MAYER BROWN LLP
EDWARD JOHNSON (SBN 189475)
wjohnson@mayerbrown.com
Two Palo Alto Square, Suite 300
3000 El Camino Real
Palo Alto, CA 94306
Telephone: (650) 331-2000

Attorneys for Plaintiff Maxell, Ltd.

FISH & RICHARDSON P.C.
MICHAEL J. MCKEON (admitted *pro hac vice*)
mckeon@fr.com
1000 Main Avenue, S.W., Suite 1000
Washington, DC 20024
Telephone: (202) 783-5070

Attorneys for Defendants LG Electronics Inc. and LG Electronics U.S.A., Inc.

Additional counsel listed on signature pages

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

MAXELL, LTD.,

Plaintiff,

v.

LG ELECTRONICS INC. and LG ELECTRONICS U.S.A., INC.,

Defendants.

Case No. 5:24-cv-04972-NW-SVK

JOINT CASE MANAGEMENT STATEMENT

Judge: Hon. Noël Wise

The parties to the above-entitled action, Plaintiff Maxell, Ltd. ("Plaintiff" or "Maxell") and Defendants LG Electronics Inc. and LG Electronics U.S.A., Inc. (collectively, "Defendants" or "LG"), jointly submit this JOINT CASE MANAGEMENT STATEMENT pursuant to the Order Reassigning Case (Dkt. 130). In this action, a Case Management Conference was held on December 4, 2024 (Dkt. 117), and a Case Management & Scheduling Order and Order Referring Case to Private ADR (Dkt. 118) ("Scheduling Order") was entered on December 5, 2024 (both before The Hon. Eumi K. Lee).

1. **Jurisdiction & Service**

This is an action for patent infringement arising under 35 U.S.C. § 271, *et seq*. The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a). This case was transferred to the Northern District of California from the Eastern District of Texas. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c) and/or 1400(b). No issues exist regarding personal jurisdiction, venue or service. All parties have been served.

2. **Facts**

Maxell filed its original complaint (the "Complaint") in this action on December 29, 2023 in the Eastern District of Texas. Defendants filed a Motion to Transfer pursuant to 28 U.S.C. § 1404(a). Defendants' Motion to Transfer was granted on July 1, 2024 and the case was transferred to the Northern District of California.

Plaintiff's Factual Contentions

Defendants willfully infringe nine U.S. Patents, namely U.S. Patent Nos.: 6,856,760; 6,973,334; 7,199,821; 10,244,284; 8,339,493; 8,736,729; 7,421,188; 9,818,449; and 10,199,072 (collectively, "the Asserted Patents"). Defendants have directly infringed one or more claims of the Asserted Patents, literally and/or under the doctrine of equivalents, by or through making, using, importing, offering for sale and/or selling their telecommunications technology (*e.g.*, smartphones and laptops). Further, Defendants have indirectly infringed one or more claims of the Asserted Patents by, among other things, actively inducing the use, offering for sale, selling, or importation of their telecommunications technology. Defendants, and their customers who operate devices and

components thereof in accordance with Defendants' instructions, directly infringe one or more claims of the Asserted Patents in violation of 35 U.S.C. § 271. Maxell seeks damages and injunctive relief.

Maxell identifies the following six prior cases involving one or more of the Asserted Patents in the E.D. of Texas:

