

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

**OPPOSITION TO PATENT OWNER'S
MOTION TO SUBMIT SUPPLEMENTAL INFORMATION (Paper 37)**

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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 ”)
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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 ”)
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1021	US 2007/0116292 (“ Kurita ”)
1022	Bluetooth Video Distribution Profile (“ VDP ”)
1023	US 2007/0275704 (“ Terai ”)
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1072	N93 Wikipedia page (August 18, 2007)
1073	Scheiter, C. et al., (2003) A System for QoS-Enabled MPEG-4 Video Transmission Over Bluetooth For Mobile Applications, Multimedia and Exp, 2003 ICME '03, Proceedings, Washington DC, pp. 789-792
1074	Razavi, et al., (2006) Efficient Packetization for Bluetooth Video Transmission, Electronic Letters, Vol. 42, No. 20, pp. 1143-1145
1075	U.S. Pat. No. 8,514,832
1076	The N93 User Manual slide
1077	Excerpt from Samsung's Opposition to Plaintiff's Motion for Partial Summary Judgment of Validity Based on Samsung's <i>Sotera</i> Stipulations (5:23-cv-00092-RWS (E.D. Tex.), Dkt. 191)

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1078	Samsung's Surreply in Opposition to Maxell's Motion for Partial Summary Judgment of Validity Based on Samsung's <i>Sotera</i> Stipulation (5:23-cv-00092-RWS (E.D. Tex.), Dkt. 221)
1079	Email from Robert Pluta to the Board, dated June 5, 2025
1080	Email from Robert Pluta to Brian Erickson, et al., regarding Samsung/Maxell IPRs—draft email to Board, dated September 8, 2025
1081	Email from Brian Erickson to Robert Pluta, et al., regarding Samsung/Maxell IPRs—draft email to Board, dated September 8, 2025

I. INTRODUCTION

Patent Owner's ("PO's") motion to submit attorney argument in a transcript (EX2037) and brief (EX2038) should be denied as waived and untimely because PO had Petitioners' arguments in January and February, prior to filing its Patent Owner Response in March. PO's motion should also be denied because Petitioners' arguments in EX2037-EX2038 and this IPR are entirely consistent.

II. ARGUMENT

A. PO's Motion Should be Denied as Waived and Untimely

1. PO's Argument as to EX2037 was Waived and is Untimely

Petitioners' attorney argument in EX2037 was set forth in Petitioners' opposition to PO's *Sotera* summary judgment motion (EX1077), filed on February 4, 2025, and Petitioners' Sur-Reply (EX1078), filed on February 18, 2025. Petitioners' opposition explained why the N93 product was a better reference than the cited passage in the N93 User Manual, which lacks the word "video." EX1077, 17-19. Petitioners' Sur-Reply also explained that the N93 product was a better reference because it actually updated its operating system, precluding the argument PO asserts in this IPR that such updates were impossible. EX1078, 8-9.

PO should have raised any argument regarding that information in its Patent Owner Response filed on March 26, 2025. PO failed to do so, waiving any such argument. Paper 13 (Scheduling Order) at 9 ("Patent Owner is cautioned that any

arguments not raised in the response may be deemed waived.”); *see also, e.g., Snap Inc. v. Sanderling Management Ltd.*, IPR2021-00779, Paper 38, at 31 and 36 n.10 (P.T.A.B. October 31, 2022) (finding waiver of claim construction and other arguments not made in patent owner response because petitioner was deprived of opportunity to address them in reply brief and declaration); *In re Nuvasive, Inc.*, 842 F.3d 1376, 1380 n.4 (Fed. Cir. 2016) (holding that waiver at PTAB precludes consideration on appeal). PO's motion should also be denied as untimely under 35 C.F.R. § 42.123(b) since PO obtained this information long before its request.

