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-92-RWS [redacted]

ORDER

Plaintiff Maxell, Ltd. filed its initial complaint in this case on September 7, 2023, alleging that Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Samsung") had infringed seven of its patents: U.S. Patent Nos. 8,037,161 ("the '161 Patent"); 8,982,086 ("the '086 Patent"); 10,176,848 ("the '848 Patent"); 11,223,757 ("the '757 Patent"); 11,017,815 ("the '815 Patent"); 10,129,590 ("the '590 Patent"); and 11,445,241 ("the '241 Patent"). The parties' claims involving the '241 Patent have been severed and stayed in a separate cause of action. Docket No. 250.

On April 24, 2025, the Court heard oral argument on a variety of motions. Based on the parties' briefing and argument, the Court rules as follows:

- Samsung's Motion to Exclude the Opinions and Testimony of Plaintiff's Damages Expert John C. Jarosz (Docket No. 117) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- Maxell's Motion to Strike and Exclude Certain Testimony and Opinions Offered By Ms. Julie L. Davis (Docket No. 126) is **DENIED**;
- Samsung's Motion to Strike Portions of the Expert Reports of Bruce McNair Regarding U.S. Patent No. 10,129,590 (Docket No. 118) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

the touch display," and the Court construed [1.d] to mean that "the second camera is located on a side of the touch display that is **opposite a side of the touch display** on which the first camera is located." Docket Nos. 80 at 4 (emphasis added); Docket No. 107 at 18 (emphasis added).

In the *Markman* order, the Court noted that Maxell treated " 'same side of touch display' as 'same side of **the image recording device** as the touch display.' " Docket No. 107 at 17–18. The Court found this interpretation to be consistent with the specification and "also . . . with Samsung's construction" of a plain and ordinary meaning that was adopted by the Court. *Id.* at 18. Accordingly, Samsung's legal theory for non-infringement of limitation [1.d] is not based on a proper interpretation of the claim, and the motion is **DENIED** as to the limitation [1.d] theory of non-infringement for the '757 patent.

Even if the Court adopted Samsung's interpretation of the claims, summary judgment would still be inappropriate. Samsung and its expert contend that all cameras, including the front facing and rear facing cameras, are located on the rear side of the touch display. Docket No. 121 at 4 (citing Docket No. 121-2 (Guidash Rebuttal Report) at ¶¶ 46, 56–86). However, Maxell argues that Mr. Guidash relies on 3D image files that show a portion of the front camera protruding beyond the touch display. Docket No. 180-6; Docket No. 180-3 (Guidash Rebuttal Report) ¶¶ 61–62. There is at least a genuine dispute of material fact.

B. '757 Patent, limitations [1.h], [1.i], [1.j]

The Court recognizes that portions of this motion may be moot in light of its decision to **GRANT** Samsung's motion to strike Dr. Wobbrock's Enable Construction regarding limitations [1.g], [1.i], and [1.j] of the '757 Patent (Docket No. 119). *See supra* Section IV.B; Docket No. 121-4 (Wobbrock Tr.) at 44:14–24 (explaining that his interpretation of limitations [1.h], [1.i], and [1.j] operate under a similar logic). But to the extent it is not, the Court addresses whether limitations [1.h], [1.i], and [1.j] are not infringed under the theory Dr. Wobbrock presents.

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In addition to limitation [1.h] requiring a *recording operation being started* in response to the "touch operation instruction," Maxell expert Dr. Wobbrock opines as part of his infringement theory that the combination of limitations [1.h], [1.i], and [1.j] requires that the *second camera is enabled and that the first camera is disabled* in response to the same "touch operation instruction" Docket No. 121 at 5 (citing Docket No. 121-4 (Wobbrock Tr.) at 44:14–24; Docket No. 121-5 (Samsung '757 claim 1 representation)). Samsung argues that the accused products do not infringe the asserted claims of the '757 Patent because the products do not perform both functions ((1) starting the recording of the second image signal and (2) enabling the second camera while disabling the first camera) in response to the same touch operation instruction. Docket No. 121 at 5–6; *see* Docket No. 121-4 (Wobbrock Tr.) at 46:7–47:8, 55:3–11; Docket No. 121-3 (Wobbrock Report) at ¶ 936. A user of the representative Galaxy S23 accused product must touch both a camera selection button and a different shutter button. Docket No. 121 at 5–6.

