

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.

IPR2025-01312
Patent 7,952,645 B2

Before TERRENCE W. McMILLIN, SCOTT C. MOORE, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND
37 C.F.R. § 42.121(e)

I. INTRODUCTION

On August 29, 2025, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Petitioner” or “Samsung”) filed a Petition for *Inter Partes* Review, requesting cancellation of claims 1–8 (“Challenged Claims”) of U.S. Patent No. 7,952,645 B2 (Ex. 1001, “the ’645 patent”). Paper 3 (“Pet.”), 1. On February 10, 2026, the Director granted institution of *inter partes* review of the ’645 patent in the above-referenced proceeding. Paper 15. After institution, Maxell, Ltd. (“Patent Owner” or “Maxell”) filed a Contingent Motion to Amend. Paper 23 (“Motion” or “Mot.”). Should we determine in a final written decision that the Challenged Claims are unpatentable, Maxell proposes substitute claims 9–16, each of which corresponds to a respective one of Challenged Claims 1–8. *See* Mot. 1, App. A. Petitioner filed an Opposition to the Motion. Paper 28 (“Opposition” or “Opp.”).

In the Motion, Maxell requested that we provide preliminary guidance concerning the Motion. Mot. 1; *see* 37 C.F.R. § 42.121(e)(1); *see also Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024) (“Final Rule”). We have considered Maxell’s Motion and Samsung’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Maxell has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review (“IPR”) and whether Samsung establishes a reasonable likelihood that the substitute claims are unpatentable. 37 C.F.R. § 42.121(e)(1), (2); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121(a)(2), (a)(3), (b)

(regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). The reasonable likelihood standard this Preliminary Guidance applies is different than the preponderance of the evidence standard applied when ultimately deciding the Motion. Compare 37 C.F.R. § 42.121(e)(1), with § 42.121(d). Finally, this preliminary guidance is not a “decision” for purposes of rehearing under 37 C.F.R. § 42.71(d). 37 C.F.R. § 42.121(e)(2).

For purposes of this Preliminary Guidance, we focus on proposed substitute claims 9–16, and specifically on the amendments proposed in the Motion. See 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. We do not address the patentability of the originally challenged claims 1–8. See *id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Samsung’s challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Maxell. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision or any other subsequent decision in this proceeding. 37 C.F.R. § 42.121(e)(2); see *Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

Maxell bears the ultimate burden to show that its motion to amend complies with the requirements of 35 U.S.C. § 316(d)(1), (3) and 37 C.F.R. § 42.121(a)(2), (a)(3), (b)(1), and (b)(2). 37 C.F.R. § 42.121(d)(1). For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears

that Maxell has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend with respect to proposed substitute claims 9–11, and Maxell has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend with respect to proposed substitute claims 12–16. *See* 37 C.F.R. § 42.121(e)(1).

1. Reasonable Number of Substitute Claims

A motion to amend must propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3).

Samsung challenges claims 1–8 of the ’645 patent, and Maxell proposes claims 9–16, as potential substitutes for claims 1–8. Mot. 1. Maxell thus proposes no more than one substitute claim for each challenged claim, and proposes to replace three independent claims and five dependent claims with three independent claims and five dependent claims. Samsung does not oppose Maxell’s proposed amendment on this point. *See generally* Opp.

Based on our review of the current record, Maxell has shown it proposes a reasonable number of substitute claims.

2. Respond to Ground of Unpatentability

A motion to amend must respond to a ground of unpatentability involved in the proceeding. 37 C.F.R. § 42.121(a)(2)(i).

Maxell contends that proposed substitute claims 9–16 respond to the instituted grounds. *See* Mot. 15–19. More specifically, Maxell contends that the proposed substitute claims distinguish over Kim and Fujimura (*see* Pet. 1, 13–18), respectively, in that the substitute claims recite “wherein the detector detects whether a first portion of the first frame contains the pattern portions based on both the first portion and contents in the first frame other than the first portion.” *Id.*

at 15–17; *see also id.* at A1, A2–A3, A4 (App. A). Maxell also contends that proposed substitute claims 11 and 12 distinguish over Kim and Fujimura, respectively, in that the substitute claims recite “wherein the detector detects whether the first portion of the first frame contains the pattern portions based on comparing the first frame with a preceding frame of the one or more frames.” *Id.* at 16–17, 18 (emphasis omitted); *see also id.* at A3 (App. A). Samsung presents no argument that the Motion fails to respond to a ground of unpatentability involved in the proceeding. *See generally* Opp.

Based on our review of the current record, the Motion is responsive to a ground of unpatentability involved in this proceeding.

3. *Scope of Amended Claims*

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii).

Maxell contends that “[e]ach claim amendment in the substitute claims further limits the claims beyond original independent claims 1, 3, and 5, and the substitute claims do not seek to enlarge the scope of the claims of the ’645 patent.” Mot. 13–14. Maxell’s amendments add narrowing limitations to proposed substitute independent claims 9, 11, and 13, as compared to their original independent claims 1, 3, and 5, and therefore, do not enlarge the scope of the challenged independent claims of the ’645 patent. Mot. App. A, A1–A2, A2–A3, A4–A5. Also, Maxell’s amendments to proposed substitute dependent claims 10, 15, and 16 merely change the dependency of challenged dependent claims 2, 7, and 8, and therefore, do not enlarge the scope of those challenged dependent claims. *Id.* at A2, A6.

