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

MAXELL, LTD.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	CIVIL ACTION NO. 5:23-CV-92-RWS [redacted]
	§	
SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC.,	§	
	§	
Defendants.	§	

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**;

- Samsung's Motion to Strike Certain Portions of the Expert Reports of Dr. Jacob O. Wobbrock Regarding U.S. Patent No. 11,223,757 (Docket No. 119) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

- Samsung's Motion to Strike Portions of Expert Reports of Dr. Jon Weissman (Docket No. 123) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

- Samsung's Motion to Strike Certain Portions of the Rebuttal Expert Reports of Dr. Karan Singh Regarding U.S. Patent No. 11,017,815 (Docket No. 127) is **DENIED**;

- Maxell's Motion to Strike Portions of Defendants' Expert Reports Based on Untimely Claim Construction Positions (Docket No. 125) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

- Maxell's Motion for Partial Summary Judgment of Validity Based on Samsung's *Sotera* Stipulations (Docket No. 132) is **DENIED**;

- Samsung's Motion for Summary Judgment of Subject Matter Ineligibility Under 35 U.S.C. § 101 for U.S. Patent Nos. 11,017,815; 11,223,757; and 8,037,161 (Docket No. 130) is **DENIED**;

- Maxell's Motion to Strike and Exclude Dr. Buehrer's Testing of the N93 Product Samples (Docket No. 128) is **DENIED**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,129,590 (Docket No. 120) is **GRANTED**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent Nos. 11,223,757 and 8,037,161 (Docket No. 121) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,176,848 (Docket No. 122) is **DENIED**; and

- Samsung's Motion for Partial Summary Judgment of Noninfringement and Summary Judgment of Invalidity for Lack of Written Description Under 35 U.S.C. § 112 for U.S. Patent No. 8,982,086 (Docket No. 124) is **GRANTED-IN-PART** and **DENIED-IN-PART**.

LEGAL STANDARD

I. Motions to Exclude Expert Testimony

Under Federal Rule of Evidence 702, a qualified expert may testify if (1) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the

evidence or to determine a fact in issue; (2) the testimony is based on sufficient facts or data; (3) the testimony is the product of reliable principles and methods; and (4) the expert has reliably applied the principles and methods to the facts of the case. Fed. R. Evid. 702.

The Federal Rules of Evidence "assign to the trial judge the task of ensuring that an expert's testimony both rests on a reliable foundation and is relevant to the task at hand." *Daubert v. Merrell Dow Pharms. Inc.*, 509 U.S. 579, 597 (1993). "The relevance prong [of *Daubert*] requires the proponent [of the expert testimony] to demonstrate that the expert's 'reasoning or methodology can be properly applied to the facts in issue.' " *Johnson v. Arkema, Inc.*, 685 F.3d 452, 459 (5th Cir. 2012) (quoting *Curtis v. M & S Petroleum, Inc.*, 174 F.3d 661, 668 (5th Cir. 1999)). "The reliability prong mandates that expert opinion 'be grounded in the methods and procedures of science and . . . be more than unsupported speculation or subjective belief. ' " *Johnson*, 685 F.3d at 459 (quoting *Curtis*, 174 F.3d at 668).

"The proponent need not prove to the judge that the expert's testimony is correct, but she must prove by a preponderance of the evidence that the testimony is reliable." *Johnson*, 685 F.3d at 459 (quoting *Moore v. Ashland Chem., Inc.*, 151 F.3d 269, 276 (5th Cir. 1998) (en banc)). At base, "the question of whether the expert is credible or the opinion is correct is generally a question for the fact finder, not the court." *Summit 6, LLC v. Samsung Elecs. Co., Ltd.*, 802 F.3d 1283, 1296 (Fed. Cir. 2015).

II. Motions to Strike Untimely Expert Testimony

Local Patent Rule 3-1 requires a party alleging infringement to disclose asserted claims and infringement contentions shortly after the initial case management conference. The disclosure must include "[w]hether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality." P.R. 3-1. "The contentions must be specific enough to give a defendant notice of plaintiff's infringement claims

and must go beyond that provided by the mere language of the patent." *Computer Acceleration Corp. v. Microsoft Corp.*, 503 F. Supp. 2d 819, 823 (E.D. Tex. 2007)

Expert infringement reports may not rely on new theories not previously set forth in the plaintiff's infringement contentions. *See Sycamore IP Holdings LLC v. AT&T Corp.*, No. 2:16-CV-588-WCB, 2017 WL 4517953, at *6 (E.D. Tex. Oct. 10, 2017). For example, a plaintiff's failure to disclose doctrine of equivalents ("DOE") infringement theories in its contentions is grounds to strike DOE theories from an expert report. *Id.* at *2. "[T]he scope of infringement contentions and expert reports are not, however, coextensive"—a plaintiff's infringement contentions are "not required to cite all the evidence its experts would rely on." *Core Wireless Licensing, S.A.R.L. v. LG Elecs., Inc.*, No. 2:14-CV-91, 2016 WL 3655302, at *4 (E.D. Tex. Mar. 21, 2016) (citations omitted).

When deciding whether to strike a new infringement theory for non-compliance with Local Patent Rules, courts in this district consider several factors, including:

> (1) the **length** of the delay [in asserting the new theory] and its potential impact on judicial proceedings; (2) the **reason** for the delay, including whether it was within the **reasonable control** of the [offending party]; (3) whether the offending party was **diligent** in seeking an extension of time, or in supplementing discovery, after an alleged need to disclose the new matter became apparent; (4) the **importance** of the particular matter, and if vital to the case, whether a lesser sanction would adequately address the other factors to be considered and also deter future violations of the court's scheduling orders, local rules, and the federal rules of procedure; and (5) the danger of **unfair prejudice** to the [other parties].

Id. at *2 (emphasis added).

III. Motions for Summary Judgment

Summary judgment exists, in part, "to isolate and dispose of factually unsupported claims or defenses." *Celotex Corp. v. Catrett*, 477 U.S. 317, 323–24 (1986). A court may grant summary judgment when the moving party shows that "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *see also Celotex*,

477 U.S. at 327. A genuine dispute of material fact exists when "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). The trial court must resolve all reasonable doubts in favor of the party opposing the motion for summary judgment. *Casey Enterprises, Inc. v. American Hardware Mut. Ins. Co.*, 655 F.2d 598, 602 (5th Cir. 1981) (citations omitted). The substantive law identifies which facts are material. *Anderson*, 477 U.S. at 248.

The party moving for summary judgment "always bears the initial responsibility of . . . demonstrat[ing] the absence of a genuine issue of material fact." *Celotex*, 477 U.S. at 323. If the movant bears the burden of proof on a claim or defense on which it is moving for summary judgment, it must come forward with evidence that establishes "beyond peradventure all of the essential elements of the claim or defense." *Fontenot v. Upjohn Co.*, 780 F.2d 1190, 1194 (5th Cir. 1986) (emphasis in original). The moving party, however, is not required to support its motion with materials negating its opponent's claim where the party in opposition carries the burden of proof at trial. *Celotex*, 477 U.S. at 322–23. Instead, the movant may discharge its burden by showing there is an absence of evidence to support the nonmovant's case. *Id.* at 325; *see also*, *Byers v. Dallas Morning News, Inc.*, 209 F.3d 419, 424 (5th Cir. 2000). Where a nonmoving party that carries the burden of proof at trial fails to make a showing sufficient to establish an essential element of its case in response to a motion for summary judgment, "there can be no genuine issue as to any material fact, since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial." *Celotex*, 477 U.S. at 323 (citations omitted).

DISCUSSION

I. Samsung's Motion to Exclude the Opinions and Testimony of Plaintiff's Damages Expert John C. Jarosz (Docket No. 117)

Samsung moves to exclude opinions from Maxell's damages expert, John C. Jarosz, concerning his (1) incremental benefits approach and (2) licensing comparables approach. Docket No. 117 at 1.

A. Mr. Jarosz's Incremental Benefits Approach

Experts must use sound methodology to reliably apportion damages between the value of unpatented and patented features. *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1226 (Fed. Cir. 2014). With respect to Mr. Jarosz's incremental benefits approach, Samsung argues that he improperly apportions the gains enjoyed by Samsung attributable to use of the asserted patents by "count[ing] the number of features used as headings in a press release, determin[ing] which features purportedly include patented technology . . . and then simply divid[ing] the number of allegedly patented features by the total number of highlighted features to arrive at a profit 'apportionment' value for the allegedly patented features." *Id.* at 5 (describing an exemplary equation for the '161 Patent as: "one patented feature highlighted in press release ÷ 19 total features highlighted in press release = 5.3 percent 'apportionment' of profits to patented feature"); *see* Docket No. 117-1 (Jarosz Report) at Tab 27. Samsung argues that this apportionment is improper because it assigns zero value to product features not mentioned in the marketing documents and arbitrarily assigns equal value for the product features that are mentioned. *Id.* at 5–10 (citing *Stragent, LLC v. Intel Corp.*, No. 6:11-CV-421, 2014 WL 1389304 (E.D. Tex. Mar. 6, 2014)).

In response, Maxell contends that Samsung has not identified any features omitted from marketing documents and courts have held that exclusion of features from an analysis (even where such exclusion could directly impact the mathematical calculation) is an issue that goes to weight rather than admissibility. Docket No. 151 at 6–7. Maxell also explains that the court in *Stragent* struck expert testimony assigning all features equal value because that expert "admitted that he could not separately estimate the value of the accused feature," thus failing to provide any adequate

basis for his opinion on equal value. *Id.* at 8; *Stragent*, 2014 WL 13890304, at *4 (citations omitted). Maxell claims that, unlike *Stragent*, Mr. Jarosz does not just assume the product features all have the same value because he could not determine their value—instead, he "performed a careful review of facts related to the accused functionalities and determined that such functionalities are more valuable than average and thus, conservatively assigned them a lower number, an average value, calculated from the press releases." Docket No. 151 at 9.

Mr. Jarosz's methodology for his incremental benefits approach is flawed and unreliable in at least three respects. *See Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1226 (Fed. Cir. 2014) (explaining that experts must reliably apportion damages between the value of the patented and unpatented features); *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 904 F.3d 965, 977 (Fed. Cir. 2018).

1. Choosing the Samsung Marketing Documents

First, Mr. Jarosz arbitrarily chose to use Samsung's press releases and marketing documents to conduct his calculations without input from any technical expert or Samsung fact witness. It is undisputed that Mr. Jarosz did not confirm with any technical expert or Samsung fact witnesses that he could reliably use the Samsung press releases and select the features in them for his incremental benefits approach. Docket No. 117-2 (Jarosz Tr.) at 67:13–68:5, 87:22–89:3 (admitting that he did not speak to any Samsung fact witness or technical expert for his analysis). Mr. Jarosz did not discuss the Samsung press releases with any technical expert and did not review any deposition testimony about them. *Id.*

Samsung explains that this is improper because there is no support that Samsung intended its press releases to value the features. Docket No. 175 at 1. Samsung also points out if Mr. Jarosz had chosen to use the more thorough Galaxy S9/S9+ manual instead, then this would have included many more features. Docket No. 117 at 1. Maxell argues that Mr. Jarosz reliably chose to use the

Samsung press releases because they reflect what Samsung, who "knows its business better than anybody else," believed to be the "difference makers in the marketplace." Docket No. 151 at 5 (citing Docket No. 151-2 (Jarosz Tr.) at 85:21–86:15, 95:10–15). But these are just assumptions untethered from the evidence.

2. Selecting the Features in the Samsung Marketing Documents

Second, Mr. Jarosz strays even further from a reliable methodology by arbitrarily selecting the features in those press releases and marketing documents without input from any technical expert or Samsung fact witness, potentially excluding relevant features that would lower the apportionment value for the accused feature. Besides the fact that he did not rely on a technical expert or Samsung fact witness, Mr. Jarosz's report does not explain his methodology for how he selected certain features over others. *See, e.g.*, Docket No. 171-1 (Jarosz Report) at ¶ 191 ("I compiled the features and product specifications that Samsung highlighted when it launched Galaxy S9 and Galaxy S9+. Based on Samsung's press release, I identified 19 Broad Features / Product Specifications Categories, which are the highest grouping of features or product specifications that Samsung highlighted"). The court in *Stragent* found the damages expert's selection of features unreliable because, *inter alia*, "his report [did] not . . . explain the methodology he used to select those features." *Stragent, LLC v. Intel Corp.*, No. 6:11-CV-421, 2014 WL 12611339, at *1 (E.D. Tex. Mar. 12, 2014). Mr. Jarosz's methodology here is unreliable for the same reason.

And even though his report does not explain his methodology, it is clear that Mr. Jarosz's selection of what constitutes a feature or not in Samsung's press releases is arbitrary. As Samsung highlights, some of the features that Samsung decides to include in press releases for new products "may differ based on factors that Mr. Jarosz did not consider, including geography and whether the device is completely new or an upgraded model of a prior version." Docket No. 175 at 2. And

"many headings in the press release do not describe product features specifically but rather are catch-all phrases describing groups of features and functions." *Id.* For example, Maxell attempts to argue that the "Network" and "Connectivity" headings are allegedly features that encompass the ability to make a phone call. Docket No. 151 at 7. If Maxell had chosen to confirm what Samsung intended for each heading to encompass and what technical features Mr. Jarosz may have missed by eliciting technical expert and Samsung fact witness testimony, that may have cured these problems, but it is too late now.

Maxell musters one last argument that caselaw shows that exclusion of features from an analysis is an issue that goes to weight rather than admissibility. Docket No. 151 at 6 (citing *Kaist IP US LLC v. Samsung Elecs. Co.*, No. 2:16-CV-1314-JRG-RSP, 2018 WL 2688185, at *1–2 (E.D. Tex. June 5, 2018)). But in *Kaist*, the court did not exclude a damages expert's opinion that had excluded certain features over others when that expert had relied on the opinion of a technical expert. *Kaist*, 2018 WL 2688185, at *2. Any argument from Maxell that Mr. Jarosz did so in his expert report only cites to broad sweeping statements about the technology and the patents unrelated to verifying how he chose to use the press releases and selected the features for his incremental benefits approach. Docket No. 151 at 8 (citing Docket No. 171-1 (Jarosz Report) at ¶¶ 17–41, 45–78, 173, 214, 227, 230, 254); Docket No. 171-1 (Jarosz Report) at ¶¶ 17 ("I understand from Professor Jon Weissman, Professor Karan Singh, Professor Ravin Balakrishnan, Professor Jacob Wobbrock, and Mr. Bruce McNair that the Asserted Patents relate to various functionalities and capabilities of electronic devices including smartphones, tablets, laptops, and consumer appliances"), 230 (relying on a technical expert only to opine that the features are enabled by the patent, but not how he selected the features), 254 (focused on the benefits of the patents).

