PUBLIC VERSION

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD., *Plaintiff*, v. SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC., *Defendants*.	Case No. 5:23-cv-00092-RWS **JURY TRIAL DEMANDED**

MAXELL, LTD.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF VALIDITY BASED ON SAMSUNG'S *SOTERA* STIPULATIONS

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Pursuant to the Third Amended Docket Control Order (Dkt. No. 115), and in accordance with Fed. R. Civ. P. 56, Plaintiff Maxell, Ltd. ("Maxell") moves for partial summary judgment of validity on Samsung's 35 U.S.C. §102/103 affirmative defenses and counterclaims with respect to U.S. Patent Nos. 11,223,757 (the '757 Patent), 11,017,815 (the '815 Patent), 8,982,086 (the '086 Patent), 10,176,848 (the '848 Patent), 11,445,241 (the '241 Patent), and 10,129,590 (the '590 Patent).

I. INTRODUCTION

Samsung filed *Inter Partes* Review (IPR) proceedings against each of the patents-in-suit except U.S. Patent No. 8,037,161, all of which have been instituted. *See* Dkt. Nos. 108-109. To avoid non-institution of the IPRs based on the significant progress of this case, Samsung filed so-called *Sotera* stipulations pursuant to the Patent Trial and Appeal Board (PTAB) case *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) ("*Sotera*"). In each of these stipulations, Samsung stipulates as follows:

> if the Board institutes *inter partes* review in this proceeding…, then Petitioners **will not** pursue in the parallel district court proceeding, *Maxell Ltd. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 5:23-cv-00092-RWS, the same grounds as in the petition or any grounds that **could have** reasonably been raised in the petition.

Ex. 1 (emphasis added). Contrary to its stipulations, Samsung continues to assert affirmative and counterclaim defenses it stipulated it would not pursue by cloaking its invalidity grounds in "system" art, arguing it could not have raised such art in the IPRs. These system art grounds, embodied in the Nokia N93, Samsung Galaxy SIII and S10, and Apple iPhone 8, rely largely on publicly available documents that could have reasonably been raised in Samsung's IPR petitions and are thus subject to the *Sotera* stipulations. In the case of the Nokia N93, Samsung actually used the user guide to support its IPR. In the case of the Samsung Galaxy SIII and S10, and Apple

iPhone 8 user guides, Samsung *could have reasonably* used the guides to support the IPRs, just as it did with the N93, but withheld those documents from the PTAB in attempt to skirt estoppel in this Court.

When a party relies on or reasonably could have relied on a printed publication before the PTAB and then relies on a physical device in court, it relies on the same "ground" if the printed publication and the physical device provide the same information. Because the printed publication and the physical device fill the same gap in the combination, the combination as a whole is the same ground for arguing invalidity. Such is the case here.

Samsung's "system art" grounds are subject to its *Sotera* stipulations and Samsung is estopped from raising those grounds in this Court. Maxell thus respectfully requests the Court grant Maxell's motion for partial summary judgment barring Samsung from asserting anticipation or obviousness invalidity defenses in this case based on IPR estoppel.

II. STATEMENT OF ISSUES TO BE DECIDED

Whether Samsung is estopped based on its *Sotera* stipulations from relying on publicly available documents that were raised or reasonably could have been raised in IPR for its anticipation and obviousness affirmative and counterclaim defenses, including those based on "system art."

III. STATEMENT OF UNDISPUTED MATERIAL FACTS

A. Samsung's IPRs

1. Between April and June 2024 Samsung filed IPRs directed at six of the seven patents-in-suit: IPR2024-00717 (the '757 IPR) (Ex. 2), IPR2024-00735 (the '815 I IPR) (Ex. 3), IPR2024-00777 (the '815 II IPR) (Ex. 4), IPR2024-00828 (the '086 IPR) (Ex. 5), IPR2024-00867 (the '848 IPR) (Ex. 6), IPR2024-00906 (the '241 IPR) (Ex. 7), and IPR2024-00907 (the '590 IPR) (Ex. 8) (collectively, the "IPRs").

2. Prior to the institution decisions, Samsung filed *Sotera* stipulations in each of the IPRs, stating as follows:

> In accordance with the Board's precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (Petitioners) stipulate that if the Board institutes *inter partes* review in this proceeding…, then **Petitioners will <u>not</u> pursue in the parallel district court proceeding, *Maxell Ltd. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 5:23-cv-00092-RWS, the same grounds as in the petition or any grounds that <u>could have</u> reasonably been raised in the petition**.

Ex. 1 (emphasis added).

3. Between November and December 2024, PTAB instituted the IPRs on all grounds. *See* Dkt. Nos. 108-109.

4. The N93 User Guide formed the basis of several grounds in the '590 and '241 IPR petitions. Exs. 7-8.

5. As it did with its use of the N93 User Guide for the '590 and '241 IPR petitions, Samsung reasonably could have raised grounds using the Galaxy SIII user manual, the Galaxy S10 user manual, and Apple iPhone 8 user manual in the '757 IPR petition.

6. Similarly, Samsung reasonably could have raised grounds using the Galaxy S10 user manual and Apple iPhone 8 user manual in the '815 IPR petitions.

B. Samsung's Invalidity Grounds In This Litigation

7. Samsung has asserted affirmative and counterclaim defenses of invalidity for all of the patents-in-suit based, among other things, on anticipation and obviousness under 35 U.S.C. §§ 102 and 103. *See* Dkt. No. 110.

8. For the '086 Patent, Samsung has not proffered an expert witness supporting its invalidity defense with respect to 35 U.S.C. §§ 102 and 103. Ex. 11.

