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

Inter Partes Review No.: IPR2024-00907

U.S. Patent No. 10,129,590

PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

INDEX OF EXHIBITS

Exhibit No.	Description
1001	Reserved
1002	Declaration of Chuck Creusere
1003	File History of 11,445,241 (17/568,166)
1004	U.S. Pat. No. 10,129,590 (with reexamination certificate)
1005	File History of 10,129,590 (15/208,886)
1006	File History of the Reexamination of 10,129,590 (90/014,651)
1007	Declaration of Nathaniel E Frank-White, records request processor at the Internet Archive, attesting authenticity and public availability of EX1010, EX1014, EX1015, EX1018
1008	US 2006/0258289 ("**Dua**")
1009	US 7,149,508 ("**Herle**")
1010	Nokia N93 User Guide ("**N93**")
1011	US 2006/0128332 ("**Rooyen**")
1012	US 2006/0274704 ("**Desai**")
1013	US 2004/0264600 ("**Kao**")
1014	Bluetooth 2.0 + EDR ("**BT-Spec**")
1015	3GPP TS 36.211 V0.2.1 (2006-11) Technical Specification ("**3GPP-Spec**")
1016	Jan 11, 2024, Infringement Contentions for '241 Patent
1017	RM-55 (Nokia N93) SAR Compliance Test Report
1018	News article published on May 15, 2006, on www.mobiletracker.net
1019	WO 00/48373 ("**Rinne**")
1020	US 2005/0280471 ("**Matsushita**")
1021	US 2007/0116292 ("**Kurita**")
1022	Bluetooth Video Distribution Profile ("**VDP**")
1023	US 2007/0275704 ("**Terai**")
1024	March 7, 2024, Infringement Contentions for the '590 Patent
1025	Plaintiff Maxell, Ltd.'s Opening Claim Construction Brief in 5:23-cv-00092-RWS (without exhibits)
1026	Defendants' Responsive Claim Construction Brief in 5:23-cv-00092-RWS (without exhibits)
1027	Plaintiff Maxell, Ltd.'s Reply Claim Construction Brief in 5:23-cv-00092-RWS (without exhibits)

Exhibit No.	Description
1028	Plaintiff's Claim Construction Presentation in 5:23-cv-00092-RWS
1029	Defendants' Claim Construction Presentation in 5:23-cv-00092-RWS
1030	Claim Construction Hearing Transcript in 5:23-cv-00092-RWS
1031	Court's Preliminary Claim Constructions in 5:23-cv-00092-RWS

Pursuant to the Board's authorization (EX3002), Petitioners file this Reply to address Patent Owner's ("PO's") claim construction arguments in the related litigation, which confirm the challenged claims are unpatentable under Ground 3.

Petitioners suspected that PO might argue the claims encompass the controller selecting (choosing) between radios. Pet., 4. As shown in Ground 3, Dua discloses an "improved" method wherein the user indicates the controller should select between radios. *See, e.g.*, Pet., Ground 1, [1h] (explaining how Dua's CPU 109 controls assignment of the radios), Ground 3, [1h] (incorporating from Ground 1), Ground 3, [1j] (further explaining Dua's "improved" method wherein user indications cause the controller to select between radios).

PO has now explicitly argued in the litigation that the controller, instead of the user, can select the first radio. EX1025, 24-25 (asserting Petitioners' construction precluding controller-based selection is "nonsensical"); EX1027, 5-6 (asserting the construction "contradicts the claim language."). As a result, the Court preliminarily construed limitation [1j] as "plain and ordinary meaning, where the user is not required to select the particular radio." EX1031, 3; EX1030, 1-5. PO agreed with the Court's preliminary construction. EX1030, 70:3-4. Petitioners explained at the hearing, using EX1029, slide 113, how PO's contentions encompass a user indicating the controller should select (choose) between radios. EX1030, 73:3-20. PO then admitted that it contends this limitation

encompasses a user indicating the controller should select between cellular and Wi-Fi radios. EX1030, 79:7-17 (erroneously referring to slide 113 as slide 130).

PO's broad interpretation and the Court's preliminary construction mean the user need not select (choose) the first radio—the user can instead indicate the controller should select between radios. This reads directly on Dua's "improved" user indications, wherein a user indicates the controller should run a program to select between radios. Pet., 61 (user indicates the controller should use the NFC process), 62 (user indicates the controller should use the stored profile process). In each case, it is the controller that selects (chooses) between the radios. *Id.*, 62-63.

While other grounds in the Petition apply a construction that requires the controller assign the radio indicated by the user, *see, e.g.*, Pet., 4; EX1026, 21-22, Ground 3 relies on Dua's "improved" method and establishes unpatentability under PO's interpretation and the Court's preliminary construction. Thus, the Board should institute this IPR under either construction. Finally, given PO's attempt to recapture controller-based selection that was surrendered during prosecution (EX1026, 22-24), public policy favors the Board instituting this IPR to resolve this claim construction issue as part of the intrinsic record of the challenged patent.

Date: October 25, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on October 25, 2024, a true and correct copy of the Petitioners' Reply was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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