United States District Court

EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD.,	§	
	§	
v.	§	**No. 5:24-CV-00088-RWS-JBB**
	§	**SEALED**
CORETRONIC CORP. AND OPTOMA CORP.	§	
	§	

REPORT AND RECOMMENDATION OF THE UNITED STATES MAGISTRATE JUDGE

Maxell, Ltd. ("Maxell") alleges Coretronic Corp. and Optoma Corp. ("Defendants") directly and indirectly infringe seven patents owned by Maxell. Defendants move to dismiss Counts 6 and 7 of Maxell's complaint for failure to state a claim upon which relief can be granted under Federal Rule of Civil Procedure 12(b)(6). Dkt. Nos. 22, 24. The Court, having carefully considered the relevant briefing, recommends the motions be **DENIED**.[1]

I. BACKGROUND

In two separate motions, Defendants move to dismiss with prejudice Counts 6 and 7 of Maxell's complaint, which allege infringement of U.S. Patent Nos. 9,565,388 (the "'388 Patent") and 9,900,569 (the "'569 Patent") respectively, based on invalidity under 35 U.S.C. § 102(a)(1). Dkt. Nos. 22, 24. According to Defendants, if the allegations in Maxell's complaint are taken as true, then at least: (1) claim 4 of the '388 Patent is invalid as clearly anticipated by certain prior art Optoma products (HD82/HD8200 and HD83/HD8300), both of which were offered for sale before the filing date of the '388 Patent; and (2) claim 1 of the '569 Patent is invalid as clearly

[1] The above-referenced case was referred to the undersigned United States Magistrate Judge for pretrial purposes in accordance with 28 U.S.C. § 636.

anticipated by certain prior art Optoma products (EH501 and W316), both of which were offered for sale before the filing date of the '569 Patent. With respect to any other claims of the'388 and '569 Patents which Maxell may assert in this case, Defendants argue that to the extent any of those claims are alleged to cover the asserted products, they would be invalid for the same reasons. Dkt. No. 22 at 17, 28; Dkt. No. 24 at 29.

Maxell responds that the motions are procedurally flawed because they each rely on "dozens of exhibits, totaling hundreds of pages, and a fact declaration by an employee of Defendant Coretronic, none of which are found within" the complaint. Dkt. No. 39 at 4; Dkt. No. 40 at 6. According to Maxell, consideration of Defendants' "newly submitted material" would require the motions to dismiss be converted into ones for summary judgment under Rule 56 and create "a material dispute of fact that cannot fairly or fully be resolved at this stage of litigation before any discovery has commenced." Dkt. No. 39 at 4-5; Dkt. No. 40 at 6. Maxell further asserts the motions fail on their merits (with or without the submitted material) because the products the complaint accuses of infringing the asserted claims of the '388 and '569 Patents are different products and have different functionality/technology from those relied upon by Defendants to show invalidity. Dkt. Nos. 39, 40 at 1. Finally, Maxell argues Defendants' "[s]weeping [r]equest" to invalidate all remaining claims of the '388 Patent and all remaining claims of the '569 Patent is improper when Defendants have only addressed one claim for each patent. Dkt. No. 52 at 5 (stating Maxell has also identified claims 6, 10, 16, 18, and 22 of the'388 Patent in its infringement contentions); Dkt. No. 53 at 5 (stating the '569 Patent's other claims are distinct from claim 1).

II. LEGAL STANDARDS

A. Rule 12(b)(6)

A party may move to dismiss an action for a "failure to state a claim upon which relief can be granted." FED. R. CIV. P. 12(b)(6). To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to "state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. *Id.* (citing *Twombly*, 550 U.S. at 556). The court accepts well-pleaded facts as true and views all facts in the light most favorable to the plaintiff but is not required to accept the plaintiff's legal conclusions as true. *Arigna Tech. Ltd. v. Bayerische Motoren Werke AG*, 697 F. Supp. 3d 635, 641 (E.D. Tex. 2023) (citation omitted).

