

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
WACO DIVISION**

CAROLYN W. HAFEMAN,

Plaintiff,

v.

LG ELECTRONICS, INC.,

Defendant.

Civil Action No. 6:21-cv-00696-ADA-DTG

JURY TRIAL DEMANDED

**FILED UNDER SEAL**

**PLAINTIFF'S MOTION FOR A NEW TRIAL AND  
PARTIAL JUDGMENT AS A MATTER OF LAW**

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## I. INTRODUCTION

Plaintiff Carolyn W. Hafeman respectfully submits this motion for a new trial and partial judgment as a matter of law. On April 28, 2023, the jury returned a verdict of non-infringement and invalidity as to each Asserted Claim.<sup>1</sup> The Court should set aside that verdict because it was compromised by prejudicial conduct and errors and because it cannot be reconciled with the undisputed evidence of infringement and utter lack of evidence of invalidity.

## II. BACKGROUND

In this case, Ms. Hafeman asserts three patents against Defendant LG Electronics, Inc. (LG) that relate to a method, apparatus, and computer program for *remotely initiating or changing* return/recovery information<sup>2</sup> on a computer *without assistance from the user* in possession of the computer. *See, e.g.*, JX 1 ('287 Patent).

***Pretrial Conference.*** The Court made four pretrial rulings that are relevant to this motion. *First*, the Court granted a *Daubert* motion as to LG's damages expert, Ms. Lauren Kindler. ECF No. 203 (PTC Order) at 3. The Court observed that Ms. Kindler's calculation of a purported reasonable royalty based on a tentative contingency offer to litigate Ms. Hafeman's patents was "something I'm unfamiliar with anyone ever having tried before, and . . . I don't mean that in a good way." Ex. 2 (PTC Tr.) 98:1–3. *Second*, the Court granted a related motion *in limine* (MIL) that more broadly precluded LG from offering evidence of *any* unconsummated offer sent to Ms. Hafeman's patent broker, Tangible IP. PTC Order at 3. *Third*, the Court held that LG was estopped from challenging the Asserted Claims' priority date because in its *Sotera* stipulation, LG

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<sup>1</sup> The Asserted Claims are claims 1 and 4 of U.S. Patent No. 9,892,287; claims 1, 4, and 7 of U.S. Patent No. 10,325,122; and claims 1, 4, and 7 of U.S. Patent No. 10,789,393.

<sup>2</sup> Return/recovery information is "information provided by the owner so that the device can be returned to the owner." Ex. 1 (Tr.) 1084:15–18. Ms. Hafeman uses the term "return information" throughout this motion.

agreed that it would not rely on “any ground that Google or Microsoft raised or reasonably could have raised” in the pending *inter partes* reviews against Ms. Hafeman’s patents. PTC Order at 1–2; *see* Ex. 3 (Sotera Stipulation).<sup>3</sup> Fourth, over Ms. Hafeman’s opposition, the Court granted LG’s MIL to preclude any evidence regarding the [REDACTED]

[REDACTED] PTC Order at 4; *see* Ex. 4 [REDACTED] Ex. 5 [REDACTED] [REDACTED] Following the pretrial conference, trial commenced as scheduled on April 24, 2023.

***Ms. Hafeman’s Infringement Case.*** Ms. Hafeman’s technical expert, Dr. Scott Schaefer, conducted a detailed, claim-by-claim analysis of LG’s infringement. Tr. 292:10–348:4. Android and Windows Find My Device each allow the owner to log in to a remote computer and to initiate or change return information that is displayed on or before the lock screen of a lost or stolen device (the “Accused Functionality”). *See, e.g.*, Tr. 299:6–10, 300:9–18, 340:9–14. As Dr. Schaefer explained using a live demonstration, an owner “remotely initiates” return information when he or she sets return information on the lost or stolen device for the first time. *See, e.g.*, Tr. 340:10–12. An owner “remotely changes” return information when he or she changes the message or phone number that is displayed on the lock screen of the lost or stolen device. *See, e.g.*, Tr. 340:12–14.

Critically, Find My Device displays the return information “without assistance by a user with the computer,” as required by the Asserted Claims. *See, e.g.*, ’287 Patent at 17:23–24. The user does not need to do *anything* for return information to be displayed when the owner initiates or changes the return information from the remote computer. *See, e.g.*, Tr. 319:14–19, 334:23–335:2. As Ms. Hafeman explained at trial, this limitation was essential because the owner cannot force the user—who could be a thief—to “do something to make [the invention] work.” Tr. 59:11–

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<sup>3</sup> Unless otherwise indicated, all emphasis in this brief has been added, all internal quotations and citations have been omitted, and all internal alterations have been adopted.

60:1. Find My Device also “maintain[s]” the return information, as required by several of the Asserted Claims. *See, e.g.*, JX 2 (’122 Patent) at 16:58–59. As Dr. Schaefer showed with his live demonstration, the return information does not automatically disappear, but rather remains on the display screen until the password is entered on the device. *See, e.g.*, Tr. 326:16–24.

***Ms. Hafeman’s Damages Case.*** Mr. Louis Carbonneau, Ms. Hafeman’s former patent broker, testified by deposition about LG’s receipt of actual notice of infringement beginning on March 29, 2018. Tr. 249:5–278:7. Using this actual notice date, Ms. Hafeman’s damages expert—Mr. Walter Bratic—testified that Ms. Hafeman was entitled to damages of over \$54.9 million based on a reasonable royalty rate of \$1.00 per Accused Product. Tr. 513:7–602:23.

