

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

SNAPAID, LTD.
Patent Owner.

CASE NO. IPR2025-01522
U.S. PATENT NO. 10,659,682

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I.	Introduction	1
II.	Background	1
III.	Settled Expectations Weigh in Favor of Discretionary Denial.....	4
IV.	The <i>Fintiv</i> Factors Weigh in Favor of Discretionary Denial	11
	A. The district court litigation has not been stayed and there is no evidence a stay will be granted.....	11
	B. The proximity of the court’s scheduled trial date to the Board’s Final Written Decision weighs in favor of denying institution.....	13
	C. There will be significant investment in the district court before any Decision on Institution.....	15
	D. Petitioner’s <i>Sotera</i> stipulation does not resolve the potential overlap and is not dispositive.	16
	E. The parties are identical in the district court proceeding.	18
	F. The arguments in the Petition are not compelling.....	18
V.	Conclusion.....	20

TABLE OF AUTHORITIES**Cases**

<i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> 694 F.3d 1312 (Fed. Cir. 2012)	19
<i>Amazon.com Servs. LLC et al v. Audio Pod, LLC</i> IPR2025-00757, Paper 15 (Aug. 14, 2025)	10
<i>Apple Inc. v. Apex Beam Techs. LLC</i> IPR2025-00896, Paper 10 (Sept. 3, 2025)	9
<i>Apple Inc. v. Fintiv, Inc.</i> IPR2020-00019, Paper 11 (Mar. 20, 2020)	14
<i>Apple Inc. v. Fintiv, Inc.</i> IPR2020-00019, Paper 15 (May 13, 2020)	18
<i>Aquestive Therapeutics, Inc., v. Iono Pharma, LLC</i> IPR2025-00874, Paper 11 (Oct. 3, 2025)	10
<i>AT&T Servs. Inc. v. RightQuestion, LLC</i> IPR2025-00360, Paper 12 (July 29, 2025)	12
<i>Cambridge Indus. USA Inc. v. Applied Optoelectronics, Inc.</i> IPR2025-00433, Paper 8 (Apr. 28, 2025)	16
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> IPR2025-00408, Paper 21 (June 18, 2025)	10
<i>In Re Anova Hearing Labs, Inc.,</i> 2019-1507, Oral Argument (Fed. Cir. Feb. 3, 2020)	19
<i>Motorola Sols., Inc. v. Stellar, LLC</i> IPR2024-01205, Paper 19 (Mar. 28, 2025)	17
<i>Nvidia Corp. v. Neural AI, LLC</i> IPR2025-00606, Paper 18 (July 31, 2025)	11
<i>Peloton Interactive, Inc. v. Flywheel Sports, Inc.</i> 2019 WL 3826051 (E.D. Tex. Aug. 14, 2019)	11
<i>Phison Elecs. Corp. v. Vervain LLC</i> IPR2025-00212, Paper 10 (May 28, 2025)	19
<i>Polaris Powerled Techs., LLC v. Samsung Elecs. Am., Inc.</i> 2024 WL 1149223 (E.D. Tex. Mar. 15, 2024)	12

Samsung Elecs. Co. v. SiOnyx, LLC

IPR2025-00065, Paper 16 (June 6, 2025)17

Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.

IPR2025-00354, Paper 11 (June 12, 2025)15

Patent Owners' Exhibit List

Exhibit No.	Description
2001	<i>SnapAid, Ltd. v. Samsung Electronics Co., Ltd. et al</i> , 2-25-cv-00378-RWS-RSP (E.D. Tex.), Complaint, ECF No. 1 (April 10, 2025)
2002	<i>SnapAid, Ltd. v. Samsung Electronics Co., Ltd. et al</i> , 2-25-cv-00378-RWS-RSP (E.D. Tex.), Docket Control Order, ECF No. 31 (September 25, 2025)
2003	USPTO Notice of Proposed Rulemaking, October 16, 2025, available at https://public-inspection.federalregister.gov/2025-19580.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=
2004	Side-by-Side Comparison of Claim 17 of the '682 Patent, Claim 1 of the '226 Patent, and Claim 1 of the '537 Patent
2005	U.S. Provisional Application No. 61/717,216, filed Oct. 23, 2012
2006	U.S. Provisional Application No. 61/759,643, filed Feb. 1, 2013
2007	Email dated September 3, 2015, from Doron Gonen, Director, Head of Technology Collaboration Group, Samsung
2008	Email thread dated September 30, 2015, from Maya Lipkin, Samsung (attaching executed NDA)
2009	Executed Dual Non-Disclosure Agreement between Samsung and SnapAid (attachment to Email thread dated September 30, 2015, from Maya Lipkin, Samsung)
2010	Email dated October 8, 2015, from Igor Gankin, Technology Collaboration Group, Samsung
2011	Email thread dated October 8, 2015, from Ishay Sivan, Founder & CEO, SnapAid (attaching SnapAid Android App User Manual)
2012	SnapAid Android App User Manual (attachment to Email thread dated October 8, 2015, from Ishay Sivan, Founder & CEO, SnapAid)

