

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2024-00717

U.S. Patent No. 11,223,757

PATENT OWNER'S SUR-REPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	CLAIM CONSTRUCTION	1
	A. “first camera arranged on a same side of the touch display” / “first camera being arranged on the same face side of a touch display” and “second camera arranged on an opposite side of the touch display” / “second camera being arranged on an opposite side of the touch display”	1
	B. Claim Limitation [1i]	1
III.	GROUND 1: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-8 AND 10-11 ARE RENDERED OBVIOUS BY THE COMBIANTION OF CHINN, TAKAHASHI, AND EX-V7	2
	A. The Combination of Chinn, Takahashi, and EX-V7 Fails to Render Obvious Claim Element [1.i].....	2
	1. Chinn Does Not Disclose A Voice Command For Enabling The First Camera And Disabling The Second Camera	2
	2. The Plain Reading Does Not Require A Recitation Of The Preferred Embodiment	4
	3. The Plain Reading Does Not Render Claim 2 Superfluous	5
	4. Chinn Does Not Disclose A First Standby Time That Is Longer Than A Second Standby Time	7
	B. Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claim Elements [1.g] and [1.j].....	8
IV.	GROUND 3: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-3 AND 7-10 ARE RENDERED OBVIOUS BY THE COMBINATIONS OF KIM, YAMAMOTO, AND THORN	9
	A. Kim, Yamamoto, And Thorn Do Not Render Obvious Claim Element [1j].....	9
V.	CONCLUSION.....	10

PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
1st Amended Docket Control Order from District Court Litigation	2001
Original Docket Control Order from District Court Litigation	2002
Maxell's Supplemental Preliminary Election of Asserted Claims	2003
Defendants' Preliminary Election of Prior Art	2004
Declaration of Dr. Jacob O. Wobbrock	2005
Claim Construction Order (EDTX)	2006
Deposition of R. Michael Guidash (February 17, 2025)	2007

I. INTRODUCTION

Even in their Reply, Petitioners fall short. In attempting to dismiss the plain and ordinary reading of the claims, Petitioners stretch their own arguments and interpretations too far. Accordingly, the Reply does not correct the failure of the Petition to demonstrate that claims 1-11 are unpatentable and the claims should be confirmed as patentable over the prior art references cited therein.

II. CLAIM CONSTRUCTION

A. “first camera arranged on a same side of the touch display” / “first camera being arranged on the same face side of a touch display” and “second camera arranged on an opposite side of the touch display” / “second camera being arranged on an opposite side of the touch display”

Petitioners seemingly raise a claim construction issue without offering a specific construction but instead “adopt this apparent construction for the purposes of this Petition.” Pet., 6; Reply, 2. Nor do Petitioners contest the Patent Owner’s assertion that the plain and ordinary meaning should apply here. Accordingly, Patent Owner agrees that the Board need not construe these terms.

B. Claim Limitation [1i]

Patent Owner disagrees that the POR sets forth a claim construction. Rather, as explained below and in the POR, Petitioners ignore the antecedent basis based on a plain and ordinary reading of the claim as informed by the claim as a whole. See, *e.g.*, POR, 9-10; EX2005, ¶78.

III. GROUND 1: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-8 AND 10-11 ARE RENDERED OBVIOUS BY THE COMBINATION OF CHINN, TAKAHASHI, AND EX-V7

Petitioners have failed to show by a preponderance of the evidence that Chinn in view of Takahashi and EX-V7 teaches each and every element of claims 1-8 and 10-11. Specifically, the Reply does not cure the deficiencies identified by Patent Owner in the combination of Chinn, Takahashi, and EX-V7.

A. The Combination of Chinn, Takahashi, and EX-V7 Fails to Render Obvious Claim Element [1.i]

1. Chinn Does Not Disclose A Voice Command For Enabling The First Camera And Disabling The Second Camera

As a defense to the glaring inadequacies in Chinn, Petitioners seek to create misdirection, accusing Patent Owner of improperly construing claim limitation [1.i]. However, Petitioners' allegations of claim construction demonstrate a failure to read the claim limitations in context. As demonstrated in the POR and explained by Dr. Wobbrock, the claim language clearly traces the antecedent basis for "the first instruction" in element [1.j] to "the command voice giving a first instruction" in element [1.g]. POR, 9-10; EX2005, ¶78. At the same time, the antecedent basis for "the first standby time" in element [1.j] comes from "a first standby time of a case where the first camera is enable and the second camera is disabled" in element [1.i]. *Id.* As a result, claim 1 requires that the command voice enables the first camera and disables the second camera. *Id.*

