

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 C1)¹

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

HUDALLA, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motions to Submit
Supplemental Information
37 C.F.R. § 42.123

¹ This Order addresses the same issue for the above-identified proceedings. Therefore, we exercise our discretion to issue one order to be filed in each proceeding. The parties are not authorized to use this caption style in any subsequent papers.

I. INTRODUCTION

With our authorization (Paper 36²), Patent Owner filed a motion to submit Exhibits 2037 and 2038 as supplemental information under 37 C.F.R. § 42.123(b) in each of these proceedings. Paper 37 (“Mot.”). Petitioner filed an opposition (Paper 39, “Opp.”) and Patent Owner filed a reply (Paper 40, “Reply”). For the reasons that follow, we deny Patent Owner’s motions to submit supplemental information.

II. ANALYSIS

Where, as here, a party files a motion to submit supplemental information more than one month after the institution of trial, the party “must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.” 37 C.F.R. § 42.123(b). Although Petitioner presents arguments related to the timeliness of Patent Owner’s motions and whether Patent Owner’s request to submit Exhibit 2038 as supplemental information is within the scope of the authorized motions (*see* Opp. 1–4), we dispose of the instant motions based on arguments related to the interests-of-justice standard.

² We cite to papers and exhibits in IPR2024-00906. Similar documents were filed in IPR2024-00907. Likewise, we reference Patent Owner’s arguments relative to particular claim limitations of the challenged patent in IPR2024-00906; Patent Owner makes similar arguments against limitations of the challenged patent in IPR2024-00907.

A. Exhibit 2037

Exhibit 2037 is the transcript of a motions hearing in the related district court action. Mot. 2. During the motions hearing, the parties presented arguments about differences between the Nokia N93 User Guide (Ex. 1010) and the N93 product itself in response to disputes between the parties about the scope of Petitioner’s *Sotera* stipulation (Paper 8) and its impact on a summary judgment motion in that action. The N93 User Guide is asserted as prior art in these proceedings, so Patent Owner argues that certain statements made by Petitioner’s counsel during the motions hearing amount to admissions that allegedly “demonstrate that Petitioner is taking different positions in the district court litigation than it has taken during this IPR.” Mot. 1.

First, relative to limitation [1j] in claim 1 of the ’241 patent, Patent Owner cites Petitioner’s contention from the Petition that an ordinarily skilled artisan “would have understood that **N93 discloses simultaneous Bluetooth video transfers and data packet connections over UMTS.**” Mot. 5 (emphasis by Patent Owner) (quoting Pet. 36). Correspondingly, Patent Owner cites Petitioner’s counsel’s statement from the motions hearing that the N93 User Guide does not use the word “video” and that it “**doesn’t show video.**” *Id.* at 6 (emphasis by Patent Owner) (quoting Ex. 2037, 27:10–28:10). Considering the statements of Petitioner’s counsel in the motions hearing, Patent Owner argues that “Petitioner conceded that claim element [1j] is not shown in the [N93] user manual.” *Id.* (internal quotation omitted); *see also* Reply 4 (arguing that Petitioner’s statement disclaimed that the N93 User Guide discloses limitation [1j]).

Petitioner argues that its statements in the motions hearing were made in the context of discussing differences between the N93 User Guide and the N93 product itself. *See* Opp. 5–7. Petitioner acknowledges that “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.’” *Id.* at 5. Further, Petitioner argues that the statements in the motions hearing were “not inconsistent with anything in the Petition, which discusses what a[an ordinarily skilled artisan] ‘would have known’ based on a plurality of teachings in the N93 User Manual.” *Id.* at 7 (citing Pet. 36). Petitioner further argues that Patent Owner’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.” *Id.* (citing Pet. 13–16, 36–38).

We agree with Petitioner that the statements of Petitioner’s counsel in the motions hearing—which pertain to what the N93 User Guide alone discloses—are not inconsistent with Petitioner’s *obviousness* contentions here based on a combination of references. Thus, we do not find that consideration of the relevant passage from the motions hearing transcript would be in the interests of justice. We further note Petitioner’s acknowledgement that the N93 User Guide does not explicitly use the word “video” (Opp. 7) and will consider the same in rendering our Final Written Decisions.

Second, relative to limitation [1k] in claim 1 of the ’241 patent, Patent Owner argues that “Petitioner’s lead trial counsel conceded that claim element [1k] is not shown ‘because the [N93] user manual never talks about downloading the operating system.’” Mot. 7 (quoting Ex. 2037, 29:1–6).

