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.: IPR2024-00735
U.S. Patent No. 11,017,815

PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

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1028	U.S. Patent Application Publication No. 2004/0064476 to Rounds ("Rounds")
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I. INTRODUCTION

The Board's Scheduling Order warned that arguments not made in its patent owner responses may be deemed waived. In the parallel district court proceeding, the court adopted several claim constructions in an order dated November 5, 2024. When Maxell filed its patent owner responses nearly three months later, it made the strategic decision not to request that the Board adopt the district court's construction of "character," while at the same time requesting that the Board adopt other claim constructions in that same order. Maxell made this decision because it knew that if it attempted to apply the district court's construction here, then its statements here would hamper its ability to argue infringement in the district court. Only after trial in the district court does Maxell now request that the Board adopt the very construction it consciously eschewed in its patent owner responses. Such tactical gamesmanship is not in the interests of justice and should be rejected.

II. PO WAIVED ARGUMENTS BASED ON THE "CHARACTER" CONSTRUCTION IT ASKS THE BOARD TO ADOPT

All the supplemental information Maxell seeks to submit concerns the construction of the "character" limitation that appears in each independent claim of the '815 patent. Mot., 1-2. Maxell knew about this construction long before Maxell filed its Patent Owner Responses ("PORs") in both the 735 and 777 IPRs on January 31, 2025. In fact, both of Maxell's PORs cited the district court claim

construction order and requested that the Board adopt some of the district court's constructions that Maxell liked, but they did **not** request that the Board adopt the district court's "character" construction that Maxell now belatedly seeks to inject into this proceeding. *See* 735 POR at 6-7; 777 POR at 12, 17 (requesting that the Board adopt the district court's construction of "user profile" and "user preferences" but not "character"); EX2033 at 31 (listing court's constructions).

Maxell was well aware of the scope of the district court's "character" construction when it filed its PORs. Indeed, in addition to the scope of the construction being comprehensible on its face, Maxell argued in its Reply *Markman* brief to the district court that the construction, if adopted, would exclude titles made up of multiple letters and complex graphics. EX1074, 2-3. Thus, contrary to Maxell's current assertion that it somehow did not understand the scope of this construction until the district court trial, it plainly did. But Maxell elected not to ask the Board to adopt the construction here because of its apparent concern that any reliance on such a construction here would undermine its infringement case in the district court.[1]

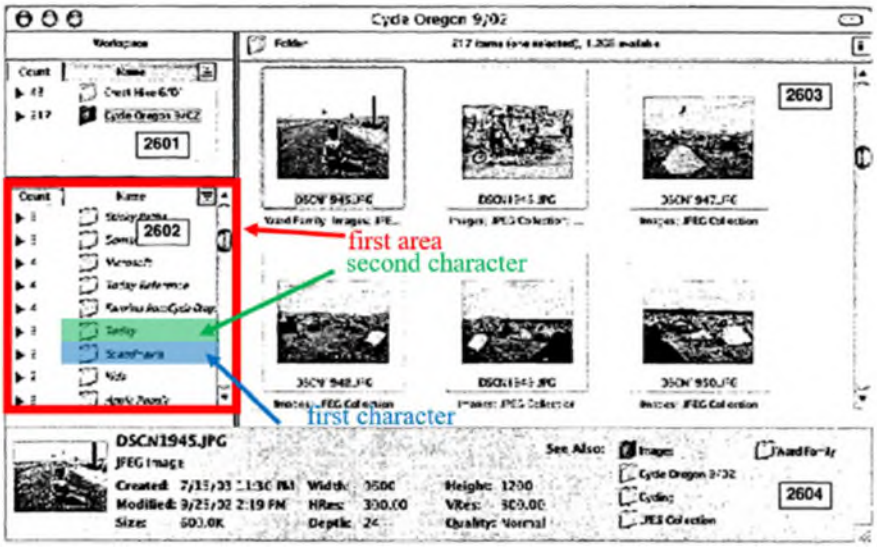
[1] Maxell's arguments in IPR2024-00717 were relied on by the district court to grant summary judgement of non-infringement. EX1075, 4-5.

When Maxell made the strategic choice not to request the district court's "character" construction and arguments based thereon, it waived that construction and those arguments. Paper 12 (Scheduling Order) at 9 ("Patent Owner is cautioned that any arguments not raised in the response may be deemed waived."); *see also, e.g.*, *Snap Inc. v. Sanderling Management Ltd.*, IPR2021-00779, Paper 38, at 31 and 36 n.10 (P.T.A.B. October 31, 2022) (finding waiver of claim construction and other arguments not made in patent owner response because petitioner was deprived of opportunity to address them in reply brief and declaration); *In re Nuvasive, Inc.*, 842 F.3d 1376, 1380 n.4 (Fed. Cir. 2016) (holding that waiver at PTAB precludes consideration on appeal).

