

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
Granting in Part and Denying in Part
Patent Owner's Request
For Authorization To File Materials

On October 8, 2025, Patent Owner filed a Request For Authorization To File Materials From Related Matters. Paper 39 (“Request” or “Req.”). On October 14, 2025, Petitioner filed an Opposition To Patent Owner’s Request. Paper 40 (“Opposition” or “Opp.”). We have considered the parties’ positions on this Request, and for the reasons discussed below, Patent Owner’s Request is *granted in part and denied in part*.

Patent Owner requests authorization to file additional materials in this proceeding pursuant to the Board’s General Order on related matters filed on September 19, 2025. Paper 36 (“General Order”). The General Order states that

[t]he 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)*.

Paper 27, 1 (emphasis added).

According to the Request, 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).” Req. 1. Patent Owner asserts that “[e]ach 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).” *Id.* at 2. Patent Owner also asserts that these patents and file histories “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.” *Id.* at 4.

Petitioner opposes Patent Owner’s Request “as to four of the five patents and their file histories” that Patent Owner seeks to submit. Opp. 1. Petitioner argues that

the Board should deny PO’s request, or if submitted, they should be given no weight. First, these four patents fall outside the scope of the Board’s Order (Paper 37) because they are neither related matters under 37 C.F.R. § 42.8(b)(2) nor “developments.” Second, PO has waived its arguments as to these patents and their file histories given that they all issued before the Petition and PO could have raised them in any one of its prior filings. Third, the Board has already rejected in its Institution Decision relevance arguments similar to those that PO makes in its request.

Id. (citing Paper 7, 3–12; Paper 9, 15–20).

As to the fifth patent that is the subject of Patent Owner’s request—U.S. Patent No. 12,400,685 (“the ’685 patent”)—and its file history (EX2039 and EX2040), Petitioner agrees that they should be submitted, but not for the purpose that PO argues in its request. Instead, Petitioner argues that “they should be admitted because they go to [Patent Owner’s] credibility in this and other IPR proceedings.” Opp. 1.

We agree with Petitioner. The General Order is clear—the parties must keep the Board apprised of developments in a proceeding that “is identified as a related matter under 37 C.F.R. § 42.8(b)(2).” Paper 27, 1. Patent Owner failed to identify any of these patent proceedings as “related matters” in its mandatory notices. *See* Paper 5. Patent Owner’s attempt to submit these patents and their file histories is thus not within the General Order’s express instruction to submit materials only from proceedings that are “identified as a related matter under 37 C.F.R. § 42.8(b)(2).” Paper 37,

1. However, if these patent proceedings are indeed related proceedings, Patent Owner provides no explanation as to why it did not comply with its obligations under the Board’s Rules governing mandatory notices, 37 C.F.R. § 42.8.

Petitioner’s second reason for denying Patent Owner’s request—that Patent Owner has waived its arguments as to these materials—also has merit. Opp. 3–4. Petitioner asserts that

[i]t is undisputed that [Patent Owner] had access to the four patents and their file histories at the time it filed its [Patent Owner Preliminary Response] in August 2024. Yet [Patent Owner] chose not to raise any of them in the [Patent Owner Preliminary Response] or in subsequent filings (e.g., the [Patent Owner Response] in January 2025 or [Patent Owner’s] Sur-Reply in May 2025). [Patent Owner] has therefore waived these arguments.

Opp. 4 (citing Paper 10, 9 (discussing waiver)).

Our Scheduling Order (Paper 10) in this case expressly states that “Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.” Paper 10, 9. Nonetheless, Patent Owner did not raise any arguments concerning these proceedings in its Patent Owner Response filed on January 10, 2025 (Paper 20). Because Patent Owner did not raise any arguments with respect to these proceedings in the Patent Owner Response, Patent Owner has waived these arguments and they will not be considered now.

Petitioner asserts a third reason to deny Patent Owner’s Request, “that the Board has already considered and rejected the relevance arguments that PO seeks to revive here.” Opp. 4–5. However, we do not think it is necessary to reach this third reason in order to decide Patent Owner’s Request.

As to the fifth patent that is the subject of Patent Owner’s request—U.S. Patent No. 12,400,685 (“the ’685 patent”)—and its file history (EX2039 and EX2040), Petitioner argues that “the ’685 patent and its file history should be admitted for the purpose of assessing: (1) PO’s candor in these and related proceedings, and (2) the credibility of PO’s arguments regarding the ’848 patent and the prior art.” Opp. 5. Petitioner asserts that

[t]he ’685 patent issued less than two months ago— on August 26, 2025—as a continuation of the ’848 patent. EX2039 at 1. Unbeknownst to Petitioner, [Patent Owner] had been prosecuting the ’685 patent since February 29, 2024. *Id.* The ’685 patent is a continuation of the ’848 patent (EX2039 at 2), so [Patent Owner] should have identified it in [Patent Owner’s] mandatory notices.

Opp. 5 (citing Consolidate Trial Practice Guide (“TPG”), 18). Petitioner also argues that “[t]he ’685 patent file history is further instructive because it shows that [Patent Owner] took positions in prosecuting the ’685 patent that conflict with infringement positions it took in the District Court trial.” Opp. 7.

The Board’s Rules and the Trial Practice Guide are clear, in that [t]he rules *require* that parties to a proceeding provide certain mandatory notices, including identification of the real parties-in-interest, related matters, lead and back-up counsel, and service information. 37 C.F.R. § 42.8. Where there is a change of information, a party *must* file a revised notice within 21 days of the change. 37 C.F.R. § 42.8(a)(3).

TPG 12 (emphasis added). The TPG further clarifies that

Parties to a proceeding *are to identify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.* Judicial matters include actions involving the patent in federal court. *Administrative matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party’s*

involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent.

Id. (emphasis added). Here, Patent Owner failed to identify the '685 patent prosecution as a related matter in this proceeding in compliance with its mandatory notice obligations under 37 C.F.R. § 42.8(b)(2).

ORDER

Accordingly, it is

ORDERED that Patent Owner's Request For Authorization To File Materials From Related Matters is *granted in part* as to U.S. Patent No. 12,400,685 (EX2039) and its file history (EX2040); and *denied in part* as to U.S. Patent No. 11,094,350 (EX2033) and its file history (EX2034); U.S. Patent No. 11,948,605 (EX2035) and its file history (EX2036); U.S. Patent No. 11,727,960 (EX2037) and its file history (EX2038); and U.S. Patent No. 10,418,069 (EX2041) and its file history (EX2042).

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