3. "More Important Than Average" Conclusion and Equal Value Benchmark

Third, Mr. Jarosz's methodology of concluding that the accused feature was "more important than average" and subsequently assigning that feature a benchmark value equal to the other features in the document was not appropriately tethered to the evidence. Courts generally do not permit damages experts to assign equal value across features because such estimates are "arbitrary, general, and unrelated to the facts of the case." *Stragent*, 2014 WL 1389304, at *4 (citations omitted). Here, Mr. Jarosz's assignment of equal value based on his valuation of the accused feature as "more important than average" is unreliable. Docket No. 151 at 3; Docket No. 117-2 (Jarosz Tr.) at 55:4–7 (agreeing with the characterization of his analysis as valuing the accused features as "more important than average"). Mr. Jarosz admits that as part of his analysis, "[he] did not explicitly value the other features." Docket No. 175-1 (Jarosz Tr.) at 52:11–12. Without valuing the other features, Mr. Jarosz could not benchmark what the "average" value is. Maxell also offers no evidence as to what "average" means. *See, e.g.*, Docket No. 117-1 (Jarosz Report) at ¶ 304 (merely concluding that technology covered by the '757 Patent "is an important functionality in Samsung devices"). This is no different from *Stragent* where the expert arbitrarily assigned equal value to the features because "he could not separately estimate the value of the accused feature" from the other RAS features. 2014 WL 1389304, at *4.

Maxell claims that Mr. Jarosz's methodology was acceptable because, to conclude that the accused feature was "more important than average," Mr. Jarosz had performed a careful review of the facts, which included Samsung press releases, statements made by third parties about the accused features, Samsung's website, internal Samsung presentations, and Samsung post-purchase surveys. Docket No. 151 at 9–11. Maxell argues that this is different than what the expert did in *Stragent*, who arbitrarily assigned equal value, and similar to what the expert did in *Skillz Platform*,

who reviewed "among other things, [the parties'] developer presentations, [Plaintiff's] marketing materials, [the parties'] user responses to surveys, and depositions of witnesses for both parties" before concluding that the accused feature "would be at least equivalent to the average value of all the features." *Skillz Platform Inc. v. AviaGames Inc.*, 2023 WL 8438738, at *8 (N.D. Cal. Dec. 5, 2023) (citations omitted); *Stragent*, 2014 WL 13890304, at *4.

Skillz Platform is distinguishable. The court there found that a damages expert's decision to assign equal value to the key features was appropriately supported by the evidence, because it had already found that "it was not arbitrary for [the damages expert] to rely on [the opposing party's] SEC filings, which the parties **agree** list the same features year-after-year." *Skillz Platform*, 2023 WL 8438738, at *7–8 (emphasis added). Maxell does not argue that the Samsung marketing documents are similar or have the same year-to-year consistency as the SEC filings in *Skillz Platform*. *See* Docket No. 202 at 2 (instead admitting "though *Skillz* may have involved a party's SEC filings, ..."). Samsung also has evidenced no such agreement here and its fact witnesses did not have the opportunity to testify on the documents Mr. Jarosz used. *See, e.g.*, Docket No. 117 at 9; Docket No. 117-2 (Jarosz Tr.) at 88:20–89:3. The issues related to Mr. Jarosz's choice of the marketing documents trickle down to his "more important than average" conclusion and equal value benchmark.

Other courts have held that a damages expert's assignment of equal value across features is only acceptable because they relied on a technical expert's analysis. *See, e.g.*, *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1313 (Fed. Cir. 2018). As mentioned in the previous section, Mr. Jarosz did not rely on any technical experts for his incremental benefits approach.

Finally, Maxell attempts to save Mr. Jarosz's use of the benchmark equal value by explaining that it was a "conservative" way to inform the royalty rate. Docket No. 151 at 5, 10;

see Docket No. 117-2 (Jarosz Tr.) at 118:5–10, 14–19 (**Q:** Now, you didn't rely on those customers surveys as part of your . . . math [for the numeric proportionality calculations], right? **A:** As part of the math, that's correct. I[] did confirm that using a simple average in the apportionment was conservative"). When faced with such arguments, courts have responded that "a conservative opinion in that sense [still] does not equate to a scientific one." *Stragent*, 2014 WL 1389304, at 4 (striking damages expert's arbitrary equal value opinion even when parties attempted to justify the opinion as "conservatively low").

There is no scientific basis for Mr. Jarosz's choice to use the Samsung marketing documents he did, his selection of the features in those documents, and his assumptions about the equal value of the accused features. For these reasons, Samsung's motion to exclude the opinions of Mr. Jarosz (Docket No. 117) is **GRANTED** with respect to his incremental benefits approach.

B. Mr. Jarosz's Licensing Comparables Approach

With respect to Mr. Jarosz's licensing comparables approach, Samsung argues that the upper bound of Mr. Jarosz's royalty rate, 1%, is unsupported because none of the relevant license agreements Mr. Jarosz cites state that rate on their face. *Id.* at 11 (citing *Whitserve, LLC v. Computer Packages, Inc.*, 694 F.3d 10, 29 (Fed. Cir. 2012) (rejecting a "rate [that] was based on a proposed, but unaccepted, license")). Further, Samsung claims that Mr. Jarosz fails to apportion the value of unpatented features from his proposed royalty base of accused component costs. *Id.* at 14–15.

Maxell explains in response that the 1% upper bound was grounded in agreements and testimony, and that the very case that Samsung cites explicitly "acknowledge[d] that proposed licenses may have some value for determining a reasonable royalty in certain situations." Docket No. 151 at 13 (citing *Whitserve*, 694 F.3d at 30). And to Samsung's argument complaining of the lack of apportionment in the royalty base, Maxell explains that the *patent* portfolio royalty rate

Mr. Jarosz proposes already apportions out the unpatented technologies because it only captures the value associated with Maxell's patented technology. *Id.* at 15.

Unconsummated offers can have value for determining a reasonable royalty in certain situations. *Whitserve*, 694 F.3d at 30. And here, there is sufficient evidence that supports Mr. Jarosz's opinion that Maxell has a 1% standard royalty rate, whether the relevant offers were consummated or not. Maxell license agreements [redacted]. Docket No. 151-7 ([redacted] License) at MAXELL_SAMSUNG_0017435 ("[redacted]"); Docket No. 151-8 ([redacted] License) at MAXELL_SAMSUNG_0092717 (same). Maxell corporate witnesses have testified that Maxell has a 1% standard royalty rate that is communicated to potential licensees during negotiations. Docket No. 151-5 (Yamamoto Tr.) at 180:12–181:2, 181:10–12, 181:19–182:9, 182:10–16; Docket No. 151-6 (Nakamura Tr.) at 12:3–12. And Maxell corporate witnesses have testified that even where the explicitly written standard rate has been reduced to account for non-monetary consideration, Maxell itself believed that the monetary and non-monetary consideration combined amounted to 1%. Docket No. 151-5 (Yamamoto Tr.) at 192:8–193:17, 208:22–209:10, 223:10–21 (addressing [redacted]); Docket No. 151-6 (Nakamura Tr.) at 27:12–28:6 (addressing [redacted]). The Court is not convinced that 1% is such an "outrageous offer[]" that the evidentiary value of the rate is limited. *Whitserve*, 694 F.3d at 30. Samsung is free to challenge the weight of that evidence on cross-examination.

With respect to the accused component costs, the issue is whether Mr. Jarosz needed to further apportion the royalty base. Maxell argues that Mr. Jarosz already properly apportioned through the royalty rate. *See* Docket No. 117-1 (Jarosz Report) at ¶ 456 ("To account for the fact that a hypothetical license . . . would only grant Samsung the rights to a subset of Maxell's

smartphone patent portfolio, I applied the apportionment factors . . . to the [redacted] percent to 1.0 percent range"); Docket No. 151 at 15 ("Mr. Jarosz therefore need not perform additional, redundant quantitative calculations [in the royalty base] to address functionalities not covered by the asserted patents because they are already excluded [through the royalty rate]").

Despite Samsung's argument that the royalty base must be apportioned regardless of whether the royalty rate has already been apportioned, Samsung cites a case to support its own damages expert that explains that "apportionment may occur in the royalty base, royalty rate, or anywhere in between so long as the ultimate reasonable royalty award [is] based on the incremental value that the patented invention adds to the end product." Docket No. 155 at 4 (citing *PerdiemCo, LLC v. Industrack LLC*, No. 2:15-CV-726-JRG-RSP, 2016 WL 6611488, at *2 (E.D. Tex. Nov. 9, 2016) (citations omitted)). Samsung has provided no reasoning for its claim that Mr. Jarosz's proposed reasonable royalty award is not tethered to the value the patented invention adds to the end product when he did not apportion the royalty base specifically. Samsung does not explain why apportioning through the patent portfolio royalty rate is insufficient. Samsung's argument that Mr. Jarosz testified that the [redacted] rate was the "baseline value" of Maxell's portfolio is inapposite because, not only is it a mischaracterization of his testimony, but Mr. Jarosz is entitled to his reliable and supported opinion that there is a [redacted] to 1% rate for the hypothetical negotiation here. Docket No. 175 at 5 (citing (Docket No. 175-1 (Jarosz Tr.) at 168:2–14. The Court also notes that Mr. Jarosz's approach was limited by Samsung's production because it did not provide fulsome material costs and Maxell had to rely on cost of goods sold instead.

For these reasons, Samsung's motion to exclude Mr. Jarosz's opinions (Docket No. 117) is **GRANTED** with respect to his incremental benefits approach and **DENIED** with respect to his licensing comparables approach.

II. Maxell's Motion to Strike and Exclude Certain Testimony and Opinions Offered By Ms. Julie L. Davis (Docket No. 126)

Maxell moves to exclude opinions from Samsung's damages expert on (1) use of royalty range benchmarks based on the [redacted] Agreement and (2) the "other Samsung licenses" between Samsung and third parties. Docket No. 126.

The [redacted] Agreement ("PSA") is a [redacted] agreement entered into between [redacted] and Samsung. Docket No. 126 at 2–3. [redacted]. *Id.* at 3. Under the PSA, [redacted] paid [redacted] in exchange for the [redacted]. *Id.* at 3; Docket No. 155 at 9.

In order to assess *Georgia-Pacific* factor 2—rates paid by the licensee for the use of other patents comparable to the patents-in-suit—Ms. Davis uses the PSA and other Samsung licenses with third parties as comparable agreements. Docket No. 126 at 2.

A. [redacted] Agreement

To derive a benchmark value from the PSA, Ms. Davis calculates an "average per-patent family purchase" by dividing the [redacted] purchase price by [redacted] (the number of purchased patent families) to arrive at [redacted] per patent family. Docket No. 126-2 (Davis Report) at 66. To account for the fact that the purchased patent families include non-U.S. patents, Ms. Davis then applies 33%—[redacted]—to arrive at [redacted] as an endpoint for her reasonable royalty range per asserted patent. *Id.*

Maxell argues that no evidence supports Ms. Davis's assignment of equal value to each purchased patent family. Docket No. 126 at 6–8 (citing *Personalized Media Commc'ns, LLC v.*

Apple, Inc., No. 2:15-CV-1366-JRG-RSP, 2021 WL 662237, at *7 (E.D. Tex. Feb. 20, 2021)). Maxell also argues that there is no technical comparability for the patents purchased under the PSA—Dr. Kia, Samsung's technical expert, simply opined that purchased patents "relate to mobile phone technology" or "could be potentially included in mobile products." *Id.* at 8–10. Maxell explains that while the asserted patents fell under the [redacted] of the PSA, Ms. Davis only attributed value to the [redacted] *purchased* patent families for her reasonable royalty analysis. Docket No. 169 at 3. Finally, Maxell argues that Ms. Davis never adjusted the per-patent family purchase price when she used 2015 revenue data for the [redacted] PSA and included revenues of countries where there was no patent coverage, which would artificially inflate the benchmark value. *Id.* at 11–12.

In response, Samsung claims that there is evidence supporting Ms. Davis's conclusion that the purchased patent families under the PSA are equally valuable. Docket No. 155 at 6. Maxell corporate witness Mr. Tatsuya Yamamoto, who had been employed by Hitachi in their licensing department since 1996, had testified that Maxell "[redacted]. *Id.* at 6 (citing Docket No. 155-1 (Yamamoto Tr.) at 30:5–10, 31:18–32:19, 104:19–105:5, 160:14–15). Samsung argues that even though Mr. Yamamoto's testimony was about Maxell generally, "it was entirely reasonable for Ms. Davis to consider that [redacted]," the initial party to the [redacted] PSA and [redacted] the hypothetical negotiation. *Id.* at 6–7; *see also* Docket No. 117-1 (Jarosz Report) at ¶ 147. As for the technical comparability of the PSA, Samsung contends that Ms. Davis relied on Samsung's technical expert and none of the cases Maxell cites involve excluding expert opinions on a comparable agreement when that agreement involves the same parties and same asserted patents. Docket No. 155 at 10–12. On the issue of adjustments, Samsung argues that it was proper for Ms. Davis to use 2015 revenues because Mr.

Jarosz opined that that is the date of the hypothetical negotiation, and Ms. Davis also testified that her opinions would not change when using [redacted] revenues. *Id.* at 12–13; Docket No. 155-7 (Davis Tr.) at 96:21–25 ("I don't recall [the Samsung Americas revenue in [redacted] but I don't think it was much different in terms of a percentage of U.S. versus overseas"). Samsung also argues that Maxell provides no support that Ms. Davis needed to further apportion for countries where there was no patent coverage. *Id.* at 13.

Maxell's caselaw—specifically, its citation to *Personalized Media*—does not support its motion to strike Ms. Davis's assignment of equal value to the PSA's [redacted] purchased patent families. 2021 WL 662237, at *7. Not only is the expert's opinion on equal value specific to the *asserted patents* in *Personalized Media*—not patent families in a comparable agreement for the purposes of calculating a reasonable royalty range—but the court in *Personalized Media* notes that an expert "may conclude—by using evidentiary support—that the patents-in-suit hold[] the same value." *Id.* at *7. Ms. Davis has sufficiently tied her determination that the purchased patent families in the PSA have equal value to the facts of the case. *See, e.g.*, Docket No. 155-1 (Yamamoto Tr.) at 30:5–10, 31:18–33:5, 104:19–105:5, 160:9–15 (Maxell corporate witness, who had worked at Hitachi, Ltd., HCE, and Maxell with responsibilities related to IP and licensing since 1996, testifying "[redacted]").

To support its argument that the PSA is not comparable, Maxell does not cite any cases where the license covers the asserted patents and also includes the parties to the hypothetical negotiation. Docket No. 155 at 11 (distinguishing Maxell's cases); *see Headwater Rsch. LLC v. Samsung Elecs. Co.*, No. 2:22-CV-422-JRG-RSP, 2024 WL 4730474, at *2 (E.D. Tex. Nov. 8, 2024) ("Importantly here there can be no doubt that the settlement licenses are technically comparable, since they license the patent in suit"). Even though the asserted patents are part of the

license aspect of the PSA and not the purchased patent families, there is no requirement that Ms. Davis can only consider the [redacted] and not the patent sale. *Parthenon Unified Memory Architecture LLC v. Apple Inc.*, No. 2:15-CV-621-JRG-RSP, 2016 WL 7670833, at *1 (E.D. Tex. Sept. 21, 2016) ("[D]amages experts can consider patent sale agreements [to help calculate a reasonable royalty] under certain circumstances"). In determining the value of the PSA, Ms. Davis sufficiently accounted for the fact that "[t]he agreement includes rights much broader than the bare patent license that would be the outcome of the hypothetical negotiation." Docket No. 155-6 (Davis Report) at 67. She also relies on Dr. Kia's opinion on technical comparability. *Id.* at 62–67; Docket No. 155 at 9–10. Ms. Davis has set forth why she believes that the parties negotiating the PSA—[redacted]—were similarly situated to the parties for the hypothetical negotiation in this case, and therefore her use of the PSA meets at least a baseline level of comparability. *See Mobile Telecomms. Techs., LLC v. Spring Nextel Corp.*, No. 2:12-CV-832-JRG-RSP, 2014 WL 5816106, at *3 (E.D. Tex. Nov. 7, 2014).

