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. IPR2025-01308
U.S. Patent No. 11,277,650

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. BACKGROUND 2

III. DISCRETIONARY DENIAL IS NOT WARRANTED 8

A. The Complex and Diverse District Court Litigation Weighs Against Discretionary Denial. 8

B. The Fintiv Factors Do Not Support Discretionary Denial. 10

1. Factor 1 (Stay) Does Not Support Discretionary Denial. 11

2. Factor 2 (Trial Date) Weighs Strongly Against Discretionary Denial. 12

3. Factor 3 (Parallel Proceeding) Weighs Strongly Against Discretionary Denial. 13

4. Factor 4 (Issue Overlap) Weighs Strongly Against Discretionary Denial. 15

5. Factor 5 (Same Party) Weighs Against Discretionary Denial. 16

6. Factor 6 (Other Considerations) Does Not Support Discretionary Denial. 17

C. The ’650 Patent Issue Date Weighs Against Discretionary Denial. 17

D. The Interim Processes for PTAB Workload Management Violate the Administrative Procedures Act 19

IV. CONCLUSION 20

TABLE OF AUTHORITIES

Page(s)

Cases

Alpinestars S.p.A. v. Dainese S.p.A.,
IPR2025-00750, Paper 14 (Director August 14, 2025) 17, 18

Amazon.com, Inc. v. NL Giken Inc.,
IPR2025-00250, Paper 14 (Director May 16, 2025) 12

Apple Inc. v. Apex Beam Techs. LLC,
IPR2025-00896, Paper 10 (Director Sept. 3, 2025) 18

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) ..... *passim*

Berkshire Hathaway Energy Co. v. Birchtech Corp.,
IPR2025-00274, Paper 23 (Director, Jul. 2, 2025) 18

Fall Line Patents, LLC v. Zoe's Kitchen, Inc.,
No. 6:18-cv-407-RWS, 2019 WL 11025871 (E.D. Tex. Aug. 9, 2019) 12

Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.,
No. 2:24-cv-210, 2025 WL 1811321 (E.D. Tex. Jul. 1, 2025) 11

Papst Licensing GmbH & Co. v. Apple, Inc.,
No. 6:15-cv-1095-RWS, 2017 WL 11638426 (E.D. Tex. Jun. 16, 2017) 12

Resonant Sys., Inc. v. Nintendo Co.,
No. 2:25-cv-90 (E.D. Tex. Jul. 25, 2005) 11

Samsung Display Co. v. Pictiva Displays Int'l. Ltd.,
IPR2024-1222, Paper 12 (P.T.A.B. Mar. 6, 2025) 15

Samsung Elecs. Co. v. GenghisComm Holdings, LLC,
IPR2025-00780, Paper 11 (Director Aug. 14, 2025) 18

Samsung Elecs. Co. v. GenghisComm Holdings, LLC,
IPR2025-00788, Paper 12 (Director Aug. 22, 2025) 18

Samsung Elecs. Co. v. Mullen Indus. LLC,
IPR2024-01472, Paper 9 (P.T.A.B. Mar. 31, 2025) 14

Samsung Elecs. Co. v. Staton Techiya, LLC,
IPR2022-00302, Paper 13 (P.T.A.B. Jul. 11, 2022) 17

Samsung Elecs. Co. v. Wilus Inst. of Standards and Tech., Inc.,
IPR2025-00933, Paper 11 (October 10, 2025) 19

Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC,
IPR2019-01393, Paper 24 (P.T.A.B. Jun. 16, 2020) 11

SAP America, Inc. v. Cyandia, Inc.,
IPR2024-01432, Paper 14 (P.T.A.B. Apr. 7, 2025) 15

Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.,
IPR2025-00438, Paper 10 (Director Jul. 17, 2025) 8, 9, 10, 16

Sotera Wireless, Inc. v. Masimo Corp.,
IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020) 15, 16

Tesla, Inc. v. Intellectual Ventures II LLC,
IPR2025-00217, Paper 9 (Director Jun. 13, 2025) 8, 9, 10, 16

