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 CORPORATION,
Patent Owner

Inter Partes Review No.: IPR2025-01316

U.S. Patent No. 10,812,646

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

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Notice Letter to Samsung (July 7, 2021)	2001
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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
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Hudson Institute Article, "Google's Loss to Sonos Settles It, Big Tech Has an IP Piracy Problem"	2011
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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 1-25 of U.S. Patent No. 10,812,646 ("the '646 Patent").

Petitioner has known about its infringement of the '646 Patent for nearly 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, Patent Owner 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 investigated its portfolio consisting of thousands of patents and 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 at 26. It followed up with another letter in December 2021 (Ex-2002) 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 all 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. 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))[1], 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 '646 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[2] targeting patents

[1] The hearing in this investigation is scheduled to begin on October 10, 2025.

[2] Samsung's Petitions were instituted by the Board despite presenting strong basis for discretionary denial, particularly where a patent had previously been reexamined

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, 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

on substantially the same Grounds. *See, e.g.*, IPR2024-00828, Paper 7, at 2-19.

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. 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 *Amgen Inc. v. Bristol-Myers Squibb Co.*, the Director denied institution for patents that had been in force for only six and seven years, finding they created "strong settled expectations" that the Office was "disinclined to disturb." *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9, at 3 (P.T.A.B. July 24, 2025). Similarly, in the *GenghisComm* cases, the Board rejected eight of Samsung's IPR petitions based on a holistic assessment of compelling factors, including the patent

owner's "strong settled expectations." In the first decision, the patents had been in force for approximately six and eight years. In a subsequent decision covering another six petitions, the Director found that even though the challenged patents were younger, with some being in force for as little as three years, that fact alone did not "tip the balance against discretionary denial." *See Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00780, Paper 11 (P.T.A.B. Aug. 14, 2025); *Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00788, Paper 12 (P.T.A.B. Aug. 22, 2025). Here, while the '646 Patent issued in June 2021 Samsung also concurrently challenges patents that have been in force for twelve, thirteen, fourteen, and sixteen years. *See, e.g.,* IPR2025-01315, -01314, -01312, -01309. Indeed, the average pendency across the 10 patents in the underlying litigation is 7.35 years.

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. *See also 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); *Microsoft Corp. v. Dialect, LLC*, IPR2025-00655, Paper 12, at 2-3 (P.T.A.B. Aug. 14, 2025) (denying institution where petitioner's real party in interest was the former owner of the patents); *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). **Here, the '646 Patent issued on Oct. 20, 2020 and Maxell promptly notified Samsung. Notably, Samsung had specific notice of the '646 Patent just a nine months later in July 2021, yet waited years to file this Petition**. Ex-2002. *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 '646 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 three-and-a-half-year delay in challenging the '088 Patent. The patent issued on Oct. 20, 2020, and Petitioner received specific notice of the patent and asserted claims on July 7, 2021, just nine months after it issued.

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 July 25, 2025—more than three 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 '646 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 its peers 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.

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). Similarly, in the litigation over U.S. Patent No. 8,982,086, Samsung's expert testified that the claimed "two registering modes" require showing "two different algorithms" and branching to different outcomes, a standard he did not apply to the prior art in the corresponding IPR. *See* IPR2024-00828, Paper 39 (P.T.A.B. Sept. 15, 2025). Finally, 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).

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 12% of

petitions facing such arguments this year (60 of 510), and the Board denied all but two. This near-perfect record 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. For instance, in the parallel *VB Assets* case (*VB Assets, LLC v. Samsung Elecs. Co., Ltd. et al.*, No. 2:24-cv-00828 (E.D. Tex.), where the same Petitioner also offered a narrow stipulation, its previously-filed invalidity contentions still included challenges based on numerous other system art references, as well as separate invalidity defenses under 35 U.S.C. §§ 101 and 112. Because the district court must resolve these voluminous challenges regardless of this IPR's outcome, the proceeding does not represent an efficient alternative to litigation and creates duplicative workloads.

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

1. No Stay Of The Parallel District Court Litigation (Factor 1)

Petitioner has not filed, nor indicated any intent to file, a Motion to Stay the District Court Litigation.[3] This failure 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).

Viewed through that lens, it is clearly Petitioner's strategy to burden Maxell with a duplicative proceeding it could have brought years ago given the long relationship between the parties and Maxell's clear intent to enforce its patent rights.

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

This conduct is consistent with the pattern of gamesmanship identified by the Director in the eight recent *GenghisComm* denials against this same Petitioner. Petitioner's failure to seek a stay, 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 February 2027, at which point at least fact and expert discovery will have closed. While a final trial date may fall shortly after the February 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 are due
- 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.

This timeline demonstrates that 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 creates the precise inefficiency, risk of inconsistent rulings, and duplicative effort that discretionary denial is intended to prevent.

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 July 25, 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 February 2026). The Docket Control Order entered on

August 18, 2025, sets a clear path forward. By February 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 colossal 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 claims of the '646 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 regarding the same subject patent as this Petition. 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. 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: September 30, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of September, 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. 10,812,646, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:.

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Respectfully submitted,

Date: September 30, 2025 By: /Robert G Pluta Reg No 50970/
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