

**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

Case: IPR2024-00828

U.S. Patent No. 8,982,086

PATENT OWNER'S OFFER OF PROOF PURSUANT TO FRE 103(a)

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

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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
Declaration of Jacob O. Wobbrock, Ph.D.	2005
Handbook of Fingerprint Recognition (2nd ed.)	2006
Claim Construction Order	2007
Valdes-Perez, F.E. and Pallas-Areny, R. (2009) <i>Microcontrollers: Fundamentals and Applications with PIC</i> . Boca Raton, FL: CRC Press	2008
Deposition Transcript of Seth James Nielson, Ph.D. (January 15, 2025)	2009
Excerpts from Human-Computer Interaction, 3rd Ed., Dix et al. (2004)	2010
Definition of “mode” from PCMag (https://www.pcmag.com/encyclopedia/term/mode)	2011
McGraw-Hill Dictionary of Scientific and Technical Terms, 6th ed. (2003)	2012
Excerpts from the Deposition Transcript of Seth James Nielson, Ph.D. (December 20, 2024)	2013
Patent Owner's Hearing Demonstratives	2014
June 13, 2025 Email from Board Denying Authorization to File Motion for Supplemental Information	2015
August 12, 2025 Email from Board Denying Pre-hearing Conference Request	2016
May 23, 2025 Public Trial Transcript from <i>Maxell, Ltd. v. Samsung Electronics et al.</i>	2017
August 25, 2025 Authorization for Offer of Proof	2018
Parties' Meet and Confer Communication regarding supplemental information	2019
Parties' Meet and Confer Communication regarding pre-hearing conference	2020

I. INTRODUCTION

Pursuant to Fed. R. Evid. 103(a)(2) and authorization granted by the Board on August 25, 2025, Patent Owner provides this offer of proof. FRE 103(a)(2) provides that “[a] party may claim error in a ruling to . . . exclude evidence only if the error affects a substantial right of the party,” and the party “informs the court of its substance by an offer of proof” Here, Patent Owner requested authorization to file motions to submit supplemental information regarding Petitioner’s inconsistent positions taken regarding U.S. 8,982,086 (“the ’086 Patent”) in the district court litigation. The Board excluded that supplemental information offered by Patent Owner by denying Patent Owner the opportunity to even raise that information during a conference call with the Board, let alone submit the evidence in this proceeding through a motion for supplemental information. This was an error because the request was timely made, was directly related to a claim for which the trial was instituted, and if admitted, would have demonstrated that Petitioner and its expert—Dr. Seth Nielson—were taking different positions in the district court litigation than it has taken during this proceeding.¹ *See Ultratec, Inc v. Captioncall,*

¹ Under 37 CFR 42.51(b)(1)(iii) routine discovery requires that “a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding.” Petitioner did not produce this information and thus Patent Owner

LLC, 872 F.3d 1267 (Fed. Cir. 2017) (holding that the PTAB abused discretion when it refused to admit and consider an expert's inconsistent trial testimony during an IPR).

II. PATENT OWNER'S OFFER OF PROOF IS TIMELY AND PROPER

A. Patent Owner's Offer of Proof is Timely

Patent Owner's Offer of Proof is timely and proper under the law and regulations applicable to this IPR proceeding. The '086 Patent was asserted in *Maxell, Ltd. v. Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.*, 5:23-cv-00092-RWS (E.D. Tex.). Paper 5, at 1. The jury trial in this case occurred on May 19-May 28, 2025. 5:23-cv-00092-RWS (E.D. Tex.), Dkt. Nos. 319, 322-323, 331, 335, 344, 346. After the trial concluded, Patent Owner sent an email to Petitioner on June 2, 2025 to confer regarding requesting authorization to submit supplemental information. EX2019.²

sought to enter it into the record through a motion for supplemental information as soon as the information became available.