A court may look beyond the complaint only after converting the motion into one for summary judgment, unless the additional materials or facts are amenable to judicial notice, attached to the complaint, or incorporated therein. *Semantic Search Techs. L.L.C. v. Aldo U.S., Inc.*, No. 6:16-CV-01058-RWS, 2019 WL 13029910, at *2 (E.D. Tex. Aug. 21, 2019) (citing *Great Plains Tr. Co. v. Morgan Stanley Dean Witter & Co.*, 313 F.3d 305, 313 (5th Cir. 2002); also citing FED. R. CIV. P. 12(d)). However, "the mere submission or service of extraneous materials does not by itself convert a Rule 12(b)(6) or 12(c) motion into a motion for summary judgment." *Id.* (quoting *U.S. ex rel. Long v. GSDMIdea City, L.L.C.*, 798 F.3d 265, 275 (5th Cir. 2015) (internal brackets omitted in *Semantic*)). In fact, "Rule 12(b) gives a district court complete discretion to determine whether or not to accept any material beyond the pleadings." *Id.* (quoting *Isquith for & on Behalf of Isquith v. Middle S. Utilities, Inc.*, 847 F.2d 186, 194 n.3 (5th Cir. 1988) (internal

quotation marks omitted in *Semantic*)). The exercise of this discretion in any particular case depends on whether "the conversion of the motion facilitates the disposition of the case." *Id.* (quoting *Woods v. City of Galveston*, 5 F. Supp. 2d 494, 497 n.3 (S.D. Tex. 1998); *Webb v. Taylor*, No. 6:11-CV-14, 2011 WL 13220216, at *1 (E.D. Tex. Sept. 22, 2011) (same); also citing 5 C. Wright & A. Miller, *Federal Practice and Procedure, Civil.* § 1366 (3d. ed. 2017)).

B. Invalidity defense based on anticipation

Patents are presumed valid by statute. *Finnigan Corp, v. International Trade Comm'n*, 180 F.3d 1354, 1365 (Fed. Cir. 1999). A defendant raising an invalidity defense bears a "'heavy burden of persuasion,' requiring proof of the defense by clear and convincing evidence." *ProStrakan, Inc. v. Actavis Lab'ys UT, Inc*., No. 2:16-CV-00044-RWS, 2018 WL 11363829, at *62 (E.D. Tex. Sept. 28, 2018), *aff'd*, 787 F. App'x 757 (Fed. Cir. 2019) (quoting *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 102 (2011)).

A person is entitled to a patent unless "the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention." 35 U.S.C. § 102(a)(1). Section 102 embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is "anticipated" by the prior invention. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). Anticipation is a factual question and thus within the ordinary provenance of the jury. *Biogen MA Inc. v. EMD Serono, Inc*., 976 F.3d 1326, 1332 (Fed. Cir. 2020) (citing *Lighting Ballast Control L.L.C. v. Philips Elecs. N. Am. Corp*., 790 F.3d 1329, 1340 (Fed. Cir. 2015)); *Digital Control, Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1319 (Fed. Cir. 2006) (stating "the scope and content of prior art and what the prior art teaches are questions of fact").

Under the pre-AIA public use bar, "[a] person shall be entitled to a patent unless ... the invention was ... in public use ... in this country, more than one year prior to the date of the application for patent in the United States." *Ingenico Inc. v. IOENGINE, L.L.C.*, No. 2023-1367, 2025 WL 1318188, at *2 (Fed. Cir. May 7, 2025) (citing 35 U.S.C. § 102(b) (pre-AIA)). In 2011, Congress enacted the AIA, shifting the "first-to-invent" system to a "first-inventor-to-file" regime. *Celanese Int'l Corp. v. Int'l Trade Comm'n*, 111 F.4th 1338, 1344 (Fed. Cir. 2024), *cert. denied sub nom. Celanese Int'l Corp. v. ITC*, No. 24-635, 2025 WL 1211791 (U.S. Apr. 28, 2025) (citations omitted). In enacting the AIA, Congress amended Section 102, the pertinent part of which now provides that one shall not be entitled to a patent if "the claimed invention was patented, described in a printed publication, or in public use, *on sale*, or otherwise available to the public before the effective filing date of the claimed invention."[2] *Id.* (citing 35 U.S.C. § 102(a)(1) (emphasis added in *Celanese*)).

