

**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' AUTHORIZED RESPONSE
TO DIRECTOR REVIEW REQUEST**

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I. INTRODUCTION

PO's Request offers an extensive array of incorrect or misleading arguments that should all be rejected. Although PO alleges that the '086 patent "has survived countless reviews by the Office" (PO Request at 2), in reality the patent has been subject to just two—its initial prosecution and a reexamination—neither of which considered the merits of the two distinct prior art combinations that invalidate the claims here.¹ The Board's final written decision here, which over the course of seventy-seven pages addresses the three substantive arguments that PO raised in defense of its patent, finds extensive support in the intrinsic evidence and properly rejects the extrinsic evidence submitted by PO and its expert Dr. Wobbrock.

Importantly, the Board was not alone in its conclusions. In a parallel proceeding in the Eastern District of Texas, the Court recently issued a JMOL order finding noninfringement and invalidating the '086 patent for lack of written description. EX1026. In that order, the Court found that PO's expert offered testimony that "was not based on any record evidence ([EX1026] at 7, 9), arbitrary (*id.*), contrary to the evidence (*id.* at 7–8), unjustified (*id.* at 8), *ipse dixit* (*id.* at 9), conclusory (three times) (*id.*), insufficient to support a jury verdict (three times) (*id.*

¹ PO's Request does not even address the Board's decision to invalidate the claims under Grounds 3 and 4. FWD 77. The Request can be denied on this basis alone.

at 9, 27), untethered from the Specification (three times) (*id.* at 28, 30, 31), inconsistent (*id.* at 29), insufficient to support his opinion (*id.* at 29–30), unsupported (*id.* at 30), and not to be credited by a reasonable jury (*id.* at 31).” *See* FWD 9, n.13 (citing EX1026). Likewise, PO’s Request for Director review of the Board’s final written decision invalidating all challenged claims of the ’086 patent should be rejected.

II. DISCUSSION

A. The Board Sufficiently Addressed PO’s Arguments Regarding the Different Prior Art at Issue During Reexamination.

PO first challenges the Board’s decision to institute proceedings here at all because it claims the prior art the Board considered in this IPR proceeding overlaps with the prior art considered during the patent’s prosecution and re-examination. PO Request at 4-8. This is wrong for several reasons.

This portion of PO’s Request should be rejected on two threshold grounds. First, this argument is untimely, because the deadline for Director review of the Institution Decision has long passed. 37 C.F.R. § 42.71(d). Second, the Director has already rejected PO’s argument regarding institution: the Director reviewed and denied a nearly identical request from PO after the institution decision. *See* PO Request re ID (Paper 11); Order Denying Director Review (Paper 13).

On the merits, this portion of PO's Request remains as incorrect as when PO first argued it over a year ago. Contrary to PO's continued attempts to mischaracterize the record, no previous evaluation of the '086 patent or any related patent has expressly considered the prior art that forms the basis of the Board's decision here. Although PO misleadingly suggests (as it did in past submissions to the Board) that the Patent Office considered Rogers and Rosenberg during reexamination, the Office has never substantively considered Rogers or the combination of Rogers and Rosenberg. *See* Pet. Resp. (Paper 48) at 4; Institution Decision (Paper 9) at 46. PO's statement about the Examiner's findings during the '086 reexamination (i.e., the bold language on page 5 of PO's Request) involved a different combination—of Bayram and Rosenberg—at issue during reexamination. EX1004, 8. Indeed, the Board addressed and rejected this very argument from PO in its Institution decision. *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”).

