

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. IPR2025-01312
Patent No. 7,952,645

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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I. INTRODUCTION

The Director should reject Maxell's request for discretionary denial (Paper 10, "DD Brief"). The trial in the corresponding district court litigation will take place at least five months after the final written decision. The other *Fintiv* factors also favor institution. In the district court, Maxell has asserted ten patents in ten different families covering a wide range of technologies, which further favors institution. Maxell can have no settled expectations in its third-string '645 patent given the PTAB's recent string of final written decisions and the district court's order finding claims of Maxell's first-string patents to be unpatentable or invalid. The examiner's material error and Maxell's attempt to shift the patent's purported invention into new areas of technology also favor institution.

To try to deflect attention from the weakness of its position, Maxell creates a skewed version of the parties' disputes and lobs untrue accusations that Samsung is acting unreasonably by not surrendering to Maxell's licensing demands. At the same time, Maxell ignores the district court's finding of noninfringement of all five Maxell patents that have been adjudicated, ignores the PTAB's recent string of final written decisions finding claims from Maxell's patents to be unpatentable, and ignores its own problematic conduct during its litigation campaign against Samsung. A holistic assessment of these and other factors warrants denying Maxell's request for discretionary denial.

II. BACKGROUND

Samsung filed the petition in this IPR along with nine others in response to a second district court lawsuit brought by Maxell against Samsung. Although Maxell's brief repeatedly refers to Samsung's "infringement," Maxell omits that the district court found noninfringement of all five adjudicated patents in Maxell's first lawsuit against Samsung. In that lawsuit, Maxell asserted seven patents, which common sense dictates were Maxell's best patents. EX1016, ¶166. The district court severed two of those patents into separate lawsuits. EX1017, 1; EX1018, 1. Of the five remaining patents, the district court granted summary judgment of noninfringement of two patents before trial, and granted judgment as a matter of law of noninfringement of the other three patents after trial. EX1019, 60, 64; EX1020, 39. The district court also granted judgment as a matter of law of invalidity for two of those three patents, finding that the asserted claims improperly claimed subject matter not disclosed in the specification in violation of 35 U.S.C. § 112. EX1020, 27-31, 33-37. Thus, contrary to Maxell's portrayal of Samsung as an "infringer," the district court has determined that Samsung does not infringe any of the five Maxell patents that have been adjudicated so far, and Samsung is rightfully defending itself against additional unfounded infringement claims.

To fully understand the impropriety of Maxell's conduct in its "multi-jurisdictional legal campaign against Samsung" (DD Brief at 12), Samsung

provides a brief summary of the history between the parties, which is at odds with Maxell's portrayal. Samsung and Maxell's predecessor, Hitachi, entered into a Patent Sale Agreement in 2011, in which Samsung bought ten patent families and permanently licensed other patents. EX1021, 109:20-110:9. Samsung also obtained a term-limited license to thousands of other patents in Hitachi's portfolio, which expired in 2016. DD Brief at 2. For five years after the expiration of that license, Maxell did not contact Samsung about renewing that license. EX1021, 819:17-820:19. Samsung understandably took this as an indication that Maxell shared Samsung's belief that a renewed license to these patents was unnecessary.

In July 2021, Maxell sent Samsung a letter seeking to start licensing discussions and listing nearly 200 Maxell patents along with vague categories of accused Samsung products. EX1022. Samsung immediately responded, expressing a willingness to talk. EX1023, 8. Maxell waited until December 2021 to send another letter, in which it listed almost 30 additional patents, again with vague categories of Samsung products, bringing the total between the two letters to more than 220 patents. EX1024. Neither letter identified any patents as being particularly important or included any claim charts purporting to show infringement of any of the patents. EX1022; EX1024.

Samsung did what any party in its position would do: it requested claim charts mapped to specific products and features three times. EX1023, 1-4. Despite

falsely alleging that it provided Samsung with “detailed information” about “Samsung’s ongoing use of [Maxell’s] patent technology” (DD Brief at 3)—a claim since disproven for the five patents adjudicated in the first district court action—Maxell refused to provide claim charts or to identify any particular patents of interest so that the parties could have a meaningful discussion. EX1023, 2. Indeed, Maxell admits that it decided not to provide “detailed infringement charts for even a handful of patents,” to prevent Samsung from challenging those patents in a declaratory judgment action or, presumably, an IPR. DD Brief at 3-4. Maxell then went silent for 18 months before filing its first lawsuit against Samsung, asserting seven patents in September 2023 that it never highlighted for Samsung other than to list them among the over 200 other patents in Maxell’s 2021 letters.

