

**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: IPR2024-00906

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

**PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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<i>SZ DJI Tech. Co., Ltd., Autel Robotics USA LLC</i> , IPR2019-00343, Paper 30 (P.T.A.B. Jan. 16, 2020)	4
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TABLE OF EXHIBITS

Exhibit	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 Publication No. US 2006/0203758 (Tee)
2006	U.S. Patent Publication No. US 2006/0135076 (Honkanen)
2007	Petitioner's invalidity contentions chart in District Court—Tee
2008	Petitioner's invalidity contentions chart in District Court—Honkanen
2010	L2CAP-Based Prototype Media Streaming via Bluetooth Technology
2011	https://www.nytimes.com/2009/10/19/technology/companies/19nokia.html
2012	https://www.codeproject.com/Articles/9357/Symbian-OS-design-faults
2013	https://www.engadget.com/2010-10-21-nokia-refines-development-strategy-adopts-html5-in-qt-and-ends-s.html
2014	https://www.businessinsider.com/ios-5-over-the-air-updates-2011-7
2015	https://support.apple.com/en-us/102998
2016	Conference Transcript
2017	Declaration of Bruce McNair, dated March 26, 2025
2018	Claim Construction Order
2019	https://time.com/4837176/iphone-10th-anniversary/
2020	https://sites.suffolk.edu/jhtl/2014/09/30/nfc-technology-makes-first-appearance-in-apple-devices/
2021	https://www.nfcw.com/2010/12/07/35385/google-unveils-first-android-nfc-phone-but-nexus-s-is-limited-to-tag-reading-only-for-now/
2022	https://news.samsung.com/us/samsung-announces-launch-dates-for-groundbreaking-mobile-payment-service-samsung-pay/
2023	https://www.theregister.com/2008/08/13/iphone_not_very_3g/
2024	https://www.wsj.com/articles/SB118306134626851922
2025	https://blogs.windows.com/devices/2012/09/19/circuit-training-the-amazing-evolution-of-smartphone-processors/
2026	Essentials of Mobile Handset Design
2027	https://9to5mac.com/2012/06/02/new-iphone-to-debut-with-dual-band-40nm-bcm4334-broadcom-wifi-significant-power-savings-and-wifi-directios-airdrop/

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Patent Owner's Motion to Submit Supplemental Information

2028	https://community.arubanetworks.com/browse/blogs/blogviewer?blogkey=5c9cb0f9-a77e-4f1f-95de-4aac6fa7b262
2029	SAM-MAX-00388464
2030	Creusere Deposition Transcript
2031	https://www.wired.com/2007/06/why-the-iphone-2/
2032	https://www.comms-express.com/infozone/article/802-11n/
2033	https://support.apple.com/en-us/102587
2034	https://www.ezurio.com/resources/blog/ota-over-the-air-updates-for-iot-devices
2035	https://www.theregister.com/2007/02/06/nokia_update_updated/
2036	UMTS; Physical channels and mapping of transport channels onto physical channels
2037	5:23-cv-00092-RWS (E.D. Tex.), Transcript (April, 24, 2025)
2038	Samsung's Opposition to Maxell's Motion for Partial Reconsideration of the Court's Order, Docket No. 285 (May 8, 2025)
2039	E-mail to the Board on June 5, 2025

I. INTRODUCTION

Patent Owner respectfully moves to submit EX2037 and EX2038 as supplemental information pursuant to 37 C.F.R. § 42.123(b). These exhibits contain evidence “related to testimony in the federal district court” offered by Samsung either orally or in writing. Paper 36 at 2. This evidence could not have been obtained earlier and consideration of the evidence would be in the interests-of-justice.

EX2037 contains admissions as to the deficiencies in Petitioner's primary reference, the N93 User Manual (EX1010), that undermine Petitioner's arguments in this proceeding with respect to elements [1i], [1j], and [1k]. EX2038 contains admissions that element [1i] is not met by Bluetooth video sharing functionality, precisely the opposite of what Petitioner argues in this proceeding with respect to alleged disclosures in EX1010.

Patent Owner's request was timely made, is directly related to a claim for which the trial was instituted, and if admitted, will demonstrate that Petitioner is taking different positions in the district court litigation than it has taken during this IPR. *See Ultratec, Inc v. Captioncall, LLC*, 872 F.3d 1267 (Fed. Cir. 2017).

