony cited by Maxell are no better. Opp. at 16 (citing Trial Tr. 106:2-107:11, 752:17-755:20, 771:18-775:8). The first passage adds nothing to the previously discussed passage at 106:8-107:1. The second passage establishes that album titles are represented as strings of characters (*id.* at 755:11-10), but does not address the selection of one of those characters as required by claim 1. In the third passage repeats a statement from Dr. Singh’s expert report (*id.* at 773:6-11), but that statement again only identifies the user selecting *a title* (which cannot be the claimed “character” because the title is represented by more than one unit of information) and does nothing to show the selection of a character as construed by the Court and as required by claim 1.

Maxell also cites Dr. Singh’s conclusory and off-point testimony at Trial Tr. at 755:25-756:7 that “it’s a touchscreen,” that “you have to touch it to select anything,” and that “when you touch it, what you are selecting is what is underneath that – what is displayed there” and that this is “common knowledge.” Opp. at 16. This testimony does nothing to show selecting a “character” as construed by the Court and required by claim 1. For example, Dr. Singh did not identify a single line of source code or *any other evidence* showing that what is selected is a “character” under the Court’s construction, or that the S23 Gallery app can even recognize selection of a character such as “F” in “Favorites.” Moreover, Dr. Singh’s reliance on “common knowledge,” without any evidentiary support—as is the case here—is legally insufficient to avoid JMOL. *Dominion Energy*,

Inc. v. Alstom Grid LLC, 725 F. App'x 980, 985–86 (Fed. Cir. 2018) (JMOL required when expert's testimony was conclusory, unsupported and contrary to the evidence).

Dr. Singh's unsubstantiated conclusions stand in stark contrast to the actual evidence the jury was presented regarding how the accused products work. As Dr. Kia conclusively showed at trial, the products operate by selecting an area of the screen rather than by selecting a character. Trial Tr. (Sealed Portion No. 14) at 3:6-6:11; 1009:9-1014:15. For example, Dr. Kia proved both through his demonstration of an accused product and source code analysis that an album can be selected even when a user touches an area where no album title or icon is present. Trial Tr. at 1009:9-1013:8. This is because the source code [REDACTED] [REDACTED] Trial Tr. (Sealed Portion No. 14) at 3:11-4:13. Samsung is therefore entitled to JMOL of non-infringement or, at a minimum, a new trial because the jury's verdict is at least against the great weight of the evidence. *Smith*, 773 F.2d at 613.

B. Claims 21 And 24 Noninfringement

1. No Evidence “Continue Watching” Meets the “Character” Limitation of 21[f]

Maxell attempts to manufacture substantial evidence for limitation 21[f] by quoting Dr. Singh's testimony about “continue watching” playlists in relation to a *different* claim limitation, limitation 21[b], which concerns the first user interface for selecting a user profile and not the second user interface or the “character” limitation of 21[f]. Opp. at 20. Dr. Singh's reference to “continue watching for Miyagi-Do . . .” simply describes the types of playlists associated with user profiles—and not how the “character” limitation is met on the second user interface as required by limitation 21[f]. Trial Tr. (Sealed Portion No. 9) at 124:17-22.

The entirety of Dr. Singh's actual direct testimony regarding limitation 21[f] is limited to two answers and one demonstrative. Trial Tr. (Sealed Portion No. 9) at 127:8–19; Ex. A, PDX007-

78. During that cursory testimony, there is no mention of “continue watching,” “My List,” or any playlist as meeting the “character” limitation, or as “indicating an identity of the user which the first user profile is associated with” on the second user interface as required by limitation 21[f]. Further, there is no other trial testimony, source code, product demonstration, or expert opinion from Dr. Singh (or from anyone else) that “continue watching” (or any playlist) on the second user interface can meet the requirement that the interface display a “first character ... indicating an identity of the user which the first user profile is associated with” as required by the claims.