A claim is anticipated only if "each and every [limitation] is found within a single prior art reference." *Biogen*, 976 F.3d at 1331–32 (quoting *Summit 6, L.L.C. v. Samsung Elecs. Co.*, 802 F.3d 1283, 1294 (Fed. Cir. 2015)). Because the hallmark of anticipation is prior invention, a prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." *Net MoneyIN*, 545 F.3d at 1369 (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

[2] Congress also retained the one-year grace period for certain disclosures made one year or less prior to applying for patent, which was previously codified in pre-AIA Section 102(b) and is now codified in AIA Section 102(b)(1). *Celanese Int'l Corp. v. Int'l Trade Comm'n*, 111 F.4th 1338, 1344 (Fed. Cir. 2024), *cert. denied sub nom. Celanese Int'l Corp. v. ITC*, No. 24-635, 2025 WL 1211791 (U.S. Apr. 28, 2025). The application that matured into the '388 Patent was filed on April 3, 2013, and issued on February 7, 2017. *See* Dkt. No. 1-11. The application that matured into the '569 Patent was filed on July 4, 2014, and issued on February 20, 2018. *See* Dkt. No. 1-12.

However, there is a narrow exception. *Metaswitch Networks Ltd. v. Genband US L.L.C.*, No. 2:14-CV-744-JRG-RSP, 2016 WL 3618831, at *7 (E.D. Tex. Mar. 1, 2016). When the defendant contends the patent is invalidated by the accused product itself, the patentee's infringement allegations operate as a concession that the accused product meets the limitations of the asserted claims. *Id.* (citing *Vanmoor v. Wal-Mart Stores, Inc*., 201 F.3d 1363, 1366 (Fed. Cir. 2000)). The *Vanmoor* exception requires an identity between the accused product and the asserted prior art, at least with respect to the aspects of the product that are accused of infringement.[3] *Id.* (citing *Vanmoor*, 201 F.3d at 1366 (prior art accused product "made to specifications that remain unchanged to the present day"); also citing *U.S. Ethernet Innovations, L.L.C. v. Texas Instruments Inc.*, No. 6:11-CV-491-MHS-JDL, 2014 WL 1347994, at *2 (E.D. Tex. Apr. 3, 2014) (A party "cannot argue a product contains each and every element of the patented invention for infringement purposes, but that the same product does not contain each and every element of the patented invention for invalidity purposes.") (emphasis added in *Metaswitch Networks*); also citing *Inline Connection Corp. v. Earthlink, Inc.*, 684 F. Supp. 2d 496, 514 (D. Del. 2010) (holding it is not sufficient for the prior art and the accused product to be "materially identical"; there must be "no dispute that the accused infringing product was identical to the prior art") (emphasis added in *Metaswitch Networks*)).

The *Vanmoor* exception is, and must be, narrowly construed to require the defendant to allege and prove an identity between the accused product and the prior art. *Metaswitch Networks*,

[3] In *Vanmoor*, the plaintiff sued Wal–Mart alleging infringement of its patent directed at a caulking gun cartridge. *Vanmoor v. Wal-Mart Stores, Inc*., 201 F.3d 1363, 1364 (Fed. Cir. 2000). Wal–Mart argued that "certain of the accused caulking cartridges were identical to cartridges manufactured, sold, and used prior to the critical date for the '331 patent." *Id.* at 1365. The Federal Circuit stated that "[a]s was the case in *Evans Cooling* [*Sys., Inc. v. Gen. Motors Corp*., 125 F.3d 1448, 1450 (Fed. Cir. 1997)] the entire basis of the patent infringement claim is Vanmoor's (the patentee's) contention that the accused cartridges infringe the '331 patent." *Id.* at 1366. "Although Wal–Mart. . . bore the burden of proving that the cartridges that were the subject of the pre-critical date sales anticipated the '331 patent, that burden was satisfied by Vanmoor's allegation that the accused cartridges infringe the '331 patent." *Id.*

2016 WL 3618831, at *7. Thus, proof that the accused product and the prior art are similar, comparable, or even materially identical, is not sufficient under *Vanmoor*. *Id.* (citing *Inline Connection*, 684 F. Supp. 2d at 515 (attempting to prove the accused product and the prior were "materially identical" constituted an impermissible "practicing the prior art" defense)).

