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Paper: 33
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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.

IPR2024-00717
Patent 11,223,757 B2

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

TROCK, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Request
For Authorization To File Materials

On October 8, 2025, Patent Owner filed a Request For Authorization To File Materials From Related Matters. Paper 30 ("Request" or "Req."). On October 10, 2025, Petitioner filed an Opposition To Patent Owner's Request. Paper 31 ("Opposition" or "Opp."). We have considered the parties positions on this Request, and for the reasons discussed below, Patent Owner's Request is *denied*.

Patent Owner requests authorization to file additional materials in this proceeding pursuant to the Board's General Order on related matters filed on September 19, 2025. Paper 27 ("General Order"). The General Order states that

> [t]he parties must keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims, or substantially similar patent claims, such as claim construction, findings of fact, or conclusions of law, in "any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding" *and is identified as a related matter under 37 C.F.R. § 42.8(b)(2)*.

Paper 27, 1 (emphasis added).

According to the Request, Patent Owner "seeks authorization to submit related U.S. Patent No. 12,284,437 (EX2009) and file history (EX2010) illustrating the Office's prior consideration of prior art from the Petition." Req. 1. Patent Owner asserts that "U.S. Patent 12,284,437 addresses substantially similar patent claims as the claims being challenged in the '757 Patent." *Id.* at 2. Patent Owner also asserts that "[t]he file history of the '437 Patent should be considered in this proceeding because the prior art forming the basis of the Petition in this case was also considered by the Examiner in allowing substantially similar claims." *Id.* To substantiate this, Patent Owner references an IDS filed during the

prosecution on September 23, 2024, in response to a non-final rejection issued on May 21, 2024. *Id.* at 3.

Petitioner opposes Patent Owner's Request, asserting that "Patent Owner seeks to introduce a patent that issued after the Institution Decision in this IPR." Opp. 1. Petitioner argues that the Request should be denied "because it is outside the scope of the Board's General Order because Patent Owner did not disclose the patent and its file history as a related matter" in its mandatory notices pursuant to 37 C.F.R. § 42.8(b)(2). *Id.* at 1, 3 (citing Paper 4, 1; Paper 14, 1). Petitioner also argues that the Request should be denied because "Patent Owner did not disclose the Institution Decision in this IPR to the examiner during prosecution [of the '437 patent] in clear violation of its duty of disclosure under 37 C.F.R. § 1.56." *Id.* at 1. Petitioner further argues that the Request should be denied because "the '437 patent and file history are not relevant to Patent Owner's stated reason for considering them," because the prior art considered during prosecution of the '437 patent does not disclose or render obvious a "voice command for enabling the first camera and disabling the second camera." *Id.* at 3.

We agree with Petitioner. The General Order is clear—the parties must keep the Board apprised of developments in a proceeding that "is identified as a related matter under 37 C.F.R. § 42.8(b)(2)." Paper 27, 1. Patent Owner failed to identify the '437 patent prosecution as a related matter in this proceeding. Patent Owner filed two Mandatory Notices in this proceeding pursuant to 37 C.F.R. § 42.8(b)(2), Paper 4 and Paper 14. Patent Owner's first mandatory notice (Paper 4) was filed on May 9, 2024, almost one year *after* the application for the '437 patent was filed on May 22, 2023.

See Ex. 2009, code (22).[1] Yet, Patent Owner did not notify the Board or the Petitioner of the prosecution of the '437 patent as a related matter pursuant to its obligations under 37 C.F.R. § 42.8(b)(2).

Patent Owner also filed a second mandatory notice (Paper 14) in this proceeding on February 20, 2025, yet failed once again to notify the Board and the Petitioner of the prosecution of the '437 patent as a related matter pursuant to its obligations under 37 C.F.R. § 42.8(b)(2). The '437 patent issued on April 22, 2025, but Patent Owner still did not update its mandatory notices, or apprise the Board and the Petitioner of the existence of the '437 patent until Patent Owner filed this Request on October 8, 2025. *See* Paper 30. Yet, in its Request, Patent Owner provides no explanation as to why it did not comply with its obligations under the Board's Rules governing mandatory notices, 37 C.F.R. § 42.8.