Samsung contends that “substitute claim 12 deletes all of the substance of original claim 4, removing those features and broadening the claim’s scope in that

regard.” Opp. 1. Maxell’s Motion deletes from proposed substitute dependent claim 12 the limitations reciting “pattern portions are wallpaper areas or no-picture areas having a single color added to left and right of the contents or above and below the contents and displayed.” Mot. App. A, A3–A4. We note these deleted limitations are not added to proposed substitute independent claim 9, from which substitute claim 12 depends. *See id.* at A1–A2. As such, we agree with Samsung’s contention that proposed substitute claim 12 broadens the scope of original claim 4 since “if a substitute claim ‘is broader in *any respect* [it] is considered to be broader than the original claim[] even though it may be narrower in other respects.’” *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231, 1241 (Fed. Cir. 2023) (quoting *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999)); *see also Lectrosonics*, Paper 15 at 6 (“A patent owner may not seek to broaden a challenged claim in any respect that enlarges the scope of the claims of the patent Likewise, a proposed substitute claim may not remove a feature of the claim in a manner that broadens the scope of the claims of the challenged patent.”).

Maxell’s Motion deletes from proposed substitute dependent claim 14 the limitations reciting “a characteristic point detector which detects a level or distribution of at least one of luminance, hue and saturation of the video signal” and “wherein when the no-picture area detector has detected that the pattern portions are no-picture areas, the characteristic point detector detects a level or distribution of at least one of luminance, hue and saturation of the video signal other than the no-picture areas.” Mot. App. A, A5–A6. Samsung contends that proposed substitute claim 14 broadens the scope of original claim 6 by deleting these limitations. Opp. 1–2. We note these deleted limitations are not added to proposed substitute independent claim 9, from which substitute claim 14 depends.

See Mot. App. A, A1–A2. In addition, as Samsung points out, even though “substitute claim 14 is a substitute of original claim 6, which depends from original claim 5,” “substitute claim 14 depends from substitute claim 9, the substitute for original claim 1, rather than from substitute claim 13, the substitute of original claim 5.” Opp. 2 (citing Mot. 3, 11–12). Samsung contends—and we agree—that “[b]y changing the claim from which substitute claim 14 depends, Patent Owner has removed limitations from that claim such as limitation 5.c (‘a no-picture area detector which detects . . . no-picture areas having a single color’), broadening the claim in that regard.” *Id.* (citing Mot. 11). Accordingly, we agree with Samsung that proposed substitute claim 14 broadens the scope of original claim 6. *See Sisvel*, 81 F.4th at 1241.

Based on the current record, we find Maxell’s amendments to proposed substitute claims 12 and 14 appear to broaden the scope of originally challenged claims 4 and 6, respectively.

4. New Matter

A motion to amend may not introduce new subject matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii).

In the Motion, Maxell provides tables ostensibly showing written description support for each limitation of proposed substitute claims 9–16 in the specification of the ’645 patent (*see* Ex. 1001) and U.S. Application No. 11/602,956 (“the ’956 application”) (*see* Ex. 1002, 309–419), from which the ’645 patent issued. *See* Mot. 3–13.

As Samsung points out, the ’645 patent includes a claim of priority to Japanese Patent Application No. JP2005-338000, filed on November 24, 2005. Opp. 2; Ex. 1001, code (30). To the extent the Japanese application constitutes the

“original disclosure” of the ’645 patent, Maxell should set forth support for proposed substitute claims 9–16 in the Japanese application.

Samsung contends that “[f]or many limitations, [Maxell] does not provide written description support and instead states ‘Originally filed claim.’” Opp. 2–3 (citing Mot. at 7, 9, 11, 13). However, “[a]n original claim is part of the disclosure at the time of filing.” *In re Rasmussen*, 650 F.2d 1212, 1214 n.5 (CCPA 1981); *see also In re Anderson*, 471 F.2d 1237, 1238–39 (CCPA 1973) (“Claim 1 . . . is an unamended original claim in this application and therefore, by elementary principles of patent law, to be considered as a part of the original disclosure.”). The proper test for written description support is whether the original disclosures “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the applicant] was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). Here, Samsung’s Opposition does not provide any argument or evidence that the originally filed claims that Maxell cites do not convey with reasonable clarity to those skilled in the art that, as of the filing date, the applicant was in possession of the claimed limitations. *See generally* Opp.

Samsung also argues that Maxell has not shown adequate written description support for the limitation reciting “the detector detects whether a first portion of the first frame contains the pattern portions based on both the first portion and contents in the first frame other than the first portion,” which is recited in each of proposed substitute independent claims 9, 11, and 13. Opp. 3–4 (citing Mot. 4–5, 8, 11). Samsung asserts that even though “[t]he plain meaning of this limitation includes detecting whether the first frame contains pattern portions based on the first frame alone,” Maxell cites for written description support the ’645 patent’s description of a process “consider[ing] two frames: the current frame and ‘the

preceding frame.” *Id.* at 4 (citing Mot. 4–5, 7, 11; Ex. 1001, 18:23–26, 18:33–38, Fig. 33).

We are not persuaded by Samsung’s argument based on its interpretation of the claim limitation at issue. To construe claim terms, we apply the same claim construction standard as would be used by a district court to construe a claim in a civil action involving the validity or infringement of a patent. 37 C.F.R. § 42.100(b). Under that standard, claim terms are given their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history of record. *Id.*; *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc); *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). It appears that Samsung’s interpretation of the limitation as requiring detecting whether the first frame contains pattern portions based on the first frame alone is too restrictive and inconsistent with the plain language of the limitation, which merely recites “based on both the first portion and contents in the first frame other than the first portion.” Rather, we preliminarily determine the plain meaning of the limitation is broader in scope to encompass comparing the first portion of the first frame to the corresponding portion of the preceding frame (i.e., based on the first portion of the first frame) and comparing contents other than the first portion in the first frame to the corresponding portion of the preceding frame (i.e., based on the contents other than first portion in the first frame), as described in the specification and the original disclosure. *See* Mot. 4–5; Ex. 1001, 18:23–49; Ex. 1002, 356–357. In other words, at this juncture, we do not read “based on” to mean “based *only* on.”