III. DISCUSSION

Regarding Count 6 (Infringement of the '388 Patent), Defendants argue that the claims are anticipated because Maxell has accused the UHZ65LV projector of infringing Claim 4, and that the UHZ65LV projector is "similarly applicable to Defendants' products [HD82/HD8200 and HD83/HD8300] that were offered for sale before the '388 Patent was filed." Dkt. No. 22 at 2-3. Regarding Count 7 (Infringement of the '569 Patent), Defendants argue that the claims are anticipated because Maxell has accused the GT1080HDRx projector of infringing Claim 1, and the GT1080HDRx projector is "similarly applicable to Defendants' products [EH501 and W316] that were offered for sale before the '569 Patent was filed." Dkt. No. 24 at 2-3. Though the parties' briefing and Maxell's complaint focus on Claim 4 of the '388 Patent and Claim 1 of the '569 Patent, Defendants assert that any other '388 Patent and '569 Patent claim would be anticipated for the same reasons. Dkt. Nos. 22, 24 at 3.

Defendants' invalidity arguments are premature on a motion to dismiss. As noted above, invalidity is an affirmative defense that a defendant has the burden of proving by clear and convincing evidence. *Design Ideas, Ltd. v. Target Corp.*, No. 20-CV-3231, 2021 WL 6058698, at *2 (C.D. Ill. Dec. 21, 2021) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008)). A plaintiff is not required to "plead around" affirmative defenses, *Hyson USA, Inc. v. Hyson 2U, Ltd.*, 821 F.3d 935, 939 (7th Cir. 2016), so it is usually inappropriate to dismiss a claim under Rule 12(b)(6) on the basis of an invalidity defense. *Id.* (citing *Midwest Innovative*

Prod., LLC v. Kinamor, Inc., No. 16-CV-11005, 2017 WL 2362571, at *5 (N.D. Ill. May 31, 2017)). The only exception to this general rule applies when "the allegations of the complaint. . . set forth everything necessary to satisfy the affirmative defense." *Id.* (quoting *United States v. Lewis*, 411 F.3d 838, 842 (7th Cir. 2005)). "In other words, 'the plaintiff must affirmatively plead himself out of court.'" *Id.* (quoting *Hyson USA*, 821 F.3d at 939 (quoting *Chi. Bldg. Design v. Mongolian House, Inc*., 770 F.3d 610, 613 (7th Cir. 2014))).

Here, Maxell has not pleaded itself out of court. *Id.* Maxell's complaint does not allege the prior art models relied upon by Defendants in their motions to dismiss disclose each and every limitation claimed in the '388 and '569 Patents. *See Natera, Inc. v. Inivata, Inc*., No. CV 21-56, 2022 WL 767529, at *3 (D. Del. Mar. 14, 2022).

For example, Count 6 (Infringement of the '388 Patent)[4] accuses 4K UHD-compatible projectors and not prior art projectors which do not support 4K UHD video. Dkt. No. 1 (hereinafter "Compl."), ¶¶ 357 (accusing Defendants' 4K UHD-compatible projectors that perform Retinex processing "to improve the video performance when displaying modern 4K UHD video" and alleging "Defendants' PureMotion process for modern 4K UHD video has been adapted to perform sophisticated frame-interpolation and advanced motion control processing to eliminate motion blurring or image judder when displaying modern 4K UHD video involving high-speed action sequences"); 361 (alleging "Defendants' PureDetail/UltraDetail has been adapted to perform sophisticated motion adaptive edge enhancement algorithms to provide sharp pictures when displaying modern 4K UHD video"). While it is not clear what the significance of 4K UHD versus

[4] The '388 Patent is directed to a video display device that includes hardware arrangements for performing an improved type of "Retinex" processing on video input. Dkt. No. 1, Ex. J at 3:60-65. The complaint asserts Defendants infringe one or more claims of the '388 Patent, including at least Claim 4, by making, using, importing, offering for sale, and/or selling projectors that are 4K UHD capable, including Optoma model numbers UHZ65LV, ZK507-W, UHD55, and UHZ55 (the "'388 Accused Products"). Dkt. No. 1, ¶ 348.

standard-definition or traditional high-definition video is, it is undisputed that Maxell has not accused the prior art projectors Defendants are relying on in their motion. *See* Dkt. No. 39 at 5 (Maxell stating it "is undisputed that the '388 Accused Products are not the same models as the products Defendants rely on as previously sold, and they are also not in the same category as the '4K UHD projectors' accused").

