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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD., Plaintiff, v. SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	Civil Action No. 5:23-cv-00092-RWS **JURY TRIAL DEMANDED** [redacted]

SAMSUNG'S OPPOSITION TO PLAINTIFF MAXELL'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF VALIDITY BASED ON SAMSUNG'S *SOTERA* STIPULATIONS

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EXHIBITS[1]

Ex.	Description
A	Excerpts from the N93 Service Manual (produced as SAM-MAX-00351033)
B	Excerpts from the Deposition Transcript of Jose Garcia (dated Oct. 9, 2024)
C	Excerpts from the Opening Expert Report of Dr. Buehrer (dated Nov. 5, 2024)
D	Excerpts from the Deposition Transcript of Bruce McNair (dated Dec. 18, 2024)
E	Galaxy SIII Service Manual (produced as SAM-MAX-00190812)
F	Excerpts from the Opening Report of Michael Guidash (dated Nov. 5, 2024)
G	Excerpts from the ’815 Patent Opening Report of Dr. Omid Kia (dated Nov. 5, 2024)

[1] All references to “Ex. (ABC, etc.)” refer to exhibits attached to this Opposition. All references to “Ex. (123, etc.) refer to exhibits attached to Plaintiff Maxell’s Motion for Partial Summary Judgment of Validity Based on Samsung’s *Sotera* Stipulations (Doc. No. 132).

[redacted]

I. INTRODUCTION

Maxell's motion for partial summary judgment of validity based upon Samsung's *Sotera* stipulations should be denied because it is contrary to the current weight of legal authority, both in this District and elsewhere. Under the currently prevailing view, IPR estoppel—and thus a *Sotera* stipulation—does not apply to product prior art even if the product prior art is materially identical to printed publications that could have been raised in an IPR. Because the Samsung invalidity defenses that Maxell seeks to strike are based on product prior art that is not subject to IPR estoppel, Maxell's motion should be denied.

Even under the older non-prevailing view of IPR estoppel, Maxell's motion fails on the facts. Specifically, Maxell fails to show that the product guides and manuals that its motion relies upon "disclose[] all of the relevant features of the [product prior art] device." as Maxell asserts. Mot. at 7-8. Instead, there are many claim limitations for which Samsung relies upon either the product prior art product itself, or on unpublished documents that are not printed publications, that could not have been raised in an IPR. Maxell's motion should be denied for this second independent reason.

Maxell's additional request for partial summary judgment of the patent and printed publication-based invalidity grounds that Samsung *previously* asserted before the IPRs instituted also should be denied. Samsung timely withdrew those invalidity defenses consistent with its *Sotera* stipulation, and those defenses are now moot.

II. RESPONSE TO STATEMENT OF ISSUES TO BE DECIDED

1. Whether the Court should follow the current prevailing legal authority that IPR estoppel (and thus a *Sotera* stipulation) does not apply to product prior art, and that Maxell's motion should therefore be denied as to Samsung's product prior art-based invalidity defenses.

[redacted]

2. Whether, to the extent the Court applies the currently non-prevailing view of IPR estoppel, Maxell's motion still should be denied because the printed publications relied upon by Maxell are not materially identical to the product prior art.

3. Whether Maxell's request for partial summary judgment of the patent and printed publication-based invalidity grounds that Samsung previously asserted, and timely withdrew in light of the *Sotera* stipulations, should be denied as moot.

III. RESPONSE TO STATEMENT OF UNDISPUTED MATERIAL FACTS

1-3. Undisputed.

4. Disputed. In the IPR, the N93 User Guide is asserted in combination with other publications for obviousness—the N93 User Guide is not asserted as anticipatory.

5. Disputed. The Galaxy SIII User Manual is not asserted as anticipatory of any claim of the '757 patent.

6. Disputed. The Galaxy S10 and iPhone 8 user manuals are not asserted to anticipate any asserted claim of the '815 patent.

7-16. Undisputed.

17. Disputed. Dr. Buehrer's expert report asserting Grounds 3 and 4 was served on December 5, 2024, prior to institution of the IPRs. Samsung will comply with its *Sotera* stipulation by not asserting those grounds at trial.

18. Undisputed that these letters were sent. Disputed that the content of Maxell's letter is accurate.

19. Disputed. Samsung no longer relies on the Galaxy S10 for the '757 patent.

20. Disputed. Samsung did not know of the N93 Service Manual prior to filing the IPRs on the '590 and '241 patents.

[redacted]

21. Disputed. Samsung's product-based grounds rely on evidence that includes many documents, only some of which independently qualify as printed publications.

22. Disputed. Each of grounds 1, 2 and 5 relies on the N93 product. The N93 User Guide is a printed publication under 35 U.S.C. § 102. The N93 Service Manual is a different document. Maxell has not shown that the N93 Service Manual could have been raised in the IPR because Maxell has not shown that it was publicly available at the relevant time such that it qualified as a printed publication under section 102. The N93 Service Manual is not materially identical to the printed publications relied on in Maxell's motion because it discloses additional evidence regarding relevant features of the N93 product (*e.g.*, detailed images and schematics of internal hardware). The N93 product is not materially identical to the printed publications relied on in Maxell's motion because it discloses additional evidence regarding relevant features (*e.g.*, details of internal hardware and videos of the transmission and reception of video using the Bluetooth radio while connecting to the Internet using the cellular radios).

