

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' AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

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Petitioners submit this opposition to Patent Owner's (PO) request for director review of the final written decision (Paper 52, the "Request") pursuant to the Board's authorization in an email dated December 2, 2025 (EX3103).

I. INTRODUCTION

Five years ago, the Board found the challenged claims of U.S. Pat. No. 9,284,783, a great grandparent of the '815 patent at issue in this IPR, unpatentable based on the same references used in some of the challenges here. EX1009, 48. The Board has similarly found many of the challenged claims unpatentable here.

PO's Request to undo that decision should be rejected because the Request's premise that there has been inconsistent testimony here and in the parallel district court proceeding is wrong. Moreover, PO's tactical decision to both ignore the district court's longstanding construction of "character" and refrain from making its current arguments here based upon that construction until after the jury's verdict in the district court—in order to avoid impairing its infringement case in the district court—is a separate and independent reason for denying the Request.

II. THERE IS NO INCONSISTENCY BETWEEN DR. BEDERSON'S TESTIMONY AND THE PARALLEL DISTRICT COURT TRIAL

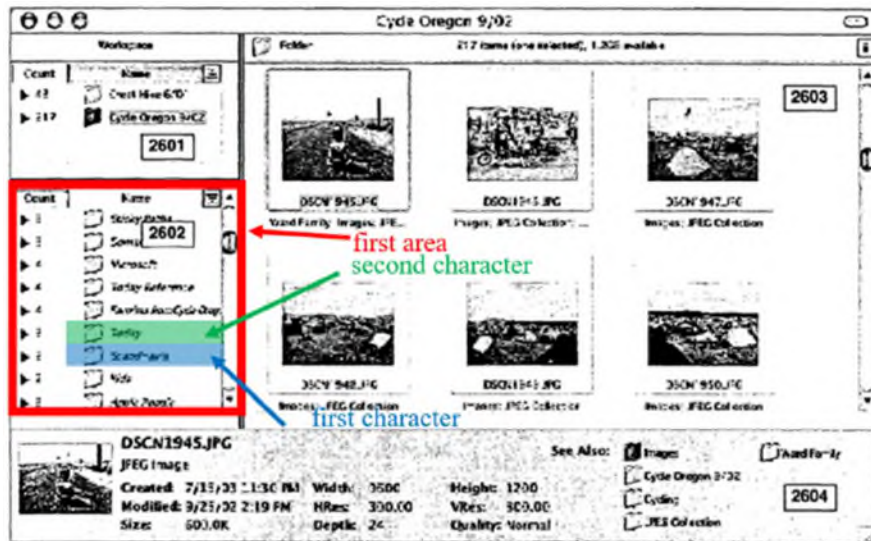
A. Dr. Bederson's IPR Testimony Is Consistent with the District Court's Construction of "character"

PO's Request is based on the false assertion that Petitioner took inconsistent positions on claim construction for the "character" limitation of the challenged claims in this IPR and the corresponding district court litigation. Request, 1. That

assertion is wrong. The district court adopted a construction of “character” that is based on dictionary definitions proffered by both parties rather than any lexicography or disclaimer, and which the district court found represents that term’s plain meaning in the art. EX2033, 10 (construing character as “a letter, number, punctuation mark, or other symbol or control code that is represented to a computer by one unit of information”). The district court’s plain meaning construction is consistent with the statement in the Petition at 18 that the term should be construed according to its plain and ordinary meaning to a POSITA.

Dr. Bederson’s testimony here concerning the “character” limitation is entirely consistent with the district court’s plain meaning construction. In support of Ground 1 based on a combination of the Horn and Baumgartner references, Dr. Bederson testified that individual letters, such as “S” and “T” in Horn’s collection names, are selectable:

In Fig. 26 below, one item in the list, e.g., “Scandinavia” (highlighted in blue) includes a **first character** (i.e., the **portion** of the item that is clicked to select it, which can include the “S” in Scandinavia) ... and a second item in the list, e.g., ‘Today’ (highlighted in green) that includes a **second character** (i.e., the portion that is clicked, which can include the “T” in “Today”)...