2. No Evidence that Miyagi-Do Icon Is a Unicode Character.

Maxell’s assertion that Dr. Singh’s citation to PX-311 and PX-312 “supported his opinions regarding how the Netflix app uses character sets that are represented by units of code, including showing the use of the index” (Opp. at 22) is wholly unsupported. First, there is no evidence that PX-311 and PX-312 correspond to anything in the accused products. Second, Dr. Singh never testified that the Miyagi-Do Karate icon (or any profile icon) is represented by Unicode, or that the app’s UI elements are represented as Unicode “characters.” Trial Tr. (Sealed Portion No. 9) at 125:12-20. Indeed, on cross-examination, Dr. Singh admitted neither of these exhibits is from either Netflix or Samsung, nor do they mention the Netflix app, and Dr. Singh was unable to identify any evidence tying Unicode to the accused app. *Id.* at 765:13-766:10. Maxell’s argument that these documents support the existence of an index to represent the Miyagi-Do icon in the accused products is thus only attorney argument, not evidence that could support the jury’s verdict.

C. ’815 Patent Invalidity

1. No Waiver of Samsung’s New Trial Motion

Maxell’s forfeiture argument is directed only to Samsung’s Rule 50(b) motion and not to Samsung’s request for a new trial under Rule 59, and it cannot affect Samsung’s new trial motion because a new trial motion does not require preservation at trial. Fed. R. Civ. P. 59. The Court

should therefore grant Samsung's request for a new trial regarding the invalidity of the '815 patent for the reasons set forth in Samsung's motion and below.

2. No Disclosure of the “No Deletion” Limitation.

Maxell fails to identify any express or implied disclosure of the “No Deletion Limitation.” While word-for-word support is not required, that does not relieve Maxell of its obligation to identify language in the specification that a POSITA would recognize as supporting the limitation. Maxell has not done so—none of the passages cited by Maxell—including column 6, lines 19-40—state or suggest that deleting a video from one folder leaves it in another. The law requires clear, unambiguous language in the specification—not mere possibility or obviousness. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Moreover, Dr. Singh admitted there is no express disclosure of what happens in the “father” folder when item 502 is deleted from the “mother” folder. Trial Tr. at 1217:6-1218:7. Column 6, lines 19–40 does not expressly disclose the “No Deletion” limitation because it does not state what happens in the “father” folder when an item is deleted from the “mother” folder, or vice versa. *See id.* at 1028:22-1029:5; 1029:6-17. Dr. Singh's bald assertion of an express disclosure (Trial Tr. at 1215:24-1216:2) when the words in the patent contradict that assertion is entitled to no weight. *Dominion Energy*, 725 F. App'x at 985–86.

3. No Disclosure of the “Encrypted” Limitation.

None of the passages of the specification cited by Maxell—including 1:46-50, 6:57-65, or Figure 3 of the '815 patent—expressly state that video information is received in encrypted form, as required by the claim. Mot. at 27-28. Dr. Singh was unable to point to any passage in the specification that expressly discloses receiving encrypted video information, but instead relied on general references to “digital broadcast” and the presence of encryption and decryption modules in Figure 3. Trial Tr. at 1198:11-1201:12, 1221:5-20. However, Figure 3 and the accompanying text describe a system in which video is first received by the device and only then encrypted

internally—contrary to the claim’s requirement that the video is already encrypted when received. Trial Tr. at 1047:10-18, 1048:2-18. Indeed, Dr. Singh admitted that the only explicit discussion of encryption in the ’815 patent relates to element 331 in Figure 3, which is an internal component and cannot encrypt any signal before it is received. *Id.* at 1220:18-1221:4. He also conceded there is no inherent disclosure of video being received in encrypted form, as it is possible for video to be received in unencrypted form. *Id.* at 1223:17-21; 1225:11-1226:8.

IV. THE COURT SHOULD GRANT JMOL OR A NEW TRIAL ON THE ’848 PATENT

Maxell’s Opposition confirms that, apart from Dr. Balakrishnan’s conclusory and unsupported say-so, there is no evidence that a specific person is registered in the alleged “first setting mode” in the accused products. Rather, the evidence Maxell relies upon shows only that when a person *who already has been registered* through creating an auto-updating album (the “second setting mode”) is then *later* photographed again, facial recognition is performed on the new picture and the picture is sorted into the previously registered person’s *existing* auto-updating album. Opp. at 29-31. This showing fails the plain language of limitation [8.g], which requires the subject in the picture be “registered as the specific person” in the “first setting mode.” PX-005 at 15:51-16:9. Neither facial recognition nor sorting are registering a person as a specific person. This is particularly true in the Samsung accused products, where the person already has been registered as a specific person during the alleged “second setting mode” and there is thus no need to—and the accused products do not—register the person a second time.