23. Disputed. Samsung does not contend that the Galaxy SIII User Manual itself discloses all the relevant features of the SIII device with respect to the asserted claims of the '757 patent. For example, with respect to Ground 1, Samsung does not contend that Galaxy SIII User Manual itself discloses limitations [1e] or [1i] of claim 1, or claim 5, of the '757 patent.

24. Disputed. Samsung no longer relies on the Galaxy S10 for the '757 patent and does not contend that the Galaxy S10 User Manual itself discloses all the relevant features of the S10 device with respect to asserted claims 21, 24 and 27 of the '815 patent. For example, with respect to Ground 1 for the '815 patent, Samsung does not contend that the Galaxy S10 User Manual itself discloses limitations [21c], [21d], or [21l] of claim 21 of the '815 patent.

[redacted]

25. Disputed. Samsung does not contend that the Apple iPhone 8 User Manual itself discloses all the relevant features of the Apple iPhone 8 device with respect to asserted claims 1 and 8 of the '815 patent. For example, with respect to Ground 2 for the '815 patent, Samsung does not contend the Apple iPhone 8 User Manual itself discloses limitation [1i] of claim 1, or claim 8.

27. Disputed. *See* RSUF ¶¶ 22-25, *supra*. Dr. Buehrer, Mr. Guidash, and Dr. Kia each rely extensively on documents related to the products that Maxell has not shown are printed publications, including, for example, source code documents and service manuals, and their opinions regarding the products are indisputably different from their opinions regarding the printed publications. Moreover, these experts did not testify that their opinions would not change without reliance of evidence of the prior art product. For example, for the '590 and '241 patents, Dr. Buehrer testified that his opinion *would* change without the N93 product samples—specifically, that if they were excluded, "it would weaken my opinion." Ex. 21 (Buehrer Tr.) at 166:20-167:9; *see also* Ex. 20 (Guidash Tr.) at 43:24-44:2, 44:21-25 (testifying that he based his opinions on the evidence he was provided and that the source code provides direct evidence of the operation of the product); Ex. 22 (Kia Tr.) at 201:2-7, 203:16-18.

IV. LEGAL STANDARD

A. Burden of Proof

Maxell bears the burden of proving that IPR estoppel is appropriate. *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, C.A. No. 17-1612 (MN), 2022 WL 2643517 (D. Del. July 8, 2022) at *1 n.2. As with any motion for summary judgment, all reasonable inferences must be drawn in favor of the non-movant. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

B. IPR Estoppel

Under the more recent and prevailing view of the scope of IPR estoppel, including in this District, "[a]s a matter of statutory interpretation, estoppel does not apply to the prior-art products

that Daikin relies on – regardless of whether those products are 'cumulative.'" *Chemours,* 2022 WL 2643517 at *2; *Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973 *22 (D. Del. December 13, 2023) (holding that IPR estoppel does not apply to system prior art even if it is "entirely cumulative of, *i.e.*, materially identical to, prior art in the form of patents or printed publications that were or could have been raised in an IPR."); *Lionra Techs. Ltd. v. Fortinet, Inc.*, No. 2:22-cv-0322-JRG-RSP, 2024 WL 3055977 *4 (E.D. Tex. April 24, 2024) ("The Court is convinced by *Kemper Corp*. and *Prolitec* and adopts their understanding of 'grounds.' As such the Court declines to extend estoppel to the system art that Lionra contends is cumulative of what could have been raised in the IPRs.").

Under the older non-prevailing view of IPR estoppel—adopted in *Wasica Fin. GmbH v. Schrader Int'l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020) and its progeny—a defendant can be estopped on a prior art product ground if that ground is "materially identical" to a ground that could have been raised in an IPR based on printed publications. *Id*. at 455 ("materially identical"), 453 (no dispute that the publication discloses "all of the relevant features"), note 5 ("[n]or is this a case in which there is a contention that the product (ZR-1 Sensors) is a 'superior and separate reference' from the prior art publication'").

V. ARGUMENT

A. Summary Judgment Should Be Denied As To The Withdrawn Printed Publication And Patent Prior Art Grounds

After the IPRs were instituted on six of the seven patents-in-suit, Samsung withdrew the invalidity grounds for those six patents that were based solely on patents or printed publications. SUF ¶¶ 2, 8-16; RSUF ¶ 17. Maxell now seeks summary judgment on those withdrawn grounds. Mot. at 12. Courts, however, routinely deny as moot motions for summary judgment on affirmative defenses and counterclaims that have been withdrawn. *See, e.g.*, *Pardalis Tech. Licensing, LLC v.*

Int'l Bus. Machines Corp., No. 2:22-cv-0452-JRG-RSP, 2024 WL 4329013, at *2 (E.D. Tex. Aug. 5, 2024) (denying as moot summary judgment motion on withdrawn enablement defense because the "Court is a court of limited jurisdiction and it is inappropriate to rule on matters not before the Court"); *Amarin Pharma, Inc. v. West-Ward Pharm. Int'l Ltd.*, 407 F. Supp. 3d 1103, 1106, 1120 (D. Nev. 2019) (denying summary judgment motion "as moot as to the other challenged defenses and counterclaims because Defendants have withdrawn them"); *Ferrara Land Mgmt. Miss., LLC v. Landmark Am. Ins. Co.*, No. 1:19-cv-956, 2021 WL 5055675, at *5 (S.D. Miss. July 7, 2021); *Moore v. Intuitive Surgical, Inc.*, No. 1:15-cv-056, 2019 WL 10784535, at *6 (M.D. Ga. Jan. 30, 2019); *Gareis v. 3M Co.*, No. 16-cv-4187, 2018 WL 1786976, at *2 (D. Minn. Apr. 13, 2018); *FDIC v. BKD, LLP*, No. 4:13-cv-720, 2016 WL 9446793, at *1 (E.D. Ark. Apr. 11, 2016); *Rocky Mountain Chocolate Factory v. SDMS, Inc.*, No. 06-cv-01212, 2007 WL 4268962, at *3 (D. Colo. Nov. 30, 2007).