***LG’s Non-Infringement Case.*** LG’s non-infringement expert, Dr. John Black, contested only one claim limitation: remotely initiating or changing return information. Tr. 946:25–947:6. Dr. Black testified that the Asserted Claims all require that a user first input return information locally on a device, but Find My Device requires that the return information be initially input through a web browser on a remote computer. Tr. 926:23–927:8, 932:14–17. However, LG never raised and the Court never adopted that claim construction and it conflicts with the plain claim language. ECF Nos. 49, 208. Dr. Black also claimed that the Accused Products do not remotely change return information, but failed to rebut all of Dr. Schaefer’s testimony on this element or even all of the testimony of a Microsoft witness, Mr. Hans Andersen. Tr. 929:7–930:16. Finally, Dr. Black repeated the false testimony of a Google witness, Mr. Sorin Dinu, and claimed that Android Find My Device does not maintain return information if the device is turned off and then back on. Tr. 931:17–932:7. In rebuttal, Dr. Schaefer proved Dr. Black’s and Mr. Dinu’s testimony false by conducting a live demonstration showing that previously downloaded return information still resides on the device even after it is turned off and back on. Tr. 994:15–996:1, 996:18–997:3.

***LG's Damages Case.*** Ms. Kindler [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]

[REDACTED] after fifteen minutes and was prevented from offering further testimony. Tr. 969:20–993:2.

***LG's Invalidity Case.*** LG claimed that the Asserted Claims were anticipated by the BlackBerry “System” and were rendered obvious by the Windows 2000 “System” in combination with Cohen (EPO Publication No. EP0687968A2). *See, e.g.*, Tr. 701:9–17. LG and its invalidity expert—Dr. Sandeep Chatterjee—did not have access to an operable BlackBerry “System.” Instead, LG offered Chatterjee as an uncorroborated fact witness to testify about his *recollection* of the BlackBerry server software from *20 years before*, and offered ambiguous user manuals without any evidence on whether the manuals reflected the actual operation of the system. Tr. 818:23–819:25; *see, e.g.*, DX 44; DX 182. Similarly, LG’s evidence on the Windows 2000 combination—including the testimony of Dr. Chatterjee and the testimony of a Microsoft witness, Mr. Eric Flo—relied on several printed publications (*see, e.g.*, DX 83; Tr. 762:21–765:22) and an edited video that omitted parts showing user assistance and a wired cable connection between the two computers (*see* DX 477-L). LG’s efforts to evade this critical no user assistance limitation are made clear by comparing the two minute, thirty-one second video that LG introduced and referenced dozens of times at trial (*see* [Ex. 6](#)) with the eleven minute, fifty-eight second video attached to Dr. Chatterjee’s expert report (*see* [Ex. 7](#)), which showed that user assistance was required by logging on to the computer first with the username and password.

***Ms. Hafeman's Rebuttal Case.*** Dr. Schaefer’s rebuttal testimony exposed fatal flaws in LG’s prior art. First, Dr. Schaefer explained that the Windows 2000 combination did not “maintain” return information on or before or with the lock screen, as required by several of the Asserted Claims. Instead, the return information automatically disappeared after approximately



two minutes. Tr. 1010:9–1011:6. Second, Dr. Schaefer testified that the Windows 2000 combination did not satisfy the “without assistance” limitations and explained that in LG’s sole Windows 2000 video demonstration, the user had already provided assistance by logging in. Tr. 1003:17–1010:8. Third, Dr. Schaefer testified that the BlackBerry System did not satisfy the “without assistance” limitations because the user was required to accept a new password. Tr. 1012:5–1016:11.

***JMOL, Deliberations, and Verdict.*** Following the close of all evidence, Ms. Hafeman moved for judgment as a matter of law (JMOL) on both infringement and validity, which the Court denied. Tr. 1057:22–1058:24. The jury began deliberating on April 28, 2023 and returned a defense verdict the same day. ECF No. 248. The Court has not yet entered final judgment.

### **III. LEGAL STANDARD**

“[I]f the trial judge is not satisfied with the verdict of a jury, he has the right—and indeed the duty—to set the verdict aside and order a new trial.” *Smith v. Transworld Drilling Co.*, 773 F.2d 610, 613 (5th Cir. 1985). Among other reasons, the Court can order a new trial if it finds that “the verdict was against the weight of the evidence . . . the trial was unfair, or prejudicial error was committed in its course.” *In re Depuy Orthopaedics, Inc. Pinnacle Hip Implant Prod. Liab. Litig.*, 888 F.3d 753, 784 (5th Cir. 2018) (quoting *Smith*, 773 F.2d at 613); *see* FED. R. CIV. P. 59(a)(1)(A). “In making this determination, the [Court] weighs all the evidence, but need not view it in the light most favorable to the nonmoving party.” *Smith*, 773 F.2d at 613.

The Court can also grant a renewed motion for judgment as a matter of law under Rule 50(b) “[i]f a party has been fully heard on an issue during a jury trial and the court finds that a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue.” FED. R. CIV. P. 50(a)(1); *see* FED. R. CIV. P. 50(b). In making this determination, the Court

views the evidence in the light most favorable to the verdict. *See, e.g., Streamline Prod. Sys., Inc. v. Streamline Mfg, Inc.*, 851 F.3d 440, 450 (5th Cir. 2017).

