

**IN THE 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 REPLY IN SUPPORT OF MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF EXHIBITS

Exhibit	Description
2001	1st Amended Docket Control Order from District Court Litigation
2002	Original Docket Control Order from District Court Litigation
2003	Maxell's Supplemental Preliminary Election of Asserted Claims
2004	Defendants' Preliminary Election of Prior Art
2005	U.S. Patent Publication No. US 2006/0203758 (Tee)
2006	U.S. Patent Publication No. US 2006/0135076 (Honkanen)
2007	Petitioner's invalidity contentions chart in District Court—Tee
2008	Petitioner's invalidity contentions chart in District Court—Honkanen
2010	L2CAP-Based Prototype Media Streaming via Bluetooth Technology
2011	https://www.nytimes.com/2009/10/19/technology/companies/19nokia.html
2012	https://www.codeproject.com/Articles/9357/Symbian-OS-design-faults
2013	https://www.engadget.com/2010-10-21-nokia-refines-development-strategy-adopts-html5-in-qt-and-ends-s.html
2014	https://www.businessinsider.com/ios-5-over-the-air-updates-2011-7
2015	https://support.apple.com/en-us/102998
2016	Conference Transcript
2017	Declaration of Bruce McNair, dated March 26, 2025
2018	Claim Construction Order
2019	https://time.com/4837176/iphone-10th-anniversary/
2020	https://sites.suffolk.edu/jhtl/2014/09/30/nfc-technology-makes-first-appearance-in-apple-devices/
2021	https://www.nfcw.com/2010/12/07/35385/google-unveils-first-android-nfc-phone-but-nexus-s-is-limited-to-tag-reading-only-for-now/
2022	https://news.samsung.com/us/samsung-announces-launch-dates-for-groundbreaking-mobile-payment-service-samsung-pay/
2023	https://www.theregister.com/2008/08/13/iphone_not_very_3g/
2024	https://www.wsj.com/articles/SB118306134626851922
2025	https://blogs.windows.com/devices/2012/09/19/circuit-training-the-amazing-evolution-of-smartphone-processors/
2026	Essentials of Mobile Handset Design
2027	https://9to5mac.com/2012/06/02/new-iphone-to-debut-with-dual-band-40nm-bcm4334-broadcom-wifi-significant-power-savings-and-wifi-directios-airdrop/
2028	https://community.arubanetworks.com/browse/blogs/blogviewer?blogkey=5c9cb0f9-a77e-4f1f-95de-4aac6fa7b262
2029	SAM-MAX-00388464

Patent No. 10,129,590

Patent Owner's Reply in Support of Motion to Submit Supplemental Information

2030	Creusere Deposition Transcript
2031	https://www.wired.com/2007/06/why-the-iphone-2/
2032	https://www.comms-express.com/infozone/article/802-11n/
2033	https://support.apple.com/en-us/102587
2034	https://www.ezurio.com/resources/blog/ota-over-the-air-updates-for-iot-devices
2035	https://www.theregister.com/2007/02/06/nokia_update_updated/
2036	UMTS; Physical channels and mapping of transport channels onto physical channels
2037	5:23-cv-00092-RWS (E.D. Tex.), Transcript (April, 24, 2025)
2038	Samsung's Opposition to Maxell's Motion for Partial Reconsideration of the Court's Order, Docket No. 285 (May 8, 2025)
2039	E-mail to the Board on June 5, 2025

Petitioner does not dispute that the testimony and positions taken in the District Court were material-to-patentability. “[U]nder 37 CFR § 42.11, Petitioner itself [had] an ongoing duty of candor to disclose this material-to-patentability information to the Board.” See Paper No. 37 at 4. Further, Petitioner never explains why the holding of *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) does not apply.

Under *Ultratec*, the Federal Circuit made clear that such subsequently arising inconsistent positions are precisely the type of information that should be admitted as supplemental information. The Board's focus under 37 CFR § 42.123(b) is on whether the information could have been obtained earlier, not whether the general subject matter was previously addressed. Here, the specific admissions and the context in which they were made only became available after the POR was filed; Maxell acted promptly to bring them to the Board's attention. Thus, there is no waiver, and the motion is timely.

I. MAXELL'S MOTION IS TIMELY AND PROPER

Petitioner alleges earlier material contained the statements at issue in this motion, but the content of these earlier materials does not resemble the concessions made on or after the April 24, 2025 hearing. Petitioner's vague and nonspecific

discussion of these earlier exhibits underscores this. Petitioner fails to identify these specific admissions in earlier exhibits because they are simply not present.

For example, EX1077, allegedly explaining why the N93 product was a “better reference” fails to provide Petitioner’s specific concessions regarding lack of video disclosure in the N93 reference. Paper 39, 1. In EX1077, Petitioner never went beyond characterizing the N93 user guide besides asserting that that the User Manual and the product were not “materially identical.” EX1077, 17-19. Such broad statements fail to meet the level of specificity in the concessions identified by PO in EX2037. Moreover, EX1077 merely points to PO’s characterizations rather than Petitioner’s own characterizations of the N93 reference. EX1077, 17-19.

