

**IN THE 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

Case: IPR2024-00867

U.S. Patent No. 10,176,848

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

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	1st Amended Docket Control Order from District Court Litigation
2002	Original Docket Control Order from District Court Litigation
2003	Maxell’s Supplemental Preliminary Election of Asserted Claims
2004	Defendants’ Preliminary Election of Prior Art
2005	U.S. Patent Application No. 2009/0135269
2006	U.S. Patent No. 8,488,847
2007	Samsung invalidity contentions (Gallagher)
2008	Samsung invalidity contentions (Nakashima)
2009	U.S. Patent Application No. 2007/0098303
2010	U.S. Patent Application No. 2007/0019083
2011	CNET Iphone Article
2012	MacRumors Article
2013	CNET iPhone Face ID Article
2014	iPhone User Guide IOS 12—Find people in Photos
2015	iPhone User Guide IOS 18—Find people in Photos
2016	iPhone User Guide IOS 13—Find people in Photos
2017	iPhone User Guide IOS 14—Find people in Photos

2018	iPhone User Guide IOS 15—Find people in Photos
2019	iPhone User Guide IOS 16—Find people in Photos
2020	iPhone User Guide IOS 17—Find people in Photos
2021	Apple Support—Use the People & Pets Album
2022	Google Photos Help—Set up & manage your face groups
2023	Microsoft Support—Group photos by faces
2024	Amazon Help & Customer Service—Learn More about image
2025	Nikon Press Release
2026	JP No. 2008-130678
2027	U.S. Patent No. 9,159.368
2028	PC Mag Dictionary
2029	McGraw-Hill Dictionary
2030	Declaration of Ravin Balakrishnan, Ph.D.
2031	Deposition of Benjamin B. Bederson (January 23, 2025)
2032	Hearing Demonstratives
2033	U.S. Patent No. 11,094,350
2034	U.S. Patent No. 11,094,350 file history
2035	U.S. Patent No. 11,948,605
2036	U.S. Patent No. 11,948,605 file history
2037	U.S. Patent No. 11,727,960

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2038	U.S. Patent No. 11,727,960 file history
2039	U.S. Patent No. 12,400,685
2040	U.S. Patent No. 12,400,685 file history
2041	U.S. Patent No. 10,418,069
2042	U.S. Patent No. 10,418,069 file history

Patent Owner files this request for authorization to file additional materials, pursuant to Paper 37 and pursuant to that Order: (1) identifies the additional materials; (2) explains how and 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) explains how and why the additional materials should be considered in this proceeding.

Pursuant to the request made in the email from the parties dated September 26, 2025 and in response to the General Order (Paper 36) Patent Owner seeks authorization to submit U.S. Patent Nos. 11,094,350 (EX2033) and its file history (EX2034); 11,948,605 (EX2035) and its file history (EX2036); 11,727,960 (EX2037) and its file history (EX2038); 12,400,685 (EX2039) and its file history (EX2040); and 10,418,069 (EX2041) and its file history (EX2042) illustrating the Office's prior consideration of prior art from the Petition (Nozaki and Haitani).

The General Order states that 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.’” Paper 36

(emphasis added). The General Order makes clear that the Board must also be updated on any findings of substantially similar claims by the Office.

(1) identify the additional materials

Patent Owner identifies the additional materials as U.S. Patent Nos. 11,094,350 (EX2033) and its file history (EX2034); 11,948,605 (EX2035) and its file history (EX2036); 11,727,960 (EX2037) and its file history (EX2038); 12,400,685 (EX2039) and its file history (EX2040); and 10,418,069 (EX2041) and its file history (EX2042).

(2) explain how and 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);

Each related patent addresses substantially similar patent claims as the claims being challenged in the '848 Patent (Claims 11, 12, 16, 17, 19, 20, and 84).

