

**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 REPLY IN SUPPORT OF ITS MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION**

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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 #
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

Petitioner does not dispute that the testimony and positions taken by Samsung in the District Court proceeding were material-to-patentability. Paper No. 39 at 4. Once Petitioner and its experts started taking inconsistent positions, it was Petitioner's duty to disclose its inconsistent positions regarding "two algorithms" and different branches to different outcomes. *See* 37 CFR § 42.11. Instead of honoring its duty of candor, it now attempts to recast its IPR positions and expert testimony as disclosing a two algorithm and branching requirement. A full review of the evidence demonstrates that Samsung never made such an argument in this proceeding. Rather, it demonstrates that Maxell has been consistent and Rogers fails to disclose the claimed "two modes." Maxell's motion was timely, proper, and clearly shows that Samsung, not Maxell, has taken inconsistent positions.

I. MAXELL'S MOTION IS TIMELY AND PROPER

Samsung argues that Dr. Nielson's noninfringement positions were disclosed prior to trial. Opp. Br. at 1-2. But the specifics regarding Petitioner's inconsistent positions on "two modes" and the requirement for two algorithms and branching was not made clear until trial. First, Samsung provides zero support for its assertion that "two algorithms" and "branching" were disclosed in its expert reports. They were not. Indeed a search of "branch" in Dr. Nielson's noninfringement expert report yields zero hits and a search for "algorithm" in Dr. Nielson's noninfringement expert report yields only one hit that is included in his CV and has nothing to do with any

of his non-infringement opinions. That explains why Samsung provides no support or citation for its assertion that such positions were disclosed. Second, Samsung points to Dr. Nielson's deposition in the IPR as disclosing these positions yet at no point in EX2009 does Dr. Nielson disclose any requirement of the claimed "two modes" needing two algorithms or branching. Opp. Br. at 2; EX2009. Samsung specifically identifies EX2009, 67:7-71:20, which fails to discuss "how a fingerprint sensor uses one mode and one algorithm" and also fails to discuss "discrete algorithmic structures." Opp. Br. at 2. Rather, Samsung's brief makes clear that it is now stretching Dr. Nielson's IPR deposition testimony to try and align it with his trial testimony. All this does is highlight the inconsistencies.

Moreover, there simply is no prejudice. Samsung knew of the inconsistency it was introducing at trial and should be held to that position here. It makes no difference that the issue at trial was infringement. If anything, it makes it more important for the Board to consider it here as Samsung cannot have it one way for infringement and another for invalidity. Indeed, the district court used Dr. Nielson's different interpretation of "two modes" in granting Judgment as a Matter of Law.

The motion was timely, consideration of Dr. Nielson's inconsistent positions are in the interest of justice, and there is no prejudice to Samsung.

II. SAMSUNG'S POSITIONS ARE CLEARLY INCONSISTENT

The testimony that Samsung highlights from trial (Opp. Br. at 4-6) aligns completely with the single registration and training process of Rogers. EX1006, Fig. 4, 7:7-16, 8:42-67. As Samsung acknowledges, Dr. Nielson clearly testified that the '086 Patent requires "two algorithms for two different modes." Opp. Br. at 5 (quoting EX2017, 908:25-909:11. At no point does Dr. Nielson require this of the prior art or point to anything in Rogers that meets this requirement.

Dr. Nielson goes even further and explained to the jury that "If there were multiple modes, there would be branching or some kind of way of showing the - - the way you take two paths - - kind of like how in the patent it showed you could end with a pad or a tip that's different routes out, this only has one route to one conclusion." Opp Br. at 5-6 (quoting EX2017, 907:24-908:7, 909:4-909:11). Rogers too, as clearly shown in Fig. 4, has only one route (no branching) to one conclusion (the storage of one passcode template).

Despite Samsung's attempt to mischaracterize Dr. Nielson's IPR testimony, the record is clear. At no point during this proceeding has Dr. Nielson testified that Rogers uses two different algorithms to use two different routes or branches to arrive at two different conclusions. Rather, Rogers use one route to achieve one result, the storage of a graphical passcode with flexibility for entry obtained through touching the device multiple times to get a more full and accurate template.

III. MAXELL HAS BEEN ENTIRELY CONSISTENT

A. Consistency with “two modes”

In order to show infringement, Maxell does **not** need to argue that the claim elements are met by a single algorithm for registration because Samsung’s own expert admitted at **trial** that the fingerprint registration process in the accused product includes a “sequence of algorithms.” EX2017 at 41-42. This is precisely what Maxell pointed to in its post-trial brief. Thus, no matter what confusion Samsung tries to create in the record now, one thing is clear. In **both** the District Court and PTAB proceedings, Maxell has consistently argued and **shown** by evidence that the claim requires two registration modes, not one registration process like Rogers.

For infringement, this was already proven in front of the jury with Dr. Nielson admitting that the accused products include a sequence of algorithms when discussing the fingerprint registration document for S23. *Id.* For validity in this proceeding, Maxell and Dr. Wobbrock argued the same when distinguishing from Rogers. POR, at 31-45; PO Sur-reply, at 15-18. While Maxell acknowledges that the District Court found otherwise in its Order granting Judgmental as a Matter of Law in accepting Dr. Nielson’s inconsistent positions, that testimony regarding the sequence of algorithms in the accused products is still part of the trial record and will be considered on appeal.

B. Consistency with “controller”

In an attempt to distract from Dr. Nielson’s inconsistencies, Samsung again tries to argue that Maxell has taken inconsistent positions regarding the “controller” term. First, as explained in the papers and during the hearing (Paper 40, 39:3-17), all of the briefing that Samsung identifies on “controller” relates to a different issue and, moreover, it clearly demonstrates that Maxell has been consistent across multiple proceedings because Dr. Wobbrock stated that “**any** type of processor” cannot be equated to a controller in this proceeding (EX2005 ¶ 111) and followed that up in District Court by pointing to a specific implementation of a **CPU**—not any type of processor—to correspond to a controller (EX1023 at 2), and then Dr. Wobbrock went further to **explicitly** identify two separate controllers as set forth in Android Requirements Specification: CPU executing operating system and implementing a separate **trusted execution environment (TEE)**, which Samsung did not dispute at trial. *See* EX2017 at 28-54 (Dr. Nielson not providing any non-infringement opinions for the “controller” limitations). Thus, Maxell does not **need** to be inconsistent because there is **no** explicit mention of two controllers in Rogers whereas two controllers are present in Samsung’s products.

Thus, once again, Maxell is able to keep its infringement and validity interpretations consistent because there is no need for Maxell to do the opposite as the evidence for infringement is consistent with its distinctions from prior art, which clearly fail to disclose the claimed two controllers.

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U.S. 8,982,086

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of September, 2025, a copy of the attached PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO SUBMIT SUPPLEMENTAL INFORMATION 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: September 24, 2025

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