Statutes

5 U.S.C. § 553(b) 20

5 U.S.C. § 553(c) 20

35 U.S.C. § 2(b)(2) 20

35 U.S.C. § 112 2

35 U.S.C. § 314 20

35 U.S.C. § 314(a) 20

35 U.S.C. § 316(a) 20

35 U.S.C. § 316(a)(2) 20

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 11,277,650.
1002	Declaration of Joseph Paradiso.
1003	File History of U.S. Patent No. 11,277,650.
1004	Certified English Translation of WO 2005/094080 ("Shindo").
1005	WO 2005/094080 ("Shindo").
1006	Certified English translation of Japanese Patent App. Pub. No. 2003/208375 ("Sasaki").
1007	Japanese Patent App. Pub. No. 2003-208375 ("Sasaki").
1008	U.S. Patent No. 6,680,940 ("Lewin").
1009	U.S. Patent Pub. No. 2004/0010687 ("Futa").
1010	U.S. Patent No. 5,619,250 ("McClellan").
1011	U.S. Patent Pub. No. 2004/0231003 ("Cooper").
1012	"Wearable Sensing for Dynamic Management of Dense Ubiquitous Media," Laibowitz, M., Gong, N-W., and Paradiso, J.A., in the Proc. of the Sixth International Workshop on Wearable and Implantable Body Sensor Networks (BSN 2009), Berkeley, CA, June 3-5, 2009.
1013	"Metaphor and Manifestation – Cross Reality with Ubiquitous Sensor/Actuator Networks," Lifton, J., Laibowitz, M., Harry, D., Gong, N.W., Mittal, M. and Paradiso, J.A., IEEE Pervasive Computing Magazine, July-September 2009 (Vol. 8, No. 3).
1014	"Experiences and Challenges in Deploying Potentially Invasive Sensor Systems for Dynamic Media Applications," Gong, N-W., Laibowitz, M., and Paradiso, J.A., in Proc. of the Cloud-Mobile Convergence for Virtual Reality Workshop (CMCVR 2010), Waltham MA, March 20, 2010.
1015	"Dynamic Privacy Management in Pervasive Sensor Networks," Gong, N-W., Laibowitz, M., and Paradiso, J.A., in Proc. of Ambient Intelligence (AmI) 2010, Malaga, Spain, 25-29 October 2010.
1016	"Multimedia Content Creation using Societal-Scale Ubiquitous Camera Networks and Human-Centric Wearable Sensing," Laibowitz, M., Gong, N-W., and Paradiso, J.A., in Proc. of ACM Multimedia 2010, Florence Italy, 25-29 October 2010.
1017	"Gestures Everywhere: A Multimodal Sensor Fusion and Analysis Framework for Pervasive Displays," Nicholas Gillian, Sara

Exhibit No.	Description
	Pfenninger, Spencer Russell, and Joseph Paradiso, in Proceedings of the International Symposium on Pervasive Displays, Copenhagen, June 2014.
1018	Musical Zoo, Vimeo (Feb. 12, 2016), https://vimeo.com/155157756.
1019	Channarukul, S., McRoy, S.W., and Ali, S.S., "MULTIFACE: multimodal content adaptations for heterogeneous devices," in proc. of ICMI '04, October 13, 2004.
1020	Robertson, S., Whaton, C., Ashworth, C., and Franzke, M., "Dual Device User Interface Design: PDAs and Interactive Television," in Proc. of the CHI '96 Conference, April 13-18, 1996.
1021	Lippman, A. and Kermode, R., "Media Banks: Entertainment and the Internet", IBM Systems Journal, Vol. 35, No. 3&4, 1996.
1022	Spinner. Responsive Environments. https://resenv.media.mit.edu/#Projects#spinner.
1023	Petitioners' Stipulation
1024	Complaint dated September 7, 2023, *Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.*, Case No. 5:23-cv-92 (EDTX)
1025	Order dated July 9, 2025 *(Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.*, Case No. 5:23-cv-92 (EDTX), Dkt. 389)
1026	Order dated March 21, 2025 *(Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.*, Case No. 5:23-cv-92 (EDTX), Dkt. 251)
1027	Order dated May 2, 2025 (Dkt. 300, 5:23-cv-92-RWS; EDTX) (public version)
1028	Order dated September 18, 2025 (Dkt. 300, 5:23-cv-92-RWS; EDTX) (public version)
1029	IPR2024-00735, Paper 41 (Opposition to Motion to Submit Supplemental Information)
1030	IPR2024-00828, Paper 42 (Response to Patent Owner's Motion to Submit Supplemental Information)
1031	IPR2024-00828, Paper 47 (Sur-reply to Patent Owner's Motion to Submit Supplemental Information)
1032	RESERVED
1033	Letter from Maxell to Samsung (July 7, 2021)
1034	Email thread and letter from Maxell to Samsung dated December 29, 2021
1035	Email thread between Maxell and Samsung (July 2021 – January 2022)