Maxell’s sole argument that limitation [8.g] is met is that Dr. Balakrishnan testified that when he takes a new picture following the creation of an auto-updating album, “[t]he face recognition process works [on the new picture],” and “if it finds a face, then it will recognize that face and register it as that specific person.” Opp. at 30-31 (citing Trial Tr. (Sealed Portion No. 3) at 88:14-21. Neither Maxell nor Dr. Balakrishnan, however, points to *any* evidence—none—

showing that any such “registration” occurs, and Maxell cannot avoid JMOL based upon such conclusory expert testimony. *Dominion Energy*, 725 F. App’x at 985–86. Moreover, the actual evidence at trial instead establishes that registering a specific person on the Samsung products is performed only from photographs saved to memory in the Gallery app. Trial Tr. at 971:9-16, 992:15-994:11; *see also* Trial Tr. (Sealed Portion No. 5) at 96:2-12 (“Now, enrollment is the same thing as registering.”). 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.

Maxell’s argument also fails because neither performing face recognition nor sorting (saving a photo to a specific location in the device’s memory) can constitute “registration” under limitations [8.g] and [8.h] for the additional reason that both of these functions are recited as separate claim elements in limitations [8.d] and [8.e]. Mot. at 33-34 (citing PX-005 at claim 8). Maxell does not dispute that these two functions are indeed entirely separate claim elements. Opp. at 32. And the one case that Maxell cites, *Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221 (Fed. Cir. 2011), Opp. at 32 n. 3, is inapposite. The issue in *Powell* was whether two distinctly claimed physical structures must be physically separate components for purposes of infringement, which is not the issue here. *Powell*, 663 F.3d at 1231-32. Here, claim 8 instead recites a series of distinct functions performed by a processor, in which facial recognition, saving a photo to memory, and “registering a specific person” are separately recited and performed.

Maxell argues that the Court already rejected Samsung’s position that sorting a photograph is not registering a specific person under limitation [8.g]. Opp. at 31-32. But the Court did not hold that sorting a photograph constitutes registering a person as a specific person. Docket No. 285 at 66-67. Instead, the Court found that there was a genuine dispute of material fact with respect to limitation [8.g] based on the expert testimony at the time. *Id.* at 67. Moreover, the Court’s statement

on which Maxell now relies related to a tagging functionality infringement theory that Maxell did *not* assert at trial, not to the auto-updating albums infringement theory it did assert at trial. *Id.*

Maxell further argues Samsung’s position is predicated on untimely claim construction. Opp. at 32. Not so. Samsung’s position is based upon the plain meaning of claim 8, which requires a registration during the first setting mode and a separate registration during a second setting mode. Here, the only evidence of any registration occurring in the accused Samsung products is during the alleged second setting mode auto-updating album process.

Because Maxell did not present *any* actual evidence of a “first setting mode” under limitation [8.g], the Court should grant Samsung JMOL of non-infringement of the ’848 patent. At the very least, because the great weight of the evidence showed the accused products do not have a “first setting mode,” the Court should order a new trial on the issue. *Smith*, 773 F.2d at 613.

V. SAMSUNG IS ENTITLED TO JMOL OR A NEW TRIAL ON WILLFULNESS

A. Legally Insufficient Evidence Of Pre-Suit Knowledge Of Infringement

It is undisputed that Maxell’s 2021 “notice” letters listed over 200 patents, failed to draw Samsung’s attention to the three asserted patents among this long list of patents, and failed to explain how any particular Samsung product allegedly infringed any particular patent claim. Opp. at 34-35; PX-20; PX-29. As such, the 2021 letters failed to communicate a specific charge of infringement sufficient to permit a willfulness finding as to the three asserted patents. Mot. at 36.