Here, the Court should similarly deny as moot Maxell's request for partial summary judgment on Samsung's withdrawn invalidity grounds: Grounds 1-4 for the '086 patent, Grounds 1 and 2 for the '848 patent, Grounds 6 and 7 for the '757 patent, Grounds 3-7 for the '815 patent. In addition, Samsung will comply with its *Sotera* stipulation by not presenting at trial Grounds 3 and 4 for the '590 and '241 patents. *See* RSUF ¶ 17.

B. Summary Judgment Should Be Denied As To The Product Prior Art Grounds

Maxell's motion for partial summary judgement as to Samsung's product prior art defenses should be denied for two independent reasons. First, product prior art may not be asserted in an IPR and the current prevailing view of the courts regarding IPR estoppel, including in this District, is that IPR estoppel does not apply to a product prior art defense even if printed publications exist regarding that product provide materially identical disclosures as the prior art product itself.

Second, even under the older non-prevailing view of IPR estoppel, Maxell's motion still must be denied because Maxell fails to show that the product guides and manuals it cites disclose all the relevant features of the product prior art device.

1. Product Prior Art Grounds Are Not Subject to IPR Estoppel under the Great Weight of Authority

Maxell acknowledges that product prior art "ordinarily cannot be used in a ground in an IPR." Mot. at 9 (citing 35 U.S.C. § 311(b)). There is, however, a split in authority among district courts as to whether IPR estoppel applies to product prior art when a printed publication exists (such as a manual or user guide) that provides relevant information concerning the product that could have been used in an IPR. While the Federal Circuit has not yet ruled on this issue, the great weight of current authority, including a decision in this District, is that IPR estoppel does not apply to product prior art even if the product prior art is materially identical to printed publications that could have been raised in an IPR.

The leading case supporting Maxell's position is the Delaware *Wasica* case. *Wasica*, 432 F. Supp. 3d 448. *Wasica* and its progeny are the linchpins of Maxell's motion. Mot. at 9-11. The leading case to the contrary—a case Maxell fails to cite—is the more recent Delaware *Chemours* case. *Chemours*, 2022 WL 2643517. *Chemours* rejected *Wasica's* reasoning, holding that "[a]s a matter of statutory interpretation, estoppel does not apply to the prior-art products that Daikin relies on – regardless of whether those products are 'cumulative.'" *Id.*, *1. After acknowledging *Wasica*, the *Chemours* opinion explained that:

> The statute at issue was the product of considered debate and careful thought. Congress could have broadened the categories of prior art on which IPR could be requested. Congress could have dictated that estoppel applies to products covered by the paper art underlying the IPR where the paper art discloses the same claim limitations as the product. But Congress did not do so. Adhering to well-accepted canons of construction, it is not for this Court to ignore Congress's omission and create additional bases for estoppel.

Id., *2.

Many courts have adopted the compelling reasoning in *Chemours*. For example, prior to *Chemours*, Federal Circuit Judge Byson (sitting by designation) indicated in a Delaware case that IPR estoppel applied to system prior art if it is "simply a printed publication invalidity theory in disguise." *IOENGINE, LLC v. PayPal Holdings, Inc.,* 607 F. Supp. 3d 464, 513 (D. Del. 2022). However, after *Chemours*, Judge Bryson (again sitting by designation) changed his view and found that IPR estoppel does not apply to system prior art even if it is "entirely cumulative of, *i.e.*, materially identical to, prior art in the form of patents or printed publications that were or could have been raised in an IPR." *Prolitec*, 2023 WL 8697973 *22. In *Prolitec*, Judge Bryson noted that the split in district court authority on this issue stems from the meaning of "ground" as used in the IPR estoppel statute, 35 U.S.C. § 315(e)(2). *Id*. As Judge Bryson explained, "[o]ne interpretation is that 'grounds' refers to the underlying legal arguments, which incorporate patents, printed publications, and cumulative device art. The other is that 'grounds' are the particular patents and printed publications on which invalidity arguments are based, and that the supporting affidavits, declarations, and the like are evidence, not 'grounds.'" *Id.* In adopting the *Chemours* line of cases, Judge Bryson noted that "[t]he weight of authority favors the second theory, treating 'grounds' as the specific pieces of prior art that are the bases on which a petitioner challenges a claim." *Id*., *23.

Like Judge Bryson, other judges have shifted from following *Wasica* to following *Chemours*, including in the Eastern District of Texas. For example, while Maxell's motion relies on Judge Payne's opinion in *Biscotti* that adopts the reasoning in *Wasica* (Mot. at 9-11), Maxell fails to note that Judge Payne more recently adopted Judge Bryson's reasoning in *Prolitec* to follow *Chemours*. *Lionra Techs.*, 2024 WL 3055977 *4 ("The Court is convinced by *Kemper Corp*. and

Prolitec and adopts their understanding of 'grounds.' As such the Court declines to extend estoppel to the system art that Lionra contends is cumulative of what could have been raised in IPRs.").

