

**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 DIRECTOR REVIEW OF THE  
FINAL WRITTEN DECISION**

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

## **TABLE OF CONTENTS**

|             |                                                                                                                                                    |           |
|-------------|----------------------------------------------------------------------------------------------------------------------------------------------------|-----------|
| <b>I.</b>   | <b>INTRODUCTION .....</b>                                                                                                                          | <b>1</b>  |
| <b>II.</b>  | <b>LEGAL STANDARD .....</b>                                                                                                                        | <b>2</b>  |
| <b>III.</b> | <b>SUMMARY OF THE TRIAL RECORD .....</b>                                                                                                           | <b>3</b>  |
| <b>IV.</b>  | <b>ARGUMENT.....</b>                                                                                                                               | <b>4</b>  |
| <b>A.</b>   | <b>The FWD Fails to Explain Why a Different Conclusion is Warranted in View of the Office’s Multiple Prior Confirmations of Patentability.....</b> | <b>4</b>  |
| <b>B.</b>   | <b>Haitani’s Filters Are Not the Claimed Reproducing Modes.....</b>                                                                                | <b>6</b>  |
| <b>C.</b>   | <b>The FWD Erred in Finding Claims 11-12, 16-17, and 19-20 Unpatentable.....</b>                                                                   | <b>9</b>  |
| <b>1.</b>   | <b>The Petition’s Inconsistent Mapping of the Claimed Reproducing Modes .....</b>                                                                  | <b>10</b> |
| <b>2.</b>   | <b>Patent Owner’s Arguments Regarding Samsung’s Inconsistent Application of Haitani’s Filters Were Unrebutted by Samsung .....</b>                 | <b>11</b> |
| <b>3.</b>   | <b>The FWD Ignores Patent Owner’s Arguments and Abstracts Away the Claimed Relational Structure .....</b>                                          | <b>13</b> |
| <b>V.</b>   | <b>CONCLUSION .....</b>                                                                                                                            | <b>15</b> |

## PATENT OWNER'S EXHIBIT LIST

| <b>Exhibit No.</b> | <b>Description</b>                                              |
|--------------------|-----------------------------------------------------------------|
| 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               | Patent Owner Demonstratives                                     |

## **TABLE OF AUTHORITIES**

### **Page(s)**

#### **Cases**

|                                                                                                        |    |
|--------------------------------------------------------------------------------------------------------|----|
| <i>Digital Biometrics, Inc. v. Identix, Inc.</i> ,<br>149 F.3d 1335 (Fed. Cir. 1998) .....             | 11 |
| <i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> ,<br>821 F.3d 1359 (Fed. Cir. 2016) ..... | 3  |
| <i>Phonometrics, Inc. v. N. Telecom Inc.</i> ,<br>133 F.3d 1459 (Fed. Cir. 1998) .....                 | 11 |

#### **Statutes**

|                               |   |
|-------------------------------|---|
| 35 USC §§314 and 325(d) ..... | 1 |
|-------------------------------|---|

#### **Other Authorities**

|                                                                                                                                                                                                                                                                 |   |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---|
| 37 C.F.R. §42.75 .....                                                                                                                                                                                                                                          | 1 |
| 37 C.F.R. § 42.104(b)(3)-(4).....                                                                                                                                                                                                                               | 7 |
| 90 Fed. Reg. 48335, at 3 .....                                                                                                                                                                                                                                  | 1 |
| <a href="https://www.uspto.gov/patents/ptab/decisions/director-review-process">https://www.uspto.gov/patents/ptab/decisions/director-review-process</a> .....                                                                                                   | 3 |
| <a href="https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf">https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf</a> ..... | 5 |

## I. INTRODUCTION

Patent Owner Maxell Ltd. respectfully requests that the Director grant review, vacate the Final Written Decision (“FWD”) (Paper 43) finding all challenged claims of U.S. Patent 10,176,848 (“the ’848 Patent”) unpatentable, and terminate the proceeding. 37 C.F.R. §42.75.

