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

IPR2024-00735

U.S. Patent No. 11,017,815

PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

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

TABLE OF CONTENTS

I. INTRODUCTION 1
II. LEGAL STANDARD 1
III. EXS2041-2044 SATISFY 37 C.F.R. § 42.123(B) 2
A. The Information Could Not Have Been Obtained Earlier 2
B. Consideration of EXS2041-2044 Is In The Interests-of-Justice 2
C. Granting PO's Motion Does Not Prejudice Petitioner And Is Consistent With Petitioner's Obligations Under 37 CFR § 42.11 3
D. No Administrative Burden Exists 4
IV. PETITIONER'S INCONSISTENT STATEMENTS 5
A. Relevance of the Supplemental Information 5
B. Petitioner's Inconsistent Statements 5

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
IPR2024-00735 & IPR2024-00777 Petitions side-by-side compare	2005
U.S. Patent No. 10,679,647	2006
U.S. Patent No. 10,199,072	2007
U.S. Patent No. 9,818,449	2008
U.S. Patent No. 9,384,783	2009
U.S. Patent No. 8,644,684	2010
U.S. Patent No. 7,613,383	2011
U.S. Patent Application No. 2007/0022382	2012
U.S. Patent No. 7,512,622	2013
U.S. Patent No. 6,480,669	2014
U.S. Patent No. 7,974,511	2015
U.S. Patent No. 7,853,893	2016
Petitioner's invalidity contentions chart in District Court—Kaplan	2017
Petitioner's invalidity contentions chart in District Court—Bryant	2018
Translation of JP 4385943B2	2019
Certificate of Accuracy for Translation of JP 4385943B2	2020
Declaration of Jacob Sharony, Ph.D.	2021
Internet Archive Web Page from Hauppauge Computer Works (8/03)	2022
Internet Archive Web Page from Hauppauge Computer	2023

Works(9/03)	
www.bricklin.com/homenetwork.htm	2024
https://www.itprotoday.com/it-infrastructure/mixing-wired-andwireless-networking-in-your-home	2025
The Benefits of Wireless Technologies (https://librarytechnology.org/document/9643)	2026
Internet Archive Web Page from Hauppauge Computer Works (10/03)	2027
Internet Archive Web Page from Hauppauge Computer Works(10/03)—Product Data Sheets	2028
Internet Archive Web Page from Hauppauge Computer Works (10/03)—Manuals	2029
TS 101 197 v1.2.1 (2002-02)	2030
Scrambling (Conditional Access System)	2031
Conditional Access (10/01)	2032
District Court Claim Construction Order	2033
Samsung Claim Construction Brief	2034
Lassalle, Broadcast Encryption	2035
Bederson Deposition Transcript (June 6, 2024)	2036
Bederson Claim Construction Declaration	2037
Bederson Deposition Transcript (January 17, 2024)	2038
User's Guide for Windows NT	2039
Declaration of Ravin Balakrishnan, Ph.D.	2040
5:23-cv-00092-RWS (E.D. Tex.), Dkt. 394	**2041**
5:23-cv-00092-RWS (E.D. Tex.), Dkt. 416	**2042**
5:23-cv-00092-RWS (E.D. Tex.), Transcript	**2043**
Demonstratives from Dr. Singh	**2044**
Email to the Board on June 5, 2025	**2045**
Jury Verdict	**2046**

I. INTRODUCTION

Patent Owner ("PO") respectfully moves to submit EXS2041-2046 as supplemental information pursuant to 37 C.F.R. § 42.123(b). The exhibits contain evidence that reasonably could not have been obtained earlier. Consideration of this evidence also is in the interests-of-justice because it demonstrates inconsistent positions taken by Petitioner regarding the meaning of the claim term "character" in the district court litigation between Petitioner and PO. PO's request was timely made, is directly related to a claim for which the trial was instituted, and if admitted, will demonstrate that Petitioner and its expert—Dr. Kia—took inconsistent positions in the litigation than it has taken during this IPR. *See Ultratec, Inc v. Captioncall, LLC*, 872 F.3d 1267 (Fed. Cir. 2017).