For this reason, PO's criticisms of the Final Written Decision necessarily fail. Citing the Patent Office's September 16, 2025 Memorandum, PO argues for example that the Final Written Decision needed to include an explanation for why the IPR outcome should differ from that of the reexamination. PO Request at 6. But PO's summary of the Memorandum uses ellipses to hide that the Board's Institution

Decision was by itself sufficient to meet the Patent Office guidance. *Compare* PO Request at 6 (stating that “the Board shall explain in the ... final written decision why a different outcome is warranted”) *with* U.S.P.T.O. Memorandum (Sept. 16, 2025) (stating that “the Board shall explain in the institution or final written decision why a different outcome is warranted”) (underlines added by Petitioners). The Director has already reviewed the Institution Decision and deemed its explanation sufficient.

PO also argues that the Board needed to explain in detail why the outcome of the IPR proceeding differed from the Examiner’s consideration of Bayram and Rosenberg during reexamination. Not so. As the Board concluded in its Institution Decision—this IPR proceeding involves different prior art and different combinations than the reexamination did. Thus, the Board was not considering “the same or substantially the same evidence and/or arguments” in this proceeding as during the reexamination. Although PO argues to the contrary, its Request—like its previous submissions—never shows how Bayram and Rogers, or the combination of either with Rosenberg, allegedly overlap. Moreover, PO concedes that its arguments in the reexamination proceedings differed from those here because in the reexamination—unlike here—PO challenged the motivation to combine the Bayram and Rosenberg references, whereas here PO conceded that it would have been obvious to combine Rogers and Rosenberg. PO Request at 7; FWD 61.

In any event, even if PO were correct that it has consistently advanced the same arguments across proceedings (it has not), those arguments are clearly wrong, as discussed in detail below.

B. The Board's Construction of the "First Registering Mode" and "Second Registering Mode" Is Correct.

The Board's construction of "first registering mode" and "second registering mode" finds extensive support in the intrinsic record and properly rejects the self-serving construction that PO offered. For clarity, the relevant claim language appears below with the "registering mode" terms in bold. The excerpted language includes both limitation 1[f]—which contains the disputed terms—and limitation 1[c], which provides important context for understanding the Board's conclusions.

[1c] a first controller configured to control the information processing apparatus to operate into two operating modes: at least an identification mode and a registering mode, as the operating mode thereof;

...

[1f] in said registering mode, there are provided a **first registering mode** for inputting input information by a pad of the finger, and a **second registering mode** for inputting input information by an end of the finger, and said second information relating to the identification of the user is produced upon basis of the input information, which is inputted at least in the first or second mode.

The Board construed these two "registering mode" terms to have their plain and ordinary meaning, which according to the claim language means "that the 'first

registering mode' and the 'second registering mode' are 'mode[s] for inputting input information' that are 'provided in said registering mode' which is one of two delineated 'operating modes.'" FWD 18.² In making this determination, the Board rejected PO's narrower proposed construction, which would have required the "first registering mode" and "second registering mode" of limitation 1[f] to be distinct "operational states" wherein "the same action has different results or effects based on the current value of the system state." FWD 14; Pet. Reply (Paper 23) at 2.

The Board's explanation for this determination—spanning twenty pages—is detailed, comprehensive, and entirely correct. FWD at 13-34. PO addresses almost none of it. Instead, PO conjures up arguments that find no basis in the record. For example, PO accuses the Board of reaching the "erroneous" conclusion to afford these terms their plain and ordinary meaning while failing to mention that PO itself proposed this alternative. *See* FWD 14 (noting that PO's Sur-reply argues that "[t]he Board should either adopt Patent Owner's proposed constructions **or, alternatively,** give the terms their plain and ordinary meaning") (emphasis in FWD). PO also misleadingly (and incorrectly) argues that the Board's construction reads out

² As it does with many other aspects of the FWD, PO's Request selectively omits portions of the Board's analysis to make it appear that the Board simply construed these terms as "different input methods." *See* PO Request at 8 (citing FWD at 57).

“registering” from “registering mode” and “operating” from “operating mode” (PO Request at 8), without acknowledging that the Board rejected PO’s proposed construction because it would have had that very effect. *See* FWD 15-18 (including footnote 17, which explains that PO’s proposed construction—which effectively required every “mode” recited in the claims to be an “operating mode”—“would make ‘operating mode’ redundant and the word ‘operating’ superfluous”).