#### IV. ARGUMENT

##### A. A New Trial Is Warranted Due To The Prejudice Resulting From The ██████████ ██████████ By LG's Damages Expert.

The Court should grant a new trial due to the prejudice resulting from Ms. Kindler's ██████████ ██████████. Contingency offers like the ones that Ms. Kindler referred to “are not representative of a hypothetical negotiation because they base the payment for the patents on the outcome of litigation.” *In re ChanBond, LLC Patent Litig.*, 2020 WL 550786, at \*2 (D. Del. Feb. 4, 2020). Moreover, unconsummated offers have “so little probative value that [their] probative value is substantially outweighed by the danger of unfair prejudice caused by the failure to interest anyone in the technology at the time and the waste of time needed to explain why the non-agreement[s] [are] uninformative.” *Id.* at \*1. In fact, this Court has held that unconsummated negotiations are not even *discoverable* because such negotiations are “unreliable absent a final decision.” *Daedalus Blue, LLC v. Microsoft Corp.*, 2022 WL 3031076, at \*2–3 (W.D. Tex. Aug. 1, 2022) (Albright, J.). Thus, the Court was undoubtedly correct to ██████████ and grant Ms. Hafeman's MIL on unconsummated offers.

Ultimately, LG persisted in calling Ms. Kindler after representing that she would merely offer “opinions criticizing Mr. Bratic.” Tr. 284:9–10; *see also* Tr. 987:5–7. Yet just fifteen minutes into her trial testimony—and barely after she finished overviewing her background and qualifications—Ms. Kindler ██████████ testifying that “none of [Ms. Hafeman's] activities resulted in any takers of a license or offers to purchase the patents that were accepted--.” Tr. 983:9–11. ██████████

[REDACTED]

[REDACTED]

Ms. Kindler’s message was clear: the jury should not find in favor of Ms. Hafeman because the market thought her patents were worthless. That message resulted in extreme prejudice because, [REDACTED]

[REDACTED]

[REDACTED] The prejudice was compounded because—as the penultimate witness at trial— [REDACTED] came shortly before the close of evidence and the beginning of the jury’s deliberations. [REDACTED]— while certainly appropriate under the circumstance—seemingly left the jury with the impression that she had provided all the necessary testimony (*i.e.*, that the patents had no real-world market value) for the jury to render a verdict in LG’s favor.

The Fifth Circuit has affirmed the grant of a new trial under similar circumstances. In *Hollybrook Cottonseed Processing, LLC v. American Guarantee & Liability Insurance Co.*, the defendant violated a MIL by eliciting testimony about a demand made during settlement negotiations. 772 F.3d 1031, 1033 (5th Cir. 2014). As the Fifth Circuit explained, this violation was not harmless because “the improper testimony about the settlement offer came shortly before the case was submitted to the jury, and it therefore would have been somewhat fresh in the jurors’ minds.” *Id.* at 1034. Here, as in *Hollybrook Cottonseed Processing*, a new trial is warranted because Ms. Kindler’s prejudicial [REDACTED] so close to the jury’s deliberations leaves “no fair assurance the jury was not influenced by the inadmissible . . . testimony.” *Id.*

**B. A New Trial Is Warranted Due To The Prejudice Resulting From LG's Violations Of Its *Sotera* Stipulation.**

LG's continued refusal to honor its *Sotera* stipulation also warrants a new trial. *See* Tr. 3:14–10:14 (Ms. Hafeman objecting based on *Sotera* stipulation). To get IPRs instituted against Ms. Hafeman's patents, LG precluded itself from relying on “*any ground* that Google or Microsoft raised or reasonably could have raised” in the IPRs. *Sotera* Stipulation at 1. After violating the *Sotera* stipulation at summary judgment, *see* PTC Order at 1–2, LG again violated the *Sotera* stipulation at trial in two distinct ways.

First, LG relied on BlackBerry and Windows 2000 as purported “system art.” *See, e.g.*, Tr. 6:10–15. But a defendant cannot “simply swap[] labels for what is otherwise a patent or printed publication invalidity ground in order to ‘cloak’ its prior art ground and ‘skirt’ estoppel.” *Cal. Inst. of Tech. v. Broadcom Ltd.*, 2019 WL 8192255, at \*7 (C.D. Cal. Aug. 9, 2019). That is exactly what LG did here.

With respect to BlackBerry, LG did not even have access to an operable system and relied *solely* on printed publications—like user manuals, administration guides, and press releases—**that Google and Microsoft reasonably could have raised in the IPRs.** Tr. 818:23–819:25; *see, e.g.*, DX 44; DX 182. Courts have not hesitated to find estoppel under these circumstances. *See, e.g.*, *General Access Sols., Ltd. v. Sprint Spectrum L.P.*, 2020 WL 12572917, at \*3 (E.D. Tex. Dec. 1, 2020) (“When a party asserts a prior art system and relies exclusively on printed subject matter that it could have raised in IPR, it is not asserting a system at all.”); *Cal. Inst. of Tech.*, 2018 WL 7456042, at \*15 (holding that defendant was estopped from relying on purported system art where “all of Defendants’ actual arguments to show that certain limitations were disclosed in the prior art emanate from the documents”); *Milwaukee Elec. Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d

990, 1032 (E.D. Wis. 2017) (“[The defendant] cannot skirt [estoppel] by purporting to rely on a device without actually relying on the device itself.”).