9. On November 11, 2024, Samsung indicated for the ’086 Patent it was no longer asserting invalidity defenses based on Rogers and Rosenberg (Ground 1), Rogers, Rosenberg, and Miyazawa (Ground 2), Rogers and Rekimoto (Ground 3), and Rogers, Rekimoto, and Miyazawa (Ground 4). Ex. 14.

10. For the ’848 Patent, Samsung has proffered an expert witness (Omid Kia) supporting its invalidity defense with respect to 35 U.S.C. §§ 102 and 103. Dr. Kia opines that Claims 11 and 12 are obvious in view of Nozaki and Haitani (Ground 1), and that Claim 84 is obvious in view of Nozaki, Haitani, and Graham (Ground 2), and Nozaki, Haitani, and Kim (Ground 3). Ex. 12.

11. On November 11, 2024, Samsung indicated for the ’848 Patent it was no longer asserting invalidity defenses based on Nozaki, Haitani, Graham, and Kim. Ex. 14.

12. For the ’757 Patent, Samsung has proffered an expert witness (R. Michael Guidash) supporting its invalidity defense with respect to 35 U.S.C. §§ 102 and 103. Dr. Guidash opines that Claims 1, 5, and 9 are obvious in view of the following seven grounds: (1) Samsung Galaxy SIII (Ground 1), (2) Samsung Galaxy SIII, Chinn, and Takahashi (Ground 2), (3) Samsung Galaxy S10 (Ground 3), (4) Samsung Galaxy S10, Chinn, and Takahashi (Ground 4), (5) Samsung Galaxy SIII, Yamamoto, and Takahashi (Ground 5), (6) Chinn, Yamamoto, and Takahashi (Ground 6), and (7) Chinn, Yamamoto, Takahashi, and Kim (Ground 7). Ex. 9.

13. On November 11, 2024, Samsung indicated for the ’757 Patent it was no longer asserting invalidity defenses based on Grounds 6 and 7. Ex. 14.

14. For the ’815 Patent, Samsung has proffered an expert witness (Omid Kia) supporting its invalidity defense with respect to 35 U.S.C. §§ 102 and 103. Dr. Kia opines that Claims 1, 8, 21, 24, and 27 are obvious in view of the following seven grounds: (1) Samsung

Galaxy S10 (Ground 1), (2) Apple iPhone 8 (Ground 2), (3) Horn and Baumgartner (Ground 3), (4) Horn, Baumgartner, and Candelore (Ground 4), (5) Kaplan and Bryant (Ground 5), (6) Kaplan, Bryant, and Baumgartner (Ground 6), and (7) Kaplan, Bryant, Baumgartner, and Candelore (Ground 7). Ex. 10.

15. On November 11, 2024, Samsung indicated for the ’815 Patent it was no longer asserting invalidity defenses based on Grounds 3-7. Ex. 14.

16. For the ’590 and ’241 Patents, Samsung has proffered an expert witness (R. Michael Buehrer) supporting its invalidity defense with respect to 35 U.S.C. §§ 102 and 103. Dr. Buehrer opines that Claims 1, 5, 11, and 16 of the ’590 Patent and Claims 25 and 26 of the ’241 Patent are anticipated or obvious in view of the following five grounds: (1) N93 (Ground 1), (2) N93 and Herle (Ground 2), (3) Dua, Herle, BT-Spec, and Rooyen (Ground 3), (4) Dua, Herle, BT-Spec, Rooyen, and N93 (Ground 4), and (5) Dua, Herle, and N93 (Ground 5). Ex. 13.

17. Samsung continues to assert all five grounds against the ’590 and ’241 Patents. Ex. 13

18. On November 14, 2024, Maxell wrote Samsung objecting to the continued inclusion of invalidity defenses using the so-called “system art” either alone or in conjunction with references utilized in the IPRs. Ex. 15 at 7-8. On November 19, 2024, Samsung responded contending that its invalidity defenses were “in no way inconsistent with its *Sotera* stipulations.” Ex. 16 at 2.

19. The “system art” upon which Samsung relies is as follows: For the ’590/’241 Patents: Nokia N93; for the ’815 Patent: Samsung Galaxy S10 and Apple iPhone 8; for the ’757 Patent: Samsung Galaxy SIII and Samsung Galaxy S10. *See, e.g.,* Ex. 9 at 29-41; Ex. 10 at 43-48; Ex. 13 at 27-66.

20. Samsung knew of and had access to the "printed publications" and devices regarding the Galaxy SIII, Galaxy S10, iPhone 8, and N93 prior to the filing of its IPRs. Ex. 17 at 12-15, 17-20, 22, 39-53 (invalidity contentions dated March 7, 2024).

21. Each of Samsung's "system art" references, however, embodies not only the devices, but also the printed publications of which Samsung is estopped from advancing in this case as a result of its *Sotera* stipulations. For example, with respect to the Nokia N93 "system," Samsung states "The N93 phone, User Guide, N93 SAR and PC Suite Guide each constitute or describe the N93, and therefore, are appropriately considered a single reference for anticipation purposes." Ex. 18 ('590 contentions for N93 at 1). With respect to the Galaxy SIII system, Samsung relies on the SIII device, the SIII User Manual, and SIII Service Manual. Ex. 9 at 29-41; Ex. 10 at 43-48. With respect to the Galaxy S10 system, Samsung relies on the S10 device, the S10 User Manual, and the S10 Service Manual. With respect to the Apple iPhone 8, Samsung relies on the iPhone 8 device and the iPhone User Manual. Ex. 10 at 43-48.

