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.: IPR2024-00828

U.S. Patent No. 8,982,086

PETITIONERS' SUR-REPLY TO PATENT OWNER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION

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After two motions and a reply brief, PO has yet to identify a single quote from Dr. Nielson's IPR testimony that contradicts his statements at trial. Instead, PO offers mischaracterizations of Dr. Nielson's IPR testimony, unsupported attorney argument about the prior art, and misleading assertions about Petitioners' positions in both proceedings. At the same time, PO contradicts its own prior arguments and downplays the recent JMOL order from the District Court that reversed the jury's infringement verdict and invalidated claim 1 of the '086 patent for lack of written description. In that order the Court rejected the "arbitrary," "*ipse dixit*," "conclusory," and "self-contradictory" testimony of PO's experts Dr. Wobbrock and Dr. Balakrishnan, the expert in IPR2024-00867, which is also before this panel. EX1026. PO's IPR positions here are similarly flawed and should be rejected.

I. DISCUSSION

A. PO's Motion Is Untimely and Prejudicial.

Petitioners' Response showed that Dr. Nielson's noninfringement positions were disclosed well before the POR deadline. *See* Resp. at 6-8. PO ignores that discussion entirely. Instead, PO declares in conclusory fashion that "Samsung provides zero support" for its arguments, suggesting that because Dr. Nielson did not use the words "branch" or "algorithm" in his expert report, PO has somehow proven its point. PO Reply at 1-2. Not so. Indeed, PO's expert Dr. Wobbrock did not once use the word "algorithm" during his direct testimony regarding infringement,

but he immediately agreed on cross-examination that the "fingerprint registration process" he talked about during his testimony could also be called "an algorithm." EX1024 at 569:20-570:16. In the passages of Dr. Nielson's IPR deposition testimony that Petitioners' response cites, Dr. Nielson discussed the "registration process" in the '086 patent and why the fingerprint sensors of the Samsung accused products do not use that registration process. In short, Petitioners disclosed their noninfringement theory long ago; PO simply chose not to raise it until now.

For that reason, PO cannot reasonably dispute the prejudice to Petitioners from allowing this evidence at this late stage. PO does not address any of the legal arguments that Petitioners raised in their response. *See* Resp. at 2-3. Nor does PO dispute that its motion, if granted, would deprive Petitioners of an opportunity to have their expert directly address PO's allegations. Instead, PO again asserts in conclusory fashion that "no prejudice" will result to Petitioners because "Samsung knew of the inconsistency it was introducing at trial." PO Reply at 2. Although PO now claims that it was not aware of the position Dr. Nielson would take at trial, PO never once objected that his trial testimony exceeded the scope of his expert reports, something PO would certainly have done had Dr. Nielson actually acted as PO alleges. *See generally* EX1017 at 880:17-942:7 (Nielson Direct). Thus, the trial record belies PO's assertion that "the specifics" of Petitioners' position were "not made clear until trial." PO Reply at 1.

B. Dr. Nielson's Positions Have Been Consistent At All Times.

Petitioners' Response explains, in detail and with extensive quotes, how Dr. Nielson's IPR testimony is consistent with his statements at trial. *See* Resp. at 6-8. PO addresses none of this, then inexplicably concludes that "the record is clear" regarding Dr. Nielson's alleged inconsistency (PO Reply at 3), even though PO still has not—after three briefs on this subject—provided a single quote from Dr. Nielson's IPR testimony that allegedly contradicts his trial testimony. PO's reply consists of nothing more than unsupported attorney argument about the disclosures in Rogers. *See* PO Reply at 3. This is improper at this stage.

C. PO and Its Experts Have Taken Inconsistent Positions.

PO states that "Samsung cannot have it one way for infringement and another for invalidity." PO Reply at 2. It is PO, not Petitioners, that have taken inconsistent positions. Dr. Wobbrock's testimony proves as much:

Type of Testimony	Quote from Dr. Wobbrock
Validity Testimony (EX2005 ¶ 111)	"A POSITA would not equate any type of processor to a controller."
Infringement Testimony (EX1023 at 2)	"For our purposes, controller, processor, they're -- they're the same."