- *Hitachi Maxell, Ltd. v. Huawei Device USA, Inc., et al.*, Case No. 5:16-cv-178 (E.D. Tex.) (involving Asserted U.S. Patent No. 6,856,760);
- *Maxell, Ltd. v. ZTE Corp., et al.*, Case No. 5:16-cv-179 (E.D. Tex.) (involving Asserted U.S. Patent Nos. 8,339,493 and 8,736,729);
- *Maxell, Ltd. v. Huawei Device USA, Inc., et al.*, Case No. 5:18-cv-33 (E.D. Tex.) (involving Asserted U.S. Patent No. 6,973,334);
- *Maxell, Ltd. v. ZTE Corp., et al.*, Case No. 5:18-cv-34 (E.D. Tex.) (involving Asserted U.S. Patent No. 6,973,334);
- *Maxell, Ltd. v. ZTE Corp.*, Case No. 5:18-cv-80 (E.D. Tex.) (involving Asserted U.S. Patent Nos. 8,339,493 and 8,736,729); and
- *Maxell, Ltd. v. Apple, Inc.*, Case No. 5:19-cv-36 (E.D. Tex.) (involving Asserted U.S. Patent No. 8,339,493).

Maxell further identifies the following case involving related patents:

- *Maxell, Ltd. v. Samsung Electronics Co., Ltd.*, et al., Case No. 5:23-cv-92 (E.D. Tex.) (involving U.S. Patent Nos. 10,129,590 and 11,445,241 (related to Asserted U.S. Patent No. 10,244,284) and U.S. Patent No. 11,017,815 (related to Asserted U.S. Patent Nos. 9,818,449 and 10,199,072)).

Defendants' Factual Contentions

Maxell has accused certain LG's mobile devices of infringing all nine of the asserted patents. On April 5, 2021, years before the complaint was filed, LG announced that it was closing its mobile business. By July 31, 2021, LG stopped manufacturing mobile devices. LG's employees who were involved in its mobile business are now former employees. Maxell has also accused Qualcomm hardware, and Google's Android OS in its contentions against the discontinued LG smartphones.

Only two of the asserted patents additionally target laptops. LG's employees in Korea are primarily responsible for the design and development of the accused laptops.

LG denies that any of the accused mobile devices or laptops directly or indirectly infringe any asserted claim of the asserted patents, whether literally or under the doctrine of equivalents. Additionally, the asserted claims of the asserted patents are invalid for failure to satisfy one or more of the conditions or requirements of 35 U.S.C. §§ 101, 102, 103, 111, 112, 116, and/or 132.

3. **Legal Issues**

The principal disputed legal issues are:

- The proper construction of any disputed claim terms;
- Whether Defendants infringe any or all of the Asserted Patents, either directly or indirectly (35 U.S.C. § 271(a)-(c));
- Whether Maxell is entitled to damages as a result of the alleged infringement of any or all of the Asserted Patents, and if so, the amount (35 U.S.C. § 284)
- Whether Maxell is entitled to injunctive relief (35 U.S.C. § 283);
- Whether Defendants' alleged infringement is willful (35 U.S.C. § 284);
- Whether this case is exceptional (35 U.S.C. §§ 284-285);
- Whether any or all claims of the Asserted Patents are invalid under 35 U.S.C. §§ 101 *et seq.*, including particularly whether the asserted claims of the '188, '072, '449, and '760 patents are directed to an abstract idea without any inventive concept, and do not cover patentable subject matter under § 101.
- Whether any or all claims of the Asserted Patents are invalid under 35 U.S.C. §§ 102, 103, 111, 112, 116, and/or 132;
- Whether Maxell's claims for relief are statutorily limited, in whole or in part, by 35 U.S.C. §§ 286 and 287 for failure to properly mark and failure to give proper notice that LG's actions allegedly infringe the Asserted Patents; and
- Whether Maxell's claims are barred, in whole or in part, by any of Defendants' defenses, including their additional defenses pleaded in their Answer.

4. **Motions**

Defendants previously filed a Motion to Transfer pursuant to 28 U.S.C. § 1404(a). The Eastern District of Texas granted the Motion to Transfer on July 1, 2024 and transferred the case to the Northern District of California.

The parties filed a Joint Motion to Stay Pending Transfer in the Eastern District of Texas after the Motion to Transfer was granted, and that stay was entered on July 11, 2024.