The ’848 Patent has been repeatedly examined by the Office, through original prosecution, reexamination, and this proceeding. The main references—Nozaki and Haitani—were previously presented to the Office during prosecution and reexamination. EX1003 at 533; EX1004 at 165-190. The ’848 Patent was also tried to a jury six months before the FWD.<sup>1</sup> Having previously refused to deny institution based on many of these factors, the Board now misinterprets the claims in view of the prior art, leading to error finding all of the challenged claims unpatentable. This IPR is a textbook example of a petition that never should have been instituted under 35 USC §§314 and 325(d) and is a clear example of the issues recognized in the recent NPRM, namely that “even extremely strong patents become unreliable when subject to serial or parallel validity challenges.” *Revision to Rules of Practice before the Patent Trial and Appeal Board* at 90 Fed. Reg. 48335, at 3 (“if [a] patent is subjected to repeated *de novo* patentability review each time it is enforced, it will no longer be reliable.”) (“NPRM”).

---

<sup>1</sup> This Petition was also improperly instituted over the *Fintiv* factors. Paper 7, 12-18.

First, Director Review is necessary because the Board erred by failing to satisfy the requirement of the September 16, 2025 Memorandum entitled “PTAB consideration of prior findings of fact and conclusions of law” (“9/16/25 Memo”) because the FWD *completely failed to address* why a different outcome was warranted when the Office previously found the same claims valid during reexamination over the **same and substantially the same art**. The Board was required to provide such explanation and rationale in view of recent guidance but FWD did not do so. Thus, the FWD should be reversed and the IPR terminated.

Second, Director review is necessary because the Board legally erred in its claim construction of “mode” and its application of that term to the prior art in view of the Petition’s evidence. The Board’s improper view of the scope of “mode” to encompass Haitani’s filters infected the Board’s entire analysis of the prior art when it erroneously found the art rendered obvious the claimed reproducing modes. In so doing, the FWD made erroneous findings of fact regarding the prior art.

Finally, even accepting the Board’s erroneous application of Haitani’s filters as the claimed modes, the FWD overlooked several of Patent Owner’s arguments and Petitioner’s failure of proof with respect to Claims 11-12, 16-17, 19, and 20. Thus, for this additional reason, the FWD should be reversed and the IPR terminated.

## II. LEGAL STANDARD

Director review of a FWD is “limited to decisions presenting (a) an abuse of

discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO, Director Review Process, Sec. 2.B., <https://www.uspto.gov/patents/ptab/decisions/director-review-process>. “An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (internal citation omitted).

### III. SUMMARY OF THE TRIAL RECORD

On May 1, 2024, Samsung filed a Petition challenging claims 11, 12, 16, 17, 19, 20, and 84 of the '848 Patent. Paper 3. On August 11, 2024, Patent Owner filed its Preliminary Response explaining why denial was appropriate under §325(d) due to the Office’s prior consideration of the Petition art during the original prosecution and reexamination proceedings. Paper 7 at 3-12. Patent Owner also explained why denial was appropriate under *Fintiv. Id.* at 12-18. Despite these showings, the PTAB instituted review on November 4. Paper 9. Patent Owner sought Director review and explained why the Decision ignored the standard set forth in the precedential *Advanced Bionics* decision and rendered §325(d) and prior reexamination proceedings meaningless. Paper 11. That request was summarily denied. Paper 13.

In its Response, Patent Owner explained that a POSITA would understand the

term “mode” to mean “an operational state that a system has been switched to,” which is distinct from a “filter” such as those disclosed in Haitani. Paper 20, 13-19. Even Samsung’s expert has distinguished between “mode” and “filter” in the relevant art. *Id.* at 17-19. In its Reply, Samsung did “not necessarily object to the concept of a ‘mode’ as an operational state....” Paper 24 at 1. Samsung did object to Maxell’s argument that Haitani’s filters are not the claimed reproducing modes. *Id.* However, as explained in the Response, Haitani’s filters are not reproducing modes, and the FWD never grapples with the reexamination’s prior consideration of Haitani and Nozaki nor the full extent of Patent Owner’s arguments that Samsung failed to carry its burden in demonstrating that the prior art rendered obvious the claimed reproducing modes. Paper 20, at 19-49; Paper 25, at 13-21. On November 6, 2025, the Board found all challenged claims unpatentable based principally on its finding that the Haitani’s filters are equivalent to the claimed reproducing modes. In so doing the FWD ignored several of Maxell’s key arguments that were unrebutted by Samsung. This was legally erroneous and an abuse of discretion.

