

**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

Inter Partes Review No.: IPR2024-00828

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

**PETITIONERS' RESPONSE TO PATENT OWNER'S REQUEST FOR
AUTHORIZATION TO FILE MATERIALS FROM RELATED MATTERS**

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I. INTRODUCTION

PO's request to submit RE49,669 and its file history should be rejected, or if submitted, they should be given no weight. First, RE49,669 patent and its file history are not within the scope of the Board's Order (Paper 41). PO has never identified RE49,669 as a related matter under 37 C.F.R. § 42.8(b)(2). Nor does RE49,669 qualify as a "development" under the Board's Order given that it issued in September 2023, more than six months before the Petition and nearly a year before the POPR. Second, PO failed to raise RE49,669 and its file history in any of its prior filings, despite the fact that RE49,669 predates this proceeding, and has thus waived its arguments as to those materials. Third, the Board has already rejected in the Institution Decision relevance arguments similar to those PO makes in its request. *See* Institution Decision (Paper 9) at 45-48; POPR at 3-13. There is no basis for PO to now submit the RE49,669 materials.

II. DISCUSSION

A. RE49,669 Is Not Within the Scope Of The Board's Order.

The RE49,669 materials should not be submitted because they are not within the scope of the Board's Order. PO did not identify RE49,669 as a related matter in its mandatory notices. *See* Paper 5, Paper 15. PO's attempt to submit the RE49,669 and its file history thus does not comply with the Order's express instruction to submit materials only from proceedings that are "identified as a related matter under

37 C.F.R. § 42.8(b)(2).” *See* Order (Paper 41) at 1. PO ignores this “related matter” requirement. PO Request (Paper 45) at 2.

In addition, the RE49,669 proceedings do not qualify as a “development” under the Board’s Order. The Order states that “the parties must keep the Board apprised of developments regarding adjudications of validity or patentability” in related proceedings. Order (Paper 41) at 1 (emphasis added). RE49,669 issued in September 2023, long before Petitioners filed their April 2024 Petition and nearly a year before PO filed its Preliminary Response (in August 2024). RE49,669 and its file history are not “developments” in any sense. The Board should reject PO’s request.

B. PO Has Waived Its Arguments Regarding RE49,669.

The Board should also reject PO’s request because PO has waived its arguments as to RE49,669. PO unquestionably knew of RE49,669 at the time of filing its POPR in August 2024. Yet PO chose not to raise RE49,669 or its file history at any point in the POPR or in subsequent filings (e.g., the POR in January 2025 or PO’s Sur-Reply in May 2025). Significantly, PO’s request attempts to couple its argument for RE49,669 to arguments regarding the ’086 patent reexamination that it made in its prior submissions, confirming that the time for PO to make its arguments has long since passed. *See* PO Request (Paper 45) at 5-6 (arguing for consideration “in connection with Patent Owner’s arguments that Petitioner failed

to show that Rogers... disclosed the claimed two registering modes” and “in light of Patent Owner’s arguments that the Office has already considered substantially the same art”). PO has therefore waived any arguments for RE49,669. *See* Scheduling Order (Paper 10) at 9 (discussing waiver).

C. The Board Has Already Rejected PO’s Arguments.

The Board should reject PO’s request for the additional reason that the Board has already considered and rejected the relevance arguments that PO is making for RE49,669. PO’s request advances the same arguments for RE49,669 that PO made in the POPR about prior art that was previously considered in the reexamination of the ’086 patent and in the reissue file history of the parent to the ’086 patent, RE48,830. *See* POPR at 5-13. In fact, PO itself notes that the language of the RE49,669 claims resemble that of the RE48,430 claims and file history that the Board already considered. PO Request (Paper 45) at 5. The Board expressly rejected these arguments in the Institution Decision. *See* Institution Decision (Paper 9) at 46-47 (rejecting PO’s arguments and concluding that “none of the cited pages show that Rogers or the combination of Rogers and Rosenberg was given any consideration by the Office during reexamination of the ’086 patent”). PO fails to show how consideration of RE49,669 would prove its already-rejected argument to a greater extent than the evidence that the Board already considered, or would lead to any

different result. Thus, the Board should reject PO's request. To the extent the Board does admit PO's new materials, it should afford them no weight.

Not only does PO recycle its failed arguments for the '086 patent reexamination, it presents a misleading account of what happened in that reexamination. PO claims that the Patent Office "considered" Rogers and Rosenberg in the reexamination and then suggests that the Examiner considered "the combination" and agreed it did not disclose the claims:

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.

PO Request (Paper 45) at 4 n. 1. This is not correct. The Patent Office has never "considered" Rogers or the combination of Rogers and Rosenberg. The statement about the Examiner's findings during the '086 reexamination (the second sentence in PO's footnote 1 above) involved a different combination—Bayram and Rosenberg—at issue during reexamination. The Board already addressed PO's argument on Bayram and Rosenberg. See Institution Decision (Paper 9) at 46 ("none of the cited pages show that Rogers or the combination of Rogers and Rosenberg

was given any consideration by the Office during the reexamination of the '086 patent").¹ PO's footnote highlights that its request lacks merit.

III. CONCLUSION

For the reasons discussed above, PO's request should be rejected, or, to the extent that the Board grants PO's request, it should afford the RE49,669 materials no weight.

Date: October 14, 2025

Respectfully submitted,

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¹ PO's request cites the exact same pages of the reexamination file history that it identified in the POPR and that the Board addressed in the Institution Decision. *Compare* PO Request (Paper 45) at 4 n.1 (excerpted above), *with* POPR at 4 (also citing Ex. 1004 at 30-33; 77-79; 85-98; 158-162; 176-271), *and* Institution Decision (Paper 9) at 46 (addressing POPR at 4 as well as the same EX1004 cites).

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on October 14, 2025, a true and correct copy of the Petitioners' Response to Patent Owner's Request for Authorization to File Materials was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

maxell-samsung-service@mayerbrown.com

A courtesy copy was sent electronically to counsel for Patent Owner in the District Court Litigation:

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