In response to that lawsuit, Samsung filed seven IPR petitions for six of the seven asserted patents.¹ The PTAB instituted all seven IPRs and recently issued final written decisions in five of them. The PTAB found all challenged claims unpatentable in three decisions (IPR2024-00717, -00828, and -00867), found most challenged claims unpatentable in another (-00735), and found no challenged claims unpatentable in another (-00777).

Before the first district court action even reached trial, Maxell tried to coerce

¹ IPR2024-00717, -00735, -00777, -00828, -00867, -00906, and -00907.

Samsung into taking a license by filing a complaint in the ITC, multiple complaints in Europe's Unified Patent Court, multiple complaints in Japanese courts, and another complaint in the Eastern District of Texas. *See* DD Brief at 4. In response to the second district court lawsuit, Samsung promptly filed petitions seeking IPR of all ten asserted patents. *See* IPR2025-01307 through -01316.

Maxell's patents deserve heightened scrutiny in view of Maxell's pattern of concealing material information from, and submitting contradictory positions to, the Patent Office. In IPR2024-00867, a recent filing revealed that Maxell had been withholding critical information from the PTAB and a Patent Office examiner. EX1025, 5-8. The examiner had been evaluating a continuation of the challenged patent without being notified by Maxell of either the pending IPR challenging similar claims in the challenged patent, or the fact that Maxell had taken a position in district court that contradicted its arguments to distinguish the prior art. *Id.* This was not an isolated incident. The PTAB recently found that Maxell also: (1) failed to disclose to the examiner reviewing a continuation of Maxell's '757 patent the material institution decision in the '757 patent IPR; and (2) failed to disclose to the PTAB the existence of the continuation application. EX1026, 3-6.

Moreover, Maxell repeatedly has submitted contradictory arguments between district court and the PTAB to argue for infringement on the one hand and to try to preserve the validity of its patents on the other. In the May 2025 district

court trial, Maxell’s technical expert opined that a “processor” was “the same” as the claimed “controller,” but in IPR proceedings that same expert unequivocally argued the opposite: “a POSITA would not equate any type of processor to a controller.” *See* EX1027, 8-10; *see also* EX1028, 3-5. Maxell again took opposite positions before the district court and the PTAB just six days apart on the issue of whether two touches constitute a single touch operation or multiple touch operations. *See* EX1019, 63-64. And in two IPRs, Maxell tried to distinguish the prior art by arguing that it lacked discrete “modes” with “wholly different processing operations,” but in the district court trial argued the opposite. EX1027, 8-10. Maxell’s allegation that Samsung has taken inconsistent positions (DD Brief at 13-14) rings hollow because the PTAB already has rejected one such accusation. EX1029, 2 (finding that the allegation that Samsung’s expert took “inconsistent” positions is “false”). It is Maxell that has taken inconsistent positions between the district court and the PTAB. *See also* EX1030, 7-10 (another example).

Maxell has continued that behavior in this round of IPRs by taking inconsistent positions for the ’650 and ’646 patents. *Samsung Elecs. Co. v. Maxell Ltd.*, IPR2025-01308, Paper 13 (Dec. 4, 2025); *Samsung Elecs. Co. v. Maxell Ltd.*, IPR2025-01316, Paper 11 (Nov. 24, 2025). Samsung notes the Board’s order dated December 1, 2025 stating that “[t]he Office received an *ex parte* communication” regarding this and other Samsung IPRs. Paper 11; EX3001.

III. DISCRETIONARY DENIAL IS NOT WARRANTED

A holistic evaluation of *Fintiv* factors and the additional considerations in the March 26, 2025 Memorandum show that discretionary denial is not warranted.

A. The Complex and Diverse District Court Litigation Tips the Balance Against Discretionary Denial.

A “complex and diverse” district court litigation “tip[s] the balance against discretionary denial.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Acting Director Jun. 13, 2025); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Acting Director Jul. 17, 2025) (same). In *Tesla*, “the district court proceeding involve[d] eleven patents spanning nine different families that involve a diverse range of subject matter.” *Tesla*, Paper 9 at 2-3. In *Tuozhu*, the district court proceeding “involve[d] nine different patents spanning six families that involve a diverse range of subject matter.” *Tuozhu*, Paper 10 at 2. The Acting Director explained that “[t]he large number and vast scope of the patents asserted in the district court litigation ... weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla*, Paper 9 at 3; *Tuozhu*, Paper 10 at 3; *see also Samsung Elecs. Co. v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-00933, Paper 11 at 3 (Deputy Director Oct. 10, 2025) (same finding for a “large number and wide scope of patents”).