#### **IV. ARGUMENT**

##### **A. The FWD Fails to Explain Why a Different Conclusion is Warranted in View of the Office’s Multiple Prior Confirmations of Patentability**

The ’848 Patent not only was thoroughly examined by the Office during the original prosecution, but it also went through extensive reexamination proceedings.

*See generally* EX1004. Specifically, the '848 Patent was thoroughly reexamined, resulting in a Reexamination Certificate dated March 18, 2022. EX1004, 39-40. Original claims 11, 12, 16, 17, 19, and 20 were confirmed and claims 21-84 were added and determined to be patentable. Original claims 1-7, 9, and 14 were not reexamined. Nozaki—the Petition's primary reference—was previously presented to the Office during original prosecution and reexamination of the '848 Patent. EX1003, 533; EX1004, 171. Haitani—the Petition's secondary reference—was also considered during the reexamination of the '848 Patent. EX1004, 171.

Patent Owner explained, in detail, how the Office already considered substantially the same art and arguments presented in the Petition. Paper 7, 3-14. Patent Owner also explained in detail how the Board erred in its analysis of this evidence and abused its discretion in instituting this proceeding. Paper 11.

The 9/16/25 Memo states that “if the Board reaches . . .[a] final decision on a finding of fact or conclusion of law that is different than the prior finding or conclusion of the Office, . . . the Board shall explain in the . . . final written decision why a different outcome is warranted. A more detailed explanation is required from the Board when the same or substantially the same evidence and/or arguments that were previously presented to the Office . . . are being relied upon in the subsequent AIA trial proceeding.” [https://www.uspto.gov/sites/default/files/documents/Memo\\_re\\_prior\\_findings\\_of\\_fact\\_and\\_conclusions\\_of\\_law\\_9\\_16\\_25.pdf](https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf). **The FWD,**

**however, fails to explain why an outcome different than the finding by the Office that Gallagher, Nozaki, or Haitani fails to disclose the claimed reproducing modes is supported by the evidence.** The Board's consideration of the reexamination proceedings is cursory and contrary to the 9/16/25 Memo.

Indeed, during reexamination, Gallagher was used just as Samsung uses Haitani in this IPR, particularly for Claims 11-12, 16-17, 19, and 20. EX1004, 388-392. The FWD does not address any of the substance of the reexamination, nor explain why a different outcome is warranted. A more detailed explanation is required from the Board where, as here, the same or substantially the same evidence and/or arguments that were previously presented to the Office. Paper 7, 3-12.

This serial challenge to the '848 Patent should have never proceeded. And, having been erroneously instituted, it was incumbent on the Board in the FWD to provide a more detailed explanation where the same or substantially the same evidence and/or arguments were previously presented to the Office. As detailed in the recent NPRM, the Board's actions in this proceeding "jeopardize the reliability of patent rights and incentives to invest in new technology." NPRM at 48335.

**B. Haitani's Filters Are Not the Claimed Reproducing Modes**

The FWD turns entirely on an improper application of the term "mode" to the claimed reproducing modes of Claims 11-12, 16-17, 19, and 20. The FWD states that mode "means 'a state,' 'condition,' or 'operational state' of a recording device,

such as a video camera, that is selected by a user and may include a selection function ***using threshold values.***” FWD, 19 (emphasis added). The FWD then uses the concept of “threshold values” to equate them with Haitani’s filters, a theory first introduced by Samsung in its Reply. Paper 25, 2-4. This is error for several reasons.

***First***, the Petition never raises an argument that a “filter” is equivalent to a “threshold.” *Id.* Nor does the Petition equate Haitani’s user-selected filters to the ’848 Patent’s predetermined, non-user selectable thresholds. It was only on Reply and in Dr. Bederson’s reply declaration that Samsung attempted to rehabilitate the use of Haitani’s filters as the claimed reproducing modes and equating a filter to a threshold. Paper 24, 2-3. This point was conceded at oral hearing by Samsung. Paper 34, at 40:11-15. This change in theory is not supported by the Petition and the FWD’s acceptance of this new theory and its crediting of Samsung and Dr. Bederson on this point was error. Moreover, “filter” is not a term that appears in the ’848 Patent, as admitted by Samsung. Paper 34 at 7:13-16. Thus, Samsung’s late argument that a “user-selected filter” is equivalent to a predetermined, non-user selectable “threshold” is not supported by the Petition or the intrinsic record. *Id.* The FWD overlooked this waiver argument instead of holding Samsung to its burden of “[h]ow the challenged claim is to be construed” and “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104(b)(3)-(4). The FWD justified the Petition’s use of filters on its own by erroneously finding that activation of the ’848 Patent’s