² Contrary to Petitioner's professed ignorance at the oral hearing of what information Patent Owner sought to include with its offer of proof, Patent Owner identified for

Patent Owner sent an email on June 5, 2025 requesting authorization to file motions to submit supplemental information. EX2015:

Pursuant to 37 CFR 42.123(b), Patent Owner requests authorization to file motions to submit supplemental information in ... IPR2024-00828.... More specifically, Patent Owner intends to move to supplement the record to add the following information:

1. April 24, 2025, Public Motions Hearing transcript from Maxell, Ltd. v. Samsung Electronics et al.
2. May 19, 2025 Public trial transcript from Maxell, Ltd. v. Samsung Electronics et al.
3. May 21, 2025 Public trial transcript from Maxell, Ltd. v. Samsung Electronics et al.
4. May 23, 2025 Public trial transcript from Maxell, Ltd. v. Samsung Electronics et al.
5. May 27, 2025 Public trial transcript from Maxell, Ltd. v. Samsung Electronics et al.

This information is new information and relevant to the instituted grounds insofar as Petitioner makes arguments contrary to the positions it has taken in these proceedings. Good cause exists because the trial was only completed on May 28, 2025.

While the email presented the parties' availability for a conference call to discuss this request, on June 13, 2025, the Board denied the request without conducting a

Petitioner the precise testimony it sought to introduce prior to sending the original email to the Board. EX2019 at 2.

conference call to understand the inconsistent statements made by Petitioner that the supplemental information would demonstrate. EX2015.

On July 24, 2025, Patent Owner sent another email to the Board requesting a pre-hearing conference to address this issue and that request was denied on August 12, 2025. EX2016.³

At the Oral Hearing on August 13, 2025, Patent Owner again raised the issue, indicating it was prepared to make an offer of proof at the hearing, and requested permission to make an offer of proof under FRE 103(a). This briefing was allowed pursuant to the request made at the Oral Hearing. EX2018.

Patent Owner's motion to submit supplemental information should have been authorized because the information—Dr. Nielson's trial testimony (1) reasonably could not have been obtained earlier, (2) is relevant to a claim for which trial has been instituted, and (3) consideration of the information is in the interests of justice. 37 C.F.R. §42.123(a)-(c). The request was timely made following the district court trial and the evidence to be presented involves inconsistent statements made by Petitioner Samsung's expert (who is the same expert in both proceedings). Allowing

³ As with the request for authorization to submit supplemental information, Patent Owner informed Petitioner that it intended to discuss an offer of proof and identified the information again in the parties' email exchange. EX2020 at 2.

the inconsistencies to stand is both prejudicial to Patent Owner and risks inconsistent rulings.

B. Patent Owner’s Offer of Proof is Legally Necessary and Proper

Admission and consideration of the evidence through Patent Owner’s offer of proof is proper in PTAB proceedings:

“In an inter partes review, we regard it as the better course to have a complete record of the evidence to facilitate public access, as well as appellate review.” *Sony Computer Entm’t Am. LLC v. Game Controller Tech. LLC*, IPR2013-00634, Paper 32, 31 (PTAB Apr. 14, 2015); *see also Gnosis S.p.A. v. S. Alabama Med. Sci. Found.*, IPR2013-00118, Paper 64, 43 (PTAB June 20, 2014).

ZF North America v. Stoneridge Control Devices, IPR2023-00273, Paper 31, at 58 (P.T.A.B. June 12, 2024).

Moreover, the Board relies on *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00053, Paper 66, 19 (PTAB May 1, 2014) regarding challenges to the admissibility of evidence:

As stated in *Corning*, similar to a district court in a bench trial, the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to evidence presented. *Id.* (citing *Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941) (stating, in the context of reviewing an administrative determination of the National Labor Relations Board

based on findings by a Trial Examiner, “We think that experience has demonstrated that in a trial or hearing where no jury is present, more time is ordinarily lost in listening to arguments as to the admissibility of evidence and in considering **offers of proof** than would be consumed in taking the evidence proffered One who is capable of ruling accurately upon the admissibility of evidence is equally capable of sifting it accurately after it has been received”)).

