IN THE UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
WACO DIVISION

NEONODE SMARTPHONE LLC, Plaintiff, v. SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS AMERICA, INC., Defendants.	Civil Action No. 6:20-cv-00507 **JURY TRIAL DEMANDED**

ORDER REGARDING DISCOVERY DISPUTE

Upon consideration of the parties' supporting written positions concerning a discovery dispute submitted to the Court for resolution by the plaintiff Neonode Smartphone LLC ("Neonode") and defendants Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung") on April 15, 2024, and oral arguments concerning the same, the Court hereby **ORDERS** the following relief:

A. Discovery Dispute

Issue #2: Details regarding Samsung's contention or belief that 35 U.S.C. § 315(e) (IPR estoppel) does not apply.

1. Neonode (Requesting Party)'s Position

This information is relevant to the application of 35 U.S.C. § 315(e) to this case and the permissible scope and nature of Samsung's invalidity contentions, because Samsung, as a petitioner in IPR2021-00144 directed to the '879 Patent, may not assert in this litigation invalidity grounds that Samsung raised or reasonably could have raised in the IPR. *See* 35 U.S.C. § 315(e)(2).

Samsung's Final Invalidity Contentions identify 349 prior art patents and applications and 118 other prior art publications. Samsung's original interrogatory response did not explain why any of these 467 references could not have been raised in the IPR or, for the many that *were* raised in the IPR, why they are not estopped now.

Samsung's March 14 supplemental response limits Samsung's prior-art based invalidity contentions to nine theories premised upon products/systems and combinations thereof with patents and printed publications identified in Samsung's contentions. But Samsung's response remains deficient, for several reasons.

First, Samsung's nine products/systems contentions cite and rely upon 50+ patents and printed publications (a subset of the 467). With one exception, Samsung failed to explain why these 50+ references are not estopped. Samsung now says, "for references that qualify as 'patents and printed publications,' the only such reference Samsung contends is beyond the scope of estoppel is the PalmTop VHS video tape." But such hedging leaves unclear whether Samsung agrees that all of the remaining 50+ references qualify as "patents and printed publications" and are estopped.

Second, as to the PalmTop video, Samsung's response says it "could not have been raised by Samsung in an inter partes review" because "[a] skilled searcher conducting a diligent search reasonably would not have uncovered the reference." But in fact, Samsung submitted the video in IPR2021-00144 as an exhibit. Samsung has not explained why the video is not estopped.

Third, Samsung has not explained why its products/systems are not estopped. IPR estoppel can apply to products/systems that are merely cumulative of, and provide the same material teachings as, estopped patents or printed publications. *E.g.*, *Boston Sci. Corp. v. Cook Grp. Inc.*, 2023 WL 1452172, at *34 (S.D. Ind. Jan. 31, 2023); *Wasica Fin. GmbH v. Schrader Int'l, Inc.*,

432 F. Supp. 3d 448, 454–55 (D. Del. 2020). Here, Samsung relies heavily if not exclusively on the 50+ estopped references as evidencing the purported teachings of the products/systems raised in its contentions. Samsung has not explained how any of the products/systems are not cumulative of those estopped references.

Requested Relief: Order that: "Within 14 days following entry of this order, Samsung must, (1) for each patent and printed publication cited in or forming the basis of any invalidity contention, state the full and complete legal and factual basis for any contention or belief that such patent and printed publication is not subject to estoppel under 35 U.S.C. § 315(e), including a detailed explanation of why each patent and printed publication (alone or in combination) could not reasonably have been raised in a prior inter partes review, and (2) for each product and system raised in its invalidity contentions, state the full and complete legal and factual basis for any contention or belief that such product or system is not cumulative of patents and printed publications cited in Samsung's contention chart corresponding to the product or system."

2. Samsung (Responding Party)'s Position

Samsung has fully responded to this contention interrogatory by identifying prior art references and combinations it intends to pursue that could not have been raised in an IPR. Any further supplement will require Neonode to disclose its contentions regarding IPR estoppel—an issue on which Neonode bears the burden of proof and for which Neonode has refused to disclose its contention.

As to Neonode's first and second points, for references that qualify as "patents and printed publications," the only such reference Samsung contends is beyond the scope of estoppel is the PalmTop VHS video tape. Samsung disclosed in its response that Samsung could not have

previously raised this reference in IPR because it could not have been located with reasonable efforts prior to filing the IPR. Samsung's response is complete.

