

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.

and SAMSUNG ELECTRONICS AMERICA,
INC.,

Petitioners,

v.

Inter Partes Review

MAXELL, LTD.,

No. IPR2024-00906 &

Patent Owner.

IPR2024-00907

TELEPHONIC PETITION FOR INTER PARTES REVIEW OF U.S.
PATENT NO.11,445,241 UNDER 35 U.S.C. SECTIONS 311-319
AND 37 C.F.R. SECTIONS 42.1-100, ET SEQ

DATE: Wednesday, January 22, 2025

TIME: 4:00 p.m.

BEFORE: Honorable Kevin C. Trock

Honorable Jason W. Melvin

Honorable Frederick C. Laney

LOCATION: Remote Proceeding

New York, NY 10001

REPORTED BY: Surina Mahadeo

JOB NO.: 7129309

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E X H I B I T S		
NO.	DESCRIPTION	PAGE
	(None marked.)	

1 P R O C E E D I N G S

2 MR. ERICKSON: This is Brian Erickson,
3 lead counsel for Petitioner, Samsung. With me are
4 backup counsel, Gianni Minutoli and Roshan Bhattarai.

5 THE COURT: Okay. Good day, Mr.
6 Erickson. Patent Owner?

7 MR. PLUTA: Good afternoon, Your Honor.
8 This is Robert Pluta on behalf of Patent Owner. With
9 me also is Saqib Siddiqui.

10 THE COURT: Okay. Good day, Mr. Pluta.

11 MR. PLUTA: And, Your Honor?

12 THE COURT: Yes.

13 MR. PLUTA: Your Honor, I believe we
14 have a court reporter on the call as well.

15 THE COURT: Okay. Thank you very much
16 for that. Yes.

17 THE REPORTER: Good afternoon. This is
18 Surina Mahadeo, the court reporter.

19 THE COURT: All right. Thank you very
20 much. All right. Well, we have what appears to be
21 somewhat of a bit of confusion with respect to this
22 case, and that's why we requested a conference call
23 with Counsel.

24 There have been a couple of
25 communications with the board, starting with

1 Petitioner's request for authorization to file
2 supplemental information, on January 10th. We gave
3 approval for that, and then we had another
4 communication from Patent Owner requesting opposition
5 to Petitioner's motion for supplemental information.

6 So the confusion arises on our part,
7 because it's not clear to us, based on these
8 communications, whether we're proceeding with which
9 rules we're proceeding, with respect here to. The
10 understanding that we had was that there were
11 objections to evidence filed by the Patent Owner, in
12 both of these cases.

13 Let me pull these up. In 906, there
14 were Patent Owner's objections to evidence Paper 13,
15 filed on December 23rd. And then in the 907 case,
16 there were Patent Owner's objections to evidence Paper
17 12, also filed on the 23rd.

18 In those objections, with respect to
19 the extent that the papers are identical in either
20 case, which I'm assuming they might be, on page 4 with
21 respect to Exhibits 10-10, 10-14, 10-15, 17, and 18,
22 Patent Owner filed hearsay objections under FRE 801,
23 802, and 805, with respect to these exhibits and their
24 date of publication or the date when the documents
25 were publicly accessible or publicly available.

1 So when we received Petitioner's
2 communication asking to file supplemental information,
3 our understanding was that we were proceeding with
4 respect to 37 C.F.R. section 42.64, which provides
5 that the party can file supplemental information,
6 under (b) (2), with respect to objections to evidence.
7 But then when we received Patent Owner's communication
8 saying, "We want to file an objection to their
9 motion," we were not expecting a motion from
10 Petitioner.

11 So now you can see the confusion. We
12 don't know which part we're proceeding under. So as
13 it appears to us, as that the petitioner or the patent
14 owner are thinking they're proceeding under two
15 different parts of the C.F.R.. So, given that
16 perspective from the board, let's hear from Petitioner
17 first.

18 MR. ERICKSON: Thank you, Your Honor.
19 Brian Erickson. We are intending to proceed with a
20 motion under 42.123(a), for supplemental information.
21 We do not intend to submit any supplemental evidence,
22 in response to Patent Owner's objections.

23 The parties are involved in a series of
24 IPRs that are not legally related to this one, but
25 they're all patents that are in the same co-pending

1 proceeding and litigation. This is the same form e-
2 mail, if you will, that Petitioners used in those
3 other IPRs, to request leave to submit supplemental
4 information, subsequent to the granting of that leave.
5 Petitioner filed that via motion, and then Patent
6 Owner opposed that motion.