22. Samsung contends the N93 User Guide/Service Manual discloses all of the relevant features of the N93 device. *See, e.g.*, Ex. 13 (For the '590 Patent Ground 1: ¶¶213-232 (elements [1pre]-[1a]); ¶¶233-264 (element [1b]); ¶¶265-270 (element [1c]); ¶¶271-276 (element [1d]); ¶¶277-283 (element [1e]); ¶¶284-288 (element [1f]); ¶¶ 289-295 (element [1g]); ¶¶296-310 (element [1h]); ¶¶311-312 (element [1i]); ¶¶313-325 (element [1j]); ¶¶326-331 (element [1k]); ¶¶332-349 (element [1l]); ¶¶350-366 (Claim 5); ¶367 (Claim 11); ¶368 (Claim 16); at Ground 2: ¶¶399-417; 429-430; at Ground 3: ¶¶568-579; at Ground 5: ¶¶622-635; for the '241 Patent, *see, e.g.*, ¶¶ 369-386; 431-445; 594-608; and 648-662). For ground 4, Samsung primarily uses the IPR references Dua, Herle, BT-Spec, and Rooyen for Claim 1 elements [1pre]-[1i] and [1k]. *Id.* ¶¶568-577. It then adds the N93 user guide (notably *only* the user guide, not the device) for element [1j].

Id. ¶¶578-579. For Claims 5, 11, and 16, Samsung only relies on Dua, Herle, BT-Spec, and Rooyen.

23. Samsung contends the Galaxy SIII User Manual discloses all of the relevant features of the SIII device. *See, e.g.*, Ex. 9 (For Ground 1: ¶¶ 113-130 (elements [1pre] - [1a]), ¶¶131-137 (element [1b]), ¶¶ 138-145 (element [1c]), ¶¶ 146-153 (element [1d]), ¶¶ 154-160 (element [1e]), ¶¶ 161-163 (element [1f]), ¶¶ 164-174 (element [1g]), ¶¶ 175-180 (element [1h]), ¶¶181-187 (element [1i]), ¶¶188-193 (element [1j]; ¶¶194-197 (Claim 5); ¶¶198-208 (Claim 9); for Ground 2: ¶¶223-252; for Ground 5: ¶¶383-411.

24. Samsung contends the Galaxy S10 User Manual discloses all of the relevant features of the S10 device. *See, e.g.*, Ex. 9 (For Ground 1: ¶¶ 253-260 (elements [1pre]-[1a]), ¶¶261-264 (element [1b]), ¶¶ 265-271 (element [1c]), ¶¶ 272-277 (element [1d]), ¶¶ 278-284 (element [1e]), ¶¶ 285-288 (element [1f]), ¶¶ 289-297 (element [1g]), ¶¶ 298-302 (element [1h]), ¶¶303-307 (element [1i]), ¶¶308-311 (element [1j]; ¶¶312-321 (Claim 5); ¶¶322-325 (Claim 9); for Ground 4: ¶¶340-368); Ex. 10 (¶¶ 141-159 (elements [21pre] - [21a]), ¶¶ 160-172 (element [21b]), ¶¶173-175 (element [21c]), ¶¶ 176-180 (element [21d]), ¶¶ 181-187 (element [21e]), ¶¶ 188-193 (element [21f]), ¶¶ 194-195 (element [21g]), ¶¶ 196-197 (element [21h]), ¶¶198-201 (element [21i]), ¶¶202-207 (element [21j]), ¶¶208-211 (element [21k]), ¶¶212-218 (element [21l]), ¶¶219-220 (element [21m]), ¶¶221-230 (Claim 24), ¶¶231-236 (Claim 27)

25. Samsung contends the Apple iPhone 8 User Manual discloses all of the relevant features of the iPhone 8 device. *See, e.g.*, Ex. 10 (¶¶238-249 (elements [1pre] – [1a]), ¶¶250-253 (element [1b]), ¶¶254-262 (element [1c]), ¶¶263-267 (element [1d]), ¶¶268-271 (element [1e]), ¶¶272-277 (element [1f]), ¶¶278-290 (element [1g]), ¶¶291-295 (element [1h]), ¶¶296-302

(element [1i]), ¶¶303-305 (element [1j]), ¶¶306-308 (element [1k]), ¶¶309-319 (element [1l]), ¶¶320-322 (element [1m]), ¶¶323-326 (Claim 8)).

C. Samsung's Experts Reliance On Printed Publications

27. The opinions of Samsung's technical experts regarding the Samsung Galaxy SIII, Samsung Galaxy S10, Apple iPhone 8, and Nokia N93 do not primarily rely on their operation or testing of the products. SUF ¶¶22-25. When asked whether their opinions would change if they did not have access to the products, each expert either equivocated or admitted their opinions would not change. *See, e.g.*, Ex. 20, Guidash Depo. at 43:21-44:6; 44:17-25; Ex. 21, Buehrer Depo at 166:20-167:9;[1] Ex. 22, Kia Depo. (rough) at 200:2-8; 201:8-14; 202:12-18; 203:13-18.

IV. LEGAL STANDARD

A. IPR Estoppel

The 2011 Leahy-Smith America Invents Act (AIA) created *inter partes* review as "a quick, inexpensive, and reliable alternative to district court litigation." S. Rep. No. 110-259, at 20 (2008). In service of these efficiency goals, the AIA includes an estoppel provision. 35 U.S.C. § 315(e)(2). IPR estoppel "applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which could reasonably have been asserted against the claims included in the petition." *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 989 (Fed. Cir. 2022) (cleaned up).