III. THE '815 IPRS ARE CONSISTENT WITH THE DISTRICT COURT'S "CHARACTER" CONSTRUCTION

Dr. Kia's testimony in the district court is consistent with Dr. Bederson's testimony here concerning the "character" construction. Dr. Bederson testified that individual letters, such as "S" and "T" in Horn's collection names, are selectable:

> In Fig. 26 below, one item in the list, e.g., "Scandinavia" (highlighted in blue) includes **a first character** (i.e., the **portion** of the item that is clicked to select it, which can include the **"S"** in Scandinavia) ... and a second item in the list, e.g., 'Today' (highlighted in green) that includes a **second character** (i.e., the portion that is clicked, which can include the **"T"** in "Today")...



EX1003, ¶151 (emphasis added). Dr. Bederson's testimony that a portion of "Scandinavia" that can be selected, the letter S, constitutes a first character, and that a portion of "Today" that can be selected, the letter T, constitutes a second character is consistent with the district court's construction of "character" because they are indisputably letters that can be represented by, e.g., single-byte ASCII codes.

A. Dr. Kia's Testimony Concerning The Samsung Gallery App

Maxell's assertion that Dr. Bederson's testimony here is inconsistent with Dr. Kia's district court testimony that there was no infringement of the "character" limitations by the Gallery app running on a Samsung Galaxy S23 smartphone is wrong. Dr. Kia's testimony was specifically based on the source code of the Gallery app. EX1076, 13-14 (1007:10-1008:3). The Gallery app is different from any prior art at issue in this IPR and the evidence regarding the two are different

too. Specifically, the Gallery app runs on an operating system, Android, that is different from any operating system at issue here. EX1076, 22 (1105:5-11); EX1005, 37:29-32. In addition, the Samsung smartphone includes a touchscreen, which is unlike the PCs of the prior art at issue here, which instead use conventional displays and pointing system such as a mouse. EX1076, 6-7 (681:21-682:10); *see* EX1005, 19:58-60 (discussing double-clicking). Moreover, there is no source code for any prior art here. In this regard, Maxell offers no proof, and does not even allege, that the way a user makes selections in the Gallery app on the touchscreen of a Samsung Galaxy smartphone running on Android bears any relationship to how a user makes a selection in any prior art at issue in this proceeding.

Dr. Kia's analysis of the Gallery app source code proved that what is selected by a user in the Gallery app is actually **an area** of the screen rather than anything that appears on the screen (such as an icon, title, or letter) in that area and that the area of the screen is not represented by one unit of information. EX1076, 25-27 (3:25-5:23); EX2014, 21-22. As part of his showing, Dr. Kia also physically demonstrated on the Galaxy smartphone that a Gallery album can be selected when nothing (no thumbnail, no title, no letter) is visible in the area corresponding to a Gallery album—proving beyond question that selection in the Samsung accused products is based upon area and not characters. EX1076, 15-19 (1009:9-1013:17);

EX2014, 22. There is thus nothing inconsistent between Dr. Kia's district court testimony showing that what is selected in the Gallery app is an area of the screen that is not represented by one unit of information, and Dr. Bederson's testimony here that individual letters that are represented by one unit of information are selected in the prior art at issue here.

B. Dr. Kia's Testimony Concerning The Netflix App

Maxell is also wrong that Dr. Kia's testimony concerning the Netflix app in the district court is inconsistent with Dr. Bederson's testimony here. In the district court, Maxell alleged that a complex graphic "Miyagi-Do" icon including embedded "Miyagi-Do Karate" letters appearing in the Netflix app constituted a "character." EX1076, 5 (127:8-19); EX1077, 73 and 78.

