

**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 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 #
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
RE49,669	2021
File history for RE49,669	2022

Patent Owner files this request for authorization to file additional materials, pursuant to Paper 44 and pursuant to that Order: (1) identifies the additional materials; (2) explains how and why the additional materials are related to the patent claims being challenged in this proceeding, or substantially similar claims, that have been previously adjudicated, post-issuance, before the Office, in district court, or at the U.S. International Trade Commission (ITC); and (3) explains how and why the additional materials should be considered in this proceeding.

Pursuant to the request made in the email from the parties dated September 26, 2025 and in response to the General Order (Paper 41) Patent Owner seeks authorization to submit related patent RE49,669 (EX2021) and its file history (EX2022) illustrating the Office's prior consideration of prior art from the Petition, for example, Rogers, Miyazawa, and Rosenberg.

The '086 Patent and its related parent have been repeatedly examined by the Office, through original prosecution, reexamination, and multiple reissues, many of which considered the precise references upon which the Petition is based. Indeed, when considering this history, it is clear Petitioner used these prior examinations by the Office as a roadmap for its Petition. *See generally* Paper 7, at 8-13 and citations therein.

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.

(1) identify the additional materials

Patent Owner identifies the additional materials as related patent RE49,669 (EX2021) and its file history (EX2022).

(2) explain how and why the additional materials are related to the patent claims being challenged in this proceeding, or substantially similar claims, that have been previously adjudicated, post-issuance, before the Office, in district court, or at the U.S. International Trade Commission (ITC);

RE49,669 addresses substantially similar patent claims as the claims being challenged in the '086 Patent. For example, like the '086 Patent, claim 1 of RE49,669 recites “wherein the registering mode includes a first registering mode for inputting first input information corresponding to a first portion of the finger and a second registering mode for inputting second input information corresponding to a

second portion of the finger.” EX2021, claim 1. Thus both the reissue patent and the patent challenged in this proceeding recite the two modes limitation that is currently in dispute.

(3) explain how and why the additional materials should be considered in this proceeding.

The file history of RE49,669 should be considered in this proceeding because the prior art forming the basis of the Petition in this case was also considered by the Examiner in allowing substantially similar claims. As part of a non-final rejection on October 20, 2022, the Examiner found the claims allowable if amended to overcome a 112 rejection.

VIII. ALLOWABLE SUBJECT MATTER

Claims 8-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), 2nd paragraph, set forth in this Office action.

8-14 define over the art in that none of the art associates a first password with the first information, which is the finger pad and the second password with the second information, as claimed.

EX2022, at 139.

The Examiner considered Rogers (8,683,582), Rosenberg (2007/0097096), and Miyazawa (8,633,909), which are the basis of the Grounds in the '086 Petition

13	20070097096	A1	2007-05-03	Rosenberg
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EX2022, at 62, 179.

14	8683582		2014-03-25	Rogers
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Id. at 67, 143.

10	8633909	B2	2014-01-21	Miyazawa et al.
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Id. at 188.

In a corrected notice of allowability, the claims were allowed on June 16, 2023¹:

¹ Similarly, two of the references—Rogers and Rosenberg—were previously presented to and considered by the Office during reexamination of the '086 Patent. EX1004 at 30-33; 77-79; 85-98; 158-162; 176-271. The Examiner also expressly stated that “The Examiner agree[s] that the combination did not have 2 registration modes, one for the finger tip and one for the finger pad, as Bayram has one registration mode for the signature.” EX1004 at 8.

VI. ALLOWABLE SUBJECT MATTER

Claims 8-16 are allowable.

8-16 define over the art in that none of the art stores a first password associated with first information and a second password associated with second information, where the first and second information include first and second reference identification information and first and second reference area ranges, and where a first password with the first information, where the first and second reference identification information are each based on both first and second portions of a finger, as claimed.

EX2022, at 607.

Rogers and Rosenberg were also considered during the file history of RE48,830, a prior reissue proceeding for US 8,654,093, the parent of the '086 Patent. *See* EX1005 at 83; 573. Claim 1 of RE48,830 includes a similar limitation reciting the “registering mode includes a first registering mode for inputting first input information corresponding to a first portion of the finger and a second registering mode for inputting second input information corresponding to a second portion of the finger.”

This additional information should be considered in connection with Patent Owner’s arguments that Petitioner failed to show that Rogers (relied upon for “two modes” in every Ground) disclosed the claimed two registering modes. Paper 16, at 31-47; Paper 25, at 14-18. It should also be considered in light of Patent Owner’s

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arguments that the Office has already considered substantially the same art and arguments as presented in the Petition. See Paper 7, at 3-14.

As such Patent Owner respectfully requests authorization to file RE49,669 (EX2021) and its file history (EX2022).

Dated: October 6, 2025

Respectfully submitted,

/Robert G. Pluta /

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CERTIFICATE OF SERVICE

I hereby certify that on this 6th 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:

James Heintz
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With a courtesy copy by electronic mail to:

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Respectfully submitted,

Date: October 6, 2025

By: /Robert G Pluta Reg No 50970/
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