Exhibit No.	Description
1036	RESERVED
1037	Infringement Contentions dated August 12, 2025 (*Maxell, Ltd. v. Samsung Electronics Co.*, *Ltd, et al.,* Case No. 5:25-cv-52 (EDTX))
1038	IPR2024-00828, Paper 50 (Order Denying Patent Owner's Motion to Submit Supplemental Information)
1039	IPR2024-00867, Paper 40 (Petitioner's Response to Patent Owner's Request for Authorization to File Materials From Related Matters)
1040	IPR2024-00717, Paper 31 (Petitioner's Opposition to Patent Owner's Request for Authorization to File Materials from Relate Matters)
1041	Excerpts from Trial Transcript from *Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.*, Case No. 5:23-cv-92 (EDTX)
1042	Motion to Stay Pending Inter Partes Review dated October 24, 2025 (*Maxell, Ltd. v. Samsung Electronics Co., Ltd, et al.*, Case No. 5:25-cv-52 (EDTX)), Dkt. 53.

I. INTRODUCTION

The Director should reject the request for discretionary denial in Maxell's Brief (Paper 8, the "DD Brief"). The '650 patent challenged in this IPR issued less than four years ago, and Director policy favors early challenges to patents like this one without settled expectations. The trial date in the corresponding district court litigation has not yet been set but will occur no sooner than six months after the due date for a final written decision in this IPR. The other *Fintiv* factors also strongly favor institution. In the district court litigation, Maxell has asserted ten patents in ten different families covering a wide range of technologies, which would favor institution even if the young age of the '650 patent and the *Fintiv* factors did not favor institution, which they do.

To try to deflect attention from the weakness of its position, Maxell creates a skewed version of the dispute between the parties and lobs untrue accusations that Samsung is acting unreasonably by not capitulating to Maxell's licensing demands. But at the same time, Maxell ignores that the district court found noninfringement of all five of Maxell's patents that were adjudicated in the first district court case, and Maxell ignores its own problematic conduct during its litigation campaign against Samsung as discussed below. Based on a holistic assessment of (a) Maxell's assertion of ten patents from ten different families covering a wide range of technologies in a single district court litigation, (b) the *Fintiv* factors, and (c)

Maxell's conduct in its litigation campaign, the Director should deny Maxell's request for discretionary denial.

II. BACKGROUND

Samsung filed this IPR along with nine others in response to a second district court lawsuit brought by Maxell against Samsung. Although Maxell's discretionary denial brief repeatedly refers to Samsung's "infringement," Maxell omits that the district court found noninfringement of five patents in Maxell's first lawsuit against Samsung.[1] In that lawsuit, Maxell asserted seven patents against Samsung, which common sense dictates were Maxell's best patents. EX1024, § 166. The district court severed two of those patents into separate lawsuits. The district court severed and stayed the '241 patent after Maxell asserted that patent in a subsequent U.S. International Trade Commission action. EX1026, 1. The district court also severed the '161 patent after Maxell chose not to proceed with that patent at trial. EX1025, 1. Of the five remaining patents, the district court granted summary judgment of noninfringement of two patents before trial, then granted

[1] Maxell's brief portrays the Court's JMOL ruling as limited to invalidity. DD Brief at 5 ("The Court later granted Samsung's JMOL and found the asserted claims invalid."). However, Court's JMOL found all asserted claims not infringed. EX1028, 39-40.

judgment as a matter of law of noninfringement of the other three patents after trial. EX1027, 60, 64; EX1028, 39. The district court also granted judgment as a matter of law of invalidity for two of those three patents, finding that the asserted claims improperly claimed subject matter not disclosed in the specification in violation of 35 U.S.C. § 112, first paragraph. EX1028, 27-31 and 33-37. Thus, contrary to Maxell's portrayal of Samsung as an "infringer," the district court has determined that Samsung does not infringe all five of Maxell's patents that have been adjudicated thus far, and Samsung is rightfully defending itself against additional unfounded infringement claims by Maxell.

To fully understand the impropriety of Maxell's conduct in its "multi-jurisdictional legal campaign against Samsung" (DD Brief at 10-11), Samsung provides a brief summary of the history between the parties, which is at odds with the portrayal in Maxell's DD Brief. As Maxell acknowledges, Samsung and Maxell's predecessor, Hitachi, entered into a Patent Sale Agreement in 2011 in which Samsung bought ten patent families outright and permanently licensed other patents. EX1041, 109:20-110:9. Samsung also obtained a term-limited license to thousands of other patents in Hitachi's portfolio, which expired in 2016. DD Brief at 2. For five years after the expiration of that license, Maxell did not contact Samsung about renewing that license. EX1041, 819:17-820:19. Samsung understandably took this as an indication that Maxell shared Samsung's conclusion

that a renewed license to Maxell's portfolio was unnecessary. Maxell's five-year silence resulted in strong settled expectations by Samsung that it would not be subject to patent infringement claims by Maxell.

