

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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 C1¹

Before KEVIN C. TROCK, JOHN A. HUDALLA, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

ORDER
Granting Motion to Submit Supplemental Information
37 C.F.R. § 42.123

¹ This Order applies to Petitioner's Motions (Paper 16) filed in IPR2024-00906 and IPR2024-00907. Substantially similar briefs were filed in both cases. Citations are to the briefs filed in IPR2024-00906. The parties are not authorized to use this caption.

I. Introduction

We instituted *inter partes* review on December 11, 2024. Paper 11. On January 10, 2025, Petitioner by email requested authorization to file a motion to submit supplemental information for Exhibit 1010 (Nokia N93 User Guide), Exhibit 1014 (Bluetooth 2.0+EDR), and Exhibit 1015 (3GPP TS 36.211 V0.2.1 (2006-11) Technical Specification) in the form of Internet Archive declarations. On January 27, 2025, we issued an Order granting Petitioner's request. Paper 15. Petitioner thereafter filed its Motion to Submit Supplemental Information. Paper 16 ("Motion" or "Mot."). Patent Owner filed an Opposition. Paper 17 ("Opposition" or "Opp."). Petitioner filed a Reply. Paper 18 ("Reply"). After consideration of the parties' briefing and arguments on this issue, Petitioner's Motion to Submit Supplemental Information is *granted*.

II. Discussion

Petitioner's Motion seeks to submit Exhibits 1031 and 1032 as supplemental information. Mot. 1. According to Petitioner, Exhibits 1031 and 1032 "contain information relating to the public accessibility of Ex. 1010 ("N93"), Ex. 1014 ("BT-Spec"), and Ex. 1015 ("3GPPSpec")." *Id.* With respect to Exhibit 1031, Petitioner explains that

EX1031 is an Internet Archive declaration with accompanying exhibits. EX1031 at pages 4-6 establishes a true and accurate copy of the Wikipedia page for the Nokia N93 archived on October 15, 2007. EX1031, 4 (Wikipedia URL), 5-6 (Wikipedia page). The link "Online copy of the N93 Manual (PDF)" under External links (EX1031, 5) is the link to the N93 URL on Nokia's website. EX1031, 733 (N93 URL), 734-864 (N93).

Mot. 5.

With respect to Exhibit 1032, Petitioner explains that

EX1032 is an Internet Archive declaration establishing true and accurate copies of navigational pages for each of N93, BT-Spec, and 3GPP-Spec. For N93, EX1032 establishes, same as EX1031, a true and accurate copy of the Wikipedia page for Nokia N93 archived on October 15, 2007 with a link to N93. *See* EX1032, 4-6. For BT-Spec, EX1032 establishes true and accurate copies of the navigation web pages to reach the BT-Spec from the parent webpage of www.Bluetooth.com. *See* EX1032, 19-26. For 3GPP-Spec, EX 1032 establishes true of accurate copies of the navigational pages to reach 3GPP-Spec from the parent webpage of www.3gpp.org. *See* EX1032, 7-18.

Mot. 5–6.

The governing rule for a motion to submit supplemental information is 37 C.F.R. § 42.123, which reads as follows:

§ 42.123 Filing of supplemental information

(a) Motion to submit supplemental information. Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

(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;

(2) The supplemental information must be relevant to a claim for which the trial has been instituted.

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interest-of-justice.

(c) Other supplemental information. A party seeking to submit supplemental information not relevant to a claim for which

the trial has been instituted must request authorization to file a motion to submit the information. The motion must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interest-of-justice.

37 C.F.R. § 42.123.

Petitioner's Motion seeks to file supplemental information under 37 C.F.R. § 42.123(a). Mot. 1. Petitioner sought authorization to file the motion within one month from the issuance of the Institution Decision, and Patent Owner does not challenge Petitioner's timeliness. Patent Owner, however, raises several other objections to Petitioner's Motion, which we discuss in further detail below.

Patent Owner first argues that "[a]ll of the information [Petitioner] seeks to add was available when it filed its Petition," and that Petitioner's proposed new information "negatively impacts the just, speedy, and inexpensive resolution of this proceeding, and unfairly prejudices Patent Owner." Opp. 4.

Petitioner, however, points out that "[i]n 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." Mot. 5.

As noted by Petitioner, Patent Owner previously challenged Petitioner's showing of public accessibility of these documents, arguing in its Preliminary Response that "Petitioner provides no evidence that N93, BT-Spec, or 3GPP-Spec were disseminated to the interested public before the critical date," and with respect to Petitioner's N93 evidence, argued that the Petition offered "no evidence that this URL was available for more than

a moment in time to be able to [be] searched and found by a [person of ordinary skill in the art].” Prelim. Resp. 21. Patent Owner continued, arguing that “the Petition fails to offer any evidence or argument that the N93, BT-Spec, and 3GPP-Spec webpages were indexed through search engines or otherwise and thus locatable by a search engine.” *Id.* at 21–22.

