

**IN 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

Case: IPR2024-00867

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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

| Description | Exhibit # |
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| 1st Amended Docket Control Order from District Court Litigation | 2001 |
| Original Docket Control Order from District Court Litigation | 2002 |
| Maxell's Supplemental Preliminary Election of Asserted Claims | 2003 |
| Defendants' Preliminary Election of Prior Art | 2004 |
| U.S. Patent Application No. 2009/0135269 | 2005 |
| U.S. Patent No. 8,488,847 | 2006 |
| Samsung invalidity contentions (Gallagher) | 2007 |
| Samsung invalidity contentions (Nakashima) | 2008 |
| U.S. Patent Application No. 2007/0098303 | 2009 |
| U.S. Patent Application No. 2007/0019083 | 2010 |

I. INTRODUCTION

The Board abused its discretion by not denying Institution under 35 U.S.C. § 325(d) based on the *Advanced Bionics* two part framework. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). In its Institution Decision (“ID”) the Board ignored Patent Owner's overwhelming evidence for Part 1, removed Petitioner's burden for Part 2, and placed the burden for Part 2 squarely on Patent Owner. This approach ignores the standard set forth in the precedential *Advanced Bionics* decision and renders §325(d) and prior reexamination proceedings meaningless. Director Review is necessary to correct the Board's abuse of discretion and restore §325(d) to its intended form—a commitment to defer to prior office examination.

First, the Board abused its discretion and applied a heightened standard to Patent Owner inconsistent with the Board's precedent when analyzing the Petition under 35 U.S.C. § 325(d) based on Part 1 of *Advanced Bionics*. The '848 Patent was (1) initially examined by the PTO, (2) underwent subsequent reexamination, and (3) now faces the present proceeding. In its preliminary response (POPR), Patent Owner demonstrated that Part 1 of *Advanced Bionics* was met because the asserted art was the same or substantially the same as art presented (and considered) during reexamination. POPR at 5-11. As a result, Petitioner was required to demonstrate

material error under Part 2. But Patent Owner also demonstrated how Petitioner failed to meet its burden. *Id.* at 11-12. Yet, the Board instituted anyway, erecting strawman arguments with respect to Part 1, and incorporating the Part 2 analysis that should have been Petitioner's burden within its discussion of Part 1. The Board concluded that "Patent Owner makes no effort to compare or contrast the teachings of Nozaki '980 (Ex. 1006) asserted as prior art by Petitioner in the Petition with the teachings of Nozaki '108 (Ex. 3002) or Nozaki '252 (Ex. 3003) listed on the '848 reexamination IDS." ID at 16. In so finding, the Board completely misapprehended Patent Owner's evidence, and proceeded to submit its own evidence that allegedly undermines Patent Owner's Part 1 analysis. This was an abuse of discretion.

Second, the Board gave short shrift to Patent Owner's demonstration that the asserted art was cumulative to art and arguments made during reexamination. Patent Owner extensively showed—utilizing Petitioner's own analysis—why the four asserted references were cumulative to art and arguments previously considered by the Office during prosecution and reexamination.

Third, the Board's failure to find Part 1 of *Advanced Bionics* met in light of Patent Owner's evidence and its subsequent placing of the burden on Patent Owner for Part 2 implicates important issues of law and policy regarding the inconsistent application of the Board's precedential decision in *Advanced Bionics*.

Director review is appropriate to cure the Board's abuse of discretion.

II. LEGAL STANDARD

“Requests for Director Review of the Board’s decision whether to institute an AIA trial ... shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy.” USPTO, Director Review Process, Sec. 2.B., <https://www.uspto.gov/patents/ptab/decisions/director-review-process>. “An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (internal citation omitted).

III. BACKGROUND OF THE PATENT

The '848 Patent generally describes a recording and reproducing apparatus (such as a mobile phone or camera), Ex. 1001 at 13:38-42, that allows users to “rapidly and easily” locate certain types of images from among a large number of images. *Id.* at 2:18-22. Specifically, the patent recognizes that, in the 2008 timeframe, the memory capacities of camera devices were increasing, thereby allowing for the storing of more and more images. *Id.* at 1:55-59. Aware of this trend, inventor Ms. Yoshida recognized the need for a better way to find images among the ever-increasing number of images stored on recording devices. *See id.* at 1:59-61

("It is therefore difficult for a user to quickly find a target scene from a number of scenes recorded in the recording medium.").

IV. ARGUMENT

The Board abused its discretion by applying an incorrect standard in its 35 U.S.C. §325(d) analysis. Moreover, important issues of law and policy highlight the Board's approach to 35 U.S.C. §325(d) was incorrect.

