

**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: IPR2024-00735

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

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF THE
FINAL WRITTEN DECISION**

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

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37 C.F.R. 42.11	12
37 C.F.R. §42.75	1
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PATENT OWNER’S EXHIBIT LIST

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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
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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
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I. INTRODUCTION

Patent Owner Maxell Ltd. respectfully requests that the Director grant review of the Final Written Decision (“FWD”) (Paper 51) and find claims 1-6 and 9-13 of U.S. Patent 11,017,815 (“the ’815 Patent”) patentable. 37 C.F.R. §42.75.

The ’815 Patent was tried to a jury six months before the FWD.¹ Having instituted this IPR after disregarding the *Fintiv* factors, the FWD has now created an inconsistent record due to Petitioner advocating for a different narrower construction for “character” in front of the jury while arguing that the same claim is met by the prior art. *See Interactive Comm’s Int’l, Inc. v. Blackhawk Networks, Inc.*, IPR2024-00465, Paper 40, at 3 (Director, Oct. 9, 2025). Although presented with this staggering inconsistency, the Board refused to reconcile the construction Samsung presented to the jury through its expert relative to the broad reading of the claims in this proceeding. Namely, “character” was narrowly interpreted by Petitioner’s expert in front of the jury to exclude selection of a character within a graphical image, but here Petitioner required far less of the prior art. Paper 49, at 5. Instead of holding Petitioner accountable for building inconsistent records in both forums for arguing invalidity and non-infringement under different constructions, the Board shifted the burden onto Patent Owner for “not disputing Petitioner’s application of the claim term “character.” *Id.* at 5. This is a legal error. Under 37 CFR § 42.104(b)(4) it is

¹ The Petition was improperly instituted over *Fintiv*. *See* Paper 9 at 13-19.

Petitioner’s burden to set forth the proposed constructions and explain how the prior art teaches the asserted claims under such proposed constructions. The Board ignored the construction Samsung used at the jury trial relative to the interpretation it set forth in this proceeding. “Patent Owner should not have been the first party to inform the Board as to Petitioner’s different claim construction positions in the two forums” as it did so here in its motion for supplemental information.² *See Am. Airlines Inc. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11, at 13, (PTAB Nov. 21, 2025) (denying institution); Paper 38, 10 (also raising Samsung’s duty of candor). Left as is, it will be up to the Federal Circuit—like it did in *Ultratec*—to reconcile the inconsistent records. *See Ultratec, Inc v. Captioncall, LLC*, 872 F.3d 1267 (Fed. Cir. 2017).

Thus, Director review is necessary because the Board legally erred in refusing to consider Samsung’s inconsistent constructions and application of the claimed “character” limitations. This refusal infected the Board’s entire analysis of the prior art when it erroneously found challenged claims 1-6 and 9-13 unpatentable.

² Indeed, rather than criticizing Patent Owner for failing to appreciate earlier how Samsung would so narrowly interpret the term “character” in the district court and broadly interpret the term in these proceedings, the Board should have grappled with the scope of this term in the FWD in light of Samsung’s competing application of the scope of this term.

II. LEGAL STANDARD

Director review of a FWD is “limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO, Director Review Process, Sec. 2.B., <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

“An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (internal citation omitted).

III. SUMMARY OF THE TRIAL RECORD

On April 19, 2024, Samsung filed a Petition challenging claims 1-15 of the '815 Patent. Paper 3. On August 12, 2024, Patent Owner filed its Preliminary Response explaining why denial was appropriate under §325(d) due to the Office's prior consideration of the Petition art. Paper 9, at 3-13. Patent Owner also explained why denial was appropriate under *Fintiv*. *Id.* at 13-20. Despite these showings, the PTAB instituted review. Paper 11. Patent Owner sought Director review. Paper 13. That request was summarily denied. Paper 17.

In a motion to submit supplemental information, Patent Owner sought to admit evidence of Samsung's inconsistent claim construction position in the district

court case regarding the term “character.” Paper 38; EX2041-2046. On October 28, 2025, the Board denied Patent Owner’s motion. Paper 49. On October 30, 2025, the Board found claims 1-6 and 9-13 unpatentable without considering any of this conflicting evidence on claim construction. Paper 51, at 65; Paper 38. This was legally erroneous and an abuse of discretion.