In congressional debates, one of the key architects of the AIA explained that "reasonably could have raised" is meant to include prior art that a petitioner actually knew about or that "a skilled searcher conducting a diligent search reasonably could have been expected to discover"

[1] Maxell is simultaneously seeking to strike and exclude Samsung's reliance on the N93 Product Samples that form the basis of Dr. Buehrer's opinion in this case. *See* Plaintiff's Motion to Strike and Exclude Dr. Buehrer's Testing of the N93 Product Samples. Should such motion be granted, the printed publications would be the only evidence of the N93 system art that remains.

and also includes non-petitioned grounds. *GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00071-JRG-RSP, 2019 WL 5677511, at *3-4 (E.D. Tex. Oct. 30, 2019) (citing 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)). A number of districts, including this one, have adopted a similar view of the AIA estoppel provision. *See, e.g.*, *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-1015, 2017 WL 2526231, at *6 (E.D. Tex. May 11, 2017); *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 924 (S.D. Cal. 2019) (finding all post-*SAS* cases have held the same); *Palomar Techs., Inc. v. MRSI Sys., LLC*, 373 F. Supp. 3d 322, 331 (D. Mass. 2019) (collecting cases); *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-CV-1067, 2017 WL 3278915, at *7–8 (N.D. Ill. Aug. 2, 2017).

It is also consistent with the purpose of the estoppel statute—to prevent a party from pursuing one round of invalidity at the PTAB and another in district court. *Cobalt Boats, LLC v. Sea Ray Boats, Inc.*, No. 2:15-cv-21, 2017 WL 2605977, at *3 (E.D. Va. June 5, 2017); *Parallel Networks Licensing, LLC v. Int'l Bus. Machs. Corp*, No. CV 13-2072 (KAJ), 2017 WL 1045912, at *12 (D. Del. Feb. 22, 2017) ("Allowing [the petitioner] to raise arguments here that it elected not to raise [before the PTAB] would give it a second bite at the apple and allow it to reap the benefits of the IPR without the downside of meaningful estoppel.").

B. IPR Estoppel As Applied to "System Art"

Although so-called "system art" ordinarily cannot be used as a ground in an IPR, *see* 35 U.S.C. § 311(b), in certain circumstances estoppel can extend to grounds that on their face appear to be based on system art. This is one of those circumstances. System art can—and often does—embody inventions disclosed in patents and printed publications that could have been raised in an IPR. Courts in this and other districts have therefore held that a party is estopped from asserting "system" prior art if its "purported system prior art relies on or is based on patents or printed

publications that [it] would otherwise be estopped from pursuing at trial." *Biscotti*, 2017 WL 2526231, at *8.

Many courts recognize that "[w]here there is evidence that a petitioner had reasonable access to printed publications corresponding to or describing a product that it could have proffered during the IPR process, it cannot avoid estoppel simply by pointing to its finished product (rather than the printed materials) during litigation." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15 C 1067, 2019 WL 861394, at *10 (N.D. Ill. Feb. 22, 2019); *Avanos Med. Sales, LLC v. Medtronic Sofamor Danek USA, Inc.*, 2021 WL 8693677, at *2 (W.D. Tenn. Oct. 8, 2021) (where a defendant claims to rely on "product" or "system" prior art, estoppel still applies when "the relevant claim limitations … [are] adequately described in [] publicly available documents"); *Wasica Fin. GmbH v. Schrader International, Inc.*, 432 F. Supp. 3d 448, 453-54 (D. Del. 2020) (where printed publication "discloses all of the relevant features" of the physical device, IPR estoppel applies); *In re Koninklijke Philips Pat. Litig.*, 2020 WL 7392868, at *27 n.25 (N.D. Cal. Apr. 13, 2020) ("[i]f a defendant 'purport[s] to rely on a device without actually relying on the device itself' ..., the policy behind IPR estoppel may best be served by excluding that reference"); *Vaporstream, Inc. v. Snap, Inc.*, No. 2:17-cv-00220, 2020 WL 136591, at *23 (C.D. Cal. Jan. 13, 2020) ("[I]f a patent challenge is simply swapping labels for what is otherwise a patent or printed publication invalidity ground in order to 'cloak' its prior art ground and "skirt' estoppel," then § 315(e)(2) estoppel still applies").

If the party's system art relies on or is based on patents or printed publications that the party would be otherwise estopped from pursuing at trial, then it "should be estopped from presenting those patents and printed publications at trial." *Biscotti*, 2017 WL 2526231, at *8. When a party relies on a printed publication before the PTAB and then relies on a physical device in

court, it relies on the same "ground" if the printed publication and the physical device provide the same information. Because the printed publication and the physical device fill the same gap in the combination, the combination as a whole is the same ground for arguing invalidity. *Wirtgen America, Inc. v. Caterpillar, Inc.*, No. 1:17-cv-00770, 2024 WL 51010, at *9-10 (D. Del. Jan. 4, 2024). "To hold otherwise would allow for a mammoth loophole: an IPR petitioner would always add a physical device that is identical to patents or printed publications in the subsequent civil case just to evade estoppel." *Id*;[2] *but see Lionra Techs. v. Fortinet, Inc.*, 2024 WL 3055977 (E.D. Tex. April 24, 2024) (noting the disagreement in the caselaw on the interpretation of "grounds" as the underlying legal arguments).

The policy animating these holdings is clear: preventing defendants from "simply swapping labels for what is otherwise a patent or printed publication invalidity ground in order to 'cloak' its prior art ground and 'skirt' estoppel." *Cal. Inst. of Tech. v. Broadcom Ltd.*, No. CV 16-3714, 2019 WL 8192255, at *7 (C.D. Cal. Aug. 9, 2019), *aff'd*, 25 F.4th 976 (Fed. Cir. 2022); *see also Biscotti*, 2017 WL 2526231, at *8.