Maxell’s observation that its overall patent portfolio includes over 6,000 patents (Opp. at 35) cannot save its willfulness claim, because its long list of over 200 patents did not provide Samsung the required specific notice of infringement as to the three asserted patents. Mot. at 34-35. *See, e.g., Evolved Wireless, LLC v. Samsung Elecs. Co., Ltd.*, No. CV 15-545-SLR-SRF, 2016 WL 1019667, at *3-4 (D. Del. Mar. 15, 2016) (“a patent included in an appendix containing dozens of patents does not place a defendant on notice of the patents-in-suit” and “[t]he letter does not

specifically identify the patents-in-suit in this action from the list of eighty-five patents and patent applications”), *report and recommendation adopted*, No. 15-545-SLR-SRF, 2016 WL 1381765 (D. Del. Apr. 6, 2016); *Cascades Computer Innovation, LLC v. Samsung Elecs. Co.*, 77 F. Supp. 3d 756, 766-67 (N.D. Ill. 2015) (communication insufficient to give notice where patent-in-suit was merely listed in an appendix with 39 other patents and applications).

The fact that Maxell notified Samsung of other patent infringement lawsuits does not support Maxell’s willfulness claim. None of the other lawsuits involved the ’848 patent, so they could not have provided Samsung with notice as to the ’848 patent. Maxell also fails to explain how Maxell’s infringement claims against different, non-Samsung products could have provided Samsung with the requisite notice of Samsung’s alleged infringement of the ’815 and ’086 patents. Maxell never offered any proof at trial that any of the non-Samsung products actually functioned in the same way the accused Samsung products function, and Maxell never provided Samsung infringement claim charts showing how the accused Samsung products allegedly infringed.

B. Samsung Lacked Specific Intent To Infringe The Asserted Patents

Maxell’s Opposition also fails to establish that the jury was presented with any—much less legally sufficient—evidence of Samsung’s supposed specific intent to infringe, which is a second, independent reason the jury’s willfulness verdict cannot stand. Mot. at 38 (citing *Bayer Healthcare LLC v. Baxalta Inc.*, 989 F.3d 964, 987 (Fed. Cir. 2021)). Indeed, instead of Maxell presenting the jury with *any* evidence of a specific intent to infringe, Samsung provided the jury with strong evidence to the contrary, namely its strong non-infringement defenses and the instituted IPR proceedings, both which established a good faith belief of no infringement. *See, e.g.*, Mot. at 40-41 (citing Trial Tr. at 379:9-13, 382:3-17, 823:15-24, 824:21-827:10; DTX-242; DTX-243; DTX-244; DTX-245); Mot. at 40 (citing Trial Tr. at 823:15-20).

Maxell's attempts to distinguish *Team Worldwide* by citing a statement in that decision indicating that continuing sales *without an adequate inquiry* into infringement may give rise to an inference of willful infringement. Opp. at 36 (citing *Team Worldwide Corp. v. Acad., Ltd.*, No. 2:19-cv-00092-JRG-RSP, 2021 WL 1897620, at *6 (E.D. Tex. May 3, 2021)). However, it is undisputed Samsung promptly requested claim charts from Maxell to perform such an inquiry, and Maxell fails to cite any authority suggesting this was an inadequate inquiry in the face of being presented with a list of over 200 patents.

The other cases Maxell cites are also inapposite. In *Packet Intelligence LLC v. NetScout Sys.*, 965 F.3d 1299, 1315-16 (Fed. Cir. 2020), the defendant's inventorship defense was deemed by the court to be nothing more than a personal attack on plaintiff's witness. Ex. C, *Packet Intelligence LLC v. NetScout Sys., Inc. et al.*, No. 2-16-cv-00230, Docket No. 305 at 2-3, 5 (E.D. Tex. Sept. 7, 2018). Here, by contrast, the Patent Office's institution of Samsung's IPR petitions demonstrates the good faith basis of Samsung's belief that the asserted patents are invalid.

Maxell's reliance on the *ZitoVault* and *Blitzsafe* cases is also misplaced. Those cases stand for the proposition that allegations in a complaint that a defendant cited to an asserted patent during Patent Office proceedings can satisfy the patent knowledge requirement at the pleading stage. *ZitoVault, LLC v. Int'l Bus. Machines Corp.*, 2018 WL 2971131, at *3 (N.D. Tex. Mar. 29, 2018); *Blitzsafe Texas, LLC v. Volkswagen Grp. Of Am., Inc.*, 2016 WL 4778699, at *6-7 (E.D. Tex. Aug. 19, 2016). Here, by contrast, the Patent Office instituted IPR proceedings indicating the asserted patents are likely invalid. DTX-242; DTX-243; DTX-244; DTX-245.