Many other courts have joined Judges Bryson and Payne in declining to follow *Wasica* and instead adopting the reasoning in *Chemours*. *See*, *e.g.*, *EIS, Inc. v. IntiHealth Ger GmbH*, No. 19-1227, 2023 WL 6797905, at *5–6 (D. Del. Aug. 30, 2023) (rejecting the reasoning in *Wasica* and holding that IPR estoppel does not apply to system prior art); *Singular Computing LLC v. Google LLC*, No. 19-12551, 2023 WL 2839282 (D. Mass. Apr. 6, 2023) (same); *Willis Elec. Co. v. Polygroup Macau Ltd.,* 649 F. Supp. 3d 780, 813–15 (D. Minn. 2023) (same); *IPA Techs. Inc. v. Microsoft Corp.*, No. 18-1-RGA, 2024 WL 1797394, at *6 (D. Del. Apr. 25, 2024), reconsideration denied, No. 18-1-RGA, 2024 WL 1962070 (D. Del. May 2, 2024) (same); *No Spill, LLC v. Scepter Canada, Inc.*, No. 2:18-CV-02681-HLT, 2023 WL 12004664, at *11 (D. Kan. Feb. 2, 2023) (same).[2] In contrast, Maxell cites only three post-*Chemours* cases that follow *Wasica*. Mot. at 15, 17 (citing *Wirtgen*, *Hafeman*, and *Boston Sci*.).

Samsung respectfully submits that this Court should follow the current prevailing view of IPR estoppel and adopt the compelling reasoning in *Chemours*, *Prolitec*, and *Lionra* and hold that Samsung is not estopped pursuant to its *Sotera* stipulations from asserting invalidity based on any product prior art, including the N93, iPhone 8, Samsung Galaxy SIII and Samsung Galaxy S10.

[2] These post-*Chemours* decisions join a number of courts that declined to adopt *Wasica*'s reasoning even prior to *Chemours*. *See, e.g.*, *Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17 C 7216, 2020 WL 5512132, at *3 (N.D. Ill. Sept. 14, 2020); *Pavo Sols. LLC v. Kingston Tech. Co.*, No. 8:14-cv-01352, 2020 WL 1049911, at *2 (C.D. Cal. Feb. 18, 2020); *Clearlamp, LLC v. LKQ Corp.,* No. 12 C2533, 2016 WL 4734389, at *8 (N.D. Ill. Mar. 18, 2016); *Microchip Tech. Inc. v. Aptiv Servs. US LLC*, No. 1:17-cv-01194-JDW, 2020 WL 4335519, at *4 (D. Del. July 28, 2020); *SPEX Techs. Inc. v. Kingston Tech. Corp.*, No. SACV 16-01790 JVS (AGRx), 2020 WL 4342254, at *15 (C.D. Cal. June 16, 2020).

[redacted]

2. Even if *Wasica* Were to Apply, Maxell's Motion Still Fails Because Samsung's Product Prior Art Grounds Are Not "Materially Identical" to the Printed Publications

Although the Court should deny Maxell's motion under the reasoning in *Chemours*, *Prolitec*, and *Lionra*, Maxell's motion also fails under *Wasica*. Specifically, under *Wasica*, Maxell must show—but has failed to show—that there is no genuine dispute of material fact that the product prior art is materially identical to the printed publications.

a. '590 and 241 Patents

Maxell's motion fails as to the '590 and '241 patents under *Wasica* because the N93 product—which the parties agree Samsung relies on for invalidity under Grounds 1, 2, and 5 (SUF ¶ 22; RSUF ¶ 22)—is not "materially identical" to the printed publications.

i. Maxell fails to show the N93 Service Manual is a printed publication

Maxell's motion fails out of the gate as to the N93 product because Maxell fails to show that the N93 Service Manual qualifies as a "printed publication" that could have been raised in the IPR. *Wasica*, 432 F. Supp. 3d at 455. Because it is undisputed that the N93 Service Manual was *not* raised in the IPR, Maxell asserts it could have been raised in the IPR. Mot. at 14-15. However, Maxell fails to provide any evidence or argument showing that the N93 Service Manual qualifies as a "printed publication" under sections 102 and 311(b) that would have permitted it to serve as a ground in an IPR. 35 U.S.C. §§ 102, 311(b). Indeed, in its motion, Maxell does not even identify the date on which Maxell contends the N93 Service Manual became publicly available.

Maxell's silence on this point was not the result of oversight. The N93 Service Manual is marked "Confidential" (Ex. A (N93 Service Manual), 1) and Maxell elicited deposition testimony from Mr. Garcia (a former Nokia employee) that the N93 Service Manual would have been treated as confidential. Ex. B (Garcia Tr.), 40:11-41:25. Maxell's failure to offer any evidence

establishing that the N93 Service Manual qualifies as a printed publication that could have served as a basis of an IPR is by itself fatal to its motion as to the N93 product.

ii. Maxell fails to prove the N93 product is materially identical to printed publications

Maxell's argument under *Wasica* also fails for the independent reason that Maxell failed to show that the N93 product is materially identical to the printed publications, as *Wasica* requires. The "materially identical" bar is a high one, as Maxell's motion recognizes. *See* Mot. 15 (acknowledging that the product and printed publication must provide the "same information"), *Id.* (recognizing that the prior art device must be "entirely superfluous" to the publications), 16-17 (same). Despite this high bar, Maxell's motion relies on string cites to essentially the entirety of Dr. Buehrer's expert report and a conclusory statement that everything is the same. Mot. 15-17. Maxell fails to present an analysis for *any* claim limitation—much less for every limitation as *Wasica* requires—of the evidence cited for the N93 product in comparison to the evidence cited for the printed publications. The Court should deny Maxell's motion on this basis alone.