We emphasize that our construction of “the detector detects whether a first portion of the first frame contains the pattern portions based on both the first portion and contents in the first frame other than the first portion,” recited in proposed substitute independent claims 9, 11, and 13, is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

Samsung also contends that Maxell has not shown adequate written description support for the limitations of proposed substitute claim 13 reciting “the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit . . . when the pattern portions are the no-picture areas, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions in the first frame are not the no-picture areas.” Opp. 4–5; Mot. App. A, A4–A5. Proposed substitute claim 13 also recites “a no-picture area detector which detects whether the pattern portions are no-picture areas having a single color.” Mot. App. A, A4. Based on the current record, we preliminarily find Samsung’s contention persuasive for the following reasons.

For written description support for the foregoing limitations of proposed substitute claim 13, Maxell’s Motion cites portions of the Specification describing the “Fourth Embodiment” of the invention. Mot. 12 (citing Ex. 1001, 22:58–23:12; Ex. 1002, 368–369); Ex. 1001, 20:11. According to the Specification,

[i]f the pattern portions are formed of *single color of black*, correction causes a less change in the pattern portions as compared with the case where the pattern portions are formed of *patterns or a single chromatic color*. When it is detected that pattern portions have been added to the left and right of contents, it is detected in the present embodiment

whether the pattern portions are black no-picture areas. *If the pattern portions are black no-picture areas, then the video signal is corrected.*

Id. at 20:14–22 (emphasis added). The Specification further describes setting the “wallpaper flag” and “no-picture flag” to distinguish between a wallpaper area portion, i.e., a portion that is contained in the pattern portions and that is not a black no-picture area portion, and a black no-picture area portion. *Id.* at 20:20–25, 22:63–23:16, Fig. 44 (S4401, S4402). As such, this embodiment describes correcting the video signal when the pattern portions are *black no-picture areas* and not correcting the video signal when the pattern portions are *not black no-picture areas*. However, this embodiment does not describe correcting the video signal when the pattern portions are no-picture areas of *any other single color* (e.g., red) and not correcting the video signal when the pattern portions are not no-picture areas of *any other single color*, as required by the limitations of proposed substitute claim 13 at issue. Even if this would have been obvious over what is expressly disclosed in the original disclosure, “[t]he question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (citing *Martin v. Mayer*, 823 F.2d 500, 504 (Fed. Cir. 1987)).

We note that the foregoing limitations of proposed substitute claim 13 were substantially recited in originally filed claim 5 in the original disclosure of the ’645 patent. *See* Ex. 1002, 376–377. Referring to the Specification of the ’645 patent, Samsung argues that determining whether a no-picture area is any single color other than black “is *impossible* in the disclosed embodiments because

‘pattern portion detector 1511’ receives only the luminance signal, not the R-Y or B-Y signals or other signals.” Opp. 5 (citing Ex. 1001, Figs. 27, 37, 16:28–31). Based on our review of the specification, we preliminarily find Samsung’s argument persuasive. As such, even though the originally filed claim recites the limitations at issue, the original disclosure of the ’645 patent does not appear to “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the applicant] was in possession of *the invention*” claimed in proposed substitute claim 13. *Vas-Cath*, 935 F.2d at 1563–64. Based on the current record, we preliminarily determine Maxell’s proposed substitute claim 13 lacks written description support in the original disclosure of the ’645 patent and introduces new matter.

For proposed substitute claims 15 and 16, by virtue of their dependency from substitute independent claim 13, we preliminarily determine that Maxell has not demonstrated sufficient written description support for these proposed substitute claims in the original disclosure of the ’645 patent for the same reason.

B. Unpatentability Arguments by Petitioner

Petitioner bears the ultimate burden to show that any proposed substitute claims are unpatentable. 37 C.F.R. § 42.121(d)(2). For the reasons discussed below, and based on the current record,¹ Samsung has shown a reasonable likelihood that proposed substitute claims 9–16 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

¹ We express no view on the patentability of originally challenged claims 1–8 in this Preliminary Guidance. Instead, we focus on limitations added to originally challenged claims 1–8 in Maxell’s Motion.

We note that Maxell will have the opportunity to respond to the evidence cited in Samsung's Opposition and this Preliminary Guidance by filing a Reply or, alternatively, by filing a Revised Motion in this proceeding.

1. Lack of Written Description

Based on the current record, it appears that there is a reasonable likelihood of establishing that proposed substitute claims 13, 15, and 16 are unpatentable under pre-AIA 35 U.S.C. § 112 ¶ 1 for lacking written description.²

We preliminarily found above (*see supra* § II.A.4) that Maxell failed to meet its burden of showing that substitute claims 13, 15, and 16 do not add new matter because Maxell does not appear to have sufficiently identified adequate written description support for the limitations recited in these substitute claims in the original disclosure of the '645 patent. Even if we placed the burden on Samsung to prove unpatentability based on its written description arguments, we preliminarily find that Samsung appears to have met its burden for the same reasons discussed above. *See Opp.* 4–5.

Specifically, for the reasons discussed above with regard to proposed substitute independent claim 13, we tentatively agree with Samsung that the limitations reciting “the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit . . . when the pattern portions are the no-picture areas, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions in the first frame are not the no-picture areas,” wherein “no-pictures hav[e] a single color,” appear to

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102, 103, and 112, effective on March 16, 2013. Because the application from which the '645 patent issued was filed before this date, the pre-AIA versions of §§ 102, 103, and 112 apply to this Preliminary Guidance.

lack written description support. Opp. 4–5; Mot. App. A, A4–A5. For proposed substitute claims 15 and 16, by virtue of their dependency from substitute claim 13, we preliminarily find that Samsung appears to have met its burden to show that these claims lack written description support for the same reasons.³

2. Obviousness

Samsung contends proposed substitute claims 9–12 and 14 are obvious over Fujimura⁴ and Dua.⁵ *See* Opp. 6–19. Based on the current record, Samsung appears to have shown a reasonable likelihood that proposed substitute claims 9–12 and 14 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Fujimura and Dua.