II. LEGAL STANDARD

A motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b) must meet two requirements: (1) the supplemental information reasonably could not have been obtained earlier; and (2) consideration of the supplemental

information would be in the interests-of-justice. Both prongs are met here. There is no prejudice to Petitioner and Patent Owner's motion meets "the very low threshold required to show that the proposed supplemental information has relevance in this proceeding, that . . . [Patent Owner's] request is timely despite the advanced stage of this proceeding, and that it would be in the interested of justice to grant the motion." *See, e.g., Kingston Tech. Co., Inc. v. Spex Techs., Inc.*, IPR20217-01021, Paper 31, at 4-5 (P.T.A.B. May 29, 2018).

III. PATENT OWNER'S EXS 2037-2038 SATISFY 37 C.F.R. § 42.123(b)

A. EXS 2037 and 2038 Could Not Have Been Obtained Earlier

Patent Owner's motion is timely because the information could not reasonably have been obtained earlier. The '241 Patent was asserted in *Maxell, Ltd. v. Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.*, 5:23-cv-00092-RWS (E.D. Tex.). Paper 7, at 1. The admissions in EX2037 were made at a dispositive motions hearing by lead counsel for Samsung on April 24, 2025. The assertion in EX2038 that distinguishes Bluetooth File Share functionality from element [1i] was made in Samsung's Opposition to Maxell's request for reconsideration of summary judgment on May 8, 2025 and elaborated on concessions provided on April 24, 2025. While these statements were made in reference to U.S. Patent No. 10,129,590 (the "'590 Patent"), Samsung asserts identical invalidity grounds for the '241 Patent so Petitioner's statements also apply here. After trial concluded on May 28th, and in an

effort to provide all conflicting testimony in a consolidated manner to the PTAB, PO sent an email on June 5, 2025, requesting authorization to file motions to submit supplemental information. EX2039.

Such information “did not exist at the time Patent Owner filed its Patent Owner Response. Thus Patent Owner could not have submitted it then.” See *PNC Bank, N.A., United Services Automobile Association*, IPR2021-01070, Paper 52, at 4 (P.T.A.B. Sept. 14, 2022) (granting similar motion citing *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) (“inconsistent testimony did not exist sooner and thus could not have been proffered to the Board sooner.”)).

B. Consideration of EXs 2037 and 2038 Is In The Interest of Justice

Admissions about deficiencies of N93 and inconsistent statements made by Petitioner are germane to Grounds with respect to N93 (Ground Nos. 1, 2, 4, and 5). Thus, consideration of EXS 2037 and 2038 is in the interest of justice because they involve party admissions and inconsistent statements on the *same* prior art and theories by the *same* party at issue in this IPR. “This information has the potential to be highly relevant.” *PNC Bank*, Paper 52, at 6 (holding that conflicting information across forums is highly relevant for Board’s view of credibility). The Board found this type of information to be highly relevant even where the testimony was given by a different expert. *Id.* Here, the source of the admissions and inconsistent testimony is Petitioner Samsung.

In *Ultratec*, CaptionCall's expert testified about similar issues in both proceedings—***just like Samsung has provided admissions/statements***. And, the Federal Circuit determined that a “reasonable adjudicator would have wanted to review this evidence.” *Id.* Allowing introduction of Samsung's admissions and inconsistencies would be in the interest of justice here, like it was in *Ultratec*.

C. Granting Patent Owner's Motion Does Not Prejudice Petitioner

Petitioner is represented by the same counsel and knew about its positions across both proceedings. Any claim of prejudice is of Petitioner's own making and any “concerns are outweighed by the relevance of potentially inconsistent testimony.” *SZ DJI Tech. Co., Ltd., Autel Robotics USA LLC*, IPR2019-00343, Paper 30, at 5 (P.T.A.B. Jan. 16, 2020).

Each of Petitioner's admissions/statements highlights deficiencies in the prior art cited in this proceeding. In particular, these statements include a party's characterization of specific features not disclosed in a primary reference across multiple grounds or functionality that does **not** meet certain claim limitations. Petitioner has a duty of candor in this proceeding and was obligated to disclose these statements under 37 CFR § 42.11. Instead, Petitioner continues to exert every effort to exclude such information. Creation of such conflicting records is precisely the rationale that *Fintiv* sought to prevent. Paper 7 at 12. Thus, any claims of prejudice

by Petitioner are outweighed by the obligations to satisfy the duty of candor to the PTAB under 37 CFR § 42.11.