II. LEGAL STANDARD

A motion pursuant to 37 C.F.R. § 42.123(b) must show: (1) the supplemental information reasonably could not have been obtained earlier; and (2) consideration of the supplemental information would be in the interests-of-justice. Both prongs are met here. There is no prejudice to Petitioner and the motion meets "the very low threshold required to show that the proposed supplemental information has relevance in this proceeding . . . [the] request is timely despite the advanced stage of this proceeding, and that it would be in the interest of justice to grant the motion." *See,*

e.g., *Kingston Tech. Co., Inc. v. Spex Techs., Inc.*, IPR20217-01021, Paper 31, at 4-5 (PTAB May 29, 2018).

III. EXS2041-2044 SATISFY 37 C.F.R. § 42.123(b)

A. The Information Could Not Have Been Obtained Earlier

PO's motion is timely because the information could not reasonably have been obtained earlier. The '815 Patent was asserted in the underlying litigation. Paper 9 at 1, 13. The jury trial in that case occurred May 19-May 28, 2025. 5:23-cv-00092-RWS (E.D. Tex.). Only then did Petitioner's narrow application of its construction became explicit. *See e.g.,* EX2041. After trial concluded, PO sent an email on June 5, 2025 requesting authorization submit such information. EX2045.

Dr. Kia's "trial testimony did not exist at the time PO filed its PO Response. Thus PO could not have submitted it then." *See PNC Bank, N.A., United Services Automobile Association*, IPR2021-01070, Paper 52, at 4 (P.T.A.B. Sept. 14, 2022) (granting similar motion citing *Ultratec, Inc. v. CaptionCall, LLC,* 872 F.3d 1267, 1272 (Fed. Cir. 2017) ("That inconsistent testimony did not exist sooner and thus could not have been proffered to the Board sooner.")).

B. Consideration of EXS2041-2044 Is In The Interests-of-Justice

Inconsistent statements made by Petitioner and Petitioner's expert are germane to all asserted Grounds with respect to the meaning of "character." Thus, consideration of EXS2041-2044 are in the interests-of-justice because the evidence

involves the ***same*** patent by the ***same*** party, Samsung, regarding the ***same*** term at issue in this IPR. "This information has the potential to be highly relevant." *PNC Bank*, Paper 52, at 6 (quoting *Ultratec*, 872 F.3d at 1273 (holding that "conflicting testimony on cross-examination" is highly relevant for the Board's analysis of invalidity and credibility determinations). **The Board found this type of information highly relevant even where the testimony was given by "two different experts."** *Id*. In *Ultratec*, CaptionCall's expert testified about similar issues in both proceedings—***just like Samsung has provided admissions/statements***. Ultratec sought to introduce evidence from trial into the IPRs (just like Maxell), alleging that the evidence from trial testimony conflicted with written declarations made in the IPRs. *Id*. at 1270. The Federal Circuit determined that a "reasonable adjudicator would have wanted to review this evidence." *Id*. Allowing introduction of these admissions and inconsistencies would be in the interest of justice here, like it was in *Ultratec.*

C. Granting PO's Motion Does Not Prejudice Petitioner And Is Consistent With Petitioner's Obligations Under 37 CFR § 42.11

Petitioner is not prejudiced by admission of this information. Petitioner has known about its own positions across both proceedings; Petitioner is represented by the same counsel. Any claim of prejudice is of Petitioner's own making and any "concerns are outweighed by the relevance of potentially inconsistent testimony."