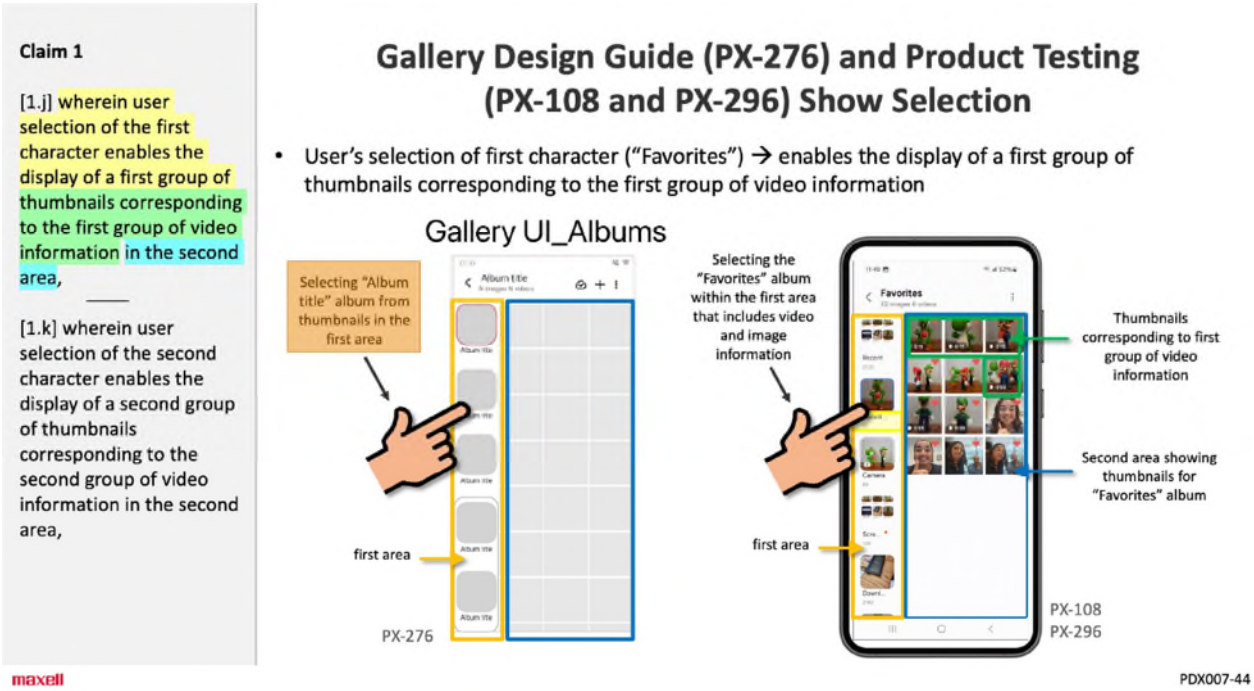
Dr. Kia testified that this complex graphic Miyagi-Do icon itself is not a character under the district court's construction because it is not represented by one unit of information but instead is represented by "hundreds to thousands of pixels, each containing multiple numbers." EX1076, 20-21 (1017:24-1018:16); EX2041, 25. Dr. Kia testified that the entire icon, rather than any part of it such as the letters

visible in the icon, is selected by a user of the Netflix app. EX1076, 22 (1019:3-7). Dr. Kia further testified that the letters that are visible in this complex icon are not like characters in a Word document, but rather are just fixed pixels numbering in the tens to hundreds of pixels and are therefore not characters under the district court's construction. EX1076, 22-23 (1019:11-1020:2); EX2041, 25. There is nothing inconsistent between any of this district court testimony and Dr. Bederson's testimony regarding the individual letters in the prior art at issue here.

For all the reasons discussed above, Maxell has failed to show any inconsistency between Dr. Kia's district court testimony regarding the Gallery and Netflix apps at issue in the district court and Dr. Bederson's testimony regarding the prior art at issue in this proceeding.

