

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.: IPR2024-00735
U.S. Patent No. 11,017,815

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. PATENT OWNER’S REQUEST TO SUBMIT ADDITIONAL TRIAL MATERIALS SHOULD BE DENIED	2
III. PATENT OWNER’S REQUEST TO SUBMIT FILE HISTORIES OF RELATED PATENTS SHOULD BE DENIED	3
IV. CONCLUSION.....	4

Petitioners' Opposition to Request to File Materials from Related Matters

PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,017,815
1002	File History of U.S. Pat. 11,017,815
1003	Declaration of Dr. Benjamin Bederson
1004	CV of Dr. Benjamin Bederson
1005	U.S. Patent No. 7,275,063 ("Horn")
1006	U.S. Patent No. 7,970,240 ("Chao")
1007	U.S. Patent No. 7,650,361 ("Wong")
1008	Declaration of Nathaniel E. Frank-White
1009	<i>Fandango Media, LLC v. Maxell, Ltd.</i> , IPR2018-01432, Paper 32 (PTAB Feb. 10, 2020) ("01432FWD")
1010	WinTV Installation and Reference Manual (June 30, 1999) ("WinTV")
1011	Archived Specifications - WinTV PCI boards including the WinCast/TV and WinTV-pci (November 10, 1999) (https://web.archive.org/web/19991110153658/http://hauppauge.com:80/html/wc_data.htm)
1012	Bt848/848A/849A - Single-Chip Video Capture for PCI – Datasheet ("BT848")
1013	U.S. Patent Application Publication No. 20030174844A1 ("Candelore")
1014	U.S. Patent Application Publication No. 20010056434A1 ("Kaplan")
1015	U.S. Patent Application Publication No. 20040201691 ("Bryant")
1016	U.S. Patent Application Publication No. 20050160458A1 ("Baumgartner")
1017	Appendix 5 to PO's January 11, 2024 Infringement Contentions
1018	U.S. Patent No. 6,259,418 ("Jones")
1019	U.S. Patent No. 5,911,129 ("Towell")
1020	JP-A-2000-152180
1021	Machine Translation of JP-A-2000-152180
1022	U.S. Patent No. RE32,632 to Atkinson
1023	Brent Ethington, <i>Introducing Microsoft Windows 95</i> , Microsoft Press (1995), with authenticating declaration of Carmen Debord
1024	U.S. Patent No. 6,493,006 to Gourdol et al.
1025	Microsoft Computer Dictionary, 4th Ed., Microsoft Press (1999)

Petitioners' Opposition to Request to File Materials from Related Matters

Exhibit No.	Description
1026	James Cohoon & Jack Davidson, C++ Program Design: An Introduction to Programming and Object-Oriented Design, 3rd Ed., McGraw Hill (2002)
1027	George W. Furnas and Jeff Zacks, 1994, <i>Multitrees: Enriching and Reusing Hierarchical Structure</i> , In Proceedings of the SIGCHI Conference on Human Factors in Computer Systems (CHI 1994), Beth Adelson, Susan Dumais, and Judith Olson (Eds.), ACM, New York, NY, USA, 330-336. DOI http://dx.doi.org/10.1145/191666.191778 , with authenticating declaration of Scott Delman.
1028	U.S. Patent Application Publication No. 2004/0064476 to Rounds ("Rounds")
1029	U.S. Patent Application Publication No. 2002/0082730 to Capps et al. ("Capps")
1030	U.S. Patent No. 6,166,735 to Dom et al. ("Dom")
1031	U.S. Patent No. 5,884,056 to Steele ("Steele")
1032	U.S. Patent No. 5,442,744 to Piech et al. ("Piech")
1033	U.S. Patent Application Publication No. 2006/0107289 to DeYonker et al. ("DeYonker")
1034	Benjamin B. Bederson, 2001, PhotoMesa: A Zoomable Image Browser Using Quantum Treemaps and Bubblemaps, In Proceedings of the 14th annual ACM symposium on User Interface Software and Technology (UIST 2001), ACM, New York, NY, USA, 71-80. DOI http://dx.doi.org/10.1145/502348.502359
1035	U.S. Patent No. 6,609,253 to Swix et al. ("Swix")
1036	U.S. Patent Application Publication No. 2004/0078383 to Mercer et al. ("Mercer")
1037	WIPO Patent Publication No. WO 02/32122
1038	U.S. Patent No. 5,767,897
1039	"Windows XP Media Center Exposed" (AnandTech, January 8, 2003)
1040	File History of U.S. Patent No. 10,679,674
1041	File History of U.S. Patent No. 10,199,072
1042	File History of U.S. Patent No. 9,818,449
1043	File History of U.S. Patent No. 9,384,783
1044	File History of U.S. Patent No. 8,644,684
1045	File History of U.S. Patent No. 7,613,383
1046	Ex. 2002 from IPR2018-01432