Defendants filed a Motion for Judgment on the Pleadings ("§ 101 Motion," Dkt. 94) on October 4, 2024, alleging that the '188, '072, '449, and '760 patents cover an abstract idea without any inventive concept and are ineligible for patenting under 35 U.S.C. § 101. In its Opposition, Plaintiff moved, in the alternative, for leave to file a First Amended Complaint should the Court be inclined to grant the § 101 Motion. In their Reply, Defendants explained why leave to amend should be denied as futile. A hearing, previously scheduled for March 12, 2025, has been vacated.

Defendants filed a Motion to Stay Pending *Inter Partes* Reviews of certain asserted patents on January 24, 2025. ("Motion to Stay," Dkt. 124). The Motion to Stay has been fully briefed. A hearing, previously scheduled for March 12, 2025, has been vacated.

The parties anticipate that they will likely file motions for summary judgment or partial summary judgment on issues of infringement/non-infringement and/or validity/invalidity, and may file other dispositive and non-dispositive motions as appropriate, and pending any leave of Court that may be required, as the case progresses.

The parties jointly entered into a Patent Protective Order in the Eastern District of Texas case and the Court in this action entered a Stipulated Protective Order (Dkt. 121). The parties expect to enter into a Stipulated ESI Order and a Stipulated Supplemental Protective Order additionally governing discovery provided by one of LG's component suppliers, third party Qualcomm Inc.

5. **Amendment of Pleadings**

In its Opposition to LG's § 101 Motion described above, Plaintiff moved, in the alternative, for leave to file a First Amended Complaint should the Court be inclined to grant the Motion. Although the Scheduling Order set a deadline of February 3, 2025 to amend the pleadings without

leave, it also stated: "That deadline does not apply to the request for leave to amend that Plaintiff raised in its Opposition to the Defendants' Motion for Judgement on the Pleadings. That request will be addressed as part of the Court's ruling on the Motion for Judgment on the Pleadings." Scheduling Order, n. 1.

6. **Evidence Preservation**

The parties have reviewed the Northern District of California's Guidelines for the Discovery of Electronically Stored Information ("ESI") and Checklist for Rule 26(f) Meet and Confer Regarding ESI, including those portions related to evidence preservation. Additionally, the parties have met and conferred regarding evidence preservation. Each party has implemented a litigation hold with respect to all ESI and hardcopy documents and media identified as relevant to this action. Further agreement regarding ESI preservation will be addressed in the parties' Stipulated Order Regarding Discovery of ESI ("ESI Order").

7. **Disclosures**

The parties complied with the initial disclosure requirements of Fed. R. Civ. P. 26 on June 13, 2024 in the Eastern District of Texas litigation prior to transfer. On February 26, 2025, Defendants served amended initial disclosures.

8. **Discovery**

A. ***Discovery To Date***

The parties have served written discovery requests and responses. Additional written discovery requests have been served by the parties with responses not yet due.

To date, Maxell has produced over 197,000 pages of discovery, and LG has produced over 107,000 pages of discovery, totaling over 300,000 pages collectively produced.

Additionally, on February 14, 2025, Maxell served subpoenas *duces tecum* and *ad testificandum* on Qualcomm, Inc.

B. ***Scope of Anticipated Discovery***

The Court addressed written discovery limitations in its December 5, 2024 Scheduling Order (Dkt. 118), adopting discovery limitations previously set in the Eastern District of Texas Discovery Order (Dkt. 40). The parties have also agreed to (i) certain limits on the number of

requests for document production and admission, (ii) certain limits on deposition lengths, and (iii) certain limitations and modifications of discovery rules regarding privilege/work product, expert communications, third-party discovery, email service, ESI, and authenticity. (Dkt. 115)

C. ***Patent Local Rules***

Per the Eastern District of Texas's Patent L.R. 3-1 and 3-2, Maxell served its Infringement Contentions on May 16, 2024, and Corrected Infringement Contentions on May 22, 2024.