Even ignoring that Maxell failed to provide the required support for its position, the following are some of the many examples of why Maxell's "materially identical" argument fails. First, Maxell misrepresents that Dr. Buehrer testified that excluding the N93 product "wouldn't change his opinion." Mot. 14. But Dr. Buehrer testified precisely the opposite—that excluding the N93 samples "would weaken" his opinion. Ex. 20 at 166:20-167:9. Indeed, Dr. Buehrer's testimony addressed only excluding the N93 samples—Maxell did not ask Dr. Buehrer about a more sweeping exclusion of the entirety of the evidence regarding the N93 product as Maxell represents in its motion, which by definition would have a much greater impact on his opinion. *Id.*

Second, the design of the N93 product is shown in part by the non-printed publication N93 Service Manual, which is a different document than the printed publication N93 User Guide. *See*

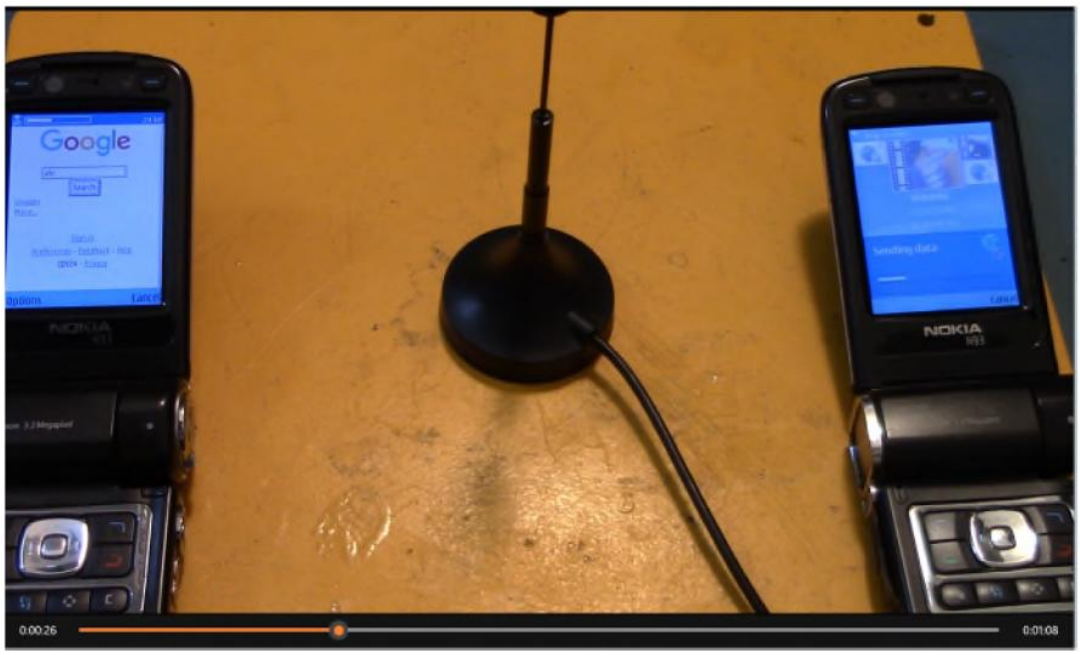
RSUF ¶ 22. Maxell has failed to show how the evidence in the N93 Service Manual is materially identical to the N93 User Guide or any other document that could have been raised in the IPR. In this regard, former Nokia engineer Jose Garcia, who designed the hardware in the N93 product, testified that the schematics in the N93 Service Manual accurately depict the hardware in the N93 product. Ex. B (Garcia Tr.) at 15:13-16:21, 18:1-19:6. Dr. Buehrer's analysis confirms Mr. Garcia's testimony. Ex. C (Buehrer Rpt.), ¶¶ 80, 141-144, 200. The N93 Service Manual provides relevant hardware schematics showing the input device, controller, Wi-Fi, Bluetooth, and cellular radios, and connections between those components. Ex. A (N93 Service Manual), 00351402-415; Ex. C (Buehrer Rpt.), ¶¶ 227 (1a), 244, 258 (1b),267 (1c), 275 (1d), 280 (1e), 287 (1f), 292 (1g), 299 (1h). Maxell's expert does not dispute that the N93 Service Manual accurately describes the product. Ex. D (McNair Tr.), 146:24-148:24. Maxell does not show that this information in the N93 Service Manual is present in any document that qualifies as a printed publication under sections 102 and 311(b), much less that the information is "materially identical."[3]

Third, the N93 product defense is not materially identical to the publications because it includes evidence of the N93 products themselves. As one example, by testing the N93 product samples, Dr. Buehrer showed that the N93 product could connect to the Internet using its 2G and 3G cellular radios while transferring videos using their Bluetooth radios. Ex. C (Buehrer Rpt.) ¶¶ 88-131 (testing), ¶¶ 328-331 ([1.k]), ¶¶ 364-365 ([5h], ¶ 384 ([25l]). For example, as shown in the image below, the N93 on the left is shown running a Google search using its 2G 1900MHz

[3] Because Maxell's motion erroneously treats the N93 Service Manual as a printed publication, Maxell includes that document on the wrong side of the product v. printed publication comparison because the manual should instead be on the product side of the comparison. SUF 22 ("the N93 User Guide/**Service Manual** discloses all the relevant features of the N93 device"); Mot. at 15 ("N93 device and the N93 User Manual/**Service Manual** provide the same information") (emphasis added); *id.* ("the N93 device is simply an exercise in confirming what is already alleged by Samsung to be in … [t]he N93 Service Manual").

