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

PETITIONERS' MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. §§ 42.123(a)

I. INTRODUCTION

Petitioners respectfully move to submit EX1051-1057 as supplemental information pursuant to 37 C.F.R. § 42.123(a). EX1051-1057 contain evidence relating to the public availability of EX1010 ("WinTV") and EX1011 (Archived specifications for WinTV). WinTV is relied on in multiple grounds in this proceeding, including Grounds 7, 8 and 10, and is therefore clearly relevant to the claims at issue in this IPR as required by § 42.123(a)(2). EX1011 is also relied upon for authentication of WinTV and is therefore also relevant to the claims at issue in this IPR as required by § 42.123(a)(2). Accordingly, Petitioners respectfully request that their motion be granted.

II. BACKGROUND

A. Legal Standard

A party may submit supplemental information under 37 C.F.R. § 42.123(a) if: (1) a "request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted," and (2) the "supplemental information [is] relevant to a claim for which the trial has been instituted."

Unlike supplemental information submitted later in trial (§ 42.123(b)) or information not relevant to a claim for which trial was instituted (§ 42.123(c)), a motion under § 42.123(a) need not "show why the supplemental information reasonably could not have been obtained earlier…" *Compare* 37 C.F.R. §

42.123(c) (where a motion to supplement not filed under subpart (a) "must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice").

Instead, the focus of a motion under subpart (a) of the Rule merely requires the Board to ensure that the proffered supplemental information does not seek to: (i) alter "the grounds of unpatentability authorized in this proceeding"; or (ii) change "the evidence initially presented in the Petition to support those grounds of unpatentability." *Palo Alto Networks,* IPR2013- 00369, Paper 37 at 3; *see also Biomarin Pharma. Inc., v. Genzyme Therapeutic Prods Limited Partnership,* IPR2013-00534, Paper 80 at 5 (Jan. 7, 2015) (considering the same factors under § 42.123(b)). Conducting such an evaluation, the Board also considers whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *Palo Alto,* IPR2013-00369, Paper 37 at 4, or would unfairly prejudice the other party, *Unified Patents Inc., v. Dragon Intellectual Property, LLC,* IPR 2014-01252, Paper 43 at 3 (Apr. 14, 2015).*Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, slip op. at 2-5 (PTAB Jan. 17, 2014) (Paper 37), *Hayward Industries, Inc. v. Pentair Water Pool and Spa, Inc.*, IPR2013-00287, slip op. at 2-5 (PTAB Jan. 27, 2014) (Paper 24).

B. This Proceeding

On November 8, 2024, the Board instituted trial in this proceeding. Patent Owner has not yet filed its Response to the Petition. On November 21, 2024, Patent Owner has filed a Request for Director Review of the institution decision.

III. ARGUMENT

A. Petitioners' Motion Is Timely and the Supplemental Information Is Relevant as Required by 37 C.F.R. § 42.123(a)

Petitioners timely requested authorization from the Board by e-mail on December 5, 2024, which was within one month of the trial institution date of November 8, 2024. Thus, this motion satisfies the timeliness requirement under § 42.123(a)(1). The Board authorized this motion in an email dated December 6, 2024.

In addition, the information Petitioners request to submit into the record is unquestionably "relevant to a claim [at issue in] the trial" as required by § 42.123(a)(2). As explained below, the supplemental exhibits are relevant because they support Petitioners' assertions, do not seek to alter "the grounds of unpatentability authorized in this proceeding," and do not attempt to change "the evidence initially presented in the Petition to support those grounds of unpatentability." Moreover, acceptance of the proffered material will promote the search for truth in this matter and will thus serve to foster a fair and just final adjudication of the issues involved in these proceedings. For the foregoing reasons,

Petitioners submit that the supplemental information should properly be permitted under § 42.123(a)(1) and entered into the record.

B. The Public Availability of WinTV is Relevant to the Challenges in This IPR

In its Institution Decision, this Board concluded that "[t]he Petition provides a showing that the limitations recited in claims 20, 26, and 27 are taught by Horn, Baumgartner, Candelore, and ***WinTV***" and that "there is a reasonable likelihood that Petitioner will prevail with respect to the unpatentability of claims 20, 26, and 27 over Horn, Baumgartner, Candelore, and ***WinTV***." Institution Decision at 20 (discussing Ground 7) (emphasis added). The Board further noted that "[t]he Petition provides a showing that the limitations recited in claims 16–27 are taught by Horn, Baumgartner, Candelore, ***WinTV***, and Chao" and that " there is a reasonable likelihood that Petitioner will prevail with respect to the unpatentability of claims 16–27 over Horn, Baumgartner, Candelore, and Chao (claims 16–19 and 21–25), and over Horn, Baumgartner, Candelore, ***WinTV***, and Chao (claims 20, 26, and 27)." Institution Decision at 23-24 (discussing Ground 8) (emphasis added). Moreover, the Board indicated that it would "address any disputed contention [regarding Ground 10 based on the combination of "Kaplan, Bryant, Wong, Candelore and ***WinTV***"] during the instituted trial." Institution Decision at 35 (emphasis added).