SZ DJI Tech. Co., Ltd., Autel Robotics USA LLC, IPR2019-00343, Paper 30, at 5 (PTAB Jan. 16, 2020). Indeed, this material information includes Petitioner's interpretation of the term "character" when mapping the claims to particular functionality. Thus, under 37 CFR § 42.11, Samsung **itself** has an ongoing duty of candor to disclose this material-to-patentability information to the Board. Instead, Petitioner continues to exert every effort to exclude such information. Creation of conflicting records is precisely the outcome that *Fintiv* seeks to prevent. Paper 9 at 13. Notwithstanding the *Sotera* stipulation, Petitioner set forth anticipation and obviousness defenses in front of the jury for claims 1, 21, and 24 and the jury delivered a verdict of validity. EX2046. Samsung, however, continues to move forward creating conflicting records.

D. No Administrative Burden Exists

The supplemental information is focused and concise. *See PNC Bank*, Paper 52, at 7. Indeed, *Ultratec* noted that "[t]here would have been very little administrative burden to reviewing more on-point testimony from the same expert on the same exact issues. Had the testimony been inconsistent, a reasonable fact finder would consider the inconsistencies.." *Ultratec*, 872 F.3d at 1273; *see also SZ DKI Tech*, Paper 30, at 5 (additional burden is "minimal").

IV. PETITIONER'S INCONSISTENT STATEMENTS

A. Relevance of the Supplemental Information

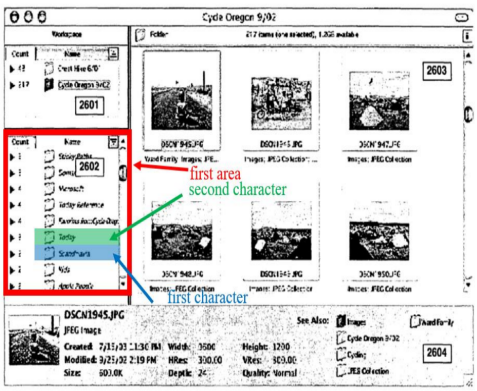
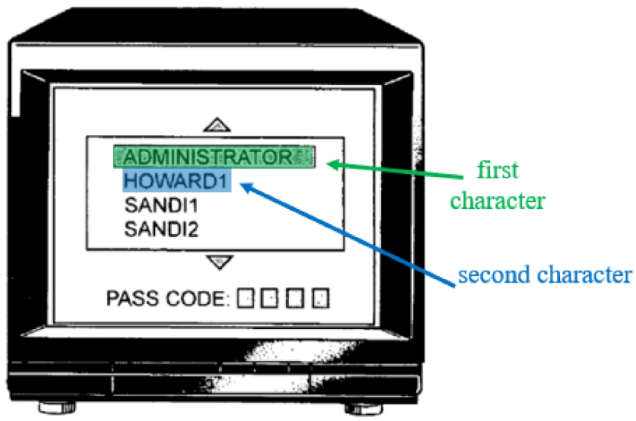
EXS2041-2044 highlight inconsistent testimony by Dr. Kia and statements by Samsung in this proceeding and at trial. These inconsistencies are highly relevant because they demonstrate why Petitioner has not shown that the prior art discloses or renders obvious the "character" limitation in every Ground of the Petition. In the litigation, Dr. Kia and Samsung asserted the "primacy" of source code in determining whether the claim element of selecting "a [first/second] character" is satisfied. EX2041 at 10-11. Petitioner further asserted that "the Character Selection limitations are not satisfied by **selecting an area of a display** because that is not a 'character.'" *Id.* (emphasis added). Here, without relying on any source code, Petitioner and its expert assert that selecting an area on the screen is sufficient to show that a character is being selected and the claim elements are met. These inconsistent positions are relevant to whether Samsung can show the claims are unpatentable by a preponderance of the evidence.

B. Petitioner's Inconsistent Statements

PO's evidence demonstrates inconsistent positions by Petitioner in the litigation regarding the meaning of the term "character," at issue in all independent claims for both IPR2024-00735 and IPR2024-00777. While Petitioner had proposed its construction of "character" requiring one unit of information during the *Markman*

process in the litigation, it was not until trial that Petitioner's narrowness in interpreting "one unit of information" became explicit.

