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

SAMSUNG ELECTRONICS, INC. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners

v.

MAXELL LTD.,
Patent Owner

Inter Partes Review No.: IPR2025-01315

U.S. Patent No. 8,471,950

BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
Notice Letter to Samsung (July 7, 2021)	2001
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Docket Navigator Time to Trial Statistics for the Eastern District of Texas	2003
Docket Control Order, *Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, No. 5:25-cv-00052-RWS (E.D. Tex.)	2004
Jury Trial Transcript, Vol. 4, *Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, No. 5:23-cv-00092-RWS (E.D. Tex.)	2005
Complaint, *Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, 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, *Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, No. 5:23-cv-00092-RWS (E.D. Tex.)	2013
Follow-up Notice Letter to Samsung (November 28, 2024)	2014

I. INTRODUCTION

Patent Owner, Maxell, Ltd. ("Patent Owner"), respectfully requests that the Director deny institution of the Petition for *Inter Partes* Review filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (hereinafter "Petitioner" or "Samsung") challenging the patentability of claims 1-15 of U.S. Patent No. 8,471,950 ("the '950 Patent").

The '950 Patent issued over **12 years** ago. The Petition is solely aimed at disrupting Patent Owner's strong and settled expectation in the validity of its patent rights. Petitioner has known about its infringement of the '950 Patent for over four years. Yet, after receiving notice, Petitioner did nothing to investigate the patent or its infringement thereof. This head-in-sand approach is a tactical gambit Petitioner employs to enjoy the fruits of its infringement while refusing reasonable efforts to negotiate settlement. Among its peers, Petitioner stands alone in its refusal to reasonably negotiate a license to Maxell's vast patent portfolio.

Only now, after Maxell was forced by Petitioner's intransigence to initiate a *second* district court litigation, Petitioner avails itself of this IPR proceeding. This pattern of feigned ignorance, unreasonable negotiation, and running to the Patent Office only when suit is brought, undermines the "effective and efficient alternative" to litigation Congress envisioned for IPR proceedings; rather, the Petition is a late-filed, tactical weapon aimed at disrupting Patent Owner's strong and settled

expectation in the validity of its patent rights. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

As set forth below, the Director should exercise discretion and deny institution. A holistic analysis of the *Fintiv* factors and additional factors, when viewed through the lens of Petitioner's tactical delay and long history with Maxell, weighs in favor of denial. Furthermore, Petitioner's broader litigation conduct, including its history of filing a high volume of ultimately denied petitions, demonstrates a pattern of leveraging PTAB proceedings to gain an unfair advantage in district court. This conduct undermines the purpose of the AIA and warrants the exercise of the Director's discretion to deny institution.

Accordingly, Maxell respectfully requests that the Petition be denied in its entirety.

II. BACKGROUND

More than a decade ago, Samsung recognized the value of Maxell's intellectual property. In 2011, Samsung and Maxell's predecessor, Hitachi Consumer Electronics ("HCE"), entered into a Patent Sale Agreement, which included a patent license to HCE's patents. Ex-2006, ¶8. In 2016, the license expired, and the parties entered into renewal negotiations. Following the expiration of the prior license, Maxell took time to thoroughly investigate its portfolio consisting of

thousands of patents and out of those thousands of patents it identified around 200 patents that it believed would be particularly valuable to Samsung. Maxell provided Samsung with a notice letter on July 7, 2021 informing Samsung of its infringement of such patents by Samsung's Galaxy smartphones. Ex-2001. These notice letters clearly identified the specific claims and products Maxell believed infringed. It followed up with another letter in December 2021 (Ex-2002, 4:22) and sent a subsequent notice letter on April 21, 2025. Ex-2007.

During these negotiations, Maxell provided Samsung's representatives with detailed information regarding Maxell's patents, the developed technology, Samsung's ongoing use of this patented technology, and informed Samsung of other smartphone entities having already entered into agreements with Maxell, including Apple. Despite providing all of this information, Samsung declined to renew the license. Over two years, the parties exchanged over a dozen correspondences, wherein some of the patents Samsung challenges were identified, but Samsung never made ***any*** licensing offer. Ex-2006, ¶¶8-9. In fact, as explained below Samsung has admitted that it did not evaluate any of Maxell's identified patents. As a practical matter, it is not feasible, nor is it standard practice in complex licensing negotiations, to provide hundreds of detailed infringement charts for a portfolio of this size. Maxell behaved reasonably by identifying the relevant patents and claims within the portfolio and products it believed were infringing its technology. Maxell carefully

evaluated the thousands of patents in its portfolio to identify the 200 it believed Samsung was infringing. Indeed, providing preemptive, detailed infringement charts for even a handful of patents prior to litigation would have invited the very declaratory judgment actions this Petitioner is known to file and would have done nothing to resolve Samsung's need for a license to Maxell's broader patent portfolio. This decade-long history establishes Samsung's deep, long-standing awareness of Maxell's intellectual property.

