

**IN 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: IPR2024-00777

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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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 Works (9/03)	2023
www.bricklin.com/homenetwork.htm	2024
https://www.itprotoday.com/it-infrastructure/mixing-wired-and-wireless-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
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<i>Affordable Wire Management, LLC v. Cambria County Association for the Blind and Handicapped, Inc.</i> , IPR2024-00182, Paper 18 (PTAB Apr. 24, 2024)	9
<i>Apple Inc. v. Speir Technologies Ltd.</i> , IPR2023-00543 Paper 8 at (PTAB Aug. 8, 2023)	10
<i>Blue Calypso, LLC v. Groupon, Inc.</i> , 815 F.3d 1331 (Fed. Cir. 2016)	4
<i>Dexcom, Inc. v. Abbott Diabetes Care Inc.</i> , IPR2023-01252, Paper 9 (PTAB Feb. 5, 2024)	9
<i>Hulu, LLC v. Sound View Innovations, LLC</i> , IPR2018-01039, Paper 29 (PTAB Dec. 20, 2019)	3, 5
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	2
<i>Intex Recreation Corp. v. Bestway Inflatables & Materials Corp.</i> , IPR2023-00489, Paper 12 at 16-17 (PTAB Sept. 20, 2023)	9
<i>Lowe’s Home Centers, LLC v. Epistar Corp.</i> , IPR2018-00932, Paper 7 (PTAB Nov. 1, 2018)	7
<i>TriVascular, Inc. v. Samuels</i> , 812 F.3d 1056, 1066 (Fed. Cir. 2016)	7

Statutes

35 U.S.C. §102(b)	4, 6
35 U.S.C. § 312(a)(3)	7

I. INTRODUCTION

Patent Owner requests Director Review because the Board abused its discretion by introducing new arguments and evidence to remedy the Petition's deficiencies, violating the well-established requirement that the Petition set forth its entire case in chief at the time of filing. The Board ignored the actual arguments and evidence that the Petition raised, and instead substituted its own reasoning and evidence to cure the Petition's defects.

First, the Board abused its discretion through erroneous factual findings by finding Petitioner's showing "sufficient" that WinTV (Ex. 1010) was publicly accessible, and failing to determine the prior art status of Wong (Ex. 1007).

Second, the Board abused its discretion by improperly shifting the burden to Patent Owner to show the subject references were non-analogous, rather than holding Petitioner to its burden to show the references were analogous.

Third, policy considerations of efficiency and PTO and Patent Owner burden militate against institution of this proceeding. Filing more than one petition directed at the same patent "should be rare." Consol. Trial Practice Guide ("CTPG") at 59 (November 2019). In its Institution Decision (ID), the Board never addresses why Petitioner was justified in filing more than one petition.

II. LEGAL STANDARD

"Requests for Director Review of the Board's decision whether to institute an

AIA trial ... shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy.” 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. BACKGROUND

The '815 Patent is directed to an information processing apparatus, and related methods, that manages digital data and reproduces video content associated with user profiles in a specific manner that enables improved video management, storage, and the presentation of groups of video information. Ex. 1001, at 2:63-3:6. At the time of invention, content systems allowed users to group media into “playlists,” but those playlists were not optimized for multiple users. *Id.* at 2:28-47. Different members of the same household, for instance, could not customize their views with select playlists and programs. The '815 Patent solved this problem by providing a recording and reproducing device in which the user can select and manage arbitrary playlists in a particular manner using hierarchical levels of information management.

IV. ARGUMENT

The Board abused its discretion by (1) erroneously finding that WinTV was publicly accessible and failing to address whether Wong is prior art, (2) shifting the burden to Patent Owner with respect to Petitioner's proposed grounds, and (3) instituting this unnecessary Petition and failing to address Patent Owner's response to Petitioner's Notice of Ranking Multiple Petitions.

A. The Board Abused Its Discretion By Failing to Properly Determine The Prior Art Status Of Two Of The Petition's References

The Board abused its discretion through erroneous factual findings by finding Petitioner's showing "sufficient" that WinTV (Ex. 1010) was publicly accessible, and failing to determine the prior art status of Wong (Ex. 1007).

1. The Board Abused Its Discretion By Finding WinTV Publicly Accessible

The Board abused its discretion through erroneous factual findings by finding Petitioner's showing "sufficient" that WinTV (Ex. 1010) was publicly accessible. ID at 19. "The burden is on the petitioner to identify with particularity evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as a printed publication." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (P.T.A.B. Dec. 20, 2019) (precedential). "Because there are many ways in which a reference may be

disseminated to the interested public, 'public accessibility' has been called the touchstone in determining whether a reference constitutes a 'printed publication' bar under 35 U.S.C. §102(b)." *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986)). But there is insufficient evidence in the record to establish a reasonable likelihood that WinTV was publicly accessible. The Board lowered Petitioner's burden by finding Petitioner's evidence sufficient for institution and ignoring the reasonable likelihood standard it must find at institution that WinTV qualifies as a printed publication. ID at 19. It was an abuse of discretion for the Board to find as such on this threshold issue and further invite Petitioner to cure its evidentiary defects through supplementation. *Id.*

The Petition relies on WinTV to support Grounds 7, 8, and 10. In the Preliminary Response (POPR), Patent Owner argued that Petitioner had not provided sufficient evidence to establish a reasonable likelihood that the WinTV Installation and Reference Manual was publicly accessible to a person of ordinary skill in the art prior to the critical date. POPR at 31-34. Petitioner solely provided an Internet archive link as evidence of the existence of WinTV. Pet. at 16. As acknowledged in the POPR, it is undisputed that the link provided in the Petition takes a user in 2024 to the manual Petitioner uses as Exhibit 1010. However, Petitioner provided no evidence to support its statement that "[a] POSITA would

have been familiar with Hauppauge WinTV products...[and] would therefore have known to look on the Hauppauge website for relevant information.” Pet. at 15-16. The Board noted that “[a]lthough Petitioner does not provide citations for some of its assertions, we note that Dr. Bederson supports assertions with his testimony.” ID at 19. But this “testimony” is merely a parroting of the attorney argument set forth in the Petition including the lack of citations for the assertions. *Compare* at Pet. at 19 with Ex. 1003 ¶101. Such an approach should be afforded little to no weight. *Xerox Corp. et. al. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (PTAB Feb. 10, 2023).

In contrast, Patent Owner provided un rebutted evidence through an expert declaration that WinTV “would have only been accessible by the ones who created it, and was not indexed in a customary or meaningful way. EX2021, ¶57.” POPR at 33-34. Specifically, “if one navigates Internet Archive to the Hauppauge web site around the time Petitioner contends the WinTV manual was available (in August or September 2003) (*see, e.g.*, EXS2022-2023), there is no discernable link to current or archived manuals. EX2021, ¶56. Even further exploring some of the links on the home page fail to provide accessibility to product manuals. *Id.*” POPR at 34.

The Board abused its discretion when it erroneously found, in light of the evidence presented, that “Petitioner’s showing is sufficient for institution and establishes that WinTV was publicly accessible.” ID at 19. While Petitioner need

not prove public accessibility by a preponderance of the evidence for institution, the Board typically requires “**strong indicia**” that an asserted reference was publicly accessible” at this stage. *Hulu, LLC*, IPR2018-01039, Paper 29 at 18 (emphasis added). No such “strong indicia” was presented in the Petition. Quite the contrary. Patent Owner provided un rebutted testimony that WinTV was not publicly accessible. POPR at 33-34.

The Board then invited Petitioner “to supplement the record with additional evidence regarding WinTV’s accessibility, now that the issue is in dispute.” *Id.* at 20. The Board’s failure to find the Petition’s evidence deficient in light of the evidence presented by Patent Owner is an abuse of discretion and there is no basis in the record upon which the Board could rationally base such a decision.

2. The Board Abused Its Discretion By Assuming That Wong Is Prior Art

The Petition relies on Wong to support Grounds 9 and 10. The Petition acknowledges that Wong “may only be prior art under post-AIA §102. Post-AIA §102 applies to the Challenged Claims because those claims are not entitled to priority any earlier than 11/9/2017” because of lack of written support in several applications prior to 11/9/2017. Pet. at 9. In its Preliminary Response, Patent Owner detailed, with support from its expert, why each claim term has written support in several applications prior to 11/9/2017. POPR at 25-28.

Yet, the Board completely failed to analyze the prior art status of Wong, and proceeded to utilize Wong in conjunction with its analysis of Grounds 9 and 10 in finding Wong could be combined with Kaplan and Bryant, and that Petitioner had shown a reasonable likelihood of success on these grounds. ID at 28-32. The Board found the combination “adequately stated, and determine at this state that the reasons justify the combination. Should Patent Owner believe that Petitioner has not justified an aspect of the combination asserted against a particular limitation, we will address such arguments made during trial.” ID at 30. The Board abused its discretion by failing to address the threshold issue of the prior art status of Wong and instituting on Grounds 9 and 10.

B. The Board Abused Its Discretion By Shifting The Burden To Patent Owner To Show Petitioner's References Are Non-Analogous Art