Maxell admits that Ms. Davis does conduct an apportionment to account for the fact that the PSA included [redacted], but contends her use of 2015 revenues as a basis for that apportionment is unreliable. Docket No. 126 at 11. The Court does not find it unreliable that Ms. Davis used revenues from 2015, a date tied to Mr. Jarosz's proposed hypothetical negotiation. Whether she should have used the [redacted] revenues instead is an issue best left for cross-examination. Further, Maxell provides no support for the notion that Ms. Davis needed to further apportion for countries where there was no patent coverage.

B. Other Samsung Licenses

Maxell then argues that while Ms. Davis opined that prior Maxell agreements would not be comparable or relevant to the hypothetical negotiators under *Georgia-Pacific* factor 1—the royalties received by the patentee for the licensing of the patents-in-suit, proving or tending to

prove an established royalty—Ms. Davis then turns around and offers Samsung licenses with third parties as comparable under *Georgia-Pacific* factor 2 even though the same bases of incomparability she raised for the Maxell licenses also exist in the Samsung licenses. Docket No. 126 at 6, 12.

Samsung contends that Maxell's economic comparability arguments on the other Samsung licenses are issues better left for cross-examination. Docket No. 155 at 13–15. The Court agrees. Each of Maxell's arguments relate to the degree of comparability of the Samsung licenses versus the Maxell licenses. *See, e.g.*, Docket No. 126 at 14 ("Ms. Davis provides no explanation as to why [redacted] renders Maxell's agreements incomparable but not Samsung's"). Ms. Davis is entitled to draw her own conclusions on which licenses are comparable, and she has sufficiently explained why she chose those licenses. Docket No. 155 at 14 (describing that the Samsung licenses [redacted] the Samsung licenses were more relevant).

For these reasons, Maxell's motion to exclude Ms. Davis's opinions on the PSA and other Samsung licenses (Docket No. 126) is **DENIED**.

III. Samsung's Motion to Strike Portions of the Expert Reports of Bruce McNair Regarding U.S. Patent No. 10,129,590 (Docket No. 118)

Samsung moves to strike Mr. McNair's '590 Patent opinions on (1) a new infringement theory related to Quick Share Link Share ("Link Share") not disclosed in Maxell's infringement contentions, (2) new DOE theories not disclosed in Maxell's infringement contentions, and (3) secondary considerations of nonobviousness that were included in his rebuttal report but not his opening report. Docket No. 118 at 1.

A. New Link Share Infringement Theory

Samsung moves to strike Mr. McNair's new infringement theory related to Link Share, alleging that while Maxell disclosed in its infringement contentions a "First Infringement Theory" and "Second Infringement Theory" on Quick Share Nearby Share ("Nearby Share") and Bluetooth File Share, respectively, it did not do the same for Link Share. *Id.* at 1, 3. Maxell opposes, claiming that its definition of the "First Infringement Theory" is broad enough to capture Link Share, and that it included screenshots specific to Link Share in its contentions. Docket No. 152 at 4–9.

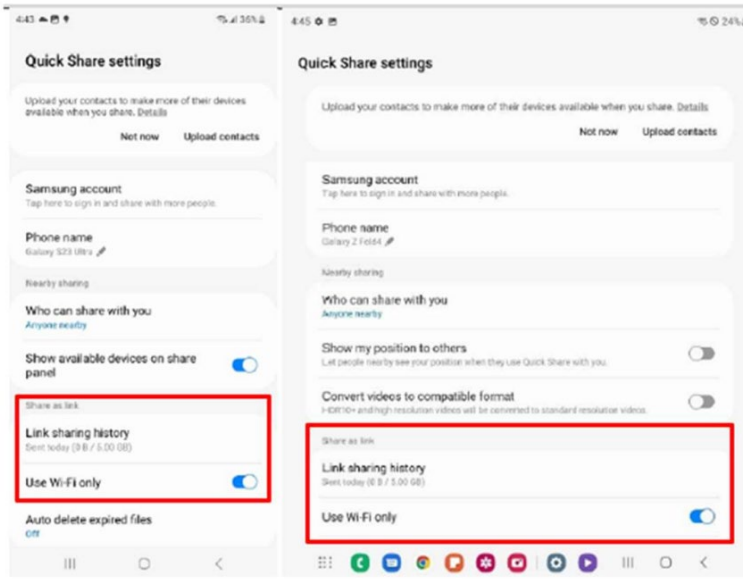
To be clear, there are two ways of sharing files using the Quick Share application: Nearby Share and Link Share. Docket No. 152-5 (Choi Tr.) at 12:19–13:16 ("[redacted]"). Samsung claims that "[a]ll the images, documents, and source code citations in Maxell's 2,124 pages of infringement contentions for the '590 patent relate solely to the user's choice to perform a Nearby Share—none relate to Link Share." Docket No. 174 at 1. Maxell points to statements, source code, and screenshots in the contentions that [redacted]. *Id.* at 2; *see, e.g.*, 118-5 ('590 Supplemental Infringement Contentions) at 38–66.

At the time it served its initial and supplemental contentions, it does not appear that Maxell intended to assert that Link Share infringed the '590 Patent. In fact, the way that Maxell had made its disclosures in its contentions suggested that the only Quick Share infringement theory it was pursuing was with respect to Nearby Share. For example, in its [1.k] contentions, Maxell fails to identify a single reference to Link Share. *See* Docket No. 174 at 3 (citing Docket No. 118-5 ('590

Supplemental Infringement Contentions) at 375–391). Maxell does not rebut this. *See* Docket No. 203. In its contentions, Maxell also relies on disabling the Wi-Fi router to test the fact that only the cellular radio in the accused products could connect to the Internet while the "WiFi router [was] switched off" which is a quality specific to Nearby Share, not Link Share. *See, e.g.*, Docket No. 118-5 ('590 Supplemental Infringement Contentions) at 383; Docket No. 174 at 3–4. Maxell also does not rebut this, and merely argues that disclosure of examples not related to Link Share does not foreclose Maxell's invocation of a Link Share theory. Docket No. 203 at 1.

Maxell's argument highlights that, although Nearby Share is disclosed on its own and analyzed in the contentions, Link Share is hardly ever discussed separate from Nearby Share. In fact, most of what Maxell argues are its supposed disclosures of its Link Share theory include references and arguments related to Nearby Share. *See* Docket No. 152 at 4; *see, e.g.*, Docket No. 118-5 ('590 Supplemental Infringement Contentions) at 14–20 (introducing Quick Share generically without excluding Nearby Share). This is also the case for what Maxell argues is its first disclosure of the Link Share theory. Docket No. 118-5 ('590 Supplemental Infringement Contentions) at 14 ("[E]ach of the Accused Samsung '590 Products includes a Wi-Fi communication chip . . . capable of transmitting video information via Wi-Fi communications (e.g., Quick Share)"). This lends credence to Samsung's argument that when Nearby Share and Link Share are addressed together in Maxell's contentions, it is a general and high-level introduction to Quick Share before the contentions describe how the Nearby Share functionality infringes each of the asserted claim limitations. *See* Docket No. 174 at 1. This does not constitute disclosure and notice of the Link Share theory.

The only instance that Link Share appears to be accused in Maxell's 2,000-page contentions on its own at the exclusion of Nearby Share is in the following screenshot.[1]



Docket No. 152 at 7 (citing Docket No. 118-5 ('5 [redacted] 's infringement contentions appears to have been a mistake. [redacted]. *See, e.g.*, Docket No. 284 (Hearing Tr.) at 151:25–152:16; *see* Docket No. 174 at 3. But Maxell certainly did not appear to be aware of this before, and therefore could not have been disclosing a Link Share theory in its contentions. *See, e.g.*, Docket No. 174 at 4 (explaining the [redacted]).

For example, the first time Maxell's expert Mr. McNair realized that the "Use Wi-Fi only" setting was [redacted]

[1] One could easily make the argument that this discloses Nearby Share as well through the heading "Quick Share settings."

served. Samsung's counsel had asked Mr. McNair why he would use the "Use Wi-Fi only" setting for testing the Nearby Share functionality. Docket No. 118-9 (McNair Tr.) at 194:5–24. Mr. McNair explained that he "thought it was relevant" at the time he developed the protocol, but that if the setting was only part of "Quick Share link, then it doesn't apply." *Id.* at 194:20–24; 196:18–23. To clarify his opinions, he testified "I am only accusing Quick Share and Nearby. [redacted] Docket No. 118-9 (McNair Tr.) at 83:9–17. And when Maxell questioned Samsung's 30(b)(6) witness Eunha Choi on Link Share during her deposition, it was [redacted]. Docket No. 152-5 (Choi Tr.) at 12:19–13:16, 24:12–31:23. The way that Maxell litigated the case up through the time it served its supplemental infringement contentions in April 2024—and even until opening expert reports were served in November 2024—does not suggest that Maxell was pursuing a Link Share theory. Samsung maintains that it was not put on actual notice until expert reports were served. *See* Docket No. 118 at 7. Maxell should not benefit from asserting a new last-minute theory when Samsung has not had an adequate opportunity to defend against the theory.

The factors relevant to Maxell's violation of the Local Patent Rules weigh in favor of excluding Mr. McNair's new Link Share theory. Maxell disclosed its Link Share theory ten months after the service of its initial infringement contentions and six months after the service of its supplemental infringement contentions. Docket No. 118 at 10. Notably, Maxell never sought to amend its contentions. Maxell's delay is inexcusable because Link Share is a publicly available functionality on Samsung's smartphones. *Id.* There is great prejudice to Samsung, because had Samsung properly been on notice that Maxell would accuse the two radio circuits of doing the

exact same thing, it could have crafted discovery requests or elicited testimony from fact witnesses probing Mr. McNair's "two Internet connection" theory, or changed the prior art it selected and the damages theories it pursued. *Id.* at 11; Docket No. 174 at 4. And Maxell is silent on the importance of Mr. McNair's Link Share theory despite Samsung's arguments to the contrary in its opening and reply motions. Docket No. 118 at 11–12; Docket No. 174 at 4. Maxell's failure to respond suggests that this theory is only secondary to Maxell. *See, e.g.*, Docket No. 118 at 1 (alleging that Mr. McNair only asserts that Nearby Share, and not Link Share, infringes claim limitations [1.j] and [5.g], not Link Share); Docket No. 118-7 (McNair Report) at ¶¶ 563–564, 816.

Samsung's motion to strike the opinions of Mr. McNair (Docket No. 118) is **GRANTED** with respect to its Link Share Theory (or Quick Share cloud, as it is occasionally referred to). Accordingly, the Court **STRIKES** references to the Link Share theory at paragraphs 163, 168, 171, 172, 174, 202, 203, 219, 220, 221, 224, 238, 352, 357, 360, 384, 385, 401, 402, 403, 406, 420, 464, 467, 490, 491, 507, 508, 509, 512, 526, 546, 551, 565, 567, 572, 580, 606, 607, 623, 624, 625, 628, 642, 667, 674, 679, 684, 708, 709, 725, 726, 727, 730, 744, 829, 860, 861, 877, 878, 879, and 896 of Mr. McNair's opening report (Docket No. 118-7).

B. New DOE Theories

Samsung also moves to strike Mr. McNair's new DOE theories that were not properly disclosed in Maxell's infringement contentions for the '590 Patent. Docket No. 118 at 12–15. Although Maxell attempted to reserve its rights to assert DOE theories for all claim limitations in its P.R. 3-1 cover pleading, Samsung contends this was insufficient because Maxell proceeded to only reserve DOE for some limitations in its claim charts. Docket No. 118-4 (Maxell's Supplemental Infringement Contentions) at 55 ("To the extent any claim limitation is found not to

be literally present, Maxell asserts that such limitation is present under the doctrine of equivalents"); Docket No. 118 at 12–13.

In response, Maxell withdraws a subset of the limitations Samsung seeks to exclude. Docket No. 152 at 11. Maxell does not refute that the law in this district rejects boilerplate reservations in the cover pleading. Maxell only argues that its disclosures are not boilerplate and that Mr. McNair does not rely on any "structures or components that were not already disclosed in the contentions" for literal infringement and "relies on the same evidence." Docket No. 203 at 3, 152 at 10–11; 118-7 (McNair Opening Report) at ¶ 994 (explaining as part of his DOE analysis that if certain components do not literally infringe, then they are at least equivalents).

"Courts in this district have been clear that doctrine of equivalents theories must be laid out in detail in a party's infringement contentions and that the type of boilerplate allegations contained in [the cover pleading of Maxell's] infringement contentions are insufficient." *Sycamore IP Holdings LLC v. AT&T Corp.*, No. 2:16-CV-588-WCB, 2017 WL 4517953, at *3 (E.D. Tex. Oct. 10, 2017) (collecting cases). In omitting DOE for certain claim limitations in its claim charts, Maxell did not put Samsung on adequate notice that it would eventually assert DOE for those limitations. And, unsurprisingly, Maxell cites no caselaw supporting its argument that DOE is sufficiently disclosed if an expert relies on the same structures or components for literal infringement as he does for the new DOE theories.

The factors relevant to Maxell's violation of the Local Patent Rules weigh in favor of excluding Mr. McNair's new DOE theories. There was a delay of ten months after Maxell served its initial infringement contentions, which it never amended with respect to the DOE allegations. Docket No. 118 at 13. No reason for the delay has been articulated. During the delay, Samsung was prejudiced because it "proceeded with fact and expert discovery on the basis that Maxell was

only asserting literal infringement for the Untimely DOE Limitations." *Id.* at 14. Though Samsung had an opportunity to depose Mr. McNair on his new DOE theories, there remains a "prejudice that typically flows from allowing an opposing party to disregard pretrial timing requirements—the party's loss of an opportunity to use discovery to explore the opposing party's theories and the loss of time to develop responses to those theories." *Sycamore*, 2017 WL 4517953, at *5. Finally—and most notably—Maxell never claims that Mr. McNair's new DOE theories are important to its case or that it would be prejudiced if those theories are excluded. The Court finds that Maxell "has not made a showing that it would be prejudiced by exclusion of those theories to a degree sufficient to justify overlooking [Maxell's] [] non-compliance with the Local Rules." *Id.* at *6.

C. Secondary Considerations of Nonobviousness

Samsung also moves to strike Mr. McNair's opinions on secondary considerations of nonobviousness for the '590 Patent, which Samsung argues he included for the first time in his rebuttal report. Docket No. 118 at 9. Samsung explains that the Court's Second Amended Docket Control Order (Docket No. 106) requires Maxell's opening expert reports to address all issues on which Maxell bears the burden of proof, including secondary considerations of obviousness. *Id.* Samsung contends that as a result, its expert was deprived of any opportunity to address Mr. McNair's opinions on the nexus of secondary considerations. Docket No. 174 at 5.