ZF North America, IPR2023-00273, Paper 31, at 57.

In *Ultratec*, the Federal Circuit held that the Board abused its discretion by refusing to admit and consider an expert’s inconsistent trial testimony during an IPR. 872 F.3d at 1272-73. In that case, the Board refused to enter newly-available, allegedly inconsistent expert testimony, where neither the reasons for the Board’s refusal nor the testimony were made of record. *Id.* Because of this lack of record, the Federal Circuit noted it had no means to review whether the Board reached an appropriate ruling. *See id.* at 1274.

The facts of this case parallel those in *Ultratec*. In *Ultratec*, CaptionCall retained the same invalidity expert in the district court litigation and the IPRs—***just like Samsung has done here***. In some instances, CaptionCall’s expert testified about similar issues in both proceedings—***just like Samsung’s expert has done here***. *Ultratec* sought to introduce the trial testimony into the IPRs (just like *Maxell*), alleging that the expert’s trial testimony conflicted with written declarations he made

in the IPRs. *Id.* at 1270. There, as here, the Board denied authorization to supplement the record.

The Federal Circuit reasoned: “In district court litigation, a party dissatisfied with a ruling excluding evidence is allowed to make an offer of proof to preserve error. Fed. R. Evid. 103. Parties in IPRs are not given similar protections. In this case, the PTO forbade even a ‘discussion of the contents or types of the particular documents sought to be entered.’” *Id.* at 1273. The Board also refused to admit into evidence “Ultratec’s email requesting authorization to file a motion to supplement the record. Excluding such discussion from the record contributes to the unreviewability of the Board’s decision-making.” *Id.* Failure to consider Patent Owner’s offer of proof here would result in the same finding because here, too, the email requesting authorization to file the motion to supplement the record also was not entered into the record.

III. DR. NIELSON’S INCONSISTENT TESTIMONY

A. Evidence Excluded

Denying Patent Owner’s request for authorization to file supplemental information resulted in exclusion of evidence (EX2017) that highlights inconsistent testimony by Dr. Nielson in this proceeding on the one hand, and testimony made at trial on the other. This inconsistent testimony is highly relevant because it demonstrates why Petitioner has not shown that Rogers discloses or renders obvious

limitation [1f] in every Ground of the Petition. Claim limitation [1f] recites “in said registering mode, there are provided a first registering mode for inputting input information by a pad of the finger, and a second registering mode for inputting input information by an end of the finger, and said second information relating to the identification of the user is produced upon basis of the input information, which is inputted at least in the first or second mode.” In the district court, Petitioner and Dr. Nielson argued that the two registering modes require showing two different algorithms. Here, however, Petitioner and Dr. Nielson only require the prior art to disclose one process with one result and fail to even mention the disclosure of any algorithms in Rogers. Petitioner’s inconsistent positions regarding the accused products and the prior art and Dr. Nielson’s testimony regarding the claimed “modes” should lead the Board to give little to no weight to Dr. Nielson’s positions in this proceeding and find Petitioner has not carried its burden in showing the claims are unpatentable.

B. Offer of Proof

Patent Owner’s evidence demonstrates inconsistent statements made by both Petitioner and its expert germane to all asserted Grounds, and particularly with respect to Patent Owner’s contention that Petitioner has failed to meet its burden of proof showing Rogers discloses two registration modes required by limitation [1f].

As with this IPR, Samsung relied on the testimony of Dr. Nielson in support of its positions regarding the '086 Patent at trial in the district court case.

1. Dr. Nielson's Inconsistent Testimony

In support of the Petition Dr. Nielson alleges that the single registration process of Rogers discloses both the claimed registering modes, but at trial he testified that an alleged single registration process did not meet the claims. For example, on May 23, 2025, Dr. Nielson testified that claim element **[1f]** of the '086 Patent is not met because, unlike the '086 Patent, the accused product allegedly had “one mode, one algorithm, one result”:

Q. At a high level, how is fingerprint registration in the Samsung phone different from what is in the '086 patent?

A. So what's different is it's a registration mode for this biometric information, the fingerprint. There's a single mode, and its registration is for a fingerprint. And there's **one mode, one algorithm, one result**. A fingerprint is registered at the end of it.