EX1003, ¶151 (emphasis added); *see also* Petition, 37-38. Dr. Bederson’s testimony that a portion of “Scandinavia” that can be selected, the letter S, constitutes a first character, and that a portion of “Today” that can be selected, the letter T, constitutes a second character, is consistent with the district court’s construction of “character” because the letters “S” and “T” are clearly letters that can be represented by, e.g., single-byte ASCII codes.

The Request at 6-7 reproduces the same figure from Dr. Bederson’s declaration shown above and selectively cites other portions of the same paragraph 151 to mischaracterize Dr. Bederson’s testimony as an assertion that what was being selected was an area of the screen rather than the letter “S” or the letter “T.” But even a cursory review of Dr. Bederson’s testimony in ¶151 demonstrates that is not the case. Tellingly, the Request inexplicably omits any discussion of the portion of ¶151 of Dr. Bederson’s testimony reproduced above despite citing other

portions of ¶151. The same testimony from ¶151 reproduced above was also identified in Petitioner’s Opposition to Maxell’s Motion to Submit Supplemental Information in response to PO making the same allegation of inconsistent testimony earlier. Paper 41, 3-4. PO’s failure to address this testimony in its Request is a tacit acknowledgement that its characterization of Dr. Bederson’s testimony as being directed toward selection of an area rather than letters such as “S” and “T” is incorrect.

B. Dr. Bederson’s Testimony Is Consistent with Dr. Kia’s Testimony Concerning the Samsung Gallery App

PO’s assertion (Request, 4) that the district court testimony of a different expert, Dr. Kia, was inconsistent with the district court’s construction or Dr. Bederson’s testimony is also wrong.¹ Dr. Kia’s testimony that there was no infringement of the “character” limitations by the Gallery app running on a Samsung Galaxy S23 smartphone was specifically based on the source code of the Gallery app. EX1076, 13-14 (1007:10-1008:3). Dr. Kia’s analysis of the Gallery

¹ The Request asserts that the fact that these are two different experts is “of no moment” and cites *Revvo* at 4 as support. Request, 5 n.3. However, *Revvo* does not address this issue. In contrast, *Ultratec*, which is relied on in the Request at 4, is very much based on the fact that district court expert testimony was from the same expert. *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 (Fed. Cir. 2017).

app source code proved that what is selected by a user in the Gallery app is actually an area of the screen rather than anything that appears on the screen (such as an icon, title, or letter) in that area, and that the area of the screen is not represented by one unit of information. EX1076, 25-27 (3:25-5:23); EX2014, 21-22. As part of his showing, Dr. Kia also physically demonstrated on the Galaxy smartphone that a Gallery album can be selected when nothing (no thumbnail, no title, no letter) is visible in the area corresponding to a Gallery album—proving beyond question that selection in the Samsung accused products is based upon an area and not characters. EX1076, 15-19 (1009:9-1013:17); EX2014, 22.

The Gallery app is different from any prior art at issue in this IPR, and the evidence regarding the two are different too. Specifically, the Gallery app runs on an operating system, Android, that is different from any operating system at issue here. EX1076, 22 (1105:5-11); EX1005, 37:29-32. In addition, the Samsung smartphone includes a touchscreen, which is unlike the PCs of the prior art at issue here, which instead use conventional displays and a pointing system such as a mouse. EX1076, 6-7 (681:21-682:10); *see* EX1005, 19:58-60 (discussing double-clicking). Moreover, there is no source code for any prior art here, which renders the assertion in the Request at 10 that Petitioner did not provide any evidence of whether the source code in Horn’s system discloses selecting an area or a character a *non-sequitur*. Also, as discussed above, Horn’s system involves selection using a

mouse on a regular computer screen rather than using a finger on a touchscreen. In this regard, the Request offers no proof, and does not even allege, that the way a user makes selections in the Gallery app on the touchscreen of a Samsung Galaxy smartphone running on Android bears any relationship to how a user makes a selection in any prior art at issue in this proceeding. The Request's failure to do so now is telling because these same points were previously made in Petitioner's Opposition to Maxell's Motion to Submit Supplemental Information. Paper 41, 4-6.