Maxell argues that secondary considerations are rebuttal evidence—Defendants must form a prima facie case of obviousness before the burden shifts to Maxell to rebut the case with secondary considerations. Docket No. 152 at 12. Maxell argues that Samsung cites no law supporting its motion to strike, and explains that, contrary to Samsung's position, courts in this district have routinely permitted experts to address secondary considerations of nonobviousness in rebuttal reports. *Id.* at 12. Maxell also argues that Samsung has suffered no prejudice because Maxell disclosed the secondary considerations of obviousness that it would be relying on in its

interrogatory responses. *Id.* at 14–15. As a result, Samsung's expert was able to provide his rebuttal opinions with respect to secondary considerations in his opening report based on Maxell's disclosures in its interrogatory responses. *Id.* at 15. Samsung's counsel was also able to depose Mr. McNair on his opinions on secondary considerations. *Id.*

The Court will not exclude Mr. McNair's opinions on secondary considerations in his rebuttal report. Samsung has cited no law to support its position. A plaintiff's expert may present their opinions on secondary considerations in their rebuttal report due to the "burden shifting involved in considerations of obviousness." *Tinnus Enters., LLC v. Telebrands Corp.*, No. 6:15-CV-33-RWS, 2017 WL 11630440, at *2 (E.D. Tex. July 12, 2017) (denying motions to strike rebuttal reports on secondary considerations); *see Pers. Audio, LLC v. Togi Ent., Inc.*, No. 2:13-CV-13-JRG-RSP, 2014 WL 4403186, at *2–3 (E.D. Tex. Sept. 5, 2014) (same). Samsung has not articulated any prejudice that it has suffered, given that (1) Samsung's expert was able to provide his opinions rebutting what Maxell disclosed in its interrogatory responses on secondary considerations and (2) Samsung's counsel had the opportunity to depose Mr. McNair. Samsung could have moved for leave to serve a supplemental expert report to address any lingering issues, such as nexus, but it did not. *Id.* at 14.

For the reasons above, Samsung's motion to strike (Docket No. 118) is **GRANTED** with respect to Mr. McNair's new DOE theories identified by Samsung (Docket No. 118 at 8–9) at paragraphs 993–1012 of Mr. McNair's opening report and **DENIED** with respect to Mr. McNair's opinions on secondary considerations of nonobviousness.

IV. Samsung's Motion to Strike Certain Portions of the Expert Reports of Dr. Jacob O. Wobbrock Regarding U.S. Patent No. 11,223,757 (Docket No. 119)

Samsung moves to strike Dr. Wobbrock's '757 Patent opinions on (1) a new "Component Theory" related to the first camera limitation of claim 1 not disclosed in Maxell's infringement

contentions, (2) new DOE theories not disclosed in Maxell's infringement contentions, (3) a new "Enable Construction" related to enabling the first camera in claim 1, and (4) secondary considerations of nonobviousness that were included in Dr. Wobbrock's rebuttal report but not his opening report. Docket No. 119 at 1–2.

For the same reasons described in Sections III.B and III.C on Samsung's motion to strike Mr. McNair's new DOE theories and opinions on secondary considerations of nonobviousness (Docket No. 118), Samsung's motion to strike (Docket No. 119) is **GRANTED** with respect to Dr. Wobbrock's new DOE theories identified by Samsung (Docket No. 119 at 5) at paragraphs 1055–1070 of Dr. Wobbrock's opening report and **DENIED** with respect to Dr. Wobbrock's opinions on secondary considerations of nonobviousness.

The Court addresses the remaining aspects of Samsung's motion below.

A. Component Theory

Samsung argues that the Court should strike Dr. Wobbrock's opinions that circuitry for a touch screen of a '757 accused product is located behind the front camera. Docket No. 119 at 5–6, 11. Samsung contends that Maxell's infringement contentions do not disclose this theory because they do not (1) identify any internal components corresponding to a touch display or (2) assert that the front camera is located in front of any touch display component. *Id.* Maxell argues that it properly disclosed in its contentions that "each of the Accused Samsung '757 Products includes 'a **front facing camera** that is on the same side of the front facing **touch display screen**.' " Docket No. 154 at 6 (citing Docket Nos. 119-2 ('757 Infringement Contentions) at 65, 119-4 ('757 Supplemental Infringement Contentions) at 89). Dr. Wobbrock's report only provided evidence of the circuitry of the same camera and touch screen that were identified in Maxell's contentions. *Id.* at 7.

The Court agrees with Maxell. There is no requirement that a plaintiff's infringement contentions must cite all of the evidence the plaintiff's expert will rely on. *Core Wireless Licensing*, 2016 WL 3655302, at *4. Maxell's disclosure was sufficient to put Samsung on notice of its theory. And Samsung was on notice—Samsung designated fact witnesses and experts that opined on the location of the front camera placement in relation to the touch screen. Docket No. 154 at 8. Samsung also sought specific constructions for the camera limitations. *Id.*; *see* Docket No. 107 at 16–17.

B. Enable Construction

Samsung moves to strike Dr. Wobbrock's opinion that the combination of limitations [1.g], [1.i], and [1.j] "requires that the first camera is enabled and the second camera is disabled in response to the command voice." Docket No. 119 at 6–7 (citing Docket No. 119-6 (Wobbrock Rebuttal Report) at ¶ 237). Maxell argues that Dr. Wobbrock's opinion merely explains the plain and ordinary meaning of "**the** first standby time" in [1.j], where that claim term's antecedent basis comes from "**a** first standby time of a case where the first camera is enable[d] and the second camera is disabled" in element [1.i]. Docket No. 154 at 9 (citing Docket No. 119-6 (Wobbrock Rebuttal Report) at ¶ 237).

Dr. Wobbrock's opinion strays beyond an analysis based on antecedent basis because nothing in the language of any limitation of claim 1 requires the first camera to be enabled in response to the command voice. *See* Docket No. 160 at 5 (explaining that only claim 2 does so). Maxell never sought a construction for these disputed limitations of claim 1. By failing to do so, Maxell has forfeited this argument. Docket No 68 at 3; *Maxell, Ltd. v. Apple Inc.*, No. 5:19-CV-36-RWS, 2020 WL 8269548, at *23 (E.D. Tex. Nov. 11, 2020) (finding defendant's expert's claim construction based on plain and ordinary meaning was waived when the dispute was not presented to the Court during claim construction). And in any event, the Court is not convinced that Dr.

Wobbrock's construction of "the first standby time" in element [1.j] is correct. At the very least, Dr. Wobbrock's construction renders claim 2—which recites "wherein the first camera is enabled in accordance with the command voice"—superfluous. Docket No. 119 at 14 (noting doctrine of claim differentiation).

For these reasons, Samsung's motion to strike (Docket No. 119) is **DENIED** with respect to Dr. Wobbrock's component theory opinions and **GRANTED** with respect to Dr. Wobbrock's Enable Construction identified by Samsung (Docket No. 118 at 14–15) at paragraphs 237–254, 259–270, and 278–288 of Dr. Wobbrock's rebuttal report.

V. Samsung's Motion to Strike Portions of Expert Reports of Dr. Jon Weissman Regarding U.S. Patent No. 8,037,161 (Docket No. 123)

Samsung moves to strike Dr. Weissman's '161 Patent opinions on (1) 11 new literal and DOE infringement theories not disclosed in Maxell's infringement contentions and (2) secondary considerations of nonobviousness that were included in Dr. Weissman's rebuttal report but not his opening report. Docket No. 123 at 1.

For the same reasons described in Sections III.B and III.C on Samsung's motion to strike Mr. McNair's new DOE theories and opinions on secondary considerations of nonobviousness (Docket No. 118), Samsung's motion to strike (Docket No. 123) is **GRANTED** with respect to Dr. Weissman's new DOE theories (new infringement theory # 10) identified by Samsung (Docket No. 123 at 6) and **DENIED** with respect to Dr. Weissman's opinions on secondary considerations of nonobviousness.

The Court addresses the remaining aspects of Samsung's motion below.

A. New Infringement Theory #1 (Fridge and Washer)

Samsung argues that the Court should strike Dr. Weissman's new infringement theory that the "fridge" and "washer" perform a scan and create a list of available Wi-Fi networks that

constitutes a "list of network devices ordered chronologically according to corresponding events indicating participation or nonparticipation of the devices in the Wi-Fi network." Docket No. 123 at 4. The Court disagrees.

Though sparse, Maxell provided disclosures in the contentions that point to devices "select[ing] a network from the **Wi-Fi networks list**." Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 1395 (emphasis added). While the screenshot disclosing this is from the Galaxy S23 User Guide, not a guide for the fridge or washer, Maxell has explained in its contentions that "[e]ach of these products infringe for the reasons and theories as set forth herein as they operate the same way by forming a SmartThings home network that is based on one or more home networking protocols." Docket No. 208-2 ('161 Supplemental Infringement Contentions) at 21.

B. New Infringement Theories #2 and #9 ([redacted])

Samsung fails to show that this Court should strike Dr. Weissman's reliance on new source code files and documents related to [redacted]. Docket No. 123 at 9, 13 (describing new infringement theory #9 as based on new infringement theory #2). There is no requirement for plaintiffs' infringement contentions to cite all the evidence its experts would rely on. *Core Wireless*, 2016 WL 3655302, at *4. The [redacted] functionality was properly disclosed when Maxell specifically identified the [redacted] in its contentions. Docket No. 158 at 7; *see, e.g.*, Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 359–360, 460, 925, 1031, 1757–158. [redacted]. Docket No. 158 at 7. Samsung's argument that, with more robust disclosure it could have included non-infringing alternatives in its opening expert reports, such as simply disabling

the [redacted] functionality, is not persuasive. Samsung could have filed for leave to amend its reports, rather than lie in wait.

C. New Infringement Theory #3 (Network)

Next, Samsung contends that the Court should strike Dr. Weissman's new infringement theory that the claimed "network" of claim 6 of the '161 Patent is a "Wi-Fi Network" or a combination of the alleged SmartThings Network and a "Wi-Fi Network." Docket No. 123 at 9–10. The Court agrees that Maxell never disclosed "Wi-Fi Network" as the claimed "network" in its contentions. There is no doubt that Maxell has disclosed the existence of "WiFi interfaces and/or chipsets," but only in the context of connecting to "a SmartThings network." *See, e.g.*, Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 1326, *see id.* at 27 ("Accused Samsung '161 Products include one or more of Wi-Fi or Bluetooth chipsets to form and **communicate within a SmartThings network**") (emphasis added), 592, 1165; *see also id.* at 100 ("[E]ach of the Accused Samsung '161 Products include . . . network interfaces such as WiFi interfaces . . . and/or WiFi circuitry working alone or together that are **used to connect to the SmartThings network**") (emphasis added), 257, 363, 666, 823, 929, 1392. Maxell has pointed to nothing in its contentions that advances the Wi-Fi network as a separate "network" from the SmartThings Network or even in combination. The Court agrees with Samsung.

D. New Infringement Theories #4 and #6 ([redacted])

Samsung argues that Maxell's contentions did not disclose that [redacted], or that the [redacted]. *See* Docket No. 177 at 4. Maxell argues that it has sufficiently disclosed in its contentions that [redacted]. *See, e.g.*, Docket

No. 158-2 ('161 Supplemental Infringement Contentions) at 1296, 1384. The Court agrees with Maxell.

E. New Infringement Theory #5 ([redacted])

Samsung requests that the Court strike Dr. Weissman's new infringement theory that the [redacted]. Docket No. 123 at 11. Samsung contends that Maxell's contentions only list non-Cloud devices—Hub and non-Hub devices—forming the alleged SmartThings network. *Id.*; *see* Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 1434 (defining a "Hub device" as including "a Galaxy smartphone/tablet/laptop/Smartwatch/SmartThings Station/SmartThings Hub/Family Hub refrigerator" and a "non-Hub device" as including "ranges, washers, dryers, air dressers, dishwashers, vacuums, air purifiers, microwaves, and wall ovens"). Samsung also contends that where [redacted]. Docket No. 177 at 4–5.

The Court disagrees. There is enough information in Maxell's contentions to put Samsung on notice that Maxell would be contending that [redacted]. Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 1440 (describing that [redacted]) (emphasis added); *see also id.* at 1221 (describing "[redacted]" . . . ."), 1359, 1371, 1387, 1538,

1668; *id.* at 1230 (showing that [redacted]). Samsung was at least on notice that Maxell contended [redacted] Docket No. 158-7 (Samsung Supplemental Invalidity Contentions) at 5.

F. New Infringement Theories #7 and #8 (Favorites/History/Notifications Lists)

Samsung argues that Maxell did not disclose in its contentions that each of the S23 and fridge sends its Favorites, History, and Notifications ("F/H/N") lists [redacted] (New Infringement Theory #7) and that the [redacted] (New Infringement Theory #8). Docket No. 123 at 12; Docket No. 177 at 3, 9. Samsung's primary issue appears to be that the contentions do not disclose [redacted]. Docket No. 177 at 5. Through Maxell's disclosure in its contentions that the [redacted], Maxell's new infringement theories #7 and #8 are sufficiently disclosed. *See, e.g.*, Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 548, 1435, 1493–1494.

G. New Infringement Theory #11 (Indirect Infringement)

Maxell has sufficiently disclosed its induced and contributory infringement theories in its infringement contentions. *See* Docket No. 158-2 ('161 Supplemental Infringement Contentions) at 1–2 ("Samsung encourages its customers through numerous webpages to connect these devices to make a home network").

For the reasons above, Samsung's motion to strike Dr. Weissman's opinions (Docket No. 123) is **GRANTED** with respect to New Infringement Theory #3 and **DENIED** with respect to New Infringement Theories #1, #2, #4, #5, #6, #7, #8, #9, and #11.

VI. Samsung's Motion to Strike Certain Portions of the Rebuttal Expert Reports of Dr. Karan Singh Regarding U.S. Patent No. 11,017,815 (Docket No. 127)

Samsung moves to strike Dr. Singh's '815 Patent opinions on secondary considerations of nonobviousness that were included in Dr. Singh's rebuttal report but not his opening report. Docket No. 127 at 1. For the same reasons described in Section III.C on Samsung's motion to strike Mr. McNair's opinions on secondary considerations of nonobviousness (Docket No. 118), Samsung's motion to strike (Docket No. 127) is **DENIED**.

VII. Maxell's Motion to Strike Portions of Defendants' Expert Reports Based on Untimely Claim Construction Positions (Docket No. 125)

At the outset of the case, the Court limited the parties to 10 terms for claim construction. Docket No. 45 at 6. At the *Markman* stage, the Court granted Samsung's request to construe three more terms. Docket No. 68 at 3. But given the Court's leniency in construing the additional terms, the Court stated that "any future claim construction disputes are waived, unless the Court's *Markman* order itself raises additional claim construction disputes and the parties timely notice such disputes." *Id.* "[W]here a court has prescribed specific claim construction procedures and the parties have proceeded towards trial in reliance thereon, the court has discretion to preclude parties from injecting new claim construction theories on the eve of trial." *Intell. Ventures II LLC v. BITCO Gen. Ins. Corp.*, No. 6:18-CV-298-JRG, 2019 WL 999902, at *3 (E.D. Tex. Feb. 28, 2019) (citations omitted).