EX2017 at 896:18-24) (emphasis added). This testimony is highly probative of whether Rogers discloses limitation [1f].

Dr. Nielson clearly testifies that “a single mode, and its registration is for a fingerprint” and such a mode **does not** meet the claim because two modes require

two algorithms and two results. *Id.* In this proceeding, for Rogers, Dr. Nielson characterizes the single registration process of Rogers as meeting this same claim requirements for limitation [1f] for all asserted Grounds without ever making any reference to requiring multiple algorithms or multiple results. EX2009, 89:19-22. On the one hand, Dr. Nielson testified to the jury that when “there’s one mode, one algorithm, one result,” claim element [1f] is not met. On the other hand, when analyzing the prior art he concludes the opposite without identifying any evidence that Rogers discloses two algorithms and two results to establish that Rogers discloses or renders obvious two registration modes to meet claim element [1f]. EX1003, ¶124.

At trial Dr. Nielson testified further how the claim limitation [1f] requirements are not met when “there was a single mode of operation needed to register a fingerprint” as this means that “there was one algorithm, one mode, and one fingerprint registration all the way through,” just like a single registration process of Rogers all the way through. EX2017, at 901:20-902:7.

Q. So now you’re at 100 percent. What has happened?

A. At the end of the entire process, it has created a single fingerprint template. So each of the readings was used to create one fingerprint template for -- for this finger

Q. And -- and why is that important, sir?

A. Well, there was a single mode of operation here. It needed to register a fingerprint. As data is read in, it – it's being used to combine for the full fingerprint registration. But at the end, **there was one algorithm, one mode, and one fingerprint registration all the way through.**

Id. (emphasis added).

Yet, in this proceeding Dr. Nielson asserts the opposite, namely, that a **single** registration process of Rogers creating a **single** template *can* meet both the first and second registering modes in limitation [1f]. EX1003, ¶¶103, 124.

Neither the Petition nor Dr. Nielson (in this proceeding) identify two different algorithms to meet limitation [1f]. In fact, none of the secondary references relate to a “registration process.” The only reference relied upon for registration—as was made clear at the Oral Hearing—is Rogers. But there is **zero** evidence presented by Dr. Nielson or Petitioner that there are **two algorithms** in Rogers meeting the two registration modes of the '086 Patent.

At trial, Dr. Nielson testified how, in his opinion, the process for fingerprint registration in the accused products allegedly only uses one mode when the finger is lifted and put back down because “it's doing the same sensor reading to get a more full and accurate template” using the **same** algorithm to build the template rather

than using two different algorithms. “It’s not going into a different mode of operation or using a different algorithm.”

Q. Now, Dr. Wobbrock also testified that when you lift your finger up and put it back down during the process you just showed, the phone has entered a different mode; is that correct?

A. No.

Q. How do you know?

A. Well, again, it's doing the same sensor reading. Each time it's looking for more data to get a more full and accurate template. But -- but it’s not going into a **different mode** of operation or **using a different algorithm**

EX2017 at 903:18-904:2 (emphasis added).

Yet, in this proceeding, Dr. Nielson testified that a similar training process in Rogers meets limitation [1f]. *See, e.g.*, EX1003, ¶122; EX2009, 68:1-14, 70:5-17.

At trial, Dr. Nielson testified that an algorithm is a series of steps for computing a result like the fingerprint template:

Q. And -- and you’ve == you've used the word “algorithm” a few times. Can you just remind us what an algorithm means to a software engineer like yourself?

A. Sure. So an algorithm is just a series of steps for solving a problem or -- or computing a result. So when I say

there's an algorithm, there is an algorithm that is used to compute the fingerprint template.