For purposes of this Preliminary Guidance, we focus on the amendments proposed in the Motion, although we also consider the limitations from the original challenged claims as needed to address the parties’ disputes raised in the Motion and the Opposition. When referring to the limitations of the proposed substitute claims, we use the bracketed designations of the limitations used by Samsung in the Opposition. *See* Opp. v-vii.

³ In its Opposition, Samsung focuses its written description arguments on proposed substitute independent claims 9, 11, and 13, but for purposes of this Preliminary Guidance we infer that Samsung considers the proposed substitute dependent claims to stand or fall with these arguments. That said, we note, for example, that proposed substitute dependent claim 16 recites, “the no-picture areas have a black color or a white color,” and encourage the parties to consider how such narrowing limitations impact Samsung’s written description arguments.

⁴ U.S. Patent No. 5,808,697, issued Sept. 15, 1998 (Ex. 1005, “Fujimura”).

⁵ US 2006/0258289 A1, published Nov. 16, 2006, filed May 12, 2005 (Ex. 1036, “Dua”).

i. “portable telephone” and “battery”

Proposed substitute independent claims 9 and 11 each recite a “portable telephone” in the preamble (i.e., [9.pre], [11.pre]) and “a battery which supplies power for components included in the portable telephone” (i.e., [9.a], [11.a]). Mot. App. A, A1, A2. Samsung contends Dua’s “generally portable” “media player 100 with cellular phone capability” including “rechargeable lithium polymer battery” teaches or suggests these elements. Opp. 6–7 (citing Ex. 1036 ¶¶ 57–59, 94, 213, Figs. 2A, 2C, 12). Based on the current record, we are preliminarily persuaded by Samsung’s contention.

ii. “video signal comprising one or more frames”

Proposed substitute independent claims 9 and 11 each recite “a video signal comprising one or more frames” (i.e., [9.b], [11.b]). Mot. App. A, A1, A2. Samsung contends Fujimura teaches or suggests this limitation because “Fujimura discloses ‘video signals’ with ‘a series of frames’ and ‘consecutive images.’” Opp. 7 (citing Ex. 1005, Abstract, 1:3–6, 14:60–15:4, 3:56–61). Based on the current record, we are preliminarily persuaded by Samsung’s contention.

iii. “detector”

Proposed substitute independent claims 9 and 11 each recite “a detector which detects whether pattern portions other than contents are contained in a first frame of the one or more frames in the video signal input to the input unit, wherein the detector detects whether a first portion of the first frame contains the pattern portions based on both the first portion and contents in the first frame other than the first portion” (i.e., [9.c], [11.c]). Mot. App. A, A1, A2–A3.

Maxell argues that “Fujimura does not detect whether pattern portions other than contents are contained, instead it detects whether an image is of a particular

format, i.e., a letterbox format” and “Fujimura is completely silent on pattern detection and fails to disclose or refer to pattern detection at all.” Mot. 17 (citing Ex. 1005, 13:50–58).

In the Opposition, Samsung contends Fujimura discloses “a given frame (*a first frame*) may contain ‘black non-picture bands above and below’ the ‘picture area,’ also referred to as ‘letterbox’ bands (*pattern portions other than contents*).” Opp. 7 (citing Ex. 1005, 13:42–49, 1:51–55, Fig. 18); *see also id.* at 12 (addressing [11.c]). Samsung argues that “Fujimura discloses determining whether each scanning line in the frame has a number of ‘bright pixels’ or ‘dark pixels’ above a certain bright-pixel threshold or dark-pixel threshold” so as to “determine[] whether the frame contains letterbox bands above and below the picture area (*detects whether pattern portions other than contents are contained in a first frame*).” *Id.* at 7–8 (citing Ex. 1005, 14:7–36, 14:46–50, 13:53–58; Pet. 41–42). Samsung maps “[t]hat area above and below the picture area, collectively, [to] *a first portion of the first frame that contains the letterbox bands (pattern portions)*.” *Id.* at 8. Samsung also contends that since Fujimura’s “process analyzes every scanning line in the frame,” it is based on both the letterbox bands and the picture area (*based on both the first portion and contents in the first frame other than the first portion*).” *Id.* (citing Ex. 1005, 14:13–36). In response to Maxell’s argument that Fujimura does not detect whether pattern portions other than contents are contained, Samsung points out that “the [the ’645] patent describes letterbox bands as patterns.” *Id.* at 8 (citing Ex. 1001, 16:7–12, 20:17–20, Figs. 36A–B, 45A–B).

Based on the current record, we preliminarily determine Samsung’s arguments that Fujimura teaches or suggests limitations [9.c] and [11.c] are more persuasive.

Proposed substitute independent claim 11 and proposed substitute dependent claim 12 (depending on proposed substitute independent claim 9) each recite “wherein the detector detects whether the first portion of the first frame contains the pattern portions based on comparing the first frame with a preceding frame of the one or more frames” (i.e., [11.d], [12]). Mot. App. A, A3.

Maxell argues that “Fujimura is silent as to comparing a first frame with a preceding frame of the one or more frames.” Mot. 18–19 (citing Ex. 1005, 6:11–18, 7:27–30, 15:61–63).

