

**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 REQUEST FOR AUTHORIZATION TO FILE
MATERIALS FROM RELATED MATTERS**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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
Oral Hearing Demonstratives	2008
U.S. Patent No. 12,284,437	2009
U.S. Patent No. 12,284,437 file history	2010

Patent Owner files this request for authorization to file additional materials, pursuant to Paper 28 and pursuant to that Order: (1) identifies the additional materials; (2) explains how and why the additional materials are related to the patent claims being challenged in this proceeding, or substantially similar claims, that have been previously adjudicated, post-issuance, before the Office, in district court, or at the U.S. International Trade Commission (ITC); and (3) explains how and why the additional materials should be considered in this proceeding.

Pursuant to the request made in the email from the parties dated September 26, 2025 and in response to the General Order (Paper 27) Patent Owner seeks authorization to submit related U.S. Patent No. 12,284,437 (EX2009) and file history (EX2010) illustrating the Office's prior consideration of prior art from the Petition, for example, Chinn, Kim, Takahashi, Yamamoto, and EX-V7 User Guide.

The General Order states that the “parties must keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims, **or substantially similar patent claims**, such as claim construction, findings of fact, or conclusions of law, in ‘any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.’” Paper 27 (emphasis added). The General Order makes clear that the Board must also be updated on any findings of substantially similar claims by the Office.

(1) identify the additional materials

Patent Owner identifies the additional materials as related U.S. Patent No. 12,284,437 (EX2009) and file history (EX2010).

(2) explain how and why the additional materials are related to the patent claims being challenged in this proceeding, or substantially similar claims, that have been previously adjudicated, post-issuance, before the Office, in district court, or at the U.S. International Trade Commission (ITC);

U.S. Patent 12,284,437 addresses substantially similar patent claims as the claims being challenged in the '757 Patent. For example, like the '757 Patent, claim 1 of 12,284,437 recites “a start of the recording of the first image signal acquired by the first camera after the first camera is enabled and the second camera is disabled is longer than a second standby time.” EX2009, claim 1. Thus both the '437 Patent and the patent challenged in this proceeding recite the first camera is enabled and second camera is disabled limitation that is currently in dispute.

(3) explain how and why the additional materials should be considered in this proceeding.

The file history of the '437 Patent should be considered in this proceeding because the prior art forming the basis of the Petition in this case was also considered by the Examiner in allowing substantially similar claims.

In a non-final rejection on May 21, 2024, the Examiner rejected the claims for nonstatutory double patenting and under Section 103:

4. Claims 1-7 are rejected under 35 U.S.C. 103 as being unpatentable over Desai (US PG PUB 2013/0328997) in view of Konicek (US PG PUB 2007/0086764).

Regarding claim 1, Desai discloses an image recording method of an image recording device configured to execute a plurality of different photographing processes, comprising the steps of:

photographing an object and acquiring an image signal by a first camera or a second camera, the first camera being arranged on the same face side of a touch display and configured to acquire a first image signal (see figure 3A camera 127A and paragraphs 0049-0050), the second

EX2010 at 105.

In an IDS on September 23, 2024, the Applicant disclosed Chinn (2014/0247368), Kim (2010/0137026), Takahashi (JP2001305642A), Yamamoto (2010/0026815), and EX-V7 User Guide:

1	20100026815	A1	2010-02-04	YAMAMOTO
2	20140247368	A1	2014-09-04	CHINN

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4	20100137026	A1	2010-06-03	KIM
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Id. at 139.

1	2001-305642	JP	A	2001-11-02	FUJI PHOTO FILM CO., LTD.
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Id. at 140.

11	Casio Exilim EX-V7 Users Guide
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Id. at 142; *see also* 179-182 (noting all references considered except where lined through).

In response to the Office Action, the Applicant explained why the rejections were overcome:

Therefore, the attempted combination of Desai and Konicek fails to disclose or suggest all of the limitations of claim 1. In particular, the attempted combination of Desai and Konicek fails to disclose or suggest “performing control such that a first standby time between a recognition of the first instruction and a start of the recording of the first image signal acquired by the first camera after the first camera is enabled and the second camera is disabled is longer than a second standby time between the recognition of the second instruction and a start of the recording of the second image signal acquired by the second camera after the second camera is enabled and the first camera is disabled.”

As such, Applicant submits that claim 1 and the claims depending therefrom are patentable.

Id. at 166.

On December 27, 2024, the claims were allowed. *Id.* at 167.

This additional information should be considered in connection with Patent Owner’s arguments that Chinn does not disclose a voice command for enabling the first camera and disabling the second camera and that it would also not be obvious in view of Takahashi and EX-V7.

As such Patent Owner respectfully requests authorization to file U.S. Patent No. 12,284,437 (EX2009) and file history (EX2010).

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Dated: October 8, 2025

Respectfully submitted,

/Robert G. Pluta /

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CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of October, 2025, a copy of the attached PATENT OWNER'S REQUEST TO FILE MATERIALS FROM RELATED MATTERS together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
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With a courtesy copy by electronic mail to:

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Respectfully submitted,

Date: October 8, 2025

By: /Robert G Pluta Reg No 50970/
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