2. PO's Argument as to EX2038 Was Waived and is Untimely

PO incorrectly represents to the Board in its motion that PO could not have submitted the information in EX2038 earlier, when PO was aware of the underlying information in January and February 2025. EX2038, filed May 8, 2025, is an opposition to a motion for reconsideration which, by definition, is based on information in previous filings. For example, the Statement of Undisputed Material Facts in EX2038 is from Petitioners' original motion filed on January 14, 2025 and relies on paragraphs in Dr. Buehrer's noninfringement expert report from 2024. EX2038, 6-7. The information was also in Petitioners' Sur-Reply filed on February 18, 2025. There is no new information in the May 8, 2025 filing, nor could there be, because it is an opposition to a motion for reconsideration related to a motion filed in January. If PO thought those arguments were relevant, PO should have

raised them in its Patent Owner Response filed on March 26, 2025. PO failed to do so, waiving any such argument. Paper 13 (Scheduling Order) at 9; *Snap Inc.*, IPR2021-00779, Paper 38, at 31 and 36 n.10; *In re Nuvasive, Inc.*, 842 F.3d at 1380 n.4. PO's motion should also be denied as untimely under 35 C.F.R. § 42.123(b) since PO obtained this information long before its request.

B. PO's Motion Should be Denied as to EX2038 Because it Exceeds the Scope of PO's Request and the Board's Order

EX2038 is a brief, not a public record transcript and, therefore, is beyond the scope of PO's request and the Board authorization under 37 C.F.R. § 42.123(b). On June 5, 2025, PO requested leave to submit the April 24, 2025 public record hearing transcript in this IPR and other trial transcripts in other IPRs. EX1079, 1. On September 10, 2025, the Board authorized PO to file a motion to submit "public record transcripts" in this IPR. Paper 36, 2. The Board did not authorize PO to submit any other information. The Board also ordered the parties to meet and confer to determine whether Protective Orders would be required for any of PO's submissions or Petitioners' responses. On September 8, 2025, PO emailed Petitioners and stated it might submit EX2038 and two other briefs. EX1080, 1. Petitioners promptly responded that submitting anything more than the authorized public transcripts would require a new authorization from the Board and that Petitioners would likely need a protective order for its response. EX1081, 1. PO

never responded to that email. Instead, PO represented to the Board that a protective order was needed only in IPRs 2024-00735 and 2024-00777. Thus, Petitioners understood that PO would not submit anything other than the authorized transcript, and Petitioners lack the protective order necessary to provide the Board responsive information, such as the expert reports from 2024 on which EX2038 is based and which provided PO the underlying information long ago.

C. Petitioners' Arguments Are Entirely Consistent

PO's motion should be denied because Petitioners' arguments in EX2037 and EX2038 are entirely consistent with the evidence in this IPR and, therefore, the interests of justice do not require their submission under 37 C.F.R. § 42.123(b).

1. Petitioners' Argument in EX2037 is Consistent

Petitioners' attorney argument in EX2037 regarding the disclosures in the N93 User Manual (EX1010) relative to the N93 product are entirely consistent with the evidence in this IPR. PO filed a motion for summary judgment that Petitioners' *Sotera* stipulation precluded Petitioners from presenting the N93 product at trial because PO asserted the N93 product was materially identical to the N93 User Manual (EX1010). Petitioners argued PO failed to meet its burden on summary judgment because the evidence PO cited failed to establish as a matter of law that the N93 product was materially identical to the N93 User Manual.

