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

Inter Partes Review No.: IPR2024-00717
U.S. Patent No. 11,223,757

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR AUTHORIZATION TO FILE MATERIALS FROM RELATED MATTERS

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PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,223,757
1002	File History of U.S. Pat. 11,223,757
1003	Declaration of R. Michael Guidash
1004	U.S. Patent Publication No. 2014/0247368 ("Chinn")
1005	Certified translation of Published JP Application JP2001305642A ("Takahashi"), which is referred to in EX1006
1006	Translator Certification by Sarah Dunham of Lango Translations dated February 23, 2024 for JP2001305642A, including the Japanese language version of JP2001305642A
1007	U.S. Patent No. 8,957,981
1008	U.S. Patent Publication No. 2010/0137026 ("Kim")
1009	U.S. Patent Publication No. 2010/0026815 ("Yamamoto")
1010	Declaration of Nathaniel E. Frank-White
1011	U.S. Patent Publication No. 2009/0167881 ("Thorn")
1012	Appendix 4 to Patent Owner's March 7, 2024 Corrected Infringement Contentions
1013	U.S. Patent Publication No. 2013/0124207 ("Sarin")
1014	Casio Exilim EX-V7 Users Guide ("EX-V7")
1015	Transcript of the March 28, 2025 Deposition of Dr. Wobbrock
1016	Petitioner's Demonstratives
1017	May 2, 2025 Order (5:23-cv-92-RWS; EDTX)
1018	Confidential Version of May 2, 2025 Order (5:23-cv-92-RWS; EDTX) (Board and Parties Only)

I. INTRODUCTION

Patent Owner seeks to introduce a patent that issued after the Institution Decision in this IPR and its file history as allegedly supporting Patent Owner's arguments that the prior art in the IPR does not disclose or render obvious "a voice command for enabling the first camera and disabling the second camera." Req. at 5. This Request should be rejected because the claims of the patent that Patent Owner seeks to introduce do not require a voice command that enables the first camera or disables the second camera and thus do not serve the one purpose identified in the Request. This request should also be rejected because it is outside the scope of the Board's General Order because Patent Owner did not disclose the patent and its file history as a related matter.

Moreover, Patent Owner did not disclose the Institution Decision in this IPR to the examiner during prosecution of that continuation patent in clear violation of its duty of disclosure under 37 C.F.R. § 1.56. Patent Owner should not be rewarded for that failure by according any weight in this IPR to the examiner's action in connection with the continuation patent when that examiner was deprived of the Board's considered reasoning in the Institution Decision.

II. THE '437 PATENT AND FILE HISTORY ARE NOT RELEVANT TO PATENT OWNER'S STATED REASON FOR CONSIDERING THEM

Patent Owner requests authorization to submit U.S. Pat. No. 12,284,437 (the "'437 patent," EX2009) and its file history (EX2010). Req. at 2. Patent Owner

asserts that 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." Req. at 5. This argument fails because the claims of the '437 patent do not recite a voice command for enabling the first camera and disabling the second camera. (The claims of the '757 patent also do not require this limitation as explained in Petitioner's Reply at 4-14 and discussed in detail during the oral argument).

Patent Owner's Request cites claim 1 of the '437 patent in support of its argument. Req. at 2. Claim 1 recites in relevant part:

> when the audio input interface receives the command voice giving a first instruction to start a recording of an image signal in a state in which the first camera is enabled, controlling to start a recording of the first image signal in response to the first instruction
>
> 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 . . .

EX2009, 16:22-26 and 16:33-37. This claim language does not require the voice command (command voice) to enable the first camera or disable the second camera. The first limitation requires only that the first camera be in an enabled

state when the voice command is received. The second limitation requires only that the start of the recording occurs after the first camera has been enabled and the second camera has been disabled. Neither limitation requires the enabling of the first camera or the disabling of the second camera be in response to the voice command. As APJ Trock described similar limitations in the '757 patent during the oral argument in this IPR, the relationship between the voice command and the enabling/disabling of the cameras in claim 1 of the '437 patent is coincidental, not causative. Paper 25, 23:25-24:6.

Accordingly, the '437 patent and its file history are not relevant to the one reason identified in the Request for considering this information, *i.e.*, that the prior art considered during prosecution of the '437 patent does not disclose or render obvious a "voice command for enabling the first camera and disabling the second camera." Patent Owner's request should be denied for this reason alone.

III. THE '437 PATENT AND ITS FILE HISTORY ARE OUTSIDE THE SCOPE OF THE BOARD'S GENERAL ORDER.

The '437 patent and its file history should not be admitted for the additional reason that they fall outside the scope of the Board's General Order, Paper 27. Patent Owner did not identify the '437 patent as a related matter in its mandatory notices. *See* Paper 4 at 1, Paper 14 at 1. As a result, the submission of the '437 patent and its file history is outside the scope the Board's General Order, which is limited to proceedings that are "identified as a related matter under 37 C.F.R.

§ 42.8(b)(2)." Order (Paper 27) at 1. This is a second independent reason for rejecting PO's Request.

IV. PATENT OWNER'S REQUEST SHOULD BE DENIED DUE TO PATENT OWNER'S VIOLATION OF ITS DUTY OF DISCLOSURE

The '437 patent issued on April 22, 2025. EX2009, 1. That was more than five months after the November 7, 2004 Institution Decision in this IPR, in which the Board found that the Petitioner "demonstrates a reasonable likelihood of prevailing in its challenge to claims 1-11 as obvious over Chinn, Takahashi, EX-V7, and Kim (Grounds 1 and 2)." Paper 9, 52. Patent Owner did not disclose the Institution Decision to the examiner during prosecution of the '437 patent. EX2009, 1-2.

The Institution Decision is highly material information as it sets forth the Board's detailed reasoning as to why the prior art cited in the Petition establishes to a reasonable likelihood that the claims of the related '757 patent are unpatentable, which, according to the Request, are "substantially similar." Request at 2; *see also* EX2010 at 163 (double patenting rejection of '437 patent claims over claims of the '757 patent at issue in this IPR). The Board's Institution Decision here is at least as relevant as the withheld rejection of a substantially similar claim in a related application that was found to be material to patentability in *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003), or the withheld office actions rejecting claims of a related application in *Larson Manuf. Co. v. Aluminart Prods. Ltd.*, 559 F.3d 1317, 1338 (Fed. Cir. 2009). As

discussed in those cases, the rationale for an unpatentability decision can be material even when the prior art relied on in that rationale has been disclosed. The Board's finding that the rationale for the challenges in the Petition were persuasive despite patent owner's arguments to the contrary is highly material and not cumulative of the references or the Petition itself. Indeed, it is hard to imagine that an examiner would not have issued a rejection of these "substantially similar" '437 patent claims based on the references discussed in the Institution Decision if the Patent Owner had disclosed the Institution Decision to the examiner.

Patent Owner should not be rewarded for its failure to disclose the Institution Decision to the examiner during prosecution of the '437 patent by bootstrapping the examiner's allowance of the '437 patent into a basis for not finding the '757 patent claims unpatentable in this IPR. Accordingly, Patent Owner's request should be denied. Alternatively, if these materials are entered into the record, they should be given little or no weight in the Board's Final Written Determination for this IPR.

V. CONCLUSION

The Board should deny Patent Owner's request for the reasons discussed above.

Date: October 10, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on October 10, 2025, a true and correct copy of the Petitioners' OPPOSITION TO PATENT OWNER'S REQUEST FOR AUTHORIZATION TO FILE MATERIALS FROM RELATED MATTERS was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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Respectfully submitted,

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