Similarly, with respect to Windows 2000, Dr. Chatterjee relied on printed publications that Google and Microsoft reasonably could have raised in the IPRs. *See, e.g.*, Tr. 762:21–765:13 (testifying about the Windows 2000 Server Resource Kit).<sup>4</sup> “Where there is evidence that a petitioner had reasonable access to printed publications corresponding to or describing a product that it could have proffered during the IPR process, it cannot avoid estoppel simply by pointing to its finished product (rather than the printed materials) during litigation.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, 2019 WL 861394, at \*10 (N.D. Ill. Feb. 22, 2019). Because Dr. Chatterjee’s use of the system did not show anything that the printed publications did not already show, LG’s reliance on Windows 2000 also violated its *Sotera* stipulation. *See, e.g., Avanos Med. Sales, LLC v. Medtronic Sofamor Danek USA, Inc.*, 2021 WL 8693677, at \*2 (W.D. Tenn. Oct. 8, 2021) (holding that defendant was estopped from relying on purported system art where “the relevant claim limitations . . . were adequately described in the publicly available documents”); *Wasica Fin. GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 453–55 (D. Del. 2020) (same, where “all the relevant features of th[e] physical product had been disclosed in a patent or printed publication that reasonably could have been raised during the IPR”).<sup>5</sup>

Second, LG relied on Cohen for invalidity in combination with Windows 2000. *See, e.g.*, Tr. 701:15–17. This ground violated LG’s *Sotera* stipulation because Cohen is a printed patent application that was *actually raised* by Google and Microsoft in the IPRs. *See, e.g.*, Ex. 10 (’1188

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<sup>4</sup> The Windows 2000 Server Resource Kit is a printed publication. *See* <https://www.amazon.com/Microsoft-Windows-Server-Resource-Resource/dp/1572318058>.

<sup>5</sup> LG, Google, and Microsoft were undoubtedly aware of these publications, as their counsel raised them in LG’s invalidity contentions prior to filing the IPRs and Microsoft was responsible for developing Windows 2000. Exs. 8–9 (Excerpts of Preliminary Invalidity Contentions).

Petition) at 16–18. IPR estoppel applies “whether the patents and printed publications are offered as stand-alone evidence, *or in combination with other evidence that could not have been presented at the IPR proceeding.*” *Singular Computing LLC v. Google LLC*, 2023 WL 2839282, at \*7 (D. Mass. Apr. 6, 2023). In *Singular Computing*, Google proffered three purported prior art systems and sought to prove the relevant features of those systems using printed publications as well as non-printed materials. *Id.* The court rejected that attempt and held that Google could not rely on the printed publications, regardless of whether Google’s invalidity case also relied on materials that could not have been presented in the IPRs. *Id.*; *see also, e.g., Biscotti Inc. v. Microsoft Corp.*, 2017 WL 2537021, at \*1 (E.D. Tex. May 30, 2017) (holding that defendant could only use patents or printed publications to show the date on which systems were in public use or on sale). Thus, LG’s use of Cohen violated the *Sotera* stipulation even in combination with Windows 2000.

**C. A New Trial Is Warranted Due To The Prejudice Resulting From The Court’s Exclusion Of [REDACTED] Evidence.**

Google and Microsoft are LG’s suppliers of the Accused Functionality. Predictably then, LG, Google, and Microsoft have cooperated extensively against Ms. Hafeman throughout the litigation: LG’s counsel is representing Google and Microsoft in the IPRs; Google and Microsoft provided witnesses for LG in this case; LG’s counsel represented those witnesses; Microsoft produced prior art systems for LG in this case; and Google and Microsoft lawyers attended the pretrial conference and trial. There is a reason for this extensive coordination: [REDACTED]

[REDACTED] Yet at the pretrial conference, the Court precluded Ms. Hafeman from offering any evidence of these obligations. PTC Order at 4.

The impact of this exclusion cannot be overstated, as it shielded crucial evidence of the extreme bias of three testifying witnesses: Mr. Flo (a Microsoft employee), Mr. Dinu (a Google

employee), and Mr. Andersen (a Microsoft employee). It also confused the jury. At trial, LG pointed the finger at Google and Microsoft and maintained that all LG does is install the infringing Find My Device software as provided by Google and Microsoft. *See, e.g.*, Tr. 491:3–7, 492:21–24 (Mr. Lee testifying that LG had no input in the design or development of Find My Device). Without the evidence of [REDACTED], the jury was left to wonder why it should hold LG liable when Google and Microsoft were responsible for developing the infringing technology.

