

**IN 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: IPR2024-00906

U.S. Patent No. 11,445,241

PATENT OWNER'S SUR-REPLY

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

Petitioner's argument that Patent Owner ("PO") asserts inconsistent positions and attempts to "recapture controller-based selection that was surrendered during prosecution" is incorrect. Reply 2. Resolution of Petitioner's manufactured claim construction dispute is not necessary for denial of the Petition. PO has consistently asserted the same position—that this claim term does not need any construction and plain and ordinary meaning applies—throughout these proceedings and the district court litigation. *See, e.g.*, EX1024 at 24-25; EX1026 at 5-6; EX1029, 78:9-80:18; Paper 7 at 60. Under this position, the plain claim language requires two things: (1) a user indication and (2) that the controller needs to assign a connection based on the user indication being received. At no point has PO (or Petitioner) argued that both of these requirements are unnecessary. *See id.* This position was also consistent during reexamination of the related '590 Patent—PO argued that Tee failed to disclose (1) an appropriate user indication and (2) the controller assigns a connection ***in response to*** the user indication. *See* EX1006 at 117-130, 137-40, 142. While Petitioner attempts to mischaracterize PO's arguments as "excluding a controller 'automatically' selecting a radio," PO was in fact arguing against a ***particular*** automatic controller assignment that was occurring ***before, and not in response to,*** the alleged user indication. *See* EX1006 at 139-140 ("The response to the prompt of step 320 cannot constitute the claimed 'user indication' since by the time of this step

the controller has already assigned the connection.”). Thus, PO's reexamination arguments are not directed to rejecting **any** automatic controller assignments as alleged by Petitioner. *See* Pet. at 4. Because PO's arguments are based on a position that is consistent across both PO's and Petitioner's interpretations, no construction is necessary.

The only inconsistency is with Petitioner's claim construction positions between this proceeding and the litigation. In the litigation Petitioner argues for a negative limitation that contradicts the language of the claim—requiring “the user, not the controller, to select the particular radio.” *See, e.g.*, EX1030 at 3. PO has consistently argued against this approach. *See, e.g.*, EX1024 at 24-25; EX1026 at 5-6. Petitioner's position was rightly (though preliminarily) rejected by the Court.

Further, the Board need not settle this faux claim construction dispute because during prosecution the PTO considered Dua—among other prior art—during reexamination of the related '590 Patent and found these claims patentable. *See* Paper 7 at 5-11; *see also* EX1006 at 320, 361, and 375. Petitioner's Reply never argues that the PTO's prior interpretation of the claims in view of the prior art and arguments of record was “material error.” Nor could it. The '241 Patent claims have been thoroughly reviewed by the PTO and the PTO found the claims patentable over the prior art of record. *See* Paper 7 at 4-12. PO's interpretation of the claims has been consistent throughout and the Petition should be denied.

Patent No. 11,445,241
Patent Owner's Sur-Reply

Dated: November 1, 2024

Respectfully submitted,

/ Robert G. Pluta /
Robert G. Pluta (Reg. No. 50,970)
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: (312) 701-8641
Fax: (312) 706-8144
rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)
MAYER BROWN LLP
1999 K Street NW
Washington DC, 20006
ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

Patent No. 11,445,241
Patent Owner's Sur-Reply

CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of November, 2024, a copy of the attached
PATENT OWNER'S SUR-REPLY, together with all exhibits was served by
electronic mail to the attorneys of record, at the following addresses:

Brian Erickson
Brian.Erickson@us.dlapiper.com

Gianni Minutoli
Gianni.Minutoli@us.dlapiper.com

Roshan K. Bhattarai
Roshan.Bhattarai@us.dlapiper.com

With a courtesy copy by electronic mail to:
dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: November 1, 2024

By:

/ Robert G. Pluta/

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

Counsel for Maxell, Ltd.