

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN MOBILE ELECTRONIC  
DEVICES**

**Inv. No. 337-TA-1432**

**ORDER NO. 18: INITIAL DETERMINATION GRANTING-IN-PART  
COMPLAINANT’S MOTION FOR SUMMARY  
DETERMINATION**

(September 2, 2025)

On August 11, 2025, complainant Maxell, Ltd. (“Maxell”) moved (1432-014) for summary determination (“Mot.”) regarding certain affirmative defenses asserted by respondents Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”). Samsung filed an opposition (“Opp’n”) on August 21, 2025. The motion is granted-in-part.

**I. STANDARDS OF LAW**

Commission Rule 210.18 governing summary determination states, in pertinent part:

The determination sought by the moving party shall be rendered if pleadings and any depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a summary determination as a matter of law.

19 C.F.R. § 210.18(b). The Commission has analogized summary determination to summary judgment, in which “the evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor.” *Certain Carburetors and Products Containing Such*

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*Carburetors*, Inv. No. 337-TA-1123, Comm’n Op. at 5–6 (Oct. 28, 2019) (“*Carburetors*”) (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986))). When the moving party bears the burden of proof on a particular issue, the moving party must show that there is no genuine issue of material fact as to every element. *See Meyers v. Asics Corp.*, 974 F.2d 1304, 1307 (Fed. Cir. 1992). When the nonmoving party bears the burden of proof on a particular issue, the moving party must show that the nonmoving party failed to produce evidence on an essential element of its claim or defense. *See Eli Lilly and Co. v. Barr Labs., Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001). A party moving for summary determination must identify the legal basis of its motion and must point to those portions of the record that show the lack of a genuine issue of material fact. *Carburetors*, Inv. No. 337-TA-1123, Comm’n Op. at 6 (citing *Novartis Corp. v. Ben Venue Labs., Inc.*, 271 F.3d 1043, 1046 (Fed. Cir. 2001) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986))).

Prosecution laches may render a patent unenforceable where a patentee's conduct “constitutes an egregious misuse of the statutory patent system.” *Personalized Media Communications, LLC v. Apple Inc.*, 57 F.4th 1346, 1354 (Fed. Cir. 2023) (citation omitted). Prosecution laches requires proving two elements: (1) the patentee's delay in prosecution must be unreasonable and inexcusable under the totality of circumstances and (2) the accused infringer must have suffered prejudice attributable to the delay. *See id.* The accused infringer bears the burden of proving the defense. *See id.* at 1353.

Collateral estoppel, or issue preclusion, arises “where the matter raised in the second suit is identical in all respects with that decided in the first proceeding and where the controlling facts

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and applicable legal rules remain unchanged.” *Comm’r v. Sunnen*, 333 U.S. 591, 599-600 (1948). The Commission applies issue preclusion when: “(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) the [parties] had a full and fair opportunity to litigate the issue in the first action.” *See Certain 3G Mobile Handsets & Components Thereof*, Inv. No. 337-TA-613 (Remand), Comm’n Op. at 13 (Sept. 21, 2015). The accused infringer bears the burden of proving the defense. *See Taylor v. Sturgell*, 553 U.S. 880, 907 (2008).

## II. PROSECUTION LACHES

Maxell first seeks summary determination that Samsung cannot sustain its prosecution laches defense. *See Mot.* at 4-14. It is undisputed that all three patents at issue—U.S. Patent Nos. 12,108,103, 11,509,953, and 11,445,241—claim priority, through strings of continuation applications, to U.S. patent applications filed in 2008 and to Japanese patent applications filed in 2007. *See Mot.*, Ex. 1 at 73-74. But “legitimate grounds for refiling a patent application” exist, even after many years, and “there are no strict time limitations” for application of prosecution laches. *Symbol Techs., Inc. v. Lemelson Medical, Education & Research Foundation, LP*, 422 F.3d 1378, 1385 (Fed. Cir. 2005).