The Fifth Circuit has ordered a new trial under these precise circumstances. *See Thurber Corp. v. Fairchild Motor Corp.*, 269 F.2d 841, 844 (5th Cir. 1959). A third-party supplied Ford with transmissions that allegedly infringed the plaintiff’s patents. 269 F.2d at 844. In exchange, the third-party supplier agreed to indemnify Ford and share in its litigation expenses. *Id.* After the district court excluded evidence regarding the third-party supplier, two witnesses affiliated with the third-party testified at trial, and the jury subsequently returned a defense verdict. *Id.* at 843–44. The Fifth Circuit reversed, finding that the evidence of indemnification was “of such great significance and pertinence to the case at hand” that the exclusion was not harmless. *Id.* at 844. As the Fifth Circuit explained, “[i]t is axiomatic that [the witnesses’] employment by someone with such a direct interest in the outcome of the case is a fact that the jury should know in weighing their testimony.” *Id.* at 845; *see also, e.g.*, 27 Victor J. Gold, *Federal Practice and Procedure* § 6095 & n.17 (2d ed., Apr. 2023 update) (citing *Thurber Corp.*).

The exclusion was particularly prejudicial here because a Microsoft employee, Mr. Flo, testified that he had “no interest in the outcome of this case.” Tr. 640:10–12; *see* Tr. 606:13–18. The Court found that this testimony did not open the door to evidence of [REDACTED], reasoning that “there’s no reason to believe he has any bias that would be revealed to the jury by

bringing up that issue since he is unaware of that legal relationship between Microsoft and LG.”  
Tr. 642:11–14.

Respectfully, however, [REDACTED]

[REDACTED] is irrelevant. The jury was entitled to know that [REDACTED]

And the [REDACTED]

regardless of whether their employees knew precisely why:

[T]he fact that a witness is employed by a party to the suit is regarded as a relevant circumstance to be considered by the jury as showing bias or interest, and *a fortiori* where the witness is an employee of a party who has an interest in the recovery, his employment may be shown for the same reason. *To this must be added the further a fortiori that the financial interest of the witness’ employer may be shown to connect the chain.*

*Thurber Corp.*, 269 F.2d at 845. In addition, without the evidentiary exclusion, Ms. Hafeman could have cross-examined LG’s corporate representative, Mr. Lee, regarding the [REDACTED]. Thus, the Court should order a new trial because the MIL prevented Ms. Hafeman from explaining the [REDACTED] and resulting bias to the jury. *Id.* at 844–45.<sup>6</sup>

**D. Ms. Hafeman Is Entitled To Judgment As A Matter Of Law On Infringement.**

Ms. Hafeman proved infringement as a matter of law. *See* Tr. 1057:22–1058:12 (moving for JMOL on infringement). During trial, Dr. Schaefer conducted a detailed, claim-by-claim analysis of each Asserted Claim; presented numerous demonstratives showing how the Accused Products met all limitations; and performed a live demonstration that was itself sufficient to prove

<sup>6</sup> [REDACTED]. *See, e.g., DSC Commc’ns Corp. v. Next Level Commc’ns*, 107 F.3d 322, 329 (5th Cir. 1997) (affirming admission of indemnification agreement that was necessary to understanding “the parties’ full relationship”).



infringement by the Accused Phone and Tablet Products. Tr. 292:10–367:17. LG completely failed to rebut this proof of infringement.

**1. LG Based Its Lone Non-Infringement Argument On A New, Unsupportable Claim Construction.**

Dr. Black arrived at his opinion of non-infringement only after engaging in improper claim construction with respect to the term “initiating.” Relying on an isolated snippet of the specification, Dr. Black concluded that the term “initiating” requires that the owner first input return information locally on the device. Tr. 926:23–927:8, 932:14–17. In essence, Dr. Black took one embodiment from the specification and used that embodiment to read an additional limitation into the Asserted Claims under the guise of interpreting the plain and ordinary meaning of “initiating.” Tr. 926:17–18 (citing ’287 Patent at 8:39–48). The Asserted Claims do not cover this one embodiment. Instead, all Asserted Claims expressly require “initiating” the return information “through remote communication.” *E.g.*, ’287 Patent at 17:22–23. Thus, Dr. Black’s improper construction directly conflicted with the plain claim language.

“At trial, parties may introduce evidence as to the plain and ordinary meaning of terms not construed by the Court to one skilled in the art, *so long as the evidence does not amount to arguing claim construction to the jury.*” *EMC Corp. v. Pure Storage, Inc.*, 2016 WL 775742, at \*4 (D. Del. Feb. 25, 2016). Dr. Black’s testimony about the term “initiating” far surpassed any proper interpretation of plain and ordinary meaning and, instead, improperly added a limitation that is found nowhere in the claims. *See, e.g., Network-1 Techs., Inc. v. Alcatel-Lucent USA, Inc.*, 2017 WL 4020589, at \*4 (E.D. Tex. Sept. 12, 2017) (excluding testimony where technical expert “directly compare[d] the accused instrumentalities with an embodiment disclosed in [the patent], which is impermissible”); *EMC Corp.*, 2016 WL 775742, at \*4 (“Testimony that embodiments in a patent specification support an expert’s opinions regarding the plain and ordinary meaning of

claim terms would amount to claim construction and suggest that [non-infringement] can be established by a comparison between accused products and specification embodiments.”<sup>7</sup>

**2. Even Under LG’s Claim Interpretation, A Reasonable Jury Could Only Find Infringement.**

At trial, both parties agreed that infringement of the Asserted Claims could be shown by *either* remotely initiating *or* remotely changing return information. *See, e.g.*, Tr. 329:21–24 (Dr. Schaefer); Tr. 947:14–21 (Dr. Black). ***Dr. Black entirely failed to rebut Dr. Schaefer’s testimony establishing that the Accused Products remotely change return information.***