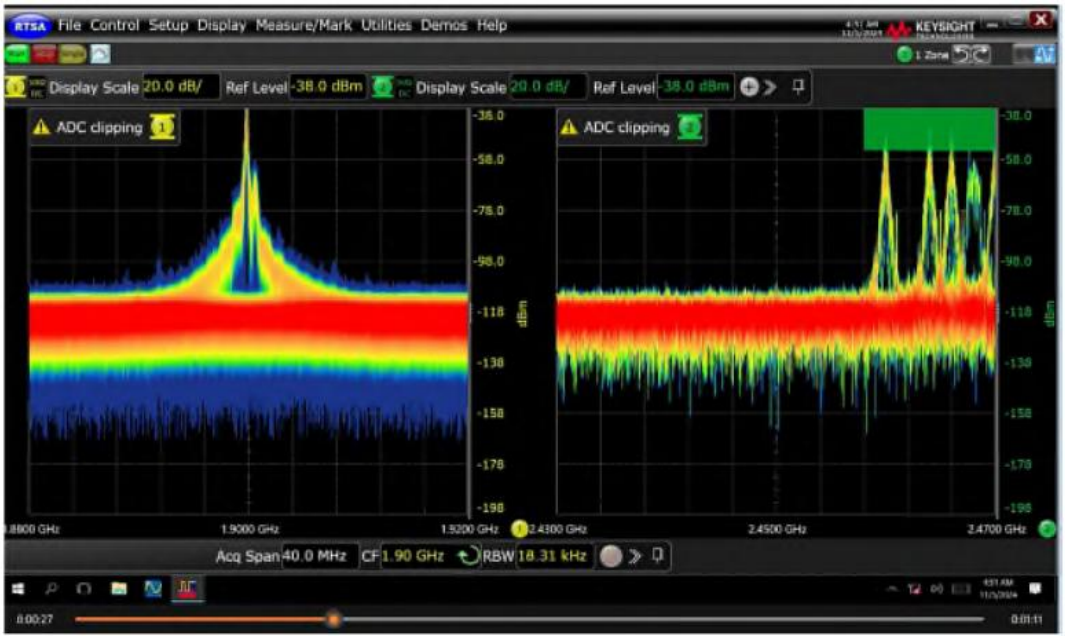
[redacted]

cellular radio on T-Mobile's network (note progress bar in upper left) while the Bluetooth radios in the N93s are transmitting video between the phones (note progress bar on phone on right). Ex. C (Buehrer Rpt.) ¶¶ 129-130.



With respect to the same test, the image below shows the 2G 1900MHz cellular radio connecting to the Internet to run the Google search (left image showing 2G signals in the 1.9000 GHz band), while the video is being transferred by the Bluetooth radios (right image showing Bluetooth signals in the 2.4 GHz band). Ex. C (Buehrer Rpt.) ¶ 131. Maxell does not even attempt to show how these test results are materially identical to any of the printed publications.

[redacted]



To be clear, these are just three examples of the shortcomings of Maxell's showing. While these examples are sufficient to affirmatively show why Maxell's motion should be denied, Samsung disputes Maxell's showing as to every claim limitation. Maxell bears the burden of proof on its motion, and the motion should be denied because Maxell failed to substantively show how the N93 product is "materially identical" to the printed publications as to every claim limitation.

b. '757 Patent

Maxell's motion also fails as to the '757 patent even if *Wasica* were to apply. Maxell agrees that Samsung's invalidity theories in this litigation under Grounds 1, 2 and 5 for the '757 patent rely on the Galaxy SIII product. SUFs ¶¶ 12, 23; RSUF ¶ 23. Maxell's motion fails under *Wasica* because the SIII product is not materially identical to the printed publications Maxell identifies.

Samsung's expert, Dr. Guidash, relies extensively on the Galaxy SIII Service Manual (Ex. E) and source code, neither of which Maxell contends is a printed publication. In contrast, Maxell's motion relies on only the Galaxy SIII User Manual as a printed publication to support its estoppel theory. SUF ¶¶ 5, 23. As a result, to prevail under *Wasica*, Maxell would need to show

[redacted]

that the Galaxy SIII User Manual is materially identical to the Galaxy SIII product; *i.e.*, that the Galaxy SIII User Manual standing alone discloses all the limitations of all of the asserted claims of the ’757 patent. Maxell failed to carry this heavy burden.

In SUF ¶ 23 and in its motion at page 18, Maxell asserts that “Samsung contends the Galaxy SIII User Manual discloses all of the relevant features of the SIII device” and then string cites various paragraphs of Dr. Guidash’s expert report without any further explanation. The lack of any explanation to support its conclusory assertion is itself sufficient reason to deny Maxell’s motion with respect to the ’757 patent. However, Maxell’s assertion also is plainly incorrect. RSUF ¶ 23. For example, for claim limitation [1f], which recites “a controller,” Mr. Guidash relies on information such as schematics from the Galaxy SIII Service Manual (such as the ones shown below), which manual bears a “Confidential” legend and which Maxell does not allege (much less prove) is a printed publication under sections 102 and 311(b).

[redacted]

SIII Service Manual at Page 8-1.