Similarly, Count 7 (Infringement of the '569 Patent)[5] accuses Defendants' lamp projectors that perform image correction based on detected voltage between electrodes of the discharge lamp by a "lamp driving unit" that drives the discharge lamp as a light source and does not accuse Defendants' prior projectors that either do not contain the specific discharge lamp requirements of the '569 Patent or do not contain the claimed lamp driving unit that performs specific image correction based on voltage between electrodes of those discharge lamps. *See* Dkt. No. 1, ¶¶ 398 ("On information and belief, each of the remaining '569 Accused Products is a projection-type image display device including a discharge lamp as a light source."); 399 ("Each of the '569 Accused Products includes a lamp driving unit configured to drive the discharge lamp."); 402 ("Each of the '569 Accused Products includes a lamp voltage detection unit configured to detect a voltage between electrodes (hereinafter, a lamp voltage) of the discharge lamp."); 403-04 (alleging the "GT1080HDRx projector includes one or more processors that detect a voltage between electrodes of the discharge lamp" and further alleging "the lamp ballast in the GT1080HDRx projector includes one or more processors (annotated in red below) mounted on a circuit board and configured to detect a voltage between electrodes of the discharge lamp"). Again, it is undisputed

[5] The '569 Patent is directed to a projection-type image display device that processes image correction based on voltage detected from its discharge lamp. Dkt. No. 1, Ex. K at 2:14-26. The '569 Accused Products include at least Optoma model numbers EH401, HD30LV, UHD38x, 4K400x, 4K400STx, UHD55, UHD35x, UHD35STx, UHD50X, EH412x, EH340UST, HD39HDR, EH412STx, HD39HDRx, GT1080HDR, GT1080HDRx, EH335, HD146X, DH351, HD28HDR, GT5600, EH200ST, W340UST, W400LVe, W319ST, H190X, W309ST, GT780, GT770, X400LVe, X309ST, and S336. Compl., ¶ 395.

that Maxell has not accused the prior art projectors Defendants are relying on in their motion. *See* Dkt. No. 40 at 5 (Maxell stating it "has not accused Defendants' discontinued projectors that do not support modern video enhancement technology based on different discharge lamps and lamp driving hardware").

To go beyond the statements in the complaint, Defendants rely on the *Vanmoor* exception in support their invalidity theory. *See* Dkt. Nos. 22, 24 at 5 (citing *Vanmoor* in the applicable legal principles sections of their motions). There are two problems with Defendants' reliance on *Vanmoor*. First, *Vanmoor* was decided at summary judgment rather than at the motion to dismiss stage. *Vanmoor*, 201 F.3d at 1364. To rely on the material attached to Defendants' motions to dismiss would require converting them to summary judgment motions, which the undersigned is not willing to do at this stage in the proceeding. *See Midwest Innovative*, 2017 WL 2362571, at *5 ("Resolving this invalidity defense requires analyzing matters outside the pleadings and on the merits, and therefore is not amenable to resolution on a Rule 12(b)(6) motion."); *see also Avanos Med. Sales L.L.C. v. Medtronic Sofamor Danek USA, Inc*., No. 2:19-CV-02754-JPM-tmp, 2020 WL 7866190, at *4 (W.D. Tenn. July 21, 2020) (stating any claims for anticipation in the prior art would be appropriate for a motion for summary judgment, not a motion to dismiss).[6]

Second, there was no dispute in *Vanmoor* that the accused product was identical to the prior art because the prior art was the product accused of infringement. *See Inline Connection*, 684 F. Supp. 2d at 514 (citing, among other cases, *Vanmoor*, 201 F.3d at 1364-66). As the court in *Inline Connection* explained, "[t]hose cases [including *Vanmoor*] do not support EarthLink's