Patent No.	Exemplary similar limitation
11,094,350 (EX2033)	“control the reproducer as a first reproducing mode to sequentially reproduce the secondly selected plurality of image information,”; “control the reproducer as a third reproducing mode to sequentially reproduce the thirdly selected plurality of image information, and” Claim 1

11,948,605 (EX2035)	“wherein the processing circuitry is further configured to control the reproducer to selectively and sequentially reproduce the image information picked out based on the predetermined condition in the reproducing mode set from one of the first reproducing mode, the second reproducing mode, and a third reproducing mode, and” Claim 3
11,727,960 (EX2037)	“wherein the processing circuitry is further configured to control the reproducer to selectively and sequentially reproduce the image information picked out based on the predetermined condition in the reproducing mode set from one of the first reproducing mode, the second reproducing mode, and a third reproducing mode, and” Claim 4
12,400,685 (EX2039)	“wherein a first person with a face is obtained by newly photographing the first person in a photographing mode and is thereafter registered as a first specific person, and wherein a second person with a face is obtained by newly photographing the second person in a photographing mode and is thereafter registered as a second specific person, and” Claim 1; <i>See</i> '848 Patent, Claim 84.
10,418,069 (EX2041)	“The recording and reproducing method according to claim 13, wherein the controlling unit further controls the reproducing unit to reproduce the video information in the reproducing mode set from one of the first reproducing mode, the second reproducing mode, and a third reproducing mode, and wherein a reproducing time required for reproducing the video information under the third reproducing mode is longer than the reproducing time required for reproducing the video information under the second reproducing mode.” Claim 14

Thus the related patents and the patent challenged in this proceeding recite the first, second, and third reproducing modes (or similar) limitation that is currently in dispute.

(3) explain how and why the additional materials should be considered in this proceeding.

U.S. Patent Nos. 11,094,350 (EX2033) and its file history (EX2034); 11,948,605 (EX2035) and its file history (EX2036); 11,727,960 (EX2037) and its file history (EX2038); 12,400,685 (EX2039) and its file history (EX2040); and 10,418,069 (EX2041) and its file history (EX2042) should be considered in this proceeding because they illustrate the Office's prior consideration by the examiner of prior art from the Petition (Nozaki WO 2007/060980; 2009/0135269 and Haitani 9,665,597) in allowing substantially similar claims. Nozaki and Haitani were also previously presented to the Office with respect to the '848 Patent. Nozaki was considered during prosecution of the '848 Patent and the reexamination of the '848 Patent. *See* Ex. 1003 at 533; Ex. 1004 at 165-190. Haitani was considered during the reexamination of the '848 Patent. Ex. 1004 at 165-190. *See* Paper 7 at 6-9.

11,094,350 file history (EX2034)

During the examination of the '350 Patent, Nozaki and Haitani were disclosed on an IDS and considered by the Examiner:

5	20090135269	2009-05-28	Nozaki et al.	Corr. to JP 2007150603 & JP 2007150604
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EX2034, at 8, 312 (noting all references considered except where lined through).

87	9665597	B2	2017-05-30	HAITANI et al.
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Id. at 421, 645 (noting consideration by the Examiner). On April 12, 2021, the claims were allowed. *Id.* at 613.

11,948,605 file history (EX2036)

During the examination of the '605 Patent, Haitani and Nozaki were disclosed on an IDS and considered by the Examiner:

93	9665597	B2	2017-05-30	HAITANI et al.
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5	20090135269	2009-05-28	Nozaki et al.	Corr. to JP 2007150603 & JP 2007150604
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EX2036, at 15-16, 128-29 (noting all references considered except where lined through). On December 1, 2023, the claims were allowed. *Id.* at 221.

