

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
Conduct of the Proceeding
37 C.F.R. § 42.5

BACKGROUND

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:

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.

On September 29, 2025, an Order (Paper 44) was entered that provided:

that within five (5) days, to the extent either party wishes to file additional materials in this proceeding, it shall file a request for authorization to file the additional materials: (1) identifying the additional materials; (2) explaining how or 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) explaining how or why the additional materials should be considered in this proceeding.

Paper 44, 3.

On October 5, 2025, Patent Owner's Request for Authorization to File Materials From Related Matters (Paper 45, "Request") was filed. In its Request, "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." Request 1. On October 14, 2025, Petitioner's Response to Patent Owner's Request for Authorization to File Materials from Related Matters (Paper 48, "Response") was filed. In this Response, Petitioner argues that "P[atent]O[wner]'s request to submit RE49,669 and its file history should be rejected, or if submitted, they should be given no weight." Response 1. For the reasons set forth below, we grant Patent

Owner's request to submit Exhibits 2021 and 2022 and we will consider these exhibits in this proceeding.¹

ANALYSIS

In arguing why Exhibits 2021 and 2022 should be allowed to be submitted and considered, Patent Owner contends that:

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.

. . . .

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.

. . . .

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.

Request 2–3.

In its Response, Petitioner argues:

P[atent]O[wner]'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).

¹ Exhibits 2021 and 2022 were filed with the Request and, thus, have already been submitted. Exhibits 2021 and 2022 are already in the record for this proceeding and should not be submitted again.

P[atent]Owner] 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 [Paper 7]. Second, P[atent]Owner] 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 P[atent]O[wner] makes in its request. *See* Institution Decision (Paper 9) at 45-48; POPR [Paper 7] at 3-13. There is no basis for P[atent]O[wner] to now submit the RE49,669 materials.

Response 1.

We determine to allow Exhibits 2021 and 2022 to be submitted. The treatment of art cited in this proceeding by the Office in connection with the reissue application proceedings reflected in Exhibits 2021 and 2022 is of potential benefit in our analysis of that same art in this proceeding.

With regard to Petitioner’s argument that Exhibits 2021 and 2022 should be given no weight (Response 1, 5), we do not at this time determine the weight that should be given to these exhibits. To the extent necessary and appropriate, we will consider Patent Owner’s arguments as to how and why Exhibits 2021 and 2022 should be considered in this proceeding (*see* Request 3–6) and Petitioner’s counter arguments (*see* Response 2–5) in connection with preparation of the final written decision.

ORDER

IT IS HEREBY ORDERED that Patent Owner’s Request for Authorization to File Materials From Related Matters (Paper 45, “Request”) is *granted*.

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