[redacted]

Ex. 9, ¶¶ 162-163; Ex. E (Galaxy SIII Service Manual) at 8-1. While Mr. Guidash refers to the SIII User Manual in discussing certain voice control functionality of the SIII, he does not rely on the SIII User Manual to demonstrate the existence of the claimed controller.

As another example, Mr. Guidash does not opine that the SIII User Manual discloses that the Samsung Galaxy SIII allows users to set different countdown timers for its front and back cameras, which claim limitation [1i] requires ("control such that a first standby time of a case […] is longer than a second standby time of a case […]"). Mr. Guidash did assert that the Galaxy SIII User Manual allows users to set a timer for taking photos. Ex. F1 Guidash Op. Rep., ¶¶ 181-187. However, that manual does *not* disclose that the timers could be different for the front and back cameras. Rather, for that claim requirement, Mr. Guidash relied on his examination of the operation of the SIII device and opined, for example, that a user can set a 10-second timer, which is the longest timer available, and take a picture with the front camera using a voice command, and, for the back camera, that a user can set a shorter timer, such as 2 seconds, before using the touch display to take a picture as shown below. *Id.*, ¶¶ 184, 185.

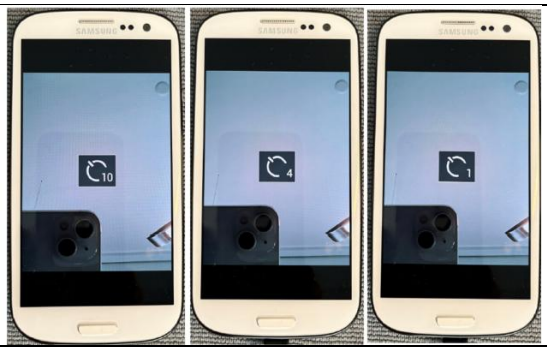
(Image of the Sample Galaxy SIII)

Further, for claim limitation [1i], Mr. Guidash relies on the source code for the Galaxy SIII rather than the SIII User Manual to explain how the SIII meets the portion of limitation [1i] that

[redacted]

recites "a [first/second] standby time of a case where the [first/second] camera is enabled and the [second/first] camera is disabled." Ex. F, Guidash Op. Rep., ¶ 186.

As yet another example, for claim 5, Mr. Guidash does not opine that the SIII User Manual discloses that the Samsung Galaxy SIII displays on the touch display the elapsed standby time from the photographing trigger (either by voice command or touch command) to the start of image signal recording, which claim 5 requires. Ex. F, Guidash Op. Rep., ¶¶ 194-197. Rather, he opined that the SIII displays the elapsed standby time from the photographing trigger through his examination of the operation of the SIII device, as exemplified below. *Id.*, ¶¶ 196-97.

	
Ex. F, Guidash Op. Rep., ¶ 196	Ex. F, Guidash Op. Rep., ¶ 197

In short, even if *Wasica* were to apply (which it should not), Maxell has fallen far short of showing that the prior art product is "materially identical" to any printed publication.

c. '815 Patent

Maxell's motion for the '815 patent again also fails under *Wasica* because the Galaxy S10 and iPhone 8 products—which all parties agree Samsung relies on for invalidity under Grounds 1 and 2 (SUFs ¶¶ 12, 24, 25; RSUF ¶¶ 24, 25)—are not materially identical to the printed publications identified by Maxell. Here again, Maxell relies only on the Galaxy S10 and iPhone 8 <u>user manuals</u> and not on any service manuals or source code as printed publications. SUF ¶¶ 6, 24, 25. Thus, Maxell would need to show that the user manuals are materially identical to the Galaxy S10 and iPhone 8 in order to prevail under *Wasica*. It failed to do so.

[redacted]

i. Galaxy S10

The Galaxy S10 User Manual does not disclose all relevant features of the S10 device regarding claims 21, 24, and 27 of the '815 patent. For example, Dr. Kia does not opine that the Galaxy S10 User Manual discloses that a character (*i.e.*, "title") displayed on the "Who's Watching" Netflix profile selection page is selectable as required by claim limitation [21c]. Instead, Dr. Kia relies on the prior art source code of the Netflix Android application, version 5.13.1, build 25870, that Netflix produced pursuant to a subpoena to show this limitation. Ex. G, Kia Op. Rep., ¶¶ 173-175. The source code analysis explains that [redacted]

Likewise, Dr. Kia does not opine that the Galaxy S10 User Manual discloses that the Netflix application on the Galaxy S10 includes an input interface that receives a selection of the first user profile at a first time and a selection of the second character at a second time, as required by claim limitation [21d]. Ex. G, Kia Op. Rep., ¶¶ 177-180. Instead, Dr. Kia relies on his analysis of the prior art source code of the Netflix Android application, in particular the application logic and UI elements designed to handle such interactions. *Id*. This analysis demonstrated that [redacted] *Id*., ¶ 179. Dr. Kia confirmed that this is achieved through the application logic and UI elements, which are designed to manage such interactions. *Id*. Dr. Kia confirms this by explaining [redacted]

[redacted]

For the "processor" of limitation [21j], Dr. Kia does not rely on the S10 User Manual, but instead relies on the S10 Service Manual (which Maxell does not contend or prove is a printed publication) as shown below. Ex. G, Kia Op. Rep., ¶¶ 202-207.