During this time, virtually every other smartphone manufacturer in the US recognized the value of Maxell's patent portfolio and took a license—from BLU Products to Samsung's primary competitor, Apple. Ex-2008. Despite this, Samsung did not engage in renewal negotiations with Maxell. Rather, Samsung viewed its license expiration as an opportunity to gain a competitive advantage over the marketplace.

Having successfully negotiated with a majority of the industry, Maxell was hopeful it could do the same with Samsung. But Samsung has not behaved reasonably. This refusal directly precipitated litigation between Samsung and Maxell, including an initial lawsuit in the Eastern District of Texas in 2023 (*Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, No. 5:23-cv-00092 (E.D. Tex.)), an investigation at the U.S. International Trade Commission (*Certain Mobile Electronic Devices*, Inv. No. 337-TA-1432 (U.S. Int'l Trade Comm'n)), and an action in Europe's Unified Patent

Court (*Maxell, Ltd. v. Samsung Elecs. Co., Ltd.*, No. UPC_CFI_196/2025 (UPC, Munich Loc. Div.)). The '950 Patent is part of a second, broader lawsuit asserting ten patents filed in the Eastern District of Texas on April 21, 2025 (*Maxell, Ltd. v. Samsung Elecs. Co., Ltd*., No. 5:25-cv-00052 (E.D. Tex.)).

In response to Maxell's efforts to compel Samsung to pay its fair share for use of Maxell's intellectual property, Samsung launched a counter-offensive by filing a barrage of IPR petitions. This includes a first wave of petitions[1] targeting patents asserted in the initial Texas lawsuit, such as IPR2024-00735, IPR2024-00777, IPR2024-00828, and IPR2024-00867. Notwithstanding its *Sotera* stipulations in those proceedings, Samsung aggressively pursued validity counterclaims in the initial Texas lawsuit. Those patents were tried to a jury in May 2025, culminating in a verdict of willful infringement and an award of $111.7m in damages for Maxell. The Court later granted Samsung's JMOL and found the asserted claims invalid; that decision is on appeal. This Petition is part of the second wave of Samsung's PTAB campaign, filed months after the district court complaint, despite having long notice of the patent, demonstrating Petitioner's use of IPR proceedings is a reactive tactic,

[1] Samsung's Petitions were instituted by the Board despite presenting strong basis for discretionary denial, particularly where a patent had previously been reexamined on substantially the same Grounds. *See, e.g.*, IPR2024-00828, Paper 7, at 2-19.

not an early alternative to litigation.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Director "possesses broad discretion in deciding whether to institute review" and "[i]n making this decision, the Director has complete discretion to decide not to institute review." *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018). Indeed "[t]he Director bears the political responsibility of determining which cases should proceed" and "[w]hile he/[she] has the authority not to institute review on the merits of the petition, he/[she] could deny review for other reasons such as administrative efficiency." *Id*. The Petition should be denied pursuant to 35 U.S.C. § 314(a) because a holistic review of the circumstances of this proceeding warrant the Director exercising discretion not to institute.

A. A Holistic Assessment Warrants Discretionary Denial

The *Interim Processes for PTAB Workload Management* ("*Process Memo*") clarifies that the "parties are permitted to address all relevant considerations" and the Director may weigh additional considerations relevant to fairness and efficiency. *Process Memo,* at 2-3. Several such considerations support denying institution here.

1. Settled Expectations

The Director has repeatedly recognized the importance of a patent owner's "settled expectations" in discretionary denial analysis. Disturbing the settled rights

of a patent owner where a patent has been in force for years undermines the integrity of the patent system. Indeed, the Director has found a patent owner's strong settled expectations to be a key factor in the holistic analysis for discretionary denial.

