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

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

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. LEGAL STANDARD 2

III. ARGUMENT 3

A. Exhibits 1051-1057 Are Legally Irrelevant To Whether The WinTV Manual (Exhibit 1010) Was Publicly Accessible 4

B. Proposed Exhibit 1057 Is Not Supplemental Information Under 37 C.F.R. § 42.123(a) 7

C. Proposed Exhibit 1057 Is Not Timely And Could Have Been Obtained Earlier 9

IV. CONCLUSION 10

CERTIFICATE OF SERVICE 12

I. INTRODUCTION

Petitioner seeks to submit three categories of documents purportedly relevant to whether the WinTV Installation and Reference Manual ("WinTV Manual") (Ex. 1010) was publicly accessible: (1) issued patents and a published application that allegedly refer to WinTV *products* (Exhibits 1051-1053), (2) archived web pages allegedly showing where WinTV *products* could be purchased (Exhibits 1054-1056), and (3) a new declaration (Exhibit 1057) from Internet Archive relating to not only proposed new Exhibits 1054-1056, but also Exhibit 1011 originally submitted with the Petition. Petitioner's motion should be denied for at least three reasons.

First, the new information contained in Exhibits 1051-1057 is legally irrelevant to whether *the WinTV Manual* (Exhibit 1010)—the document utilized in the Petition—was publicly accessible to a skilled artisan in 2004.

Second, Exhibit 1057—a new declaration—is not supplemental information. Rather, Petitioner's characterization of Exhibit 1057 as "supplemental information" appears to be designed to address evidentiary objections Patent Owner filed (Paper 15) on November 22, 2024 but to which Petitioner never responded by serving supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2).

Third, even if Exhibit 1057 is proper supplemental information, it is not timely and Petitioner has made no showing pursuant to 37 C.F.R. § 42.123(c) why the

supplemental information reasonably could not have been submitted earlier or that there is good cause to consider the supplemental information.

Patent Owner respectfully requests that the Board deny Petitioner's motion and expunge Exhibits 1051-1057 from the record.

II. LEGAL STANDARD

The party moving for supplemental information under 37 C.F.R. § 42.123(a) bears the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c); *see Western Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 7 (PTAB Jul. 23, 2018). The Board may permit a party to file such a motion only if timeliness and relevance requirements are satisfied. 37 C.F.R. § 42.123(a)(1)-(2). But the Board's decision to admit information under § 42.123(a) is discretionary, and § 42.123(a) "does not connote the PTAB must accept supplemental information so long as it is timely and relevant." *Redline Detection, LLC v. Star Envirotech, Inc., Inc.*, 811 F.3d 435, 445–49 (Fed. Cir. 2015). Rather, timeliness and relevance "provide additional requirements that must be construed within the overarching context of the PTAB's regulations governing IPR and general trial proceedings," including the Board's mandate to interpret its rules "to secure the just, speedy, and inexpensive resolution" of the proceeding and to ensures its "integrity." *Id.* at 443, 445-46, 448; 35 U.S.C. § 316(b); 37 C.F.R. §§ 42.100(a), 42.1(b).

Accordingly, the Board may consider whether the supplemental information reasonably could have been obtained earlier, and that § 42.123 "does not offer 'a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary response.'" *Redline*, 811 F.3d at 444-45, 448. It may also consider whether the supplemental information changes the evidence originally relied on in the petition, *American Well Corp. v. Teladoc Health, Inc.*, IPR2021-00748, Paper 23 at 13 (PTAB Feb. 28, 2022) (citing 35 U.S.C. § 312(a)(3)), or presents a new argument not presented in the petition, *Western Digital*, IPR2018-00082, Paper 22 at 10.

III. ARGUMENT

The Board does not permit irrelevant supplemental information or where the supplemental information offered is not supplemental information at all. *Am. Well Corp.*, IPR2021-00748, Paper 23 at 5-7 (citing *Redline*, 811 F.3d at 445-47; collecting cases); *ServiceNow, Inc. v. BMC Software, Inc.*, IPR2015-01176, Paper 15 at 3 (PTAB Dec. 29, 2015).

The Petition represents Petitioner's case-in-chief, and, under the Board's rules, Petitioner's ability to supplement that case after institution is necessarily limited. 37 C.F.R. § 42.123. Moreover, the Board's statement in the Institution Decision that "Petitioner may wish to supplement the record with additional evidence regarding WinTV's accessibility" was not an open invitation to cure

Petitioner's case-in-chief. *See Redline* 811 F.3d at 445 ("The guiding principle for the PTAB in making any determination is to 'ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.' Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this mandate and alter the intended purpose of IPR proceedings."); see also 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments raised in the corresponding . . . patent owner response").

