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Maxell Settles Patent Suit Against Apple Over Mobile Tech

By **Christopher Cole**

Law360 (March 23, 2021, 7:07 PM EDT) -- Maxell has reached a settlement with Apple in Texas federal court just before heading to trial over allegations that Apple's iOS devices infringe multiple patents on mobile technology.

The companies also called off a proceeding at the Patent Trial and Appeal Board, where Apple Inc. had planned to argue before judges Tuesday that two Maxell patents are invalid in hopes of beating infringement claims from the Japanese tech firm.

Terms of the deal to end the district court case were not disclosed. Maxell Ltd. filed a proposed order Monday under seal in what court records describe as a motion to "stay all deadlines and notice of settlement." Court minutes say the parties told the judge at the end of jury selection proceedings Monday they had reached a deal.

The parallel fights in Texas' Eastern District and the PTAB were ignited over Apple's use of certain innovations in mobile devices that Maxell claimed to already own, such as power management and ringtone technologies. Apple challenged numerous claims before the PTAB as obvious to people skilled in the art based on older inventions.

Kyoto-based Maxell first sued Apple in March 2019 and filed an amended complaint that October in Texas federal court.

Maxell's amended complaint said as an industry leader and product developer, Maxell owns a portfolio of patents related to mobile technologies and actively enforces them through licensing and, potentially, litigation.

"Maxell is forced to bring this action against Apple as a result of Apple's knowing and ongoing infringement of Maxell's patents," the suit said.

The suit claimed that since at least June 2013, Apple has been aware of Maxell's patents and "has had numerous meetings and interactions regarding its infringement of these patents."

Maxell sought damages, costs and "in no event less than a reasonable royalty" for alleged infringement of 10 patents, covering technologies used in products from cellphones to batteries and cameras. However, in February the court told Maxell that it must narrow its case down to six patents, which the company did, according to court records.

As late as March 15, the district court case was still set to proceed, as U.S. District Judge Robert W. Schroeder III **denied Apple's bid** to postpone the trial until later in the year so that all its participants can be vaccinated.

Attorneys for Maxell and Apple did not immediately respond to inquiries Tuesday.

Two of the patents in dispute had been scheduled for inter partes review at the PTAB. In one of the reviews consolidated for argument, Apple was challenging 13 claims of a patent on power management techniques for "controlling power consumption" in information processing devices. That patent was among those excluded from the upcoming Texas trial.

Apple's other PTAB challenge was against seven claims of a patent related to customizing a ringtone to provide users an indication of current conditions along with alerting the user of an incoming call.

The patents-in-suit are U.S. Patent Nos. 6,329,794; 6,928,306; 6,408,193; 10,084,991; 10,212,586; 6,430,498; 6,580,999; 6,748,317; 7,116,438; and 8,339,493.

Maxell is represented by Geoff Culbertson and Kelly Tidwell of Patton Tidwell & Culbertson LLP, and Jamie B. Beaver, Alan M. Grimaldi, Kfir B. Levy, James A. Fussell III, Baldine B. Paul, Tiffany A. Miller, Saqib J. Siddiqui, Bryan C. Nese, William J. Barrow, Alison T. Gelsleichter, Clark S. Bakewell, Robert G. Pluta and Amanda Streff Bonner of Mayer Brown LLP.

Apple is represented by Harry L. Gillam Jr. and Melissa Richards Smith of Gillam & Smith LLP, and Mark D. Fowler, Brent K. Yamashita, Christian Chessman, Sean C. Cunningham, Erin P. Gibson, Kevin Hamilton, David R. Knudson, Michael Jay, Aaron G. Fountain, Zachary Loney, Dawn M. Jenkins, Paul Steadman and Stephanie Lim of DLA Piper.

The case is Maxell Ltd. v. Apple Inc., case number 5:19-cv-00036, in the U.S. District Court for the Eastern District of Texas.

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--Additional reporting by Dave Simpson, Katie Buehler, Lauren Berg, Ryan Davis, Cara Salvatore, Hailey Konnath, Dani Kass, Britain Eakin and Tiffany Hu. Editing by Emily Kokoll.

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