In *Dabico Airport Solutions Inc. v. AXA Power ApS,* the Director explained that "in general, the longer the patent has been in force, the more settled expectations should be". *Dabico Airport Solutions Inc. v. AXA Power ApS,* IPR2025-00408, Paper 21, at 3 (P.T.A.B. June 18, 2025). Absent "persuasive reasoning" from a petitioner explaining why an inter partes review is an appropriate use of Office resources, the Office is "disinclined to disturb the settled expectations of Patent Owner." *Id*.

Here, Patent Owner's settled expectations are strong. **The '950 Patent issued in June 2013, over 12 years ago.** This is substantially longer than patents in numerous cases where the Director found strong settled expectations warranted denial, even for patents far younger than the one at issue.

For instance, in the *GenghisComm* cases, the Director rejected eight of Samsung's IPR petitions based on a holistic assessment that included the patent owner's "strong settled expectations," finding that even patents in force for as little as three years did not "tip the balance against discretionary denial." *Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00788, Paper 12 (P.T.A.B. Aug. 22, 2025); see also *Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00780, Paper 11 (P.T.A.B. Aug. 14, 2025) (patents in force for six and eight years).

Similarly, in *Amgen Inc. v. Bristol-Myers Squibb Co.*, the Director denied institution for patents in force for only six and seven years, finding they created "strong settled expectations." *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9, at 3 (P.T.A.B. July 24, 2025).

The Director consistently applies this principle to patents in force for seven, eight, nine, and ten or more years. For example, the Director has denied institution for patents in force for "more than seven, six, and nine years" (*HS Hyosung Advanced Materials Corp. v. Kolon Indus., Inc.*, IPR2025-00662, Paper 12 at 2 (Director Aug. 14, 2025)), "seven years" (*SmartSky Networks LLC v. Gogo Bus. Aviation LLC*, IPR2025-00672, Paper 10 at 2 (July 31, 2025)), "over nine years" (*Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2 (June 26, 2025)), "approximately ten years" (*Google LLC v. SoundClear Techs. LLC*, IPR2025-00344, Paper 15 at 2 (Aug. 4, 2025)), and "over ten years" (*Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, Paper 16 at 2 (July 10, 2025)). This extensive line of cases, denying challenges to patents far younger than the 12-year-old patent here, confirms that the '950 Patent's age establishes strong settled expectations.

These settled expectations are reinforced by Petitioner's purposeful delay. **Samsung is not unaware of the value of Maxell's patent portfolio; it was a licensee to Maxell's predecessor and has been holding out taking a license for**

over a decade. This directly effects the dynamics of competition in the industry. The Director has consistently found that a prior relationship or awareness of a patent weighs heavily in favor of denial. *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 16, at 2-3 (P.T.A.B. July 31, 2025) (denying institution where petitioner had actual notice of the patents and failed to seek early review); *Microsoft Corp. v. TS-Optics Corp.*, IPR2025-00767, Paper 13, at 2 (P.T.A.B. Aug. 14, 2025) (finding it an inefficient use of resources for a former licensee to challenge a patent's validity); *RegenX Science, Inc. v. NextGen Biologics, Inc.*, IPR2025-00620, Paper 9, at 2-3 (P.T.A.B. July 31, 2025) (denying institution where petitioner was a former licensee with prosecution input rights); *Ericsson Inc. v. Procomm Int'l Pte. LTD*, IPR2024-01453, Paper 15, at 2-3 (P.T.A.B. June, 25, 2025) (denying institution where petitioner was aware of the patent for years after it was cited during prosecution of its own patent).

Samsung had actual notice of the '950 Patent in December 2021. Ex-2002, 4:22. At that time, the patent had already been in force for over eight years. If Petitioner actually believed the patent was invalid, it should have sought review then. Instead, Samsung waited nearly four years to file this Petition, confirming this Petition is not a good-faith effort to correct the public record but a late-stage litigation tactic. *See, e.g., Gotab Inc. v. Fractus, S.A.*, IPR2025-00928, Paper 11, at 2-3 (P.T.A.B. Sept. 12, 2025) (finding 2021 notice to be notice "for a significant

period of time"). Moreover, even though specific notice was provided in 2021, **Samsung has been aware of Maxell's robust patent portfolio since 2011.** Samsung is also highly aware of Maxell's efforts to enforce its patent rights against Samsung's competitors in the smartphone industry and its success in obtaining numerous licensees in the industry. **Indeed, Maxell and Samsung have been in litigation regarding patents in Maxell's patent portfolio since September 7, 2023.** (*Maxell* '092 case). This "failure to seek early review" after receiving actual notice, on top of Samsung's long history with Maxell and its patent portfolio, is a key factor favoring denial.