[redacted]

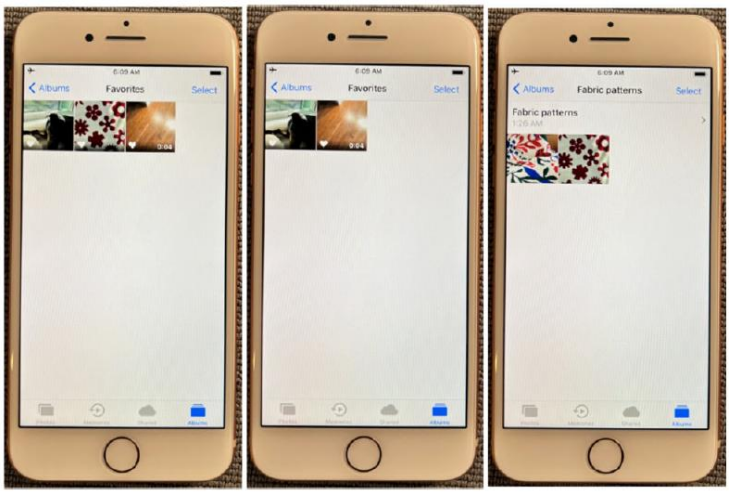
As yet a further example, Dr. Kia does not opine that the Galaxy S10 User Manual discloses that the processor in the Galaxy S10 decrypts the Netflix video information (*i.e.*, second video information) corresponding to a selected thumbnail from a group of Netflix content thumbnails required by limitation [21l]. Ex. G, Kia Op. Rep., ¶¶ 212-218. Rather, Dr. Kia exclusively relies on the analysis of the prior art source code of the Netflix Android application by Netflix. The

[redacted]

source code analysis includes a comprehensive review of the decryption mechanisms and details how the processor handles decryption by utilizing specific algorithms to convert encrypted video data into a readable format. *Id.*, ¶¶ 214-218. This involves [redacted] *Id.* Based on his source code analysis, Dr. Kia concluded that the Netflix app on the Galaxy S10 decrypts video information corresponding to a selected thumbnail. *Id.*, ¶ 216. Significantly, Maxell has not shown that the Galaxy S10 User Manual discloses any of the features described above in the source code. Maxell's "materially identical" argument as to the Galaxy S10 thus fails on its face.

ii. Apple iPhone 8

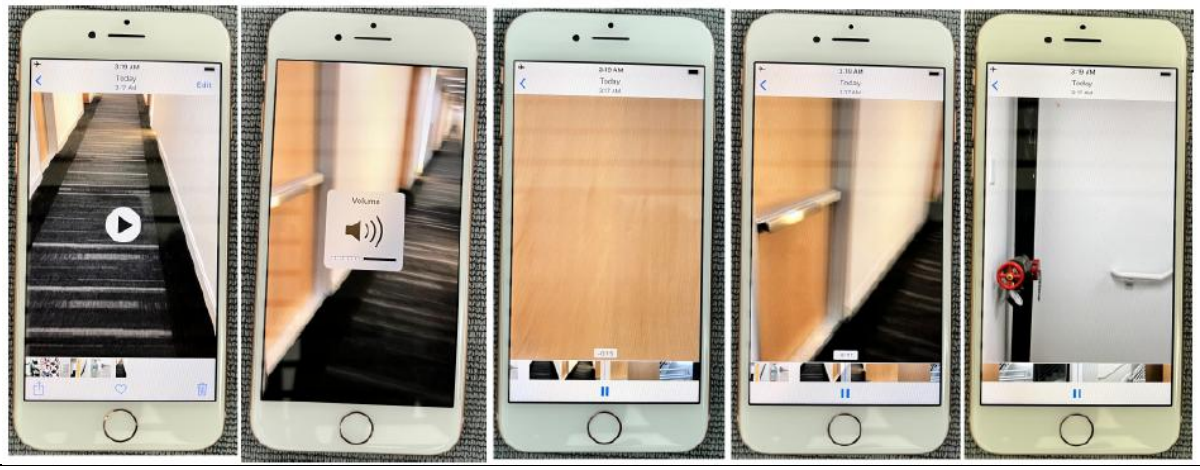
Dr. Kia does not opine that the iPhone 8 User Manual discloses that when a video included in both the Photos app and the Favorites album on the iPhone 8 is deleted from the Favorites album, it continues to be included in the other album(s) as required by claim limitation [1l]. Ex. G, Kia Op. Rep., ¶¶ 309-319. Rather, through the examination of the iPhone 8, Dr. Kia confirmed that removing the Favorites tag from one of the photos in the Favorites album removes the photo from the Favorites folder but not another (Fabric Roll) folder, as shown below. *Id.*, ¶ 314.



(Image of Apple iPhone 8 sample)

[redacted]

As a further example, Dr. Kia does not opine that the iPhone 8 User Manual discloses that the Apple iPhone 8 includes an on-screen display generator generating on screen display information, as required by claim 8. Ex. G, Kia Op. Rep., ¶ 323-324. Rather, as shown below, Dr. Kia confirmed through examination of the iPhone 8 that when a video is played, the Photos app dynamically generates and updates on-screen controls such as play/pause buttons, a progress bar, volume controls, and other interactive elements based on user interactions and video playback status. *Id.*, ¶ 324.



Ex. G, Kia Op. Rep., ¶ 323.

Maxell also has not shown that the iPhone 8 User Manual discloses any of these features that Dr. Kia confirmed through his examination of the iPhone 8. Maxell's "materially identical" argument thus also fails as to the iPhone 8

VI. CONCLUSION

For the foregoing reasons, Maxell's motion for partial summary judgment based on Samsung's *Sotera* stipulations should be denied.

Dated: February 4, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via electronic mail on February 4, 2025.

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