Contrary to PO’s mischaracterizations, the Board’s Final Written Decision correctly evaluates all evidence and arguments for this claim construction issue. In its Request, apart from the misleading arguments above, PO merely reprises old arguments that the Board properly weighed and rejected. For example, PO argues that the claim language requires the “first registering mode” and “second registering mode” of limitation 1[f] to be interpreted as “sub-operating modes” of the “registering mode” recited in limitation 1[c]. PO Request at 9. In rejecting PO’s argument, the Board appropriately recognized that: (1) limitation 1[f] does not identify the “first registering mode” and “second registering mode” as “operating modes” but rather as “modes for inputting input information”; (2) limitation 1[c] recites a “registering mode” that the first and second modes of 1[f] are provided within, and expressly identifies that “registering mode” as one of “two” claimed “operating modes” (along with the “identification mode”); and (3) interpreting the “first registering mode” and “second registering mode” from limitation 1[f] as

“operating modes” would effectively cancel out the limitation 1[c] recitation of the “registering mode” and “identification mode” as the apparatus’s two claimed “operating modes.” FWD 15-18. PO’s Request addresses none of that.

The Board also considered and properly rejected PO’s arguments about the rest of the intrinsic evidence. FWD 18-28. As an initial matter, the Board noted the undisputed fact that PO did not identify any lexicography or disclaimer to support its proposed narrowing construction. FWD 19, 29. This alone precludes PO’s narrowing construction as a matter of law and renders its Request here improper. *See* FWD 12 (quoting *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014) (“[T]he specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal.”)).

In any event, the portion of PO’s Request directed to claim construction merely reprises PO’s untenable argument that two figures from the ’086 patent labeled “calibration” (Figs. 10A and 10B) should be considered examples of the claimed “registering modes” of limitation 1[f], while three figures labeled “registration” should not (Figs. 11A, 11B, 11C). PO Request at 9-10. Just as it did in the underlying proceeding, PO cites Figure 9 of the ’086 patent—a flow chart of the password registration process—to argue that the inclusion of steps for “calibration” means that those figures relate to registration. *Id.* In more than ten pages of analysis—none of which PO’s Request discusses in any detail—the Board

explained exactly why PO's position is wrong. FWD 18-28. The Board also cited PO's acknowledgement, during reexamination, that Figs. 11A, 11B, and 11C—and not the “calibration” figures—provide written description support for the “first registration mode” and “second registration mode” terms recited in claim 5, which derives its antecedent basis from claim 1 and limitation 1[f] in particular. FWD 27-28 (citing Pet. Reply 5-6 and EX1004, 75). PO fails to address these findings as well.

Finally, PO reiterates its unfounded allegations that Samsung and its expert Dr. Nielson took inconsistent positions between this proceeding and the district court litigation. PO is wrong. PO filed multiple briefs on this topic along with hundreds of pages of transcripts (Papers 36, 39, and 43), but the Board denied PO's argument “because it is based on the false premise that the testimony of Petitioner's expert, Dr. Seth Nielson, in this proceeding is inconsistent with certain trial testimony given in a related district court case.” Order (Paper 50) at 2. The Board's conclusion that PO advanced a “false premise” in its Motions reflects its assessment not only of PO's submissions, but also of Petitioners' briefings and evidence, which PO's Request pretends did not exist. *See* Pet. Submissions (Papers 38, 42, 47). More importantly, PO fails to mention that the Board also denied its motions as untimely, a holding that PO does not dispute here and that therefore moots PO's criticisms on the substance of the Board's decision (*id.* at 3-4).