IV. ARGUMENT

In violation of the holding of *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017), the FWD committed legal error by refusing to consider the inconsistent claim constructions advocated by Samsung in different forums. Paper 49, at 5.

In particular, 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.). While Samsung’s construction was included in the District Court litigation earlier, it was not until trial that Samsung’s narrow application of its construction became explicit whereby its expert and lead counsel presented at trial that the claimed “character” cannot be met when it is displayed as a character embedded in an image on a graphical user interface. *See e.g.*, EX2041, at 10-15. After trial concluded, Patent Owner promptly sent an email **on June 5, 2025** requesting authorization submit such information. EX2045. But the Board did not authorize Patent Owner to file a Motion to Submit Supplemental Information until

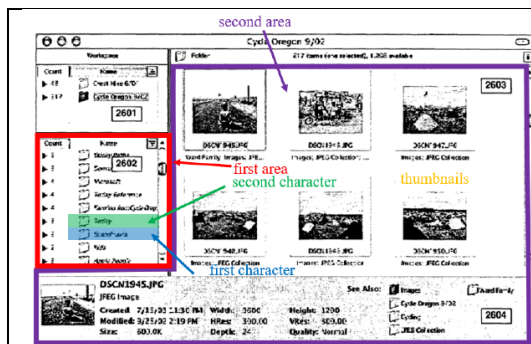
September 10, 2025, two weeks prior to the oral hearing. Paper 37. The Board, however, denied the motion two days before issuing the FWD for not bringing this to the Board’s attention at the time of filing the Patent Owner Response. Paper 49, at 4-5.

But 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.”)). Nor did Samsung’s Post-trial briefing exist at the time, each of which make Samsung’s inconsistent positions glaringly clear.³

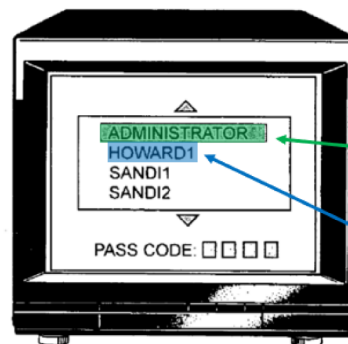
Indeed, inconsistent statements made by Samsung and Samsung’s expert were germane to all asserted Grounds with respect to the meaning of “character,” and should have been considered. Specifically, EXS2041-2043 highlight inconsistent testimony by Dr. Kia, Samsung’s district court expert, and inconsistent statements

³ The Board’s comment in its order denying the Motion for Supplemental Information that Samsung’s expert in the litigation was different than its expert in this proceeding is of no moment to this identical issue of claim construction. *Revvo Techs., Inc. v. Cerebrum Sensor techs., Inc.*, IPR2025-00632, Paper 20, at 4 (Director Nov. 2, 2025) (precedential)

by Samsung in this proceeding and at trial. These inconsistencies were highly relevant because they demonstrated why Samsung had not shown that the prior art disclosed or rendered obvious the “character” limitation in every Ground of the Petition. In the litigation, Samsung’s expert 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. Samsung 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). But when mapping the same limitations to prior art in this proceeding, without relying on any source code, Samsung and its expert asserted—and the FWD agreed—that selecting an area on the screen is sufficient to show that a character is being selected and the claim elements are met. *See* Paper No. 51 at 3 (“We denied Patent Owner’s Motion to Submit Supplemental Information”); *see also id.* at 30 (excerpting Figure 26 of Horn and noting that “Figure 26 shows the workspace view of an embodiment of Horn . . . [that] shows all the collections defined by a user, together with the name of the user . . . [and] Pane 2603 dynamically displays that content selected by a user, either an entire collection or a specific item”; EX1003 ¶ 151 (also pointing to Figure 26 to show user profile associated with first character). In particular, for each Ground, Samsung had pointed to an area of a user interface display as providing the relevant “first character” and “second character”:



