UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

MAXELL, LTD.,

Patent Owner

Inter Partes Review No.: IPR2024-00867

U.S. Patent No. 10,176,848

PETITIONERS' RESPONSE TO PATENT OWNER'S REQUEST FOR AUTHORIZATION TO FILE MATERIALS FROM RELATED MATTERS

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I. INTRODUCTION

Petitioner opposes PO's request as to four of the five patents and their file histories that PO seeks to submit: U.S. Patent Nos. 11,094,350, 11,948,605, 11,727,960, and 10,418,069 (EX2033-EX2038, EX2041, and EX2042). For those patents and their file histories, the Board should deny PO's request, or if submitted, they should be given no weight. First, these four patents fall outside the scope of the Board's Order (Paper 37) because they are neither related matters under 37 C.F.R. § 42.8(b)(2) nor "developments." Second, PO has waived its arguments as to these patents and their file histories given that they all issued before the Petition and PO could have raised them in any one of its prior filings. Third, the Board has already rejected in its Institution Decision relevance arguments similar to those that PO makes in its request. *See* POPR at 3-12; Institution Decision (Paper 9) at 15-20. There is no basis to now submit these materials.

As to the fifth patent that is the subject of PO's request—U.S. Patent No. 12,400,685 ("the '685 patent")—and its file history (EX2039 and EX2040), Petitioner agrees that they should be submitted, but not for the purpose that PO argues in its request. Instead, they should be admitted because they go to PO's credibility in this and other IPR proceedings. The '685 patent is a continuation of the '848 patent, the subject of this IPR. Unlike the other patents PO seeks to submit, the '685 patent was still being prosecuted while these proceedings were pending.

PO, however, never disclosed the '685 patent prosecution in this IPR, and the evidence indicates that PO never disclosed these IPR proceedings to the '685 patent's Examiner. *See generally*, EX2039 and EX2040. PO cannot credibly deny that it knew each proceeding is relevant to the other, yet PO kept the Board, the Examiner, and Petitioner, in the dark. Even more concerning, the arguments PO made to the Examiner to secure the allowability of its "substantially similar" '685 patent claims directly contradict the infringement arguments PO made for the '848 patent during the recent District Court trial. PO did not disclose that to the Examiner either. The '685 patent materials do not prove what PO argues in its request, but they do reflect on PO's credibility, especially when considered in combination with the numerous contradictory positions that PO has taken in other IPR proceedings. The '685 materials should therefore be admitted for this limited purpose.

II. DISCUSSION

A. Four of the Five Patents That Are the Subject of PO's Request Are Not Within the Scope of the Board's Order.

Four of the five patents and file histories PO proffers (all but the '685 patent) should not be admitted because they are not within the scope of the Board's Order.[1]

[1] The exhibits falling outside the scope of the Order are EX2033, EX2034, EX2035, EX2036, EX2037, EX2038, EX2041, and EX2042.

PO did not identify any of these patent proceedings as related matters in its mandatory notices (*see* Paper 5). PO's attempt to submit these patents and their file histories is thus not within the Order's express instruction to submit materials only from proceedings that are "identified as a related matter under 37 C.F.R. § 42.8(b)(2)." *See* Order (Paper 37) at 1. PO's Request ignores the "related matter" requirement. PO Request (Paper 39) at 1-2.

In addition, these four patents and file histories do not qualify as "developments regarding adjudications of validity or patentability" in related proceedings. Order (Paper 37) at 1 (emphasis added). The four patents all issued before Petitioners filed their May 2024 Petition and before PO filed its Preliminary Response to the Petition (in August 2024):

Patent	Issue Date
U.S. Patent No. 11,094,350 (EX2033)	Aug. 17, 2021
U.S. Patent No. 11,948,605 (EX2035)	Apr. 2, 2024
U.S. Patent No. 11,727,960 (EX2037)	Aug. 15, 2023
U.S. Patent No. 10,418,069 (EX2041)	Sept. 17, 2019

None of these patents or their file histories are a "development" in any sense. The Board should reject PO's request as to these materials.

B. PO Waived Its Arguments Regarding the Proffered Materials.

The Board should also reject PO's request as to these four patents and file histories because PO has waived its arguments as to those materials. PO argues that

each exhibit "illustrate[s] the Office's prior consideration by the examiner of prior art from the Petitioner . . . in allowing substantially similar claims." PO Request (Paper 39) at 3. PO made this exact argument about the '848 patent reexamination history in its POPR. *See* POPR at 3-11. It is undisputed that PO had access to the four patents and their file histories at the time it filed its POPR in August 2024. Yet PO chose not to raise any of them in the POPR or in subsequent filings (e.g., the POR in January 2025 or PO's Sur-Reply in May 2025). PO has therefore waived these arguments. *See* Scheduling Order (Paper 10) at 9 (discussing waiver).