Dr. Wobbrock opines that, regardless, claim 1 is met because the "touch operation instruction can be one or more touches performing an overall operation instruction." Docket No. 180 at 6 (citing Docket No. 121-4 (Wobbrock Tr.) at 44:22–24.) Maxell characterizes the disagreement between the parties as to Dr. Wobbrock's second opinion as "whether a touch operation instruction can include more than one touch to result in a 'second instruction.' " *Id.*

The answer is that it cannot. *In re Varma*, 816 F.3d 1352 (Fed. Cir. 2016), controls. *Varma* explains that when there is an element that performs two functions in the context of the claims—which is the case under Dr. Wobbrock's construction of the limitations—the claim cannot be satisfied by a first element that performs the first function and a second element that performs the second function. As illustrated by the Federal Circuit, "[f]or a dog owner to have a dog that rolls over and fetches sticks, it does not suffice that he have two dogs, each able to perform just one of

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the tasks." *Id.* at 1363. Maxell's argument that claim 1's reference to "a touch operation instruction" in the separate claim element, [1.b], suggests the existence of more than one "touch operation instruction" is wrong. Docket No. 180 at 6. Although it is generally true that the indefinite article "a", as a canon of construction, suggests the existence of one or more of the elements claimed, *01 Communique Lab., Inc. v. LogMeIn, Inc.*, 687 F.3d 1292, 1297 (Fed. Cir. 2012), *aff'd* 563 F. App'x 770 (Fed. Cir. 2014), the claim limitations at issue refer to "the touch operation instruction" and prescribe what is required of each individual "touch operation" under Dr. Wobbrock's theory. *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311, 1314 (Fed. Cir. 2023) ("[W]hile the claim term 'a microprocessor' does not require there be only one microprocessor, the subsequent limitations referring back to 'said microprocessor' require that at least one microprocessor be capable of performing each of the claimed functions"). And Dr. Wobbrock himself has opined that two touches—one touch enabling the second camera and disabling the first camera and the other touch pressing the shutter button—would not be a single touch operation instruction but would be "touch operation instruction**s**." Docket No. 271-3 (Samsung '757 Non-Infringement Hearing Slides) at 35 (citing Docket No. 121-4 (Wobbrock Tr.) at 44:25–45:12 (emphasis added)).

Maxell's attempt to argue that two touches can constitute a single touch operation instruction under the claims is inconsistent with what Dr. Wobbrock said before the PTAB. Six days after Maxell's surreply, Dr. Wobbrock filed a declaration as part of Maxell's Patent Owner Response for the '757 Patent IPR that characterized prior art Chinn as having a "two-step, two-instruction process that requires a separation between selecting a front or rear camera (camera selection control 242) and capturing an image with the selected camera (camera activation control 233)." Docket No. 243-1 at 12. At the hearing on this motion, Maxell explained that Dr.

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Wobbrock's opinion was directed to a different claim limitation which involved a "voice command limitation" as opposed to the touch operations at issue in limitations [1.h], [1.i], and [1.j] under consideration in the present motion. Docket No. 284 (Hearing Tr.) at 60:1–7. However, Dr. Wobbrock's characterization of Chinn as a "two-step, two-instruction process" was in reference to its two *button touches* at 242 and 233 of the reference—even if the limitation was different. *See* Docket No. 243 at 1–2; Hearing Tr. at 65:1–16 (explaining that 242 and 233 are both buttons); Docket No. 243-2 (Patent Owner Response) at 40 (displaying Fig. 2 of Chinn which shows the 233 and 242 button locations).

Because two touches are two touch operation instructions under the law and based on how Maxell and Dr. Wobbrock have characterized and limited limitations [1.h], [1.i], and [1.j], a reasonable jury could not find infringement of those limitations when Samsung's accused products require two touches to switch between the front and rear cameras and start the recording.

For the reasons above, Samsung's motion for summary judgment of non-infringement (Docket No. 121) is **DENIED** with respect to limitation [1.d] of the '757 Patent and **GRANTED** with respect to limitations [1.h], [1.i]. and [1.j] of the '757 Patent.

C. '161 Patent, claim 6

1. Wi-Fi Lists

The Court finds that this portion of Samsung's motion is **MOOT** in light of the Court's decision to grant Samsung's motion to strike Maxell's Wi-Fi Network theories in Section V.C. *See* Docket No. 123.

2. SmartThings Network

Claim 6 of the '161 Patent is reproduced below:

> 6. A network belonging judgment method for judging whether a first network device and a second network device, which are connectable

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