IPR2024-00735, Pet. at 33



IPR2024-00777, Pet. at 71

Yet after briefing had concluded in this IPR, 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 Patent Owner’s infringement proof attacked by Samsung are shown on the left, with Samsung’s contentions with regard to prior art are shown on the right:



Image on left from EX2044 (showing selection of characters). Samsung’s expert had testified that selection of “Favorites” on a screen—just like the selection of green and blue highlighted text Samsung 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, however, beyond pointing to selection of an

area on the screen, Samsung did not provide any evidence regarding whether the source code of Horn's system discloses selecting an area or a character. Nor did the Board require Samsung to do so.

Samsung's shifting positions and unequivocal arguments before the District Court were a material change that should have been accounted for by the Board in the interests of justice. 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, not Patent Owner. *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).

Samsung'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," necessitated a finding of patentability for every claim in this proceeding because all challenged claims rely upon independent claims with "character" limitations. *See e.g.*, claim elements [1.f] and [9.d]. Samsung had only pointed to the Horn reference as meeting these limitations (*see* Pet. at 37-38, 52, 66, 76-77, 93), but the character aspects of Horn did not differ (at least in terms of being units of information) from the characters that Samsung has argued do not meet the claim requirements.

Samsung and its expert took this position in front of a jury during trial and thereafter in post-trial briefing, so the Board should have held Samsung to this position in this proceeding and should have confirmed patentability of all challenged claims in view.

Instead, the Board committed clear error by issuing a FWD creating two divergent records whereby there is a finding of invalidity under a plain and ordinary meaning construction from the PTAB and finding of non-infringement under a **different** construction at the District Court, which the Federal Circuit will need to reconcile. *See* Paper No. 51 at 3 (denying Patent Owner’s Motion to Submit Supplemental Information regarding the construction of character); *see also id.* at 9-14 (not taking notice of Petitioner’s construction of “character” in District Court when issuing FWD); EX2041 at 10-17 (Samsung’s JMOL briefing to District Court concerning non-infringement of Claim 1 based on narrow construction of “character”); *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”).

“[W]hen a petitioner takes alternative positions before the Board and a district court, that petitioner should at a minimum, explain why alternative positions are warranted.” *Revvo Techs., Inc. v. Cerebrum Sensor techs., Inc.*, IPR2025-00632, Paper 20, at 4 (Director Nov. 2, 2025) (precedential). Samsung has not done so here. “The Board’s claim construction rules are designed to ensure that

the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.” *Id.* (citing Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,349 (Oct. 11, 2018)). Samsung sought a broader interpretation here to support invalidity and a narrower interpretation in litigation to avoid infringement, exactly what these rules were meant to discourage. *Id.* at 51,350. Now, the FWD finding the challenged claims unpatentable is inconsistent with the JMOL finding no infringement. “Allowing petitioners to continue this practice does not further the office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* at 51,342-43. Because Samsung developed inconsistent positions and the Board relied on it, the FWD should be vacated and this proceeding terminated. *Interactive Comm’s Int’l, Inc. v. Blackhawk Networks, Inc.*, IPR2024-00465, Paper 40, at 3 (Director, Oct. 9, 2025) (vacating FWD where the Board rested its finding of a reason to combine on expert’s contradictory testimony and that testimony was central to Petitioner’s analysis that a POSITA would have had a reason to combine the art).

Moreover, Samsung had a duty of candor to inform the office of its inconsistent positions under 37 C.F.R. 42.11. “Patent Owner should not have been the first party to inform the Board as to Petitioner’s different claim construction positions in the two forums” as it did so here in its motion for supplemental

information. *See Am. Airlines Inc. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11, at 13, (PTAB Nov. 21, 2025) (denying institution); Paper 38, 4 (also raising Samsung's duty of candor). It was error for the Board to deny Patent Owner's motion for supplemental information. Paper 38, 2; Paper 49.

Accordingly, Patent Owner respectfully requests the Director grant review, and find all challenged claims patentable.

Dated: December 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of December, 2025, a copy of the attached PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: December 1, 2025

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