reproducing modes “acts as a selection or filtering process that meets the stated goals of the claimed invention” proceeding then to its obviousness analysis without deciding whether the Petition supports such a theory. FWD, 47.

**Second**, the thresholds referenced in the ’848 Patent are predetermined, non-user selectable thresholds and are distinguishable from Haitani’s user-selected “filters.” The ’848 Patent teaches the threshold values are stored in memory and Samsung and the FWD’s reliance on Haitani’s user-selected filters to define/drive modes improperly expands the claims beyond the intrinsic record. Paper 20, 13–19; Paper 25, 2–7. The FWD neither reconciles this intrinsic teaching with its acceptance of filter-driven “modes” nor explains how its reading accounts for predetermined thresholds (as opposed to user-selected criteria) when analogizing to Haitani’s filters. As explained by Dr. Balakrishnan—evidence ignored by the FWD—the user does not select different filtering criteria but selects “different modes **that yield different operations.**” EX2030, ¶141. “Running a single algorithm where you’re just switching out the filtering criteria is not an indicator of a different mode. EX1018, 54:19-55:3.” “A POSITA would not understand that [a threshold] in the ’848 Patent “resembles” “filters” or the filtering search feature in, for example, Haitani, which merely separates data based on user input. Paper 20, 14 (EX2030, ¶77). The intrinsic evidence therefore supports Patent Owner’s proposed construction of “mode” and does not support Petitioners’ “new” construction erroneously adopted by the FWD

(i.e. equating a filter with a threshold and including filters within “reproducing mode”).

**Third**, the FWD ignored or overlooked evidence that illustrates a POSITA would not equate “filters” with the claimed “reproducing modes.” For example, Haitani itself distinguishes between modes and filters, EX1007, 20:66-21:1, as acknowledged by Samsung’s expert. EX2031, 49:13-18. Even Dr. Bederson authored a paper relied on by Samsung that distinguishes between “modes” and “filters,” none of which was addressed by the FWD. Paper 20, 17-19.

The foregoing illustrates that a POSITA would not treat modes and filters the same and it was error for the FWD to find otherwise by equating Haitani’s filters with the claimed reproducing modes.

### **C. The FWD Erred in Finding Claims 11-12, 16-17, and 19-20 Unpatentable**

Even if Haitani’s filters could be applied as the claimed reproducing modes, the FWD erred in finding Claims 11-12, 16-17, and 19-20 unpatentable because Samsung failed to show by a preponderance of the evidence that Nozaki in view of Haitani renders Claims 11-12, 16-17, and 19-20 unpatentable.

The FWD overlooked Patent Owner’s arguments that Samsung’s mapping of Claims 11-12, 16-17, and 19-20 to Nozaki and Haitani was fatally flawed. Each of these challenged claims requires a first reproducing mode, a second reproducing

mode, and, in the case of Claims 12, 17, and 20, a third reproducing mode. However, the FWD glossed over Samsung's inconsistent mapping of Haitani's filters to the claimed reproducing modes.

**1. The Petition's Inconsistent Mapping of the Claimed Reproducing Modes**

Claims 11, 16, and 19 require a first reproducing mode and a second reproducing mode, each mode having a temporal relationship to the other. Claims 12, 17, and 20 which depend on Claims 11, 16, and 19, respectively, utilize the first and second reproducing modes and add a third reproducing mode. With respect to Claims 11, 16, and 19, the Petition assigns Haitani's narrower search as the first reproducing mode and the broader search as the second reproducing mode. Paper 3, 26-31; 34-36. With respect to Claims 12, 17, and 20, the Petition argued "a first mode might use face registration data as a filter, a second mode might add date/time as an additional filter, and a third mode might further add a third filter (e.g., location or events). EX1005, ¶ 103." *Id.*

On cross-examination Dr. Bederson admitted he is not picking any specific filter, but relies on Haitani's disclosures of filters generally. EX2031 at 62:18-25. This is problematic because, even if Haitani's filters were reproducing modes, it is clear that the Petition and Dr. Bederson fail to maintain any cohesive theory as to which filters are which specific reproducing modes and thus fails to coherently map their theories to the claim language.

