

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 Request to File Relevant Materials
37 C.F.R. § 42.5

I. Introduction

We instituted *inter partes* review on November 8, 2024. Paper 12. On September 19, 2025, a General Order was issued stating:

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” *and is identified as a related matter under 37 C.F.R. § 42.8(b)(2)*.

Paper 41, 1. The General Order further stated: “[A]fter Board consultation, the parties shall file in the docket of this proceeding relevant materials from the related matter(s).” *Id.* at 2 (emphasis added).

On September 29, 2025, we issued an Order explaining:¹

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 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 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

¹ On September 18, 2025, the district court in parallel litigation involving Patent No. 11,017,815 (“’815 Patent”) issued a Judgement as a Matter of Law (“JMOL”) determining claims 1, 21, and 24 of the ’815 Patent invalid over a prior art product. Ex. 1080, 32–37.

discussed by the district court and the prior art asserted by Petitioner in this proceeding.

Paper 45, 3. Nonetheless, we authorized Patent Owner to file a paper 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;

Id.

On October 2, 2025, Patent Owner filed a Request for Authorization to File Materials from Related Matters. Paper 46 (“Request”). On October 7, 2025, Petitioner filed an Opposition to Patent Owner’s Request for Authorization to File Materials from Related Matters. Paper 47.

II. Discussion

In the Request, Patent Owner identifies the materials it desires to submit as follows:

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. EX3102.

Request 1 (footnote omitted).

Item 1 is outside of the scope of the General Order. Paper 40. The examination of applications of Patent Nos. 12,198,733 and 11,783,863 were not ever identified as related matter by either party in this proceeding. Also,

the Request compares only one limitation of claim 1 of Patent No. 11,017,815, which is not a challenged claim in this proceeding. Request 3. Also, comparison of one limitation is insufficient to show two claims as a whole are substantially similar. For these reasons, Item 1 does not qualify as relevant matter for consideration.

For Items 2 and 3, Patent Owner explains:

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 of the Judgment as a Matter of Law* that has now been submitted to the Board. The material will *further demonstrate the 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*.

Request, 1–2 (emphasis added). The reasonings provided are misplaced.

In the Order dated September 29, 2025, we specifically explained: “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.” Paper 45, 3. As is evident from Patent Owner’s explanation reproduced above, Patent Owner essentially is seeking to use the materials to buttress or add arguments to this proceeding and to cast doubt over the district court’s findings and conclusions. Most importantly, it should be noted that we do not review whether the district court’s Order is supported by the expert testimony in the district court litigation.

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.

For the foregoing reasons, we see no reason to authorize submission of the "relevant material" Patent Owner seeks to submit.

III. Order

It is

ORDERED that Patent Owner's Request for Authorization to Submit Motion to File Materials from Related Matters is *denied*.

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