In the Institution Decision, we determined that Petitioner’s declarant provides credible testimonial evidence explaining that the Internet Archive’s Wayback Machine has records showing that Nokia’s N93 User Guide (N93) was accessible on the Internet as of April 23, 2007, 3GPP TS 36.211 V0.2.1 (3GPP-Spec) was accessible on the Internet as of January 7, 2007, and the Specification of the Bluetooth System (BTSpec) was accessible on the Internet as of February 24, 2006.

Paper 11, 27. We concluded that “[b]ecause all of these dates precede the critical date of the ’241 patent (November 28, 2007), *based on this preliminary record* we determine that Petitioner has sufficiently shown the public accessibility of N93, 3GPPSpec, and BT-Spec for purpose of institution.” *Id.*

Faced with Patent Owner’s challenge to Petitioner’s public accessibility evidence proffered in the Petition, Petitioner now seeks to supplement that information through its Motion. We find Petitioner’s use of the supplemental information process to be an appropriate and justified response to Patent Owner’s previous arguments regarding public accessibility. We also do not agree with Patent Owner that Petitioner’s proposed supplemental information would negatively impact the just, speedy, inexpensive resolution of this proceeding given that Patent Owner has had ample opportunity to respond to the supplemental information without altering the course of trial.

Patent Owner next argues that Petitioner's reliance on proposed Exhibits 1031 and 1032 "change[s] the grounds of unpatentability." Opp. 5. Patent Owner asserts 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." *Id.* at 5–6. Patent Owner argues that "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." *Id.* at 6.

Petitioner responds, asserting that "Petitioners do not 'move away' from any theory regarding N93 as asserted by [Patent Owner]." Reply 2 (citing Opp. 6). Petitioner reiterates that "N93 was available at the Nokia's website nokia.com at the relevant time." Reply 2 (citing Ex. 1007, 2). According to Petitioner,

EX1031-EX1032 show how a POSITA would have been able to find this document at the relevant time. For example, EX1031 at 4-6 includes a true and accurate copy of the Wikipedia page for the Nokia N93 product archived on October 15, 2007. EX1031, 4 (Wikipedia URL), 5-6 (Wikipedia page). The link "Online copy of the N93 Manual (PDF)" under External links (EX1031, 5) is the link to N93 at the URL on the nokia.com website. EX1031, 733. EX1031 also includes true and accurate copies of other pages of Nokia's website, confirming a POSITA could have found N93 from within that website as well, although the last link to the pdf of N93 is no longer operable. EX1031, 38-39.

Reply 3.

We agree with Petitioner. Petitioner's proposed supplemental information does not appear to change Petitioner's theory or grounds of

unpatentability, but rather, appears to support Petitioner’s theory in view of Patent Owner’s challenges to Petitioner’s evidence.

Finally, Patent Owner argues that Petitioner’s proposed Exhibits 1031 and 1031 are not supplemental information, but rather, supplemental evidence under 37 C.F.R. § 42.20(c). Opp. 8–10. Patent Owner provides the distinction between the two as follows:

[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.

Opp. 9 (citing *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))).

Patent Owner argues that “Petitioner does not intend to use proposed Exhibits 1031 and 1032 to support an argument on the merits.” *Id.* Patent Owner argues that “[i]t 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.” Opp. 10.

Petitioner responds by pointing out that Patent Owner “fails to explain how EX1031-EX1032 could be responsive to PO’s hearsay and authenticity objections” to Exhibits 1010, 1014, and 1015 as Patent Owner argues.

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Reply 5. Petitioner reiterates that Exhibits 1031 and 1032 “are being used to support the previously made arguments in the Petition.” *Id.*

We agree with Petitioner. On its face, Petitioner proposed use of Exhibits 1031 and 1032 is to support its argument on the merits, which is challenged by Patent Owner, that N93, BT-Spec, and 3GPP-Spec were all accessible on the Internet prior to the critical date of the '241 patent.

III. Order

Accordingly, it is

ORDERED that Petitioner’s Motions to Submit Supplemental Information (Paper 16) filed in IPR2024-00906 and IPR2024-00907 are *granted*.

FOR PETITIONER:

Brian Erickson
Gianni Minutoli
Roshan Bhattarai
DLA PIPER LLP (US)
brian.erickson@us.dlapiper.com
Gianni.Minutoli@us.dlapiper.com
Roshan.bhattarai@us.dlapiper.com
dla-samsung-maxell@us.dlapiper.com

FOR PATENT OWNER:

Robert Pluta
Amanda Bonner
Saqib Siddiqui
MAYER BROWN LLP
rpluta@mayerbrown.com
astreff@mayerbrown.com
ssiddiqui@mayerbrown.com