V. ARGUMENT

The Court should grant summary judgment in Maxell's favor on Samsung's 35 U.S.C. §§ 102/103 affirmative and counterclaim defenses and find, in light of Samsung's *Sotera* stipulations, Samsung is estopped from asserting the patents-in-suit (for which there are pending IPRs) are invalid as anticipated or obvious. Samsung's invalidity grounds in this litigation generally fall into

[2] In so holding, Judge Wolson departed from an earlier opinion authored by Judge Bryson in *Prolitec Inc. v. ScentairTechs., LLC*, 2023 WL 8697973, at *23 (D. Del. Dec. 13, 2023), and rejected the position that any physical device prior art (or combination involving a physical device) is a separate "ground" for invalidity. *Wirtgen*, 2024 WL 51010, at *9-10. Judge Wolson noted *Prolitec* based its conclusion on a distinction between a "ground" and the evidence supporting that ground. "And I agree that there's a difference. But the physical device is not just a piece of evidence. It is part of the basis that animates the claim of invalidity. And if a party challenging a patent can make the same claim based on information in a printed publication, then it's the same grounds for an invalidity argument, even if the components are different." *Id.*

two categories: (1) printed patents and publication grounds raised in the IPRs, and (2) hybrid "system art" combined with printed patents and publications raised in the IPRs. There can be no dispute that Samsung is estopped from asserting the grounds in the first category. For the second category, Samsung has simply cloaked grounds otherwise clearly estopped into "system art" grounds. Yet, each of these "system art grounds" embody printed publications that, according to Samsung and its experts, disclose all of the relevant features of the physical device. As such, IPR estoppel also applies to the second category of grounds. *Wasica*, 432 F. Supp. 3d at 453-54; *Avanos*, 2021 WL 8693677, at *2.

A. Samsung Is Estopped From Asserting Grounds Raised In The IPRs

The Court should grant summary judgment because there are no issues of disputed fact that Samsung is estopped from pursing grounds in this litigation actually raised in the IPRs:

- '086 Patent: Grounds 1-4. SUF ¶¶ 2, 8-9.
- '848 Patent: Grounds 1 and 2. SUF ¶¶ 2, 10-11.
- '757 Patent: Grounds 6 and 7. SUF ¶¶ 2, 12-13.
- '815 Patent: Grounds 3-7. SUF ¶¶ 2, 14-15.
- '590/'241 Patents: Ground 3. SUF ¶¶ 2, 16-17.

As such, the Court should grant summary judgment in Maxell's favor with respect to the affirmative defenses and counterclaims on these grounds pursuant to Samsung's *Sotera* stipulations.

B. Samsung's "System Art" Grounds Are Grounds It Raised Or Reasonably Could Have Raised In The IPRs

The Court should grant summary judgment in Maxell's favor as to Samsung's "system art" grounds because there are no issues of disputed fact that these grounds are grounds that were raised or reasonably could have been raised in the IPRs. Every prior art reference used in the

combinations, including the system art, was known to, disclosed by and charted by Samsung as of March 2024 in its preliminary invalidity contentions, before Samsung filed petitions seeking IPR on these patents. SUF ¶20. Samsung's *Sotera* stipulations preclude each of its alleged "system art" invalidity theories, which are based largely on publicly available printed publications.

The statutory framework establishing IPR distinguishes "grounds" from "evidence," and the estoppel provision "applies to *grounds* … even if the *evidence* used to support those grounds was not available to be used in the IPR." *See Wasica*, 432 F. Supp. 3d at 454 (emphasis in original). Any "ground" that could have been raised in IPR is subject to estoppel under Samsung's stipulations. *Id.* Here, each and every limitation allegedly present in the asserted "system art" is alleged by Samsung to be disclosed in the publicly available printed publications such as the device user and service manuals. SUF ¶¶22-25. Thus, while the "system art" may constitute additional "evidence," it does not qualify as a different "ground." Samsung cannot nullify its stipulations by swapping in physical device "grounds" that primarily rely on printed publications it could have raised in an IPR. To hold otherwise would render the stipulations meaningless.

1. **'590/'241 Patents**

For the '590 and '241 Patents, Samsung (through Dr. Buehrer) asserts that Claims 1, 5, 11, and 16 of the '590 Patent and Claims 25 and 26 of the '241 Patent are anticipated or obvious in view of the following four system-based grounds: (1) N93 (Ground 1), (2) N93 and Herle (Ground 2), (3) Dua, Herle, BT-Spec, Rooyen, and N93 (Ground 4), and (4) Dua, Herle, and N93 (Ground 5).[3] Ex. 13; SUF ¶16. Common throughout these grounds is Samsung's use of the Nokia N93 user manual, which also formed the basis for the instituted IPRs. Herle, Dua, BT-Spec, and Rooyen also formed the basis for the instituted IPRs. Samsung contends the foregoing grounds are

[3] As set forth above "Ground 3" falls within the category of printed patents and publication grounds raised in the IPRs, addressed in Section V(A).

appropriate for this litigation because they additionally use the N93 device. However, Samsung and Dr. Buehrer use publicly available information such as the N93 user guide, SAR Compliance Test Report, and the N93 service manual to assert obviousness. Indeed, for each claim element where the N93 is asserted, each and every material limitation argued by Samsung to be present in the physical device is also disclosed in an estopped reference. SUF ¶22. Samsung attempts to skirt its estoppel obligations by referencing an N93 device to support its use of the N93 User Manual and other printed publications associated with the N93. But Samsung's own characterization of the "Nokia N93" betrays its intent to skirt estoppel: "The N93 phone, User Guide, N93 SAR and PC Suite Guide each constitute or describe the N93, and therefore, are appropriately considered a single reference for anticipation purposes." SUF ¶21. Here Samsung is simply swapping labels for what is otherwise a patent or printed publication invalidity ground in order to cloak its prior art ground and skirt estoppel. *Vaporstream*, 2020 WL 136591 at *23. In the instituted IPRs, Samsung contends that the N93 User Guide discloses each and every limitation of the asserted claims. Exs. 7-8 at 9-10. As such, § 315(e)(2) estoppel and Samsung's stipulations apply to these grounds.