First, Dr. Black testified that Android Find My Device was not capable of remotely changing return information because if an owner sent “a second message with a different phone number *but the same text*, you wouldn’t see anything change because the display isn’t changed.” Tr. 930:12–15. But Dr. Black did not rebut Dr. Schaefer’s testimony that an owner can remotely change return information by *entering new text*. *See, e.g.*, Tr. 319:9–13, 333:8–12. In addition, changing the phone number without changing the text *does* constitute remote changing of return information, because the phone number that will be called has changed. Tr. 301:25–302:4, 319:9–13.<sup>8</sup>

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<sup>7</sup> The Court should also order a new trial due to the risk that the jury relied on LG’s demonstratives and statements of counsel to find that the Accused Products do not have return information stored in the memory “at [the] time of [the] remote . . . change.” Ex. 11 (LG’s Opening Slides) at 34. LG’s witnesses did not dispute that Find My Device had return information stored in the memory at the time of the remote change.

<sup>8</sup> At trial, Dr. Black also argued that Android Find My Device does not maintain return information by doubling down on Mr. Dinu’s false claim that Android Find My Device ceased to function after a power cycle. Tr. 931:17–932:7. No reasonable jury could believe this testimony after Dr. Schaefer’s live demonstration conclusively proved it to be false. Tr. 994:15–996:1, 996:18–997:3. In addition, Dr. Black claimed that the Android Find My Device program was not a remotely accessed “interactive program” because Mr. Dinu testified that Find My Device receives commands using fire-based cloud messaging. Tr. 930:20–931:16; *see* Tr. 853:9–17. This vague testimony is insufficient to support the jury’s verdict: the Find My Device program *is* remotely accessed by the owner because it receives and executes commands that the owner sends remotely. *See, e.g.*, Tr. 322:2–15. The Asserted Claims require no more.

Second, relying on Mr. Andersen, Dr. Black claimed that Windows Find My Device was not capable of remotely changing return information because when an owner sends a second message, the first message remains on the display screen. Tr. 929:18–25. But as Mr. Andersen explained, the second message will be displayed when the computer runs out of battery and the user turns it back on. Tr. 912:3–913:6. The Asserted Patents make clear that merely powering a computer on is not the type of “user assistance” prohibited by the Asserted Claims. *See, e.g.*, ’287 Patent, Figs. 3–4 (showing that a user must “turn computer on” for return information to be displayed); *id.* at 3:28–29 (explaining that Ms. Hafeman’s invention “provides its layer of protection during the boot-up process (not before)”). Thus, Windows Find My Device allows an owner to remotely change return information without user assistance.

### **3. LG’s Infringement Had The Required Nexus To The United States.**

In three separate ways, Ms. Hafeman proved that LG’s infringement had the required nexus to the United States under 35 U.S.C. § 271. First, LG imported the Accused Products into the United States under Section 271 by shipping them from Vietnam and China to its wholly-owned subsidiary—LGEUS—in Illinois and California. PX 30; PX 31; *see, e.g., Nuance Commc’ns, Inc. v. Abby Software House*, 626 F.3d 1222, 1233 (Fed. Cir. 2010) (finding a “sufficient presence . . . for importation under § 271(a)” where a foreign parent shipped software to its subsidiary in the United States). Second, LG sold the Accused Products in the United States under Section 271 because title and risk passed from LG to LGEUS in the United States. PX 13, §§ 5.1, 5.3; *see, e.g., Litecubes, LLC v. N. Light Prods., Inc.*, 523 F.3d 1353, 1368–71 (Fed. Cir. 2008) (finding a domestic sale even when title and risk passed outside the United States). Third, by LG’s own admission, LGEUS acted as LG’s agent in selling the Accused Products to end-users in the United States. Tr. 489:25–490:2; *see, e.g., Akami Techs., Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020,

1023 (Fed. Cir. 2015) (“An actor is liable for infringement under § 271(a) if it acts through an agent (applying traditional agency principles).”).<sup>9</sup>

**E. Ms. Hafeman Is Entitled To Judgment As A Matter Of Law On Validity.**

LG failed to present any legally sufficient evidence of invalidity. *See* Tr. 1058:13–1058:23 (moving for JMOL on validity). In addition to violating its *Sotera* stipulation, LG’s invalidity evidence was conclusory, speculative, and failed to address all claim limitations.

**1. LG’s Evidence On The Windows 2000 Combination Was Insufficient As A Matter Of Law.**

LG’s evidence on the Windows 2000 combination was insufficient as a matter of law for at least two additional reasons. *First*, LG presented no evidence that the Windows 2000 combination satisfied the “without assistance” limitations. *See, e.g.*, ’287 Patent at 17:22–24. It was undisputed at trial that logging in to the computer constitutes user assistance. Tr. 1005:15–18, 1015:24–1016:11. Yet LG’s expert at trial only cited a highly edited video that misleadingly omitted the parts showing that the user had *already provided assistance* by logging in to the computer prior to remotely updating the return information. *See* DX 477-L; Tr. 808:1–4, 828:20–829:2 (Dr. Chatterjee acknowledging that the user had logged in). LG referred to this abbreviated video dozens of times at trial, falsely telling the jury that Windows 2000 did not require user assistance to remotely initiate or change return information. As Dr. Schaefer explained in rebuttal,