A. The Board Abused Its Discretion By Applying An Incorrect Standard For Discretionary Denial under 35 U.S.C. § 325(d) And Devaluing the Reexamination Process

The Board abused its discretion by not applying the correct standard in its 35 U.S.C. § 325(d) analysis by raising the standard for Part 1 and shifting the burden of Part 2 from Petitioner to Patent Owner. As a result, the ID renders the reexamination process meaningless and results in an inconsistent application of *Advanced Bionics*.

Under *Advanced Bionics*, PTAB employs a framework that "reflects a **commitment to defer to previous Office evaluations** of the evidence of record **unless** material error is shown." *Advanced Bionics* at 8. *Advanced Bionics* dictates that whether the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution is a threshold issue to be addressed *first* because "it is dispositive of [the] decision whether to institute *inter partes* review." *Id.* The Director has made clear that the Board should first consider §325(d) discretionary denial and only address the merits of the petition if that does not apply. *Id.* at 6-7; *see also* *Wolfspeed*,

Inc. v. The Trustees of Purdue University, IPR2022-00761, Paper 13 at 3 (PTAB Mar. 30, 2023) (“If the Board determines that it should not exercise its discretion to deny institution of inter partes review under §325(d), then the Board should address the remaining issues raised in the Petition and Preliminary Response to determine whether to institute an inter partes review.”).

Based on this framework, the Director will discretionarily deny institution when: (1) “the same or substantially the same art previously **was presented** to the Office or whether the same” or “the same arguments previously were **presented** to the Office”; and (2) the **petitioner does not** “demonstrate[] that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 6-7 (emphasis added).

1. Part 1 of *Advanced Bionics* Was Met

For Part 1 of *Advanced Bionics*, the Board first evaluates *Becton Dickinson* factors (a), (b), and (d). *Advanced Bionics* at 10. If it is determined that the same or substantially the same art or arguments **were previously presented** to the USPTO, then under Part 2 the Board considers factors (c), (e), and (f) to assess “**whether the petitioner has demonstrated a material error by the Office**” in its prior consideration of that art or arguments. *Id.* Factor (c) evaluates “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection” and factor (e) evaluates “whether Petitioner has pointed

out sufficiently how the Examiner erred in its evaluation of the asserted prior art.” Petitioner never addressed either of these factors and the Board improperly raised the standard for Part 1 by requiring Patent Owner to address factor (c) in Part 1.¹

The POPR demonstrated Part 1 was met— the IPR-asserted art is “the same or substantially the same” because Petitioner’s main reference for all Grounds— Nozaki—was presented during prosecution of the ’848 Patent. POPR at 6 (citing Ex. 1003 at 533; Ex. 1004 at 165-190). Haitani, a secondary reference used for all Grounds, was presented during reexamination. *Id.* (citing Ex. 1004 at 165-190). The remaining tertiary references—Graham and Kim—are cumulative of references previously presented to the Office during reexamination of the ’848 Patent as well as during prosecution, and are each used identically and narrowly for Grounds 2 and 3 directed at one challenged claim. *Id.* at 4.

The POPR extensively highlighted how Nozaki and Haitani were previously presented to the Office. POPR at 3-11. With respect to the main reference Nozaki, *Petitioner admits* that a U.S. publication of Nozaki was disclosed “but not expressly considered” during prosecution of the ’848 Patent. Pet. at 5. Patent Owner provided evidence that the U.S. publication to which Petitioner refers, U.S. Patent Publication

¹ Notably, Patent Owner *did* address the extent to which the art was considered and Board failed to accord it appropriate weight. *See* POPR at 3-11.

No. 2009/0135269 (“Nozaki ’269”), is the same in substance as Petitioner’s Nozaki publication. POPR at 6 (citing Ex. 1006 and Ex. 2005). Patent Owner further provided evidence that the Nozaki publication issued as U.S. Patent No. 8,488,847 (Ex. 2006), based on the same PCT publication upon which Petitioner now relies—WO2007/060980. POPR at 6. Thus, Nozaki was previously presented to the Office. Yet, the Board shifted Petitioner’s Part 2 burden onto Patent Owner when it found Part 1 was not met:

Patent Owner, however, provides no specific examples, comparisons, or analysis between the evidence and arguments concerning Nozaki presented in the Petition with the evidence and arguments concerning Nozaki ostensibly considered during the ’848 patent reexamination.... Nozaki ’269 is listed on the disclosure statement among approximately 50 other references and **Patent Owner does not point to any evidence to indicating [sic] that the Office meaningfully addressed this reference during prosecution** of the ’848 patent other than a blanket statement printed on the bottom of the IDS that “all references considered except where lined through.”... **This statement, however, does not allow us to evaluate the extent to which^[2] the Examiner may have substantively considered Nozaki ’269**, or any other of the approximately 50 references listed on the IDS for that matter, during

² Factor (c), which **Petitioner** must evaluate **under Part 2**, evaluates “**the extent to which** the asserted art was evaluated during examination.”

prosecution of the '848 patent. Given this level of uncertainty in the record, and the lack of evidence showing that Nozaki '269 was meaningfully addressed by the Office, we are reluctant to exercise our discretion to deny institution based on this record.

