

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**SAMSUNG ELECTRONICS CO., LTD. AND  
SAMSUNG ELECTRONICS AMERICA, INC.**

Petitioners

v.

**MAXELL, LTD.**

Patent Owner

Inter Partes Review No.: IPR2024-00906

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

**PETITIONERS' AUTHORIZED RESPONSE TO DIRECTOR REVIEW  
REQUEST**

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| 1041        | Dec. 13, 2024 email from Bhattarai to Patron Services Peach (Affidavits)                     |
| 1042        | Dec. 23, 2024 email from Bhattarai to <a href="mailto:info@archive.org">info@archive.org</a> |
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| 1060        | Archived Page of <a href="http://www.3gpp.org/ftp/Specs/html-info/36-series.htm">http://www.3gpp.org/ftp/Specs/html-info/36-series.htm</a>                                                        |
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| 1062        | Archived Page of <a href="http://www.3gpp.org/ftp/Specs/archive/36_series/36.211/36211-021.zip">http://www.3gpp.org/ftp/Specs/archive/36_series/36.211/36211-021.zip</a>                          |
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| 1064        | US 2006/0075284 (“ <b>Skan</b> ”)                                                                                                                                                                 |
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| 1071        | N93 Wikipedia page (October 12, 2007)                                                                                                                                                             |
| 1072        | N93 Wikipedia page (August 18, 2007)                                                                                                                                                              |
| 1073        | Scheiter, C. et al., (2003) A System for QoS-Enabled MPEG-4 Video Transmission Over Bluetooth For Mobile Applications, Multimedia and Exp, 2003 ICME '03, Proceedings, Washington DC, pp. 789-792 |
| 1074        | Razavi, et al., (2006) Efficient Packetization for Bluetooth Video Transmission, Electronic Letters, Vol. 42, No. 20, pp. 1143-1145                                                               |
| 1075        | U.S. Pat. No. 8,514,832                                                                                                                                                                           |
| 1076        | The N93 User Manual slide                                                                                                                                                                         |
| 1077        | Excerpt from Samsung’s Opposition to Plaintiff’s Motion for Partial Summary Judgment of Validity Based on Samsung’s <i>Sotera</i> Stipulations ( <b>5:23-cv-00092-RWS (E.D. Tex.), Dkt. 191</b> ) |
| 1078        | Samsung’s Surreply in Opposition to Maxell’s Motion for Partial Summary Judgment of Validity Based on Samsung’s <i>Sotera</i> Stipulation ( <b>5:23-cv-00092-RWS (E.D. Tex.), Dkt. 221</b> )      |

| Exhibit No. | Description                                                                                                                    |
|-------------|--------------------------------------------------------------------------------------------------------------------------------|
| 1079        | Email from Robert Pluta to the Board, dated June 5, 2025                                                                       |
| 1080        | Email from Robert Pluta to Brian Erickson, et al., regarding Samsung/Maxell IPRs—draft email to Board, dated September 8, 2025 |
| 1081        | Email from Brian Erickson to Robert Pluta, et al., regarding Samsung/Maxell IPRs—draft email to Board, dated September 8, 2025 |

## **I. INTRODUCTION**

Petitioners respectfully request the Director deny Patent Owner's request (Paper, 48, "DR Request") to review the Final Written Decision ("FWD") (Paper 47) and affirm the Board's finding that claim 15 of U.S. Pat. No. 11,445,241 ("the '241 patent") is unpatentable.

The Board's decision that UMTS encompassed EUTRAN and OFDM by the priority date is supported by evidence of record, including the testimony of Dr. Creusere and Mr. McNair, the 3GPP-Spec, and the 3GPP.org website. Pet., 45; Reply, 22-23; Ex. 1002, ¶ 93; Ex. 1058, ¶ 14; Ex. 1015, 2 ("UMTS"), 5 ("The present document describes the physical channels for evolved UTRA"), 8 ("OFDM"), 15 ("OFDM"); Ex. 2017, 155 ("OFDM"). The Board correctly found that a POSITA would have known that UMTS had evolved to include EUTRAN by the priority date, which was the only issue in dispute. FWD, 135-137. The Dissent did not disagree with that holding, and Patent Owner does not seek review of that holding. Thus, under the Board's unanimous holding, Dr. Creusere's testimony that a POSITA would have known that UMTS included OFDM is uncontested. This uncontested testimony is sufficient to affirm the Board's decision, particularly in light of Patent Owner's expert's testimony that OFDM was known to persons of even less than ordinary skill. Ex. 1057, 12-13 (11:12-12:14). But Dr. Creusere's testimony does not stand alone. The Board unanimously and correctly denied

Patent Owner’s motion to exclude the 3GPP-Spec. FWD, 138-140. Patent Owner does not seek review of that decision. 3GPP-Spec establishes that UMTS included EUTRAN and OFDM, and a reference can be used to show knowledge of a POSITA even if it does not qualify as prior art. Thus, the 3GPP-Spec is admitted evidence of record that corroborates Dr. Cruesere’s testimony.

In any event, the Director should find that the 3GPP-Spec qualifies as a printed publication. The Board acknowledged that there were two navigational paths on the 3GPP.org website to the 3GPP-Spec, but clearly erred by failing to consider the alternative path, which suffers from none of the purported deficiencies the Board found in the first path.

Finally, Petitioner did not violate the “spirit” of its *Sotera* stipulation because that stipulation was expressly limited to the then-co-pending district court litigation and is irrelevant to the later filed ITC investigation. And the Board fully considered Patent Owner’s Motion for Supplemental Information (Paper 37) on the merits and rejected Patent Owner’s allegations of inconsistencies. Paper 42, 3-7.

## **II. ARGUMENT**

### **A. The Board Correctly Found Claim 15 Unpatentable**

Patent Owner’s DR Request seeks review based on the incorrect premise that there is no evidence in the record that EUTRAN encompassed OFDM. DR Request, 6. But the record includes uncontested evidence that is the case.

First, Dr. Creusere provides uncontested testimony that UMTS includes OFDM. Ex. 1002, ¶ 93 (pointing to Ex. 1015 and “OFDM”). It is undisputed that the 3GPP-Spec (Ex. 1015) addresses UMTS’s evolution to include EUTRAN. Reply, 22-23; Ex. 1015, 5. Patent Owner’s only argument before the Board was that Dr. Creusere’s testimony and the 3GPP-Spec were irrelevant because UMTS did not include the 3GPP-Spec/EUTRAN. The Board rejected Patent Owner’s and Mr. McNair’s argument, and Patent Owner does not seek review of that holding. FWD, 127, 129. Thus, Dr. Creusere’s testimony is unrebutted. *GO1 Pty, Ltd. v. Opensesame, Inc.*, 2024-1762 (Fed. Cir. May 28, 2026) (holding uncontested expert testimony is sufficient evidence to show the claimed order of steps would have been obvious even though both references in the combination lacked that claimed order.).

Second, the 3GPP-Spec itself is admitted evidence that UMTS evolved into EUTRAN to include OFDM. Ex. 1015, 2 (“UMTS”), 5 (“The present document describes the physical channels for evolved UTRA”), 8 (“OFDM”), 15 (“OFDM”). Contrary to the assertion in the DR Request at 2-3 that the 3GPP-Spec was “excluded,” the Board denied Patent Owner’s motion to exclude. FWD, 140. A reference can serve as evidence of the knowledge of a POSITA even if the reference is not prior art. *Yeda Research & Devg. Co. v. Mylan Pharms., Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018). PO admits 3GPP-Spec is evidence that

EUTRAN included OFDM. DR Request, 2-3; Paper 25 (Reply), 22-24; Paper 31 (Sur-Reply), 20-22 (not disputing); PO's expert Mr. McNair also agrees that the 3GPP-Spec disclosed OFDM. Ex. 2017, 155 ("OFDM").

The facts here in support of unpatentability are much stronger than the facts in *GO1* for at least three reasons. First, here, Mr. McNair was not merely silent, but expressly conceded OFDM was known and within the skill of a POSITA. Ex. 1057, 7-9 (6:2-15, 7:16-8:17), 12-13 (11:12-12:14). Second, in *GO1* the order of steps in the prior art had to be modified to the claimed order or steps, but no such modification is necessary here because the expert is merely explaining that UMTS encompassed OFDM at the relevant time. FWD, 141-142 (note 12). Third, Dr. Creusere's testimony here is corroborated by the 3GPP-Spec, even if it does not qualify as a printed publication, while the expert's testimony in *GO1* was not corroborated.

PO's arguments in its DR Request fail in light of the evidence of record. PO incorrectly argues the Board and Petitioners recognized the publication issue as "fatal." DR Request, 8-9. To the contrary, the Board and Petitioners recognized that if the 3GPP-Spec were "gone" there would be an "impact," but that all grounds still included the knowledge of one skilled in the art. Paper 43, 135:20-25. Moreover, the 3GPP-Spec is not "gone" as the Board denied PO's motion to exclude. FWD, 138-140.

PO's argument that the Board inappropriately "gap filled" (DR Request, 9-11) fails in light of the admitted evidence shown above. PO's discussion of the "current practice" (DR Request, 11) is inapposite because the memorandum setting forth that practice expressly excludes petitions, like the one in this IPR, that were filed before September 1, 2025. *See* Memorandum, Enforcement and Non-Waiver of 37 C.F.R. 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews, at 3 (restricting to petitions filed after September 1, 2025).

PO's heavy reliance on the Dissent is misplaced because the Dissent erred by failing to recognize that the Petition for limitation 1b relied on the testimony of Dr. Creusere and the 3GPP-Spec technical document (Ex. 1015). Dissent, 3. The majority correctly relied on Dr. Creusere's testimony along with the evidence developed at trial. FWD, 135-137, 141-142 (note 12). For other claims related to QAM and QPSK modulation, the Dissent correctly agreed with the majority that expert testimony and a 3GPP technical document (Ex. 2036) were sufficient. Dissent, 2-3. The Dissent erred by finding differently for OFDM modulation.

**B. PO's Request To Review The Unpatentability of Claim 15 Should Be Denied On an Alternative Basis**

The Director should deny PO's Request and affirm the unpatentability of claim 15 on the alternative basis that the Board's finding that the 3GPP Spec was not sufficiently accessible was clearly erroneous because the Board failed to address the substantive differences in the alternative navigational path.

The Board acknowledged that an interested person would have had two different navigational paths on the 3GPP.org website to access the 3GPP-Spec. FWD, 39-40. The first path is illustrated on Petitioner’s demonstrative slide 22 and the alternative path is illustrated on slide 23. Paper 41, 22-23. Both paths start with the interested person clicking on “Specifications” on the 3GPP.org home page. Ex. 1032, 8. The paths diverge at the second step. Ex. 1032, 10. The first path includes a link to the “specifications file server area” and is labelled “for those who know where they are going.” Ex. 1032, 10. The alternative path uses the second link that is labelled “To find a particular spec quickly, go here...” As explained by Dr. Creusere, “[a] POSITA or interested person that were less familiar with the 3GPP website” could follow the alternative path that is “for members of the public that are not familiar” with 3GPP in general. Ex. 1058, ¶ 14; Paper 25 (Reply), 5; Paper 43 (Tr.), 18:8-23, 20:10-23, 21:4-22; Ex. 1057, 75-77 (74:6-76:15). Dr. Creusere’s testimony regarding the alternative path is not addressed by Mr. McNair.

The Board found the first path, which goes through an FTP file server area, was not “intuitive” because the third and fourth steps use lists of files that lack descriptive file names. FWD, 42. The Board found the first path was akin to a book on a library shelf that was not meaningfully catalogued or indexed. FWD, 43. The Board twice noted that the first path was explicitly labelled “for those who know where they are going” which the Board found would not include a POSITA. FWD,

42 and 44 (citing to Ex. 1032, 10). The Board held the first path required the person know the “specific numerical designation or particular location” to find the 3GPP-Spec. FWD, 43. The Board repeated and emphasized this as critical to its holding. FWD, 44 (finding no evidence a skilled artisan “would have navigated through the specifications file server area (described as ‘for those who know where they are going’) to an FTP directory, and then identified ‘36211-021.zip’ as a document of interest.”). But it is undisputed a person “less familiar” with 3GPP could have used the alternative path. Ex. 1058, ¶ 14; Paper 25 (Reply), 5; Paper 43 (Tr.), 18:8-23. And it is undisputed that the alternative path does not go through the FTP server area and does not require knowledge of a file name or location. *Id.*

The Board clearly overlooked the substantive differences in the alternative path. For example, the Board contrasted the path to the BT-Spec on the Bluetooth website with only the first path to the 3GPP-Spec on the 3GPP website. FWD, 42.