On December 18, 2024, in accordance with this District's Patent L.R. 3-1 and 3-2, Maxell served Infringement Contentions on LG. Maxell produced documents bearing production numbers MAX_LG_NDCA_0192423-0192818 as part of its accompanying document production.

On February 3, 2025, in accordance with Patent L.R. 3-3 and 3-4, Defendants served Invalidity Contentions on Maxell. Defendants produced documents bearing production numbers LGEMAX00075132-00092164 as part of its accompanying document production.

On February 18, 2025, in accordance with Patent L.R. 4-1, the parties exchanged proposed terms for construction.

On March 11, 2025, in accordance with Patent L.R. 4-2, the parties exchanged preliminary claim constructions and extrinsic evidence. Maxell and Defendants produced documents bearing production numbers MAX_LG_NDCA_0197101-0199302 and LGEMAX00100495-00107311 as part of their accompanying document production.

9. **Class Actions**

This is not a class action.

10. **Related Cases**

Maxell identifies the following pending case involving related patents:

- *Maxell, Ltd. v. Samsung Electronics Co., Ltd.*, et al., Case No. 5:23-cv-92 (E.D. Tex.) (involving U.S. Patent Nos. 10,129,590 and 11,445,241 (related to Asserted U.S. Patent No. 10,244,284) and U.S. Patent No. 11,017,815 (related to Asserted U.S. Patent Nos. 9,818,449 and 10,199,072)).

LG identifies the following *Inter Partes* Reviews ("IPR") petitions that are all captioned as *LG Electronics Inc. et al. v. Maxell, Ltd.*, but with different IPR docket numbers:

- IPR2025-00392, filed December 31, 2024, against U.S. Patent No. 8,339,493;
- IPR2025-00444, filed January 10, 2025, against U.S. Patent No. 8,736,729;
- IPR2025-00393, filed December 30, 2024, against U.S. Patent No. 9,818,449;
- IPR2025-00394, filed December 30, 2024, against U.S. Patent No. 10,199,072;
- IPR2025-00518, filed January 22, 2025, against U.S. Patent No. 6,856,760;
- IPR2025-00519, filed January 22, 2025, against U.S. Patent No. 7,421,188; and
- IPR2025-00520, filed January 22, 2025, against U.S. Patent No. 10,244,284.

11. **Relief**

Maxell seeks the following relief for an adjudication that Defendants infringe one or more claims of the Asserted Patents:

(1) Compensatory damages pursuant to 35 U.S.C. § 284 in an amount that presently cannot be ascertained but that will be determined at trial;

(2) Injunctive relief pursuant to 35 U.S.C. § 283 for any unexpired Asserted Patents found to be infringed;

(3) Trebling of damages pursuant to 35 U.S.C. § 284; and

(4) Attorneys' fees pursuant to 35 U.S.C. § 285.

Defendants seek the following relief:

(1) A judgment dismissing the Complaint in its entirety with prejudice, and denying Plaintiff all requested relief;

(2) A finding that Defendants have not infringed, and do not infringe, literally or under the doctrine of equivalents, directly or indirectly, willfully or otherwise, any valid and enforceable claim of any Asserted Patent;

(3) A finding that the asserted claims of the Asserted Patents are invalid and/or unenforceable; and

(4) Defendants' attorneys' fees, costs, and expenses under 35 U.S.C. § 285.

12. **Settlement and ADR**

The Court referred this case to private mediation to occur no later than 45 days after the Court issues its claim construction order. Scheduling Order, p. 2. The parties are engaged in

informal settlement discussions.

13. **Other References**

The parties do not believe this case is suitable for reference to binding arbitration, a special master or the Judicial Panel on Multidistrict Litigation.

14. **Narrowing of Issues**

The parties identify the following issues which are the most consequential to the case and how these issues may be expedited:

(1) **Whether any or all of the asserted claims of the '188, '072, '449, and '760 Patents are invalid under 35 U.S.C. § 101:** this issue was set for a hearing on March 12, 2025 and all briefing on LG's motion on this issue is now complete (see Section 4 above).