7 So I think the disconnect here, Your
8 Honor, is that the parties, I think, are on the same
9 wavelength. It's just Petitioner's e-mail, in
10 hindsight, was not particularly clear, and we should
11 have made clear that we were seeking leave for a
12 motion for supplemental information, under C.F.R.
13 42.123. And I was just trying to --

14 THE COURT: Okay. Thank you for that.

15 MR. ERICKSON: I'm sorry, Your Honor.
16 I wrote that --

17 THE COURT: Just thank you for --

18 MR. ERICKSON: -- and I -- go ahead.

19 THE COURT: That's okay. Just one
20 second. Just want to clarify, so Petitioner's
21 original intent is to file a motion under 123 not to
22 file supplement information under 64. Is that
23 correct?

24 MR. ERICKSON: Yes. That's correct,
25 Your Honor.

1 THE COURT: Okay, great. Well, thank
2 you for that clarification. I really appreciate that.
3 So go ahead, Petitioner. You wanted to say something
4 else about the e-mail?

5 MR. ERICKSON: Yeah, I was just going
6 to say, Gianni, I'm going to told -- can I identify
7 yourself and I, sorry, just wanted to make sure you
8 identify yourself for the court reporter.

9 MR. MINUTOLI: Sure. This is Gianni
10 Minutoli, also from DLA Piper. I wrote the e-mail,
11 and it was my -- I left out the word motion, so I
12 apologize. I think I caused this whole mess.

13 THE COURT: Okay. All right. Mr.
14 Pluta, would you like to add anything or is that also
15 your understanding of how the parties are proceeding?

16 MR. PLUTA: Yes. I'd like to add
17 something, Your Honor. Robert Pluta, on behalf of
18 Maxell. I think Your Honor was correcting the initial
19 framing of the issue under 42.64 (b). We served
20 objections objecting to the exhibits 10-10, 10-14, 10-
21 15, among others.

22 Petitioner did not serve any evidence
23 in response to our objections to evidence. Those were
24 due January 8th. They never served them, and our
25 position would be that they're waived at this point.

1 The only thing that we've been advised about, as to
2 what Petitioner seeks to submit, is a declaration from
3 internet archive.

4 And, as we briefed in one of the other
5 matters, and I'll just summarize it here, such a
6 declaration is not supplemental information. It's
7 actually supplemental evidence under 42.64. It's not
8 going to any ground in the case.

9 The board itself has cited the
10 difference between supplemental evidence and
11 supplemental information, in the ServiceNow case
12 IPR2015-01176 Paper 15. And the information at least,
13 or evidence that Petitioner is suggesting that it
14 wants to submit, is not supplemental information. So
15 we think anything they seek to submit, at this point,
16 is improper and late and waived.

17 THE COURT: Okay. Thank you Mr. Pluta.
18 All right, well it sounds like then we're on the same
19 page here. The petitioner wants to proceed with a
20 motion for supplemental information, under 37 C.F.R.
21 section 42.123. And then, Mr. Pluta, that's your
22 understanding as well? Can you confirm that for me?

23 MR. PLUTA: That's my understanding is
24 that's the mechanism that which they want to proceed.
25 Yes.

1 THE COURT: Okay. And so, Petitioner,
2 have I framed that correctly?

3 MR. ERICKSON: Yes, Your Honor.

4 THE COURT: Okay. Okay. Given that
5 then we can -- we'll go offline, and I will consult
6 with my other panel members. But it, based upon what
7 you're providing to us here, we can make a ruling on
8 this, with this request for the objection, for the
9 motion supplemental information, and then a response
10 by the Patent Owner.

11 Petitioner, can I ask, given this now,
12 what's your anticipated timeline on filing a motion?

13 MR. ERICKSON: We could easily file it
14 by Monday, Your Honor, if we could have until that
15 time.

16 THE COURT: Okay. Because I believe
17 you did send the board an e-mail saying you were going
18 to hold off on that.

19 MR. ERICKSON: Yes, Your Honor. We had
20 intended originally to file it last week. When we saw
21 the follow-up e-mail from the board, we decided to
22 wait to do anything until after this call.

23 THE COURT: Okay, so that would be
24 January 27th; correct?

25 MR. ERICKSON: Correct, Your Honor.

1 THE COURT: Okay. And then --

2 MR. ERICKSON: And --

3 THE COURT: So go ahead.

4 MR. ERICKSON: One note. Yeah. I was
5 going to say, Your Honor, parties recently filed a
6 stipulation moving back due dates one, two, and three.
7 So there is additional time in the schedule. I just
8 wanted to make that note.

9 THE COURT: Okay. And then, Owner,
10 with respect to response on this, to their motion,
11 what are you looking at in terms of page numbers and
12 time?