In addition to the language of our Rules, the Board's Trial Practice Guide ("TPG") makes clear that

> [t]he rules *require* that parties to a proceeding provide certain mandatory notices, including identification of the real parties-in-interest, related matters, lead and back-up counsel, and service information. 37 C.F.R. § 42.8. Where there is a change of information, a party *must* file a revised notice within 21 days of the change. 37 C.F.R. § 42.8(a)(3).

TPG 12 (emphasis added).

The Board's TPG goes on to clarify that

> Parties to a proceeding *are to identify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding*. Judicial matters include actions involving the patent in federal court. *Administrative matters include every application and patent claiming, or which may*

[1] Patent Owner acknowledges that the claims of the '437 patent were allowed on December 27, 2024. Request, 5.

> *claim, the benefit of the priority of the filing date of the party's involved patent or application* as well as any *ex parte* and *inter partes* reexaminations for an involved patent.

TPG 12 (emphasis added).

The '437 patent identifies the '757 patent at issue in this proceeding as a "Related U.S. Application," stating that it is a "continuation of application No. 16/686,467, filed on Nov. 18, 2019, now Pat. No. 11,223,757." *See* Ex. 2009, code (63). Yet, despite these clear obligations on Patent Owner's part, Patent Owner did not comply with its obligations under 37 C.F.R. § 42.8(b)(2). Nor has Patent Owner provided any explanation for its failure to do so.

Petitioner argues that there is a second reason for denying Patent Owner's request. Petitioner argues that "Patent Owner did not disclose the Institution Decision in this IPR to the examiner during prosecution [of the '437 patent] in clear violation of its duty of disclosure under 37 C.F.R. § 1.56." *Id.* at 1. 37 C.F.R. § 1.56 is directed to the duty to disclose information material to patentability. Rule 1.65(a) explains that "[e]ach individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability." *Id.* The Rule also explains that "[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration." *Id.*

The Decision on Institution ("DI")[2] in this proceeding issued on November 7, 2024, more than a year after the May 22, 2023, filing date of

[2] A Decision on Institution is a preliminary determination, not a final decision on patentability of the challenged claims.

the application leading to the issuance of the '437 patent. *See* Paper 9; Ex. 2009. Yet, the file history of the '437 patent shows no indication that the DI in this proceeding was ever brought to the attention of the Examiner during prosecution of the '437 patent. *See* Ex. 2010. This is despite Patent Owner's assertion here that "U.S. Patent 12,284,437 addresses substantially similar patent claims as the claims being challenged in the '757 Patent." Request, 2. If Patent Owner's assertion is correct, then Patent Owner would have an obligation under 37 C.F.R. § 1.56 to bring the DI in this proceeding to the attention of the Examiner, yet failed to do so. The failure of Patent Owner to comply with such an obligation provides a second reason to deny Patent Owner's Request here.

Petitioner argues a third reason to deny Patent Owner's Request, that "the '437 patent and its file history are not relevant to the one reason identified in the Request for considering this information, i.e., that the prior art considered during prosecution of the '437 patent does not disclose or render obvious a 'voice command for enabling the first camera and disabling the second camera.'" However, we do not think it is necessary to reach this third reason in order to decide Patent Owner's Request.

The General Order is clear—the parties must keep the Board apprised of developments in a proceeding that "is identified as a related matter under 37 C.F.R. § 42.8(b)(2)." Patent Owner failed to identify the '437 patent prosecution as a related matter in this proceeding in compliance with its mandatory notice obligations under 37 C.F.R. § 42.8(b)(2).

ORDER

Accordingly, it is

ORDERED that Patent Owner's Request For Authorization To File Materials From Related Matters is *denied*.

PETITIONER:

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