[6] Defendants argue the documents attached to their motions "use the same language as the documents cited and relied on in the Complaint" so the motions to dismiss do not need to be converted to motions for summary judgment pursuant to Rule 12(d). Dkt. Nos. 49, 50 at 1. This is unpersuasive. As urged by Maxell, Defendants cite no authority holding the court can consider new material not cited in or attached to the complaint just because the new material may use the "same language" as documents cited in the complaint. Dkt. No. 52 at 1-2; Dkt. No. 53 at 2 (stating the declarations of Jia-Lin Chen and product reviews contain "statements wholly unlike anything in the Complaint").

position that they stand for the proposition that 'when the defendant alleges that the prior art is the same as the accused technology, the defendant need only prove that the prior art reference is materially identical to the accused device to prove invalidity.'" *Id*.

Unlike *Vanmoor*, there is no dispute here that the complaint has not accused the same models that Defendants rely on as previously sold. Rather than argue the products are identical, Defendants argue the HD82 and HD83 "incorporate the same technologies" upon which Maxell bases its infringement allegations in connection with the UHZ65LV, and the EH501 and W316 "incorporate the same technologies" upon which Maxell bases its infringement allegations in connection with the GT1080HDRx. Dkt. Nos. 22, 24 at 3. However, Maxell identifies a number of differences between the prior art and accused projectors that purportedly show they are not "materially identical" to each other. Dkt. No. 39 at 9-10 (stating the complaint accuses projectors that implement "Defendants' PureEngine functionalities, including Defendants' PureMotion process for modern 4K UHD video [which] has been adapted to perform sophisticated frame-interpolation" and "Defendants' PureDetail / UltraDetail [which] has been adapted to perform sophisticated motion adaptive edge enhancement algorithms to provide sharp pictures when displaying modern 4K UHD video" but none of the alleged prior-art projectors include the capability to display images in modern 4K UHD video and further stating the hardware and software technology included in these products marketed as "PureMotion" and "PureDetail / UltraDetail" has evolved in order to be "adapted" for "modern 4K UHD video involving high-speed action" that is found in the '388 Accused Products but not in the HD82 or HD83 devices); Dkt. No. 40 at 11-21 (stating the complaint accuses certain projection-type image display devices that include a discharge lamp as a light source, including specific lamp projectors by Defendants that perform image correction based on detected voltage between electrodes of the discharge lamp

by a "lamp driving unit" that drives the discharge lamp and further stating the hardware and software technologies included in these products that include the lamp driving hardware that performs image correction based on voltage between electrodes of certain discharge lamps is only found in the '569 Accused Products); *see also* Dkt. No. 52 at 2 (stating Defendants have not alleged the video processing software in their projectors has remained materially unaltered for more than a decade nor provided technical expert opinions on the differences in functionality and hardware in the prior art and accused products); Dkt. No. 53 at 1 (stating Defendants provide no technical detail of how the allegedly equivalent prior art products are configured or why the differences in components and functionality identified by Maxell are immaterial).

Defendants respond that these are only "cosmetic and insignificant differences," and then appear to shift any remaining burden by asserting *Maxell* "does not satisfactorily explain how these differences are material to the invalidity analysis." Dkt. Nos. 49, 50 at 1. To do so, Defendants rely on *FMC Techs., Inc. v. OneSubsea IP UK Ltd*., 412 F. Supp. 3d 706, 714 n. 9 (S.D. Tex. 2019) for the proposition that their burden is satisfied by the allegations in the complaint that the "materially identical" accused devices infringe the patents. Dkt. Nos. 49, 50 at 1-2. However, *FMC Technologies* is distinguishable for the same reasons *Vanmoor* is distinguishable. The patentee in that case did not contest that the two versions at issue were "materially the same." *FMC Techs.*, 412 F. Supp. 3d at 714. What is more, in applying the *Vanmoor* exception in *FMC Technologies*, 412 F. Supp. 3d at 714, n. 9, the court did so in the context of summary judgment briefing, not in the context of a motion to dismiss. *See id.* at 715 (finding sufficient summary judgment evidence to satisfy the "commercial sale or offer for sale" element of the on-sale bar for purposes of 35 U.S.C. § 102(a)(1)).