A. '848 Patent – "Image Information"

Maxell moves to strike the claim construction opinions of Samsung's expert Dr. Kia on the term "image information" in claim 8 of the '848 Patent. Docket No. 125 at 4. Samsung's argument that Dr. Kia's opinions are not claim construction opinions—but indefiniteness opinions—is persuasive. *See* Docket No. 156 at 1–2. With respect to written description, Dr. Kia maintains that the "image information" recited in claim 8 refers to still images, but that the specification refers

almost exclusively to video information and not still images. *See, e.g.*, Docket No. 125-3 (Kia Report) at ¶¶ 36, 170. Maxell quibbles with Dr. Kia's characterization of the specification (Docket Nos. 125 at 4, 170 at 302) but musters no evidence that Dr. Kia characterized the specification to construe claim terms. For the reasons above, Maxell's motion to strike the opinions of Samsung's expert Dr. Kia (Docket No. 127) on claim 8 is **DENIED**.

B. '161 Patent

1. Connection Terms

As an initial matter, Samsung has agreed to withdraw paragraphs 168–177 of Dr. Shields's opening report on the '161 Patent directed to indefiniteness of the "Connection Terms." Docket No. 156 at 1 n.2.

Maxell's motion to strike also challenges Dr. Shields's opinions on the Connection Terms in his rebuttal report at paragraphs 58–65. *See* Docket No. 125 at 5–6. These terms were never construed at the *Markman* stage. *See* Docket No. 107. Samsung argues that there is no need to strike paragraphs 58–65 of Dr. Shields's rebuttal report because Dr. Shields merely opines that the term "connected" should be construed according to its plain and ordinary meaning when read in light of the specification. Docket No. 156 at 3. Samsung explains that "Dr. Shields addressed the meaning of 'connected' in his rebuttal report because the need to do so only became apparent when Dr. Weissman's opening report defined the "SmartThings network" as including "SmartThings cloud/platform and any connected network devices." Docket No. 209 at 2 (citations omitted). Maxell's experts never had an opportunity to address Dr. Shields's construction.

Only when confronted with a motion to strike does Samsung raise that this is a "clear claim construction dispute" that the Court should resolve. *Id.* Dr. Weissman's report is dated November 5, 2024, which is when Samsung claims that Samsung was put on notice. Docket No. 209-1. Samsung served its surreply to this motion, where it included Dr. Shields's construction of the

Connection Terms and informed the Court that this is a dispute that the Court should resolve, on February 11, 2025. Docket No. 209 at 6. At that time, the dispositive motions hearing was set for April 8, 2025. Docket No. 115. The Court informed the parties that any future claim construction disputes are waived and that it would only hear disputes if its *Markman* order raised additional disputes. Docket No. 68 at 3. Given that Maxell's expert never had an opportunity to address Dr. Shields's construction and Samsung's untimely notice of this dispute, Maxell's motion to strike (Docket No. 125) is **GRANTED** with respect to Dr. Shields's construction of the connected terms at paragraphs 58–65 of his rebuttal report and **DENIED-AS-MOOT** with respect to paragraphs 168–177 of Dr. Shields's opening report.

2. "Network"

Maxell moves to strike Dr. Shields's opinions that the "network" limitation of claim 6 of the '161 Patent is limited to a peer-to-peer network.[2] Docket No. 125 at 6. In response, Samsung has sufficiently explained that Dr. Shields's opinions are only with respect to a "peer-to-peer system," not a "peer-to-peer network." Docket No. 156 at 4. Samsung also explained that network devices described in the '161 Patent and claimed in claim 6 "form a peer-to-peer system regardless of whether such devices communicate over one or more *networks* that can support both peer-to-peer and client-server communications." *Id.* (emphasis added). For the reasons above, Maxell's motion to strike (Docket No. 125) is **DENIED** with respect to Dr. Shields's opinions on "peer-to-peer systems."

C. '815 Patent – "Character"

The Court has already construed the term "character" in claims 1 and 21 of the '815 Patent to mean "a letter, number, punctuation mark, or other symbol or control code that is represented

[2] The Court gives no weight to Dr. Shields's untimely declaration. *See* Docket No. 156-1.

to a computer by one unit of information." Docket No. 107 at 10–11. Maxell moves to strike the claim construction opinions of Dr. Kia that text must be editable, dynamically scalable, or inseparable from images in order to correspond to the claimed "character." Docket No. 125 at 8. Upon review, the Court finds no evidence that Dr. Kia is attempting to re-construe "character." Dr. Kia is entitled to his opinions that attempt to distinguish text embedded in images from the Court's construction of "character." For the reasons above, Maxell's motion to strike (Docket No. 125) is **DENIED** with respect to Samsung's expert Dr. Kia's opinions on claim element [21.f].

VIII. Maxell's Motion for Partial Summary Judgment of Validity Based on Samsung's *Sotera* Stipulations (Docket No. 132)

Samsung filed *inter partes* review ("IPR") petitions against each of the asserted patents except the '161 Patent, all of which have been instituted. Docket Nos. 108–109. Samsung filed *Sotera* stipulations, stipulating that "if the Board institutes [the IPRs], then [Samsung] will not pursue in th[is] district court proceeding . . . the same [invalidity] grounds in this petition or any grounds that could have reasonably raised in the petition." *See* Docket No. 132 at 1 (citing Docket No. 132-2 at 1). Maxell moves for partial summary judgment to estop Samsung from raising invalidity grounds allegedly covered by its *Sotera* stipulations.

The parties dispute the scope of IPR estoppel under the prevailing law. Maxell argues that *Wasica Fin. GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020), and its progeny should apply to estop Samsung from asserting "system art" grounds in district court that are essentially the same invalidity grounds it raised or reasonably could have been raised in its IPRs. *See* Docket No. 132 at 8–11. Samsung argues that the Court should adopt the more recent prevailing view of IPR estoppel articulated in *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, 2022 WL 2643517 (D. Del. July 8, 2022), and decline to estop Samsung's invalidity grounds relying on system art as a prior art reference because system art could not have reasonably been raised during

the IPR. Judge Bryson explained that the disconnect between the *Wasica* and *Chemours* approaches was due to differing interpretations of "grounds." *Prolitec Inc. v. ScentAir Techs.*, LLC, No. CV 20-984-WCB, 2023 WL 8697973, at *22 (D. Del. Dec. 13, 2023) (interpreting "grounds" under *Wasica* as "the underlying legal arguments, which incorporate patents, printed publications, and cumulative device art," and interpreting "grounds" under *Chemours* as "the particular patents and printed publications on which invalidity arguments are based."). Recently in this district, a court applied the *Chemours* approach and declined to find a defendant estopped from asserting invalidity arguments based on patents or printed publications that were cumulative of printed publications that could have been raised in an IPR. *Lionra Techs. Ltd. v. Fortinet, Inc.*, No. 2:22-CV-0322-JRG-RSP, 2024 WL 3055977, at *2 (E.D. Tex. Apr. 25, 2024) (adopting the *Chemours* approach partly because of Judge Bryson's reasoning in *Prolitec* that the interpretation under *Chemours* is better supported by other interpretations of 35 U.S.C. § 315(e)(2) and by the Federal Circuit precedent on IPRs).

Absent any guidance from the Supreme Court or the Federal Circuit, the Court is convinced that *Chemours* applies. As such, the Court declines to extend estoppel to the invalidity grounds that Maxell contends are cumulative of what was or could have been raised in the IPRs. *See Prolitec*, 2023 WL 8697973, at *23 ("I will follow the *Chemours* line of cases and hold that IPR estoppel does not apply to device art, even when that device art is cumulative of patents and printed publications that were or could have been asserted in a prior IPR").

In an attempt to distinguish *Chemours* and *Lionra*, Maxell argues that Samsung pairs its system prior art with (1) paper art explicitly raised in the IPRs, (2) paper art that reasonably could have been raised in the IPRs, and (3) user manuals that were "materially identical" to the system art relied upon. Docket No. 211 at 5. But each prior art combination constitutes separate grounds

under 35 U.S.C. § 315(e)(2). *Prolitec*. 2023 WL 8697973, at *23 (explaining that "grounds," as used by the Federal Circuit in the IPR context, means "a legal argument based on a specific combination of references"). And, because each invalidity combination that Samsung asserts in this litigation has not been raised in its IPRs, Samsung is not estopped from raising any of those combinations in this proceeding.[3]

On April 30, 2025, Maxell filed a notice of supplemental authority with respect to this motion. Docket No. 282. The Court declines to consider this authority because it is untimely.

For these reasons, Maxell's motion for partial summary judgment of validity based on Samsung's *Sotera* stipulations (Docket No. 132) is **DENIED**.

IX. Samsung's Motion for Summary Judgment of Subject Matter Ineligibility Under 35 U.S.C. § 101 for U.S. Patent Nos. 11,017,815; 11,223,757; and 8,037,161 (Docket No. 130)

Samsung moves for summary judgment that '815 Patent claims 1, 8, 21, 24, and 27; '757 Patent claims 1, 5, and 9; and '161 Patent claim 6 are directed to ineligible subject matter under 35 U.S.C. § 101. Docket No. 130 at 1.

Patent eligibility under § 101 is an issue of law, but the legal conclusion may contain underlying factual issues. *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340–41 (Fed. Cir. 2013). The Supreme Court has established a two-part test for patent eligibility. *Alice Corp. Pty. v. CLS Bank Int'l*, 573 U.S. 208, 217–18 (2014). Under *Alice*, the Court must "first determine whether the claims at issue are directed to a patent-ineligible concept." *Id.* at 218. Claims directed to software inventions do not automatically satisfy this first step of the inquiry. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1334, 1335 (Fed. Cir. 2016). Rather, "the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on [a] specific asserted

[3] Samsung has already withdrawn its patent and printed publication-based invalidity grounds that it previously asserted before the IPRs instituted. Docket No. 178 at 5.

improvement in computer capabilities . . . or, instead, on . . . an 'abstract idea' for which computers are invoked merely as a tool." *Id.* at 1335–36. In conducting the step 1 inquiry, the Court must "focus on the language of the Asserted Claims themselves" "considered in the light of the specification." *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1292 (Fed. Cir. 2020)

If the Court determines that the claims are directed to an abstract idea, it must then determine whether the claims contain an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application. *Alice*, 573 U.S. at 217. An inventive concept is "some element or combination of elements sufficient to ensure that the claim in practice amounts to 'significantly more' than a patent on an ineligible concept." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1255 (Fed. Cir. 2014). The Court "consider[s] the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application." *Alice*, 573 U.S. at 217 (citations omitted). Even if each claim element, by itself, was known in the art, "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed Cir. 2016).

"The question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). This fact must be proven by clear and convincing evidence. *Id.* (citing *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011)). "Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art." *Id.* at 1369.

All claims in a patent, both independent and dependent, are presumptively valid regardless of "the validity of other claims." *PerformancePartners, L.L.C. v. FlashParking, Inc.*, 697 F. Supp. 3d 678, 683 (W.D. Tex. 2023) (citing 35 U.S.C. § 282). But when multiple claims "are substantially similar and linked to the same abstract idea," courts can resolve challenges to all claims by analyzing a single, representative claim. *Id.* (citing *PPS Data, L.L.C. v. Jack Henry & Assocs.*, No. 18-CV-7-JRG, 2019 WL 1317286, at *5 (E.D. Tex. Mar. 21, 2019) (citations omitted)). The burden of demonstrating that a single claim is representative falls on the movant. *Id.* (citing *PPS Data*, 2019 WL 1317286, at *5).

A. '815 Patent, Claims 1, 8, 21, 24, and 27

Samsung argues that asserted claims 1, 8, 21, 24, and 27 of the '815 Patent are directed to the abstract idea of "managing and displaying stored video playlist information." Docket No. 130 at 3. According to Samsung, the asserted claims of the '815 Patent do not present an inventive concept because they recite conventional hardware (*e.g.*, a network interface) and conventional software implemented user interface elements (*e.g.*, thumbnails, characters, groups) that behave exactly as expected in their ordinary use. *Id.* at 7. Samsung argues that claim 1 is representative of claims 8, 21, 24, and 27. *Id.* at 6–7.

In response, Maxell argues that the '815 Patent's asserted claims are directed to "a new combination of [graphical user interface ("GUI")] elements for the useful implementation of video management and playback on computers." Docket No. 172 at 2. Maxell also argues that Samsung does not address the combination of the claimed elements, and that the patent publications and commercial products that Samsung cites do not disclose the relevant claim elements, do not render the claim elements conventional, or were not released until much after 2004. *Id.* at 7–8. Maxell agrees with Samsung that claim 1 of the '815 Patent is representative of claims 21 and 24 but

contends that claims 8 and 27 require displaying additional video information on the screen under certain circumstances. *Id.* at 5–6.

Maxell's argument that the asserted claims of the '815 Patent are not directed to an abstract idea—but to an improved structure or function of a graphical user interface—is persuasive. *See Broadband iTV, Inc. v. Amazon.com, Inc.*, 113 F.4th 1359, 1368 (Fed. Cir. 2024) (citing *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1007–1011 (Fed. Cir. 2018)). Claim 1 is directed to setting forth a new combination of GUI elements for the useful implementation of video management and playback on computers. The GUI elements include (1) a first area including first and second characters associated with first and second video group information having different classifications, (2) a second area that displays thumbnails for first or second video group information depending on whether the first or second character is selected, and (3) video information for each group that is independent of the other, such that deletion from the first group does not delete it from the second group and the thumbnail continues to be displayed. Docket No. 130-1 ('815 Patent) at claim 1; Docket No. 172 at 3. The GUI elements create an improved user interface that "link[s] portions of AV data together" to "manage arbitrary play lists" during a time when "high-efficiency coding technique [had] advance[d]" such that "management information for managing digital data to be recorded [could be] generated and recorded together onto the same recording medium." Docket No. 130-1 ('815 Patent) at 1:41–65, 2:28–51, 3:2–4; Docket No. 172 at 2–3. As "memory was becoming more easily available [and] video was being more [] efficiently being stored, [] you had to be able to manage video data on your computer in a more presentable, more easer, more quicker, more efficient manner." Docket No. 284 (Hearing Tr.) at 167:19–168:2.

Although the generic idea of organizing and displaying playlists certainly existed prior to the invention, *see Bluebonnet Internet Media Servs., LLC v. Pandora Media, LLC*, No. 2022-2215,

2024 WL 1338940, at *2 (Fed. Cir. Mar. 29, 2024), these claims concern a particular manner of managing arbitrary playlists *in GUIs*. '815 Patent at 1:41–65; *see Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1362 (Fed. Cir. 2018) ("Although the generic idea of summarizing information certainly existed prior to the invention, these claims are directed to a particular manner of summarizing and presenting information **in electronic devices**") (emphasis added). The majority of the cases that Samsung cites are inapposite because they do not concern specific sets of GUI elements. *See* Docket No. 130 at 4 (citing *Mobile Acuity Ltd. v. Blippar Ltd.*, 110 F.4th 1280, 1292–1293 (Fed. Cir. 2024); *AI Visualize, Inc. v. Nuance Commc'ns, Inc.*, 97 F.4th 1371, 1378 (Fed. Cir. 2024)).

