UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

Case IPR2025-00461

Patent No. 7,612,805

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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United States Patent and Trademark Office
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PATENT OWNER'S LIST OF EXHIBITS	
EX. 2001	Redacted Transcript, *Optimum Imaging Technologies LLC v. Nikon Corporation,* No. 4:23-cv-00923-ALM, Dkt. 84 (E.D. Tex. April 29, 2025)
EX. 2002	Joint Notice of Settlement and Request to Stay All Deadlines, *Optimum Imaging Technologies LLC v. Samsung Electronics Co., Ltd., et al.,* No. 4:23-cv-00927-ALM, Dkt. 114 (E.D. Tex. April 15, 2025)
EX. 2003	Amended Scheduling Order, *Optimum Imaging Technologies LLC v. Samsung Electronics Co., Ltd., et al.,* No. 4:23-cv-00927-ALM, Dkt. 78 (E.D. Tex. Feb. 14, 2025)
EX. 2004	Order granting Joint Motion to Dismiss, *Optimum Imaging Technologies LLC v. Fujifilm Corporation,* No. 4:23-cv-00922-ALM, Dkt. 75 (E.D. Tex. May 10, 2025)
EX. 2005	Joint Motion to Dismiss, *Optimum Imaging Technologies LLC v. Olympus Corporation, et al.,* No. 4:23-cv-00924-ALM, Dkt. 75 (E.D. Tex. April 25, 2025)

I. INTRODUCTION

Patent Owner respectfully submits this paper to protect its rights, out of an abundance of caution, despite Patent Owner's full expectation that the parties will finalize settlement promptly. With that said, the Director should deny institution of this IPR for at least two reasons.

First, the Parties have orally informed the district court that the disputes between them are resolved and the settlement process is fully underway. Patent Owner anticipates moving to terminate this IPR in the near future. Neither the parties nor the Board should invest any resources in this IPR.

Second, even assuming *arguendo* that the settlement were not finalized promptly, then the *Fintiv* factors favor denial. The related litigation would go to trial long before the Board would reach a final written decision in this IPR.

II. THE PARTIES HAVE RESOLVED THEIR DISPUTES

Patent Owner Optimum Imaging Technologies LLC and Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "the Parties") have resolved their disputes and the settlement process is underway. The Director should therefore deny institution of this IPR to conserve the Board's resources.

On March 27, 2025, the Parties orally informed the district court that the disputes between them are resolved and that the settlement process is underway.

See, e.g., EX. 2001 at 7:12-17, 8:7-25, and 10:2-9.

On April 15, 2025, the Parties filed a joint notice of settlement and request to stay all deadlines for forty-five days in the related district court litigation, Case No. 4:23-cv-00927 (E.D. Tex.). EX. 2002. The settlement process remains underway and the Parties anticipate filing a joint motion to dismiss the related district court litigation, as well as a joint motion to terminate this IPR, before the requested stay expires at the end of May. Thus, institution of this IPR should be denied to conserve the Board's resources. No panel should have to evaluate the merits of this IPR.

III. THE *FINTIV* FACTORS FAVOR DENIAL

In the unlikely event that the settlement is not finalized promptly, the Director should deny institution of this IPR based on analysis of the *Fintiv* factors. *See, e.g., Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential). Prior to the joint notice of settlement, the district court's final pretrial conference was set for November 6, 2025. EX. 2003.[1] Therefore, the

[1] There were six litigations before Judge Mazzant, but the Fujifilm and Olympus litigations have been or are in the process of being dismissed. EX. 2004; EX. 2005. Thus, there are four remaining litigations, involving Sony, Nikon, Samsung, and Panasonic, all of which are currently stayed due to pending settlements.

trial was expected to occur approximately ten months before a final written decision would be expected in this IPR in September 2026.[2] The parties and the district court have already substantially invested in the related litigation and the interests of fairness and efficiency favor denial of institution in this IPR.

IV. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that institution be denied.

Respectfully submitted,

Date: May 14, 2025

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[2] According to DocketNavigator, Judge Mazzant's final pretrial conference typically occurs 1-3 weeks before Trial Day 1. *See, e.g.*, Mazzant Case Nos. 4:20-cv-886, 4:08-cv-451, 4:18-cv-cv-469, 4:18-cv-474, 4:15-cv-766.

CERTIFICATE OF COMPLIANCE

This paper is under 14,000 words and complies with the type-volume and general format requirements under 37 C.F.R. §§ 42.24 and 42.6(a).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that this paper and all exhibits thereto were served on the undersigned date via email, as authorized by Petitioners, at the following email addresses:

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