As for the third point—whether Samsung's product/system prior art is cumulative of an allegedly estopped reference—Samsung cannot provide further information until Neonode discloses its contentions, including by identifying any allegedly estopped reference, why that reference qualifies as an estopped reference, and why that reference is materially identical to the product/system. It is Neonode's burden to prove estoppel under 35 U.S.C. § 315(e) and Neonode has not yet pled, disclosed or otherwise put Samsung on notice of its contentions. Until it does so, Samsung cannot disclose its rebuttal contention. Neonode has thus far refused to disclose its estoppel contention in response to Samsung's Interrogatory No. 6, so Samsung has now served Interrogatory No. 29 explicitly focused on this issue.

Finally, Interrogatory No. 14 itself does not fairly request that Samsung explain whether an asserted product/system reference is "cumulative" to any particular other reference. Samsung should not be compelled to respond to a hypothetical contention that Neonode has thus far refused to disclose.

Requested Relief: Deny Neonode's requested Relief, or, in the alternative, order Neonode to respond to Samsung's Interrogatory No. 6 or 29 to disclose Neonode's contention within 14 days so that Samsung can provide a rebuttal contention.

ORDER: Samsung shall, by May 2, 2025, supplement its response to Interrogatory 14 so as to provide: (a) the basis for any assertion that any of the references listed below cited in Samsung's Final Invalidity Contentions do not qualify as patents or printed publications, and

(b) the basis for any assertion that any of these references could not reasonably have been raised by Samsung in *inter partes review* proceeding in accordance with 35 U.S.C. § 315(e):

A-4: PalmTop

1. Sony PalmTop PTC-500 Brochure
2. VHS Video of the Sony PalmTop device
3. PalmTop Computer PTC-500 Manual, 3-751-573-03, 1990
4. PalmTop Computer PTC-500 Guide, 3-751-572-02, 1990
5. Asahi Personal Computer, No. 40, July 15, 1990, pp. 40-42; Electronics Life, July 1990, pp. 77-82, 170
6. Tomoshi Hirayama, "The PalmTop will be a Remote Controller of Information Reservoir," Information Media, July 12, 1991
7. Tomoshi Hirayama, "Personalized Information Handling Machine PalmTop," ARC, Feb. 1, 1991.

A-5: Magic Cap

1. Sony Magic Link User's Guide, PIC-1000
2. Sony Magic Link User's Guide, PIC-2000
3. Using Magic Cap, The User's Guide for the DataRover 840, Icras, Inc.
4. Motorola Envoy Wireless Communicator User's Guide
5. Motorola Envoy Wireless Communicator Hardware Manual
6. U.S. Patent No. 5,611,031 (Hertzfeld)
7. U.S. Patent No. 5,689,669 (Lynch)
8. Chris O'Malley, "UNWIRED, the next generation of communications gear," Popular Science, Vol. 244, No. 4, April 1994
9. DataRover 840 Datasheet
10. DataRover Magic Cap OS Description
11. Envoy, New User Notes
12. Envoy, Getting Started
13. "Motorola Unveils Envoy Hand-Held Device: First Fully Integrated Two-Way Personal Wireless Communicator," March 7, 1994
14. Andrew Gore, "Magic Cap OS will let users walk through on-line world," MacWEEK, Vol. 7, No. 35, September 6, 1993, 1, 116

A-6: HP OmniGo

1. HP OmniGo 100 Organizer Plus brochure
2. HP OmniGo 100 Quick Start and User's Reference, HP Part No. F1310-90001, Ed. 1
3. U.S. Patent No. 5,949,408 (Kang)

A-7: Gigabar

1. How to Do Everything with Your Pocket PC Second Edition, 2002
2. Maximum PC, June 2001
3. Pocket PC 2002, Master the Skills You Need in Ten Minutes or Less, 2002
4. Alan Barlow, GigaBar Reviewed, 2001
5. Neil Faulkner, Installing and Customizing GigaBar (December 2000)
6. www.gigabar.com, (captured and archived 2000-2001 by web.archive.org)
7. Alan Barlow, GigaBar Reviewed, 2001, available at https://web.archive.org/web/20011024104021/http://www.foxpop.ndirect.co.uk/PocketPC/giga01.htm
8. GigaBar 1.55 Review (captured and archived 2000-2001 by web.archive.org), available at (https://web.archive.org/web/20010606232300/http://www.dalecoffing.com/software/gigabar/gigabar.htm
9. GigaBar software available at 20010601_APC_Jun_2001_CD1/workshop/pdas/files/GBInstall.exe within the zip file 20010601_APC_Jun_2001_CD1 found at https://archive.org/details/20010601APCJun2001CD1
10. https://web.archive.org/web/20010803153925/http://gigabar.com:80/litm/help/GigaBar.htm
11. Neil Faulkner, Installing and Customizing GigaBar at 4 (December 2000), available at https://web.archive.org/web/20010801214350/http://www.pocketpcpassion.com:80/General/NeilF/install_configure1.htm
12. Neil Faulkner, Installing and Customizing GigaBar Part 2 at 3 (December 2000), available at https://web.archive.org/web/20011201213124/http://pocketpcpassion.com:80/General/NeilF/install_configure2.htm
13. www.gigabar.com, (captured and archived 2000-2001 by web.archive.org), available at https://web.archive.org/web/20010801214350/http://www.pocketpcpassion.com:80/General/NeilF/install_configure1.htm
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A-8: IBM Simon

