

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

**PETITIONERS' MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. §§ 42.123(a)**

I. INTRODUCTION

Pursuant to the Board’s Order on January 27, 2025 (Paper 15), Petitioners respectfully move to submit EX1032-1033 as supplemental information pursuant to 37 C.F.R. § 42.123(a). EX1032-1033 contain information relating to the public accessibility of EX1010 (“N93”), EX1014 (“BT-Spec”), and EX1015 (“3GPP-Spec”). Exhibits 1034-1051 constitute Petitioner’s requests to the Internet Archive and related correspondence. N93, BT-Spec, and 3GPP-Spec are relied on in multiple grounds in this proceeding and are therefore clearly relevant to the claims at issue in this IPR as required by § 42.123(a)(2). Accordingly, Petitioners respectfully request that their motion be granted.

II. BACKGROUND

A. Legal Standard

A party may submit supplemental information under 37 C.F.R. § 42.123(a) if: (1) a “request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted,” and (2) the “supplemental information [is] relevant to a claim for which the trial has been instituted.”

Unlike supplemental information submitted later in trial (§ 42.123(b)) or information not relevant to a claim for which trial was instituted (§ 42.123(c)), a motion under § 42.123(a) need not “show why the supplemental information reasonably could not have been obtained earlier...” *Compare* 37 C.F.R. §

42.123(c) (where a motion to supplement not filed under subpart (a) “must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice”).

Instead, the focus of a motion under subpart (a) of the Rule merely requires the Board to ensure that the proffered supplemental information does not seek to: (i) alter “the grounds of unpatentability authorized in this proceeding”; or (ii) change “the evidence initially presented in the Petition to support those grounds of unpatentability.” *Palo Alto Networks*, IPR2013- 00369, Paper 37 at 3; *see also Biomarin Pharma. Inc., v. Genzyme Therapeutic Prods Limited Partnership*, IPR2013-00534, Paper 80 at 5 (Jan. 7, 2015) (considering the same factors under § 42.123(b)). Conducting such an evaluation, the Board also considers whether granting the motion would prevent the just, speedy, and inexpensive resolution of the proceeding, *Palo Alto*, IPR2013-00369, Paper 37 at 4, or would unfairly prejudice the other party, *Unified Patents Inc., v. Dragon Intellectual Property, LLC*, IPR 2014-01252, Paper 43 at 3 (Apr. 14, 2015). *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, slip op. at 2-5 (PTAB Jan. 17, 2014) (Paper 37), *Hayward Industries, Inc. v. Pentair Water Pool and Spa, Inc.*, IPR2013-00287, slip op. at 2-5 (PTAB Jan. 27, 2014) (Paper 24).

B. This Proceeding

The Board instituted trial in this proceeding on December 11, 2024. Patent Owner's Response to the Petition is due March 26, 2025.

III. ARGUMENT

A. Petitioners' Motion Is Timely and the Supplemental Information Is Relevant as Required by 37 C.F.R. § 42.123(a)

Petitioners timely requested authorization from the Board by e-mail on January 10, 2025, which was within one month of the institution date of December 11, 2024. This motion satisfies the timeliness requirement under § 42.123(a)(1). The Board authorized this motion by order dated January 27, 2025 (Paper 15).

The information Petitioners request to submit into the record is unquestionably "relevant to a claim [at issue in] the trial" as required by § 42.123(a)(2). As explained below, the supplemental exhibits are relevant because they support Petitioners' assertions, do not seek to alter "the grounds of unpatentability authorized in this proceeding," and do not attempt to change "the evidence initially presented in the Petition to support those grounds of unpatentability." Moreover, acceptance of the proffered material will promote the search for truth in this matter and will thus serve to foster a fair and just final adjudication of the issues involved in these proceedings. For the foregoing reasons, Petitioners submit that the supplemental information should properly be permitted under § 42.123(a)(1) and entered into the record.