C. The Board Has Already Rejected PO's Arguments.

The Board should reject PO's request as to the four patents and file histories for the additional reason that the Board has already considered and rejected the relevance arguments that PO seeks to revive here. PO's request advances the same argument that PO made in the POPR about prior art that was previously "considered" in the '848 patent reexamination file history. *See* POPR at 3-11. The Board expressly rejected these arguments. *See* Institution Decision (Paper 9) at 17 (rejecting PO's arguments, stating that prior art being "listed on the information disclosure statement among approximately 50 other references… does not allow us to evaluate the extent to which the Examiner may have substantively considered" the reference). PO fails to show how consideration of any of these materials—which likewise show only that some prior art references were listed in other patents' information disclosure

statements—would prove its already-rejected argument to a greater extent than the alleged evidence that the Board already considered, or would lead to any different result. Thus, the Board should reject PO's request. To the extent the Board does admit PO's new materials, it should afford them no weight.

D. PO Withheld Information Material to Patentability.

The Board should grant PO's request as to the '685 patent and its file history (EX2039, EX2040), but not for PO's stated purpose.[2] Instead, the '685 patent and its file history should be admitted for the purpose of assessing: (1) PO's candor in these and related proceedings, and (2) the credibility of PO's arguments regarding the '848 patent and the prior art. The '685 patent issued less than two months ago—on August 26, 2025—as a continuation of the '848 patent. EX2039 at 1. Unbeknownst to Petitioner, PO had been prosecuting the '685 patent since February 29, 2024. *Id.* The '685 patent is a continuation of the '848 patent (EX2039 at 2), so PO should have identified it in PO's mandatory notices. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 18 (stating that "related" administrative matters "include every application and patent claiming, or which may

[2] As with the other four patents, the argument that PO advances for the '685 patent and its file history is the same as that which the Board has already considered and rejected. *See* Institution Decision (Paper 9) at 17.

claim, the benefit of the priority of the filing date of the party's involved patent"). PO did not. Paper 5. Nor did PO disclose this IPR to the '685 patent's Examiner. EX2039 at 1-4 (listing no IPR filings amongst the "references cited").

PO cannot credibly deny that it knew that each proceeding is relevant to the other. PO itself admits that the '685 patent claims are "substantially similar" to those of the '848 patent. PO Request (Paper 39) at 2-4. And during the prosecution of the '685 patent, the Examiner rejected PO's initial proposed claims for non-statutory double patenting in view of the '848 patent, further evidencing that PO knew that the proceedings are relevant to one another. *See* EX2040 at 139 (Examiner's Sept. 11, 2024 non-final rejection).

Despite knowing that this IPR proceeding and the '685 patent prosecution were related and unfolding in parallel, PO kept the Board, the Examiner, and Petitioner, in the dark. In doing so, it deprived everyone of critical information. For instance, the Examiner—who as noted above rejected the '685 claims because they overlapped with the '848 claims—would likely have considered the IPR filings to be material to the patentability of claims that PO itself calls "substantially similar." PO Request (Paper 39) at 4. For PO to fail to inform the Examiner of this IPR (and the prior art combinations in this IPR) and then in its request cite to the prior art listed on a information disclosure statement as evidence of the Examiner

"considering" the art that is at issue here (EX2040 at 1-22) bears on PO's candor and credibility.

The '685 patent file history is further instructive because it shows that PO took positions in prosecuting the '685 patent that conflict with infringement positions it took in the District Court trial. In the '685 patent file history, following the Examiner's non-final rejection under § 102 and § 103 in view of Tokuse (U.S. Patent Publ. No. 2008,0199056), PO distinguished the art by alleging that its "face-recognition system in which image-recognition processing is performed to determine whether the person corresponding to the face-image data had been registered" did not disclose the elements of the pending claim relating to "register[ing] a person as a specific person." EX2040 at 163-166. But in the District Court trial, PO "conflated face recognition and registration of a specific person" and argued that "the first setting mode [for registering a person] was met because 'the new picture is taken, the facial recognition occurs, and then it is added to the album'—with no reference to registration of a specific person." EX1021 at 20-21. Viewed in conjunction with the numerous contradictory positions that PO has taken in other IPRs, PO and its experts have demonstrated a pattern of taking inconsistent positions in the Patent Office and District Court. *See, e.g.*, IPR2024-00828, Paper 42 at 8-10 ("PO and Its Expert Have Taken Inconsistent Positions"), and Paper 47 at 3-5 ("PO and Its Expert Have Taken Inconsistent Positions").

Thus, although the '685 patent and its file history are not relevant to support PO's arguments, they are relevant for purposes of assessing the credibility of PO and their experts in this and other IPR proceedings.

III. CONCLUSION

For the reasons discussed above, PO's request as to EX2033-EX2038, EX2041, and EX2042, should be rejected, or, to the extent that the Board grants PO's request, it should afford the materials no weight. Moreover, the Board should admit EX2039 and EX2040 for the purpose of assessing the credibility of PO and their experts in this and other related proceedings (e.g., IPR2024-00828).

Date: October 14, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on October 14, 2025, a true and correct copy of the Petitioners' Response to Patent Owner's Request for Authorization to File Materials was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

maxell-samsung-service@mayerbrown.com

A courtesy copy was sent electronically to counsel for Patent Owner in the District Court Litigation:

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