In attempting to repair Dr. Wobbrock's inconsistencies, PO again misstates the facts and falsely alleges that Dr. Wobbrock's infringement testimony involved "a **CPU**." PO Reply at 5. But Dr. Wobbrock expressly equated a CPU with a processor. *See* EX2005 ¶ 106 (referring to "a processor (e.g., CPU)") and ¶ 110 ("a processor

(CPU)"); EX1023 at 2 (equating a CPU, processor, and controller).[1] PO also cannot explain its POR statement that "A Processor Is Not a Controller" (POR at 24), which cannot be reconciled with Dr. Wobbrock's trial testimony.

PO's inconsistent treatment of "modes" in this IPR and in IPR2024-00867 is even more egregious. As Petitioners explained, PO's position in both IPRs has been that "modes" must be distinct operational states, but in trial PO reversed itself and took an open-ended view of what constitutes a "mode." Resp. at 9-10. The District Court's JMOL Order (EX1026) validates Petitioners' point. Just as Petitioners did, the Court criticized Dr. Wobbrock for his "arbitrary labeling of 'modes'" and "view of a moded world" wherein "each touch of a new part of the finger resulted in the initiation of a new mode." EX1026 at 6-9. The Court discredited Dr. Wobbrock's "*ipse dixit*," "conclusory" testimony, and overturned the jury verdict of infringement because "none of the record evidence, aside from Dr. Wobbrock's conclusory testimony, describes multiple registering modes." *Id.* at 9. Similarly, the District Court discredited Dr. Balakrishnan's testimony about the "first setting mode" for

[1] Dr. Wobbrock's inconsistencies do not stop there. In the IPR, he distinguished Rogers because it lacked "two user interfaces in its modes" (EX2009 ¶ 125), but at trial he told the jury that "the user interface [does not have] to tell you what mode you're in" because "the device knows what mode it's in." EX1026 at 8.

registering a person in the '848 patent (which is the subject of IPR2024-00867), calling it "conclusory and self-contradictory," finding that it "stray[ed] from the original claim term" and did not establish "registration of a specific person in the first setting mode under any specific meaning of the term, much less a plain and ordinary one." EX1026 at 19-21. PO does not address any of this in its reply.

Indeed, PO's rebuttal to Petitioners' evidence of inconsistency on the meaning of "modes" results in still further contradictions. Specifically, PO asserts that it "does not need to argue that the claim elements are met by a single algorithm for registration" because Dr. Nielson said the words "sequence of algorithms" during his direct examination. PO Reply at 4. But the "sequence of algorithms" statement appears in the middle of the very testimony that PO elsewhere cites as evidence for its (incorrect) argument that Dr. Nielson advanced a new infringement theory that contradicts his opinions on Rogers. PO Reply at 3 (citing EX2017 at 907:24-980:7). So according to PO, Dr. Nielson's testimony simultaneously supports PO's infringement theory and forms the basis for Petitioners' allegedly new noninfringement theory. These statements, like others PO makes, cannot be reconciled and should not be credited.

II. CONCLUSION

PO's motion should be rejected or, at a minimum, given little to no weight.

Date: October 10, 2025

Respectfully submitted,

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CERTIFICATE OF PAGE LIMIT COMPLIANCE

Petitioners certify that this Sur-Reply complies with the 5-page limit set by the Board, as measured by Microsoft Word, exclusive of the table of contents, exhibit listing, and certificates of page limit compliance and service.

Date: October 10, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on October 10, 2025, a true and correct copy of the Petitioners' Sur-Reply to PO's Motion for Supplemental Information was served by emailing a copy of same (by agreement) to the following attorneys for the Patent Owner:

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