With respect to Grounds 6, 7, 8, and 10, Patent Owner argued Petitioner has not shown how a person of ordinary skill in the art would have combined Horn and Baumgartner, or the teachings of WinTV with at least the teachings of Horn in addition to Baumgartner with any expectation of success. POPR at 38-42, 48-50. Patent Owner supported this argument through evidence from its expert that no motivation to combine Horn with Baumgartner or Horn with WinTV exists because they are two different systems. *Id.* (citing Ex. 2021, ¶¶65-80). Yet, the Board found these arguments “inapposite and Patent Owner has not attempted to show that either

reference is non-analogous art.” ID at 20. In doing so the Board abused its discretion by improperly shifting the burden to Patent Owner to show the references were non-analogous, rather than holding Petitioner to its burden to show the references were analogous. “It is Petitioner’s burden to explain specifically how the references would be combined to produce the claimed invention.” *Lowe’s Home Centers, LLC v. Epistar Corp.*, IPR2018-00932, Paper 7 at 19 (PTAB Nov. 1, 2018) (citing *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016)). Indeed, this requirement is set out in the statutory text of 35 U.S.C. § 312(a)(3)—“the petition identifies, in writing and *with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Petitioner never makes the claim in the Petition that the references are analogous, and thus it was an erroneous conclusion of law and fact to shift Petitioner’s burden onto Patent Owner and discount Patent Owner’s evidence to the contrary.

C. Policy Considerations Of Fairness And Efficiency Respecting Multiple Petitions Demands Denial Of Institution

The Consolidated Trial Practice Guide (“CTPG”) sets forth a policy centered on fairness and efficiency respecting the filing of parallel petitions: “Two or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could

raise fairness, timing, and efficiency concerns.” CTPG at 59. The Board completely ignored these fairness and efficiency concerns in rendering the Institution Decision.

The instant proceeding is the result of multiple petitions filed by Petitioner against the '815 Patent. *See* IPR2024-00735 and IPR2024-00777. Petitioner claimed it was “unable to include all of these challenges in a single petition due to the limit on word count and the large number of limitations in the challenged claims.” Paper 4 at 1. In response, Patent Owner argued, consistent with the CTPG, that filing more than one petition directed at the same patent “**should be rare.**” CTPG at 59 (emphasis added). Grounds 1 and 2 in the first petition cover claims 1-15 utilizing Horn, Baumgartner, and WinTV. Grounds 6 and 7 in the second petition cover claims 16-27 utilizing Horn, Baumgartner, WinTV, and Candelore. All told these four grounds covering all claims expend only about 73 pages between the two petitions. *See* Pet. (IPR2024-00735) at 22-60 *and* Pet. (IPR2024-00777), at 20-55. There is no reason why Petitioner could not have covered all of the asserted claims within one petition. Instead, the petitions were designed to apply multiple, highly-redundant references to the claims as a way to increase the burden on the Board and Patent Owner and evade the Board's word limit.

PTAB routinely denies multiple petitions where, as here, Petitioner fails to explain the material differences between the two petitions or explain why this is the “rare” case where multiple petitions are necessary. *Affordable Wire Management*,

LLC v. Cambria County Association for the Blind and Handicapped, Inc., IPR2024-00182, Paper 18 at 24 (PTAB Apr. 24, 2024) (“We determine that Patent Owner has not asserted a large number of claims in the related district court litigation sufficient to justify the filing of two petitions against the ’291 patent.”); *Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01252, Paper 9 at 12 (PTAB Feb. 5, 2024) (Denying multiple petitions finding “the operative phrase [in the Trial Practice Guide] is ‘may be needed, although this should be rare.’” *Id.* (quoting Trial Practice Guide 59). Petitioner does not persuade us that this is one of the rare instances where more than one petition is needed due to a priority dispute.”); *Intex Recreation Corp. v. Bestway Inflatables & Materials Corp.*, IPR2023-00489, Paper 12 at 16-17 (PTAB Sept. 20, 2023) (“Significantly, Petitioner does not provide any explanation as to how these arguments set forth in the 488-Petition—i.e., that the ‘coupling limitations’ are taught by the combination of Aoki and Lin ’773—are materially different than its arguments regarding the coupling limitations allegedly taught by Lin set forth in the present Petition. As such, Petitioner fails to sufficiently identify material differences between the challenges presented in the 488-Petition and the present 489-Petition that would warrant institution of a second petition challenging the same claims.”); *Apple Inc. v. Speir Technologies Ltd.*, IPR2023-00543 Paper 8 at (PTAB Aug. 8, 2023) (“Petitioner’s reasons for filing this second Petition are lacking. Petitioner essentially argues that each petition is directed to different claims requiring

additional word count—'method' claims here versus 'system' claims in the '542 petition. Paper 3, 2–3. But the claims are more similar than Petitioner suggests.... As such, considerations of fairness, efficiency, and maintaining consistency between these cases counsel against instituting here.”).

In its Institution Decision, the Board never addresses why Petitioner was justified in filing more than one petition. Nor did the Board address Patent Owner's reasons why multiple petitions were not appropriate here. The Board's failure in this regard fails to account for the fairness and efficiencies lost at the expense of Patent Owner. This is yet another reason why the Petition should have been denied.

V. CONCLUSION

Director Review of the Institution Decision is warranted because the Board abused its discretion and made erroneous findings of fact that have no basis in the record. Additionally, this request presents important issues of law and policy regarding the filing of multiple petitions directed to the same patent that also merit Director Review.

Dated: November 21, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November, 2024, a copy of the attached PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

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