In July 2021, Maxell finally sent a letter to Samsung seeking to initiate licensing discussions and identifying nearly 200 Maxell patents and many categories of Samsung products without any specificity. EX1033. Samsung immediately responded, expressing a willingness to talk. EX1035, 8. Despite this, Maxell sent another letter in December 2021 identifying nearly 30 additional patents, again with no specificity, bringing the total between the two letters to more than 220 patents. EX1034. Neither letter identified any patents as being of particular importance, and neither letter included any claim charts purporting to show infringement of any of the patents listed in the letters. EX1033, EX1034. Samsung did what any party in its position would do: it repeatedly requested claim charts mapped to specific products and specific features. EX1034, 1, 2 and 4. Despite falsely alleging in its DD Brief that it provided Samsung with "detailed information" about "Samsung's ongoing use of [Maxell's] patent technology" (DD Brief at 3)—a claim since disproven for the five patents adjudicated in the first action—Maxell refused to provide claim charts or to identify any particular patents of interest so that the parties could have a meaningful discussion. EX1033, 2. And Maxell then went silent for another 18 months after the parties' last

communication before filing its first lawsuit against Samsung, asserting seven patents in September 2023 that Maxell had never identified to Samsung other than listing them among the 200-plus other patents in Maxell's July and December 2021 letters.

In response to that lawsuit, Samsung filed seven IPR petitions against six of the seven asserted patents, including the three patents at issue in the May 2025 jury trial.[2] The PTAB instituted all seven petitions, which are nearing final written decision. The district court then found no infringement of the five patents that were adjudicated in that lawsuit and found two of them to be invalid.

Before that first district court action even reached trial, Maxell tried to coerce Samsung into taking a license by filing a complaint in the ITC asserting six patents, multiple complaints in the Unified Patent Court asserting three patents, multiple complaints in Japanese courts asserting four patents, and a second Eastern District of Texas lawsuit asserting ten patents. DD Brief at 4. In response to the second district court lawsuit, Samsung promptly filed IPR petitions against all ten asserted patents, including the Petition for this IPR.[3]

---

[2] IPR2024-00717, IPR2024-00735, IPR2024-00777, IPR2024-00828, IPR2024-00867, IPR2024-00906, and IPR2024-00907.

[3] IPR2025-01307 through IPR2025-01316.

In addition to the foregoing, Maxell's patents deserve heightened scrutiny in view of Maxell's pattern of concealing material information from, and submitting contradictory positions to, the Patent Office. In one ongoing IPR proceeding (IPR2024-00867), a recent filing revealed that Maxell had been withholding critical information from both the PTAB and a Patent Office examiner. EX1039 at 5-8. The examiner had been evaluating a continuation of the challenged parent patent without being notified by Maxell of either the ongoing IPR challenge to similar claims in the parent patent, or the fact that Maxell had taken a position in district court litigation that contradicted its arguments to distinguish the prior art. *Id*. This was not an isolated incident: Maxell also failed to advise the examiner reviewing a continuation of the '757 patent of the material institution decision in IPR2024-00717 involving the '757 patent. EX1040 at 4-5.

In concurrent district court and IPR proceedings involving three patents, Maxell repeatedly submitted contradictory arguments to argue for infringement on the one hand and to try to preserve the validity of its patents on the other. For example, in the May 2025 district court trial, Maxell's technical expert opined that a "processor" was "the same" as the claimed "controller," while in IPR proceedings that same expert unequivocally argued the opposite position that "a POSITA would not equate any type of processor to a controller." EX1030, 8-10; *see also* EX1031, 3-5. Maxell again took opposite positions before the district

court and the PTAB just six days apart on the issue of whether two touches constitute a single touch operation or multiple touch operations in connection with an IPR for the ’757 patent. EX1027, 63-64. And in two IPRs, Maxell attempted to distinguish the prior art by arguing that it lacked discrete “modes” with “wholly different processing operations,” but in the district court trial argued the opposite. EX1030, 8-10. In finding noninfringement and invalidity of that patent, the district court criticized Maxell’s “arbitrary labeling of ‘modes.’” EX1028, 7. In the same order, the district court rejected the “conclusory” and “*ipse dixit*” testimony of Maxell’s trial experts, each of whom offered opinions at trial that the district court determined to be untethered to the evidence in the record. EX1028 at 9, 14, 22, 33.