As in *Tesla*, *Tuozhu*, and *Wilus*, the parallel district court litigation here is

complex and diverse. It involves ten asserted patents spanning ten unique patent families involving disparate technologies, as summarized below. EX1013, 2.

Patent	Title	Technology
7,577,417	Mobile terminal	Power management by adjusting clock speed when a foldable device is closed
7,952,645	Video processing apparatus and mobile terminal apparatus	Video signal correction based on pattern detection
8,180,198	Playlist creating apparatus and method, and dubbing list creating apparatus and method	Playlist recommendation based on other selections
8,471,950	Signal processor for adjusting image quality of an input picture signal	Image processing
10,783,228	Information processing device, application software start-up system, and application software start-up method	Communications between devices related to biometric sensors
10,812,646	Portable terminal apparatus	Different display modes for remote control on a mobile device
11,026,088	Communication system, communication device and communication terminal device	Permitting external entity to display video on a display device on a temporary basis
11,277,650	Contents receiving system and client	Distribution of video from a main terminal to subsidiary terminals
11,812,091	Multimedia player displaying operation panel depending on contents	Displaying different control panels depending on digital content being displayed
12,160,681	Video transmitter apparatus and video receiver apparatus	Screen mirroring video from a source to display device

The parallel district court litigation for this IPR therefore involves a similar number of patents (ten here versus eleven in *Tesla*, nine in *Tuozhu*, and twelve in

Wilus) and more patent families (ten here versus nine in *Tesla*, six in *Tuozhu*, and eight in *Wilus*), making it even more complex and diverse than the parallel litigations in those IPRs. Moreover, unlike *Tesla*, *Tuozhu*, and *Wilus*, the final written decision due date in this proceeding will precede the not-yet-scheduled trial date, as established below for *Fintiv* factor two. And unlike *Tesla*, there has not been a “meaningful investment in the district court litigation by the parties,” as shown below for *Fintiv* factor three. *Tesla*, Paper 8 at 4-5 (*Markman* hearing scheduled months before the institution decision). This proceeding and its parallel litigation therefore present a more compelling case against discretionary denial than *Tesla*, *Tuozhu*, and *Wilus*, where the Acting Director found that the circumstances tipped the balance against discretionary denial.

B. The Examiner’s Material Error Weighs Against Discretionary Denial.

The Director has consistently found that discretionary denial is inappropriate when the Patent Office materially erred during prosecution of a challenged patent. *E.g.*, *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (Acting Director Jul. 17, 2025). The ’645 patent examiner never rejected the ’645 patent claims in light of the prior art, and allowed the claims because the prior art supposedly did not disclose “applying correction processing to a video signal when non-content pattern data is not detected/contained, and not applying the correction when the pattern data is detected/contained.” EX1002, 21. But the Konuma reference that

the examiner cited and considered discloses this limitation several times. EX1031, 8:62-9:6 (“[a] video signal of the effective picture area,” which exclude the “non-picture portions,” “is extracted” and “adjusted”), 9:15-26 (same), Figs. 8A-B (same), Figs. 9A-B (same), 3:7-14 (same), 3:18-24 (same). The examiner’s material error in this regard further weighs against discretionary denial.

C. The *Fintiv* Factors Do Not Support Discretionary Denial.

The *Fintiv* factors do not support discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”).

1. Factor 1 (Stay) Does Not Support Discretionary Denial.

This factor considers “whether a stay exists or is likely to be granted if a proceeding is instituted.” *Fintiv*, Paper 11 at 6. Samsung has filed a pending motion to stay the underlying litigation. EX1032. The Board “will not attempt to predict how the district court ... will proceed” regarding potential stays “because the court may determine whether or not to stay any individual case ... based on a variety of circumstances and facts.” *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (P.T.A.B. Jun. 16, 2020) (informative). For this reason alone, this factor is neutral and does not support discretionary denial.

