

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.: IPR2024-00777
U.S. Pat. No.: 11,017,815

**PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING
MATERIAL DIFFERENCES BETWEEN PETITIONS**

I. INTRODUCTION

Petitioner is filing two concurrent petitions challenging the patentability of claims of U.S. Patent No. 11,017,815 B2 (the “’815 Patent”):

- Petition 1 (IPR2024-00735) challenges claims 1-15.
- Petition 2 (IPR2024-00777) challenges claims 16-27.

Petitioner was unable to include all of these challenges in a single petition due to the limit on word count for a single petition and the large number of limitations in the challenged claims.

Petitioner submits this paper, pursuant to the Board’s November 2019 Consolidated Trial Practice Guide (“TPG”), in order to “identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” TPG, 60.

II. RANKING OF PETITIONS

Petitioner believes that both petitions are meritorious and justified. Nonetheless, as required by the TPG, Petitioner provides the following ranking:

Rank	Petition/PTAB Case No.	Challenged Claims
1	Petition 1/IPR2024-00735	1–15
2	Petition 2/IPR2024-00777	16-27

III. MATERIAL DIFFERENCES REQUIRING MULTIPLE PETITIONS

The key difference between the two petitions is that Petition 1 challenges the first 15 claims and Petition 2 challenges the last 12 claims of the '815 patent. Petitioners made every reasonable effort to include all challenges in a single petition. However, due to the length of the first petition, which was nearly 14,000 words, it was not possible to do so.

Petitioner respectfully submits that under these circumstances, the Board should not discretionarily deny Petition 1. As the Consolidated Trial Practice Guide recognizes, more than one petition may be necessary under circumstances such as “when the patent owner has asserted a large number of claims in litigation” and that “[i]n such cases two petitions by a petitioner may be needed.” Consolidated Trial Practice Guide, P.T.A.B. November 2019, at 59.

Here, the patent owner has asserted 26 of the 27 claims challenged by Petitioner. These claims are lengthy and occupy approximately 6 columns of the '815 patent. The claims include a large number of limitations, at least some of which appear to have little value other than preventing the filing of a single

petition for an IPR. For example, claim 3 adds a requirement for an “antenna” to claim 1, which recites “first video information received wirelessly by the network interface.” Claim 4, which depends from claim 1 that already recites first and second video information and thumbnails, adds requirements for third fourth and fifth video information and thumbnails corresponding to this third, fourth and fifth video information. Including requirements for an antenna to an apparatus that includes a network interface that receives video information wirelessly, and third, fourth and fifth video information and thumbnails, adds little or nothing to the patentability of the claims, but addressing these claims in a petition nonetheless requires consumes word count. In light of the foregoing, Petitioner respectfully requests institution of both Petitions 1 and 2.

Date: April 19, 2024

Respectfully submitted,

/s/ James M. Heintz

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CERTIFICATE OF SERVICE

I hereby certify that on April 19, 2024, the foregoing document entitled
Petitioners' Notice Ranking Petitions and Explaining Material Differences
Between Petitions was served on Patent Owner's counsel via email, as agreed to by
Patent Owner, at the following address:

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A courtesy copy was sent to the below counsel via electronic mail:

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Respectfully submitted,

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