

**IN 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: IPR2024-00907

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

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION
PURSUANT TO 37 C.F.R. § 42.123(a)**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
1st Amended Docket Control Order from District Court Litigation	2001
Original Docket Control Order from District Court Litigation	2002
Maxell's Supplemental Preliminary Election of Asserted Claims	2003
Defendants' Preliminary Election of Prior Art	2004
U.S. Patent Publication No. US 2006/0203758 (Tee)	2005
U.S. Patent Publication No. US 2006/0135076 (Honkanen)	2006
Petitioner's invalidity contentions chart in District Court—Tee	2007
Petitioner's invalidity contentions chart in District Court—Honkanen	2008
Declaration of Bruce McNair	2009
L2CAP-Based Prototype Media Streaming via Bluetooth Technology	2010
https://www.nytimes.com/2009/10/19/technology/companies/19nokia.html	2011
https://www.codeproject.com/Articles/9357/Symbian-OS-design-faults	2012
https://www.engadget.com/2010-10-21-nokia-refines-development-strategy-adopts-html5-in-qt-and-ends-s.html	2013
https://www.businessinsider.com/ios-5-over-the-air-updates-2011-7	2014
https://support.apple.com/en-us/102998	2015
Transcript of January 22, 2025 Conference Call With Board	2016

I. INTRODUCTION

On January 10, 2025, Petitioner sought “authorization to file supplemental information for EX1010 (Nokia N93 User Guide), EX1014 (Bluetooth 2.0+EDR), and EX1015 (3GPP TS 36.211 V0.2.1 (2006-11) Technical Specification) in the form of Internet Archive’s declarations.” Paper 15 at 2. The Board held a conference call and later issued an order allowing the request. Paper 15; EX2016 (transcript of conference call). At no time during the call, or in Petitioner’s email, did Petitioner advise the Board or Patent Owner that Petitioner sought to inject **over 1,200 pages of new evidence** into the record. Granting Petitioner’s motion directly and negatively impacts the just, speedy, and inexpensive resolution of this proceeding, and unfairly prejudices Patent Owner by Petitioner’s shifting sands approach to the evidence in this proceeding. *Redline Detection, LLC v. Star Envirotech, Inc., Inc.*, 811 F.3d 435, 445–49 (Fed. Cir. 2015).

Petitioner seeks to change the evidence (and thus the grounds) on which it relies. When the Petition was filed, it included an Internet Archive declaration addressing EXS1010, 1014, and 1015. *See* EX1007. Now, after institution, Petitioner wishes to bolster the deficiencies in the Petition by submitting over 1,200 pages of information that allegedly supports the public accessibility of N93, 3GPP, and BT-Spec. However, the motion offers new theories on where N93, 3GPP-Spec, and BT-Spec may have been accessible and, in the case of N93, new versions of the manual.

Petitioner cannot change its theory of public accessibility any more than it can change the references upon which it relies.

Finally, EXS1031-1032—the new declarations—are not supplemental information. Rather, Petitioner's characterization of EXS1031-1032 as “supplemental information” appears to be designed to address evidentiary objections Patent Owner filed (Paper 13) but to which Petitioner never responded by serving supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2).

Patent Owner respectfully requests that the Board deny Petitioner's motion and expunge Exhibits 1031-1050 from the record.

II. LEGAL STANDARD

The party moving for supplemental information under 37 C.F.R. § 42.123(a) bears the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c); *see Western Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 22 at 7 (PTAB Jul. 23, 2018). The Board may permit a party to file such a motion only if timeliness and relevance requirements are satisfied. 37 C.F.R. § 42.123(a)(1)-(2). But the Board's decision to admit information under § 42.123(a) is discretionary, and § 42.123(a) “does not connote the PTAB must accept supplemental information so long as it is timely and relevant.” *Redline*, 811 F.3d at 445–49. Rather, timeliness and relevance “provide additional requirements that must be construed within the overarching context of the PTAB's regulations governing IPR and general trial

proceedings,” including the Board’s mandate to interpret its rules “to secure the just, speedy, and inexpensive resolution” of the proceeding and to ensures its “integrity.”

Id. at 443, 445-46, 448; 35 U.S.C. § 316(b); 37 C.F.R. §§ 42.100(a), 42.1(b).

Accordingly, the Board may consider whether the supplemental information reasonably could have been obtained earlier, and that § 42.123 “does not offer ‘a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary response.’” *Redline*, 811 F.3d at 444-45, 448. It may also consider whether the supplemental information changes the evidence originally relied on in the petition, *American Well Corp. v. Teladoc Health, Inc.*, IPR2021-00748, Paper 23 at 13 (PTAB Feb. 28, 2022) (citing 35 U.S.C. § 312(a)(3)), or presents a new argument not presented in the petition, *Western Digital*, IPR2018-00082, Paper 22 at 10.