Maxell’s framing of the timing of Samsung’s motion to stay as a “tactical maneuver” and “gamesmanship” (DD Brief at 16) is baseless because Samsung

simply filed the motion shortly after it had filed its last petition for IPR of the Maxell patents asserted in the latest district court action. EX1032 (filed October 24th, eleven days after the October 13th filing of the petition in IPR2025-01310).

2. Factor 2 (Trial Date) Does Not Support Discretionary Denial.

This factor considers the “proximity of the court’s trial date to the Board’s projected statutory deadline.” *Fintiv*, Paper 11 at 9. This factor weighs against discretionary denial where the statutory deadline precedes the trial date. *E.g.*, *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (Acting Director May 16, 2025) (not denying institution because “it is likely that a final written decision in this proceeding will issue before the district court trial occurs”).

Here, the district court has set a pretrial conference for August 10, 2027, but has not set a trial date. EX2004, 1-2. Trial will be no earlier than August 10, 2027. Maxell’s reliance on average trial date statistics (DD Brief at 17) is irrelevant because the court already has set a schedule and will not move a trial date forward. The statutory deadline for the Board’s final written decision is March 5, 2027, more than five months before the earliest possible trial date. This factor therefore weighs strongly against discretionary denial.

3. Factor 3 (Parallel Proceeding) Does Not Support Discretionary Denial.

This factor considers “the amount and type of work already completed in the

parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Id.* at 10. Here, the district court has not made any substantive rulings on the ’645 patent, and it is unlikely to do so prior to the institution decision deadline in March 2026. EX2004 (Docket Control Order), 5-7. Maxell does not argue otherwise. DD Brief at 18-19.

Maxell’s argument that the parties will “be well into the claim construction process” at the time of the institution decision (DD Brief at 18-19) ignores the fact that the key milestones of *Markman* briefing and the *Markman* hearing will come after the institution decision deadline of March 5, 2026, as shown below.

Event	Date
Opening Claim Construction Brief	March 11, 2026
Responsive Claim Construction Brief	April 1, 2026
Reply Claim Construction Brief	April 15, 2026
<i>Markman</i> Hearing	May 6, 2026
Fact Discovery Deadline	October 23, 2026
Opening Expert Reports	December 8, 2026
Rebuttal Expert Reports	January 12, 2027
Expert Discovery Deadline	February 2, 2027
Dispositive Motions	February 16, 2027
Dispositive Motion Hearing	May 11, 2027
Pretrial Disclosures	June 22, 2027
Joint Final Pretrial Order	July 13, 2027
Motions <i>in Limine</i>	July 13, 2027
Pretrial Conference	August 10, 2027

EX2004, 2-5; *see also SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (P.T.A.B. Apr. 7, 2025) (this factor favored institution even after *Markman* briefing was complete); *Samsung Display Co., v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 7 (P.T.A.B. Mar. 6, 2025) (this factor weighed against denial, even though a *Markman* hearing had been held, in part because “much remain[ed] to be done, including expert discovery”). The schedule also shows that much work will remain in the district court at the time of the institution decision, which further disfavors discretionary denial. *Samsung Display*, Paper 12 at 7.

Moreover, Samsung was diligent in filing this petition on August 29, 2025, approximately four months after the complaint was filed on April 21, 2025. Samsung also filed this petition only about two weeks after Maxell served preliminary infringement contentions on August 12, 2025, and almost eight months before the statutory deadline. *See Samsung Elecs. Co. v. Mullen Indus. LLC*, IPR2024-01472, Paper 9, at 10 (P.T.A.B. Mar. 31, 2025) (finding diligence when petition was filed less than five months after infringement contentions). This factor therefore weighs strongly against discretionary denial.

4. Factor 4 (Issue Overlap) Weighs Strongly Against Discretionary Denial.

This factor considers the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 12. Samsung has submitted a

broadened *Sotera* stipulation (“*Sotera plus stipulation*”) in this IPR. EX1015; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (“*Sotera*”) (describing the standard, narrower *Sotera* stipulation). Samsung’s *Sotera plus stipulation* goes beyond the standard *Sotera* stipulation by extending to “any ground based on a combination of system prior art (*i.e.*, prior art that is neither a patent or printed publication) and the references that form the basis of any ground raised in [this IPR]” and “any ground that could be raised under §§ 102 or 103 on the basis of system art corresponding to a reference that forms the basis of any ground raised in [this IPR].” EX1015, 2. Samsung’s *Sotera plus stipulation* ensures that this IPR will be a true alternative to the parallel district court action. Indeed, the Acting Director described this type of stipulation as “broad” and as a factor that helps “tip the balance against discretionary denial.” *Tuozhu*, Paper 10 at 3; *Shenzen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438, EX1033 at 1 (stipulation with a scope identical to Samsung’s *Sotera plus stipulation*); *see also Tesla*, Paper 9 at 2 (such a stipulation is “broad” and “counsel[s] against discretionary denial”); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, EX1067 at 2 (stipulation). In view of Samsung’s *Sotera plus stipulation*, this factor weighs against discretionary denial.