D. No Administrative Burden Exists

Furthermore, the supplemental information is focused on limited portions of the District Court record. *See PNC Bank*, Paper 52, at 7. *Ultratec* highlights the importance of considering inconsistencies in view of “very little administrative burden.” *Ultratec*, 872 F.3d at 1273; *see also SZ DKI Tech*, Paper 30, at 5.

IV. PETITIONER'S ADMISSIONS/STATEMENTS

A. Relevance of EX2037 ([1j] and [1k])

Claim element [1j] of the '241 Patent recites that the “controller controls each of the first and second radio communication circuit so that the first radio communication circuit transmits video information while the second radio communication circuit connects to the internet or the home network.” *See* Pet. at viii. In Grounds 1 and 2, Petitioner relies on N93 to teach this claim element and alleges that “**N93 explicitly teaches** the phone can be used as a modem for a PC by simultaneously using a Bluetooth connection to the PC and a UMTS connection to the Internet. . . . Thus, a POSITA would have understood that **N93 discloses simultaneous Bluetooth video transfers and data packet connections over UMTS.**” *See* Pet. at 36, 57 (emphases added); *see also* Paper 25 at 11 (“N93 teaches . . . simultaneously using Bluetooth connection to the PC and a UMTS connection

to the Internet . . . sufficient to render obvious simultaneous operation of the two processes as a whole, for example, when a user is browsing the web or **transferring a video file**").¹ But, in efforts to defeat a summary judgment motion brought by Patent Owner relating to Petitioner's violation of its *Sotera* stipulation, Petitioner's lead trial counsel made great efforts to highlight distinctions between the prior art publication and alleged system. As such, Petitioner conceded that claim element [1j] is "not shown in the [N93] user manual." *See* EX2037, 27:10-28:10:

Your Honor, if you look back at it after the hearing is **you will not see the word "video"** in that paragraph at all because there is no evidence that's cited here with respect to the use of video. It's **talking about the N93 teaching** simultaneous data packet connections, but what's being referenced here **doesn't show video. They haven't cited anything in the user manual that says that you could transmit video at the same time as connecting to the Internet. It's just not there.** *Id.* (emphasis added).

This admission as to the deficiency of N93 (EX1010) is glaring when put side-by-side with Petitioner's position in this proceeding where Petitioner specifically seeks motivation from disclosures in the N93 as the rationale for why a POSITA would have understood N93 to disclose "simultaneous Bluetooth video transfer":

1. Patent Owner acknowledges that claim element [1j] does not recite the word "simultaneous," but Petitioner's argument relied on "simultaneous communications" to satisfy this element. Further, Petitioner conceded that the N93 User Manual fails to teach anything about "transmit[ing] video at the same time as connecting to the Internet." *See id.*

Pet. at 36	EX2037 at 27:13-17
Thus a POSITA would have understood N93 discloses simultaneous Bluetooth video transfers and data packet connections over UMTS	Claim 1 requires that the simultaneous use of two radios , one to transmit video and one to connect to the Internet, specific video, video and the Internet, that is not shown in the user manual

PO also agrees that this limitation is not rendered obvious by the combination in Grounds 1 and 2, and PO's expert provided detailed evidence why such simultaneous video transfer over Bluetooth would not be obvious either in N93 User manual or Dua or any combination due to technical limitations at that time of Bluetooth for video streaming. POR, 23-33, 57-58. This admission in the District Court supports PO and its expert's assertion of non-obviousness.

With respect to claim element [1k], to defeat a summary judgment based on its violation of its *Sotera* stipulation, Petitioner's lead trial counsel conceded that claim element [1k] is not shown "because the [N93] user manual never talks about downloading the operating system." See EX2037, 29:1-6:

You will note, Your Honor, that on Slide 29 of the Plaintiff's deck, what they cite is the downloading of applications, not the downloading of the operating system, because **the user manual never talks about downloading the operating system**. It only talks about downloading applications.