ID at 15, 17 (emphasis added). In concluding thus, the Board abused its discretion in several respects.

First, the legal standard under Part 1 does not require a reference to be “meaningfully addressed” in order for Part 1 to be met, and the Board abused its discretion by not finding Nozaki and Haitani “previously presented.”³ A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office. *Fitesa Simpsonfille, Inc. v. The Proctor & Gamble Co.*, IPR2023-01450, Paper 11 at 10-19 (PTAB Mar. 20, 2024) (denying institution based on §325(d) because Petition was based on previously presented and cumulative art and that Petitioner failed to demonstrate that the Examiner erred in the evaluation of the prior art); *see also Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (PTAB Feb. 12, 2018) (denying institution even though the ‘Examiner did not base a rejection’ on the

³ In requiring references to be “meaningfully addressed” the Board ignored *Advanced Bionics* in favor of the non-final and non-implemented notice of proposed rulemaking respecting discretionary denial. *See* 89 Fed. Reg. 28693 (Apr. 19, 2024).

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reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12, 9 (PTAB Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (PTAB Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited). Patent Owner clearly showed that both Nozaki and Haitani were previously presented to the Office.

Second, it was not Patent Owner's burden under Part 1 to demonstrate whether the Office "meaningfully addressed" the references. The evaluation of the extent to which asserted art was evaluated and how the Examiner erred in its evaluation of the asserted prior art is squarely Petitioner's burden under *Advanced Bionics* Part 2 (*Becton Dickinson* factor (c): "**the extent to which** the asserted art was evaluated during examination, including whether the prior art was the basis for rejection" and factor (e): "whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art."). Thus the fact that the evidence led the Board to conclude it could not "**evaluate the extent to which** the Examiner may have substantively considered Nozaki '269" was a failure of Petitioner's evidence, not Patent Owner's. This alone should have dictated a denial under §325(d). The Board abused its discretion by shifting Petitioner's burden of evaluating factor (c) under Part 2 to Patent Owner under Part 1. ID at 17.

Compounding this abuse, the Board erred in finding that the asserted references are not cumulative to the art and arguments set forth during prosecution and reexamination of the '848 Patent. Patent Owner alternatively detailed extensively how Nozaki was cumulative to Gallagher, a reference considered during reexamination. POPR at 7-9. Patent Owner demonstrated this through comparison of Petitioner's use of both Nozaki and Gallagher in the district court litigation. *Id.* Patent Owner also demonstrated how Haitani, Graham, and Kim are cumulative to the art already considered during reexamination. *Id.* at 8-11. In doing so, Patent Owner compared Petitioner's use of the art in the district court litigation to substantively show the cumulativeness of the art previously considered during the '848 prosecution and reexamination. However, instead of engaging with the substance of Patent Owner's claim, the Board dismissed the evidence finding "Because the PTAB and district courts use different legal standards, it is possible for each tribunal to reach a different result even when considering the same evidence. Merely because a party argues in district court that a particular reference teaches all of the limitations of an asserted patent claim doesn't make it so." ID at 19.

The Board missed the point, leading to an erroneous factual finding. Patent Owner simply took references that were previously presented and considered by the Office—Gallagher and Nakashima—and Petitioner's analysis of them in the district court, to illustrate how the Petition's references—Nozaki, Haitani, Graham, and

Kim—are cumulative to these previously considered references. POPR at 8-11. This factual comparison between the references—guided by Petitioner's own interpretation of each reference—demonstrates the cumulativeness of Nozaki, Haitani, Graham, and Kim. It was an abuse of discretion to find otherwise.

2. Petitioner Failed to Meet Its Burden Under Part 2

Patent Owner provided overwhelming evidence that Part 1 was met for all of the asserted art. As a result, Petitioner was required to demonstrate material error under Part 2. Petitioner failed to meet its burden—the Petition is silent on this point and thus Petitioner failed to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims,” as required under Part 2; denial of institution was required. *Advanced Bionics* at 6-7.

“If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute [] review.” *Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (PTAB June 22, 2021) (denying institution). Petitioner fails to even state any alleged material error by the Office. Petitioner's failure to address Part 2 should have ended the inquiry and resulted in denial of institution under §325(d). The Board abused its discretion in finding otherwise.