Samsung emphasizes that recitation of a user interface does not automatically render claims non-abstract. Samsung explains that while Maxell's leading user interface case, *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1011 (Fed. Cir. 2018), found a claim to be eligible for claiming "notebook tabs [that] are specific structures within the three-dimensional spreadsheet environment that allow a user to avoid the burdensome task of navigating through spreadsheets in separate window using arbitrary commands," it also found a separate claim was directed to an abstract idea for merely "associating each of the cell matrices with a user-settable page identifier." *Id.* at 1009–1012; *see* Docket No. 271-4 at 10. Much like the claim that was found eligible in *Data Engine*, the invention here also claimed a set of GUI elements that solved a problem specific to GUIs and computer technology—"the difficulty [of] manag[ing] arbitrary playlists" as more memory became available and more video was being stored. Docket No. 284 (Hearing Tr.) at 171:18–21, 167:19–168:2. Samsung also argues that courts only find claimed GUI elements eligible when those elements are unconventional. Docket No. 210 at 1–2 (distinguishing *Pantech Corp. v. LG Elecs., Inc.*, 2023 U.S. Dist. LEXIS 169865, at *17–25 (E.D. Tex. Aug. 21, 2023);

CXT Sys v. Acad., Ltd., 2019 U.S. Dist. LEXIS 51915, at *9–11 (E.D. Tex. Mar. 12, 2019)). Asserted claim 1 of the '815 Patent is at least as unique as the claims found to be eligible in *CXT*, which required "two different display regions with specific information [] presented in the display and specifies that the regions must be simultaneously visible," which was a "specific improvement over prior art systems" that provided no easy way to browse messaging boards. 2019 U.S. Dist. LEXIS 51915, at * 11.

The Court need not address Maxell's arguments about Samsung's failure to make a *prima facie* case of representativeness given its finding that claim 1 is not directed to an abstract idea.

If the claims are not directed to an abstract idea under step one of the *Alice* analysis, the Court need not proceed to step two of that analysis. *Enfish*, 822 F.3d at 1339. Here, even if these claims were abstract, they would survive summary judgment because there are genuine disputes of material fact under *Alice* step two. Both parties present expert testimony and evidence that support their respective positions as to whether the claim elements are well-understood, routine, and conventional considered separately or in their ordered combination. *See, e.g.*, Docket No. 210 at 1 (citing Docket No. 210-1 (Kia Report) at ¶ 60); Docket No. 172 at 8 (citing Docket No. 172-2 (Singh Report) at ¶¶ 165–182).

B. '757 Patent, Claims 1, 5, and 9

Samsung argues that asserted claims 1, 5, and 9 of the '757 Patent are directed to the abstract idea of "waiting for a longer period of time for a voice activated selfie photo using a first camera than for a regular touch-activated photo using a second camera in one of these well-known generic two-camera devices." Docket No. 130 at 10. According to Samsung, the asserted claims of the '757 Patent do not present an inventive concept because, among other reasons, (1) they recite conventional hardware and conventional software and (2) the concept was disclosed by state-

of-the-art references. *Id.* at 12. Samsung argues that claim 1 of the ’757 Patent is representative of claims 5 and 9. *Id.* at 11.

In response, Maxell argues that the ’757 Patent’s asserted claims are directed to “a specific solution for a specific class of devices (with touch screens on one side, audio input, and cameras on both sides) that helps a user capture the images that they intended, rather than self-images with the form of his mouth in a state immediately after the utterance of the command voice.” Docket No. 172 at 9 (citations omitted). Maxell also argues that Samsung does not address the combination of the claimed elements and offers no evidence that the patent publications cited were the state of the art at the time. *Id.* at 11–12. Maxell disagrees that claim 1 is representative of claims 5 and 9. *Id.* at 9, n.2.

Claim 1 of the ’757 Patent is directed to the abstract idea of waiting for a longer period of time for a voice activated selfie photo using a first camera than for a regular touch-activated photo using a second camera in a generic two-camera device. Claim 1 of the ’757 Patent is more similar to the claims in *Yu v. Apple Inc.*, 1 F.4th 1040, 1043–1045 (Fed. Cir. 2021), which were found to be directed to the abstract idea of using an image from one camera to enhance an image in a second camera using conventional components. Though Maxell attempts to distinguish *Yu* and liken the asserted claims of the ’757 Patent to those in *Contour IP Holding LLC v. GoPro, Inc.*, 113 F.4th 1373, 1380 (Fed. Cir. 2024), the claims in *Contour* were not held eligible because they were “directed to improving just a certain type of camera-containing device,” as Maxell alleges, but because the claimed point-of-view camera was configured to “operate differently than it otherwise could” by recording multiple streams in parallel and transmitting only the lower quality stream. Limiting the use of an abstract idea to “a particular technological environment,” like Maxell does here, does not render the idea non-abstract. *Alice*, 573. U.S. at 223. The claim does not teach how

to implement a longer standby time for the voice activation, but instead only dictates the result where the camera causes a delay. *See TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1293 (Fed. Cir. 2020).

Even though the asserted claims of the ’757 Patent are directed to an abstract idea, they would still survive summary judgment because there are genuine disputes of material fact under *Alice* step two. *See, e.g.*, Docket No. 130 at 11–12 (citing Chinn, Takahashi, and Yamamoto references); Docket No. 172 at 11–12 (citing Docket No. 172-6 (Wobbrock Rebuttal Report) at ¶¶ 300–305 on at least the Chinn, Takahashi, and Yamamoto references). The Court need not address Maxell’s arguments about Samsung’s failure to make a *prima facie* case of representativeness for claim 1 given that the only difference it points out is “claim 5’s added limitation, which [only] matters for step two.”[4] Docket No. 172 at 9, n.2.

C. ’161 Patent, Claim 6

Samsung argues that asserted claim 6 of the ’161 Patent is directed to the abstract idea of “judging whether a device belongs to a network based on the period of time the device is connected to the network in order to authenticate or verify membership in the network.” Docket No. 130 at 12. According to Samsung, the asserted claim of the ’161 Patent does not present an inventive concept because (1) it is an abstract idea that cannot serve as the required inventive concept; (2) it is not an inventive concept even if it was not disclosed in the prior art; (3) the claim relies on conventional components; and (4) Dr. Weissman never explains how the use of the known components was innovative. *Id.* at 15–16.

[4] The Court notes that even though Samsung states in its opening motion that “Maxell’s expert states claim 5 falls outside of what Samsung identifies as the abstract idea” (citing Docket No. 130-13 at ¶ 296), Maxell only mentions claim 5’s relevance to *Alice* step 2 in its briefing. Docket Nos. 130 at 11, 172 at 9, n.2.

In response, Maxell argues that the ’161 Patent’s asserted claim is directed to “a specific type of method for judging whether devices belong in a particular network, resulting in increased reliability when protecting transmitted content.” Docket No. 172 at 12 (citations omitted). Maxell also argues that Samsung incorrectly describes the state of the art at the time. *Id.* at 16–17.

Claim 6 of the ’161 Patent is directed to a specific type of method for accurately judging whether devices among a plurality of devices exchanging content belong to the same home network. As claimed, the judgment method involves network devices “collect[ing] peripheral device information” while connection to the network is established, “stor[ing] home network information” that includes a chronological list of network devices connected to the network, “receiv[ing] the home network information,” and “collat[ing] the received home network information” with home network information stored on the first device to determine whether the second device belongs on the network. ’161 Patent, claim 6. The specific method for accurately judging belonging is a “solution to a problem specifically arising in the realm of computer networks.” *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1293 (Fed. Cir. 2020) (citations omitted).

Claim 6 passes both eligibility inquiries set forth by *TecSec*: (1) the claimed invention is a solution to “a problem specifically arising in the realm of computer networks,” and (2) “it is properly characterized as setting forth a ‘specific’ improvement in computer capabilities . . . , rather than only claiming a desirable result or function.” *Id.*

With respect to the first *TecSec* inquiry, Samsung does not and cannot dispute that the claimed invention of the ’161 Patent is a solution to a problem specifically arising in the realm of computer networks. The specification of the ’161 Patent sets forth the conventional techniques of judging network belonging (1:43–59), describes “the following problems [with] the aforementioned techniques” (1:66–2:23), and then sets forth “a new method for judging whether

devices belong to the same home network" (2:24–3:4, claim 6). Claim 6 of the '161 Patent also comports with other cases finding claims eligible for being directed to a solution in the network security context. *See, e.g.*, *Ancora Techs. V. HTC Am., Inc.*, 908 F.3d 1343, 1348 (Fed. Cir. 2018); *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1303 (Fed. Cir. 2016). Much like the claim in *Amdocs* that was found eligible because "the distributed architecture allows the system to efficiently and **accurately** collect network usage information in a manner designed for efficiency to minimize impact on network and system resources," claim 6 also allows devices to accurately judge network belonging in light of certain problems identified in the patent where devices are misjudged (1:66–2:33). 841 F.3d at 1303 (emphasis added).

With respect to the second *TecSec* inquiry, Samsung has not shown that claim 6 of the '161 Patent is not a "specific" improvement. Samsung likens claim 6 to the claims in *Ericsson Inc. v. TCL Commc'n Tech. Holdings Ltd.*, 955 F.3d 1317, 1326, 1328 (Fed. Cir. 2020), which were directed to an abstract idea because they recited generic functions without specifically explaining "how or what is done." Docket No. at 271-4 at 24. *Ericsson* is readily distinguishable. Claim 6 of the '161 Patent is directed to accurately judge belonging, which is performed by network devices "collect[ing] peripheral device information," "stor[ing] home network information," "receiv[ing] the home network information," and "collat[ing] the received home network information." Docket No. 121-6 ('161 Patent), claim 6. *Ericsson*'s claims are directed only to controlling access to resources, do not reference a specific technique, and require nothing more than this abstract idea. *Ericsson*, 955 F.3d at 1326.

The other cases that Samsung cites do not counsel against patent eligibility because they are all directed to solving or accomplishing abstract ideas while using computers. In *Universal Secure Registry LLC v. Apple Inc.*, 10 F.4th 1342, 1349–1350 (Fed. Cir. 2021), "the asserted claims

[we]re directed to a method for verifying the identity of a user to facilitate an economic transaction, for which computers are merely used in a conventional way." The claims in *Elec. Commc'n Techs., LLC v. ShoppersChoice.com, LLC*, 958 F.3d 1178, 1182 (Fed. Cir. 2020), were directed to using a computer to accomplish "longstanding commercial practices," such as "providing advance notification of the pickup or delivery of a mobile thing." *FairWarning IP, LLC v. Iatric Sys.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016), is also distinguishable because the claims there were not directed to an improvement in the way computers operate, but to the abstract idea of detecting fraud while using computers. In contrast, the '161 Patent does not merely direct a practitioner to use a computer to judge network belonging of peripheral devices, but sets forth a particular method for doing so. Not to mention, detecting network belonging is a problem specifically arising in the realm of computer networks.

If the claims are not directed to an abstract idea under step one of the *Alice* analysis, the Court need not proceed to step two. *Enfish*, 822 F.3d at 1339. But even if these claims were abstract, they would survive summary judgment because there are genuine disputes of material fact under *Alice* step two. *See, e.g.*, Docket No. 130 at 15–16 (citing Docket No. 130-17 (Shields Report) at ¶¶ 197–200, 206–207); Docket No. 172 at 16–17 (citing Docket No. 172-8 (Weissman Rebuttal Report) at ¶¶ 195–198, 200).

For these reasons, Samsung's motion for summary judgment of subject matter ineligibility (Docket No. 130) is **DENIED**.

X. Maxell's Motion to Strike and Exclude Dr. Buehrer's Testing of the N93 Product Samples (Docket No. 128)

Maxell moves to exclude Dr. Buehrer's reliance on the six Nokia N93 Product Samples or, in the alternative, to admit certain facts regarding their origin, condition, and functionality. Docket No. 128 at 1, 15. Dr. Buehrer tested six Nokia N93 Product Samples to support his opinions that

the Nokia N93 was "known, used, and offered for sale and sold in the United States" before the priority date of the '590 Patent, anticipates or renders obvious the asserted claims. Docket No. 157-1 at ¶ 75; Docket No. 157 at 1. Maxell argues that (1) the N93 samples are unreliable because Dr. Buehrer does not know their origins or whether they were modified, and inspections reveal that they are foreign models; (2) Dr. Buehrer's Costa Rican testing should be excluded because he does not provide evidence of how present-day testing of foreign products in a foreign country is indicative of N93 operation in the United States before the November 28, 2007 priority date; and (3) Maxell is prejudiced by spoliation of the eBay product listings corresponding to Samsung's counsel's purchase of the N93 samples. *Id.* at 1–2.

Samsung argues in response that Dr. Buehrer based his N93 opinions "on a rigorous review of all the appropriate evidence—the testimony of two fact witnesses, technical documentation from Nokia, the FCC and numerous third parties that identified all the possible N93 hardware and software variants (all of which were prior art) and conducted reliable testing of the N93 product samples." Docket No. 157 at 3. Samsung argues that Maxell did not identify a single material difference between the N93 samples and any other N93 device or document. *Id.* Moreover, Samsung explains that Dr. Buehrer's testing of the N93 samples had to be performed in Costa Rica because there are no networks relevant to the priority date time period that are currently operating in the United States. *Id.* at 9. As for Maxell's claim of spoliation, Samsung argues that the standard of spoliation in this circuit requires that the spoliating party must have controlled the evidence, the evidence must have been intentionally destroyed, and the spoliating party acted in bad faith. *Id.* at 10. Samsung claims that its conduct does not meet any of those elements. *Id.*

A. Dr. Buehrer's N93 Sample Opinions

The Court finds that Dr. Buehrer's opinions on the N93 samples are sufficiently reliable and relevant to the issues before the jury such that they are appropriate for the jury's consideration.

See Micro Chem., Inc. v. Lextron, Inc., 317 F.3d 1387, 1391–1392 (Fed. Cir. 2003). Samsung has made a sufficient showing that the hardware of the N93 samples is not materially different from that of the prior art N93 device. Docket No. 284 (Hearing Tr.) at 79:12–17 (describing that there was only a single hardware version of the N93 device), 79:21–23 (describing that all of the N93 samples are labeled with the same FCC ID), 92:17–93:6 (describing Mr. McNair's testimony that he has seen "no evidence of an N93 that lacked [a 3G] radio"). The same is true regarding the software of the N93 device. Docket No. 157-1 at ¶¶ 81–83, 333 (describing software version 20.0.058); Docket No. 157 at 7 (explaining that v20.0.058 is a Nokia version number of the Symbian operating system present in the N93 devices). There is also no dispute that the SIM card Dr. Buehrer used is not materially different. Docket No. 284 (Hearing Tr.) at 85:22–86:2 (describing Mr. McNair's testimony that he was "not aware of any differences in how the phone operates with the Truphone SIM card versus a different type of SIM card" "[w]ith respect to data connection to the Internet"). Even if there is a dispute on whether the SIM card Dr. Buehrer used is an "identifier" or "data connection," Samsung acknowledges that it did not have a choice but to use a new SIM card from 2024. *See* Docket No. 284 (Hearing Tr.) at 86:3–10, 101:4–9. Similarly, Samsung had no choice but to test the N93 samples in Costa Rica because the types of networks used in 2007 are no longer available in the United States. Docket No. 284 (Hearing Tr.) at 84:25–85:8; Docket No. 271-5 at 20. Accordingly, Dr. Buehrer's opinions and testing of the N93 samples are sufficiently reliable.