Petitioner's proposed exhibits are irrelevant to the instituted proceedings and proposed Exhibit 1057 is not supplemental information. The motion should be denied.

A. Exhibits 1051-1057 Are Legally Irrelevant To Whether The WinTV Manual (Exhibit 1010) Was Publicly Accessible

The information contained in proposed Exhibits 1051-1057 is legally irrelevant to whether the WinTV Manual (Exhibit 1010) was publicly accessible to a skilled artisan in 2004 and thus qualifies as prior art under § 102. For example, in the Preliminary Response, Patent Owner argued (with expert support-Exhibit 2021) that Petitioner had not sufficiently shown that the WinTV Manual was publicly accessible at the relevant time:

> For example, 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.*, EXS 2022-2023),

> there is no discernable link to current or archived manuals. EX2021, ¶50. Even further exploring some of the links on the home page fails to provide accessibility to product manuals. *Id.* The inability to access the manual through the archived web page during the 2003 timeframe suggests that the general public, or a POSITA at the time, did not have access to the various WinTV manuals, at least through the Hauppauge web site at the time. EX2021, ¶51.

Paper 9 at 34 (citing Ex. 2021, ¶¶50-51). Proposed Exhibits 1051-1057 do not address these arguments, and the proposed exhibits are legally irrelevant to whether the WinTV Manual was publicly accessible to a person of ordinary skill in the art.

For example, proposed Exhibits 1051-1052 are US Patents and Exhibit 1053 is a published US application "that refer to WinTV." Paper 16 at 5. Petitioner contends these exhibits "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." Paper 16 at 5 (emphasis added). **But this is not evidence of the public accessibility of Exhibit 1010**. Petitioner never explains how the vague reference to "WinTV" provides any evidence of the public accessibility of Exhibit 1010. Petitioner never asserts these proposed exhibits are relevant to whether the WinTV Manual was publicly accessible to a person of ordinary skill in the art. None of the proposed exhibits mention the WinTV Manual, let alone show that document was publicly accessible to establish it was a prior art

printed publication. Whether a POSITA was looking for information ***on the WinTV products*** is irrelevant to the instituted grounds and whether ***the WinTV Manual*** was publicly accessible prior to December 2, 2004. Indeed, the Board has rejected similar efforts to establish public accessibility of a reference based on publication of another document. *See, e.g., Monolithic Power Sys., Inc. v. Volterra Semiconductor LLC*, IPR2020-01351, Paper 20 at 6-11 (PTAB March 4, 2021) (finding Petitioner had not established public accessibility of a reference based on publication of another document because the record lacked evidence "that would tend to indicate that the release of the Handbook submitted as Exhibit 1017 is the particular release to which Philips refers."). Simply put, Petitioner has not established any connection between the vague references to WinTV in proposed Exhibits 1051-1053 and the WinTV Manual used as Exhibit 1010 in the Petition.

Similarly, proposed Exhibits 1054-1056, according to Petitioner, are information on "where to buy WinTV" and "showing WinTV for sale" and "are further evidence that would have come to the attention of a POSITA looking for information **on such products** well before the December 2, 2004 priority date of the '815 Patent." Paper 16 at 5 (emphasis added). But, again, these exhibits fail to show or support ***the WinTV Manual*** was publicly accessible prior to December 2, 2004. None of these proposed Exhibits 1054-1056 mention *the WinTV Manual*, let alone show that document was publicly accessible to establish it was a prior art printed

publication. *See, e.g.*, *Monolithic Power Sys., Inc.*, IPR2020-01351, Paper 20 at 6-11. Petitioner has not established any connection between the vague references to WinTV products in proposed Exhibits 1054-1056 and the WinTV Manual used as Exhibit 1010 in the Petition.

Finally, proposed Exhibit 1057, an Internet Archive declaration purportedly authenticating proposed Exhibits 1054-1056 and originally filed Exhibit 1011, is irrelevant to the instituted grounds because it fails to address the public accessibility of the WinTV Manual and is thus irrelevant to any instituted ground.

B. Proposed Exhibit 1057 Is Not Supplemental Information

In addition to the reasons above, the Board should deny Petitioner's motion as to proposed Exhibit 1057 for another reason: it is not supplemental information under 37 C.F.R. §42.123(a). Petitioner, as the moving party seeking to submit supplemental information under 37 C.F.R. § 42.123(a), bears the burden of proof to establish that proposed Exhibit 1057 is supplemental information, rather than supplemental evidence. 37 C.F.R. § 42.20(c). The Board has previously explained the difference between supplemental evidence under 37 C.F.R. § 42.64(b)(2) and supplemental information under 37 C.F.R. § 42.123(a):

> [S]upplemental *evidence*—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on

> the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental *information*, on the other hand, is evidence a party intends to support an argument on the merits.