11,727,960 file history (EX2038)

During the examination of the '960 Patent, Haitani and Nozaki were disclosed on an IDS and considered by the Examiner:

93	9665597	B2	2017-05-30	HAITANI et al.
5	20090135269	2009-05-28	Nozaki et al.	Corr. to JP 2007150603 & JP 2007150604

EX2038, at 21-22, 144-45 (noting all references considered except where lined through). On February 24, 2023, the claims were allowed. *Id.* at 160. The Examiner provided the following reasons for allowance:

Allowable Subject Matter

3. Claims 1-30 are allowed.
4. The following is an examiner's statement of reasons for allowance: The present invention is directed towards a recording and reproducing apparatus for recording and reproducing image information on a scene obtained through photographing. Claim 1 uniquely recites the distinct features, "register a person in the image information as a specific person in a mode selected from a first setting mode and a second setting mode, wherein, when the first setting mode is selected, an image information of a person with a face is obtained by newly photographing the person with a face in a photographing mode and, thereafter, the image information of the person with a face is used to register the person with a face as the specific person, and, when the second setting mode is selected, a person with a face in an image information of a person with a face is selected from a plurality of faces in the image information recorded in the recording medium and, thereafter, the image information of the person with a face is used to

register the person with a face as the specific person; selectively reproduce the recorded image information which includes the registered specific person; and generate a thumbnail corresponding to the recorded image information in the recording medium such that the thumbnail is displayed on the display with an icon having a predetermined shape when an importance level is set for the recorded image information via a user interface; a touch panel adhered to a screen of the display, wherein the first setting mode and the second setting mode are each selected using the touch panel; a camera providing video information, wherein, in response to the face-recognizing process detecting that a face of a person is included in the video information, the display displays the video information with a frame surrounding at least a portion of the face of the person; an analog/digital converter, wherein the analog/digital converter is configured to convert analog image data corresponding to the captured photograph into a digital image signal; and a codec for compressing the digital image signal using a predetermined compression encoding method and generating encoded image information, wherein the encoded image information is stored in the recorded medium, wherein the camera captures video information corresponding to a scene and the processor: automatically sets a plurality of sections corresponding to the video information of the scene; and generates a plurality of thumbnails corresponding to the plurality of sections, wherein each of the plurality of thumbnails is associated with the same video information corresponding to the scene, and the display displays the plurality of thumbnails; and wherein the display is configured to display at least a plurality of images recorded in the recording medium such that contents of each image in the plurality of images include a face of a different person and background objects and displaying the plurality of images includes displaying the faces without displaying all of the background objects included in the contents of each image of the plurality of images.” Claim 2 uniquely recites the distinct features, “register a person in the image

Id. at 165-67.

12,400,685 file history (EX2040)

During the examination of the '685 Patent, Haitani and Nozaki were disclosed on an IDS and considered by the Examiner:

93	9665597	B2	2017-05-30	HAITANI et al.
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5	20090135269		2009-05-28	Nozaki et al.	Corr. to JP 2007150603 & JP 2007150604
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EX2040, at 9-19, 116-17 (noting all references considered except where lined through). On April 30, 2025, the claims were allowed. *Id.* at 168.

10,418,069 file history (EX2042)

During the examination of the '069 Patent, Nozaki was disclosed on an IDS and considered by the Examiner:

5	20090135269		2009-05-28	Nozaki et al.	Corr. to JP 2007150603 & JP 2007150604
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EX2042, at 18, 109 (noting all references considered except where lined through). On March 20, 2019, the claims were allowed. *Id.* at 131.

This additional information should be considered in connection with Patent Owner's argument that Haitani's filters are not the claimed first, second, and third reproducing modes.

As such Patent Owner respectfully requests authorization to file U.S. Patent Nos. 11,094,350 (EX2033) and its file history (EX2034); 11,948,605 (EX2035) and its file history (EX2036); 11,727,960 (EX2037) and its file history (EX2038);

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12,400,685 (EX2039) and its file history (EX2040); and 10,418,069 (EX2041) and its file history (EX2042).

Dated: October 8, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of October, 2025, a copy of the attached PATENT OWNER'S REQUEST TO FILE MATERIALS FROM RELATED MATTERS together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz
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With a courtesy copy by electronic mail to:

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Respectfully submitted,

Date: October 8, 2025

By: /Robert G Pluta Reg No 50970/
Robert G. Pluta (Reg. No. 50,970)

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