"[T]he purpose of a motion under Federal Rule 12(b)(6) is to test the formal sufficiency of the statement of the claim for relief; the motion is not a procedure for resolving a contest between the parties about the facts or the substantive merits of the plaintiff's case." *Midwest Innovative*, 2017 WL 2362571, at *2 (quoting 5B Wright & Miller Fed. Practice & Procedure Civil § 1356 (3d ed.)). Defendants' invalidity defense does not seek to test whether Maxell has stated a claim for relief. Instead, Defendants' motions to dismiss seek to introduce materials outside the pleadings to resolve invalidity based on anticipation—a matter typically resolved at a later stage of litigation.[7] *Id.*; *see also id.* at *5.

In two motions to dismiss with hundreds of pages of attached datasheets, specifications, manuals, user reviews, and two declarations from an employee of Defendant Coretronic, Defendants ask the Court to find, at this early stage of litigation, that products having different model numbers, different components, and different release dates are the same as those accused by Maxell—all without the benefit of discovery or claim construction. Defendants also ask this Court to rule that the hardware and software included in these products have not evolved in over a decade—again, without the benefit of discovery or expert witness testimony. Defendants argue that additional discovery would be unnecessary" because the documents "speak for themselves and make clear that the relevant technology is the same across the prior art and accused devices." Dkt. Nos. 49, 50 at 1. However, without fact discovery, expert discovery, and claim construction, the issue of prior art product invalidity cannot fully or fairly be evaluated at this stage.

[7] Regarding Count 6, Maxell argues "there are genuine issues of (pled) facts concerning whether the '388 Patent claims asserted against Defendants' modern 4K Projectors that support 4K UHD video involving high-speed action are anticipated by products that are compatible only with older standard definition or 1080 high definition video projectors." Dkt. No. 39 at 2. Maxell similarly argues regarding Count 7 that "there are genuine issues of (pled) facts concerning whether the '569 Patent claims asserted against Defendants' projectors with modern video enhancement technology based on different discharge lamps and lamp driving hardware are anticipated by products that implement allegedly similar techniques against older video projector products." Dkt. No. 40 at 2.

Defendants' invalidity theory may be the subject of evidentiary proceedings as this case moves forward, but it does not provide a meritorious basis on which to dismiss Maxell's claims of infringement. *See Natera*, 2022 WL 767529, at *3. The undersigned recommends Defendants' Rule 12(b)(6) motions to dismiss based on anticipation under 35 U.S.C. § 102(a)(1) be denied.

IV. RECOMMENDATION

Based on the foregoing analysis, it is hereby

RECOMMENDED that Defendants' Motion to Dismiss Count 6 of Plaintiff's Complaint for Failure to State a Claim Under Fed. R. Civ. P. 12(b)(6) (Dkt. No. 22) and Defendants' Motion to Dismiss Count 7 of Plaintiff's Complaint for Failure to State a Claim Under Fed. R. Civ. P. 12(b)(6) (Dkt. No. 24) be **DENIED**.

Objections

Within fourteen (14) days after service of the magistrate judge's report, any party must serve and file specific written objections to the findings and recommendations of the magistrate judge. 28 U.S.C. § 636(b)(1)(C). In order to be specific, an objection must identify the specific finding or recommendation to which objection is made, state the basis for the objection, and specify the place in the magistrate judge's report and recommendation where the disputed determination is found. An objection that merely incorporates by reference or refers to the briefing before the magistrate judge is not specific.

Failure to file specific, written objections will bar the party from appealing the unobjected-to factual findings and legal conclusions of the magistrate judge that are accepted by the district court, except upon grounds of plain error, provided that the party has been served with notice that such consequences will result from a failure to object. *See Douglass v. United Servs. Auto. Ass'n*,

79 F.3d 1415, 1417 (5th Cir. 1996) (en banc), *superseded by statute on other grounds*, 28 U.S.C. § 636(b)(1) (extending the time to file objections from ten to fourteen days).

SIGNED this the 16th day of May, 2025.

J. Boone Baxter
UNITED STATES MAGISTRATE JUDGE