

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. IPR2025-01316
U.S. Patent No. 10,812,646

**PETITIONERS' PRELIMINARY REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	1
III.	CONCLUSION.....	3

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,812,646
1002	File History of U.S. Patent No. 10,812,646
1003	Declaration of Dr. Benjamin B. Bederson in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,812,646
1004	U.S. Patent No. 9,736,217 (“Esaka”)
1005	U.S. Patent No. 9,454,251 (“Guihot”)
1006	U.S. Patent No. 9,521,247 (“Bandyopadhyay”)
1007	U.S. Patent No. 10,375,343 (“Sharif-Ahmadi”)
1008	U.S. Patent Application Publication 2012/0129496 (“Park”)
1009	U.S. Patent Application Publication 2014/0019994 (“Miyazawa”)
1010	Amy K. Karlson et. al., <i>AppLens and LaunchTile: Two Designs for One-Handed Thumb Use on Small Devices</i> , PROCEEDINGS OF THE SIGCHI CONFERENCE ON HUMAN FACTORS IN COMPUTING SYSTEMS (CHI 2005), 201-210 (2005), https://doi.org/10.1145/1054972.1055001 .
1011	Benjamin B. Bederson et. al., <i>DateLens: A Fisheye Calendar Interface for PDAs</i> , 11 ACM TRANSACTIONS ON COMPUTER-HUMAN INTERACTION 1, 90-119 (March 2004), https://doi.org/10.1145/972648.972652 .
1012	KARLSON, A. ET. AL., HANDBOOK OF RESEARCH ON USER INTERFACE DESIGN AND EVALUATION FOR MOBILE TECHNOLOGY, “Understanding One Handed Use of Mobile Devices,” 86-101 (Lumsden, Jo ed., 2007).
1013	SCH-I600 SERIES USER GUIDE (Samsung Telecommunications America, Inc., 2003).
1014	WILLIAM LIDWELL ET. AL., UNIVERSAL PRINCIPLES OF DESIGN, 142-143 (Rockport Publishers 2003), ISBN 978-1-59253-587-3.
1015	Ben Shneiderman, DESIGNING THE USER INTERFACE: STRATEGIES FOR EFFECTIVE HUMAN-COMPUTER INTERACTION, 74-75 (Addison-Wesley, 3 rd ed. 1998), ISBN 0-201-69497-2.
1016	Petitioners’ Stipulation
1017	RESERVED
1018	RESERVED
1019	RESERVED
1020	RESERVED
1021	RESERVED

Exhibit No.	Description
1022	RESERVED
1023	RESERVED
1024	Complaint dated September 7, 2023, <i>Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 5:23-cv-92 (EDTX)
1025	Order dated July 9, 2025 (<i>Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 5:23-cv-92 (EDTX), Dkt. 389)
1026	Order dated March 21, 2025 (<i>Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 5:23-cv-92 (EDTX), Dkt. 251)
1027	Order dated May 2, 2025 (Dkt. 300, 5:23-cv-92-RWS; EDTX) (public version)
1028	Order dated September 18, 2025 (Dkt. 300, 5:23-cv-92-RWS; EDTX) (public version)
1029	IPR2024-00735, Paper 41 (Opposition to Motion to Submit Supplemental Information)
1030	IPR2024-00828, Paper 42 (Response to Patent Owner's Motion to Submit Supplemental Information)
1031	IPR2024-00828, Paper 47 (Sur-reply to Patent Owner's Motion to Submit Supplemental Information)
1032	RESERVED
1033	Letter from Maxell to Samsung (July 7, 2021)
1034	Email thread and letter from Maxell to Samsung dated December 29, 2021
1035	Email thread between Maxell and Samsung (July 2021 – January 2022)
1036	RESERVED
1037	Infringement Contentions dated August 12, 2025 (<i>Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 5:25-cv-52 (EDTX))
1038	IPR2024-00828, Paper 50 (Order Denying Patent Owner's Motion to Submit Supplemental Information)
1039	IPR2024-00867, Paper 40 (Petitioner's Response to Patent Owner's Request for Authorization to File Materials From Related Matters)
1040	IPR2024-00717, Paper 31 (Petitioner's Opposition to Patent Owner's Request for Authorization to File Materials from Related Matters)
1041	Excerpts from Trial Transcript from <i>Maxell, Ltd. v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 5:23-cv-92 (EDTX)