While pre-AIA 35 U.S.C. § 102(a) presumes patents valid "unless the invention was known or used by others **in this country**," Maxell has not shown that there is a *per se* bar on experts conducting present-day testing to replicate the operation of N93 devices in the United States prior to the November 28, 2007 priority date of the '590 Patent. 35 U.S.C. § 102(a) (emphasis added).

Under Federal Rule of Evidence 702 and *Daubert*, Dr. Buehrer applied a reliable methodology and accounted for and explained the differences between the N93 conditions before the priority date and the conditions now. *See* Docket No. 157 at 3–9.

B. Spoliation

Maxell fails to persuade the Court that Samsung spoliated the third-party eBay listings. To assess whether spoliation sanctions should be imposed, the Court determines whether Maxell has shown "(1) the existence of a duty to preserve the evidence; (2) a culpable breach of that duty; and (3) resulting prejudice to the innocent party." *Smith v. Chrysler Grp., LLC*, No. 1:15-CV-218, 2016 WL 7741735, at *3 (E.D. Tex. Aug. 31, 2016). The Court declines to apply a spoliation test that requires bad faith here, as that is reserved for more "severe sanctions," such as an adverse inference or default judgment. *Rimkus Consulting Grp., Inc. v. Cammarata*, 688 F. Supp. 2d 598, 614 (S.D. Tex. 2010).

Generally, a "duty to preserve arises when a party has notice that the evidence is relevant to the litigation," and "whether preservation . . . is acceptable depends on what is reasonable" and "proportional to that case." *Rimkus*, 688 F. Supp. 2d at 612–613 (citations omitted). In this case, the N93 product samples are the best evidence of their origin and condition, and it was reasonable that Samsung did not preserve the third-party eBay listings—which would at best be cumulative of the samples themselves. Docket No. 157 at 13; *see* Docket No. 128-9 (North Carolina N93 eBay listing) at SAM-MAX-00402569; Docket No. 128-7 (Morocco N93 eBay listing) at SAM-MAX-00402565. The situation was reversed in *Edwards v. Junior State of Am. Found.,* No. 4:19-CV-140-SDJ, 2021 WL 1600282 (E.D. Tex. Apr. 23, 2021), which Maxell claims is the best case supporting its motion to exclude and where the spoliator did have a duty to preserve. Docket No. 284 (Hearing Tr.) at 74:13–15. In *Edwards*, the court excluded screenshot evidence as sanctions

because the original messages—the best evidence—had been spoliated. *Edwards*, 2021 WL 1600282, at *7.

Further, Maxell has made no showing that it has been prejudiced by the loss of the third-party listings. Not only can the samples themselves be tested—and they have, by Dr. Buehrer—but the listings that have been produced only (1) state where the product shipped from, not where the product was sold in 2006 and (2) contain equivocal language about what the product "may" have been used as, indicating that the seller does not know their history either. Docket No. 157 at 12–13. Although the parties agree that "it is unclear where [the] N93 product samples were originally sold," it is highly doubtful that Samsung's preservation of the third-party listings would have shed any light on where the samples were originally sold. Docket No. 157 at 13. And, in any event, Maxell can address that issue on cross-examination. Maxell goes too far in seeking to admit facts that broadly call into question the origin and condition of the samples, when at least one listing that was preserved describes the corresponding sample as being in "excellent, new condition."[5] Docket No. 128-9 (North Carolina N93 eBay listing) at SAM-MAX-00402569.

For these reasons, Maxell's motion to exclude Dr. Buehrer's testing of the N93 product samples (Docket No. 128), which includes Maxell's request for spoliation sanctions, is **DENIED**.

XI. Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,129,590 (Docket No. 120)

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[5] Maxell argues that the Court should admit the following facts:

> (1) all samples are of foreign origin; (2) all samples are not in their original condition and have been modified and repaired since their date of manufacture; (3) all samples are floor models; (4) all samples are limited to 2G functionalities; and (5) all sample have an unknown date of first sale.

Docket No. 128 at 15.

Samsung moves for summary judgment of non-infringement of claims 1, 5, 11, and 16 of the ’590 Patent. Docket No. 120 at 1.

A. ’590 Patent, Claim 5

Samsung argues that Maxell’s expert had previously provided an opinion on the [5.d] limitation, which recites “the compression circuit compressing the **video** information received by the first radio communication circuit,” by incorporating his analysis of the [1.d] limitation, which “requires a circuit compressing information received from an optical system [like a **camera**,] rather than from a radio.” Docket No. 120-1 (’590 Patent) at claim 5; Docket No. 120 at 3 (emphasis added). Maxell then withdrew its expert’s opinion on this limitation “as it relates to incorporating by reference the analysis of claim element [1.d].” *Id.* Samsung argues that Maxell has subsequently offered no evidence that Samsung infringes this limitation.

Maxell argues that the accused products do have a circuit compressing video information, and Samsung’s interrogatory responses and technical documents also confirm that the accused products include a video compression circuit. Docket No. 179 at 2. Maxell claims that the accused products clearly include a compression circuit that when storing *any video,* which includes received video, can implement a compression scheme. *Id.*

Maxell has not provided any evidence that Samsung infringes this limitation. The [5.d] limitation requires compression of *video* information *received by radio*, and Maxell has provided no evidence that the accused products meet this limitation. Maxell cites generally to Samsung responses and documents stating that the accused products generally include a compression circuit that can compress video data. But, as Samsung explains, Maxell has forfeited its “any video” theory—the theory that evidence of compression of video information in general necessarily entails the compression of video information *received by radio*—because it was not disclosed in its contentions. Docket No. 201 at 1 (citing Docket No. 120-7 (’590 Supplemental Infringement

Contentions) at 579–598). And there is no evidence that the circuit can compress "any video," much less a video that is received by radio and already has been compressed. Docket No. 201 at 1. Maxell's best evidence is that the Samsung Galaxy S22 User Manual specifically explains that video data can be stored after compression to conserve storage space. Docket No. 223 at 1. But even as circumstantial evidence, Maxell has failed to explain how this suggests or establishes that the accused products compress videos received by radio. A reasonable jury could not infer that there is compression of video information that was received by radio just because the accused products can *store* video after compression to conserve storage space.

B. '590 Patent, Claims 1, 11, 16

1. Quick Share Nearby Share

Asserted independent claim 1 of the '590 Patent recites: "wherein . . . when an indication from the user indicates to transmit video information using the first radio communication circuit, the controller assigns a connection to the first radio communication circuit for transmitting the video information." Docket No. 120-1 ('590 Patent). Asserted claims 11 and 16 depend on claim 1. In its *Markman* order, the Court gave this limitation its "plain and ordinary meaning," explaining that "the language plainly requires the *user* to indicate two things: (1) to transmit video information, and (2) to use the first radio communication circuit in making that transmission." Docket No. 107 at 21–23 (emphasis added). The Court explained that Maxell had explicitly underscored the second requirement during prosecution to overcome prior art that had "nothing to do with a user indicating a particular radio communication circuit to be used." *Id.* at 23 (citing Docket No. 76-13 at 27).

Samsung argues that the Nearby Share function does not infringe because the user only indicates Quick Share should be used, but the *user* does not provide any indication to use any particular radio communication circuit to transmit video information. Docket No. 120 at 4.

Samsung argues that Maxell's expert Mr. McNair only offers evidence of a user selecting the Quick Share application and selecting a nearby Galaxy device with which to share a video to prove infringement of this limitation. *Id.* at 4. Though Mr. McNair attempts to argue that "but for" the user selecting the nearby device, the Wi-Fi circuit (a particular radio circuit) would not be used, Samsung contends that this "cause and effect" argument is based upon a reading of the claim that the Court already rejected in its *Markman* order. *Id.* at 5.

The Court agrees with Samsung. The best evidence that Maxell can muster to meet the Court's construction is evidence that Wi-Fi is "the **only** and **default** circuit" that Quick Share uses to transmit video. Docket No. 179 at 4 (emphasis in original). Therefore, Maxell argues that when a user indicates to share video via Quick Share, the user is also indicating to use the Wi-Fi circuit. *Id.* Maxell also argues that Mr. McNair explains that a *user* is indicating to select the Wi-Fi circuit when it selects Quick Share to transmit video because "a user is also aware that by selecting 'Quick Share' a user is also indicating to select the Wi-Fi circuit." *Id.* at 5 (citing Docket No. 179-2 (McNair Report) at ¶ 576.

The Court's construction of claim 1 is clear. It requires a user to make two indications—to transmit the video and to use a radio circuit. Maxell has offered no evidence from which a reasonable jury could conclude that a user makes the second indication to use a radio circuit. Though Mr. McNair opines that a user is making a second indication because they are aware that they are selecting the Wi-Fi circuit when they select Quick Share, a user's awareness that a result will occur as a result of an action does not mean that that action constitutes an indication for that result to occur. At most, Maxell's evidence only shows a *controller* assigning the radio circuit after a user selects Quick Share. *See, e.g.*, Docket No 179-2 at ¶ 576); *see also* Docket No. 179-2 at ¶ 577 ("When the user provides these one or more user indications . . . [for] ('Quick Share'), the

CPU in 8450 then functions as a controller and assigns a connection to the Wi-Fi circuit"). However, a controller is not a user, and a controller's default assignment of a radio circuit does not establish that a user indicated the use of that radio circuit. Maxell is merely re-litigating its claim construction arguments, which the Court rejected during the *Markman* stage and rejects again here.

That Mr. McNair initially relied on a "Use Wi-Fi Only" setting is inapposite because Maxell has conceded that this setting is irrelevant to Nearby Share. Docket No. 284 (Hearing Tr.) at 151:25–152:16; *see* Docket No. 120-5 (McNair Tr.) at 196:15–23.

2. Quick Share Link Share

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 Quick Share Link Share theories (Docket No. 118). *See supra* Section III.A.

3. Bluetooth File Share

The asserted claims of the '590 Patent recite "wherein the controller controls assignment of connection for . . . the first . . . communication circuit **in response to** receiving an indication from a user such that **when** an indication from the user indicates to transmit video information using the first radio communication circuit, the controller assigns a connection to the first radio communication circuit for transmitting the video information." Docket No. 120-1 ('590 Patent) at 1:59–67 (emphasis added).

Samsung argues that Bluetooth File Share does not practice this limitation because the assignment of a "connection to the first radio communication circuit," is not made either *when* or *in response to* an "indication from the user indicat[ing] to transmit video information using the first communication circuit." Docket No. 120 at 7 (emphasis in original). Samsung argues that undisputed facts show that the claimed timing and causality are absent because the controller *waits*

to assign either Bluetooth or Wi-Fi to transmit the video information until *after* it receives an "Accept" response code from the target phone. *Id.* (emphasis in original)

The Court agrees with Samsung. It is undisputed that after the user provides the accused indications, sometimes the phone will use Wi-Fi instead of Bluetooth to transmit the video information. Docket No. 120-5 (McNair Tr.) at 69:5–12. It is undisputed that the controller waits to assign either Bluetooth or Wi-Fi to transmit the video information until after it receives the response code. Docket No. 120-3 (Buehrer Report) at ¶¶ 69–77; Docket No. 120-5 (McNair Tr.) at 69:5–12. Maxell attempts to show that the controller assigns the radio circuit when and in response to a user indication, but the evidence it offers only shows Bluetooth being turned on or established—not the "controller assign[ing] a connection to the first radio communication circuit for transmitting the video information." Docket No. 179-2 (McNair Report) at ¶¶ 671 (explaining that "if Bluetooth [is] off and then the user . . . provides a user indication to select Bluetooth File Transfer, . . . the controller in the Samsung Galaxy S22 . . . assigns a connection to the Bluetooth radio communication circuit **because Bluetooth radio communication circuit is turned on**") (emphasis added).

Samsung also establishes that the facts here are similar to *DoggyPhone LLC v. Tomofun LLC*, 2024 WL 4848447, at *2 (Fed. Cir. Nov. 21, 2024), where the Federal Circuit affirmed summary judgment of no infringement. In that case, the claims required that a system "*begin*[] transmission to the remote client device of live audio or video of the pet in in response to input from a pet." *Id.* at *2 (emphasis added). However, in response to input from a pet, the accused system only triggered a notification to a user's mobile device, and the transmission did not begin until the user clicked on the notification. *Id.* Thus, the accused system did not infringe because the system did not "begin[] transmission . . . in response to input from a pet"—the system only

"beg[an] *a process* of transmission" in response to that input. *Id.* (emphasis added). Maxell argues unconvincingly that there is no temporal limitation in the claims at issue that would preclude the "occurrence of any intermediate condition, event, or determination." Docket No. 179 at 10 (citing *Optis Wireless Tech., LLC v. Huawei Device Co.*, No. 2:17-CV-123-JRG-RSP, 2018 WL 476054, at *36 (E.D. Tex. 2018). But the temporal limitation in the asserted claims at issue is "*when*," which the Federal Circuit has previously held to preclude intervening steps. *Sierra Wireless, ULC v. Sisvel S.p.A.*, 130 F.4th 1019, 1021–1024 (Fed. Cir. 2025).

The Court cannot consider Maxell's argument in its surreply that Samsung's non-infringement argument only applies to S22 to S22 video transfer. This argument is unsupported, is not evidence, and is attorney argument that does not create a material dispute of fact. Docket No. 223 at 3–4.

For the reasons above, Samsung's motion for summary judgment of non-infringement of the '590 Patent (Docket No. 120) is **GRANTED**.

XII. Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent Nos. 11,223,757 and 8,037,161 (Docket No. 121)

Samsung moves for summary judgment of non-infringement of the '757 and '161 Patents. Docket No. 121 at 1.

A. '757 Patent, limitation [1.d]

Samsung argues that the accused products do not infringe the asserted claims because they do not include "a second camera arranged on an opposite side of the touch display" as required by [1.d]. *Id* .at 3. Limitation [1.c] requires "a first camera arranged on a **same side of the touch display**," and limitation [1.d] requires "a second camera [is] arranged **on an opposite side of the touch display**." Docket No. 121-1 ('757 Patent), claim 1 (emphasis added). The parties agreed that the plain and ordinary meaning of [1.c] is "that the first camera is located on **a same side of**

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.

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

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 instructions." 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.

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

> to a network, belong to the same network, the network belonging judgment method comprising the steps of:
>
> causing each of the network devices to collect peripheral device information indicating which ones of the network devices are connected to the network while the connection to the network is established;
>
> causing each of the network devices to store home network information, which is a chronological list of network devices connected to the network, in accordance with the collected peripheral device information;
>
> causing **the first network device** to receive the home network information stored in the second network device and **collate** the received home network information with the home network information stored in the first network device **when judging the belonging** of the second network device; and
>
> **judging in accordance with the collation result** whether the second network device belongs to the same network as the first network device.

Docket No. 121-6 ('161 Patent) at claim 6 (emphasis added).