Similarly, EX1078 references PO’s own statements in the POPR and Maxell’s demonstratives to highlight that **PO** recognized certain deficiencies, but not that Petitioner recognized certain deficiencies regarding the limitations of the N93 reference at issue in this motion. EX1078, 8-9. Petitioner’s arguments regarding EX2038 fare no better. Petitioner never points to any section in earlier materials where Petitioner stated that source code was necessary to determine when assignment occurs. Paper 39, 2. Petitioner only points to irrelevant portions of EX2038, such as the “Statement of Undisputed Material Facts” and state that these portions were present in earlier documents. *Id.* The fact remains that specific

statements regarding the necessity of source code to determine when assignment occurs were not made until or after the April 24, 2025 Hearing. EX2038, 2-3.

II. EX2038, RELATED TO TESTIMONY IN THE FEDERAL DISTRICT COURT CASE, IS PROPER

The Board's Order permits submitting supplemental information under 37 C.F.R. § 42.123(b) **related** to testimony in the federal district court case. Paper 36, 2. EX2038 falls squarely within this category. Moreover, Petitioner's own opposition expanded on the testimony that was presented by Samsung at the hearing. *See* Paper 39, 7 (citing EX1077). Petitioner uses its opposition as a vehicle to supplement the record. For example, the information it provides as to the "oscilloscope" and "tests" have no relevance to the fact that it provided inconsistent statements in the two forums. *See* Paper 39, 7. These tests are also wholly irrelevant to how Petitioner relies on the N93 manual, *e.g.*, as a modem. *Id.* at 5.

III. PETITIONER IS INCONSISTENT

Petitioner's arguments and admissions in EXS 2037 and 2038 are not cumulative of earlier filings, but instead represent new, direct statements that contradict or are materially differ from the positions Petitioner takes in this IPR. Petitioner not only fails to rebut the inconsistencies identified by PO but also deploys misleading statements regarding what was shown in district court that is irrelevant to the motion. Paper 39, 4-10.

Limitation [1k]: Petitioner **concedes** that a passage in the N93 User Manual fails to disclose the word “video.” Paper 39, 5 (“[I]t 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.”). However, the statement in the Hearing went further and disclaimed that the N93 reference as a whole did not disclose [1k]. Paper 37, 6-7; EX2037, 27:10-28:10. Petitioner also improperly supplements the record with statements regarding the N93 product through mischaracterizations of the district court record. Paper 39, 7. These statements are conclusory and unsupported. For example, Petitioner states that “In the litigation, because of the testing results, PO could not argue that a POSITA would not have known that the Internet included ‘video.’” Paper 39, 7. Not so. Petitioner never demonstrated video transfer occurring over the Internet using the N93 product. Petitioner tacitly concedes this previously in its opposition by stating that the “N93 products...**run searches on** Google.com” but fails to provide any evidence that the N93 product was capable of transmitting video, receiving video, or any other action over the Internet beyond “run[ning] searches on Google.com.” Paper 39, 7.

Regarding limitation [1l]: Petitioner fails to address the inconsistencies articulated by PO in its motion, such as the specific statements identified by PO where Petitioner argued for update capability based on the N93 reference. Paper 39,

7-9; Paper 37, 7-8. Petitioner also misrepresents that it showed the N93 product was capable of updating its operating system, when such a finding was never demonstrated by Petitioner. Paper 39, 8.

Regarding limitation [1j]: Petitioner's discussion regarding EX2038 similarly fails. Paper 39, 9-10. Petitioner fails to address the inconsistency by asserting the **necessity** of source code to determine **when** assignment occurs to confirm that assignment occurs based on the claim language ("when/in response to"). *Id.* Petitioner stressed the importance of analyzing assignment, such that the "timing and causal relationship [for when the controller assigns a connection] is shown **only in the source code** of the software **executed by the controller.**" Paper 37, 9; EX2038, 10. These statements squarely conflict with its statements regarding showing assignment in these proceedings. Petitioner never addresses the source code statement and instead attempts to distract from the issue through reference to an S22 product. While Petitioner states that "Samsung's S22 products (circa 2022) operate differently," Petitioner itself points to the Bluetooth functionality in the S22 as the **same** as what it accuses in the Petition. Pet. 50 ("This is the same user interface and Bluetooth video transfer functionality PO accuses in the Litigation of practicing this claim.").

Patent No. 10,129,590

Patent Owner's Reply in Support of Motion to Submit Supplemental Information

Dated: September 24, 2025

Respectfully submitted,

/Robert G. Pluta /

Robert G. Pluta (Reg. No. 50,970)

MAYER BROWN LLP

71 S. Wacker Drive

Chicago, IL 60606

Telephone: (312) 701-8641

rpluta@mayerbrown.com

Saqib J. Siddiqui (Reg. No. 68,626)

MAYER BROWN LLP

1999 K Street NW

Washington, D.C., 20006

ssiddiqui@mayerbrown.com

Counsel for Maxell, Ltd.

Patent No. 10,129,590

Patent Owner's Reply in Support of Motion to Submit Supplemental Information

CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of September, 2025, a copy of the attached
PATENT OWNER'S REPLY IN SUPPORT OF MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION together with all exhibits was served by
electronic mail to the attorneys of record, at the following addresses:

Brian K. Erickson

Brian.Erickson@us.dlapiper.com

Gianni Minutoli

Gianni.Minutoli@us.dlapiper.com

Roshan K. Bhattarai

Roshan.Bhattarai@us.dlapiper.com

With a courtesy copy by electronic mail to:

dla-samsung-maxell@us.dlapiper.com

Respectfully submitted,

Date: September 24, 2025

By: /Robert G Pluta Reg No 50970/

Robert G. Pluta (Reg. No. 50,970)

Counsel for Maxell, Ltd.