IN THE 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

IPR2024-00777

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

PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

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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	2022

Works (8/03)	
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-andwireless-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
TS 101 197 v1.2.1 (2002-02)	2030
Scrambling (Conditional Access System)	2031
Conditional Access (10/01)	2032
District Court Claim Construction Order	2033
Samsung Claim Construction Brief	2034
Lassalle, Broadcast Encryption	2035
Bederson Deposition Transcript (June 6, 2024)	2036
Bederson Claim Construction Declaration	2037
Bederson Deposition Transcript (January 17, 2024)	2038
User's Guide for Windows NT	2039
Declaration of Ravin Balakrishnan, Ph.D.	2040
5:23-cv-00092-RWS (E.D. Tex.), Dkt. 394	2041
5:23-cv-00092-RWS (E.D. Tex.), Dkt. 416	2042
5:23-cv-00092-RWS (E.D. Tex.), Transcript	2043
Demonstratives from Dr. Singh	2044
Email to the Board on June 5, 2025	2045
Jury Verdict	2046

Petitioner does not dispute that the testimony and positions taken by Samsung in the District Court proceeding were material-to-patentability and "under 37 CFR § 42.11, Samsung **itself** [had] an ongoing duty of candor to disclose this material-to-patentability information to the Board." *See* Paper No. 39 at 4 (emphasis in original); *see also* Paper No. 42 (never disputing that such information is "material-to-patentability" or that Samsung had such an ongoing duty of candor). Further, Petitioner never explains why the holding of *Ultratec, Inc. v. CaptionCall, LLC,* 872 F.3d 1267, 1272 (Fed. Cir. 2017) does not apply.

Instead, Petitioner continues to seek to exclude such evidence detailing its narrower claim construction/interpretation non-infringement positions taken during District Court litigation by alleging Maxell's "waiver" or "inconsistent positions." But it is Petitioner's burden—not Maxell's—to include in the "Content of the petition" how "the challenged claim is to be construed" and then explain how "the construed claim is unpatentable under the statutory ground." *See* 37 CFR § 42.104(b).

Given that the **same** claim construction standards apply here as in the District Court, it was Petitioner's burden to ensure that it was taking consistent claim construction positions and keep a consistent record when seeking invalidity at the PTAB and non-infringement in District Court. Once Petitioner and its experts started taking inconsistent positions, it was Petitioner's duty to disclose such material-to-

patentability information to the Board. *See* 37 CFR § 42.11. Petitioner failed to do so. As set forth in Paper 38, PO did move to supplement information promptly when the divide between Petitioner's positions widened and became clear.

I. WAIVER DOES NOT APPLY

Petitioner's response ignores the issue and attempts to shift burdens. First, Maxell is not arguing now for a particular construction of "character." Rather, the issue is that Petitioner has taken inconsistent positions regarding the construction of that term—it cannot have it one way to argue non-infringement and another way for invalidity. Petitioner should be forced to choose and stand on a consistent position in both forums.

Second, if Petitioner does believe "character" should be given a particular construction, it was Petitioner's burden to propose and support its position. Under 37 C.F.R. § 42.104(b), the Petition must provide a clear statement regarding"[h]ow the challenged claim is to be construed." It is Petitioner's burden to identify how the construed claim is unpatentable over the relevant evidence. 37 C.F.R. §§ 42.104(b), 42.204(b), 42.304(b). Petitioner, by arguing in the district court for a narrower construction and at the PTAB for a broader construction, is not complying with these requirements. It cannot disguise its failure by attempting to argue waiver by Maxell. Waiver does not apply here. It was not Maxell's burden.

It is true that Patent Owner was aware of Samsung's construction of "character" in the District Court. Patent Owner, however, had no way of knowing that Samsung would interpret this construction in such a narrow way to even exclude selection of text (*e.g.*, "F" in Favorites" or "M" in "MiYagi-Do") being displayed on a screen as meeting the character selection limitations under this construction. Indeed, Petitioner points to no evidence—including in Ex. 1074—that indicates that prior to trial Petitioner applied this construction to mean that "the Character Selection limitations are not satisfied by **selecting an area of a display** because that is not a 'character'" or that source code is required to show "character-level selection" otherwise "the Character Selection limitations are note met." *See* Paper No. 39 at 5-7; *see also* Paper No. 42 at 2-3. Petitioner's inability to identify any evidence of it making such statements prior to trial confirms the timeliness of Patent Owner's request to move to supplement information and present it to the PTAB.

Finally, the Board is not bound by the parties' failure to construe the term "character" in light of the District Court's construction and Petitioner's inconsistent positions. "[T]he Board may adopt a claim construction of a disputed term that neither party proposes without running afoul of the APA." *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1262–63 (Fed. Cir. 2021) (collecting cases). Such a construction clearly would and should have been anticipated by Petitioner based on its positions at trial in the District Court.

Accordingly, waiver does not apply and Patent Owner respectfully requests consideration of the supplemental information as it is in the interests-of-justice.

II. SAMSUNG'S POSITIONS ARE INCONSISTENT

Petitioner's Opposition only buttress Patent Owner's argument that for the **same** claim elements—the Character Selection limitations—Petitioner is arguing that selecting text displayed on a screen in Horn (*e.g.*, "S" of Scandinavia) meets the claim element but selecting text displayed on a screen (*e.g.*, "F" of Favorites or "M" of Miyagi-Do") does **not** meet the claim element when it is in Petitioner's device. Paper 42 at 3-7.

Without pointing to any support from its expert Dr. Bederson, Petitioner alleges that, on the one hand, the "T" and "S" displayed in Horn corresponds to "single-byte ASCII codes" but on the other hand that the "F" displayed in Favorites on the Gallery app is actually "an area of the screen rather than anything that appears on the screen (such as an icon, title, or letter)" or that the "M" displayed in "Miyagi-Do" is "not a character." *Id.* at 6 *Id.* at 4-6.

Petitioner attempts to reconcile these inconsistent statements "specifically based on the source code" and the fact that there is a difference between operating systems and screen types. *Id.* at 5-7. But Petitioner admits that "there is no source code for any prior art here." *Id.* at 5.

These are precisely the types of inconsistent positions that must be considered by the PTAB to ensure Petitioner is complying with its obligations to apply a consistent interpretation for invalidity and infringement. There is no evidence in the record by any of Petitioner's experts that a distinction between operating systems or screen types establishes a distinction between selecting an area of a screen and what is displayed. If source code is required to establish whether a particular text being displayed on the screen is selected then it was Petitioner's burden in this proceeding to explain what the source code of, for example, Horn would include. No such evidence was set forth supporting **any** Grounds.

III. MAXELL'S POSITIONS ARE CONSISTENT

Petitioner only points to trial testimony from Dr. Singh without identifying any testimony or statement by Patent Owner in **this** proceeding to compare it to. Paper 42 at 7-10. Thus, there is no statement by Patent Owner or its expert for the Board to consider as being "inconsistent." To the contrary, Patent Owner has consistently asserted that it is Petitioner's burden to comply with the requirements of 37 C.F.R. § 42.104(b) and interpret the claims consistently. By failing to do so, Petitioner cannot meet its burden to establish that the claims are unpatentable

Dated: September 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 23rd day of September, 2025, a copy of the attached PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO SUBMIT SUPPLEMENTAL INFORMATION together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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With a courtesy copy by electronic mail to:

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Respectfully submitted,

Date: September 23, 2025 By: /Robert G Pluta Reg No 50970/
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