The crux of Samsung's argument is that Maxell cannot establish infringement because it cannot show that [redacted]. Docket No. 121 at 13. Maxell responds that one or more of the [redacted]. *See* Docket No. 180 at 10. Because Dr. Weissman opines that [redacted], there are least genuine disputes of material fact contrary to Samsung's positions.

Dr. Weissman opines that [redacted]g. *See, e.g.*, Docket No. 180-8 (Weissman Report) at ¶¶ 545–556. He also opines that [redacted]. *See, e.g.*, *id.* at ¶¶ 406, 410, 413, 543. Dr. Weissman's testing shows

[redacted]—contradicting Samsung's position that [redacted]" *See, e.g.*, *id.* at pp. 934, 955. And he opines that the [redacted]k. *See, e.g.*, *id.* at ¶¶ 551, 555 and pp. 1609–1609. A reasonable jury could find that there is a SmartThings Network which contains the SmartThings cloud server and find for Maxell on all of these positions. *See, e.g.*, Docket No. 180-9 (Shields Tr.) at 71:5–74:23.

For the reasons above, Samsung's motion for summary judgment of non-infringement (Docket No. 121) is **DENIED** with respect to the '161 Patent.

XIII. Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,176,848 (Docket No. 122)

Samsung moves for summary judgment of non-infringement of the '848 Patent because the accused products do not practice at least one claim limitation of asserted claims 11, 12, and 84. Docket No. 122 at 1.

A. "First Setting Mode"

Asserted claims 11 and 12 depend on claim 8, which requires a "first setting mode" and a "second setting mode." The parties agree that asserted claim 84 requires modes that are "substantively similar" to those included in claim 8. Docket No. 122 at 4. In the "first setting mode," a person is "newly photograph[ed] and the image information from the newly captured photo is used to register the person as "the specific person." Docket No. 122-1 at 15:64–16:2. The "second setting mode" 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 "the specific

person." *Id.* at 16:3–7. Samsung argues that the accused products do not have a "first setting mode" because Maxell identifies only one mode of registering a person as "the specific person," and that mode corresponds only to the "second setting mode." Docket No. 122 at 4. Maxell argues that that the claims do not require that the specific person must be newly registered under the "first setting mode," but only that they are registered. Docket No. 181 at 4. Therefore, Maxell contends that associating a newly taken photograph with a previously registered person practices the "first setting mode." *Id.*

There is at least a genuine dispute of material fact because Maxell's expert testifies that once a "tag" for a specific person is set up under the "second setting mode," then a "new photo [taken under the "first setting mode"] is assigned the same tag, and as a result, is registered as the same person." Docket No. 181-3 (Balakrishnan Tr.) at 71:3–13, 73:6–74:7; *see also* Docket No. 181 at 4–5.

Finally, the Court is not convinced that Maxell's positions on the "first setting mode" before the PTAB are contrary with its positions in this case. *See* Docket No. 122 at 6 (quoting Maxell as stating to the PTAB that "it is not until after the new person is photographed that the new person is registered as the specific person"). Maxell was attempting to distinguish prior art that only involved the "first setting mode," and so therefore a new person could only be registered as the specific person after they were photographed. Docket No. 181 at 6. Here, Maxell contends that the accused products have a "second setting mode" where a specific person is newly registered and a "first setting mode" where that specific person is registered again based on the second setting mode's registration.

B. "Reproducing Mode"

Claim 11 requires first and second reproducing modes, where "the image information reproduced under the second mode includes the image information reproduced under the first

reproducing mode **and other of the image information not reproduced under the first reproducing mode**." Docket No. 122-1 ('848 Patent), claim 11 at 16:33–37 (emphasis added). Claim 12 depends from Claim 11 and requires a third reproducing mode in addition to the first and second reproducing modes included in Claim 11. *Id.*, claim 12 at 16:38–49. Samsung's argument for non-infringement of claims 11 and 12 of the '848 Patent is based on an illogical interpretation of the claim language—Samsung contends that there can only be infringement when "the same image information [is] reproduced in the three purported modes." Docket No. 122 at 7. Under Samsung's interpretation, if there are any "different photographs" in any of the modes, then there cannot be infringement. *See id.*; Docket No. 204 at 3. This interpretation violates the basic tenet that "[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention." *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997). The plain meaning of element [11.c] is that the first reproducing mode has a subset of image information that the second reproducing mode contains. *See* Docket No. 269-4 at 15.

Maxell's expert Dr. Balakrishnan makes clear that there is a genuine dispute of material fact through his opinions that a user can select photographs in accordance with the three different reproducing modes of claims 11 and 12 from the same auto-update album—the same source. Docket No. 181-2 (Balakrishnan Report) at ¶¶ 309–310, 344–345, 365, 380; Docket No. 181-3 (Balakrishnan Tr.) at 85:16–95:11, 129:8–138:2.

C. "Video Image Data"

Claim 84 requires "a video camera providing **video image data,** wherein, in response to the face-recognizing process recognizing that a face of a person is included in the **video image data**, the display displays the **video image data** with a frame surrounding at least a portion of the face of the person." Docket No. 122-2, claim 84 at 9:15–20 (emphasis added). Maxell contends that claim 84 is infringed because in the preview of the Camera application, a frame surrounds a

portion of a face of a person when the face is recognized in the video image data. Docket No. 122-4 (Balakrishnan Report) at ¶ 608. Samsung argues that the accused products do not infringe claim 84 because they do not use "video image data" when depicting a frame around a person's face in the accused camera application photo preview mode. Docket No. 122 at 9–10.

There remains a genuine issue of material fact. Maxell's expert admits that the preview image is not yet video image data, and Samsung claims this is dispositive. *Id.* at 10–11 (citing Docket No. 122-5 (Balakrishnan Tr.) at 139:16–20). But Maxell claims that if the preview screen ends up being saved as a video as opposed a photo, then "video image data is displayed . . . in preview mode." Docket No. 222 at 3; Docket No. 181-3 (Balakrishnan Tr.) at 139:21–140:1 ("**Q:** So what we're seeing on the preview screen . . . is a box around a face in image data, but not video image data, right? **A:** It's just the timing. It's not yet video image data. But if it became a video, then it would be part of the video image data."); 140:21–141:6.

For the reasons above, Samsung's motion for summary judgment of non-infringement of the '848 Patent (Docket No. 122) is **DENIED**.

XIV. Samsung's Motion for Partial Summary Judgment of Noninfringement and Summary Judgment of Invalidity for Lack of Written Description Under 35 U.S.C. § 112 for U.S. Patent No. 8,982,086 (Docket No. 124)

Samsung moves for partial summary judgment of non-infringement of the '086 Patent because (1) Maxell's DOE theory fails as a matter of law and (2) the asserted claims of the '086 Patent are invalid for lack of written description because the specification does not disclose using fingerprint information. Docket No. 124 at 1.

A. DOE Theory

Samsung argues that Maxell's DOE theory fails for limitation [1.f] because (1) Maxell's expert Dr. Wobbrock testified in his deposition that he did not consider any differences between the asserted claims and accused products; (2) Dr. Wobbrock's DOE opinion in his report was

overly broad and did not provide "particularized testimony and linking argument" as required by Federal Circuit precedent; and (3) Dr. Wobbrock's DOE theory is based on infringement of only a single registration mode (the claim requires two registration modes) that is not specific to a particular portion of the finger (the claim requires a particular area of the finger). Docket No. 124 at 5.

In response, Maxell argues that (1) Dr. Wobbrock testified that he did not consider the differences between the accused products and the claim language because any difference would be insubstantial; (2) Dr. Wobbrock identified the "function" (fingerprint sensor and processors and the registration processes they perform), the "way" (using components like the fingerprint sensors and multiple processors detect different portions of the finger), and the "result" (registering the user's finger pads and finger ends/tips/edges); (3) Dr. Wobbrock never opined that there is only one registering mode. Docket No. 173 at 2–5.

Maxell has failed to provide evidence from which a reasonable jury could find that Samsung's accused products operate in substantially the same way to register the user's finger information. The generalized testimony that Dr. Wobbrock gave was legally insufficient. *NexStep, Inc. v. Comcast Cable Commc'ns, LLC*, 119 F.4th 1355, 1371 (Fed. Cir. 2024) ("The patentee must provide particularized testimony and linking argument as to the insubstantiality of the differences between the claimed invention and the accused device. . . . Generalized testimony as to the overall similarity between the claims and the accused infringer's product or process will not suffice") (citations omitted). He needed to provide a "meaningful explanation of *why*" the element or elements from the accused product or process are equivalent to the claimed limitation. *Id.* (emphasis added). Dr. Wobbrock's opinions in his report also do not save him. Dr. Wobbrock's report provides no analysis of the differences between the accused products and the claimed

invention, and thus such opinions are insufficient under *NexStep*. *See* Docket No. 124-6 (Wobbrock Report) at ¶¶ 410–411, 413. "Broad conclusory statements offered by [Maxell's] expert are not evidence and are not sufficient to establish a genuine issue of material fact." *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334, 1343 (Fed. Cir. 2016) (citations omitted).

For the first time on surreply, Maxell argues that Dr. Wobbrock's "DOE opinions were based on the 'differences' that Samsung alleged to be present." Docket No. 224 at 3. However, Dr. Wobbrock merely observes that Samsung alleges that limitation [1.f] is not literally met because "the first registering mode does not input information by a pad of the finger and the second registering mode does not input information by an end of the finger." Docket No. 124-6 (Wobbrock Report) at ¶ 410. Such an opinion does nothing to address the Court's concern with the lack of testimony regarding "the insubstantiality of the differences between the claimed invention and the accused device." *NexStep*, 119 F.4th at 1371.

B. Written Description

During claim construction, the parties disagreed whether claim 1 of the '086 Patent encompasses fingerprint information. The Court agreed with Maxell, which argued that the "first information" and "second information" claim terms should be given their plain and ordinary meaning, which encompasses fingerprint information. Docket No. 107 at 23–27. The Court rejected Samsung's arguments that Maxell had disavowed fingerprint information from the scope of the claims during prosecution of the reissue of the '086 Patent's parent patent, RE48,830. *Id.*; *see* Docket No. 124 at 5–6. During that prosecution, the examiner had rejected certain proposed claims for lack of written description, finding that "[t]here is no support for storing information related to a fingerprint, as the specification discloses storing information as to the fingertip or the finger pad." *Id.* at 6 (citing Docket No. 124-2 (Non-Final Rejection) at 5). Maxell cancelled the claims as a result. *Id.*

Samsung makes essentially the same arguments regarding the invalidity of the asserted claims of the ’086 Patent for written description. Samsung points again to the fact that an examiner rejected the proposed claims of the RE48,830 Patent during its prosecution. Docket No. 124 at 6. And Samsung argues that the specification’s disclosure of detecting touches by a fingertip or finger pad is fundamentally different than detecting the ridges, loops, and whorls of a fingerprint, which is not disclosed. *Id.* at 6–7.

The Court, which rejected Samsung’s arguments on the RE48,830 in its *Markman* order (Docket No. 107 at 24–27), rejects them again here. The examiner’s findings on different claim language of a different patent has no bearing on whether the Court should find summary judgment on written description appropriate for the ’086 Patent here.

Moreover, there is a genuine dispute of material fact. Maxell explains that the ’086 Patent describes a specific type of capacitive sensor arranged in grid-like patterns, which would create a two-dimensional map of the user’s finger when it comes into contact with the sensor grid. Docket No. 173 at 9; Docket No. 124-1 (’086 Patent) at 3:30–34, FIGS. 5A, 5B, 6A, 6B, 8. The contact by a finger would change the capacitance and result in “identification information” in the form of letters, figures, and symbols. Docket No. 173 at 9; Docket No. 124-1 (’086 Patent) at Abstract, 1:40–64, 3:17–19, 3:30–32, 5:4–6, 7:66–67. Maxell’s expert Dr. Wobbrock opines that a POSITA at the time of the invention “would understand that capacitive sensors of the kind disclosed in the ’086 Patent would be capable of detecting a fingerprint.” Docket No. 173-2 (Wobbrock Report) at ¶¶ 138-141. He further details that a particular class of capacitance sensor could be used to detect the ridges, loops, and whorls of a user’s fingerprint. *Id.* This is in accordance with *Allergan*, which articulates that “the proper [written description] inquiry must be into the specification first and then *guided* by expert testimony.” *Allergan USA, Inc. v. MSN Lab’ys Priv. Ltd.*, 111 F.4th 1358,

1376 (Fed. Cir. 2024). At the summary judgment phase, Samsung has failed to meet its high burden of clear and convincing evidence to establish that claim 1 of the '086 Patent is invalid for lack of written description.

For the reasons above, Samsung's motion for partial summary judgment of non-infringement and invalidity of the '086 Patent (Docket No. 124) is **GRANTED** with respect to non-infringement under the doctrine of equivalents and **DENIED** with respect to invalidity for lack of written description.

CONCLUSION

For the reasons discussed above, 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**;
- Samsung's Motion to Strike Certain Portions of the Expert Reports of Dr. Jacob O. Wobbrock Regarding U.S. Patent No. 11,223,757 (Docket No. 119) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- Samsung's Motion to Strike Portions of Expert Reports of Dr. Jon Weissman (Docket No. 123) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- Samsung's Motion to Strike Certain Portions of the Rebuttal Expert Reports of Dr. Karan Singh Regarding U.S. Patent No. 11,017,815 (Docket No. 127) is **DENIED**;
- Maxell's Motion to Strike Portions of Defendants' Expert Reports Based on Untimely Claim Construction Positions (Docket No. 125) is **GRANTED-IN-PART** and **DENIED-IN-PART**;
- Maxell's Motion for Partial Summary Judgment of Validity Based on Samsung's *Sotera* Stipulations (Docket No. 132) is **DENIED**;

- Samsung's Motion for Summary Judgment of Subject Matter Ineligibility Under 35 U.S.C. § 101 for U.S. Patent Nos. 11,017,815; 11,223,757; and 8,037,161 (Docket No. 130) is **DENIED**;

- Maxell's Motion to Strike and Exclude Dr. Buehrer's Testing of the N93 Product Samples (Docket No. 128) is **DENIED**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,129,590 (Docket No. 120) is **GRANTED**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent Nos. 11,223,757 and 8,037,161 (Docket No. 121) is **GRANTED-IN-PART** and **DENIED-IN-PART**;

- Samsung's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 10,176,848 (Docket No. 122) is **DENIED**; and

- Samsung's Motion for Partial Summary Judgment of Noninfringement and Summary Judgment of Invalidity for Lack of Written Description Under 35 U.S.C. § 112 for U.S. Patent No. 8,982,086 (Docket No. 124) is **GRANTED-IN-PART** and **DENIED-IN-PART**. It is further

ORDERED that, within **seven (7) days** of this Order's entry, the parties **SHALL** jointly move to file a redacted version of this Order. The parties' joint motion **SHALL** provide proposed redactions, describe the confidential information in those proposed redactions, and provide good cause for each redaction. Or, if no redactions are necessary, the parties **SHALL** jointly file an unsealed and unredacted version of the Order with a cover page stating no redactions are needed.

So ORDERED and SIGNED this 2nd day of May, 2025.

Robert W Schroeder III

ROBERT W. SCHROEDER III
UNITED STATES DISTRICT JUDGE