The parties have a settled expectation of resolving their dispute in the District Court, which has already entered a comprehensive schedule and is already familiar with Maxell's patent portfolio. Given Petitioner's multi-year delay upon receiving actual notice of the '950 Patent, that expectation weighs strongly in favor of denial.

2. Petitioner's Undue Delay and Gamesmanship

Samsung's conduct demonstrates a pattern of gamesmanship designed to gain an unfair advantage. This pattern is first evident in its strategic delay of nearly four years in challenging the '950 Patent.

This inaction was a conscious decision, as confirmed by the sworn testimony of Petitioner's corporate representative, Mr. Kim, regarding an earlier, broader notice from Maxell:

> Q. Isn't it true that any analysis that Samsung did regarding Maxell's notice letter was done under the advice and control of counsel?
>
> A. We didn't review any patents.
>
> Q. You didn't review any patents?
>
> A. What I mean is, we could not review any of the patents, 200 -- over 200 patents that were listed on that notice letter.
>
> Q. Your answer is you could not review any of the patents; is that right?
>
> A. That's right

Ex-2005 at 844:15-25.

Mr. Kim also testified that Samsung knew how to access public information from litigations but did not investigate any of the identified cases in the July 7, 2021 letter. *See id*. at 848:16-852:2. Instead of investigating Maxell's claims, Samsung waited. It only filed this Petition on September 5, 2025—more than four months after Maxell was forced to initiate another litigation against Samsung. This delay is particularly compelling because it occurred in the face of Maxell's public and successful enforcement of its portfolio against Samsung's direct competitors. Maxell resolved disputes with numerous industry leaders, including, for example:

- **Apple**: Settled a multi-year dispute in 2021 (*Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036 (E.D. Tex.)). Ex-2008.
- **ZTE**: Won a $43.3 million jury verdict for willful infringement (*Maxell, Ltd. v. ZTE Corp.*, No. 5:16-cv-00179 (E.D. Tex.)). Ex-2009.
- **Huawei and Lenovo**: Secured settlements after initiating litigation (*Maxell, Ltd. v. Huawei Device USA Inc.*, No. 5:16-cv-00178 (E.D.

Tex.); *Maxell, Ltd. v. Lenovo Grp. Ltd.*, No. 6:21-cv-01169 (W.D. Tex.)). Ex-2010.

This context of known enforcement is not limited to Samsung's competitors. When Samsung refused to renew its license, it forced Maxell to initiate a multi-jurisdictional legal campaign against Samsung. This campaign includes an initial lawsuit in the Eastern District of Texas (*Maxell* ('092 case)), an investigation at the U.S. International Trade Commission seeking to bar Samsung's products from the U.S. market (*Certain Mobile Electronic Devices*) and an action in Europe's Unified Patent Court (*Maxell* (UPC case)). Petitioner filed this IPR only after all of these actions were underway, and as part of a second wave of litigation including the '950 Patent. This serial and reactionary deployment of defensive IPR petitions is not using the IPR process as an efficient alternative to litigation.

By ignoring a specific infringement notice for years while many of its peers, including its largest competitor, took licenses, Samsung positioned itself as a hold-out. This conduct supports a finding that this Petition is not a good-faith effort to correct a patent for the public good, but a tactical weapon held in reserve to be deployed only after its business decision to refuse a license resulted in litigation. *See, e.g.*, Adam Mossoff, *Google's Loss to Sonos Settles It: Big Tech Has an IP Piracy Problem*, (Jan. 14, 2022) (Ex-2011).

This strategic delay is compounded by a broader pattern of procedural gamesmanship where Samsung takes inconsistent positions at PTAB and in the district court, despite its *Sotera* stipulations. For example, in IPR2024-00906 and IPR2024-00907, Samsung used the same prior art, the Nokia N93 User Manual, as a "publication" in its IPRs while simultaneously arguing invalidity in district court utilizing the manual and the physical device together as a "product" to skirt its obligations under the *Sotera* stipulation. Ex-2013 at 5-6, 10. Additionally, for the "when a user indicates" limitation concerning U.S. Patent Nos. 10,129,590 and 11,445,241, Samsung argued in court that the claim requires a direct "timing and causal relationship" shown via source code, a requirement it never imposed in its IPR petitions which relied on prior art with intervening events. *See, e.g.*, IPR2024-00907, Paper 37 (P.T.A.B. Sept. 15, 2025).

