

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

**REPLY TO PATENT OWNER'S OPPOSITION TO PETITIONERS'
MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. §§ 42.123(a)**

Petitioners hereby reply to Patent Owner’s Opposition to Petitioners’ Motion to Submit Supplemental Information Pursuant to 37 C.F.R. §§ 42.123(A) (“PO’s Opposition”). The Board authorized this reply in an email dated January 8, 2025, setting a deadline to submit the reply by January 13, 2025. As such, this reply is timely.

PO’s Opposition raised two issues regarding EX1057 warranting this reply:

- 1) That EX1057 could have been obtained earlier (PO’s Opposition at 9-10); and
- 2) EX1057 is supplemental evidence, not supplemental information, and therefore Petitioners allegedly failed “to timely provide supplemental evidence in response to Patent Owner’s evidentiary objections” (PO’s Opposition at 8).

1. Petitioners Ordered EX1057 The Same Day the Board Issued its Institution Decision

In its November 8, 2024 Institution Decision, the Board 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. Petitioners Exhibits EX1051-EX1057 were provided in accordance with this suggestion, with EX1057 being submitted to authenticate EX1054-EX1056 and EX1011. Petitioners’ Motion at 5-6.

Patent Owner alleges that EX1057 could have been obtained earlier in part because it is dated December 20, 2024, which is the same day as Petitioner's Motion. PO's Opposition at 9. But Petitioners were diligent in obtaining EX1057 and any delay in obtaining that exhibit was unexpected and not caused by the Petitioners.

Specifically, on November 8, 2024, Petitioners submitted a request to Internet Archives to authenticate EX1054-EX1056 and EX1011 (as well as an additional archived link not an exhibit in this IPR). EX1063 (declaration from Roshan Kumar Bhattarai), ¶¶ 2, 3 (citing to EX1058). November 8, 2024 is the *same* day the Board issued its Institution Decision and two weeks *before* Patent Owner served its evidentiary objections on November 22, 2024.

Payment for Petitioners' request was made and acknowledged on November 12, 2024. EX1063, ¶¶ 3 (citing to EX1058), 4 (citing to EX1059). Two reminders were sent, one on December 2, 2024 (EX1060) and a second one on December 11, 2024 (EX1061). EX1063, ¶¶ 5, 6. The requested affidavit of authenticity/public availability was received from Internet Archives on the afternoon of December 20, 2024 shortly before Petitioners were to submit its Motion. EX1063, ¶ 7 (citing to EX1062).

It is Petitioners' past experience that these affidavits are often received from Internet Archives in about three weeks, not the six weeks it took to receive

EX1057. Accordingly, Petitioners respectfully submit that EX1057 was diligently pursued and requests consideration of it as supplemental information regarding WinTV's accessibility.

2. Petitioners Request Waiver or Excuse of the Time Limit Set Out in 37

C.F.R. § 42.64(b)(2) Should the Board agree That EX1057 is

“supplemental evidence”

As noted in Petitioners' Motion, information confirming the public accessibility of a prior art reference at issue in the instituted trial (i.e., EX1057), has repeatedly been found 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).

Patent Owner, however, alleges that EX1057 is supplemental evidence, not supplemental information. PO's Opposition at 8. Moreover, Patent Owner argues that because EX1057 was not submitted within ten days of service of Patent Owner's evidentiary objections, EX1057 is untimely. *Id.*

To the extent that the Board agrees with Patent Owner and determines that EX1057 is supplemental evidence, not supplemental information, Petitioners respectfully request that EX1057 be declared timely submitted. Specifically, Petitioners respectfully request that, in light of Petitioners diligence in pursuing and obtaining EX1057, the Board exercise its authority under 37 CFR 42.5(b) or (c)(3) to waive or excuse the ten day time limit set out in 37 C.F.R. § 42.64(b)(2) and deem EX1057 timely submitted.

Date: January 13, 2025

Respectfully submitted,

/s/ James Heintz

James 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, Reply to Patent Owner's Opposition to 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: January 13, 2025

/s/ James Heintz

James 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