In the Opposition, Samsung contends Fujimura teaches or suggests this limitation because Fujimura “discloses that its process for detecting letterbox bands ‘can be adapted to change the starting and ending line numbers only if the change persists for a certain number of consecutive images’ (*based on comparing the first frame with a preceding frame of the one or more frames*).” Opp. 13 (quoting Ex. 1005, 14:66–15:2); *see also id.* at 15 (addressing claim 12). Samsung argues that “[d]etermining whether a change in the starting and ending line numbers has persisted for consecutive images necessarily (inherently) includes *comparing* the current frame (*the first frame*) to a *preceding frame*, either directly or indirectly, to determine if the change exists in both frames or not.” *Id.* Samsung also argues it “would have been obvious to a [person of ordinary skill in the art] to directly compare the current frame (*the first frame*) with the previous frame (*a preceding frame*) in implementing Fujimura’s disclosure of determining whether a change in the starting and ending line numbers ‘persists for a certain number of consecutive images.’” *Id.* (citing Ex. 1005, 14:66–15:2). Samsung argues that a person of ordinary skill in the art would be motivated to do so because of “a desire to choose a straightforward and common sense

implementation of determining equivalence of the line numbers of those two frames, as Fujimura discloses.” *Id.* at 13–14 (citing Ex. 1035 ¶ 37).

Based on the current record, we preliminarily determine Samsung’s arguments that Fujimura teaches or suggests limitations [11.d] and [12] are more persuasive.

iv. “corrector”

Proposed substitute independent claim 9 recites limitation [9.d], i.e., “a corrector which, when controlled by a controller, corrects the video signal input to the input unit.” Mot. App. A, A1. Proposed substitute independent claim 11 similarly recites limitation [11.f], i.e., “a corrector which, when controlled by a controller, changes correction characteristics according to a result of detection that is output from the characteristic point detector, and corrects the video signal input to the input unit.” *Id.* at A3.

Maxell argues that “Fujimura is silent as to any CPU used to implement the claimed corrector, instead at best describing that the component circuits could be combined in an application-specific integrated circuit (ASIC) or general-purpose processor with the specific example of a digital signal processor (DSP).” Mot. 18 (citing Ex. 1005, 4:6–13).

In the Opposition, Samsung argues that Fujimura discloses the “corrector” limitation, referring back to its Petition. Opp. 9 (citing Pet. 43–48); *see also id.* at 14 (addressing limitation [11.f]). Samsung further contends that, to the extent Maxell argues that “the ‘corrector’ limitation of substitute claim 9 is a means-plus-function limitation with a corresponding structure of ‘CPU 7 or equivalents thereof,’” “Fujimura discloses that primary mapper 12 and luminance contrast enhancer 2 (each a *corrector*) may be implemented in ‘a general-purpose

processor,’ which is at least an equivalent of a CPU, also a general-purpose processor.” *Id.* (citing Mot. 5; Ex. 1005, 3:63–4:11; Pet. 45; Ex. 1035 ¶ 22).

Based on the current record, we preliminarily determine Samsung’s arguments that Fujimura teaches or suggests limitations [9.d] and [11.f] are more persuasive. In particular, we preliminarily agree with Samsung’s argument that even if the “corrector” limitation is a means-plus-function limitation with a corresponding structure of “CPU 7” or equivalents thereof, Fujimura’s general-purpose processor implementing primary mapper 12 and luminance contrast enhancer 2 would teach or fairly suggest the claimed corrector.

v. “*controller*”

Proposed substitute independent claim 9 recites limitation [9.e], i.e., “the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit when the pattern portions are not contained in the first frame, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions are contained in the first frame.” Mot. App. A, A1–A2.

The parties dispute how Fujimura’s disclosures can be mapped to this limitation. The cited portions of Fujimura describe “a letterbox signal detector to detect video signals with non-picture bands above and below the picture area, so that contrast enhancement processing can be limited to the picture area,” and letterbox control signals that “restrict the luminance and chrominance contrast enhancement processing . . . to the picture area between the non-picture bands.” Ex. 1005, 2:48–52, 13:64–14:1; *see also id.* at 14:46–59 (“[T]he calculation of average values, construction of histograms, and other contrast enhancement operations . . . are restricted to the area between the starting and ending lines of the picture area, including the starting line but not the ending line.”).

Maxell contends in the Motion that “Fujimura in operation acts to correct the video signal, even when the letterbox portions are detected.” Mot. 18 (citing Ex. 1005, 2:48–52, 13:64–14:6).

On the other hand, Samsung contends in the Opposition that “when there is a picture area in the first frame (*when the pattern portions are not contained in the first frame*), Fujimura correct[s] the video signal” and “when there is a letterbox band in the frame (*when the pattern portions are contained in the first frame*), Fujimura does not correct the video signal.” Opp. 10 (citing Ex. 1035 ¶ 23). Samsung argues that Maxell’s contention is based on “a faulty claim interpretation.” *Id.* (citing Mot. 18). Samsung argues that since “Fujimura discloses restricting contrast enhancement to the picture area, meaning it does *not* perform contrast enhancement on the letterbox bands, *i.e.*, when the letterbox portions are detected,” “‘when the pattern portions are contained in the first frame,’ Fujimura does ‘not [] correct’ the video signal, as recited by limitation 9.e.” *Id.* Samsung argues that “[t]he plain meaning of [limitation [9.e]] encompasses not correcting the pattern portions of the frame and correcting the content portions.” *Id.*

Based on the current record, we do not agree with Samsung’s interpretation of “the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit when the pattern portions are not contained in the first frame, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions are contained in the first frame” as generally encompassing the corrector not correcting the pattern portions of the frame and correcting the content portions of the frame. It appears that Samsung’s interpretation is not consistent with the plain and ordinary meaning of the claim language reciting “not to correct the video signal when the pattern portions are

contained in the first frame,” which is different from “not to correct only the pattern portions when the pattern portions are contained in the first frame.” Samsung’s argument referring to Maxell’s claim construction position in the district court litigation is not persuasive at least because Samsung does not argue that the district court has determined claim construction accordingly. *See* Opp. 10–11. In addition, Samsung’s argument that “the [’645] patent’s preferred embodiments include correcting some parts of a video signal and not correcting other parts” is not persuasive because it is not commensurate in scope with the claim. Opp. 11–12.