While Petitioner relies on Herle to disclose operating system updates in Ground Nos. 1-5, Petitioner draws from disclosures of the N93 User manual on why

such a combination would be obvious and makes representations to the PTAB that are inconsistent with the above admission. In particular, Petitioner states that “N93’s discussion of deleting installation files and only installing updates from trusted sources (POR, 34) affirmatively teaches that the user should perform updates from trusted sources and save memory” (Paper No. 25 at 15) and “it was known that Symbian could be updated over the air . . . (remote OS update), [0042] (Symbian OS could be updated OTA)” (Paper No. 25 at 17).

Thus, when justifying importing Herle’s server based update system in the N93 User manual, Petitioner asserted the N93 User manual discloses such updating features. *Id.* On the other hand, when arguing to avoid the *Sotera* stipulation, Petitioner made a clear and unequivocal concession that N93 User manual **never** talks about downloading the operating system. EX2037, 29:1-6. Petitioner’s concession combined with PO and its expert’s technical rationale on why N93 teaches away from such modifications/enhancements in view of memory, regulatory, and security constraints support a finding of non-obviousness as to at least Ground Nos. 1 and 2. *See* POR at 33-41. This unequivocal concession that a claim element is not disclosed in a primary reference is information material to patentability.

B. Relevance of EX2038—Admissions With Respect to Limitation [1i]

At the April 24, 2025, hearing, Samsung’s counsel argued that simply pointing to Bluetooth File Share function in a device—like they point to for the N93—is not

enough to show that limitation [1i] is met because Maxell's expert "didn't actually parse to look at the code to figure out **when the exact assignment** occurs." EX2037, 157:11-25. Samsung further emphasized that its expert "looked at the code" to find the precise timing of assignment of connection "for the purpose of transmitting video. It's not just **any** assignment." *Id.* Samsung then elaborated in a subsequently filed Opposition in District Court where it stated that claim element [1i] is not met by Bluetooth File Share functionality because the "timing and causal relationship [for when the controller assigns a connection] is shown **only in the source code** of the software **executed by the controller**." See EX2038, 10. Petitioner also argued that claim element [1i] is not met if "the controller **would eventually assign the Bluetooth** radio to transmit the video information [after intervening events]." *Id.* (emphasis added). Thus, Samsung alleged that claim element [1i] can **only** be shown when timing of the assignment of connection is identified in source code and there should be a direct cause and effect without intervening events.

This is precisely the opposite of what Samsung has shown in its Petition as they only rely on the N93 User manual and Dua for **all** the Grounds. Pet. at 33-35. In particular, neither Samsung or its expert has pointed to **any** source code or pointed to any evidence to identify the precise "timing and causal relationship" of when the connection is assigned in N93 or Dua. *Id.* To the contrary, they simply point to a series of steps that include intervening events. *Id.*; see also EX1010, 86 ("[i]f the

other device requires pairing before data can be transmitted”). There is simply no discussion as to “timing and causal relationship” in the Petition, instead just a conclusory assertion that connection would **eventually** be assigned. Samsung’s expert confirmed as much in this proceeding by testifying that “I haven’t identified the exact point of assignment” and that his prior art analysis shows that “[T]he decision is made at the indication of a user . . . and then internally the system will go through **whatever steps** it needs to in order to setup that connections and **ultimately allow** for the transmission of video.” EX2030, 28:6-29:6 (emphasis added). According to Samsung in the District Court, however, (1) timing and causal relationship is required; (2) this can **only** be shown via source code; and (3) eventually assigning the connection with intervening events does not meet claim element [1i]. The Petition and prior art do not meet Samsung’s own conditions. *See* Pet. at 33-35; *see also* POR at 22-23 (PO arguing that N93 and Dua provide no evidence of any controller operating based on a user indication or assigning a connection). Thus, Samsung’s analysis of the prior art in this proceeding shows exactly what Samsung deems to be insufficient to meet this claim element [1i].

In view of these admissions by Petitioner about claim elements [1i], [1j], and [1k] and Samsung’s failure to disclose information material to patentability, Maxell requests consideration of this information and confirmation of patentability.

Patent No. 11,445,241

Patent Owner's Motion to Submit Supplemental Information

Dated: September 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of September, 2025, a copy of the attached PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: September 15, 2025

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