a. The N93-based Grounds Mask Publication-based Grounds

Regarding the N93 for Grounds 1, 2, 4 and 5, Samsung asserts that each and every material limitation is disclosed in the user manual for the N93. SUF ¶22. Dr. Buehrer's testing of the N93 device, which he confirms element-by-element with the user manual or the service manual, does not transform this analysis into a ground that can avoid estoppel. Indeed, Dr. Buehrer admitted that if that Court excluded the N93 product, it wouldn't change his opinion and that the other N93 evidence provides a "pretty good" understanding of how the product functions. Ex. 20 at 166:20-167:9. When a party relies on a printed publication before the PTAB and then relies on a physical device in court, it relies on the same "ground" if the printed publication and the physical device provide the same information. Because the printed publication and the physical device fill the same

gap in the combination, the combination as a whole is the same ground for arguing invalidity. *Wirtgen America, Inc. v. Caterpillar, Inc.*, No. 1:17-cv-00770, 2024 WL 51010, at *9-10 (D. Del. Jan. 4, 2024).

That the physical N93 device and the N93 User Manual/Service Manual provide the same information related to Samsung's invalidity grounds is made plain by a comparison between Samsung's assertions in this Court and its assertions with respect to the N93 User Manual in its IPR petition. Set forth below next to the citations to Dr. Buehrer's element-by-element analysis is Samsung's corresponding citation in the IPR for the grounds based on the N93 User Manual. *See, e.g.*, '590 Patent: Ex. 13, ¶¶213-232 (elements [1pre]-[1a]); *compare* Ex. 8 at 18-19; ¶¶233-264 (element [1b]); *compare* Ex. 8 at 20-22; ¶¶265-270 (element [1c]); *compare* Ex. 8 at 22-24; ¶¶271-276 (element [1d]); *compare* Ex. 8 at 24-25; ¶¶277-283 (element [1e]); *compare* Ex. 8 at 25-27; ¶¶284-288 (element [1f]); *compare* Ex. 8 at 27; ¶¶ 289-295 (element [1g]); *compare* Ex. 8 at 28-29; ¶¶296-310 (element [1h]); *compare* Ex. 8 at 29-32; ¶¶311-312 (element [1i]); *compare* Ex. 8 at 32-33; ¶¶313-325 (element [1j]); *compare* Ex. 8 at 33-35; ¶¶326-331 (element [1k]); *compare* Ex. 8 at 36-38; ¶¶332-349 (element [1l]); *compare* Ex. 8 at 38-40; ¶¶350-366 (Claim 5); *compare* Ex. 8 at 42-45; ¶367 (Claim 11); *compare* Ex. 8 at 47-48; ¶368 (Claim 16); *see also* Ex. 23, which is an exemplary table highlighting the copious reliance on printed publications throughout N93 ground 1.

Dr. Buehrer's testing of the N93 device is simply an exercise in confirming what is already alleged by Samsung to be present in the N93 User Guide and vice-versa, and other publicly available printed publications associated with the N93 device. *See, e.g.*, Ex. 13, ¶¶ 299 ("The N93 Service Manual confirms…."), 303 ("The N93 User Guide confirms…."). As a result, the N93 device is entirely superfluous and was clearly added here to skirt estoppel.

For ground 2, Samsung repeats its use of the N93's user and service manuals and adds the Herle reference from the '590 IPR for elements [1l] and Claim 16. *Id.* ¶¶399-417; 429-430. Samsung used the N93 user manual in the '590 IPR petition in combination with Herle. It knew about these references well before filing the IPR petition. SUF ¶21. As a result, the N93 device is entirely superfluous and was clearly added here to skirt estoppel.

For ground 4, Samsung primarily uses the IPR references Dua, Herle, BT-Spec, and Rooyen for Claim 1 elements [1pre]-[1i] and [1k]. *Id.* ¶¶568-577. It then adds the N93 user guide (notably *only* the user guide, not the device) for element [1j]. *Id.* ¶¶578-579. For Claims 5, 11, and 16, Samsung only relies on Dua, Herle, BT-Spec, and Rooyen. SUF ¶22. Clearly Samsung is estopped from asserting ground 4.

Regarding ground 5, Samsung primarily uses the IPR references Dua and Herle for Claim 1 elements [1pre]-[1i], and [1k]-[1l]. *Id.* ¶¶622-631; 634-635. It then adds the N93 user guide (notably *only* the user guide, not the device) for element [1j]. *Id.* ¶¶632-633. For Claims 5, 11, and 16, Samsung only relies on Dua, Herle, BT-Spec, and Rooyen, with the exception of claim element [5g], for which it refers back to the N93's user manual's use in the analysis for claim element [1j]. Clearly Samsung is estopped from asserting ground 5. SUF ¶22.

Regarding the '241 Patent, Dr. Buehrer largely relies on the foregoing analysis with respect to Grounds 1, 2, 4, and 5 as applied to the '241 Patent Claims 25 and 26. *See, e.g.*, Ex. 13, ¶¶ 369-386; 431-445; 594-608; and 648-662. SUF ¶22. Again, a comparison with the citations in the '241 IPR for the grounds based on the N93 User Manual highlights the superfluousness of the N93 device. *Compare id. with* Ex. 7 at 19-28; 48-51.