ServiceNow, Inc., IPR2015-01176, Paper 15 at 3 (quoting *Handi Quilter, Inc. v. Bernina Int'l AG*, IPR2013-00364, Paper 30 at 2– 3 (PTAB Jun. 12, 2014) (emphasis in original).

Petitioner failed to meet its burden to establish that proposed Exhibit 1057 is supplemental information, rather than supplemental evidence. Petitioner does not intend to use proposed Exhibit 1057 to support an argument on the merits. In the motion, Petitioner characterizes proposed Exhibit 1057 as "an Internet Archive declaration establishing that Exhibit A thereto includes true and accurate copes of printouts of the archived web pages in EX1054-EX1056 ***as well as the previously submitted EX1011***. Paper 16 at 5 (emphasis added). It is clear Petitioner is attempting to cure its failure to timely provide supplemental evidence in response to Patent Owner's evidentiary objections to Exhibit 1011 (Paper 15, at 3-5) by cloaking proposed Exhibit 1057 as supplemental information.

Specifically, pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner served objections to the admissibility of, among other evidence, Exhibit 1011 which was submitted with the Petition. Paper 15 at 3-5. Patent Owner's objections to the admissibility of Exhibit 1011 were based on, among other things, hearsay and

authenticity. *Id.* Petitioner never served supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2) within ten business days of service of the objections.

Because proposed Exhibit 1057 is not supplemental information but rather supplemental evidence, the Board should deny Petitioner's motion as to Exhibit 1057. *ServiceNow, Inc.*, IPR2015-01176, Paper 15 at 3 (denying authorization for motion to submit supplemental evidence where petitioner sought to submit additional evidence asserted to remove any alleged evidentiary defect regarding prior art status, on the ground that the identified evidence was more properly considered supplemental evidence under 37 C.F.R. § 42.64(b)(2)).

C. Proposed Exhibit 1057 Is Not Timely And Could Have Been Obtained Earlier

To the extent the Board considers proposed Exhibit 1057 "supplemental information" and not "supplemental evidence," Petitioner's motion should be analyzed under 37 C.F.R. § 42.123(c). Proposed Exhibit 1057 is dated December 20, 2024—the date on which Petitioner filed its motion. Regardless of when authorization was requested for the instant motion, Petitioner should have been aware of this issue as early as the filing date of the Petition in April 2024, and was expressly on notice as to the public accessibility issue by August 12, 2024.

As explained above, proposed Exhibit 1057 is irrelevant to a claim for which trial has been instituted and is not proper supplemental information under 37 C.F.R.

§ 42.123. Additionally, Petitioner's motion does not explain why it waited until this late in the proceeding to attempt to obtain information pertaining to the public accessibility of the WinTV Manual. Petitioner waited, at a minimum, over three months following Patent Owner's Preliminary Response before attempting to obtain additional information regarding the public accessibility of the WinTV Manual. Clearly, proposed Exhibit 1057 could have been obtained earlier—Petitioner makes no argument to the contrary.

Allowing Petitioner to submit supplemental information that it withheld or elected not to obtain and submit with the Petition—which could have been addressed in Patent Owner's Preliminary Response—also offends basic notions of due process and fairness. *See Royal Brush Mfg. v. United States*, 75 F.4th 1250, 1257-58 (Fed. Cir. 2023) ("[T]he law is clear that, in adjudicative administrative proceedings, due process includes the right to know what evidence is being used against one." (cleaned up)); *Doty v. United States*, 53 F.3d 1244, 1251-52 (Fed. Cir. 1995) (citing *Greene v. McElroy*, 360 U.S. 474, 496 (1959)). Granting Petitioner's motion as to proposed Exhibit 1057 would not be in the interests of justice. 37 C.F.R. §42.123(c).

IV. CONCLUSION

Patent Owner respectfully requests that the Board deny Petitioner's motion.

Dated: January 3, 2025

Respectfully submitted,

/Robert G Pluta Reg No 50970 /

Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)
MAYER BROWN LLP
1999 K Street NW
Washington, D.C., 20006
ssiddiqui@mayerbrown.com
Counsel for Maxell, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of January, 2025, a copy of the attached PATENT OWNER'S OPPOSITION TO MOTION TO SUBMIT SUPPLEMENTAL INFORMATION, was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
Jim.Heintz@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

With a courtesy copy by electronic mail to:

dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: January 3, 2025 By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.