WinTV is therefore clearly relevant to this proceeding. Moreover, the Board also stated that "Petitioner may wish to supplement the record with additional evidence regarding WinTV's accessibility, now that the issue is in dispute." Institution Decision at 20.

EX1051 and EX1052 are issued US patents and EX1053 is published US application that refer to WinTV. See e.g., EX1051 (5:31-32; 11:28-31), EX1052 (7:56-59) and EX1053 (para. 96). EX1051 and EX1052 issued in 1998 and EX1053 published in 2002. EX1051-EX1053 are evidence that would have come to the attention of a POSITA looking for information on such products well before the alleged December 2, 2004 priority date of the '815 Patent.

EX1054 is an archived web page from the manufacturer of WinTV telling the public "where to buy WinTV, …." EX1055 and EX1056 are archived web pages from 1999 showing WinTV for sale on September 15, 1999, and November 17, 1999, respectively. EX1054-EX1056 are further evidence that would have come to the attention of a POSITA looking for information on such products well before the alleged December 2, 2004 priority date of the '815 Patent.

EX1057 is an Internet Archive declaration establishing that Exhibit A thereto includes true and accurate copies of printouts of the archived web pages in EX1054-EX1056 as well as the previously submitted EX1011. It also contains one document not need for this motion. As noted above, EX1011 is also relied upon for

authentication of WinTV and is therefore also relevant to the claims at issue in this IPR as required by § 42.123(a)(2).

Moreover, Petitioners submit that the Board may take "judicial notice of the contents of webpages available through the Wayback Machine 'as facts that can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.'" *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374 (Fed. Cir. 2021). Petitioners respectfully request that the Board do so here to the extent needed.

All of the relevant publication dates of EX1011 and EX1051-EX1056 are more than one year prior to the earliest claimed priority date of December 2, 2004 priority date of the '815 Patent at issue in this IPR. Thus, EX1051-EX1057 confirm the prior art status of WinTV and that it also is relevant to this proceeding.

Entry of EX1051-EX1057 would not impede "the just, speedy, and inexpensive resolution" to this proceeding because they do not change the instituted grounds of unpatentability or alter the initially-presented evidence in the Petition; *to the contrary*, consideration of such exhibits will indisputably promote the fair, "just, speedy and inexpensive resolution" of these proceedings. 37 C.F.R. §42.1(b).

Moreover, where a party seeks to submit information confirming the public accessibility of a prior art reference at issue in the instituted trial, the Board has

repeatedly found such evidence to be proper supplemental information. *Group III Int'l, Inc. v. Targus Int'l LLC*, IPR2021-00371, Paper 34, at 4-6 (September 17, 2021) (*Valeo North America, Inc. v. Magna Electronics, Inc.*, IPR2014-01204, Paper 26 at 4-5 (Apr. 10, 2015); *1964 Ears, LLC v. Jerry Harvey Audio Holdings, LLC*, IPR2017-01084, Paper 17 (Dec. 14, 2017) (Board granting motion to file supplemental information of Internet Archive affidavit to prove publication of reference); *Crestron Electronics, Inc. v. Intuitive Building Controls, Inc.*, IPR2015-01379, Paper 27 at 4-5 (Feb. 2, 2016) (Board granting motion to file supplemental information of Internet Archive affidavit to prove publication of reference for which trial was instituted); *Samsung Electronics Co., Ltd. v. Ibex PT Holdings Co., Ltd.*, IPR2018-00094, Paper 14 at 3-6 (July 24, 2018) (Board granting motion to file supplemental information regarding public availability of references).

IV. CONCLUSION

Petitioners respectfully request that this motion be granted for the reasons discussed above.

Date: December 20, 2024

Respectfully submitted,

/s/ James M. Heintz

James M. Heintz
Reg. No. 41,828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
Jim.Heintz@us.dlapiper.com

Attorney for Petitioners

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned hereby certifies that a copy of the foregoing, Petitioner's Motion to Submit Supplemental Information Pursuant to 37 C.F.R. §42.123(a), was provided to the Patent Owner by emailing a copy of same (by agreement) to the following attorneys of record for the Patent Owner:

rpluta@mayerbrown.com

maxell-samsung-service@mayerbrown.com

A courtesy copy was sent electronically to counsel for Patent Owner in the District Court Litigation:

Saqib J. Siddiqui (ssiddiqui@mayerbrown.com)

Tiffany A. Miller (tmiller@mayerbrown.com)

Date: December 20, 2024

/s/ James M. Heintz

James M. Heintz
Reg. No. 41,828
DLA Piper LLP
One Fountain Square
11911 Freedom Drive, Suite 300
Reston, VA 20190-5602
Phone: + 1 703 773 4000
Fax: + 1 703 773 5000
Jim.Heintz@us.dlapiper.com

Attorney for Petitioners