III. ARGUMENT

The Petition represents Petitioner’s case-in-chief, and, under the Board’s rules, Petitioner’s ability to supplement that case after institution is necessarily limited. 37 C.F.R. § 42.123; *see also Redline* 811 F.3d at 445 (“The guiding principle for the PTAB in making any determination is to ‘ensure efficient administration of the Office and the ability of the Office to complete IPR proceedings in a timely manner.’ Requiring admission of supplemental information so long as it was timely submitted and relevant to the IPR proceeding would cut against this mandate and

alter the intended purpose of IPR proceedings.”).

A. Petitioner's Proposed New Information Prevents The Just, Speedy, and Inexpensive Resolution Of This Proceeding

Petitioner's attempt to add over 1,200 of pages of new information into this proceeding to bolster the deficiencies in its Petition should be rejected. All of the information it seeks to add was available when it filed its Petition. While Petitioner attempts to justify the delay (*see* EXS1033-1050), a tardy declaration from Internet Archive did not prevent Petitioner from presenting this evidence with its Petition—its case-in-chief. Allowing Petitioner to submit supplemental information that it withheld or elected not to obtain and submit with the Petition—which could have been addressed in Patent Owner's Preliminary Response—also offends basic notions of due process and fairness. *See Royal Brush Mfg. v. United States*, 75 F.4th 1250, 1257-58 (Fed. Cir. 2023) (“[T]he law is clear that, in adjudicative administrative proceedings, due process includes the right to know what evidence is being used against one.” (cleaned up)). Granting Petitioner's motion also directly and negatively impacts the just, speedy, and inexpensive resolution of this proceeding, and unfairly prejudices Patent Owner by Petitioner's “wait and see” approach to evidence, forcing Patent Owner to address this evidence—which is of dubious relevance—in its Patent Owner Response. *Redline Detection*, 811 F.3d at 445–49. Petitioner's

case-in-chief should not be a moving target throughout the proceedings and the Board should deny Petitioner's motion on this basis alone.

B. Proposed Exhibits 1031-1032 Change the Grounds Of Unpatentability and Supporting Evidence

Consistent with the guidelines affirmed in *Redline*, the Board does not permit supplemental information where it changes the petitioned grounds or the evidence initially presented in the petition in support of those grounds. *Am. Well Corp.*, IPR2021-00748, Paper 23 at 5-7 (citing *Redline*, 811 F.3d at 445-47; collecting cases). Petitioner's supplemental evidence does just that, so it should be rejected. *See also Duration Media LLC v. Rich Media Club LLC*, IPR2023-00953, Paper 21 at 3-6 (PTAB Oct. 12, 2023) (rejecting Petitioner's supplemental evidence because allowing it "would cut against the just, speedy, and inexpensive resolution of the proceeding" given that the supplemental information "clearly was available to Petitioners before it filed its Petition" and because "it is not clear how Petitioner intends to rely on the supplemental information.")

Petitioner obscures its intended use of the supplemental information by broad reference to over 1,200 pages of new information embedded in two declarations, stating "EX1031-1032 contain information related to the public accessibility of EX1010 ('N93'), EX1014 ('BT-Spec'), and EX1015 ('3GPP-Spec')." But it is clear that Petitioners are intending to change their theories with respect to the public

accessibility of these references from the ones presented in the Petition and instituted on by the Board.

With respect to EX1010, Petitioner moves away from its original theory that N93 was available on Nokia's web site, and now offers evidence purportedly showing other ways a POSITA would have had access to the manual prior to the critical date. For example, Petitioner offers a Wikipedia page that allegedly further links to information about N93. But this information changes Petitioner's theory of unpatentability respecting N93. While none of this further information sheds light on the deficiencies of EX1010, it includes information such as reviews, data sheets, and commentaries about the *N93 product* that seeks to replace the deficient evidence of public *accessibility* with new evidence relying on purported *dissemination* of the N93 product. *See, e.g.*, EX1031 at 7-63; 178-179; 1271-1272; EX1032 at 4-6.

Additionally, at page 733 of Exhibit 1031, Petitioner includes what appears to be the same N93 user manual and link that was already presented in the Petition. At page 866, a new version of the N93 user manual is presented. At pages 997-1270, two other versions of the N93 manual are presented (one in English and one in Spanish). Yet, according to the Internet Archive declaration (EX1031), these latter two manuals are **from a link dated September 20, 2014**, well after the priority date of the Patent.

With respect to EXS1014 and EX1015, Petitioner again attempts to bolster the deficiencies in the petition by providing various links that purportedly would have provided public access to the two specifications. But this evidence clearly was available to Petitioner when the Petition was filed, and still sheds no light on the public accessibility of EXS1014 and 1015. Regarding BT-Spec, Petitioner presents archived links to the Bluetooth web site, *but not to BT-Spec* utilized in the Petition. As the declaration (EX1032 at 1) itself concedes (emphasis added):

The date indicated by an extended URL applies to a preserved instance of a file for **a given URL, but not necessarily to any other files linked therein**. Thus, in the case of a page constituted by a primary HTML file **and other separate files** (e.g., files with images, audio, multimedia, design elements, or **other embedded content**) linked within that primary HTML file, the primary HTML file and the **other files** will each have their own respective extended URLs and **may not have been archived on the same dates**.