Samsung actually raised the N93 user manual, Herle, Dua, BT-Spec, and Rooyen in its IPR petitions directed to the '590 and '241 Patents. Exs. 7-8. As a result, the N93 device is entirely

superfluous and was clearly added here to skirt estoppel. *See Hafeman v. LG Elecs., Inc. et al.,* No. 6-21-cv-00696, 2023 WL 4362863, at *1 (W.D. Tex. Apr. 14, 2023) ("Although [Defendant] uses two system references-[Plaintiff's] Retriever product and Apple's Find My iPhone-for its invalidity argument that it could not raise before the PTAB, estoppel still applies when the allegedly new references have 'materially identical' disclosures as the IPR art."); *Boston Sci. Corp. v. Cook Grp. Inc.*, 653 F. Supp. 3d 541, 594 (S.D. Ind. 2023) (applying IPR estoppel where there was "no substantive difference" between the references raised in the litigation and in the IPR);

Based on the foregoing and in light of the *Sotera* stipulations, Samsung should be estopped from challenging the validity of the '590 and '241 Patents utilizing the N93 device to argue anticipation or obviousness.

2. **'757 Patent**

For the '757 Patent, Samsung (through Dr. Guidash) is pursuing five invalidity grounds alleging that Claims 1, 5, and 9 are obvious based on IPR printed publications as well as purported "system art": (1) Samsung Galaxy SIII (Ground 1), (2) Samsung Galaxy SIII, Chinn, and Takahashi (Ground 2), (3) Samsung Galaxy S10 (Ground 3), (4) Samsung Galaxy S10, Chinn, and Takahashi (Ground 4) (5) Samsung Galaxy SIII, Yamamoto, and Takahashi (Ground 5). SUF ¶12. Samsung contends grounds 1-5 are appropriate because they utilize the Samsung Galaxy SIII and Samsung Galaxy S10 in combination with the Chinn, Takahashi, and/or Yamamoto IPR references. However, Samsung uses publicly available information such as the Galaxy SIII and Galaxy S10 user manuals, rather than the devices, to assert these obviousness combinations. Indeed, just as it did with respect to the N93 for the '590 and '241 Patents, for each ground where the SIII and S10 are asserted, each and every material limitation present in the physical device is disclosed in an estopped reference, such as the SIII user manual or the S10 user manual. SUF ¶¶23-24. Samsung is simply swapping labels for what is otherwise a patent or printed publication

invalidity ground in order to cloak its prior art ground and skirt estoppel. *Vaporstream*, 2020 WL 136591, at *23. As such, § 315(e)(2) estoppel and Samsung's stipulations apply to these grounds.

a. The Galaxy SIII-based Grounds Mask Publication-Based Grounds

Regarding the Galaxy SIII for Grounds 1, 2, and 5, Samsung asserts that each and every material limitation is disclosed in the user manual for the Galaxy SIII. *See, e.g.*, Ex. 9, ¶¶ 113-130 (elements [1pre] - [1a]), ¶¶131-137 (element [1b]), ¶¶ 138-145 (element [1c]), ¶¶ 146-153 (element [1d]), ¶¶ 154-160 (element [1e]), ¶¶ 161-163 (element [1f]), ¶¶ 164-174 (element [1g]), ¶¶ 175-180 (element [1h]), ¶¶181-187 (element [1i]), ¶¶188-193 (element [1j]);[4] ¶¶194-197 (Claim 5); ¶¶198-208 (Claim 9). For ground 2 utilizing the Galaxy SIII and Chinn and Takahashi, Samsung repeats its use of the Galaxy SIII's user and service manuals and adds the Chinn and Takahashi references from the '757 IPR for elements [1c], [1d], [1i], and [1j]. *Id.* ¶¶223-252. For ground 5 utilizing the Galaxy SIII and Yamamoto and Takahashi, Samsung again repeats its use of the Galaxy SIII's user and service manuals and adds the Chinn and Takahashi references from the '757 IPR for element [1g]. *Id.* ¶¶383-411. SUF ¶23. Samsung could reasonably have used the Galaxy SIII user and service manuals in the '757 IPR petition alone or in combination with Chinn, Yamamoto, and/or Takahashi. It knew about these references well before filing the IPR petition. SUF ¶20. As a result, the Galaxy SIII device is entirely superfluous and was clearly added here to skirt estoppel.

[4] For several elements, Dr. Guidash "confirms" the presence of a particular element by reference to the CodexWest report (Ex. 19), which purportedly analyzed source code in the Galaxy SIII device. See, *e.g.*, Ex. 20, at 44:17-25. However, this alleged confirmation does not form the basis for the ground, but is rather *evidence* used to support the ground and thus estoppel should still apply. *Wasica*, 432 F. Supp. 3d at 454.

b. The Galaxy S10-based Grounds Mask Publication-Based Grounds

Regarding the Galaxy S10 for Grounds 3-4, Samsung asserts that each and every material limitation is disclosed in the user manual for the Galaxy S10. *See, e.g.*, Ex. 9, ¶¶ 253-260 (elements [1pre]-[1a]), ¶¶261-264 (element [1b]), ¶¶ 265-271 (element [1c]), ¶¶ 272-277 (element [1d]), ¶¶ 278-284 (element [1e]), ¶¶ 285-288 (element [1f]), ¶¶ 289-297 (element [1g]), ¶¶ 298-302 (element [1h]), ¶¶303-307 (element [1i]), ¶¶308-311 (element [1j]; ¶¶312-321 (Claim 5); ¶¶322-325 (Claim 9). For ground 4 utilizing the Galaxy S10 and Chinn and Takahashi, Samsung repeats its use of the Galaxy S10's user and service manuals and adds the Chinn and Takahashi references from the '757 IPR for elements [1c], [1d], i[i], and [1j]. *Id.* ¶¶340-368. SUF ¶24. Samsung could reasonably have used the Galaxy S10 user and service manuals in the '757 IPR petition alone or in combination with Chinn and Takahashi. It knew about these references well before filing the IPR petition. SUF ¶20. As a result, the Galaxy S10 device is entirely superfluous and was clearly added here to skirt estoppel.