PO further argues that Dr. Kia took an inconsistent position with respect to whether multiple letters could constitute a character. Again, this is not true. As discussed above, Dr. Bederson's testimony concerned the selection of an individual letter in a title, such as "S" or "T." In contrast, in the district court trial, PO's expert, Dr. Singh, testified on direct examination with respect to limitations [1j] and [1k], that what was selected by a user in the Gallery application was an **entire title** of an album such as "Favorites" (rather than an individual letter in that title). This is reflected in the demonstrative Dr. Singh presented to the jury, which refers (in the brown box on the left) to "Selecting 'Album title'" and (on the right) to "Selecting the 'Favorites' album" rather than selecting individual letters therein:

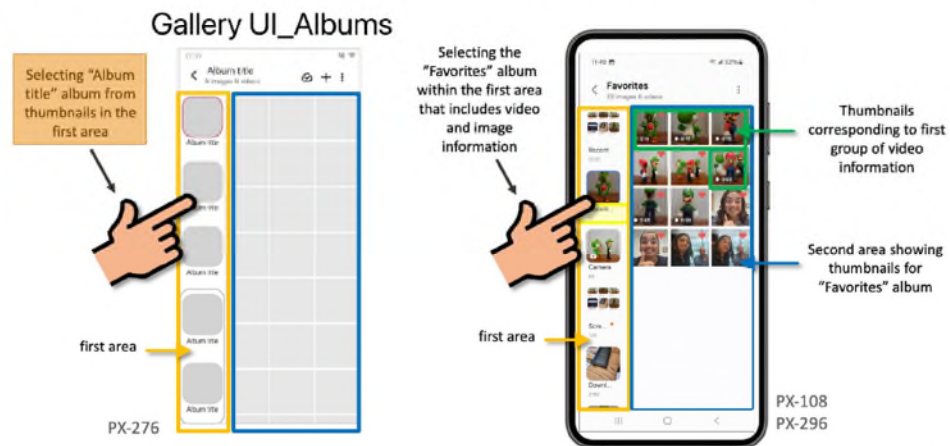
Claim 1

[1.j] wherein user selection of the first character enables the display of a first group of thumbnails corresponding to the first group of video information in the second area,

[1.k] wherein user selection of the second character enables the display of a second group of thumbnails corresponding to the second group of video information in the second area,

Gallery Design Guide (PX-276) and Product Testing (PX-108 and PX-296) Show Selection

- User's selection of first character ("Favorites") → enables the display of a first group of thumbnails corresponding to the first group of video information



EX1077, 44 (brown highlighting added; other highlighting in original). Dr. Singh further testified on cross examination that “it’s a touch screen. If you touch it, you have to touch it to select anything. And when you touch it, what you’re selecting is what is underneath that -- what is displayed there.” EX1076, 8-9 (755:25–756:7). Dr. Kia’s testimony that Dr. Singh’s testimony is inconsistent with the district court’s construction of “character” is therefore entirely consistent with Dr. Bederson’s testimony regarding the selection of individual letters such as S and T.

For all the reasons above, there is no inconsistency between Dr. Bederson’s testimony here and either the district court’s construction of character or Dr. Kia’s district court testimony.

C. Dr. Bederson's Testimony Is Consistent with Dr. Kia's Testimony Concerning the Complex Graphic Icon in the Netflix App

PO is also wrong that Dr. Kia's district court testimony concerning the complex graphic icon in the Netflix app (which is different from the Gallery app discussed above) is inconsistent with the district court's construction of "character" or Dr. Bederson's testimony here. In the district court, PO alleged that a complex graphic "Miyagi-Do" icon including embedded "Miyagi-Do Karate" letters appearing in the Netflix app constituted a "character." EX1076, 5 (127:8-19); EX1077, 73 and 78.



