

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2024-00867
Patent 10,176,848 B2

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

TROCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

On September 19, 2025, an “Order—Related Matters Update” (“Related Matters Order” (Paper 36)) 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).

Paper 36, 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 an email to the Board stating:

Pursuant to the Board’s Order on September 18, 2025 (Paper 26)¹, the 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-CV-92-RWS (E.D. Tex.), the court issued an order granting judgment as a matter of law (JMOL) that claims 11 and 12 of the ’848 patent are 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.

¹ The correct paper number for the Related Matters Order entered in this case is Paper 36. The parties’ reference to Paper 26 appears to be an error.

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 U.S. Patent Nos. 11,094,350; 11,948,605; 11,727,960; 12,400,685; 10,418,069 and their respective file histories illustrating the Office's prior consideration of prior art from the petition (Nozaki and Haitani). Petitioner does not agree that those documents are responsive to the Board's general order or the Board's September 18, 2025 Order and therefore opposes the submission of those documents.

Ex. 3004.

The purpose of this Order is to respond to the September 26, 2025, email from the parties and to order additional related briefing to determine whether any materials from another proceeding should be submitted and considered by the Board.

Accordingly,

IT IS HEREBY ORDERED that the parties' joint request for authorization to submit a motion for entry of the Board's standard protective order is GRANTED;

FURTHER ORDERED that, within three (3) days, the parties shall jointly file the referenced JMOL dated September 18, 2025, in the form made publicly available as an exhibit in this proceeding. If a full and complete copy of said JMOL was not made publicly available, the parties shall further file, under seal and made available only to the parties and the Board, a full and complete copy of said JMOL; and

FURTHER ORDERED that within five (5) days, to the extent either party wishes to file additional materials in this proceeding, including Patent Owner's opposed request to file documents related to U.S. Patents 11,094,350; 11,948,605; 11,727,960; 12,400,685; 10,418,069; and

12,284,437, the party shall file a request for authorization to submit such additional materials by: (1) identifying the additional materials; (2) explaining how such 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) further explaining why such additional materials should be considered in this proceeding. Said request shall be limited to ten (10) pages (exclusive of any appendices). A response to said request for authorization may be filed by the opposing party within five (5) days thereafter and shall be limited to ten (10) pages (exclusive any appendices).

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