Furthermore, although Maxell is asserting every challenged claim of the ’645 patent in the district court, the court has issued an order limiting Patent Owner

to “no more than five (5) asserted claims per patent” at trial. EX1033, 2. Thus, Maxell will be forced to withdraw some asserted claims in the district court. This IPR therefore would resolve the patentability of more claims than the district court will. This fact further reduces the issue overlap between the two proceedings. This factor weighs strongly against discretionary denial.

5. Factor 5 (Same Party) Does Not Support Discretionary Denial.

Because Samsung and Maxell are the parties in the district court litigation, and because the Board will issue a final written decision more than five months prior to any trial in the district court, this factor weighs against discretionary denial. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00302, Paper 13 at 18-19 (P.T.A.B. Jul. 11, 2022) (factor five weighs against discretionary denial when the statutory deadline for the final written decision is before the expected trial date in the parallel litigation).

6. Factor 6 (Other Considerations) Does Not Support Discretionary Denial.

This factor considers any “other circumstances” as “part of a balanced assessment of all the relevant circumstances.” *Fintiv*, Paper 11 at 14. Here, the merits of the petition are strong. The petition includes two grounds for three of the ’645 patent’s eight claims. Paper 3 at 1. And the cited prior art collectively discloses every limitation of each challenged claim. *Id.* at 19-75. Maxell identifies

no weakness in any of the challenges. DD Brief at 20. This factor therefore also weighs against discretionary denial.

In sum, none of the *Fintiv* factors favor the Director exercising discretion to deny institution and several factors weigh strongly against discretionary denial.

D. The Parties' Settled Expectations Do Not Support Discretionary Denial.

Samsung's settled expectations regarding the '645 patent outweigh any settled expectation Maxell may have. Maxell can have no settled expectations about the '645 patent's validity in light of several recent PTAB and district court decisions invalidating claims from the first patents that Maxell asserted against Samsung. The PTAB found all challenged claims unpatentable in IPR2024-00717 (addressing the '757 patent), -00828 (addressing the '086 patent), and -00867 (addressing the '848 patent), and found most challenged claims unpatentable in IPR2024-00735 (addressing the '815 patent). The district court also found claims of Maxell's '086 and '815 patents to be invalid based on written description deficiencies. EX1020, 27-31, 33-37. Collectively, the PTAB and the district court so far have found the claims of four out of seven Maxell patents to be unpatentable or invalid, in whole or in part. And all of those decisions address patents that Maxell selected for its first action against Samsung, which presumably were Maxell's best patents. Maxell did not assert the '645 patent against Samsung until its third U.S. lawsuit against Samsung. *See* Section II. In light of the validity

defects in its first-string patents, Maxell cannot have settled expectations about the validity of its third-string '645 patent. Moreover, Maxell's five-year silence after the expiration of Samsung's 2011 license gave Samsung settled expectations that it would not be subject to patent infringement claims by Maxell. *See* Section II.

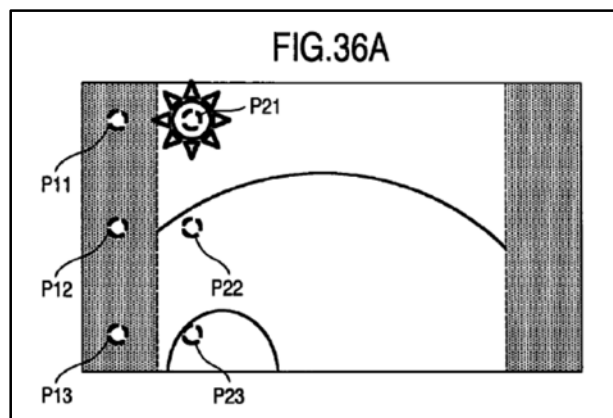
Maxell's argument that Samsung had "actual notice" of the '645 patent through Maxell's 2021 letter ignores that Maxell's letters to Samsung listed more than 220 patents. DD Brief at 9; *see* Section II. And Maxell did not distinguish the '645 patent from the other 220 patents. EX2001, 32 (listing it 38th in a table of 143 patents). Samsung could not have been expected to challenge all 220 patents, and doing so would have unnecessarily strained PTAB resources. Maxell admits that it decided not to provide "detailed infringement charts for even a handful of patents," and its strategic decision to avoid identifying a reasonable number of patents of interest should not be rewarded. DD Brief at 3-4.