13 MR. PLUTA: I suppose, as far as page
14 numbers, it depends on how extensive their motion is.
15 In the other proceeding where we filed an opposition,
16 it was about ten pages. I don't anticipate needing
17 more than that, as far as timing goes. If the board
18 would allow us until the 5th of February to file an
19 opposition, that would be appreciated.

20 THE COURT: And, the petitioner, is
21 there any need for any further briefing beyond that?
22 Or is one paper from each side sufficient, for your
23 purposes?

24 MR. ERICKSON: Your Honor, given the
25 way Patent Owner has phrased their opposition, I think

1 we can address -- we anticipate being able to address
2 all of that, in our opening motion, to the extent a
3 new argument is raised and their opposition at that
4 point. If we feel the need, we would approach the
5 board and request leave to file a reply at that point.

6 THE COURT: Okay. All right. And then
7 if there is going to be a reply, how much time is this
8 that you're asking for? Is this two weeks that you're
9 asking for, Patent Owner, 27th to the fifth?

10 MR. PLUTA: It would be a week and a
11 half, Your Honor.

12 THE COURT: Ten days?

13 MR. PLUTA: Yes.

14 THE COURT: Okay. All right. So if we
15 issue an order on this, it's likely then that we're
16 just going to put in the approval for a reply brief of
17 a certain number of pages, probably that same amount
18 of time. Okay. All right. Petitioner, anything else
19 from you with respect to this?

20 MR. ERICKSON: Your Honor, I think the
21 arguments would best be saved for the brief, to the
22 extent the board wants to reply at this point to
23 Patent Owner's arguments. I'm prepared to address
24 that briefly, although I think it would be best left
25 for the briefs.

1 THE COURT: Okay. And how many pages
2 do you anticipate your motion to be, Petitioner?

3 MR. ERICKSON: Ten. Less than ten.

4 THE COURT: Patent Owner, anything else
5 from you on this?

6 MR. PLUTA: Not at this time, Your
7 Honor.

8 THE COURT: Okay. So I think the
9 simplest way for us is we'll issue an order, on
10 Petitioner's request, for a motion to file
11 supplemental information. And it'll frame the page
12 numbers and the timing for everybody in that order.

13 But if you need anything else from us,
14 feel free to contact us by e-mail, and we can go back
15 to this and take care of that. But going forward in
16 the future, if you have other cases in front of the
17 board, it would be appreciated, you would let us know
18 under which section you're proceeding, because it
19 wasn't clear.

20 And it was, as you can see, from our
21 perspective, you could have proceeded under either one
22 of these, and it didn't appear to us as if we
23 understood that the parties were in agreement as to
24 which section of the C.F.R. they were proceeding. So,
25 in the future, we'd appreciate that kind of

1 clarification, if it's possible.

2 MR. ERICKSON: Understood. Thank you,
3 Your Honor.

4 THE COURT: Okay. Anything else that
5 we can do for you while we have you on the line,
6 Petitioner?

7 MR. ERICKSON: Nothing from Petitioner,
8 Your Honor.

9 THE COURT: Patent Owner?

10 MR. PLUTA: Nothing from Patent Owner,
11 Your Honor. Thank you.

12 THE COURT: Okay. Counsel, I really
13 appreciate your time. I appreciate your clarifying
14 this for us. This way we'll be able to move forward.
15 Mr. Erickson, Mr. Pluta, thank you very much for your
16 assistance. We are adjourned.

17 MR. PLUTA: Thank you.

18 THE REPORTER: We're off the record,
19 4:14.

20 (Whereupon, at 4:14 p.m., the
21 proceeding was concluded.)
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CERTIFICATE OF DEPOSITION OFFICER

I, SURINA MAHADEO, the officer before whom the foregoing proceedings were taken, do hereby certify that any witness(es) in the foregoing proceedings, prior to testifying, were duly sworn; that the proceedings were recorded by me and thereafter reduced to typewriting by a qualified transcriptionist; that said digital audio recording of said proceedings are a true and accurate record to the best of my knowledge, skills, and ability; that I am neither counsel for, related to, nor employed by any of the parties to the action in which this was taken; and, further, that I am not a relative or employee of any counsel or attorney employed by the parties hereto, nor financially or otherwise interested in the outcome of this action.



SURINA MAHADEO

Notary Public in and for the
State of New York

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I, KIMBERLY WYLIE, do hereby certify that this transcript was prepared from the digital audio recording of the foregoing proceeding, that said transcript is a true and accurate record of the proceedings to the best of my knowledge, skills, and ability; that I am neither counsel for, related to, nor employed by any of the parties to the action in which this was taken; and, further, that I am not a relative or employee of any counsel or attorney employed by the parties hereto, nor financially or otherwise interested in the outcome of this action.



KIMBERLY WYLIE

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