Samsung offers literally no evidence that Maxell’s delays in filing the most recent continuation applications were unreasonable or inexcusable. *See Opp’n* at 5-6. Its only argument on this point is that the parties have a factual dispute over the patents’ written descriptions, that is, whether the substantive limitations of the claims asserted in the three patents at issue satisfy the written description requirement. *See id.* Written description is a distinct

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issue, however, and has no clear connection to the reasonableness or excusability of the timing of Maxell's patent filings. Samsung offers no reasoning of its own to show this connection, relying solely on *Sonos, Inc. v. Google LLC*, No. C 20-06754 WHA, 2023 WL 6542320, at \*18, \*27 (N.D. Cal. Oct. 6, 2023). Opp'n at 5. But the decision was reversed last week (August 28, 2025) and is therefore no longer good law. See *Google LLC v. Sonos, Inc.*, No. 2024-1097, slip op. at 15-17 (Fed. Cir. Aug. 28, 2025). Thus, Samsung's evidence regarding delay, which should be "thoroughly examined" to reach an equitable determination on prosecution laches, is therefore entirely insufficient. *Symbol Techs.*, 422 F.3d at 1386. Even assuming there is sufficient evidence on the prejudice element, therefore, Samsung has not met its burden and summary determination is warranted.

### III. COLLATERAL ESTOPPEL

Maxell further seeks summary determination that Samsung cannot sustain its collateral estoppel defense as to U.S. Patent No. 11,445,241 ("241 patent"). See Mot. at 14-25. The principal basis of this defense is an Order granting summary judgment of non-infringement of U.S. Patent No. 10,129,590 ("590 patent") ("SJ Order") in *Maxell, Ltd. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, No. 5:23-CV-92-RWS (E.D. Tex.) ("Texas Case"), which the Court in the Texas Case issued on May 2, 2025. See Opp'n at 13; Mot., Ex. 5. Samsung's defense asserts, in sum: (1) the Texas Case initially involved the 241 patent (and the 590 patent), but consideration of the 241 patent was stayed once the Commission instituted the present investigation; (2) the asserted claims of both patents require "an indication from [a/the] user . . . to transmit video information using the first radio communication circuit," and when the indication is received, "the controller assigns a connection to the first radio connection circuit";

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(3) the Court in the Texas Case granted summary judgment of non-infringement of the 590 patent because the “indication” claim limitation was missing from some Samsung functionality and the “assigns a connection” claim limitation was missing from other Samsung functionality; so (4) collateral estoppel should apply to the same functionality in this investigation, and no violation should be found for certain accused products. Opp’n at 10-17.

Maxell’s requested relief, a blanket finding that “collateral estoppel does not apply to the [241 patent],” is overbroad, for three reasons. Mot. at 25. First, patent claims need not be identical for collateral estoppel to apply; it suffices if they are not “materially” different. *Ohio Willow Wood Co. v. Alps South, LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013). Here, the relevant claim language of the 241 patent seemingly differs only immaterially from the corresponding language adjudicated in the Texas Case. See Opp’n at 14 (chart comparing claim 1 of the 590 patent to claim 25 of the 241 patent). Second, Samsung’s expert has offered an opinion that the pertinent limitations of the two patents do not “differ[] in scope,” and such extrinsic evidence may bear on claim construction. Opp’n, Ex. 1 at ¶ 1610. Third, although the present investigation involves several accused products not adjudicated in the Texas Case, Maxell does not dispute that the vast majority of accused products are the same in the two proceedings, or that some accused functionalities are the same. See Mot. at 15-16, 24. So even if the accused products and functionalities here are not completely identical to those in the Texas Case, collateral estoppel may still apply to whatever issues overlap.

Accordingly, Maxell’s motion (1432-014) is GRANTED-IN-PART as outlined above. This initial determination is hereby certified to the Commission.



Pursuant to 19 C.F.R. § 210.42(h), this initial determination shall become the determination of the Commission thirty (30) days after the date of service of the initial determination, unless a party files a petition for review of the initial determination within five (5) business days after service of the initial determination pursuant to 19 C.F.R. § 210.43(a), or the Commission, pursuant to 19 C.F.R. § 210.44, orders on its own motion a review of the initial determination or certain issues herein. Any issue or argument not raised in a petition for review, or response thereto, will be deemed to have been abandoned and may be disregarded by the Commission in reviewing the Initial Determination pursuant to 19 C.F.R. §§ 210.43(b) and (c).

Within seven days of the date of this document, the parties shall submit to the Office of the Administrative Law Judges a joint statement as to whether or not they seek to have any portion of this document deleted from the public version. If the parties do seek to have portions of this document deleted from the public version, they must submit to this office a copy of this document with red brackets indicating the portion or portions asserted to contain confidential business information. The submission may be made by email and/or hard copy by the aforementioned date and need not be filed with the Commission Secretary.

**SO ORDERED.**

  
Cameron Elliot