a. Limitation [1k] - "Video" and Internet

In this IPR, one of the teachings in the N93 User Manual relied on by Petitioners is a teaching that the N93 can serve as an Internet modem for a PC, such that the N93's Bluetooth radio (the PC's connection to the N93) and the N93's 2G (GSM) radio or the N93's 3G (UMTS) radio (the N93's connection to the Internet) would be used simultaneously for all types of Internet data. Pet., 36 (discussing Internet modem functionality at EX1010, 83). The description of this Internet modem functionality on the left side of page 83 does not explicitly use the word "video," which is understandable, as it would be odd to list examples of types of informational content on the Internet. EX1010, 83 (left side discussing Internet modem functionality). The Petition relies on additional teachings in the N93 User Manual not cited by PO in its *Sotera* motion to conclude that a POSITA would have understood N93 discloses simultaneous Bluetooth video transfers and data packet connections." Pet., 36. The Petition also relies on the combination of the N93 User Manual with Dua. Pet., 12-14, 36-38. Regardless, for purposes of PO's current motion, it is undisputed in this IPR and in the litigation that the passage in the N93 User Manual about Internet modem functionality on the left side of page 83 does not explicitly use the word "video."

PO argued at the April 2025 hearing that the N93 User Manual's discussion of modem functionality on page 83 satisfied PO's burden for its *Sotera* summary

judgment motion to show that the N93 User Manual was a materially identical reference relative to the N93 product.

Simultaneous

Some Challenged Claims require video transmissions/receipt over one radio and a "simultaneous" connection of a second radio to an internet or home network. N93 teaches simultaneous data packet connections over its UMTS and GSM radios on the one hand, and its WiFi and Bluetooth radios on the other. For example, N93 teaches the phone can be used as a modem for a PC to connect it to the Internet by simultaneously using a Bluetooth connection to the PC and a UMTS or GSM connection to the Internet. EX1010, 83. N93 explicitly teaches there can be a UMTS or GSM data packet connection and a simultaneous Wi-Fi connection. Id.,

EX1076, 1 (PO's hearing slide 27) (emphasis in original).

Petitioners' counsel correctly responded at the hearing that the evidence cited by PO on Slide 27 did not explicitly use the word "video."

Now if we look at the evidence that counsel pointed to for this claim limitation, which is on Slide 27, the one thing I will ask you to note, Your Honor, if you look back at it after the hearing is you will not see the word "video" in that paragraph at all because there is no evidence that's cited here with respect to the use of the video. It's talking about the N93 teaching simultaneous data packet connections, but what's being referenced here doesn't show video. They haven't cited anything in the user manual that says that you could transmit video at the same time as connecting to the Internet. It's just not there.

EX2037, 27:22-28:10. PO also points to Petitioners' argument at 27:13-17, but it must be noted that, again, Petitioners prefaced that statement with "I'd like to address what counsel said about those two points." EX2037, 22:8-9. Regardless, it

is undisputed in the litigation and this IPR that the word "video" is not used in the passage of the N93 User Manual at issue in PO's *Sotera* motion.

In the litigation, Petitioners had additional evidence that showed the N93 products actually transmitting and receiving video over their Bluetooth radios while simultaneously connecting to the Internet over their 2G (GSM) radio and their 3G (UMTS) radio to run searches on Google.com. EX1077, 17-19 (images of simultaneous Bluetooth video transfers and Google searches with oscilloscopes showing radios working simultaneously).

Thus, the N93 product was not materially identical to the evidence cited by PO in its *Sotera* motion related to the N93 User Manual. In the litigation, because of the testing results, PO could not argue that a POSITA would not have known that the Internet included "video." In any event, this attorney argument that "video" is not used in this passage is not inconsistent with anything in the Petition, which discusses what a POSITA "would have known" based on a plurality of teachings in the N93 User Manual. Pet., 36. And PO's attack on the N93 User Manual individually is not relevant to the combined teachings of the N93 User Manual and Dua set forth in the Petition. Pet., 12-14, 37-38.

b. Limitation [11] - Updating the Operating System

In this IPR, Petitioners show that the N93 User Manual teaches updating software and explicitly mentions updating "applications." Pet., 15-16. Petitioners

do not assert in this IPR that the N93 User Manual explicitly mentions updating the “operating system.” *Id.* Therefore, the Petition combines the teachings of the N93 User Manual with Herle, which also teaches updating software, including an express teaching of updating an operating system, on smartphones like the N93. *Id.*, 16-17, 38-40. Petitioners' argument at the hearing tracks Petitioners' IPR arguments precisely. EX2037, 29:1-6.