Maxell’s conduct in the first district court case and the corresponding IPRs has been problematic in other ways too. In several of the original seven IPRs, Maxell waited until the jury verdict and only then approached the PTAB to allege that Samsung had taken inconsistent positions in the IPR and in the litigation based on issues that Maxell knew about before filing its patent owner responses six months earlier. *E.g.*, EX1029 at 1-2. By delaying as it did, Maxell was able to present its case to the jury without the burden of being confronted with the positions it later sought to take at the PTAB in the IPRs. *Id.* And the PTAB has now ruled that the first of Maxell’s allegations that Samsung took inconsistent positions in the district court and the PTAB is false. EX1038, 2 (“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."). Thus, contrary to its accusations against Samsung, Maxell is the party that has taken inconsistent positions between the district court and IPRs. EX1029, 7-10; EX1030, 8-10; EX1031, 3-5 (discussing inconsistent testimony of Maxell's expert in IPR2025-00828 and IPR2025-00867).

III. DISCRETIONARY DENIAL IS NOT WARRANTED

A holistic evaluation of *Fintiv* factors and the additional considerations identified in Director Stewart's Memorandum of March 26, 2025 confirm that discretionary denial of the petition is not warranted.

A. The Complex and Diverse District Court Litigation Weighs Against Discretionary Denial.

A "complex and diverse" district court litigation "tip[s] the balance against discretionary denial." *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Director Jun. 13, 2025); *see also Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 3 (Director Jul. 17, 2025) (same). In *Tesla*, "the district court proceeding involve[d] eleven patents spanning nine different families that involve a diverse range of subject matter." *Tesla*, Paper 9 at 2-3. In *Tuozhu*, the district court proceeding "involved nine different patents in six families involving diverse range of subject matter." *Tuozho*, Paper 10 at 2. The Director explained that "[t]he large number and vast scope of the patents asserted

in the district court litigation … weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter." *Tesla*, Paper 9 at 3; *Tuozho*, Paper 10 at 3.

As in *Tesla and Tuozhu*, the parallel district court litigation here is complex and diverse. It involves ten asserted patents in ten unique patent families involving disparate technologies, as the table below illustrates. EX1013, 2.

Patent	**Title**	**Technology**
7,577,417	Mobile terminal	Power management by adjusting clock speed when a foldable device is closed
7,952,645	Video processing apparatus and mobile terminal apparatus	Video signal correction based on pattern detection
8,180,198	Playlist creating apparatus and method, and dubbing list creating apparatus and method	Playlist recommendation based on other selections
8,471,950	Signal processor for adjusting image quality of an input picture signal	Image processing
10,783,228	Information processing device, application software start-up system, and application software start-up method	Communications between devices related to biometric sensors
10,812,646	Portable terminal apparatus	Different display modes for remote control on a mobile device
11,026,088	Communication system, communication device and communication terminal device	Permitting external entity to display video on a display device on a temporary basis

11,277,650	Contents receiving system and client	Distribution of video from a main terminal to subsidiary terminals
11,812,091	Multimedia player displaying operation panel depending on contents	Displaying different control panels depending on digital content being displayed
12,160,681	Video transmitter apparatus and video receiver apparatus	Screen mirroring video from a source to display device

The parallel district court litigation for this IPR therefore involves similar numbers of patents (ten here versus eleven in *Tesla* and nine in *Tuozhu*) and more patent families (ten here versus nine in *Tesla* and six in *Tuozhu*), making it even more complex and diverse than the parallel litigations in those cases. Moreover, unlike *Tesla* and *Tuozhu*, the final written decision due date in this proceeding will precede the scheduled trial date, as established below for *Fintiv* factor two. And unlike *Tesla*, there has not been a "meaningful investment in the district court litigation by the parties," as shown below for *Fintiv* factor three. *Tesla*, Paper 8 at 4-5 (*Markman* hearing scheduled to occur months before institution decision). This proceeding and its parallel litigation therefore present a more compelling case against discretionary denial than *Tesla* and *Tuozhu*, where the Director found that the circumstances tipped the balance against discretionary denial.

B. The *Fintiv* Factors Do Not Support Discretionary Denial.

The *Fintiv* factors do not support discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv*").

