

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.

IPR2024-00828
Patent 8,982,086 B2

Before NEIL T. POWELL, TERRENCE W. McMILLIN, and
KEVIN C. TROCK, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER
Denying Joint Motion For Entry of Protective Order
and Expunging Exhibit 1028
37 C.F.R. § 42.54

On September 19, 2025, an “Order—Related Matters Update” (“Related Matters Order” (Paper 41)) was entered in this proceeding. The Related Matters Order provided:

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). The parties must alert the Board to any such developments within five business days, by sending an email to Trials@uspto.gov, and file in the docket of this proceeding relevant materials from the related matter(s).

Related Matters Order 1–2. The Related Matters Order further provided that “the parties shall send a joint email to Trials@uspto.gov providing developments in any related matter as set forth above within five business days (if the development has already occurred) or within five business days of the development occurring.” *Id.* at 2.

On September 26, 2025, the parties sent a joint email to the Board that said:

[T]he parties jointly alert the Board to the fact that on September 18, 2025, in the related matter *Maxell, Ltd v. Samsung Electronics Co, Ltd., et al.*, Civil Action No. 5:23-CV92-RWS (E.D. Tex.), [“the related District Court Action”] the court issued an order granting judgment as a matter of law (JMOL) that claim 1 of the ’086 patent is invalid under 35 U.S.C. 112 and not infringed. That order was filed under seal. The parties jointly request authorization to submit a motion for entry of the Board’s standard protective order so that the parties may file the district courts’ order. In addition, Patent Owner wishes to submit additional documents in this matter responsive to the Board’s General Order. Specifically, Patent Owner seeks

authorization to submit related patent RE49,669 and its file history illustrating the Office's prior consideration of prior art from the petition (Rogers, Miyazawa, Rosenberg). Petitioner does not agree that those documents are responsive to the Board's general order and therefore opposes the submission of those documents.

Email to Board from Michael Jay (on behalf of the parties) dated September 26, 2025.

In response to this email, an Order was entered on September 29, 2025 (Paper 44) in which the parties were granted authorization to submit a motion for entry of the Board's standard protective order and further ordering that

[W]ithin three (3) days, Petitioner shall file the Order entered on September 18, 2025, in the Related District Court Action in the form made publicly available as an exhibit in this proceeding. If a full and complete copy of said Order was not made publicly available, Petitioner shall further file, under seal, a full and complete copy of said Order as an exhibit in this proceeding within three (3) days.

Paper 44, 3.

On October 8, 2025, the parties filed a Joint Motion for Entry of Default Protective Order and To Seal Pursuant to 37 C.F.R. § 42.54 (Paper 46). This Joint Motion provided that "The parties anticipate that . . . supplemental information to be filed pursuant to 37 C.F.R. § 42.123(b) will include highly sensitive and confidential business information of the parties." However, this proceeding is ripe for entry of a final written decision and is, therefore, very nearly over. The Board does not anticipate authorizing the filing of any additional supplemental information including highly sensitive and confidential business information.

There is pending Patent Owner's Motion To Submit Supplemental Information (Paper 39) in which leave is sought to submit Exhibit 2017 (a public trial transcript). Exhibit 2017 has been filed as publicly available.

There is also pending Patent Owner's Request for Authorization to File Materials from Related Matters (Paper 45) in which leave is sought to file issued U.S. Patent No. RE49,669 E (Exhibit 2021) and its file history (Exhibit 2022). An issued patent and its file history are publicly available documents and both Exhibit 2021 and Exhibit 2022 have been filed as publicly available.

Only one document, Exhibit 1028, has been filed in this proceeding as "Board and Parties" only. Exhibit 1028 is the full and complete copy of the Order entered on September 18, 2025, in the Related District Court Action. An additional copy of the Order entered on September 18, 2025, in the Related District Court Action in the form made publicly available was also filed as Exhibit 1026. The only differences between Exhibit 1026 (publicly available) and Exhibit 1028 (Board and Parties only) are three small redactions in Exhibit 1026 on page 15. These redactions are in a section of the Order dealing with infringement of U.S. Patent No. 11,017,815 (*see* Ex. 1026, 10–18). The issue of infringement of the '815 patent is not before us in this proceeding and the redacted information (which we have reviewed in Exhibit 1028) has no bearing on any issue in this proceeding and is immaterial and irrelevant. Accordingly, no need exists to have the Order without these redactions (Exhibit 1028) in the record for this proceeding.

The Board does not anticipate the filing of any highly sensitive and confidential business information in any additional papers or exhibits. Thus,

there is no need for entry of a protective order in this proceeding and we do not anticipate any such need arising.

For these reasons, we deny (without prejudice if the need for a protective order arises) the motion for entry of a protective order and we expunge Exhibit 1028 from the record of this proceeding.

ORDER

Now, therefore, it is

ORDERED that the Joint Motion for Entry of Default Protective Order and To Seal Pursuant to 37 C.F.R. § 42.54 (Paper 46) is *denied*; and

FURTHER ORDERED that Exhibit 1028 shall be expunged from the record in this proceeding.

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FOR PETITIONER:

Gianni Minutoli
James Heintz
DLA PIPER LLP (US)
Gianni.Minutoli@us.dlapiper.com
Jim.Heintz@us.dlapiper.com
dla-samsung-maxell@us.dlapiper.com

FOR PATENT OWNER:

Robert G. Pluta
Amanda S. Bonner
Saqib J. Siddiqui
MAYER BROWN LLP
rpluta@mayerbrown.com
asbonner@mayerbrown.com
ssiddiqui@mayerbrown.com
maxell-samsung-service@mayerbrown.com