

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

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

Petitioners,

v.

MAXELL, LTD.,  
Patent Owner

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**Case: IPR2025-01316**

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

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**PATENT OWNER'S PRELIMINARY SUR-REPLY IN RESPONSE  
TO PETITION FOR *INTER PARTES* REVIEW  
OF U.S. PATENT NO. 10,812,646**

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U.S. Patent and Trademark Office  
P.O. Box 1450 Alexandria, VA 22313-1450

Samsung’s primary reference is **completely silent** as to the claimed “sleep state.” There are no references to any of “sleep,” “asleep,” “wake,” or “awake” (POPR, 14-27 (citing EX1004)). Samsung is thus left to mischaracterize PO’s Infringement Contentions (“Inf. Cont.”) in an attempt to salvage its Petition. Samsung alleges that PO is interpreting claims inconsistently by arguing in litigation that the claimed “sleep state” is met when the S25 screen is turned off, but then arguing in this proceeding that the claimed “sleep state” is not met by Esaka’s “a simple screen-off ‘standby state.’” Paper No. 11, 2-3. There is no such inconsistency in PO’s positions. Further, the Petition fails to offer any constructions at all. Samsung’s attempt to cast its failure of proof in the Petition as a problem of PO’s making should be rejected. 37 C.F.R. § 42.104(b)(3).

Samsung relies on a single, out-of-context, snippet from the Inf. Cont., ignoring the Inf. Cont. as a whole and even the specific portion where PO interprets the claimed “sleep state,” (*i.e.*, in claim element [1.d] of the Inf. Cont. where “sleep state” is **first** introduced). Specifically, a comparison of PO’s positions in the POPR and the claimed infringing activities in the Inf. Cont. shows no inconsistency:

| POPR at 14-16                                                                                                              | PO Inf. Cont. (EX1043) at 43-56 (highlights added)                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                        |
|----------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>“A simple screen-off ‘standby state’” of Esaka does not correspond to the claimed “sleep state” because the claimed</p> | <p><b>Powersaving mode</b></p> <ul style="list-style-type: none"> <li>• Turn off Always on Display: This will disable the Always on Display feature.</li> <li>• Limit CPU speed to 70%: Decreases the processing speed of your device.</li> <li>• Decrease brightness by 10%: Tap this option to dim your device's screen by 10%.</li> <li>• Limit apps and Home screen: This option will provide you with maximum power saving by limiting background activity, using a simplified home screen, and limiting the available apps. It will also turn off Edge panels.</li> </ul> <p>• • •</p> <ul style="list-style-type: none"> <li>• App standby: The platform can place unused apps in App standby mode, temporarily restricting network access and deferring syncs and jobs for those apps.</li> </ul> |

state also requires  
“device inactivity.”

**Understand Doze**

If a user leaves a device unplugged and stationary for a period of time, with the screen off, the device enters Doze mode. In Doze mode, the system attempts to conserve battery by **restricting apps** access to network and CPU-intensive services. It also **prevents apps from** accessing the network and defers their jobs, syncs, and standard alarms.

PO interprets “sleep state” consistently by identifying various conditions of device inactivity **in addition** to screen dimming. POPR, 14-16; EX1043, 43-56. Samsung’s attempts to ignore what could not be clearer in the Inf. Cont. is, at best, disingenuous. PO explicitly points to a “Power saving mode” and/or “Doze mode” in the Accused Products that, **along with screen dimming**, put the Accused Product in sleep state due to inactivity by, for example, “Limit[ing] CPU speed to 70%” (*id.*, 43); “turn off Edge panels” (*id.*, 44); “Limit apps and Home screen” (*id.*, 44, 48); “place unused apps in App standby mode” (*id.*, 54); “temporarily restricting network access and deferring syncs and jobs for those apps” (*id.*); “deferring background CPU and network activity for apps” (*id.*, 55); “restricting apps’ access to network and CPU-intensive services . . . [and] prevent[ing] apps from accessing the network” (*id.*); “deferring jobs, sync, and alarms” (*id.*, 56). Had PO interpreted “sleep state” in its Inf. Cont. to correspond to **only** screen dimming (as Samsung suggests), elaboration in such detail regarding conditions of device inactivity would have been unnecessary. Indeed, even the single excerpt, taken out of context and relied on by Samsung in its Reply, identifies an additional condition of **device inactivity** (*e.g.*, network inactivity) by “taking the device out of the Wi-Fi range or turning off the access point.” Paper 11, at 2. These disclosure appear on the **same** page of the Inf.

Cont. as well as numerous other conditions of device inactivity being mapped to the claimed “sleep state” **in addition to** screen dimming. Samsung’s omission of these statements is, at best, misleading.

“Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.” *Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). The Petition is intentionally vague in its application of the prior art to the claims: Petitioners’ proposal “in this petition in **no way limits** their rights to assert a **different claim construction** of **any claim** term for **any** other **purpose**, including litigation or another IPR petition.” Pet., 26 (emphases added). This is insufficient. Samsung must clearly articulate “[h]ow the challenged claim is to be construed” and explain why it intends to take different claim construction positions in different forums for **any** claim term for **any** purpose. *See Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025). Samsung does neither—for the claims at issue here, or otherwise. Samsung should not have free reign to “assert a **different claim construction** of **any claim** term for **any** other **purpose**.” This is improper and denial of institution is warranted. *Am. Airlines, Inc. et al v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 (P.T.A.B. Nov. 21, 2025).

Dated: November 28, 2025

Respectfully submitted,

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## **CERTIFICATE OF SERVICE**

I hereby certify that on this 28th day of November, 2025, a copy of the attached PATENT OWNER SUR-REPLY IN RESPONSE 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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