It is Petitioners who misconstrue the claims. With respect to element [1i], Petitioners suggest that “a case where the first camera is enabled and the second camera is disabled” should be read as “a case where the first camera is already enabled and the second camera is already disabled.” Reply at 6 (emphasis added). This disregards the plain meaning that the first camera becomes enabled and the second camera becomes disabled. EX1014, 53:16-22. As made evident from reading the entire claim, the claimed image recording device receives input, such as the command voice ([1g]) or the touch operation instruction ([1h]), and then responds by starting a recording using the associated camera and image signals. Such is also the case in [1i], where the first or second standby time is determined based on the camera is being used, which is determined based on whether a command voice or touch operation instruction is received. Under Petitioners’ interpretation, there is no link between the standby time, camera, and type of input. Instead, Petitioners divorce the functionality described in the initial limitations of the claim from the implementation described in the latter limitations.

Petitioners attempt to address the plain reading by introducing the theory that “Chinn’s command voice sets the timer (e.g., 10 seconds) and then ‘proceeds ... to camera activation.’” Reply at 16. This new theory is not only absent from the grounds set forth in the Petition (see Pet., 26-27), but also stretches Chinn beyond what is stated in the reference. For example, Chinn paragraph 27—which is not cited

in the discussion of element [1g] in the Petition—states:

In some embodiments, camera control system 175 may output audible notifications by speaker 140 when responding to commands by affirming that a command is executed. For example, **in response to a “set timer: 10 seconds” command**, camera control system 175 may output an audible notification by speaker 140 such as “timer set”, and **camera control system 175 may then proceed to output an audible countdown to camera activation.**

EX1004, ¶[0027] (emphases added). The command voice given in Chinn is limited to setting a timer that has no connection to which camera is to be enabled. In contrast, the single command voice in claim 1 enables the first camera, disables the second camera, and initiates a first standby time. EX2005, ¶80. Thus, Chinn does not disclose the claimed voice command.

2. *The Plain Reading Does Not Require A Recitation Of The Preferred Embodiment*

All Petitioners have done is provide a wandering and slanted explanation that the claims do not directly and precisely follow the operational flow set forth in Figure 10. *See* Reply, 7-13. This is not a basis to disregard the actual claim language. Rather than “reading out the embodiment,” Petitioners would require the impossible: “If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims.” *SRI Int’l v.*

Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121 (Fed. Cir. 1985). Further, “[i]t is the claims that measure the invention.” *Id.* (citing *Aro Mfg. Co., Inc. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336, 339 (1961)). Petitioners’ analysis of the specification and Figure 10 should be given no weight. Particularly where the “law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention.” *Id.*

3. *The Plain Reading Does Not Render Claim 2 Superfluous*

Petitioners’ skewed reading of the ’757 Patent continues into claim 2. The natural reading of claim 2 is narrower than claim 1. Independent claim 1 describes two cases where different cameras as enabled or disabled. Claim 2 describes an addition case—an additional functionality—required by the image processing device. For example, as explained by Dr. Wobbrock, claim 2 describes a third case where the first camera is enabled and the second camera is not considered. *See* EX1015, 54:7-55:2. Thus, the scope of claim 2 encompasses a device with more capabilities than claim 1 and is narrower.

Should the Board agree with Petitioners, then Petitioners have demonstrated a hole in their own Petition because the Petition fails to demonstrate that Chinn discloses claim 2. For example, the Petition relies on Chinn’s disclosure of a “set timer: 10 seconds” command as activating the camera, “which may be the front

camera.” Pet., 31. However, Chinn uses “activate the camera” to refer to image capture. *See, e.g.*, EX1004, ¶[0027] (“claim 1 uses in response to a “set timer: 10 seconds” command, camera control system 175 may output an audible notification by speaker 140 such as “timer set”, and camera control system 175 may then proceed to output an audible countdown to camera activation”). In contrast, Petitioners agree the claims of the ’757 Patent use the term “enable” and “disable” to describe activating and deactivating specific cameras. *See, e.g.*, Pet. at 29 (“A POSITA would have understood that the need to **activate** the front camera means that it was previously **disabled**” (emphases added)); EX1003, ¶100. The claims separately describe capturing an image as done by a recorder: “the recorder starts a recording of the first image signal” ([1g]) and “the recorder starts a recording of the second image signal” ([1h]). Thus, at best Chinn discloses limitation [1g] under Petitioners’ interpretation, which precludes a disclosure of claim 2, which Petitioners allege requires a narrower claim scope yet while relying on the same evidence. Accordingly, Petitioners have not shown that Chinn discloses that “the first camera is **enabled** in accordance with the command voice” separately from starting a recording of the first image signal.

