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Paper 50
Date: October 22, 2025

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.

IPR2024-00828
Patent 8,982,086 B2

Before NEIL T. POWELL, TERRENCE W. MCMILLIN, and
KEVIN C. TROCK, *Administrative Patent Judges.*

MCMILLIN, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion To Submit Supplemental Information
37 C.F.R. § 42.123(b)

On September 15, 2025, Patent Owner's Motion to Submit Supplemental Information (Paper 39, "Motion") was filed. In opposition to the Motion, Petitioner filed Petitioner's Response to Patent Owner's Motion to Submit Supplemental Information (Paper 42, "Response to Motion"). Patent Owner filed Patent Owner's Reply in Support of its Motion to Submit Supplemental Information (Paper 43). After considering the arguments and evidence submitted and for the reasons discussed below, the Motion is denied.

We deny the Motion because it is based upon the false premise that the testimony of Petitioner's expert, Dr. Seth Nielsen, in this proceeding is inconsistent with certain trial testimony given in a related district court case, *Maxell, Ltd., v. Samsung Electronics Co., Ltd.*, No. 5:23-CV-92-RWS (E.D. Tex.). In support of its Motion, Patent Owner contends that "[h]ere [in this proceeding], Dr. Nielson alleges that the single registration process of Rogers discloses both the claimed registering modes, but at trial he testified that an alleged single registration process did not meet the claims." Motion at 6. Dr. Nielson did not testify in this proceeding that Rogers discloses a "single registration process." Paragraph 116 of the Nielson Declaration filed in this proceeding[1] states that "Rogers discloses two registering modes that distinguish between inputting two different types of user input." Ex. 1003 ¶ 116. Indeed, in its Response to the Petition, Patent Owner acknowledges that "as explained by Dr. Nielson, Petitioners interpret 'first registering mode' and 'second registering mode' as different *input methods* that can be

[1] Petitioner cites paragraphs 115–129 of the Nielson Declaration (Ex. 1003) in support of its contention that limitation 1f reciting the two registering modes are disclosed in Rogers and the combination of Rogers and Rosenberg. *See* Paper 3 (Petition), 30–38.

detected." Paper 16 (Patent Owner Response), 34 (citing Ex. 1003 (Nielson Decl.) ¶¶ 116, 121, 123). This testimony in this proceeding is not inconsistent with Dr. Nielson's testimony "at trial that an alleged single registration process did not meet the claims." *See* Motion at 6.

We further determine that the Motion is untimely. *See* 37 C.F.R. § 42.123 (b) ("A party seeking to submit supplemental information more than one month after the trial is instituted . . . must show why the supplemental information reasonably could not have been obtained earlier."). Patent Owner explored the substance and basis for Dr. Nielson's testimony in this proceeding and in the district court case long prior to filing its Motion. After the Petition and the Nielson Declaration were filed in this proceeding on April 26, 2024, but before Patent Owner filed its Response to the Petition on January 23, 2025, Patent Owner deposed Dr. Nielson on January 15, 2025. *See* Paper 3 (Petition); Paper 16 (Patent Owner's Response to the Petition); Exhibit 2009 (transcript of the deposition of Dr. Nielson). And, Patent Owner cited from this deposition transcript in opposing Petitioner's showing as to limitation 1f, the registration mode limitation, in its Response. *See* Paper 16 at 35. Moreover, Patent Owner deposed Dr. Nielson in the district court case on December 20, 2024. *See* Ex. 2013 (transcript of the deposition of Dr. Nielsen taken in the district court case).[2] In opposing the Motion, Petitioner argues:

> [T]he information is not new. The trial testimony P[atent]O[wner] seeks to introduce restates a noninfringement

[2] Dr. Nielson's deposition testimony in the district court case is consistent with his trial testimony. Ex. 2013 at 4 ("[L]ike what we've got with the accused products where there's only one state, and data is all being collected within one state for one -- one template that we're going to get to at the end of the registration mode.").

> position that P[atent]O[wner] has known about since Petitioners served Dr. Nielson's expert report in the district court case on December 9, 2024, over a month before P[atent]O[wner] filed its P[atent]O[wner]R[esponse] on January 23, 2025. In that intervening month, P[atent]O[wner] deposed Dr. Nielson once for the district court litigation on December 20, 2024 and once in these IPR proceedings on January 15, 2025 (EX2009). Dr. Nielson testified about this noninfringement issue in both depositions, yet P[atent]O[wner] never argued in its P[atent]O[wner]R[esponse] (or Sur-Reply) that Dr. Nielson had been inconsistent.

Response to Motion at 1–2. This argument has merit. Patent Owner obtained, or reasonably could have obtained, the substance and basis for Dr. Nielson's testimony in this proceeding and in the district court long prior to filing the instant Motion.

The Motion is denied for lacking merit and as untimely.

ORDER

IT IS HEREBY ORDERED that Patent Owner's Motion to Submit Supplemental Information (Paper 39) is *denied*.

FOR PETITIONER:

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