This lack of cohesiveness is best exemplified in the Petition’s analysis of Claim elements 12[b], 17[b], and 20[b], where Samsung argued that “A POSITA would have known that each mode would generate broader or narrower results, with the broadest mode being a “third” mode having the characteristics recited in this limitation, i.e., a reproducing time longer than the second mode.” POR at 40. On cross-examination Dr. Bederson admitted that the three modes he gave as examples regarding limitation 12[a] would have to be reversed to meet limitation of 12[b]. EX2031 at 65:11-66:7. The Federal Circuit has made clear that a “word or phrase used consistently throughout a claim should be interpreted consistently.” *Phonometrics, Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1465 (Fed. Cir. 1998); *see also Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345 (Fed. Cir. 1998) (“whatever interpretation we assign should encompass both uses because the same word appearing in the same claim should be interpreted consistently”). So too when applying prior art to such claims. Petitioner and Dr. Bederson’s fluid assignment of the first, second, and third modes throughout the Petition highlights their hindsight-driven analysis when attempting to apply Nozaki and Haitani to the claims. As further set forth below, the FWD never addresses this argument or attempts to justify Petitioner’s shifting assignment of Haitani’s filters to the claimed reproducing modes.

**2. Patent Owner’s Arguments Regarding Samsung’s Inconsistent Application of Haitani’s Filters Were**

### Unrebutted by Samsung

Samsung never rebutted Patent Owner's argument that the Petition failed to clearly and consistently identify first, second, and third reproducing modes. At oral hearing, Patent Owner again reiterated its position, providing specific evidence how Samsung was inconsistently applying Haitani's filters to the claims:

[PO COUNSEL]: [T]he fact is, they took a position in their petition, which mode was which, and they figured out that it was inconsistent with how the claims read, and they can't fix it now. Dr. Bederson admitted that's what he did. And he was just saying, well, you could just switch it out for Element 12 [a] and 12 [b]. That is hindsight.

| Claim Limitation | First Reproducing Mode | Second Reproducing Mode | Third Reproducing Mode |
|------------------|------------------------|-------------------------|------------------------|
| 11[a]            | Broad filter           | Narrower filter         |                        |
| 11[b]            | Narrower filter        | Broad filter            |                        |
| 11[c]            | Narrower filter        | Broad filter            |                        |
| 12[a]            | Broad filter           | Narrower filter         | Narrowest filter       |
| 12[b]            | Narrowest filter       | Narrower filter         | Broad filter           |

Paper 3 at 28-31

EX2032 at 43; Paper 34 at 34-38; 48. Samsung denied this obvious inconsistency:

JUDGE TROCK: [Y]ou can see the problem that Patent Owner has, and I am concerned about this, is that, as you're applying this prior art, and you're moving through the various limitations in the claims, are you or are you not changing which filters you're using for these first, second, and third reproducing modes?

[SAMSUNG COUNSEL]: We are not.... And I think that the way that it's discussed in the petition, as well as in Dr. Bederson's declaration is such that it's clear that these are just examples of different ways that you can apply the Haitani filter in many different ways to get modes that reproduce different subsets of information that would also have the effect of creating different reproducing times....

Paper 34, at pp. 42-43.

### **3. The FWD Ignores Patent Owner's Arguments and Abstracts Away the Claimed Relational Structure**

The FWD never addresses Samsung's hindsight driven analysis. Critically, the FWD never reconciles how the "third" mode can be the narrowest for 12(a) and the broadest for 12(b). By failing to address Patent Owner's "mode-order reversal" argument (anchored in Dr. Bederson's expert's admission), the FWD leaves that contradiction unexplained and Samsung's hindsight driven analysis intact.