Maxell's reliance on the *Samsung Elecs. Co. v. GenghisComm Holdings, LLC* cases is misplaced because, in those decisions, the Acting Director found that the *Fintiv* factors favored discretionary denial. DD Brief at 7; IPR2025-00780, Paper 11 at 2; IPR2025-00788, Paper 12 at 2. In contrast, the *Fintiv* factors here weigh strongly against discretionary denial, as established above.

E. Maxell Has Shifted the '645 Patent's Purported Invention to a New Area of Technology.

A patent owner "unexpectedly shifting its invention into new areas of

technology” disfavors discretionary denial. EX1034, 2. The ’645 patent relates to video processing that depends on whether the video signal includes portions that are not content and that are a pattern. EX1001, 24:52-54 (claim 1 reciting “detect[ing] whether pattern portions other than contents are contained in the video signal”), 25:7-9 (claim 3 reciting same), 26:1-2 (claim 5 reciting “pattern portions [that] are no-picture areas”). An example of such a non-content pattern portion in the patent is “wallpapers” on the left and right side of the video that are “black no-picture areas,” as shown in its Figure 36A.



Id., 1:41-45, 1:51-54, 19:26-30; *see also id.*, Fig. 29 (same), 16:57-17:1. The patent’s claims recite correction of the video signal that is dependent upon the detection of such non-content pattern portions. *Id.*, 24:57-62, 25:18-20, 26:5-11.

Maxell has unexpectedly shifted the purported invention into new areas of technology in two ways. First, Maxell ignores the claims’ recitation of a “video signal” and asserts infringement based instead on static images. EX1014, 107 (“image signal,” “image corrections”), 108 (“image signal”), 144 (“image

corrections”), 153 (“image signal”), 155 (“corrections on ... the image”), *passim*. Second, Maxell ignores the claims’ recitation that the pattern portions be “other than contents” or “no-picture areas” and asserts infringement based instead on supposed pattern portions that are part of an image’s content or picture. *Id.*, 145-147, 154-155 (asserting that the recited “pattern portions” are image contents such as a “[c]loud,” “foliage,” a “[w]all,” “[c]loth,” “[s]now,” and “[s]tair[s]”). For example, Maxell asserts that the cloud in the background artwork in the photograph below is a pattern portion and therefore not part of the photograph’s content. *Id.* at 145.



Such an unexpected, fundamental shift of the supposed invention into new areas of technology further disfavors discretionary denial.

F. Samsung’s Positions Regarding the ’645 Patent’s Claim Terms Are Entirely Consistent.

Maxell tries to manufacture “inconsistent” Samsung positions by recasting Samsung’s assertions of lack of written description in the district court as

assertions that claim limitations are “unclear [and] ambiguous.” DD Brief at 14. To be clear, Samsung has not asserted that any limitation of any of the ten newly asserted patents is indefinite. EX2015, 175-187 (never asserting indefiniteness). The written description requirement is fundamentally different than indefiniteness—the former considers whether a claim limitation is sufficiently disclosed in the specification and the latter considers whether a claim limitation is sufficiently clear. *Compare Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*) (under the written description requirement, “the specification must ... show that the inventor actually invented the invention claimed”) *with Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014) (“[t]he definiteness requirement ... mandates clarity” of claim terms). For example, when the district court found claims of Maxell’s ’815 patent to be invalid because their “encryption” limitation lacked written description support, it did so because the specification did not disclose that limitation, not because the limitation’s meaning was unclear. EX1020, 35-37. The Director should deny Maxell’s request for discretionary denial for these additional reasons.

IV. CONCLUSION

For the foregoing reasons, the Director should deny Maxell’s request.

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on December 5, 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:

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A courtesy copy also was sent to via email to:

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