Unlike BT-Spec, which was reachable through an intuitive four-click path from the Bluetooth SIB homepage using self-explanatory labels (Learn – Bluetooth Technology – Specification Documents – Core Specification v2.0+EDR), **the path** to 3GPP-Spec required the user to navigate to an FTP server and identify a non-descriptive zip file named ‘36211-021.zip’ among numerous other files. Nothing in the file name identifies the document as relating to physical channels and modulation for Evolved UTRA.

FWD, 42 (emphasis added). But the alternative path to the 3GPP-Spec is a nearly

identical intuitive path as follows: “Specifications” – “go here” – “Evolved UTRA aspects: 36 series” – “TS 36.211: Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Channels and Modulation.” EX1032, 8, 10; EX1059, 1, EX1060, 1; Ex. 1058, ¶ 14. The use of these substantive chapter headings in the alternative path does not require navigating an FTP file server area, requires no pre-existing knowledge of 36211-021.zip, and explicitly identifies the 3GPP-Spec as relating to physical channels and modulation schemes for Evolved UTRA. *Id.* The alternative path for the 3GPP-Spec uses plain, descriptive language, is not dependent on pre-existing knowledge of a specific URL or file name, and is self-explanatory, just like the path to the BT-Spec on the Bluetooth website that the Board found sufficient. FWD, 38. And, like the BT-Spec, the 3GPP-Spec was hosted on the official standards body website and was reachable (via at least the alternative path) though intuitive navigation from the homepage using the descriptive titles. See *M&K Holdings, Inc. v. Samsung Electronics Co.*, 985 F.3d 1376, 1381 (Fed. Cir. 2021). Finally, the 3GPP.org website itself functioned as a well-known, organized repository that a skilled artisan would naturally consult when researching 3GPP technology. *Id.* at 1382. Thus, the alternative path addresses every purported deficiency relied on by the Board in its criticism of the first path.

Indeed, the Board’s reference to “the path” (singular) in its holding indicates the Board may have overlooked the alternative path entirely at this critical point in

its decision. While the Board acknowledged the existence of the alternative path elsewhere (FWD, 39-40 noting second path included Ex. 1059-Ex. 1060), the Board erred by failing to address the substantive differences in that path in its decision. For example, the Board found there was “no evidence” to the contrary, but followed that statement by citing only to Dr. Creusere’s opinion regarding the first path at paragraph 12, overlooking his opinion at paragraph 14 regarding the alternative path that provided that very evidence. FWD, 44.

The facts regarding the alternative path were not contested because Mr. McNair never addressed the substantive headings in the alternative path. The Board directly asked PO multiple times during the hearing whether PO had any position or evidence regarding the substantive chapter headings that only exist on the alternative path. Paper 43, 59:21-60:2 (noting the “chapter headings” and asking for any evidence to the contrary from PO), 60:12-23 (referring to chapter headings and links, stating “it strikes me that someone of the level of skill that the two of you have agreed upon would understand those technical terms” and asking for any evidence to the contrary), 61:16-22 (“didn’t Petitioner point to headings that would allow that person to navigate to whatever specifications they would want to look at, in particular, the one that’s relevant to 36.211?”). PO repeatedly evaded the questions. *Id.*, 60:12 (“That wasn’t my question.”), 61:8 (“Ok. But that’s not the question.”). PO conceded “I can’t seem to find that” and never

provided an answer. *Id.*, 61:12. Thus, the relevant facts regarding the alternative path are uncontested.

The only difference between the Bluetooth website that the Board found accessible and the 3GPP website that the Board found inaccessible is the addition of the first path on the 3GPP website through the FTP file server area for those that know where they are going. The addition of that first path does not detract from the alternative path, which persons less familiar with 3GPP could use, and was undisputedly accessible. Ex. 1058, ¶ 14; Paper 25, 5; Paper 43, 18:8-23. Thus, the alternative path establishes the accessibility of 3GPP-Spec as of the critical date, which qualifies 3GPP-Spec as a printed publication and prior art.

There is no dispute that, if the 3GPP-Spec qualifies as a printed publication, claim 15 is unpatentable. Accordingly, to the extent the Director finds any error in the Board’s decision, the Director should affirm that claim 15 is unpatentable on the alternative basis that the 3GPP-Spec qualifies as a printed publication.

### **III. PETITIONERS FULLY COMPLIED WITH THE *SOTERA* STIPULATION**

The Director should reject PO’s assertion that Petitioners have violated the “spirit” of the *Sotera* stipulation (DR Request, 13-14) because Petitioners fully complied with the stipulation. On September 7, 2023, PO filed the district court litigation asserting the ’241 patent and closely related ’590 patent (IPR2024-00907). Petitioners filed the Petition in this IPR on May 17, 2024 and submitted a

*Sotera* stipulation on Oct. 24, 2024. Paper 8. The *Sotera* stipulation by its own terms is explicitly limited to “the district court litigation.” Paper 8, 1.

On Dec. 16, 2024, PO filed a Complaint in the ITC on the ’241 patent to get a “second bite at the apple,” while continuing to pursue the closely related ’590 patent in district court. To ameliorate the prejudice from PO’s actions, Petitioners sought to stay the related district court action on the ’590 patent. In opposing Petitioners’ motion, **PO argued the validity issues in the ITC would be different from the district court litigation** because the *Sotera* stipulation did not apply to the ITC investigation. The district court relied on PO’s argument by ruling the *Sotera* stipulation did not apply in the ITC and therefore Petitioners did not show the validity issues would be the same. *Maxell, Ltd. v. Samsung Elec. Co.*, No. 5:23-cv-92-RWS, slip op. at 7–8 (E.D. Tex. Mar. 21, 2025), 7-8 (denying Petitioners’ motion stay based in part on PO’s argument that the *Sotera* stipulation did not apply in the ITC investigation such that the prior art validity issues would be different).

PO’s argument here that the “spirit” of the *Sotera* stipulation applies in the ITC investigation is inconsistent with PO’s position and the district court’s ruling that the stipulation does not apply. PO’s failure to disclose its inconsistent position and the district court’s reliance on that position in the co-pending litigation is inappropriate and justifies denying PO’s request in its entirety. “[W]hen a [party]

advances different positions before the Board and a district court, that [party] is *required* to explain why those different positions are warranted.” *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00340, Paper 18 at 3 (Director Nov. 5, 2025) (informative).

PO’s prior representation in February 2025 that the stipulation would not apply to the ITC investigation also confirms that PO was subjectively considering the implications of the *Sotera* stipulation on the ITC investigation and that PO improperly adopted a “wait and see” approach in this IPR. Only after losing the Final Written Decision on April 27, 2026 did PO raise its alleged violation of the “spirit” of the *Sotera* stipulation. The Director has warned parties against adopting such a “wait and see” approach. *See, e.g.*, IPR2025-00632, paper 36 (Director Jan 26, 2026), 3-4; IPR2025-01374, -01391, paper 20 (Director May 12, 2026), 3-5.

Finally, PO asserts in its DR Request that the Board “refused to consider the evidence” related to alleged inconsistencies. DR Request, 14. Not true. The Board fully considered the evidence and PO’s arguments in Paper 37 and found PO’s assertions lacked merit. Paper 42, 3-6 (finding no inconsistencies as to the N93), 6-7 (finding no inconsistencies as to Bluetooth).

#### **IV. CONCLUSION**

The Director should deny PO’s Request for the reasons given above.

Dated: June 4, 2026

Respectfully submitted,

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## CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on June 4, 2026, a true and correct copy of the forgoing document was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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A courtesy copy was sent electronically to counsel for Patent Owner in the District Court Litigation:

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