Exhibit No.	Description
1042	Motion to Stay Pending Inter Partes Review dated October 24, 2025 (<i>Maxell, Ltd. v. Samsung Electronics Co., Ltd, et al.</i> , Case No. 5:25-cv-52 (EDTX)), Dkt. 53.
1043	Maxell's Amended Infringement Contentions, Appendix 9: October 20, 2025 Infringement Contentions Applying Claims 1-8 and 11 of U.S. Patent No. 10,812,646 to Accused Samsung '646 Products (Redline)
1044	Maxell's Infringement Contentions, Appendix 9: August 12, 2025 Infringement Contentions Applying Claims 1-8 and 11 of U.S. Patent No. 10,812,646 to Accused Samsung '646 Products

I. INTRODUCTION

Petitioners submit this Reply to alert the Director to PO's inconsistent positions on the meaning of the "sleep state" limitation in its POPR here and in its infringement contentions in related matter district court litigation, *Maxell, Ltd. v. Samsung Electronics Co., Ltd.*, Case No. 5-25-CV-00052 (E.D. Tex.).

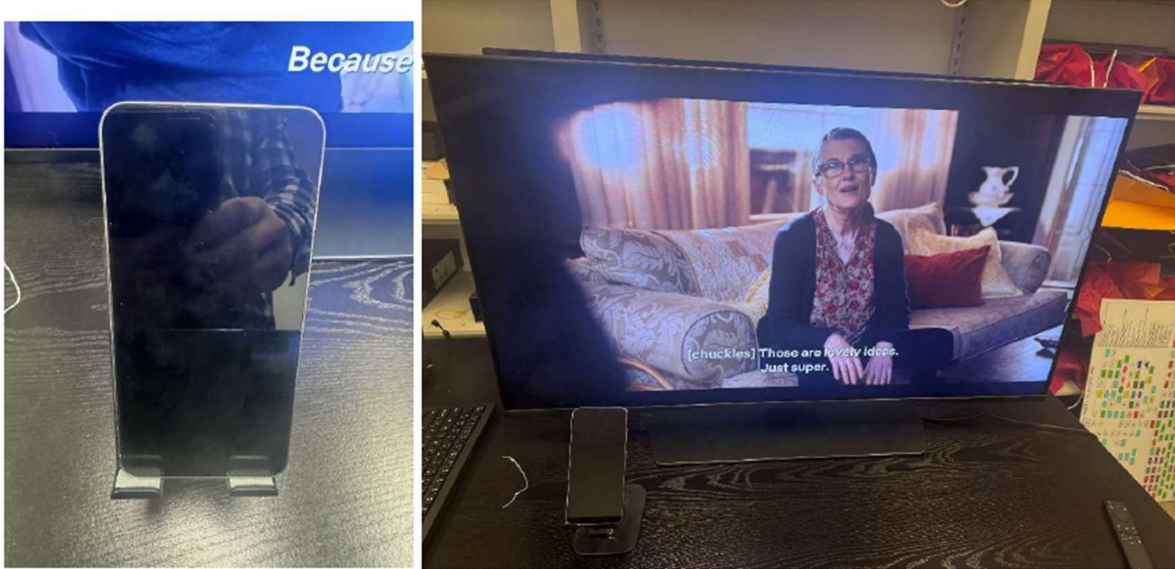
II. ARGUMENT

In its infringement contentions, PO asserts that "sleep state," as recited in claim 1, is satisfied when "the display is dimmed" (EX1043 at 43; EX1044 at 43), when "the screen turned off" (EX1043 at 57, 63, 67; EX1044 at 57, 63, 67) or when there is a "dark screen" (EX1043 at 58; EX1044 at 58). But in its POPR, in an attempt to avoid the prior art, PO asserts that "sleep state" is not disclosed by "turning off a screen" or "a display turning off." Paper No. 10 at 16.