As other examples, Samsung seeks narrow claim constructions in District Court to argue non-infringement, while strategically avoiding those same narrow constructions in its IPR Petitions for purposes of validity. When Maxell attempts to disclose this conduct and inconsistency to the PTAB, Samsung argues waiver to exclude the evidence. *See* IPR2024-00735, Paper 41 (P.T.A.B. Sept. 21, 2025).

Samsung's strategy of taxing the resources of patent owners and the Board is further demonstrated by its IPR filing statistics. Under the Board's current framework for discretionary denial, Samsung was responsible for nearly 13% of

petitions facing such arguments this year (82 of 625), and the Board denied all but twelve. This high rate of denials shows Samsung's willingness to pursue petitions the Board disfavors, suggesting an intent to overwhelm rather than seek legitimate review. While aggressively attacking the settled expectations of competitors, Samsung simultaneously seeks to build its own vast patent monopoly, holding over 90,000 patent families globally and securing 6,248 new U.S. patents in 2023 alone. Ex-2012.

Ultimately, this pattern of creating conflicting records is the epitome of the inefficiency that discretionary denial is meant to prevent. By pursuing different invalidity theories and claim interpretations in parallel, Petitioner forces the Board and the parties to expend enormous resources, creating a significant risk of inconsistent outcomes that could lead to unnecessary appeals, remands, and retrials. Instituting this Petition would only replicate that exact problem and reward Samsung's gamesmanship.

3. Petitioner's Use of *Sotera* Stipulations

Petitioner has also established a pattern of pursuing duplicative invalidity challenges in parallel forums. The Board need only look at the procedural morass created by Samsung in the first lawsuit and its parallel IPRs to understand the inefficiency of instituting here. Notwithstanding its *Sotera* stipulation, Samsung nevertheless pursued comprehensive invalidity theories in the first lawsuit. The jury

rendered a verdict six months prior to any Final Written Decision in the first wave of Samsung's IPRs, forcing the Federal Circuit to now reconcile a district court record, jury verdict, post-trial orders, and Final Written Decisions from the Board on overlapping validity issues. Instituting this Petition would replicate that exact problem, incentivizing Samsung's continued holdout. This layering of duplicative proceedings is the epitome of the inefficiency and risk of inconsistent outcomes that discretionary denial is meant to prevent.

While Petitioner again now offers a stipulation to narrow the issues, this does little to streamline the overall litigation given its history of pursuing expansive invalidity theories in district court. Indeed, the stipulation does not preclude Petitioner from pursuing §§102 or 103 theories based on system art broader than that corresponding to a reference in the Petition. Petitioner does not seek an efficient alternative to litigation but instead creates duplicative workloads.

B. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

1. Petitioner's Belated And Tactical Stay Motion (Factor 1)

Petitioner filed a motion to stay the parallel district court litigation on October 24, 2025.[2] This tactical maneuver was filed months after the district court entered its

[2] Notably, the first district court litigation was not stayed in view of the IPRs Samsung filed on those patents.

comprehensive schedule, well after Infringement Contentions were served, and just twelve days before this Discretionary Denial Brief was due on November 5, 2025. This filing should not be viewed in isolation, but in the context of Petitioner's multi-year delay in challenging this patent. The Board has repeatedly found this exact fact pattern to be a compelling reason for denial. In cases like *Amazon.com, Inc. v. Audio Pod IP, LLC* and *Murata Mfg. Co. v. Georgia Tech Rsch. Corp.*, the Board denied institution despite the early stage of the parallel litigation (no trial date set), because the petitioners' long pre-suit awareness of the patents created "settled expectations" that outweighed other factors. Those cases establish that a petitioner's "failure to seek early review" is a critical factor demonstrating gamesmanship. *See e.g. Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 (P.T.A.B. Aug. 14, 2025), and *Murata Mfg. Co. v. Georgia Tech Rsch. Corp.*, IPR2025-00383, Paper 13 (P.T.A.B. July 29, 2025).