(2) **The proper construction of any disputed claim terms**: the timing of this issue is set by the Patent Local Rules and therefore cannot be expedited.

(3) **Whether Defendants infringe any or all of the Asserted Patents, either directly or indirectly (35 U.S.C. § 271(a)-(c))**: the timing of this issue is set by the Patent Local Rules and therefore cannot be expedited.

(4) **Whether any or all claims of the Asserted Patents are invalid under 35 U.S.C. §§ 101 *et seq*., including 35 U.S.C. §§ 101, 102, 103, 111, 112, 116, and/or 132**: the timing of this issue is set by the Patent Local Rules and therefore cannot be expedited.

(5) **The number of Asserted Claims, Asserted Patents, and Accused Products:** Plaintiff has asserted 29 patent claims across nine patents; the parties' positions concerning the timing and narrowing of claims is detailed in the parties' November 20, 2024 Joint Case Management Statement. (Dkt. No. 115, p. 16.)

15. **Expedited Trial Procedure**

The parties do not believe that this case may be handled under the Expedited Trial Procedure of General Order 64.

16. **Scheduling**

On December 5, 2024, the Court entered a Case Management and Scheduling Order setting dates through the Claim Construction Hearing. (Dkt. 118.)

Plaintiff proposes that the Court now enter the remaining deadlines that Plaintiff proposed in the November 20, 2024 Joint Case Management Statement & Proposed Order (Dkt. 115 at ¶ 16).

Defendants submit that entry of additional deadlines is premature in light of the pending motions (including LG's Motion to Stay) and claim construction issues. In fact, Judge Lee expressly declined to adopt Plaintiff's "remaining deadlines," stating that the court would hold "a further case management conference after the claim construction hearing and finalize the schedule from there." (December 4, 2024 CMC Hrg. Tr. at 4:6-8.)

17. **Trial**

The parties agree that the case will be tried to a jury, and expect the trial to last 10 days given the current asserted claims, patents, and accused products.

18. **Disclosure of Non-party Interested Entities or Persons**

Each party filed its Certification of Interested Entities or Persons (Maxell on September 6, 2024 (Dkt. 75) and Defendants on October 4, 2024 (Dkt. 83)).

19. **Professional Conduct**

The parties certify that all attorneys of record have reviewed the Guidelines for Professional Conduct for the Northern District of California.

20. **Other**

A. Additional Information: On February 24, 2025, the Court ordered the parties to provide the following information under this section (Dkt. 130, ¶ 8(a)).

(i) List of Each Party.

Plaintiff Maxell is a Japanese corporation with a registered place of business at 1 Koizumi, Oyamazaki, Oyamazaki-cho, Otokuni-gun, Kyoto, Japan.

Defendant LG Electronics Inc. is a South Korean corporation with its principal place of business at LG Twin Towers 128 Yeoui-daero, Yeongdeungpo-gu, Seoul, South Korea.

Defendant LG Electronics U.S.A., Inc., is a Delaware corporation with a principal place of business at 111 Sylvan Avenue, Englewood Cliffs, New Jersey 07632.

(ii) A Summary of All Claims. See section 2, *supra*.

(iii) Brief Procedural History of Case.

