

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL, LTD.
Patent Owner.

IPR2024-00777
Patent 11,017,815 B2

Before JAMESON LEE, TERRENCE W. McMILLIN,
and KEVIN C. TROCK, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. Introduction

On September 19, 2025, a general order was entered in this proceeding instructing the parties to keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims or substantially similar patent claims in any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding. Paper 41. It ordered the parties to alert the Board of any such developments within five business days, and file, “after Board consultation, “relevant materials” from the related matters. *Id.* at 2.

On September 23, 2025, the parties by email informed the Board that in a related district court proceeding an order granting Judgment as a Matter of Law (“JMOL”) was entered on September 18, 2025, which held that certain claims of the ’815 patent are invalid and not infringed. Ex. 3102. The email also indicated that the parties disagree on whether the materials Patent Owner desires to file in association with the JMOL are “relevant materials” in the context of the Board’s general order of September 19, 2025.¹ *Id.*

Petitioner filed the JMOL on September 24, 2025. Ex. 1079.

¹ The materials Patent Owner desires to file are: (1) Related findings of validity by the Office when considering the prior art upon which the Petition is based, and associated file histories; (2) the entirety of the transcripts of Dr. Kia and the entirety of the transcript of Dr. Singh providing rebuttal, including demonstratives; and (3) trial transcripts highlighting Petitioner’s use of the IPR institution decision with the jury. Ex. 3102.

II. Discussion

The filing of “relevant materials” is to assist the Board in understanding the expressed reasoning of the district court’s findings and conclusions, and not to augment the evidentiary record of this proceeding either to provide a basis for new arguments not heretofore made in this proceeding or to provide additional evidence for arguments already made. The material Patent Owner seeks to file appears to fall outside the scope of “relevant materials” at issue.

We have reviewed the JMOL and find that we do not need any additional material to understand the basis and reasoning of the district court’s findings and conclusions regarding the claims of the ’815 patent. We also find no overlap in the prior art analyzed and discussed by the district court and the prior art asserted by Petitioner in this proceeding.

III. Order

It is

ORDERED that Patent Owner is authorized to file a paper, limited to five pages and due three business days from the date of this Order, to explain why the Board would need the materials Patent Owner seeks to submit as “relevant materials” to understand the expressed reasoning of the district court’s findings and conclusions, and to explain whether there is any overlap between the prior art analyzed and discussed by the district court and the prior art applied by Petitioner in this proceeding; and

FURTHER ORDERED that Petitioner is authorized to file a response to Patent Owner’s submission, also limited to five pages, due three business days after filing of Patent Owner’s submission.

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FOR PETITIONER:

James Heintz
Gianni Minutoli
DLA PIPER LLP
jim.heintz@dlapiper.com
gianni.minutoli@dlapiper.com

FOR PATENT OWNER:

Robert Pluta
Amanda Bonner
Saqib Siddiqui
MAYER BROWN LLP
rpluta@mayerbrown.com
astreff@mayerbrown.com
ssiddiqui@mayerbrown.com