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<sup>9</sup> In addition to direct infringement, Ms. Hafeman offered overwhelming evidence of indirect infringement that LG failed to rebut with legally sufficient evidence. *See* Tr. 1087:22–1090:18. (instructing jury on inducement of infringement and contributory infringement). For example, Ms. Hafeman proved direct infringement by LG’s customers through the testimony of Dr. Schaefer and through usage statistics. Tr. 351:16–352:12, 365:6–367:8, 387:6–388:16. Similarly, Dr. Schaefer established that the Accused Functionality of Find My Device was a material component not suitable for substantial non-infringing use, and that LG instructed its users on how to engage in infringing use. Tr. 298:16–301:1, 352:13–353:19, 355:5–356:25. Finally, Ms. Hafeman proved the requisite knowledge requirements by showing that LG continued to encourage users to infringe after repeatedly being provided with notice emails and detailed claim charts. *See, e.g.*, PX 21; PX 46.

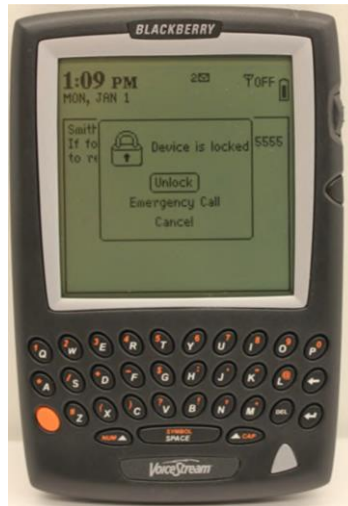
remotely initiating or changing return information with Windows 2000 required user assistance. Tr. 1003:17–1008:2. For example, a Wi-Fi connection could not be established between the remote computer and the server unless the user first logged into the remote computer—exactly the sort of user assistance that LG misleadingly cut from the video played to the jury. Tr. 1007:8–10.

*Second*, LG failed to present any evidence that return information was “maintained” on or before or with the lock screen. *See, e.g.*, ’122 Patent at 16:58–59, 17:28–29, 18:24–25. It was undisputed at trial that return information automatically disappeared with Windows 2000 after two minutes and thus was not maintained on or before or with the lock screen. Tr. 1011:4–5 (testimony of Dr. Schaefer); Tr. 659:18–22 (testimony of Mr. Flo).

## **2. LG’s Evidence On The BlackBerry System Was Insufficient As A Matter Of Law.**

LG’s evidence on the BlackBerry System was legally insufficient for at least four additional reasons. *First*, Dr. Chatterjee did not even have access to an operable system. Tr. 809:12–20, 818:23–819:25, 830:7–16. Instead, Dr. Chatterjee testified as a fact witness based on his memory of using the BlackBerry server software more than 20 years ago. Tr. 819:20–25, 830:17–22. Such uncorroborated fact testimony “cannot surmount the hurdle that the clear and convincing evidence standard imposes in proving patent invalidity.” *Finnigan Corp. v. ITC*, 180 F.3d 1354, 1370 (Fed. Cir. 1999). Nor could Dr. Chatterjee’s reliance on unauthenticated snippets of ambiguous “user manuals” overcome the absence of corroboration because LG offered no evidence that the manuals reflected BlackBerry’s actual operation. *Id.* at 1369 (finding that ambiguous documents are not “corroborative”). Thus, a reasonable jury could not have found that the BlackBerry System anticipated the Asserted Claims by clear and convincing evidence. *See, e.g., Anthony v. Chevron USA, Inc.*, 284 F.3d 578, 583 (5th Cir. 2002) (explaining that JMOL is appropriate when the jury “rest[s] its verdict on mere speculation and conjecture”).

*Second*, LG failed to present any evidence that the BlackBerry System displayed return information that was “visible to anyone viewing the display screen.” *E.g.*, ’287 Patent at 17:20–21. The evidence presented by LG showed that the return information was not visible to anyone viewing the display because it was obscured by the lock screen:



DX 469-A at 5. For the return information to become visible, the user had to provide assistance by pressing one of the buttons depicted above. *See id.* at 6 (showing device after pressing “Unlock”).<sup>10</sup> In addition, the return information depicted above and shown at trial was *inputted locally*, as evidenced by the lack of network connection. *See id.* at 3 (showing the local inputting). As discussed above, the Asserted Claims require *remotely* initiating or changing, and LG presented no evidence that the system worked in the same way (or even worked at all) when return information was set remotely rather than locally.

*Third*, LG presented no evidence that the BlackBerry System satisfied the “without assistance” limitations. Dr. Chatterjee relied on the following dialogue box:

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<sup>10</sup> Dr. Chatterjee also speculated that the return information became visible because the phone had been charged. Tr. 843:23–844:15. As discussed above, such uncorroborated speculation is insufficient to support the jury’s verdict.



DX 44 at 115. Even assuming this was implemented in the BlackBerry system (LG could not provide the system software), user assistance would be required with or without a pre-set password. First, if the user already had a password, the BlackBerry System required user assistance because the user was required to accept the new password by pressing a key. Tr. 1013:4–11. Second, with or without an existing password, “the handheld will be locked” when the “Set Owner Info” screen is activated. As shown above, when the handheld is “locked,” the user must enter the password or press a key to see the new owner information. Tr. 1013:4–7 (Dr. Schaefer explaining that “there’s going to be a prompt” that “requires . . . action by the user”). While Dr. Chatterjee disputed that the last sentence means a password will always be required, Tr. 736:22–738:10, the document is too ambiguous to be corroborative of his decades-old memory. *Finnigan*, 180 F.3d at 1369; see Tr. 1013:19–1014:2 (Dr. Schaefer explaining that the dialogue box is “not clear”). Thus, the “Set Owner Info” diagram could not have provided a basis for the jury to find that the BlackBerry System satisfied the “without assistance” limitations.