For element 12[a], the FWD embraces Samsung's additive example: first reproducing mode = face; second reproducing mode = face + time; third reproducing mode = face + time + location/events (*i.e.*, progressively narrower sets). FWD at 54. For element 12[b], the FWD states "the broadest mode" is the "third" mode and uses that breadth to infer a longer reproducing time than the second mode. FWD at 57-58. These two statements cannot both be true under the same labeling. The FWD does not reconcile these two statements or explain how the record supports relabeling the modes to cure that mismatch.

The FWD never grapples with this contradiction or explain why it does not undermine Petitioners' mapping of the "third reproducing mode" and the temporal/containment relationships among the modes, nor does it grapple with Patent Owner's specific critique that Petitioners never pinned down which filters are which mode and that their own expert's examples flip under Claim element 12[b].

Patent Owner identified a concrete inconsistency in the Petition which was never rebutted by Samsung: Dr. Bederson used one ordering of modes for claim element 12[a] but acknowledged that, to satisfy 12[b]'s "third mode longer than the second mode" requirement, his own examples would "have to be reversed." Paper 25, 20 (citing EX2031, 65:11-66:7). Patent Owner presented this as evidence that Samsung never established a coherent, consistent identification of the three modes or their relative breadth/time relationships. *Id.*, 21. The FWD finding otherwise is material error because claim 12 ties the three modes together with explicit relational constraints (12[a] introduces the three modes; 12[b] imposes a temporal ordering across them). An obviousness mapping that shifts mode labels between sub-limitations is a moving target rather than a single, enabling set of teachings, and the FWD abstracts away the claim's relational structure.

The FWD's approach trends toward "there exists some labeling that could work" rather than demonstrating that a POSITA would read the prior art to disclose or render obvious the same three modes with the required relationships, consistently

applied. This collapses Samsung's statutory burden. If the labels for "first," "second," and "third" can be re-assigned *ad hoc* between sub-limitations, the showing becomes untethered from a single, taught configuration in the prior art and fails to demonstrate that a POSITA would have recognized and implemented the specific relational structure claimed.

Despite the implications of its findings, the FWD neither answers the mode-order inconsistency raised by Patent Owner nor reconciles its own shift in how the "third" mode is characterized between 12[a] and 12[b], its obviousness analysis for Claim 12 lacks a fully reasoned, consistent foundation. A reasoned decision must resolve significant disputes and articulate a coherent rationale. Where Patent Owner flagged a concrete label-flip between elements 12[a] and 12[b], the FWD silence on the issue leaves a material inconsistency unaddressed. That omission detracts from the reasoned explanation the APA requires, because it fails to show how the same "third mode" is both the narrowest for 12[a] and the broadest for 12[b] according to the claimed invention.

## **V. CONCLUSION**

By instituting review of a reexamined patent and adopting an interpretation of "mode" that is inconsistent with the intrinsic evidence, the Board erred. Patent Owner requests the Director grant review, vacate the ID and FWD, and terminate.

IPR2024-00867

U.S. 10,176,848

Dated: December 5, 2025

Respectfully submitted,

/Robert G. Pluta /

Robert G. Pluta (Reg. No. 50,970)

Amanda S. Bonner (Reg. No. 65,224)

MAYER BROWN LLP

71 S. Wacker Drive

Chicago, IL 60606

Telephone: (312) 701-8641

[rpluta@mayerbrown.com](mailto:rpluta@mayerbrown.com)

Saqib J. Siddiqui (Reg. No. 68,626)

MAYER BROWN LLP

1999 K Street NW

Washington, D.C., 20006

[ssiddiqui@mayerbrown.com](mailto:ssiddiqui@mayerbrown.com)

*Counsel for Maxell, Ltd.*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 5th day of December, 2025, a copy of the attached PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW was served by electronic mail to the attorneys of record, at the following addresses:

James Heintz  
[Jim.Heintz@us.dlapiper.com](mailto:Jim.Heintz@us.dlapiper.com)

Gianni Minutoli  
[Gianni.Minutoli@us.dlapiper.com](mailto:Gianni.Minutoli@us.dlapiper.com)

With a courtesy copy by electronic mail to:

[dla-samsung-maxell@us.dlapiper.com](mailto:dla-samsung-maxell@us.dlapiper.com)

Respectfully submitted,

Date: December 5, 2025

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

*Counsel for Maxell, Ltd.*