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 REQUEST FOR AUTHORIZATION TO FILE MATERIALS FROM RELATED MATTERS

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

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 Works (8/03)	2022

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

Patent Owner files this brief pursuant to the authorization granted in Paper 45 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."

In response to the General Order (Paper 41) Patent Owner requested to file (1) Related findings of validity by the Office when considering the prior art upon which the Petition is based (Bryant, Kaplan, WinTV, Chao, and Baumgartner), specifically related U.S. Patent Nos. 12,198,733, and 11,783,863, 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.[1] EX3102.

Patent Owner's request ultimately seeks to demonstrate two things. First, Patent Owner seeks to introduce the entirety of expert testimony transcripts to provide the Board with the complete context for the Judgment as a Matter of Law that has now been submitted to the Board. The material will further demonstrate the

[1] Patent Owner no longer seeks consideration of the trial transcripts highlighting Petitioner's use of the IPR institution decision with the jury.

parties' disagreements on the issues and further illustrate Petitioner's inconsistencies in this proceeding. Consideration of the complete expert transcripts is necessary to fully understanding the Court's reasoning and whether it is supported by the expert testimony in the case.

Second, the Board appears to have misinterpreted Patent Owner's request (1) in stating that there is "no overlap in the prior art analyzed and discussed by the district court and the prior art asserted by Petitioner in this proceeding." Paper 45. Patent Owner's request is related to the same prior art considered during prosecution of continuation applications, not the district court. Thus, Patent Owner seeks to introduce file histories from related patents which contain the Office's consideration of the same prior art for substantially similar claims. As explained below, consideration of this material is necessary in light of the General Order.

The General Order states that the "parties must keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims, **or substantially similar patent claims**, such as claim construction, findings of fact, or conclusions of law, in 'any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.'" Paper 41 (emphasis added). The General Order makes clear that the Board must also be updated on any findings of substantially similar claims by the Office. Patent Owner never stated that the prior art analyzed by the district court overlapped with the

Petition. Rather, Patent Owner seeks authorization to file the file histories of continuations of the ’815 Patent where overlapping art was considered, the claims have similar limitations, and the claims were allowed. The General Order requires consideration of these findings.

Prosecution of related U.S. Patent Nos. 12,198,733, and 11,783,863 contains consideration of the prior art upon which the Petition is based (Bryant, Kaplan, WinTV, Chao, and Baumgartner), which is relevant to the patentability of the ’815 Patent challenges in this proceeding. First, the related patents contain similar key claim limitations. For example, claim 1 of ’815 Patent contains a limitation “a first area including a first character associated with a first group of video information for a first classification and a second character associated with a second group of video information for a second classification different from the first classification.” Similarly, claim 1 of the ’863 Patent recites “a first area including a first character associated with a first group of program or playlist information for a first classification and a second character associated with a second group of program or playlist information for a second classification different from the first classification” and claim 1 of the ’733 Patent recites “a first area including a first character associated with a first group of program or playlist information for a first classification and a second character associated with a second group of program or playlist information for a second classification different from the first classification.”

Moreover, in the ’733 Patent file history the claims were allowed on September 18, 2024 with the list of references cited by the applicant and considered by the examiner including Chao (7,970,240), Baumgartner (2005/0160458), Kaplan (2001/0056434), Bryant (2004/0201691), Horn (7,275,063), and the WinTV Installation and Reference Manual.

In the ’863 Patent file history the claims were allowed on August 17, 2023 with the list of references cited by the applicant and considered by the examiner including Bryant (2004/0201691).

Patent Owner thus requests authorization to submit as evidence the file histories of related U.S. Patent Nos. 12,198,733, and 11,783,863, the entirety of the transcripts of Dr. Kia, the entirety of the transcript of Dr. Singh, and associated demonstratives.

Dated: October 2, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 2nd day of October, 2025, a copy of the attached PATENT OWNER'S REQUEST TO FILE MATERIALS FROM RELATED MATTERS together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: October 2, 2025 By: /Robert G Pluta Reg No 50970/
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