As shown in the screen shot below, PO also asserts in its infringement contentions that an accused Samsung Galaxy S25 ("S25") phone is in a "sleep state" when its screen is turned off and dark even though the accused device is casting a video to a TV while its screen is in this state. EX1043 at 63, 67 (showing S25 with screen turned off and dark while casting video to television); *see also* EX1044 at 63, 67.

Exemplary Evidence of Infringement

Subsequently, the connection to the external device is severed by either taking the device out of Wi-Fi range or turning off the access point.



The above screenshot depicts the device entering a sleep state (e.g., screen turned off).

However, in its POPR, in an attempt to avoid the prior art, PO takes the opposite position and asserts that the “sleep state” limitation is a “‘non-operation state,’ meaning device inactivity,” and is not disclosed by “a device actively controlling a remote control session,” or by a device that is “still operating.” Paper No. 10 at 17. But clearly, for purposes of PO’s infringement contentions, the accused S25 is “active” and “still operating” when it is casting video to the TV. EX1043 at 63, 67; EX1044 at 63, 67. PO offers no explanation for these opposite positions in either its POPR or in its infringement contentions. Making matters worse, PO’s position was the same in two sets of infringement contentions: first, in its original infringement contentions on August 12, 2025 (EX1044), and then again in its

supplemental infringement contentions on October 20, 2025 (EX1043). Then, without explanation, *only ten days later* on October 30, 2025, PO took the opposite position regarding this claim term in its POPR. Paper 10.

Petitioners respectfully submit that the Board should reject the construction that PO now proffers in the POPR and construe the term as PO did in its infringement contentions; namely, that the “sleep state” limitation is satisfied when a device’s screen is turned off and dark even if the device is still performing another operation while its screen is in that state, as well as when the device is in a “non-operation state, meaning device inactivity,” as PO now proposes.

Moreover, Petitioners respectfully submit that PO’s inconsistent positions here and before the district court are another reason why the Director should not exercise his discretion to deny institution of this IPR.

III. CONCLUSION

The Director should institute this IPR for the reasons discussed above and for the reasons discussed in the Petition (Paper 1) and Petitioners’ opposition to PO’s request for discretionary denial (Paper 9).

Date: November 24, 2025

Respectfully submitted,

/s/ Salvatore Tamburo

Salvatore Tamburo

Reg. No. 45,153

DLA Piper LLP (US)

500 Eighth Street NW

Washington, DC 20004

Phone: 202.799.4000

Fax: 202.799.5000

salvatore.tamburo@us.dlapiper.com

*Attorney for Petitioners Samsung
Electronics Co., Ltd. and Samsung
Electronics America, Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on November 24, 2025, a true and correct copy of this brief and any new exhibits were served by emailing a copy of the same (by agreement) to the following attorneys for PO:

Robert G. Pluta (rpluta@mayerbrown.com); and

Saqib Siddiqui (ssiddiqui@mayerbrown.com).

A courtesy copy also was sent via email to:

maxell-samsung-service@mayerbrown.com

Date: November 24, 2025

/s/ Salvatore Tamburo

Salvatore Tamburo

Reg. No. 45,153

DLA Piper LLP (US)

500 Eighth Street NW

Washington, DC 20004

Phone: 202.799.4000

Fax: 202.799.5000

salvatore.tamburo@us.dlapiper.com

*Attorney for Petitioners Samsung
Electronics Co., Ltd. and Samsung
Electronics America, Inc.*