Regarding 3GPP-Spec, Petitioner offers the notoriously difficult-to-navigate 3GPP.org web site. EX1032 at 7-18. Nowhere in the provided information is there any reference to 3GPP TS 36.211 v0.2.1 (EX1015). Petitioner cannot show public accessibility here based on an ftp file server that was not indexed or searchable in any meaningful way. *See Acceleration Bay, LLC v. Activision Blizzard inc.*, 908 F.3d 765, at 773 (Fed. Cir. 2018) (“Substantial evidence supports [the Board’s] findings that Lin was not publicly accessible, including that Lin was not indexed in a

meaningful way and that the website's advanced search form was deficient."). Moreover, for 3GPP-Spec, Petitioner further fails to provide evidence of public accessibility because it relies on a different document than the one purportedly authenticated through the Affidavit served with the Petition. *Compare, e.g.,* EX1007 at 165 *with* EX1015 at 1.

Supplemental information under 37 C.F.R. § 42.123 "is not intended to provide a petitioner an advantageous 'wait-and-see' opportunity to use a patent owner's preliminary response and our decision on institution in order to refine or bolster petitioner's positions." *Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14, 3-4 (PTAB Jan. 23, 2018). Nor can it be used to establish prior art availability when, as here, "the requested supplemental information is *necessary* to potentially remedy an identified deficiency in the ground as provided in the Petition." *Artesian Home Prods. v. Gutterglove, Inc.*, IPR2018-00031, Paper 24, 3 (PTAB May 31, 2018); *see also First Solar, Inc. v. Rovshan Sade*, IPR2023-00881, Paper 13 at 19 (PTAB Nov. 16, 2023).

C. Proposed Exhibits 1031-1032 Are Not Supplemental Information

In addition to the reasons above, the Board should deny Petitioner's motion as to proposed Exhibits 1031 and 1032 for another reason: they are not supplemental information under 37 C.F.R. §42.123(a). Petitioner, as the moving party seeking to submit supplemental information under 37 C.F.R. § 42.123(a), bears the burden of

proof to establish that proposed Exhibits 1031-1032 are supplemental information, rather than supplemental evidence. 37 C.F.R. § 42.20(c). The Board has previously explained the difference between supplemental evidence under 37 C.F.R. § 42.64(b)(2) and supplemental information under 37 C.F.R. § 42.123(a):

[S]upplemental *evidence*—served in response to an evidentiary objection and filed in response to a motion to exclude—is offered solely to support admissibility of the originally filed evidence and to defeat a motion to exclude that evidence, and not to support any argument on the merits (i.e., regarding the patentability or unpatentability of a claim). Supplemental *information*, on the other hand, is evidence a party intends to support an argument on the merits.

ServiceNow, Inc. v. BMC Software, Inc., IPR2015-01176, Paper 15 at 3 (PTAB Dec. 29, 2015) (quoting *Handi Quilter, Inc. v. Bernina Int'l AG*, IPR2013-00364, Paper 30 at 2– 3 (PTAB Jun. 12, 2014) (emphasis in original).

Petitioner failed to meet its burden to establish that proposed Exhibits 1031 and 1032 are supplemental information, rather than supplemental evidence. Petitioner does not intend to use proposed Exhibits 1031 and 1032 to support an argument on the merits. In the motion, Petitioner characterizes proposed Exhibit 1031 as “an Internet Archive declaration with accompanying exhibits.” Paper 16 at 5. Petitioner characterizes proposed Exhibit 1032 as “an Internet Archive declaration establishing true and accurate copies of navigational pages for each of N93, BT-

Spec, and 3GPP-Spec.” *Id.* It is clear Petitioner is attempting to cure its failure to timely provide supplemental *evidence* in response to Patent Owner's evidentiary objections to Exhibits 1010, 1014, and 1015 (Paper 13, at 4-6) by cloaking proposed Exhibits 1031-1032 as supplemental information.

Patent Owner's objections to the admissibility of EXS1010, 1014, and 1015 were based on, among other things, hearsay and authenticity. *Id.* Petitioner never served supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2) within ten business days of service of the objections. The Board appeared to appreciate this distinction during the conference call preceding Petitioner's motion. EX2016 at 7:1-17.

Because proposed Exhibits 1031 and 1032 are not supplemental information but rather supplemental evidence, the Board should deny Petitioner's motion as to these exhibits and their various attachments. *ServiceNow, Inc.*, IPR2015-01176, Paper 15 at 3 (denying authorization for motion to submit supplemental evidence where petitioner sought to submit additional evidence asserted to remove any alleged evidentiary defect regarding prior art status, on the ground that the identified evidence was more properly considered supplemental evidence under 37 C.F.R. § 42.64(b)(2)).

IV. CONCLUSION

Patent Owner respectfully requests that the Board deny Petitioner's motion.

Patent No. 10,129,590

Patent Owner's Opposition to Motion for Supplemental Information

Dated: February 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of February, 2025, a copy of the attached PATENT OWNER'S OPPOSITION TO MOTION TO SUBMIT SUPPLEMENTAL INFORMATION, was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: February 5, 2025

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