

IN THE 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

Case: IPR2025-01311

U.S. Patent No. 11,812,091

**PATENT OWNER'S PRELIMINARY SUR-REPLY IN RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 11,812,091**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-145

PATENT OWNER’S EXHIBIT LIST

Description	Exhibit #
Notice Letter to Samsung (July 7, 2021)	2001
Follow-up Notice Letter to Samsung (December 29, 2021)	2002
Docket Navigator Time to Trial Statistics for the Eastern District of Texas	2003
Docket Control Order, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:25-cv-00052-RWS (E.D. Tex.)	2004
Jury Trial Transcript, Vol. 4, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:23-cv-00092-RWS (E.D. Tex.)	2005
Complaint, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:25-cv-00052-RWS (E.D. Tex.)	2006
Follow-up Notice Letter to Samsung (April 21, 2025)	2007
Law360 Article, “Maxell Settles Patent Suit Against Apple Over Mobile Tech”	2008
Law360 Article, “Maxell Scores \$43M EDTX Jury Win In ZTE Patent Trial”	2009
Law360 Article, “Maxell, Huawei Reach Terms To End Smartphone Patent Suit”	2010
Hudson Institute Article, “Google’s Loss to Sonos Settles It, Big Tech Has an IP Piracy Problem”	2011
PatentRenewal.com Article, “which-companies-hold-the-most-patents-in-the-world”	2012
Motion for Partial Summary Judgment of Validity Based on Sotera Stipulations, <i>Maxell, Ltd. v. Samsung Elecs. Co., Ltd.</i> , No. 5:23-cv-00092-RWS (E.D. Tex.)	2013
Follow-up Notice Letter to Samsung (November 28, 2024)	2014
Petitioner’s Invalidity Contentions (November 28, 2025)	2015
US Patent Application Publication No. US 2008/0184297	2016
Defendants’ PR 4-2 Disclosures	2017

Petitioner’s allegation that Patent Owner is inconsistent rests on a mischaracterization of the infringement contentions. Petitioner selectively cites pages 47/66 of Exhibits 1047 and 1048 yet ignores the operative explanation on page 46, which describes the claimed requirements. *See* EX1047 at 46–48; *see also* EX1048 at 46–48. As explained there, during general playback the controller displays a first operation panel with linear controls, but at specific times—such as the conclusion of an episode—the controller removes that panel and displays a second operation panel containing interactive buttons. *Id.* Pages 47 and 48 illustrate these two different panels. *Id.* at 47–48. Petitioner’s out-of-context reading of the contentions is essential to its narrative. When read as a whole, the infringement contentions consistently identify two distinct panels. Petitioner’s prior art does not. *See* Paper No. 11 at 27–32. Further, Petitioner has already conceded this point by proposing constructions in the pending litigation—that it did not propose in its Petition—stating that the panels “may also include one or more [linear/interactive] operation buttons. *See* EX2017 (Samsung’s PR 4-2 Disclosures). In the Petition, Petitioner did not propose any construction (Paper No. at 19), but in co-pending litigation Petitioner proposes that four terms should be construed to include the concept that the panels can include additional buttons. *See* EX2017 at 6-7. The Petition, however, does not provide any analysis under such constructions.

Petitioner’s assertion that the POPR requires the “first operation panel” to

include *only* linear or *only* interactive controls is plainly false. Petitioner cites no passage from the POPR to support this assertion because none exists. The POPR’s statements that the system “alternates between two different operation panels—one linear and one interactive,” and that the limitation “presupposes the existence of two distinct operation panels,” are made in the context of claim element [1e] and dependent claim 2. *See* Paper No. 11 at 27–32, 50. Those claims expressly require two alternative operation panels displayed in the same panel-rendering area. *See* ’091 Patent, claims 1–2. Consistent with that language, the infringement contentions identify two distinct panels in the accused Samsung products. *See* EX1047 at 46–48. By contrast, Petitioner’s prior-art grounds do not identify two distinct panels that are alternatively displayed together with the reproduced digital content. *See* Paper No. 11 at 27–32. There is no inconsistency—only Petitioner’s attempt to collapse a two-panel claim requirement into a single static interface to salvage its grounds.

Petitioner’s “clarification” of the Petition’s statements regarding the Office’s prior consideration of the Petition’s references fares no better. The Petition expressly acknowledges that Ellis is listed on the face of the patent but was not considered by the Examiner in combination with other references. *See* Paper No. 3 at 15. But Petitioner did not do so for the remaining prior art references. Instead, the Petition made five unqualified statements asserting that those references were “not considered” during prosecution. *See* Paper No. 11 at 21–24. Petitioner now attempts

to reframe those statements as shorthand for a lack of “substantive” consideration. See Paper No. 14 at 2–3. Regardless, the fact remains that Phillips, Wallis, Ellis, and Uchida were in fact considered by the Office. Petitioner’s justification that the references were not “substantively considered” is not only speculation, but irrelevant to the Director’s consideration pursuant to 35 U.S.C. §325(d) and contrary to Board case law. A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office. *Fitesa Simpsonfille, Inc. v. The Proctor & Gamble Co.*, IPR2023-01450, Paper 11 at 10-19 (P.T.A.B. Mar. 20, 2024) (denying institution based on §325(d) because Petition was based on previously presented and cumulative art and that Petitioner failed to demonstrate that the Examiner erred in the evaluation of the prior art); see also *Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (P.T.A.B. Feb. 12, 2018) (denying institution even though the ‘Examiner did not base a rejection’ on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020- 01263, Paper 12, 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (P.T.A.B. Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner’s Notice of References Cited).

Patent Owner respectfully requests that institution be denied.

Dated: January 22, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of January, 2026, a copy of the attached **PATENT OWNER'S PRELIMINARY SUR-REPLY** was served by electronic mail to the attorneys of record, at the following addresses:

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