We emphasize that our construction of “the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit when the pattern portions are not contained in the first frame, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions are contained in the first frame” recited in limitation [9.e] is preliminary, and invite the parties to address this issue, as well as issues that depend on this preliminary construction, in further briefing and/or in a revised motion.

Even though we decline at this stage to adopt Samsung’s interpretation of limitation [9.e], based on the disclosures of Fujimura identified by Samsung, we preliminarily determine that there is a reasonable likelihood that Fujimura teaches or at least fairly suggests limitation [9.e]. As noted above, Fujimura describes “a letterbox signal detector to detect video signals with non-picture bands above and below the picture area, so that contrast enhancement processing can be limited to the picture area,” and letterbox control signals that “restrict the luminance and chrominance contrast enhancement processing . . . to the picture area between the non-picture bands.” Ex. 1005, 2:48–52, 13:64–14:1. In short, Fujimura discloses performing contrast enhancement processing in the picture area

and not performing contrast enhancement processing in non-picture bands above and below the picture area. A person of ordinary skill in the art would have recognized that Fujimura teaches or at least fairly suggests “correct[ing] the video signal input to the input unit when the pattern portions are not contained in the first frame” by disclosing performing contrast enhancement processing in the picture area. It appears that Fujimura also fairly suggests “not [] correct[ing] the video signal when the pattern portions are contained in the first frame” because Fujimura discloses detecting non-picture bands above and below the picture area and not performing contrast enhancement processing in the non-picture bands and it would have been obvious to simply *not perform* contrast enhancement processing in the picture areas between the non-picture bands as well, i.e., to do nothing as claimed. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”); *see also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Proposed substitute independent claim 11 similarly recites limitation [11.g], i.e., “the controller which controls the corrector to cause the corrector to change the correction characteristics in the corrector when the pattern portions are not contained in the first frame, and which controls the corrector to cause the corrector not to change the correction characteristics in the corrector when the pattern portions are contained in the first frame.” Mot. App. A, A3.

Samsung contends that “Fujimura discloses enhancing luminance using a ‘mapping function’ that defines a mapping of each input luminance value to an output luminance value (*correction characteristics*).” Opp. 14 (citing Pet. 43–44; Ex. 1005, Figs. 3A–B). Samsung argues that “when there is a picture area in the frame (*when the pattern portions are not contained in the first frame*), Fujimura

corrects the video signal and the mapping function (*correction characteristics*) is *changed*, from the previous image and from block to block within the image.” *Id.* (citing Ex. 1035 ¶ 42). Samsung further argues that “when there is a letterbox band in the frame (*when the pattern portions are contained in the first frame*), Fujimura does not correct the video signal and the mapping function (*correction characteristic*) is *not changed*.” *Id.* at 15 (citing Pet. 56–57).

Based on the disclosures of Fujimura identified by Samsung and for the same reasons discussed above in connection with limitation [9.e], we preliminarily determine that there is a reasonable likelihood that Fujimura teaches or at least fairly suggests limitation [11.g].

vi. Claim 14

Maxell contends that “Substitute Claim 14 distinguishes over Fujimura in its specific recitation of what is compared.” Mot. 19.

In the Opposition, Samsung contends with respect to limitation [14.a] that “Fujimura detects the starting line of the picture area in the current frame by detecting that its number of bright pixels is above a bright-pixel threshold, *i.e.*, that the line has a sufficient number of bright pixels (*a first luminance level detected in the first portion of the first frame*).” Opp. 15 (citing Ex. 1005, 14:13–22).

Samsung further contends that “Fujimura discloses determining the same starting line number for two consecutive frames” and “[d]etecting the starting line of the picture area at the same line number in the previous frame therefore detects *a second luminance level detected in a second portion, corresponding to the first portion, of a preceding frame*.” *Id.* at 15–16 (citing Ex. 1005, 14:66–15:2; Ex. 1035 ¶ 46). Samsung argues that “[d]etermining that the starting line number is the same between two consecutive frames at least indirectly determines that each of those lines has a number of bright pixels (*luminance level*) that is above the

bright-pixel threshold and therefore within the range above the threshold,” thereby “at least indirectly determin[ing] that the *difference between the luminance level* of each of those lines is not more than that range.” *Id.* at 16 (citing Ex. 1035 ¶ 47).

With respect to limitation [14.b], Samsung contends that “Fujimura detects the ending line of the picture area in the current frame by detecting that its number of dark pixels is below a dark-pixel threshold, *i.e.*, that it is too bright to be part of the lower letterbox band (*a third luminance level detected in the contents in the first frame other than the first portion*).” Opp. 16 (citing Ex. 1005, 14:25–36). Samsung further contends that “Fujimura discloses determining the same ending line number for two consecutive frames” and “[d]etecting the ending line of the picture area at the same line number in the previous frame therefore detects *a fourth luminance level detected in contents in the preceding frame other than the second portion*.” *Id.* (citing Ex. 1035 ¶ 48). Samsung argues that “[d]etermining that the ending line number is the same between two consecutive frames at least indirectly determines that each of those lines has a number of bright pixels (*luminance level*) that is within a range of brightness that disqualifies them as being part of the lower letterbox band,” thereby “at least indirectly determin[ing] that the difference between the luminance level of each of those lines is not more than that range.” *Id.* at 17 (citing Ex. 1035 ¶ 49).