Based on the foregoing and in light of the *Sotera* stipulations, Samsung should be estopped from challenging the validity of the '757 Patent using obviousness combinations based on the Galaxy SIII and Galaxy S10.

3. **'815 Patent**

For the '815 Patent, Samsung (through Dr. Kia) is pursuing two invalidity grounds that Claims 1, 8, 21, 24, 27 are obvious in view of the following "system art": (1) Samsung Galaxy S10, and (2) Apple iPhone 8. SUF ¶14. Samsung contends the foregoing grounds are appropriate because they utilize the Samsung Galaxy S10 and Apple iPhone 8. However, Samsung uses publicly available information such as the Galaxy S10 and Apple iPhone 8 user manuals, rather than the devices, to assert obviousness. Indeed, for each ground where the S10 and iPhone 8 are

asserted, each and every material limitation present in the physical device is disclosed in an estopped reference such as the S10 user manual and the iPhone 8 user manual. SUF ¶¶24-25. Here Samsung is simply swapping labels for what is otherwise a patent or printed publication invalidity ground in order to cloak its prior art ground and skirt estoppel. *Vaporstream*, 2020 WL 136591 at *23. As such, § 315(e)(2) estoppel and Samsung's stipulations apply to these grounds.

a. The Galaxy S10-based Grounds Mask Publication-Based Grounds

Regarding the Galaxy S10 for Ground 1, Samsung asserts that each and every material limitation is disclosed in the user manual and/or service manual for the Galaxy S10. *See, e.g.*, Ex. 10, ¶¶ 141-159 (elements [21pre] - [21a]),[5] ¶¶ 160-172 (element [21b]), ¶¶173-175 (element [21c]), ¶¶ 176-180 (element [21d]), ¶¶ 181-187 (element [21e]), ¶¶ 188-193 (element [21f]), ¶¶ 194-195 (element [21g]), ¶¶ 196-197 (element [21h]), ¶¶198-201 (element [21i]), ¶¶202-207 (element [21j]), ¶¶208-211 (element [21k]), ¶¶212-218 (element [21l]), ¶¶219-220 (element [21m]), ¶¶221-230 (Claim 24), ¶¶231-236 (Claim 27). SUF ¶24. Samsung could reasonably have used the Galaxy S10 user and service manuals in the '815 IPR petition. It knew about these references well before filing the IPR petition. SUF ¶20. Dr. Kia admitted that he only used the S10 product for confirmation of his opinions utilizing the S10 printed publications. Ex. 22 at 201:8-14. As a result, the Galaxy S10 device is entirely superfluous and was clearly added here to skirt estoppel.

[5] For several elements, Samsung "confirms" the presence of a particular element by reference to the CodexWest report, which purportedly analyzed source code in the Galaxy S10 device. *See, e.g.*, Ex. 22 at 200:14-201:7. However, this alleged confirmation does not form the basis for the ground, but is rather *evidence* used to support the ground and thus estoppel should still apply. *Wasica*, 432 F. Supp. 3d at 454. Samsung never contends these confirmations are necessary to support any material element in the claim analysis. *See, e.g.*, Ex. 10, ¶218 ("a person of ordinary skill in the art would understand that the Galaxy S10 was capable of decrypting video information corresponding to a selected thumbnail when the input interface receives a selection of desired video information on the Netflix app….")

b. The iPhone 8-based Grounds Mask Publication-based Grounds

Regarding the Apple iPhone 8 for Ground 2, Samsung asserts that each and every material limitation is disclosed in the user manual for the iPhone 8. *See, e.g.*, Ex. 10, ¶¶238-249 (elements [1pre] – [1a]), ¶¶250-253 (element [1b]), ¶¶254-262 (element [1c]), ¶¶263-267 (element [1d]), ¶¶268-271 (element [1e]), ¶¶272-277 (element [1f]), ¶¶278-290 (element [1g]), ¶¶291-295 (element [1h]), ¶¶296-302 (element [1i]), ¶¶303-305 (element [1j]), ¶¶306-308 (element [1k]), ¶¶309-319 (element [1l]), ¶¶320-322 (element [1m]), ¶¶323-326 (Claim 8). SUF ¶25. Dr. Kia's reliance on the iPhone 8 device is largely relegated to statements such as "The sample of the Apple iPhone 8 confirms the above." *See, e.g.*, Ex. 10, ¶¶ 249, 258, 282, 301, 305, 308, 314, 322. Samsung could reasonably have used the iPhone 8 user manual in the '815 IPR petition. It knew about this reference well before filing the IPR petition. SUF ¶20. As a result, the Apple iPhone 8 device is entirely superfluous and was clearly added here to skirt estoppel.

Based on the foregoing and in light of the *Sotera* stipulations, Samsung should be estopped from challenging the validity of the '815 Patent using obviousness based on the S10 and iPhone 8.

VI. CONCLUSION

Samsung's invalidity grounds, including its "system art" grounds, are subject to its *Sotera* stipulations and Samsung is estopped from raising those grounds in this Court. Maxell thus respectfully requests the Court grant Maxell's motion for partial summary judgment barring Samsung from asserting anticipation or obviousness invalidity defenses in this case based on IPR estoppel.

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By: */s/ Jamie B. Beaber*

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CERTIFICATE OF SERVICE

I hereby certify that all counsel of record who are deemed to have consented to electronic service are being served this 14th day of January, 2025 with a copy of this document via electronic mail.

Dated: January 14, 2025

/s/ Jamie B. Beaber
Jamie B. Beaber

[redacted]