1. Factor 1 (Stay) Does Not Support Discretionary Denial.

This factor considers "whether a stay exists or is likely to be granted if a proceeding is instituted." *Fintiv*, Paper 11 at 6. Samsung has filed a motion to stay the underlying litigation, which is pending. EX1042. The Board "will not attempt to predict how the district court … will proceed" regarding potential stays "because the court may determine whether or not to stay any individual case … based on a variety of circumstances and facts." *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. Jun. 16, 2020) (informative). This factor therefore is neutral and does not support discretionary denial.

Furthermore, the district court case is pending in the Eastern District of Texas, which has granted motions to stay in light of instituted IPRs. Examples include *Resonant Sys., Inc. v. Nintendo Co.*, No. 2:25-cv-90, at *2-3 (E.D. Tex. Jul. 25, 2005) and *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc*., No. 2:24-cv-210, 2025 WL 1811321, at *2-3 (E.D. Tex. Jul. 1, 2025). The district court case is pending before District Judge Robert W. Schroeder III, the same judge who granted JMOL against Maxell. Judge Schroeder has previously stayed district court cases in light of instituted IPRs. *See, e.g*., *Fall Line Patents, LLC v. Zoe's Kitchen, Inc*., No. 6:18-cv-407-RWS, 2019 WL 11025871, at *1 (E.D. Tex. Aug. 9, 2019); *Papst Licensing GmbH & Co. v. Apple, Inc*., No. 6:15-cv-1095-RWS, 2017 WL

11638426, at *2-5 (E.D. Tex. Jun. 16, 2017). Thus, this factor is at worst neutral and does not support discretionary denial.

2. Factor 2 (Trial Date) Weighs Strongly Against Discretionary Denial.

This factor considers the "proximity of the court's trial date to the Board's projected statutory deadline." *Fintiv*, Paper 11 at 9. "If the court's trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline," the decision whether to exercise discretionary denial likely will turn on other factors, "such as the resources that have been invested in the parallel proceeding" (factor 3). *Id*. at 9.

Here, the district court has set a pretrial conference for August 10, 2027, but has not set a trial date. EX2004, 1-2. Trial will be no earlier than August 10, 2027 and is likely to be later than that. The Board mailed its notice of filing date for this petition on July 30, 2025. Paper 4. This sets the statutory deadline for the Board's final written decision on January 30, 2027, more than six months before the earliest possible trial date. The Director has held that such facts weigh against discretionary denial. *E.g., Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (Director May 16, 2025) (determining not to exercise discretion to deny institution because "it is likely that a final written decision in this proceeding will issue before the district court trial occurs"). This factor therefore weighs strongly against discretionary denial.

3. Factor 3 (Parallel Proceeding) Weighs Strongly Against Discretionary Denial.

This factor considers "the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision." *Fintiv*, Paper 11 at 9. "If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution." *Id*. at 10. Here, the district court has not made any substantive rulings on the '650 patent, and it is unlikely to do so prior to the institution decision on January 30, 2026. EX2004 (Docket Control Order), 6. Maxell does not argue otherwise. DD Brief at 17-18.

Maxell argues that at the time of the institution decision in this IPR the parties "will have completed claim construction discovery, and be well into the claim construction process for the May 2026 *Markman* hearing." DD Brief at 17-18. Neither is true. Claim construction discovery will not be complete until almost a month after the institution decision in this IPR, and the claim construction process will still be in its infancy: Maxell will not have made its preliminary election of asserted claims, and the opening claim construction brief will not be due until March 11, 2026, which is more than a month after the due date for the institution decision in this IPR on January 30, 2026. Moreover, much work will remain to be done in the district court at the time of the institution decision, as shown by the schedule below:

Event	Date
Opening Claim Construction Brief	March 11, 2026
Responsive Claim Construction Brief	April 1, 2026
Reply Claim Construction Brief	April 15, 2026
Markman Hearing	May 6, 2026
Fact Discovery Deadline	October 23, 2026
Opening Expert Reports	December 8, 2026
Rebuttal Expert Reports	January 12, 2027
Expert Discovery Deadline	February 2, 2027
Dispositive Motions	February 16, 2027
Dispositive Motion Hearing	May 11, 2027
Pretrial Disclosures	June 22, 2027
Joint Final Pretrial Order	July 13, 2027
Motions *in Limine*	July 13, 2027
Pretrial Conference	August 10, 2027

EX2004, 2-5. Samsung also was diligent in filing this petition on July 17, 2025, less than three months after the complaint was filed on April 21, 2025. Samsung filed this petition before Maxell served preliminary infringement contentions on August 12, 2025, and nine months before the statutory deadline. *See Samsung Elecs. Co. v. Mullen Indus. LLC*, IPR2024-01472, Paper 9, at 10 (P.T.A.B. Mar. 31, 2025) (finding petitioner diligent when petition was filed less than five months after infringement contentions).