We have reviewed the disclosures of Fujimura and they appear to support Samsung’s arguments. Based on the current record, we preliminarily determine Samsung’s arguments that Fujimura would have taught or at least fairly suggested to the relevant artisan the newly added limitations of proposed substitute claim 14 are more persuasive.

vii. Remaining Claim Limitations

As for proposed substitute dependent claim 10, Samsung relies on its arguments set forth in its Petition. Opp. 12 (citing Pet. 48–51).

As for limitation [11.e] reciting “a characteristic point detector . . . ,” Samsung relies on its arguments set forth in its Petition. Opp. 14 (citing Pet. 52, 48–50).

Maxell does not separately address these limitations in its Motion. *See generally* Mot.

viii. Reason to Combine Fujimura and Dua

Samsung provides rationales to combine the teachings of Fujimura and Dua to support its obviousness argument. *See* Opp. 17–19. For example, Samsung reasons that because Fujimura discloses that “it is desirable to account for ‘non-picture bands at the top and bottom’ of the screen (*i.e.*, letterbox bands) so that enhancement mapping functions are not ‘calculated or selected incorrectly,’” a person of ordinary skill in the art would have been motivated “to include Fujimura’s letterbox detection and correction logic functionality in Dua.” Opp. 18 (citing Ex. 1005, 1:51–55, 2:48–51). Samsung also reasons that because “Dua discloses that its media player may ‘browse movie trailers,’ which a [person of ordinary skill in the art] would have understood often are displayed with letterbox bands, especially given the aspect ratio of Dua’s display 102,” a person of ordinary skill in the art would have been motivated “to include Fujimura’s video correction that accounts for letterbox bands.” *Id.* (citing Ex. 1036 ¶ 168, Figs. 2A, 2C; Ex. 1035 ¶ 52). Samsung further contends that combining the functionality of Fujimura with Dua’s media player “would have been within the skill and knowledge of a [person of ordinary skill in the art], would have led to predictable

results, would have created a reasonable expectation of success, and would have been compatible with Dua.” *Id.* at 17.

Based on the current record, Samsung has shown a reasonable likelihood that the combination of Fujimura and Dua would have rendered obvious proposed substitute claims 9–12 and 14, which include the limitations of original claims 1–3 and the new limitations added by Maxell in the Motion.

We acknowledge that Maxell has not yet had the opportunity to address fully Samsung’s arguments with regard to the combination of Fujimura and Dua. Maxell will have the opportunity to do so by filing a reply to Samsung’s Opposition (or, alternatively, by filing a Revised Motion to Amend).

3. Patent Eligible Subject Matter

Samsung contends that the proposed substitute claims are directed to patent ineligible subject matter under § 101. *See* Opp. 19–25. Based on the current record, it appears that Samsung has not shown a reasonable likelihood that proposed substitute claims 9–16 would be unpatentable under 35 U.S.C. § 101 due to a lack of subject matter eligibility.

The Supreme Court’s two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). In addition, the Office published revised guidance for evaluating subject matter eligibility under 35 U.S.C. § 101, specifically with respect to applying the *Alice* framework. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Office Guidance”); *see* USPTO Memorandum, *Reminders on Evaluating Subject Matter Eligibility of Claims Under 35 U.S.C. § 101* (Aug. 4, 2025).

If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter), then the first

inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 573 U.S. at 217. As part of this inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016). Per Office Guidance, this first inquiry has two prongs of analysis: (i) does the claim recite a judicial exception (e.g., an abstract idea), and (ii) if so, is the judicial exception integrated into a practical application. 84 Fed. Reg. at 54. Under the Office Guidance, if the judicial exception is integrated into a practical application, the claim is patent eligible under § 101. 84 Fed. Reg. at 54–55. If the claim is directed to a judicial exception (i.e., recites a judicial exception and does not integrate the exception into a practical application), the next step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 573 U.S. at 217; 84 Fed. Reg. at 56.

We consider proposed substitute claims 9–16 under the Office Guidance, which is now incorporated in the Manual of Patent Examining Procedure (“MPEP”) at Section 2106 (9th ed. rev. 01.2024 Nov. 2024). Under MPEP § 2106, if the claimed invention falls within one of the statutory categories under 35 U.S.C. § 101 (Step 1), we first look to whether a claim recites:

(1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (“Step 2A, Prong One”) (*see* MPEP § 2106.04); and

(2) additional elements that integrate the judicial exception into a practical application (“Step 2A, Prong Two”) (*see* MPEP §§ 2106.04, 2106.04(d), 2106.05(a)–(c), (e)–(h)).

Only if the claim (1) recites a judicial exception, and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, to whether the claim:

(3) adds a specific limitation beyond the judicial exception that is not well-understood, routine, and conventional in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See MPEP § 2106.05.

For this Preliminary Guidance, we bypass Step 2A, Prong One to focus on what we preliminarily view as a dispositive issue. Samsung contends that “[t]he substitute claims can be boiled down to two steps: (1) determining whether a video signal includes a pattern portion; and (2) based on that determination, either correcting the video or not,” and “therefore are directed to the abstract idea of potentially correcting video data based on pattern detection.” Opp. 20. Samsung argues that “pattern recognition is [an] abstract idea” and “[the] human mind can manually detect patterns in an image, such as the black bars of the patent’s Figures 36A–B.” *Id.* at 20, 22. Even if we were to agree with Samsung and determine that the proposed substitute claims recite a judicial exception (e.g., abstract mental process of pattern recognition), we would conclude that such judicial exception is integrated into a practical application. To determine whether the judicial exception is integrated into a practical application, we identify whether there are “*any additional elements recited in the claim beyond the judicial exception(s)*” and evaluate those elements to determine whether they integrate the judicial exception into a practical application. 84 Fed. Reg. at 54–55 (emphasis added); *see also* MPEP § 2106.05(a)–(c), (e)–(h). One way to do this is for such additional

element(s) to reflect an improvement to the functionality of a computer or other technology or technical field. *See* MPEP § 2106.05(a); 84 Fed. Reg at 55.