For each Ground, Petitioner has pointed to an area of a user interface display as providing the relevant "first character" and "second character":

 735 Pet. at 38; 777 Pet. at 33	 777 Pet. at 71

Yet after briefing had concluded in these IPRs, Samsung aggressively pursued a contrary interpretation of these terms in district court. In briefing for judgment as a matter of law of noninfringement, filed July 14, 2025, Samsung argued that "character" was a *very* narrow term:

> Thus, the Character Selection limitations are **not satisfied by selecting an area of a display** because that is not a "character" . . . . This distinction was central to [Dr. Kia, Petitioner's technical expert at trial]'s noninfringement opinion, because an area is "certainly more than one unit of information, as required by Court's construction," and the absence of character-level selection is important "because that is what is required for the claim element to be satisfied." *Id.*

> […]
>
> Similarly, here, if the source code does not implement character-level selection, the Character Selection limitations are not met, regardless of what the UI appears to do.

EX2041 at 10-17 (concerning Claim 1 of the '815 Patent); *see also* EX2043 (Tr. 1001:5-12 (Dr. Kia testifying that the claim is not met "because the user selects an area of the screen rather than characters under the Court's construction"). Samsung reiterated this argument in its Reply in support of judgment as a matter of law:

> Dr. Singh's [PO's technical expert at trial] testimony at Trial Tr. at 100:19-101:21 (Opp. at 15) establishes only that the "Favorites" album has *a title* that is represented by a string of individual characters (*i.e.*, "f", "a", "v" etc.). That testimony does not address, much less show, the selection of any character in that string… Indeed, the demonstratives incorrectly equate the claimed first character with the album titles "Favorites" (PDX-7-44) and "Camera" (PDX-7-45), neither of which qualifies as a "character" as construed by the Court because they are represented to a computer by more than one unit of information. Trial Tr. at 750:20-23.

EX2042 at 7-8; *see also* EX2043 (Tr. 1003:22-1004:2 "Q. So why does a user selection on a Galaxy S23 fail to meet the Court's construction of character? A. Because the Galaxy app, when the user selects an album, **it's selecting an area**. It is

not selecting a character . . . and certainly not one unit of information.") Samsung also made the same "character" arguments for claims 21 and 24:

> Maxell failed to present any evidence that the Netflix app running on the Galaxy S23 satisfies the "character" requirement, as construed . . . [because] Dr. Singh also admitted that he did not present the Netflix source code to the jury, relying instead on the visual appearance of the Miyagi-Do icon. Trial Tr. at 764:18-22. He acknowledged that the icon is a single integrated graphical image composed of 455 pixels, each stored as three bytes of information—totaling more than a thousand bytes. Trial Tr. at 769:21-771:5. His admission contradicts the claim requirement that a "character" be represented by one unit of information. No reasonable jury could find that a 455-pixel image, represented by more than a thousand bytes, constitutes a "character."

EX2041 at 17-18 (concerning claims 21 and 24 of the '815 Patent).

For avoidance of doubt, the portions of PO's infringement proof attacked by Petitioner are shown on the left, with Petitioner's contentions with regard to Horn and Wong on the right:

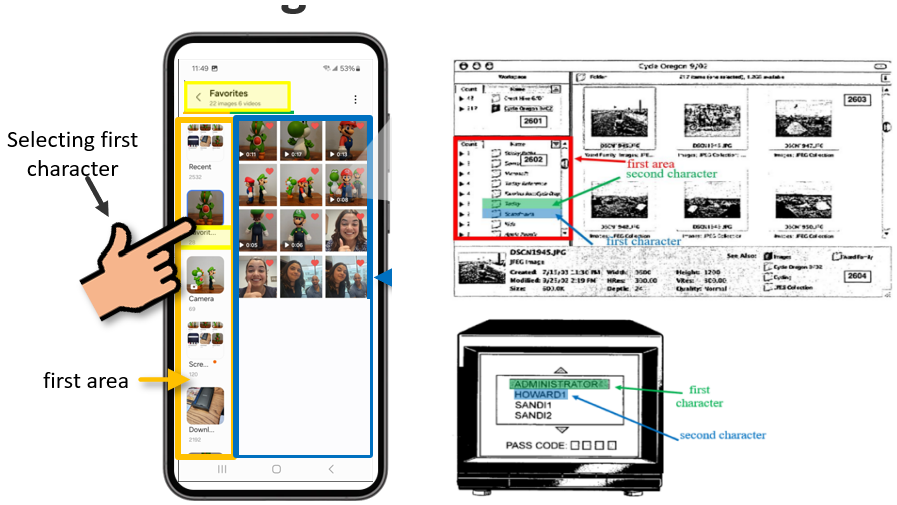


Image on left from EX2044 (showing selection of characters). Petitioner's expert—Dr. Kia—testified that selection of "Favorites" on a screen—just like the selection of green and blue highlighted text Petitioner relies upon in its Petition—does not meet the claim element because Favorites corresponds to "nine characters." EX2043 (Tr. 1005:20-1006:18). In this proceeding, beyond pointing to selection of an area on the screen, Petitioner has not provided any evidence regarding whether the source code of Horn or Wong's systems discloses selecting an area or a character.

Petitioner's shifting positions and unequivocal arguments before the District Court are a material change that must be accounted for. The burden of establishing the proper claim constructions in a Petition, and ultimately of showing invalidity under all constructions of the claim terms for a Final Written Decision, is borne by Petitioner. *See* 37 C.F.R. § 42.104(b) (requiring position by petitioner on "[h]ow the challenged claim is to be construed"); *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1377 (Fed. Cir. 2023) ("Ultimately, it is the petitioner's burden to present a clear argument" for invalidity based on the petition). Here, Petitioner has now taken contradictory positions on how the "character" terms are to be understood, which cannot carry Petitioner's burden of proof. *Id.*

Petitioner's narrow application of "character" in the District Court—requiring a single pixel or byte of information, or otherwise be a single "unit of information," requires no finding of invalidity for any claim in either IPR2024-00735 or IPR2024-

00777 based on evidence provided in the Petition. All challenged claims in both proceedings rely upon independent claims with "character" limitations. *See* claim elements [1.f], [9.d], [16.b], [21.b]. Petitioner has only pointed to the references Horn and Wong in Grounds 1-10 as meeting these limitations (*see* -735 Pet. at 37-38, 52, 66, 76-77, 93; -777 Pet. at 32-33, 45, 60, 70-73, 95), and the character aspects of Horn and Wong do not differ (at least in terms of being units of information) from the characters that Petitioner has argued do not meet the claim requirements. Petitioner and its expert have **already** taken this position in front of a jury during trial and thereafter in post-trial briefing, so Petitioner should be held to this position in this proceeding, contrary to the arguments in the Petition. Petitioner itself should have raised these issues with the Board pursuant to its duty of candor under 37 CFR § 42.11, rather than continually opposing Maxell's efforts to bring this information to the Board's attention.

Ultimately, as required by the Federal Circuit in *Ultratec*, the Board must consider the inconsistent positions of Samsung and its expert opinions set forth in a parallel district court proceeding and grant this motion. *See* 872 F.3d at 1272-73.

Dated: September 14, 2025

Respectfully submitted,

/*Robert G. Pluta* /
Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive

Chicago, IL 60606
Telephone: (312) 701-8641
rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)
MAYER BROWN LLP
1999 K Street NW
Washington, D.C., 20006
ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on this 14th day of September, 2025, a copy of the attached PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
Jim.Heintz@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

With a courtesy copy by electronic mail to:

dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: September 14, 2025 By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.