This factor weighs strongly against discretionary denial, particularly because *Markman* briefing will not have started when the institution decision is due. The Board has found that this factor favors institution even in cases that have advanced beyond the completion of *Markman* briefing. *See Samsung Display Co. v. Pictiva*

Displays Int'l. Ltd., IPR2024-1222, Paper 12 at 7 (P.T.A.B. Mar. 6, 2025) (factor weighs against denial even though a *Markman* hearing had occurred in part because "much remains to be done, including expert discovery"); *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (P.T.A.B. Apr. 7, 2025) (factor favors institution even after *Markman* briefing was complete). The fact that the opening *Markman* brief is not due for more than a month after the date of the institution decision therefore weighs strongly against discretionary denial.

4. Factor 4 (Issue Overlap) Weighs Strongly Against Discretionary Denial.

This factor considers the "overlap between issues raised in the petition and in the parallel proceeding." *Fintiv*, Paper 11 at 12. Samsung has already submitted a broadened *Sotera* stipulation ("*Sotera* plus stipulation") in this IPR. EX1015; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) ("*Sotera*") (describing the standard less-broad *Sotera* stipulation). Samsung's *Sotera* plus stipulation goes beyond the standard *Sotera* stipulation by extending to "any ground based on a combination of system prior art (*i.e*., prior art that is neither a patent or printed publication) and the references that form the basis of any ground raised in [this IPR]" and "any ground that could be raised under §§ 102 or 103 on the basis of system art corresponding to a reference that forms the basis of any ground raised in [this IPR]." EX1015, 2. Samsung's *Sotera* plus stipulation ensures that this IPR will be a true alternative to the parallel

district court action. Indeed, the Director has described this type of stipulation as "broad" and as a factor that helps "tip the balance against discretionary denial." *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc*., IPR2025-00438, Paper 10 at 3 (Director Jul. 17, 2025); *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc*., IPR2025-00438, EX1033 at 1 (stipulation with a scope identical to Samsung's *Sotera* plus stipulation); *see also Tesla*, Paper 9 at 2 (such a stipulation is "broad" and "counsel[s] against discretionary denial"); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, EX1067 at 2 (stipulation). Samsung's *Sotera* plus stipulation therefore makes this factor weigh against discretionary denial.

This factor also considers whether the IPR petition challenges claims not at issue in the district court, which indicates less issue overlap between the two proceedings. *See Fintiv*, Paper 11 at 12-13. In the district court, Maxell asserts only claims 1 and 4. EX1037, 2. But the petition challenges claims 1-4 of the '650 patent, including claims 2 and 3 that are not asserted in the district court. Petition at 1. These facts further reduce the issue overlap between the two proceedings. This factor weighs strongly against discretionary denial.

5. Factor 5 (Same Party) Weighs Against Discretionary Denial.

Because Samsung and the Maxell are the parties in the district court litigation, and because the Board will issue a final written decision at least six months prior to any trial in the district court, this factor weighs against

discretionary denial. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00302, Paper 13 at 18-19 (P.T.A.B. Jul. 11, 2022) (factor five weighs against discretionary denial when statutory deadline for final written decision is before expected trial date in parallel litigation).

6. Factor 6 (Other Considerations) Does Not Support Discretionary Denial.

This factor considers any "other circumstances" as "part of a balanced assessment of all the relevant circumstances." *Fintiv*, Paper 11 at 14. Here, the merits of the petition are strong. The petition includes three independent grounds based on separate references for each of the four claims of the '650 patent. The DD Brief identifies no weakness in any of the challenges. DD Brief, 19. This factor therefore also favors weighs against discretionary denial.

In sum, none of the *Fintiv* factors favor the Director exercising discretion to deny institution and several factors weigh strongly against discretionary denial.