Trial testimony also confirmed Maxell did not contact Samsung when the prior term license expired in 2016, much less to advise Samsung that it allegedly needed a license to any patent. Trial Tr. (Sealed Portion No. 4) at 35:18-22; Trial Tr. at 343:12-344:4. Maxell's criticism that Samsung

did not approach Maxell after the license expired (Opp. at 38) omits the *uncontested* fact that Samsung already paid [REDACTED] [REDACTED]. Mot. at 39 (citing Trial Tr. (Sealed Portion No. 13) at 109:20-110:9); *see also* Docket No. 402 at 7 (addressing the [REDACTED]' NDA), 10 (addressing the license expiration).

Maxell's observation that Samsung did not cease selling its products after this lawsuit was filed is also not substantial evidence. Opp. at 38. The Federal Circuit has *not* held that a defendant must cease manufacture upon learning of a patent or when it is sued; indeed, the opposite is true: "A party may continue to manufacture and may present what in good faith it believes to be a legitimate defense without risk of being found on that basis [*i.e.*, continued manufacture] alone a willful infringer." *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 510-11 (Fed. Cir. 1990). Here, once Maxell filed suit, Samsung presented strong evidence of non-infringement and filed the instituted IPRs, affirmatively evidencing a lack of specific intent to infringe.

VI. SAMSUNG IS ENTITLED TO JMOL OR A NEW TRIAL ON DAMAGES

A. Maxell Concedes The Damages Verdict Is Based On A One Percent Royalty.

Maxell agrees the jury used Mr. Jarosz's high-end "one percent rate" when calculating damages. Opp. at 42. Although Maxell recounts various calculations to which Mr. Jarosz testified, none result in the amount awarded by the jury. *Id.* Thus, if the Court finds that no reasonable jury could have awarded damages based on the one percent portfolio rate, then Samsung is entitled to JMOL because the verdict is "[b]ased on 1%." Mot. at 42.

B. The *EcoFactor* And *Super Lighting* Decisions Support JMOL Here.

The Federal Circuit's *en banc* decision in *EcoFactor* applies here. *EcoFactor* holds that royalty rates not reflected in license agreements must be corroborated by unbiased and reliable testimony. *EcoFactor, Inc. v. Google LLC*, 137 F.4th 1333, 1343 (Fed. Cir. 2025) (*en banc*). In *EcoFactor*, the license agreements did not "provide support for [the expert's] testimony that the

licensees agreed to pay the \$X rate.” *Id.* at 1343. Here, the six “most relevant” licenses Mr. Jarosz used to form his royalty opinions do not express a one percent rate, and other agreements that express a one percent rate [REDACTED]. Mot. at 44-45. As in *EcoFactor*, Mr. Jarosz relies on the self-interested and uncorroborated testimony of Maxell’s corporate witness, Mr. Yamamoto. *Id.* at 45-46. Mr. Yamamoto’s testimony about the [REDACTED] that purportedly equate to a one percent royalty rate lacks evidentiary support, so the Court should disregard it just as in *EcoFactor*. *Id.* at 46; *EcoFactor*, 137 F.4th at 1343-44. Mr. Yamamoto is self-interested because, among other things, [REDACTED] [REDACTED] (Trial Tr. at 336:7-19), rendering his uncorroborated royalty rate testimony unreliable. *EcoFactor*, 137 F.4th at 1343-44.

The Federal Circuit recently applied *EcoFactor* to order a new trial on damages on facts similar to this case. *See Jiaxing Super Lighting Elec. App. Co. v. CH Lighting Tech Co., Ltd.*, Case No. 23-1715, 2025 WL 2100650 (Fed. Cir. July 28, 2025). In *Super Lighting*, the expert relied on “previous portfolio licenses” and “opined that three particular patents comparable to the asserted patents drove the negotiations.” *Id.* at *7. Citing *EcoFactor*, the Federal Circuit ordered a new trial on damages, holding that the expert’s testimony “cannot be justified simply because she made a series of blanket upward and downward adjustments” and that “the district court should consider the reliability of the expert’s testimony in light of *EcoFactor*.” *Id.* at *8-9. Here, Mr. Jarosz made similarly blanket adjustments without actually apportioning the phantom one percent rate. JMOL or a new trial is warranted. Mot. at 44-47.