Although Patent Owner acknowledges that Petitioner’s obviousness case for “operating system updates” here is based on Herle, Patent Owner argues that “Petitioner draws from disclosures of the N93 User manual on why such a combination would be obvious and makes representations to the PTAB that are inconsistent with the above admission.” *Id.* at 7–8. In particular, Patent Owner cites arguments in Petitioner’s Reply pertaining to the N93 User Guide’s discussion of “installing updates from trusted sources” and the known ability to update the Symbian operating system over-the-air. *Id.* at 8. (citing Paper 25, 15, 17). As such, Patent Owner characterizes Petitioner’s counsel’s statement at the motions hearing to be an “unequivocal concession that a claim element is not disclosed in a primary reference,” which is “material to patentability.” *Id.*

Petitioner argues that its obviousness contentions here cite the N93 User Guide for teaching updating software such as “applications,” but that Petitioner never asserts that “the N93 User Manual explicitly mentions updating the ‘operating system.’” Opp. 7–8 (citing Pet. 17). Petitioner further argues that it relies on Herle for teaching updates to the operating system. *Id.* at 8 (citing Pet. 17–19, 39–40).

We agree with Petitioner that, in the motions hearing, Petitioner’s counsel merely acknowledged that the N93 User Guide does not expressly disclose updating the operating system. *See* Ex. 2037, 29:1–6. That is consistent with Petitioner’s obviousness contentions here because Petitioner relies on Herle for teaching updates to the operating system. *See* Pet. 39. And Petitioner’s Reply arguments (Paper 25, 15) relate to *application* updates in the N93 User Guide rather than operating system updates, as Patent Owner acknowledges in its Response. *See* Paper 22, 34 (quoting

Ex. 1010, 115). Thus, we do not find an inconsistency warranting our consideration of the motions hearing transcript under the interests-of-justice standard.

B. Exhibit 2038

Exhibit 2038 is Petitioner’s opposition brief related to Patent Owner’s motion for partial reconsideration of an order of the court in the underlying litigation. Patent Owner cites Petitioner’s arguments about Samsung’s S22 product—which has no bearing on these proceedings—for the proposition that Petitioner conceded that limitation [1i] in claim 1 of the ’241 patent “can **only** be shown when timing of the assignment of connection is identified in source code and there should be a direct cause and effect without intervening events.” Mot. 9 (citing Ex. 2038, 10). According to Patent Owner, [t]his is precisely the opposite of what [Petitioner] has shown in its Petition as they only rely on the N93 User manual and Dua for all the Grounds.” *Id.* (citing Pet. 33–35). Patent Owner argues that “[t]here is simply no discussion as to ‘timing and causal relationship’ in the Petition, instead just a conclusory assertion that connection would **eventually** be assigned.” *Id.* at 10. Thus, Patent Owner argues that Exhibit 2038 “contains admissions that element [1i] is not met by Bluetooth video sharing functionality.” *Id.* at 1.

Petitioner seeks to distinguish Patent Owner’s arguments based on the particular functionality of the S22 product because that product sometimes assigns a Wi-Fi protocol for faster file transfer even when a user indicates Bluetooth file sharing. Opp. 9–10. Petitioner contrasts that situation with Bluetooth video file sharing in the instant case, where Patent Owner “does

not contend . . . that the prior art might assign a different radio like Samsung's S22." *Id.* at 10.

We do not agree with Patent Owner that Petitioner's arguments in the district court brief regarding the Samsung S22 product amount to a concession about Petitioner's unpatentability contentions here. Nor do we agree with Patent Owner that arguments in the district court made specifically in the context of the Samsung S22 product should be applied here as the *de facto* standard for teaching a claim limitation. Given that Patent Owner's arguments are divorced from the context in which the alleged concession was made, we are not persuaded that considering the district court brief would be in the interests of justice.

III. CONCLUSION

For the reasons discussed above, Patent Owner has not persuaded us that it is in the interests-of-justice to consider Exhibits 2037 and 2038 as supplemental information. Thus, we deny Patent Owner's motions to submit supplemental information.³

IV. ORDER

It is

ORDERED that Patent Owner's motions to submit supplemental information are *denied*.

³ Notwithstanding, we maintain Exhibits 2037 and 2038 in the record for purposes of appellate review.

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