C. The '650 Patent Issue Date Weighs Against Discretionary Denial.

As the Director has stated, "early challenges favor robust, predictable patent rights and weigh against discretionary denial." *E.g., Alpinestars S.p.A. v. Dainese S.p.A.*, IPR2025-00750, Paper 14 at 2 (Director August 14, 2025). The '650 patent issued on March 15, 2022 and therefore has been in force less than four years. The Deputy Director has routinely denied requests for discretionary denial for patents that have been in force for fewer than six years when the *Fintiv* factors weigh

against discretionary denial. *See id.*; *see also Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10, at 3 (Director Sept. 3, 2025) (denying discretionary denial request for patents issued in 2021-2023 when the final written decision was due before the projected trial date and a large number of patents was asserted); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director, Jul. 2, 2025) ("Lastly, the challenged patents issued in 2019 and 2020, such that Patent Owner had not developed strong settled expectations that favor discretionary denial."). The same result should apply here because the '650 patent has been in force for less than four years and the *Fintiv* factors weigh strongly against discretionary denial.

Maxell's reliance on *Samsung Elecs. Co. v. GenghisComm Holdings, LLC,* IPR2025-00780, Paper 11 (Director Aug. 14, 2025) and *Samsung Elecs. Co. v. GenghisComm Holdings, LLC,* IPR2025-00788, Paper 12 (Director Aug. 22, 2025) is misplaced. In those decisions, the Director concluded that the *Fintiv* factor analysis weighed in favor of discretionary denial (IPR2025-00780, Paper 11 at 2; IPR2025-00788, Paper 12 at 2), whereas here the *Fintiv* factors weighs strongly against discretionary denial.

Maxell's argument that Samsung's "history of filing a high volume of ultimately denied petitions" warrants discretionary denial (DD Brief at 2) is meritless, and Maxell cites no authority supporting its argument. Moreover,

Maxell's argument is belied by (1) the institution of all seven IPR petitions filed in response to Maxell's first complaint against Samsung, and (2) the October 10, 2025 denial of patent owner's request for discretionary denial in *Samsung Elecs. Co. v. Wilus Inst. of Standards and Tech., Inc.*, IPR2025-00933, Paper 11 at 3 (October 10, 2025). There, as here, the patent owner asserted a large number of patents and families (12 patents spanning eight families) with diverse subject matter. As the Deputy Director found there, "[t]he large number and wide scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter." *Id*.

D. The Interim Processes for PTAB Workload Management Violate the Administrative Procedures Act.

The Director's memorandum on "Director Institution of AIA Trial Proceedings" (the "Memorandum") dated October 17, 2025 contravenes the Administrative Procedure Act ("APA") in four ways. First, the Memorandum exceeds the Director's authority and is inconsistent with the America Invents Act ("AIA") because the AIA does not authorize the Director to deny IPR petitions based on the discretionary factors referenced in the Interim Processes (*i.e.,* those reflected in the 580 decisions under the "Interim Processes" discussed on page two of the Memorandum). Second, the Interim Processes are procedurally invalid because they were issued without complying with the notice-and-comment

rulemaking requirements. *See* 5 U.S.C. § 553(b), (c); 35 U.S.C. §§ 2(b)(2), 316(a). Third, the Interim Processes are "arbitrary and capricious" and result in unpredictable disparities among similarly situated IPR petitioners. *See* 5 U.S.C. § 706(2)(A). Fourth, discretionary denial for any basis other than as authorized in 35 U.S.C. § 314(a) is unauthorized. *See also* 35 U.S.C. § 316(a)(2); 5 U.S.C. § 706(2)(A). Samsung requests that the Director deny Maxell's request for discretionary denial for these additional reasons.

IV. CONCLUSION

For the foregoing reasons, the Director should deny Maxell's request.

Date: October 30, 2025

Respectfully submitted,

/s/ James M. Heintz

James M. Heintz
Reg. No. 41,828
DLA Piper LLP (US)
11911 Freedom Dr., Suite 300
Reston, VA 20190
Phone: 703.773.4148
Fax: 703.773.5000

Attorney for Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on October 30, 2025, a true and correct copy of this brief and any new exhibits were served by emailing a copy of the same (by agreement) to the following attorneys for PO:

Robert G. Pluta (rpluta@mayerbrown.com); and

Saqib Siddiqui (ssiddiqui@mayerbrown.com).

A courtesy copy also was sent via email to:

maxell-samsung-service@mayerbrown.com

Date: October 30, 2025

/s/ James M. Heintz

James M. Heintz
Reg. No. 41,828
DLA Piper LLP (US)
11911 Freedom Dr., Suite 300
Reston, VA 20190
Phone: 703.773.4148
Fax: 703.773.5000
jim.heintz@dlapiper.com

Attorney for Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.