EX2017 at 904:22-905:3. This is just like Fig. 4 of Rogers:

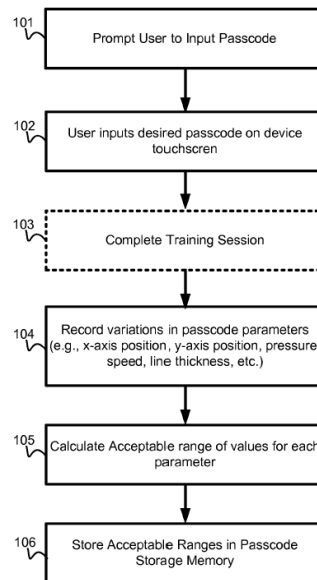


Fig. 4

EX1006, at Fig. 4., 8:42-67; Paper 16, at 31-35; Paper 25, 14-17.

In this proceeding, however, Dr. Nielson claims the opposite, equating this same process in Rogers to the claimed two modes instead of one, without ever identifying two different algorithms. EX1003, ¶¶103, 124; EX2009, 49:1-7.

At trial, Dr. Nielson testified that the '086 Patent requires two algorithms for the two registering modes producing two different outcomes:

Q. Okay. Let's have Page 665 of the trial transcript, and I believe it's Line 7 through 15. This is Dr. Balakrishnan's testimony, and he

was asked: And at the highest level, **in order for the two modes to be different, they have to be running different algorithms**, right? There's an answer. There's an: Uh-huh. And then he says "yes" on Line 12. He's asked: Yes, right? You agree with that? **Yes**. Do you remember that testimony, sir?

A. I do.

Q. Do you agree with Dr. Balakrishnan?

A. I do. You **need two algorithms for two different modes**.

Q. Okay. Can you explain what you mean by two algorithms for two different modes?

A. Sure. So, again, going back to the '086 patent, in the '086 patent, they have a mode, an algorithm for detecting. There's a pad. And that algorithm is, is it a wide area? And if it is, then you have a registration mode, and you register a pad. And it's **got a second algorithm**. Is it a small area? And if it's a small area, then, oh, it's a tip, and it registers a tip. Two algorithms, two outcomes.

EX2017, at 908:25-909:11. Yet, in this proceeding, Dr. Nielson fails to provide any support for Rogers disclosing two algorithms for two different registration modes. *See, e.g.*, EX1003, ¶¶115-125. This further supports Patent Owner's position for why the term "mode" requires construction. Paper 25, at 2-8.

There is no evidence in the record of Rogers or any reference disclosing **two algorithms** to correspond to the two registration modes of claim 1 of the '086 Patent. Paper 16, at 31-48, 52-54; Paper 25, at 14-18, 21-23.

In view of the foregoing conflicting testimonies under oath by Dr. Nielson, the PTAB should not award weight to Dr. Nielson's opinions, which is the sole basis for Petitioner's obviousness rationale.

IV. CONCLUSION

Patent Owner submits that the excluded evidence regarding Dr. Nielson's inconsistent statements is highly probative of why all Challenged Claims 1, 2, 4-7, and 9-14 are not obvious in view of Rogers in each Ground and why Rogers does not disclose the claimed "registering mode" in the challenged claims of the '086 Patent. Patent Owner respectfully preserves its objection to the exclusion of this evidence and requests that the record reflect the substance and purpose of the excluded proof.

Dated: September 2, 2025

Respectfully submitted,

/Robert G. Pluta /

Robert G. Pluta (Reg. No. 50,970)

MAYER BROWN LLP

71 S. Wacker Drive

Chicago, IL 60606

Telephone: (312) 701-8641

rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)

MAYER BROWN LLP

1999 K Street NW

Washington, D.C., 20006

ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on this 2nd day of September, 2025, a copy of the attached PATENT OWNER'S OFFER OF PROOF PURSUANT TO FRE 103(a) together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
Jim.Heintz@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

With a courtesy copy by electronic mail to:

dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: September 2, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.