To evaluate material error, the Board weighs *Becton Dickinson* factors (c), (e) and (f). **The Petition does not reference any of these factors**, let alone analyze them. *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (PTAB July 11, 2023) (“[W]hile there are no ‘magic words’ necessary to address material error, Petitioner’s alleged grounds of unpatentability cannot establish material error per se under our binding precedent. . . . Otherwise, the reasonable likelihood standard of § 314(a) and the second part of the *Advanced Bionics* framework (‘material error’) would collapse into one.”). Thus, with respect to Part 2 of the *Advanced Bionics* framework, the Board abused its discretion by not requiring Petitioner to show material error. The Petition fails to show material error with respect to the previously considered references—Nozaki and Haitani. Pet. at 58. Yet, instead of placing the burden squarely on Petitioner for Part 2, the Board shifted the burden to Patent Owner, finding “Patent Owner does not point to any evidence to indicating [sic] that the Office meaningfully addressed this reference during prosecution of the ’848 patent” ID at 17. The Board abused its discretion.

B. The Board’s Burden-Shifting Implicates Important Issues Of Law and Policy

The Board’s failure to find Part 1 of *Advanced Bionics* met in light of Patent Owner’s overwhelming evidence and its subsequent placing of the burden on Patent Owner for Part 2 implicates important issues of law and policy regarding the

inconsistent application of the Board's precedential decision in *Advanced Bionics*. The *Advanced Bionics* two part framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless a material error is shown. *Advanced Bionics* at 9. *Advanced Bionics* cautions that "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *Id.*

The number of Board decisions that deny Institution pursuant to §325(d) based on far less Part 1 evidence is legion. For example, in *Google LLC v. Valtrus Innovations LTD*, IPR2022-01197, Paper 9 at 22 (PTAB Jun 13, 2023), the Board found Part 1 met because substantially the same art as relied on in the petition was previously presented to the Office in the form of a European counterpart to the Petitioner's asserted art. *Id.* The European counterpart was cited in an IDS and was considered by the Examiner. The Board found that Petitioner failed to show Part 2 was met because Petitioner never addressed the Office's prior consideration of the European counterpart. *Id.* at 22-23.

In *Nespresso USA, Inc. v. KFee System GMBH*, IPR2021-01221, Paper 9, at 13-14 (PTAB Jan. 18, 2022), the Board denied institution where three of five references cited in the IPR "appear[ed] on a relatively long list of documents presented to the Examiner in an IDS" and the record demonstrated that the examiner considered the references by lining through ones that he did not consider on the IDS.

Similarly, in *Boragen, Inc. v. Syngenta Participations AG*, IPR2020-00124, Paper 16 at 21 (PTAB May 5, 2020), the Board denied institution because “the same disclosures that Petitioner cites from Baker were in the related Baker references before the Examiner.” In *Helena Labs. Corp. v. Sebia*, IPR2024-00801, Paper 10 at 6-21 (PTAB Oct. 23, 2024), the Board denied institution pursuant to §325(d) based on art cited in an IDS as well as art asserted in the petition that was cumulative to art that was before the Office during prosecution. *Id.* at 6-17. Having found Part 1 met, the Board then noted that Petitioner failed to demonstrate that the Examiner erred in the evaluation of the art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims. *Id.* at 17-21.

Advanced Bionics makes clear that citation on an IDS alone is enough to meet Part 1. *Advanced Bionics* at 7-8; *see also Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 12, 14-15 (PTAB June 8, 2018) (same); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 10-11 (PTAB Nov. 8, 2022) (same); *Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 7-8, 17 (PTAB Feb. 22, 2021) (same); *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021- 00412, Paper 9 at 34-35 (PTAB July 21, 2021) (same).

Here, the situation is even more compelling. The POPR extensively highlighted how Nozaki and Haitani were previously presented to the Office. POPR

at 3-11. Nozaki '269 is listed on the IDS *and* is a counterpart to the Nozaki reference utilized by Petition, *and* the Examiner specifically noted "all references considered except where lined through." POPR at 6; ID at 15, 17. Haitani, a secondary reference used for all Grounds, was presented during the reexamination of the '848 Patent. POPR at 6 (citing Ex. 1004 at 165-190). Part 1 was clearly met under *Advanced Bionics* and subsequent decisions following *Advanced Bionics*. Yet, the Board here failed to find Part 1 was met and failed to require Petitioner to address the Office's prior consideration of Nozaki '269, instead placing the burden on Patent Owner. Allowing this ID to stand allows other panels to similarly misapply *Advanced Bionics* resulting in an inconsistent application of a precedential decision.

The Board's misapplication of the precedential *Advanced Bionics* decisions warrants Director Review to restore consistency to its application across all petitions and to correct the Board's inconsistent finding under Part 1.

V. CONCLUSION

For at least the foregoing reasons, Director Review of the ID is warranted because the Board's burden-shifting decision amounts to an impermissible abuse of discretion. Additionally, this request presents important issues of law and policy as to consistent application of *Advanced Bionics* that merit Director Review.

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Dated: November 21, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November, 2024, a copy of the attached PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW, 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: November 21, 2024

By: /Robert G Pluta Reg No 50970/
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