Date	Event
December 29, 2023	Complaint filed in E.D. Texas
May 16, 2024	Plaintiff serves E.D. Tex. Infringement Contentions
May 17, 2024	E.D. Texas enters Discovery Order, Docket Control Order and Patent Protective Order
June 13, 2024	Initial Disclosures exchanged
July 1, 2024	E.D. Texas grants motion to transfer to N.D. Cal.
August 9, 2024	Case transferred to N.D. Cal. from E.D. Tex.
October 4, 2024	Defendants file Motion for Judgment of Pleadings
November 20, 2024	Joint Case Management Statement and [Proposed] Order filed
December 4, 2024	Initial Case Management Conference before Judge Eumi K. Lee
December 5, 2024	Scheduling Order entered by Judge Eumi K. Lee
December 10, 2024	Stipulated Protective Order entered by Magistrate Judge Susan van Keulen
December 18, 2024	Plaintiff serves N.D. Cal. Infringement Contentions under Patent L.R. 3-1 and 3-2
January 24, 2025	Defendants file their Motion to Stay Pending *Inter Partes* Reviews
February 3, 2025	Defendants serve Invalidity Contentions under Patent L.R. 3-3 and 3-4
February 18, 2025	Parties exchange proposed terms for construction under Patent L.R. 4-1
February 24, 2025	Order Reassigning Case to Judge Noël Wise
March 11, 2025	Parties exchange preliminary claim constructions and extrinsic evidence under Patent L.R. 4-2

C. Markman Tutorial and Hearing. A Claim Construction tutorial (June 12, 2025) and Claim Construction Hearing (June 26, 2025) are currently set in the Scheduling Order. The parties understand these two dates are vacated as "hearing dates" per the Court's Order Reassigning Case (Dkt. 130).

Dated: March 17, 2025

MAYER BROWN LLP

/s/ Michael A. Molano

EDWARD D. JOHNSON (SBN 189475)
wjohnson@mayerbrown.com
CLIFF A. MAIER (SBN 248858)
cmaier@mayerbrown.com
GRAHAM (GRAY) BUCCIGROSS (SBN 234558)
gbuccigross@mayerbrown.com
Two Palo Alto Square, Suite 300
3000 El Camino Real
Palo Alto, CA 94306
Telephone: (650) 331-2000

MICHAEL A. MOLANO (SBN 171057)
mmolano@mayerbrown.com
575 Market Street, Suite 2500
San Francisco, CA 94105
Telephone: (415) 874-4230

ALAN M. GRIMALDI (admitted *pro hac vice*)
agrimaldi@mayerbrown.com
1999 K Street, N.W.
Washington, D.C. 20006
Telephone: (202) 263-3000

Attorneys for Plaintiff Maxell, Ltd.

Dated: March 17, 2025

FISH & RICHARDSON P.C.

/s/ Michael J. Ballanco

Leeron G. Kalay, CA 233579
kalay@fr.com
500 Arguello Street, Suite 400
Redwood City, CA 94063
Tel: (650) 839-5070
Fax: (650) 839-5071

Michael J. McKeon, DC 459780 (*Pro Hac Vice*)
mckeon@fr.com
Christian A. Chu, CA 218336
chu@fr.com
R. Andrew Schwentker, DC 991792 (*Pro Hac Vice*)
schwentker@fr.com
Michael J. Ballanco, DC 1030421 (*Pro Hac Vice*)
ballanco@fr.com
Jack R. Wilson, IV, VA 91178 (*Pro Hac Vice*)
jwilson@fr.com
Jenna Kuh, DC 1724742 (*Pro Hac Vice*)
kuh@fr.com
Bryan J. Cannon, DC 1723657 (*Pro Hac Vice*)
cannon@fr.com
James W. Cowan, DC 90004828 (*Pro Hac Vice*)
cowan@fr.com
1000 Maine Avenue, S.W., Suite 1000
Washington, DC 20024
Tel: (202) 783-5070
Fax: (202) 783-2331

Attorneys for Defendants LG Electronics, Inc. and LG Electronics U.S.A., Inc.

FILER'S ATTESTATION

Pursuant to Civil L.R. 5-1(i)(3), regarding signatures, I, Michael A. Molano, attest that concurrence in the filing of this document has been obtained from each of the signatories. I declare under penalty of the laws of the United States of America that the foregoing is true and corrected. Executed this 17th day of March 2025, at San Francisco, California.

/s/ Michael A. Molano

Michael A. Molano

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