This conduct is also consistent with the pattern of gamesmanship identified by the Director in the eight recent *GenghisComm* denials against this same Petitioner. Petitioner's tactical filing of an uncertain motion just days before this brief was due, combined with its pre-suit delay and established pattern of conduct, makes this factor weigh in favor of denial.

2. Proximity Of The District Court's Trial Date (Factor 2)

The District Court has entered a comprehensive Docket Control Order setting a Pretrial Conference for August 10, 2027, with a trial likely to follow shortly thereafter. The median time to trial in the Eastern District of Texas is approximately 21.6 months, suggesting an earlier trial date in January 2027, ***not*** a later one. Ex-2003.

The Final Written Decision in this IPR is expected in March 2027, at which point at least fact and expert discovery will have closed. While a final trial date may fall shortly after the March 2027 statutory deadline for a Final Written Decision, there is significant and dispositive overlap with critical, resource-intensive milestones that will occur well before the Board's final decision.

The Court's schedule, established in its August 18, 2025 Docket Control Order, creates a direct and unavoidable overlap with this proceeding:

- August 12, 2025: Infringement Contentions were served
- October 28, 2025: Invalidity Contentions were served
- December 17, 2025-April 22, 2026: Claim construction process
- February 25, 2026: Close of claim construction discovery and Preliminary Election of Asserted Claims
- March 11, 2026: Preliminary Election of Asserted Prior art
- May 6, 2026: *Markman* Hearing in District Court. This is scheduled to occur approximately eight months before the Board's Final Written Decision is due.

Ex-2004.

The entire claim construction process, including the exchange of proposed terms, claim charts, and extensive briefing, will run in parallel to this IPR. The parties will be forced to litigate the scope of the exact same patent claims in two different forums simultaneously. This inefficiency, risk of inconsistent rulings, and duplicative effort, is precisely why the Petition should be denied.

Moreover, the proximity of the anticipated trial date is not far from the anticipated FWD date. At most, this factor is neutral.

3. Investment In The Parallel Proceeding (Factor 3)

The parties and the District Court have commenced their investment of time and resources in the parallel proceeding. By the time this Petition was filed on September 5, 2025, the Complaint and Answer had already been filed. Furthermore, the *Fintiv* analysis assesses investment as of the date the Institution Decision is anticipated (approximately March 2026). The Docket Control Order entered on August 18, 2025, sets a clear path forward. By March 2026, the parties will have exchanged contentions, completed claim construction discovery, and be well into the claim construction process for the May 2026 *Markman* hearing. This established trajectory, set by court order, represents a clear and impending commitment of future resources by both the parties and the court that argues against disrupting the district court proceeding.

Moreover, the parties' investment is not confined to the instant case but reflects years of extensive litigation over Maxell's patent portfolio. For example, the parties have already completed an entire jury trial and subsequent post-trial motions on a related set of patents in this same District. That prior litigation, along with a multi-year history of licensing negotiations and parallel international disputes, represents a significant investment of party and judicial resources that has already occurred. To ignore this deep-seated history and initiate a duplicative proceeding now would run contrary to the efficiency principles underlying *Fintiv*.

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation (Factor 4)

There is significant and substantial overlap between the issues in this proceeding and those in the District Court Litigation. This Petition challenges some of the claims of the '950 Patent that are also asserted in the District Court Litigation. The overlap extends to the patent itself, as both proceedings will require interpretation of the same specification, prosecution history, and claims during the claim construction process that will run in parallel.

5. The District Court Litigation And The Petition Involve The Same Parties (Factor 5)

The parallel District Court Litigation involves the same parties. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial (Factor 6)

A holistic assessment of all circumstances weighs in favor of denial. Here, where Petitioner's conduct demonstrates significant gamesmanship and Maxell has strong settled expectations, instituting a duplicative proceeding would be an inappropriate use of the Board's limited resources. Furthermore, Petitioner's high volume of filings should not be mistaken for a need for heightened scrutiny; to the contrary, Maxell's patent portfolio has repeatedly withstood numerous challenges at the PTAB, confirming its validity and the strength of Maxell's settled expectations.

Moreover, as Maxell will demonstrate in its forthcoming Preliminary Response, the Petition's merits are weak, further counseling against the inefficient use of Board resources to institute a trial that is unlikely to succeed.

IV. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: November 05, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 5th day of November, 2025, a copy of the attached BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,471,950, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:.

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Respectfully submitted,

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