PO in this IPR improperly attacks the combination of the teachings of the N93 User Manual and Herle by asserting the N93 product could not be modified to update its operating system because, e.g., the N93 product was “closed” and “unstable.” POR, 35-43. In its current motion, PO again incorrectly attacks the N93 product as having “memory, regulatory, and security” constraints that would preclude updating its operating system. Mot., 8.

PO's argument is legally inapposite because it attacks the N93 product instead of the combination of the teachings of the N93 User Manual and Herle, but it is also factually incorrect. Reply, 14-17. Petitioners in the litigation showed that the N93 product in fact did update its operating system. EX2037, 28:23-25 (“the product itself...shows you can download the operating system.”), 29:15-17 (“the N93 itself to show the downloading of the operating system”). That is why Petitioners asserted the N93 product as anticipatory in the litigation but asserts the combination of the N93 User Manual with Herle in this IPR. And that is why PO

could not present the false narrative to the jury in the litigation, like PO attempts to do here to the Board, that there was something wrong with the N93 product that would preclude updating its operating system.

2. Petitioners' Argument in EX2038 is Consistent

Petitioners' attorney argument in EX2038 regarding the Bluetooth user indications in Samsung's S22 device is entirely consistent with the showing in this IPR that this limitation is satisfied by the Bluetooth indications in the prior art. Thus, PO's motion should be denied under 37 C.F.R. § 42.123(b).

In this IPR, for the Dua and N93 User Manual (circa 2005-2006), Petitioners show that when a user indicates Bluetooth should be used to transmit a video, the controller assigns the Bluetooth radio to transmit that video. Pet., 33-35. PO does not argue that if the user indicates "Bluetooth" in Dua or N93 that the controller will run a program to choose between the Bluetooth and Wi-Fi protocols. POR, 23-25 (for 1[j], only contesting user indications related to the UMTS and GSM cellular radios and not contesting user indications related to the Bluetooth radio); Sur-Reply at 11-12 (only discussing indications for GSM/UMTS).

In contrast, Samsung's S22 products (circa 2022) operate differently. In the S22, when a user indicates "Bluetooth" for file share, the controller waits until after it receives the "Accept" message from the receiving device to decide whether to assign the Bluetooth protocol or the Wi-Fi protocol to transmit the video.

EX2038, 6 (UMF7). If the "Accept" message indicates the receiving device supports the Wi-Fi protocol, the controller will assign the higher-speed Wi-Fi protocol to transmit the video. *Id.* The Court correctly found this functionality of the S22 was undisputed because PO only argued that when the user indicated "Bluetooth," the S22 would turn Bluetooth on. *Id.*, 7 (UMF7: "the Bluetooth circuit is turned on when the user indicate[sic] to 'share' via Bluetooth"). PO's expert admitted that sometimes the Wi-Fi protocol would be used instead of the Bluetooth protocol and that he did not consider the relevant evidence of the S22, like source code, that showed how the controller decided which protocol to assign. *Id.*, 13-14.

There is no basis for PO's sweeping statement in its motion that the claim is "not met by Bluetooth video sharing functionality." Mot., 1. PO does not contend in this IPR that the prior art might assign a different radio like Samsung's S22.

III. CONCLUSION

PO's Motion should be denied in its entirety for the reasons discussed above.

Date: September 22, 2025

Respectfully submitted,

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Petitioners' Opp. to PO's Motion to Submit Supplemental Information

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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, Petitioners' Opposition to Patent Owner's Motion to Submit Supplemental Information Pursuant to 37 C.F.R. §42.123(b), was provided to the Patent Owner by emailing a copy of same (by agreement) to the following attorneys of record and email addresses for the Patent Owner:

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