Maxell's proposed substitute claims recite additional elements beyond the judicial exception. For example, proposed substitute independent claim 9 recites the following additional elements:

a corrector which, when controlled by a controller, corrects the video signal input to the input unit; and

the controller which controls the corrector to cause the corrector to correct the video signal input to the input unit when the pattern portions are not contained in the first frame, and which controls the corrector to cause the corrector not to correct the video signal when the pattern portions are contained in the first frame.

Mot. App. A, A1–A2 (underlines and strikethrough omitted). Proposed substitute independent claims 11 and 13 similarly recite additional elements of a “corrector” and a “controller.” *See id.* at A3, A4–A5.

The specification of the '645 patent states that the invention provides a technical solution to the technical problem of performing picture quality correction when wallpapers or black no-picture areas are added to the left and right sides of the video contents:

When converting contents having an aspect ratio of, for example, 4:3 to a video signal having an aspect ratio of 16:9 and corresponding to an image which is long sideways, for example, in a broadcasting station, wallpapers are added to the left and right of the contents sometimes. If such a video signal is subjected to picture quality correction, then luminance and colors of the wallpaper portions are changed according to the contents of the video signal and consequently there is a risk that the image becomes rather hard to watch and the convenience in user's use becomes worse.

In addition, if black no-picture areas are added to the left and right sides of the contents having the aspect ratio of 4:3, luminance and color information of the black no-picture areas are confused. This

results in a problem that average values of luminance and color of the 4:3 contents themselves cannot be calculated accurately.

Therefore, an object of the present invention is to provide a video processing apparatus and a mobile terminal apparatus improved in convenience in use.

A video processing apparatus according to the present invention includes a detector which detects whether pattern portions such as wallpaper portions having a pattern or the like or no-picture area portions which have a single color are contained besides contents in a video signal input thereto, and a corrector which corrects the video signal. *If the pattern portions are contained in the input video signal, the corrector is controlled so as not to correct the video signal.*

Ex. 1001, 1:41–67 (emphasis added).

Even if we were to determine that the “detector” limitations (e.g., “detect[ing] whether a first portion of the first frame contains the pattern portions based on both the first portion and contents in the first frame other than the first portion” as recited in proposed substitute claim 9) represent abstract mental processes, it is our preliminary view that the combination of additional elements in proposed substitute claim 9 applies these features in a meaningful way to improve a video processing apparatus and a mobile terminal apparatus performing picture quality correction. We also preliminarily determine such combination of additional elements integrates any recited abstract idea into a practical application. Based on our understanding of proposed substitute claim 9, this is not a situation where substitute claim 9 is drafted to monopolize on the features of correcting video signal; rather, substitute claim 9 applies these features in a meaningful way to provide the technical solutions to the technical problems in picture quality correction of a video signal discussed above (e.g., addressing problems of picture quality correction when wallpapers or black no-picture areas are added to the left and right sides of the video contents). In other words, although the claimed

controller controls the corrector based on pattern recognition, which recites the abstract idea, it integrates the recited abstract idea into a practical application by using it to improve picture quality correction of a video signal, which reflects a technological improvement to a technological problem. Thus, we preliminarily determine the proposed substitute claims integrate the allegedly abstract mental process of pattern recognition into a practical application.

Because we determine that the proposed substitute claims recite limitations that integrate any recited abstract ideas into a practical application, our analysis ends and we need not move to Step 2B.

Accordingly, based on the current record, we preliminarily determine that Samsung has not established a reasonable likelihood that proposed substitute claims 9–16 are patent ineligible because they are directed to an abstract idea without significantly more.

4. Summary

In summary, based on the current record, we preliminarily determine that Samsung has shown a reasonable likelihood that proposed substitute claims 9–16 are unpatentable.

III. CONCLUSION

This concludes our Preliminary Guidance. Maxell has the option (1) to file a reply to this Preliminary Guidance or (2) to file a revised MTA by DUE DATE 3. 37 C.F.R. § 42.121(e)(3), (f); Paper 18. Maxell's reply or revised MTA may only respond to this Preliminary Guidance or Samsung's Opposition and may be accompanied by new evidence (including declarations). 37 C.F.R. § 42.121(e)(3). Samsung has the option to file a sur-reply responsive to this Preliminary Guidance or Maxell's reply. 37 C.F.R. § 42.121(e)(3). Samsung may also file a reply to the Preliminary Guidance in the case Maxell does not file a reply or revised MTA.

37 C.F.R. § 42.121(e)(4). If Maxell files a revised MTA, that motion replaces the original MTA and Samsung may file an opposition to the revised MTA in accordance with any new scheduling order issued after the filing of a revised motion to amend. 37 C.F.R. § 42.121(f)(1)–(3).

In addition, Maxell is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an IPR, including subsequent to the issuance of the Final Written Decision. We draw Maxell’s attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Maxell chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Maxell of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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FOR PETITIONER

Robert Buergi
James Heintz
Chris Katsantonis
DLA PIPER LLP (US)
robert.buergi@dlapiper.com
jim.heintz@dlapiper.com
chris.katsantonis@dlapiper.com

FOR PATENT OWNER

Scott Kelly
Kirk Sigmon
Ross Dannenberg
KELLDANN LAW PLLC
scott@kelldann.com
kirk@kelldann.com
ross@kelldann.com