*Fourth*, LG presented an undisclosed invalidity theory at trial in violation of Federal Rule of Civil Procedure 26(e)(2). See Tr. 786:1–787:6 (objecting to Dr. Chatterjee’s undisclosed

theory). For the first time at trial, Dr. Chatterjee relied on a default BlackBerry setting that would cause a security time-out after two minutes to argue that the “without assistance” limitations were satisfied. Tr. 726:17–22. This undisclosed invalidity theory prejudiced Ms. Hafeman at trial by depriving Dr. Schaefer of the time necessary to adequately prepare a full and complete response.<sup>11</sup>

**F. In The Alternative, A New Trial On Infringement And Validity Is Warranted Because The Jury’s Verdict Was Against The Great Weight Of The Evidence.**

The standard for a new trial is significantly more lenient than the JMOL standard. The Court need only find that the verdict was against the great weight of the evidence to grant a new trial, and it need not view the evidence in the light most favorable to the verdict. *See Smith*, 773 F.2d at 613. Moreover, a motion for a new trial does not require that “an objection be made at trial or that a party first move for judgment as a matter of law under Rule 50(a).” *ESW Holdings, Inc. v. Roku, Inc.*, 2021 WL 3742201, at \*3 (W.D. Tex. Aug. 24, 2021) (Albright, J.).

For all of the reasons set forth in Section D above, the jury’s verdict of non-infringement was against the great weight of the evidence. Similarly, for all of the reasons set forth in Section E above, the jury’s verdict of invalidity was against the great weight of the evidence. Thus, even if the Court concludes that Ms. Hafeman is not entitled to JMOL under Rule 50(b), it should—at a minimum—order a new trial on infringement and validity under Rule 59(a).

**V. CONCLUSION**

The Court should enter JMOL of infringement and validity and order a new trial on damages and willfulness. In the alternative, the Court should order a new trial on all issues.

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<sup>11</sup> In any event, Dr. Chatterjee’s new theory failed to show invalidity. Under Dr. Chatterjee’s security time-out scenario, for example, the “interactive program”—*i.e.*, the software that receives the return information from the administrator of the BlackBerry Enterprise Server—does not “enable the initiating or changing of the display screen.” *E.g.*, JX 3 (’393 Patent) at 16:34–40. Instead, the security time-out functionality enables the initiating or changing of the display screen.



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Respectfully submitted,

Lawrence M. Hadley (California 157728)  
Jason C. Linger (California 323031)  
GLASER WEIL FINK HOWARD  
AVCHEN & SHAPIRO LLP  
10250 Constellation Boulevard, 19th  
Floor  
Los Angeles, California 90067  
Tel: (310) 553-3000  
Fax: (310) 556-2920  
lhadley@glaserweil.com  
jlinger@glaserweil.com

Mark D. Siegmund (Texas 24117055)  
CHERRY JOHNSON SIEGMUND JAMES  
PLLC  
The Roosevelt Tower  
400 Austin Avenue, 9th Floor  
Waco, Texas 76701  
Tel: (254) 732-2242  
Fax: (866) 627-3509  
msiegmund@cjsjlaw.com

By: /s/ Max L. Tribble Jr.

Max L. Tribble Jr. (Texas 20213950)  
Krisina J. Zuñiga (Texas 24098664)  
Thomas V. DelRosario (Texas 24110645)  
SUSMAN GODFREY LLP  
1000 Louisiana Street, Suite 5100  
Houston, Texas 77002  
Tel: (713) 651-9366  
Fax: (713) 654-6666  
mtribble@susmangodfrey.com  
kzuniga@susmangodfrey.com  
tdelrosario@susmangodfrey.com

Kalpana Srinivasan (California 237460)  
SUSMAN GODFREY LLP  
1900 Avenue of the Stars, Suite 1400  
Los Angeles, California 90067  
Tel: (310) 789-3100  
Fax: (310) 789-3150  
ksrinivasan@susmangodfrey.com

Genevieve Wallace (Washington 38422)  
SUSMAN GODFREY LLP  
401 Union Street, Suite 3000  
Seattle, Washington 98101  
Tel: (206) 516-3880  
Fax: (206) 516-3883  
gwallace@susmangodfrey.com

Daniel D. Duhaime (New York 5780432)  
(*pro hac vice*)  
SUSMAN GODFREY LLP  
1301 Avenue of the Americas, Floor 32  
New York, New York 10019  
Tel: (212) 336-8330  
Fax: (212) 336-8340  
dduhaime@susmangodfrey.com

*Counsel for Plaintiff Carolyn W. Hafeman*

**CERTIFICATE OF SERVICE**

I hereby certify that counsel of record are being served with a copy of this document and all attachments via email on July 14, 2023.

*/s/ Max L. Tribble Jr.*

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SUSMAN GODFREY LLP

*Counsel for Plaintiff*