B. The Public Accessibility of N93, BT-Spec, and 3GPP-Spec are Relevant to the Challenges in This IPR

In its Institution Decision, this Board concluded that “we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in its challenge to claim 1 under 35 U.S.C. § 103 as obvious over the combined teachings of **N93**, Dua, and Herle.” Institution Decision at 66 (discussing Ground 1) (emphasis added). The Board also noted that the same combination met “the recited limitations of claims 4, 5, 8-12, and 14–25, and that a person of ordinary skill in the art at the time of the invention would have combined the references in the manner proffered and would have had a reasonable expectation of success in that endeavor.” *Id.*, at 67. The Board also instituted Petitioner’s other Grounds based on “**N93**, Dua, Herle, Rooyen, Desai, **BTSpec**, **3GPP-Spec**, and Kao (Ground 2), Dua and Herle (Ground 3), Dua, Herle, and **N93** (Ground 4); and Dua, Herle, **N93**, Rooyen, Desai, **BT-Spec**, **3GPP-Spec**, and Kao (Ground 5).” *Id.*, at 67 (emphasis added). As such, the public availability of the N93, BT-Spec, and 3GPP-Spec are therefore clearly relevant to this proceeding.

The Board has already “determine[d] that Petitioner has sufficiently shown the public accessibility of N93, 3GPP-Spec, and BT-Spec for purpose of institution.” *Id.*, at 25. The Board’s determination was based on an Internet Archives declaration that N93, BT-Spec, and 3GPP-Spec were accessible on the Internet before the critical date of the ’590 patent. *See id.*

In its POPR, Patent Owner suggested that a POSITA may have been unable to locate the N93, BT-Spec, and 3GPP-Spec. Petitioner submits the following supplemental information showing that a POSITA, before the critical date, could have located these documents.

EX1032 is an Internet Archive declaration with accompanying exhibits. EX1032 at pages 4-6 establishes a true and accurate copy of the Wikipedia page for the Nokia N93 archived on October 15, 2007. EX1032, 4 (Wikipedia URL), 5-6 (Wikipedia page). The link “Online copy of the N93 Manual (PDF)” under External links (EX1032, 5) is the link to the N93 URL on Nokia’s website. EX1032, 733 (N93 URL), 734-864 (N93). EX1032 also establishes true and accurate copies of Nokia’s web pages, showing links to N93 were accessible by navigating Nokia’s website to the N93 Phone and selecting its user guide, although the last link to the pdf version is no longer operable. EX1032, 38-39 (N93 Phone page with link to “Device Features”), 40-43 (N93 Phone feature page with link to “User Guides”), 44-45 (User Guides page with inoperable link to pdf of N93). EX1032 also includes other documents related to the District Court Litigation (5:23- cv-00092-RWS) which are included to avoid submitting an incomplete declaration. EX1034, ¶ 2.

EX1033 is an Internet Archive declaration establishing true and accurate copies of navigational pages for each of N93, BT-Spec, and 3GPP-Spec. For N93,

EX1033 establishes, same as EX1032, a true and accurate copy of the Wikipedia page for Nokia N93 archived on October 15, 2007 with a link to N93. See EX1033, 4-6. For BT-Spec, EX1033 establishes true and accurate copies of the navigation web pages to reach the BT-Spec from the parent webpage of www.Bluetooth.com. See EX1033, 19-26. For 3GPP-Spec, EX 1033 establishes true of accurate copies of the navigational pages to reach 3GPP-Spec from the parent webpage of www.3gpp.org. See EX1033, 7-18.

The Board may take “judicial notice of the contents of webpages available through the Wayback Machine ‘as facts that can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.’” *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1374 (Fed. Cir. 2021). Petitioners respectfully request that the Board do so here to the extent needed.

All of the relevant publication dates of EX1032-EX1033 are more than one year prior to the earliest claimed priority date of November 28, 2007 priority date of the '590 Patent at issue in this IPR. Thus, EX1032-EX1033 confirm the prior art status of N93, BT-Spec and 3GPP-Spec and are also is relevant to this proceeding.