Petitioners' Opposition to Request to File Materials from Related Matters

Exhibit No.	Description
1047	Excerpt from American Heritage Dictionary (4 th ed. 2000)
1048	Excerpt from Microsoft Computer Dictionary (5 th ed. 2002)
1049	U.S. Patent No. 7,292,692 to Bonan et al. ("Bonan")
1050	Printout of https://www.atsc.org/news/security-content-protection-high-priorities-for-nextgen-tv/ (visited April 18, 2024)
1051	U.S. Patent No. 5,746,656
1052	U.S. Patent No. 5,729,741
1053	U.S. Patent Appl. Publication No. 2002/0077170
1054	Where to Buy WinTV. VideoTalk and VideoMagic Products
1055	Archived web page — Hauppauge (September 15, 1999)
1056	Archived web page — Hauppauge (November 17, 1999)
1057	Internet Archive Declaration
1058	11/8/24 email from Roshan Bhattarai to Patron Services Peach (Affidavits)
1059	11/12/24 email from Tanya Blue (Affidavits) to Roshan Bhattarai
1060	12/3/24 email from Roshan Bhattarai to Affidavits
1061	12/11/24 email from Roshan Bhattarai to Affidavits
1062	12/20/24 email from Patron Services Blue (Internet Archive) to Roshan Bhattarai
1063	Declaration of Roshan Bhattarai
1064	Exhibit 1064 from April 1, 2025 Balakrishnan Deposition
1065	Exhibit 1065 from April 1, 2025 Balakrishnan Deposition
1066	Exhibit 1066 from April 1, 2025 Balakrishnan Deposition
1067	Exhibit 1067 from April 1, 2025 Balakrishnan Deposition
1068	Exhibit 1068 from April 1, 2025 Balakrishnan Deposition
1069	Exhibit 1069 from April 1, 2025 Balakrishnan Deposition
1070	Email from Dr. Benjamin Bederson dated April 15, 2004
1071	Excerpts from PC World Magazine, Vol. 21, Num. 10, October 2003
1072	Deposition Transcript of Dr. Ravin Balakrishnan dated April 1, 2025
1073	Internet Archive Declaration
1074	Excerpts from Maxell's Reply Claim Construction Brief (5:23-cv-00092-RWS (E.D. Tex.), Dkt. 78)
1075	Excerpts from District Court Order (5:23-cv-00092-RWS (E.D. Tex.), Dkt. 285)
1076	Excerpts from Trial Transcript (5:23-cv-00092-RWS (E.D. Tex.))
1077	Excerpts from Singh Direct Demonstratives (5:23-cv-00092-RWS (E.D. Tex.))

Petitioners' Opposition to Request to File Materials from Related Matters

Exhibit No.	Description
1078	Petitioner Demonstratives
1079	Confidential JMOL Order

Petitioners' Opposition to Request to File Materials from Related Matters

I. INTRODUCTION

In the conference call convened by the Board on September 8, 2025, the Board indicated that it would authorize Patent Owner to file a motion to submit supplemental information and Petitioner to file an opposition. During that call, the Board emphasized to the parties that they were to identify and include as exhibits in that briefing any and all materials the parties wished to make of record in this proceeding, and further authorized the parties to discuss this information during the oral argument held on September 24, 2025 if the parties so wished. The Board followed up that call with an Order dated September 10, 2025 (Paper 36). Pursuant to that Order, Patent Owner filed its Motion identifying and including as exhibits certain materials the Patent Owner wished to make of record. Paper 38 and Exhibits 2041-2046.

Now, after the Board's instruction to include all materials and information that Patent Owner wished to make of record in its Motion for Supplemental Information, and after the completion of the oral argument, the Patent Owner seeks to make yet additional materials of record in this proceeding. This request should be denied as contrary to the Board's explicit instruction, as contrary to the goal of an IPR as an efficient and cost-effective proceeding, and for the following additional reasons.