This complex graphic icon is nothing like either of the images relied on in the Request at 6-7, which are clearly directed toward letters that are unquestionably characters under the district court's construction, particularly in view of Dr. Bederson's testimony discussed above regarding the selection of individual letters.

Dr. Kia testified that the complex graphic Miyagi-Do icon itself is not a character under the district court's construction because it is not represented by one unit of information but instead is represented by "hundreds to thousands of pixels, each containing multiple numbers." EX1076, 20-21 (1017:24-1018:16); EX2041,

25. Dr. Kia testified that the entire icon, rather than any part of it (such as the letters visible in the icon), is selected by a user of the Netflix app. EX1076, 22 (1019:3-7). Dr. Kia further testified that the letters that are visible in this complex icon are not like letters in a Word document, but rather are just fixed pixels numbering in the tens to hundreds of pixels and are therefore not characters under the district court's construction. EX1076, 22-23 (1019:11-1020:2); EX2041, 25. There is thus nothing inconsistent between any of the district court testimony and Dr. Bederson's testimony regarding individual letters in the prior art at issue here.

For all the reasons discussed above, PO has failed to show any inconsistency between Dr. Kia's district court testimony regarding the Gallery and Netflix apps at issue in the district court and Dr. Bederson's testimony in this IPR concerning patent documents such as Horn. Thus, the fundamental premise of PO's Request, i.e., that Dr. Bederson's IPR testimony was somehow inconsistent with the district court's construction of "character" or Dr. Kia's testimony in the district court, is incorrect. The Request should be denied for this reason alone.

III. PO'S GAMESMANSHIP IS AN INDEPENDENT REASON TO DENY THE REQUEST

PO was well aware of the district court's November 15, 2024, construction of character when PO filed its Patent Owner Response (Paper 20, the "POR") on January 31, 2025. Indeed, the POR specifically requested that the Board adopt some of the district court's constructions that PO liked, but it did **not** request that

the Board adopt the district court’s “character” construction that PO now belatedly seeks to inject into this proceeding. POR at 6-7 (requesting that the Board adopt the district court’s construction of “user profile” and “user preferences” but not “character”).

PO was well aware of the scope of the district court’s “character” construction when it filed its POR. Indeed, in addition to the scope of the construction being comprehensible on its face, PO argued in its Reply *Markman* brief to the district court that the construction, if adopted, would exclude titles made up of multiple letters and complex graphics. EX1074, 2-3. PO was also aware of Dr. Kia’s software-based analysis of the selecting a character limitation [1g] of claim 1 for the Gallery application because it had seen that analysis in Dr. Kia’s December 9, 2024, expert report nearly two months prior to the POR. See Paper 46, 2-3. And the district court’s order itself made clear that its construction did not apply to a graphical object such as the Netflix icon discussed above. EX2033, 10. Thus, contrary to PO’s current assertion that it somehow did not understand the scope of this construction until the district court trial, it plainly did.

But PO elected not to ask the Board to adopt the construction here because of its apparent concern that any reliance on such a construction, or on the arguments it now makes in its Request, would undermine its infringement case in the district court. For example, had PO argued in its POR, as it now argues in its

Request at 10, that software analysis was required to determine what is selected in the Gallery app, such an argument would have undercut its expert's infringement testimony in the district court because that expert's report did not rely on software analysis. Instead, PO ignored the district court's construction in its POR and instead waited until after the jury's verdict in the district court trial to raise its arguments in the IPR so that the jury would never hear those arguments.

The Board found that PO's strategic choice not to request the district court's "character" construction and arguments based thereon in its POR, and instead wait until after the jury's verdict in the district court trial to raise those arguments here, constituted waiver of those arguments in view of advanced state of the IPR. Paper 49, 3-5. PO's gamesmanship in waiting until after the jury verdict to raise these issues should not be rewarded by vacating the Board's sound decision.

IV. CONCLUSION

The Director should reject PO's request for all of the above reasons.

Date: December 9, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on December 9, 2025, a true and correct copy of the Petitioners' Authorized Response Director Review Request was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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