C. Maxell’s Unapportioned One Percent Rate Requires JMOL.

Mr. Jarosz failed to apportion between the value of the patented and unpatented features. *See Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 904 F.3d 965, 977 (Fed. Cir. 2018); *Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960, 971-74 (Fed. Cir. 2022). This is not a case like

Summit 6, LLC v. Samsung Elecs. Co., where there was a question of credibility for which the court deferred to the fact finder. Opp. at 42. On the contrary, Maxell failed to provide substantial evidence of apportionment of its damages claim for at least the following reasons.

First, the one percent rate is, if anything, a [REDACTED] rate that Mr. Jarosz failed to apportion. Mot. at 42-44. Maxell argues that Mr. Jarosz “apportioned that rate to the patents at issue” (Opp. at 43), but nowhere does Maxell explain how Mr. Jarosz supposedly did that, because he did not. The supposed adjustments for “the hypothetical license” that Mr. Jarosz purportedly made are the type of speculative analyses the Federal Circuit found deficient in *EcoFactor* and *Super Lighting*.

Second, the component cost apportionment Mr. Jarosz purportedly performed did not cure his improper reliance on a portfolio royalty rate that applies, if at all, to 6,000 patents. Opp. at 43-44; Mot. at 42-44, 48. As *Super Lighting* confirms, Maxell cannot simply point to upward and downward “adjustments” in Mr. Jarosz’s *Georgia-Pacific* analysis to cure this deficiency. 2025 WL 2100650, at *9 (expert testimony not justified “simply because she made a series of blanket upward and downward adjustments”); Opp. at 44; PDX008-43. And as Samsung has demonstrated (Mot. at 48), Mr. Jarosz’s component cost analysis is deficient because it does not apportion unpatented technologies contained in the components including the accused features, which he improperly included in his royalty base.

Third, as demonstrated above, the one percent [REDACTED] rate is not supported by competent evidence, but rather is based on (a) [REDACTED] or (b) the self-interested, uncorroborated testimony of Mr. Yamamoto. Opp. at 46-49; Mot. at 44-46. Maxell concedes it offered no sales information to support Mr. Yamamoto’s royalty rate testimony (Opp. at 45-47), rendering his testimony insufficient under *EcoFactor*. 137 F.4th at 1344.

D. Maxell’s One Percent Portfolio Rate Is At Best An Unaccepted Offer.

Maxell’s one percent portfolio rate is at best an unaccepted offer, which is not competent

evidence of damages. Maxell concedes that Mr. Jarosz's six "most relevant" licenses do not express a one percent royalty rate, leaving Maxell with licenses that [REDACTED]. Opp. at 49, 54. As Maxell concedes, the [REDACTED] agreements do not [REDACTED] [REDACTED] or the asserted patents and were not subject to any technical or economic comparability testimony at trial. Mot. at 45; *see also* Trial Tr. (Sealed Portion No. 12) at 81:24-82:5 (Jarosz did not opine those agreements were comparable). And although the [REDACTED] [REDACTED] (Opp. at 54), those licenses [REDACTED] [REDACTED] are not comparable to the hypothetical license either. *See Wi-LAN*, 25 F.4th at 971. In denying Samsung's *Daubert* motion, the Court did not hold that Maxell's one percent rate was not an unconsummated offer, but rather that "Samsung [was] free to challenge the weight of that evidence on cross examination." Docket No. 285 at 13. Samsung challenged that evidence, and Maxell failed to present substantial evidence to support the one percent damages verdict.

E. In The Alternative, A New Trial Or Remittitur On Damages Is Warranted.

As an alternative to JMOL, the Court should order a new trial on damages. *EcoFactor*, 137 F.4th at 1346-47; *Super Lighting*, 2025 WL 2100650, at *9. And because Ms. Davis's reasonable royalty calculations are the only competent evidence of damages in the record (Mot. at 51), the Court may also condition the denial of a new trial on Maxell's acceptance of Ms. Davis's \$3.45 million high-end damages number. On this point, Maxell's citation to *Baisden v. I'm Ready Prods., Inc.*, (Opp. at 55-56) is irrelevant because that case did not involve remittitur. A new trial or remittitur on damages is therefore warranted here.

VII. CONCLUSION

For the reasons stated in the JMOL and herein, Samsung is entitled to JMOL or, at a minimum, to a new trial on all issues.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on August 25, 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