In truth, the Board's untimeliness finding resulted from PO's continued attempts to exploit the non-overlapping IPR and district court schedules to advance different arguments in each proceeding. Pet. Resp. (Paper 38) at 2; Pet. Sur-reply (Paper 47) at 2. As discussed below, it was PO and its expert Dr. Wobbrock—not Dr. Nielson—that offered contradictory positions between the two matters in an attempt to preserve validity while arguing for infringement of the '086 patent.

C. The Board Correctly Found the Claimed First and Second Registering Modes Are Obvious.

The portion of PO's Request relating to the Board's substantive findings of obviousness relies on two demonstrably wrong assertions. First, PO incorrectly alleges that the Final Written Decision "fails to find, in either reference [Rogers or Rosenberg], the disclosure of two registering modes" as recited in limitation 1[f]. PO Request at 13-14. In so doing, PO ignores that its entire argument for distinguishing the prior art for limitation 1[f] revolved around its narrow, unsupported construction of "first registering mode" and "second registering mode." Thus, when the Board rejected PO's claim construction argument (FWD 14-34), PO had no substantive argument left as to why the prior art combination allegedly failed to disclose the claim elements. Moreover, PO did not dispute the obviousness of the combination itself; just the disclosure of the registering modes. FWD 61 ("Patent

Owner does not dispute Petitioners' showing as to motivation to combine the relevant teachings of Rogers and Rosenberg”).

Regardless, the Board discussed this topic at length. FWD 14-38, 54-61. That discussion includes, among other things, the Board's acknowledgment that “[t]he showing in the Petition as to this limitation is lengthy, detailed, and well-supported,” as well as the Board's findings—with supporting citations—that Rogers discloses “creating and storing a desired graphical passcode” based on using the size or area of the object or fingertip applied to the touch surface, i.e., distinguishing touch inputs using first and second registering modes. FWD 54. The Board also explained that PO itself admitted that Rogers teaches the ability to “distinguish between inputting two different types of user input . . . during the registration process” by “discriminat[ing] between smaller and larger contact areas” (FWD 58 (citing POR at 32-33)), which is precisely how the '086 patent itself discusses distinguishing between input types in the first and second registering modes. FWD 3-6, 14-28.

Second, PO incorrectly argues that the Board erred when it decided that the testimony of PO's expert Dr. Wobbrock should be given little to no weight in this proceeding. PO Request at 14-15. The Board's decision was justified in view of Dr. Wobbrock's well-documented history of inconsistent statements, which include blatant contradictions like the following:

Type of Testimony	Quote from Dr. Wobbrock
Validity Testimony in IPR Proceeding (EX2005 ¶ 111)	"A POSITA would not equate any type of processor to a controller."
Infringement Testimony in District Court Trial (EX1023 at 2)	"For our purposes, controller, processor, they're -- they're the same."

See Pet. Submissions (Papers 38, 42, 47). Based on the record evidence, which PO does not address, the Board "found Dr. Wobbrock's testimony to be contrary to the plain and ordinary meaning of the claims, untethered from the Specification, unsupported by the evidence, inconsistent, arbitrary, and conclusory," "accord[ed] the testimony of Dr. Wobbrock little or no weight," and stated that it "view[ed] the testimony of Petitioner's expert, Dr. Nielson, as more credible and persuasive as it tracks more closely with the '086 patent and the cited art." FWD 9, n.13. PO offers no reason other than its say-so as to why the Board erred in this determination.

The District Court's independent findings also underscore the problems with Dr. Wobbrock's testimony. As described above, in an order that the that the District Court issued after trial (EX1026)—which the Board cites in the Final Written Decision—the Court found that Dr. Wobbrock's testimony was, among other things, contrary to the evidence, conclusory, untethered to the specification, and inconsistent. FWD 9, n.13. These findings, as an independent assessment by another tribunal, reinforce that PO has no basis to claim that the Board erred.

III. CONCLUSION

For these reasons, PO's Request for Director Review should be rejected.

Date: December 8, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on December 8, 2025, a true and correct copy of the Petitioners' Authorized Response to Director Review Request was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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

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