1. IBM Simon Says "Here's How!" User's Manual

A-11: Phillip LiMe

1. Video by Royal Philips Electronics N.V., dated 2000 ("Philips Video") (available at https://rauterberg.employee.id.tue.nl/movies/Living%20Memory/Living%20memory%20material.htm)
2. Oscar de Bruijn and Robert Spence, "Serendipity within a Ubiquitous Computing Environment: A Case for Opportunistic Browsing, Ubicomp 2001, LNCS 2201, pp. 362-369 (2001) ("Bruijn")
3. Stathis et al., "Living memory: agent-based information management for connected local communities," Interacting with Computers 14, pp. 663-688 (2002) ("Stathis")
4. Living Memory Prototypes (2000) (available at https://rauterberg.employee.id.tue.nl/movies/Living%20Memory/Articles/Philips-2000.pdf)
5. Jennifer L. Schenker, "Not Very PC," TIME digital, Feb. 28, 2000

A-12: AT&T EO

1. Getting Started With Your EO Personal Communicator Handbook ("Handbook") (1993);
2. Getting Started, PenPoint Operating System, Ver. 1.0 (1992);
3. Robert Carr and Dan Shafer, The Power of PenPoint (1991);
4. PenPoint User Interface Design Reference (1992);
5. Using PenPoint (1991)
6. PenPoint Demonstration Video (1991);
7. Introducing PenPoint Video

A-13: Apple Newton

1. Apple Newton MessagePad Handbook ("Handbook")

A-14: Gridlock

1. GridLock Manual

2. GridLock Manual, available at https://web.archive.org/web/20010419080124/http://www.pdabusiness.com/gridlock/manual.html
3. Gridlock software available for download at https://web.archive.org/web/20010412093604/http://www.pdabusiness.com/gridlock/index.html
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5. https://web.archive.org/web/20010408071649/http://www.pdabusiness.com/utils.html
6. https://web.archive.org/web/20010706080249/http:/freewarepalm.com:80/utilities/gridlock.shtml

Additional References Cited In One Or More System / Device Charts

1. Andrew Sears, et al., "A new era for touchscreen applications: High precision, dragging icons, and refined feedback," ADVANCES IN HUMAN-COMPUTER INTERACTION, Vol. 3, R. Hartson, D. Hix, Ed. 1992 ("Sears")
2. Beverly L. Harrison, et al., "Squeeze Me, Hold Me, Tilt Me! An Exploration of Manipulate User Interfaces," Xerox Palo Alto Research Center ("Harrison")
3. Wayne Westerman, "Hand Tracking, Finger Identification, and Chordic Manipulation on a Multi-touch Surface," Dissertation for Ph.D. in Electrical Engineering, University of Delaware
4. Xiangshi Ren & Shinji Moriyama, "Improving Selection on Pen-Based Systems: A Study of Pen-Based Interaction for Selection Tasks," ACM Trans-actions on Computer-Human Interaction, Vol. 7, No. 3, September 2000, pp. 384-416
5. IBM Simon Says "Here's How!" User's Manual
6. Mac OS 7
7. Mac OS 8
8. U.S. Patent No. 5,249,296 (Tanaka)
9. U.S. Patent No. 5,347,295 (Agulnick)
10. U.S. Patent No. 5,406,307 (Hirayama)
11. U.S. Patent No. 5,463,725 (Henckel)
12. U.S. Patent No. 5,563,996 (Tchao)
13. U.S. Patent No. 5,603,053 (Gough)
14. U.S. Patent No. 5,612,719 (Beernink)
15. U.S. Patent No. 5,615,384 (Allard)
16. U.S. Patent No. 5,621,874 (Lucas)
17. U.S. Patent No. 5,900,876 (Yagita)
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19. U.S. Patent No. 6,337,698 (Keely)
20. U.S. Patent No. 6,894,680 (Sasaki)
21. U.S. Patent No. 7,030,861 (Westerman)
22. U.S. Patent No. 7,251,790 (Drucker)
23. U.S. Patent No. 7,345,671 (Robbin)
24. U.S. Patent No. 7,606,819 (Audet)

SIGNED this 25th day of April, 2025

ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE