

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2024-00906 (Patent 11,445,241 B2)
IPR2024-00907 (Patent 10,129,590 C1)¹

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER
Granting Director Review and
Reversing-in-Part the Final Written Decisions

¹ This order applies to each of the above-listed proceedings.

Maxell, Ltd. (“Patent Owner”) filed requests for Director Review of the Final Written Decisions in the above-captioned cases, and Samsung Electronics., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed authorized responses to the requests. *See* Paper 48 (“Request”); Paper 49 (“Response”).²

In the requests, Patent Owner argues that Director Review should be granted and the Board’s Final Written Decisions (Paper 47, “Decision”) reversed as to claim 15 of U.S. Patent No. 11,445,241 B2 (“the ’241 patent”) and claim 21 of U.S. Patent No. 10,129,590 C1 (“the ’590 patent”), which both require demodulating through Orthogonal Frequency Division Multiplexing (“OFDM”). Request 1–2; IPR2024-00907, Paper 48, 1–2; *see* Ex. 1001, 23 (claim 15); IPR2024-00907, Ex. 1004, 4 (claim 21).

Specifically, Patent Owner argues that, as the dissenting opinion in each case explained, once the Board determined that an asserted reference (a version of a 3GPP-Specification) was not publicly available, the grounds presented in the Petition lacked support for showing that the asserted prior art discloses demodulation through OFDM. Request 5–8. Petitioner responds that the Board properly relied on other evidence developed during the trial to find claim 15 and claim 21 unpatentable. Response 2–5.

I am persuaded by Patent Owner’s argument and grant Director Review. In the Decision, the panel majority finds that the communication standard at issue in the case encompasses OFDM-based technologies sufficient to render the dependent claims unpatentable under all grounds presented in the Petition. Decision 135–37. The dissenting opinion,

² Unless otherwise noted, all citations are to IPR2024-00906. The parties filed similar papers in IPR2024-00907.

however, finds that Petitioner’s contentions for these claims do not address OFDM demodulation, and that Petitioner’s general contentions about the communication standard rely, at least in part, on the 3GPP-Specification, which is not prior art. Dissent 2–3 (citing Paper 3 (“Petition”), 45).³ I agree with the dissenting opinion that Petitioner has not shown the required demodulation through OFDM. Accordingly, and for the reasons stated in the dissent, I reverse the Board’s conclusion that Petitioner has shown unpatentability by a preponderance of the evidence for dependent claim 15 of the ’241 patent and dependent claim 21 of the ’590 patent.

In consideration of the foregoing, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Final Written Decisions (Paper 47; IPR2024-00907, Paper 47) are reversed as to claim 15 of the ’241 patent and claim 21 of the ’590 patent; and

FURTHER ORDERED that Petitioner has not shown unpatentability by a preponderance of the evidence of claim 15 of the ’241 patent and claim 21 of the ’590 patent.

³ The dissenting opinion in each proceeding follows the corresponding Decision and includes its own page numbers. Although the dissenting opinion in each case addresses claim 15 or claim 21 as appropriate only as to certain grounds presented in the Petition, the deficiency the dissenting opinion identifies applies to all asserted grounds because the Petition’s showings for claim 15 or claim 21 are the same for all grounds. *Compare, e.g.,* Petition 45 (claim 15 mapping for Ground 1), *with id.* at 57 (referring back to Ground 1 analysis), 69 (incorporating analysis from Grounds 1–4).

IPR2024-00906 (Patent 11,445,241 B2)

IPR2024-00907 (Patent 10,129,590 C1)

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