Petitioners' Opposition to Request to File Materials from Related Matters

**II. PATENT OWNER'S REQUEST TO SUBMIT
ADDITIONAL TRIAL MATERIALS SHOULD BE DENIED**

Patent Owner's request to submit "the entirety of expert testimony transcripts to provide the Board with complete context for the Judgment as a Matter of Law" (Request at 1) should be denied because, as explained in Petitioner's Opposition to the Motion for Supplemental Information, Patent Owner has waived the arguments it now seeks to support with these materials. Paper 41 at 1-3.

Patent Owner's request should also be denied because it is incomplete. In order to provide the Board with the "complete context for the Judgment as a Matter of Law," Patent Owner's request should have included the parties' expert reports. These expert reports are necessary to provide the Board with the full context of the JMOL and Patent Owner's arguments based thereon in its briefing. For example, in Patent Owner's Reply on the Motion for Supplemental information, Patent Owner claims that it had no way of knowing that "prior to trial . . . Petitioner applied this construction to mean that . . . source code is required to show 'character-level selection' otherwise 'the Character Selection Limitations are not met.'" Paper 43 at 3. However, Dr. Kia's Rebuttal Expert Report Regarding Non-infringement dated December 9, 2024 – more than a month prior to Patent Owner's Response to Petition dated January 31, 2025 – demonstrates that Dr. Kia included a lengthy analysis of the source code of the accused Samsung Gallery

Petitioners' Opposition to Request to File Materials from Related Matters product at pages 11-16. Admitting this report would demonstrate that Maxell was well aware of Dr. Kia's source code analysis prior to the submission of its Patent Owner Reply but chose not to raise this issue, and would also demonstrate that nowhere in his report (or at trial) did Dr. Kia assert that source code analysis was *required* to demonstrate the presence of character selection. Similarly, admission of Dr. Singh's Initial Expert Report Concerning Infringement dated November 5, 2024 would demonstrate that Dr. Singh's infringement analysis for limitation [1.j] at pages 274-88 identified only thumbnails as being selected rather than anything that could qualify as a character under the Court's construction. Omitting these reports would leave the Board with an incomplete understanding of the context of the JMOL Order and Patent Owner's related arguments. Patent Owner's request should therefore be denied as being incomplete. Alternatively, if the Board grants Patent Owner's request as it relates to trial materials, the Board should also authorize the submission of the aforementioned expert reports.

III. PATENT OWNER'S REQUEST TO SUBMIT FILE HISTORIES OF RELATED PATENTS SHOULD BE DENIED

Petitioner respectfully submits that the General Order (Paper 40) does not require the submission of the file histories of the two continuations identified by Patent Owner because Patent Owner has made no showing that the claims of those continuations are "substantially similar" to the claims of the '815 patent. *See* Paper 40 at 1 (referring to "substantially similar patent claims"). Moreover, Patent Owner

Petitioners' Opposition to Request to File Materials from Related Matters has made no showing that such materials have any probative value in this proceeding. As a threshold matter, Petitioner notes that both of these patents issued long before the Court's finding that the limitation referred to in the JMOL Order as the "No Deletion" limitation lacks written description support in the specification of the '815 patent or any priority application.¹ EX1079 at 32-35. That finding, together with the Board's earlier final written decision in IPR2018-01432 that a limitation substantively identical to the No Deletion limitation is disclosed in the prior art, indicates that the allowance of these patents, like the allowance of the '815 patent itself, was examiner error. EX1009 (*Fandango Media, LLC v. Maxell, Ltd.*, IPR2018-01432, Paper 32 (P.T.A.B. February 10, 2020)) at 36 (finding that both Kaplan and Bryan disclose this limitation). Patent Owner's request should therefore be denied.

IV. CONCLUSION

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

Date: October 7, 2025

Respectfully submitted,

/s/ James Heintz

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¹ Indeed, U.S. Patent No. 11,783,863 issued before the Petition in this IPR was even filed.

Petitioners' Opposition to Request to File Materials from Related Matters

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CERTIFICATE OF SERVICE

The undersigned certifies that on October 7, 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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Date: October 7, 2025

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