Entry of EX1032-EX1033 would not impede “the just, speedy, and inexpensive resolution” to this proceeding because they do not change the instituted grounds of unpatentability or alter the initially-presented evidence in the

Petition; *to the contrary*, consideration of such exhibits will indisputably promote the fair, “just, speedy and inexpensive resolution” of these proceedings. 37 C.F.R. §42.1(b).

Moreover, where a party seeks to submit information confirming the public accessibility of a prior art reference at issue in the instituted trial, the Board has repeatedly found such evidence to be proper supplemental information. *Group III Int’l, Inc. v. Targus Int’l LLC*, IPR2021-00371, Paper 34, at 4-6 (September 17, 2021) (*Valeo North America, Inc. v. Magna Electronics, Inc.*, IPR2014-01204, Paper 26 at 4-5 (Apr. 10, 2015); *1964 Ears, LLC v. Jerry Harvey Audio Holdings, LLC*, IPR2017-01084, Paper 17 (Dec. 14, 2017) (Board granting motion to file supplemental information of Internet Archive affidavit to prove publication of reference); *Crestron Electronics, Inc. v. Intuitive Building Controls, Inc.*, IPR2015-01379, Paper 27 at 4-5 (Feb. 2, 2016) (Board granting motion to file supplemental information of Internet Archive affidavit to prove publication of reference for which trial was instituted); *Samsung Electronics Co., Ltd. v. Ibex PT Holdings Co., Ltd.*, IPR2018-00094, Paper 14 at 3-6 (July 24, 2018) (Board granting motion to file supplemental information regarding public availability of references).

Entry of EX1032-EX1033 would not negatively impact “the just, speedy, and inexpensive resolution” of this IPR. PO’s Response is not due until March 26, 2025, such that PO will have almost two months to investigate the additional links

at archive.org and wikipedia in EX1032-EX1033. Thus, PO will have sufficient opportunity to investigate and provide any evidence that PO contends raises a genuine dispute of material fact regarding whether the prior art publications were publicly accessible, including any facts supporting any contention by PO that the links in EX1032-EX1033 would not have led a POSITA to the prior art publications.

IV. CONCLUSION

Petitioners respectfully request that this motion be granted for the reasons discussed above.

Date: January 27, 2025

Respectfully submitted,

/s/ Brian K. Erickson

Brian K. Erickson

Reg. No. 48,895

DLA Piper LLP (US)

303 Colorado Street, Suite 3000

Austin, TX 78701

Phone: 512-457-7059

Fax: 512-721-2263

Brian.Erickson@us.dlapiper.com

Gianni Minutoli

Reg. No. 41198

DLA Piper LLP

One Fountain Square

11911 Freedom Drive, Suite 300

Reston, VA 20190-5602

Phone: + 1 703 773 4000

Fax: + 1 703 773 5000

Gianni.minutoli@us.dlapiper.com

Roshan K. Bhattarai
Reg. No. 70,092
DLA Piper LLP (US)
500 Eighth Street, NW
Washington DC 20004
Phone: 202-799-4418
Fax: +1 202 799 5000
Roshan.Bhattarai@us.dlapiper.com

Attorneys for Petitioners

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned hereby certifies that a copy of the foregoing, Petitioner's Motion to Submit Supplemental Information Pursuant to 37 C.F.R. §42.123(a), was provided to the Patent Owner by emailing a copy of same (by agreement) to the following attorneys of record for the Patent Owner:

rpluta@mayerbrown.com

maxell-samsung-service@mayerbrown.com

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

Saqib J. Siddiqui (ssiddiqui@mayerbrown.com)

Tiffany A. Miller (tmiller@mayerbrown.com)

Date: January 27, 2025

/s/ Brian K. Erickson

Brian K. Erickson

Reg. No. 48,895

DLA Piper LLP (US)

303 Colorado Street, Suite 3000

Austin, TX 78701

Phone: 512-457-7059

Fax: 512-721-2263

Brian.Erickson@us.dlapiper.com

Attorney for Petitioners