4. *Chinn Does Not Disclose A First Standby Time That Is Longer Than A Second Standby Time*

Regarding Patent Owner's explanation that Chinn does not disclose a first standby time that is longer than a second standby time because the length of time is set by the user (see POR, 19-20; EX2005, ¶92), Petitioners' dismissal of the explanation further demonstrates their inability to identify the claimed functionality in the prior art references.

For example, Petitioners assert that "nothing in the broad claim language precludes the controller from using a standby time entered by the user." Reply, 17. However, Petitioners' depiction of the claim language ignores "a controller" ([1f]), "wherein **the controller is configured to: ... control** such that a first standby time ..." ([1i]). Reply, 18 (emphasis added). Petitioners further add that "even when a user enters a standby time, the controller is still controlling the various components of the system..." *Id.* However, Dr. Wobbrock explained that "it is the controller that provides for the longer first standby time in comparison to the second standby time, not the user" (EX2005, ¶93) and "the controller controls the standby time based on the method of input (*i.e.*, voice or touch) and which camera is enabled (front or rear)." EX2005, ¶95 (citing EX1001, 6:42-45, 9:42-47, 12:12-19). Petitioners unsupported attorney argument does not outweigh the clear claim language and the analysis provided by Patent Owner and its expert.

B. Chinn, Takahashi, and EX-V7 Do Not Render Obvious Claim Elements [1.g] and [1.j]

The Reply fails to cure Petitioners' failure to meet their burden in showing the "first standby time is a time from a recognition of the first instruction to a start of the recording of the first image signal" and the "second standby time is a time from a recognition of the second instruction to a start of the recording of the second image signal." See Reply, 15-16. As explained in the POR, Chinn discloses providing separate instructions for setting a timer, activating a camera, and taking a picture. See POR, 11-12; EX1004, Fig. 3 (showing UI 300 having "take the picture" setting 302 different from "start 3 sec ready countdown" setting 303 and "start the timer" setting 304); *id.*, Fig. 4 (showing UI 400 having "take [1/2] photo[s]" settings 401 and 402 different from "Start timer length" settings 411, 412, 413, and 414); EX2005, ¶99. As explained above, the Petition fails to set forth the claimed "first instruction" that is required by claim elements [1.g] and [1.j] because, even if an instruction of setting a timer begins a standby time in Chinn, Chinn does not disclose starting "a recording of the first image signal . . . on the storage in response to the first instruction," where Chinn requires a second separate instruction to activate a camera, let alone begin recording of an image signal by the camera. EX2005, ¶99.

Thus, Petitioners have not shown by a preponderance of the evidence that claim elements [1.g] and [1.j] are met by the Chinn-Takahashi-EX-V7 combination.

IV. GROUND 3: PETITIONERS HAVE FAILED TO ESTABLISH THAT CLAIMS 1-3 AND 7-10 ARE RENDERED OBVIOUS BY THE COMBINATIONS OF KIM, YAMAMOTO, AND THORN

A. Kim, Yamamoto, And Thorn Do Not Render Obvious Claim Element [1j]

Claim [1j] requires “wherein the first standby time is a time from a recognition of the first instruction to a start of the recording of the first image signal acquired by the first camera, and the second standby time is a time from a recognition of the second instruction to a start of the recording of the second image signal acquired by the second camera.” None of the Petition, Reply, or Mr. Guidash are able to identify disclosure in Kim or Yamamoto a time from a **recognition** of the first instruction to the start of the recording of the first image signal, as claimed.

In their Reply, Petitioners point to Yamamoto’s disclosure of “an image is captured after a certain period of time (for example, 0.5 seconds) passes after ... ‘Say Cheese’ or the like has [been] uttered.” Pet., 76 (quoting EX1009, ¶249). However, Yamamoto only discloses a time from utterance to a time when an image is captured. What is not set forth in Yamamoto is any timing dedicated to the **recognition** of the utterance. Accordingly, each and every limitation is not set forth in Yamamoto. *See* EX2005, ¶127.

For the additional arguments raised in the POR, Petitioners do not provide a fulsome response beyond challenging the arguments as claim constructions. Reply,

19. Accordingly, Kim, Yamamoto, and Thorn do not render the claims obvious.

V. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of Claims 1-11.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of June, 2025, a copy of the attached PATENT OWNER'S SUR-REPLY, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Patent Owner Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Patent Owner Response indicates that the Patent Owner Response contains 2,203 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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