

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

Denying Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

I. Introduction

We instituted *inter partes* review on November 8, 2024. Paper 11. On September 10, 2025, we authorized Patent Owner to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b). Paper 37. Patent Owner filed its Motion to Submit Supplemental Information. Paper 39 (“Motion” or “Mot.”). Petitioner filed an opposition. Paper 42 (“Opposition” or “Opp.”). Patent Owner filed a reply. Paper 44 (“Reply”).

The Motion is *denied*.

II. Discussion

The Motion seeks to submit Exhibits 2041–2046.¹ Patent Owner explains as follows:

The exhibits contain evidence that reasonably could not have been obtained earlier. Consideration of this evidence also is in the interest-of-justice because it demonstrates inconsistent positions taken by Petitioner *regarding the meaning of the claim term “character”* in the district court litigation between Petitioner and PO. PO’s request was timely made, is directly related to a claim for which the trial was instituted, and if admitted, will demonstrate that Petitioner and its expert—Dr. Kia—took inconsistent positions in the litigation than it has

¹ Exhibit 2041 is Petitioner’s Renewed Motion for Judgment as a Matter of Law and Motion for a New Trial in parallel district court litigation. Exhibit 2042 is Petitioner’s Reply in Support of Petitioner’s Renewed Motion for Judgment as a Matter of law and Motion for a New Trial in parallel district court litigation. Exhibit 2043 is certain testimony of Dr. Kia, Petitioner’s witness in parallel district court litigation. Exhibit 2044 is a collection of demonstrative slides from Dr. Singh, Patent Owner’s trial witness, used by Patent Owner in parallel district court litigation. Exhibit 2045 is a copy of an email communication from the Board initially denying Patent Owner’s request for authorization to file supplemental information. Exhibit 2046 is a copy of the jury verdict from parallel district court litigation.

taken during this IPR. *See Ultratec, Inc. v. Captioncall, LLC*, 872 F.3d 1267 (Fed. Cir. 2017).

Mot. 1 (emphasis added).

Section 42.123(b) of Title 37, Code of Federal Regulations, reads as follows:

§ 42.123 Filing of supplemental information

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interest-of-justice.

37 C.F.R. § 42.123(b).

Petitioner does not contend that Patent Owner could not have obtained the information now sought to be submitted as supplemental information. Thus, we do not discuss that aspect of 37 C.F.R. § 42.123(b).

The Motion explains Patent Owner's position that Petitioner took inconsistent views on the meaning of the claim term "character" in parallel district court litigation and in this proceeding. Motion 5–10. The Opposition explains Petitioner's position that there is no inconsistency between the positions taken by Petitioner in this proceeding and in parallel district court litigation regarding the meaning of the claim term "character." Opp. 3–10. Whether or not there is inconsistency, however, is not relevant to the final disposition of this case regarding the challenged claims, because Patent Owner in its Response does not present any argument against Petitioner's manner of reading the claim term "character" onto the prior art.

We disagree with Patent Owner’s statement that under *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017), we must consider the allegedly inconsistent positions of Petitioner and its expert as set forth in parallel district court proceeding. Mot. 10. The circumstance of this case is distinguished from that in *Ultratec*, because (1) Petitioner’s witness in this proceeding, Dr. Bederson, is not the same as Petitioner’s witness in parallel district court proceeding, Dr. Kia, and (2) *Ultratec* involved a situation where the alleged inconsistency is on a matter in dispute by the parties in the Board’s proceeding. In *Ultratec*, the Court of Appeals for the Federal Circuit stated:

[T]he Board explicitly found Mr. Occhiogrosso more credible than Ultratec’s expert. *See* J.A. 23 (“We credit the testimony of Mr. Occhiogrosso over that of Mr. Steel on this issue. . . .”); J.A. 3660 (“Weighing Mr. Occhiogrosso’s testimony against Mr. Ludwick’s testimony, we credit Mr. Occhiogrosso’s testimony. . . .”); J.A. 7403 (“On this point, based on our review of McLaughlin, we credit the testimony of Petitioner’s declarant, Mr. Occhiogrosso, over that of Patent Owner’s declarant, Mr. Ludnick.”). In other instances, the Board found Mr. Occhiogrosso credible on the very issue Ultratec alleges he contradicted at trial. *See* J.A. 6383 (“We are persuaded by Mr. Occhiogrosso’s testimony that a person of ordinary skill in the art would consider McLaughlin to be disclosing a device capable of all of the HCO/VCO features described therein.”); *see also* J.A. 23, 27, 7403.

Ultratec, 872 F.3d at 1271.

The Motion belatedly creates a dispute regarding Petitioner’s application of “character” to the prior art, where none was presented in the Patent Owner Response. Granting the Motion is tantamount to going back in time to revise the Patent Owner Response by Patent Owner proposing a construction for “character” that is different from that proposed by

Petitioner, and then to restart the trial from that point onward. Whatever reasons Patent Owner had at the time of filing the Patent Owner Response for not disputing Petitioner’s application of the claim term “character” to the prior art, the choice was made by Patent Owner. We see no reason to permit this change, and the advanced state of this proceeding also would not permit such a change given that a final written decision must issue no later than one year after institution of review. *See* 37 C.F.R. § 316(a)(11).

For the foregoing reasons, we do not regard submission of Exhibits 2041–2046 as supplemental information to be “in the interest-of-justice” as is required by 37 C.F.R. § 42.123(b).

III. Order

It is

ORDERED that Patent Owner’s Motion to Submit Supplemental Information is *denied*.

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