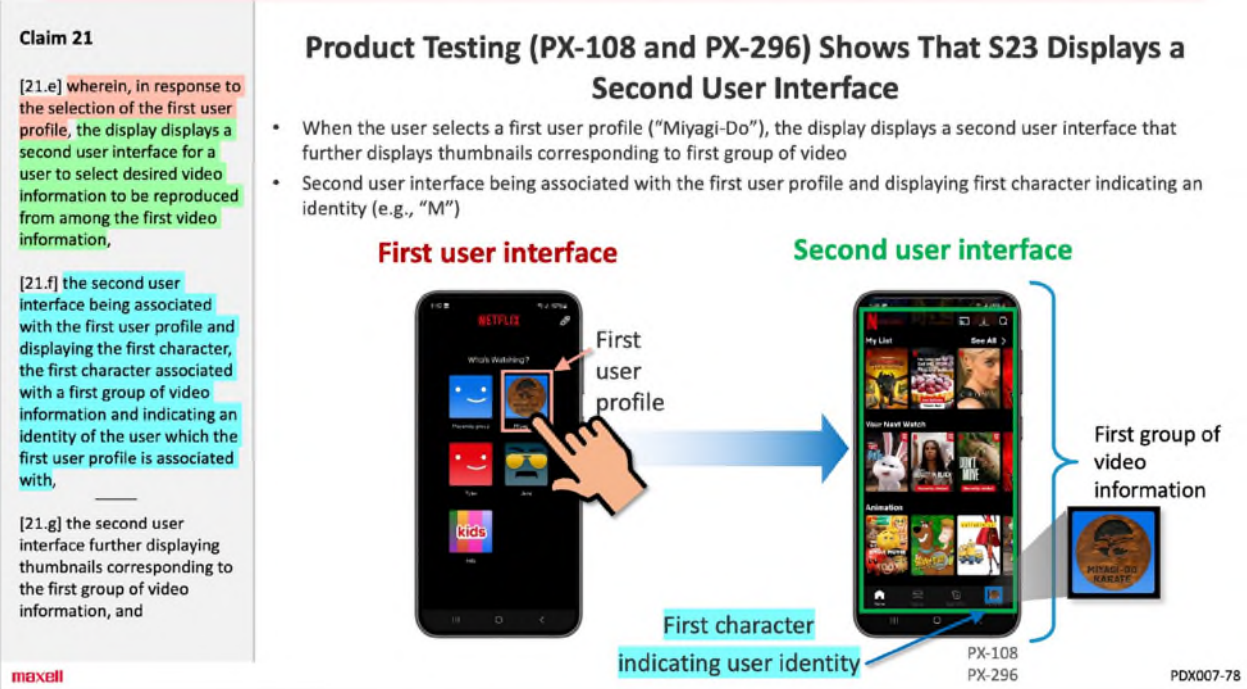
IV. MAXELL IS SEEKING TO TAKE INCONSISTENT POSITIONS HERE AND IN THE DISTRICT COURT

In the district court trial, Maxell's expert, Dr. Singh, testified on direct examination with respect to limitations [1j] and [1k] that what was selected by a user in the Gallery application was an **entire title** of an album such as "Favorites" (rather than an individual letter in that title). This is reflected in the demonstrative Dr. Singh presented to the jury, which refers (in the brown box on the left) to "Selecting 'Album title'" and (on the right) to "Selecting the 'Favorites' album" rather than selecting individual letters therein:



EX1077, 44 (brown highlighting added; other highlighting in original). Dr. Singh further testified on cross examination that "it's a touch screen. If you touch it, you have to touch it to select anything. And when you touch it, what you're selecting is what is underneath that -- what is displayed there." EX1076, 8-9 (755:25–756:7). Dr. Singh's district court testimony is contrary to the position Maxell now belatedly seeks to take here with respect to the prior art.

The same is true for Dr. Singh's testimony before the jury regarding limitation [21f]. At trial, Dr. Singh testified that limitation [21f] was found in the Netflix app because "you can see Miyagi-Do Karate" letters in the complex graphic icon shown to the right of the "second user interface" screen in the Maxell demonstrative reproduced below. EX1076, 5 (127:8-19).



EX1077, 78. Dr. Singh testified on cross examination that this limitation was satisfied because you can see the letters for Miyagi-Do Karate in the complex graphic icon. EX1076, 11 (768:18-23). Dr. Singh's district court testimony is inconsistent with the position that Maxell now belatedly seeks to adopt in these proceedings.

The Board has recognized the party presentation principle, which recognizes that parties are represented by competent counsel and can choose to make different arguments in different forums. *Abbott Diabetes Care Inc. v. DexCom, Inc.*, IPR2022-00913, Paper 14, at 15-16 (P.T.A.B., November 3, 2022). However, this does not mean that a party should be permitted to undo choices it already has made. Here, after choosing not to advocate for the district court's construction of

"character," and after advancing infringement theories in the district court that are different than the validity theories it has to date been advocating here, Maxell should not be allowed to change course at the 11th hour by advocating for a different construction in an attempt to avoid an unpatentability determination. Allowing Maxell to do so would not be in the interests of justice - it would in fact be wholly unjust.

V. CONCLUSION

The Board should find that Maxell's strategic decision not to seek the district court's "character" construction or to make the arguments it knew could be made based on that construction results in a waiver of that construction and those arguments. In any event, regardless of whether there was waiver, there is no inconsistency between Dr. Kia's district court opinions and Dr. Bederson's opinions here. Rather, it is Maxell that now seeks to take inconsistent positions in the district court and here. Accordingly, the Board should reject Maxell's motion as contrary to the interests of justice.

Date: September 21, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on September 21, 2025, a true and correct copy of the Petitioners' Request for Oral Argument was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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