Exhibit No.	Description
2013	Machine Translation of Email thread dated October 7, 2015, from SK Kim, Director, CidT Co., Ltd to Samsung (attaching SnapAid Manufacture Presentation)
2014	SnapAid Manufacture Presentation Ver2.pdf (attached to Email thread dated October 7, 2015, from SK Kim, Director, CidT Co., Ltd to Samsung)
2015	Email thread dated November 18, 2015, from Ishay Sivan, Founder & CEO, SnapAid
2016	Email thread dated January 14, 2016, from Ishay Sivan, Founder & CEO, SnapAid
2017	Email thread dated October 28, 2015, from Igor Gankin, Technology Collaboration Group, Samsung
2018	Email thread dated September 14, 2017, from Ishay Sivan, Founder & CEO, SnapAid (attaching SnapAid Patent Portfolio)
2019	SnapAid Patent Portfolio.pdf (attached to Email thread dated September 14, 2017, from Ishay Sivan, Founder & CEO, SnapAid)
2020	U.S. Patent Publication No. 2017/0237900, Pub. Date: August 17, 2017
2021	Email dated September 17, 2017, from Igor Gankin, Technology Collaboration Group, Samsung
2022	Motion Success for Stay Pending IPR for Eastern District of Texas, Docket Navigator, current as of November 6, 2025
2023	Motion Success for Stay Pending PTAB for Eastern District of Texas, Lex Machina, current as of November 7, 2025.
2024	Eastern District of Texas Time to Milestones, Docket Navigator, current as of November 6, 2025
2025	Email from Samsung's Counsel providing <i>Sotera</i> stipulation relating to IPR2025-01522
2026	<i>SnapAid, Ltd. v. Samsung Electronics Co., Ltd. et al</i> , 2-25-cv-00378-RWS-RSP (E.D. Tex.), Samsung's Answer and Counterclaims, ECF No. 14 (August 4, 2025)

I. Introduction

This case squarely fits the circumstances where the Board should exercise its discretion to deny institution. Samsung has known of this patent family since 2015, yet waited until litigation was underway to file these petitions. Worse, it challenges only five of the eight asserted patents—those issued within the last six years—ignoring the others to avoid the settled-expectations problem. That tactic underscores the strategic, not efficiency-driven, nature of these filings.

Institution here would add complexity, not reduce it. The Eastern District of Texas will resolve infringement, validity, and damages for all eight patents in April 2027. The Board's Final Written Decisions, if all related petitions were instituted, would address at most five patents and issue only one month earlier. That marginal timing benefit cannot justify duplicative proceedings, staggered adjudications, increased costs, and delayed final resolution. The petitions offer no efficiency gains—only the burden of parallel litigation.

SnapAid respectfully requests that the Director exercise discretion to deny institution of Samsung's petitions.

II. Background

The relationship between the parties began when SnapAid—then an early-stage innovator—engaged with Samsung to explore a potential strategic partnership aimed at improving cell-phone picture quality. The parties executed a Dual Non-

Disclosure Agreement on September 24, 2015, after which SnapAid provided proprietary technical materials detailing its real-time picture quality assessment and improvement features and identified its patent portfolio covering the same. Discussions in late 2015 and early 2016 did not produce any further agreement. In September 2017, SnapAid followed up, updated Samsung on its patent portfolio, and inquired about a purchase or license. After Samsung declined, it later released products incorporating the very capabilities SnapAid disclosed under the NDA, precipitating SnapAid's infringement allegations.

SnapAid filed a civil action in the Eastern District of Texas, Case No. 2:25-cv-00378, asserting eight closely related U.S. patents, each titled "Real Time Assessment of Picture Quality."¹ Ex. 2001. These patents share a common specification, claim similar subject matter, and cover systems and methods that perform real-time image quality analysis to provide users immediate feedback during photo and video capture. Trial is set for April 2027. Ex. 2002 at 2.

Samsung chose to challenge only five of the eight asserted patents in parallel

¹ U.S. Patent Nos. 9,338,348 (the "'348 Patent"), 9,661,226 (the "'226 Patent"), 10,009,537 (the "'537 Patent"), 10,659,682 (the "'682 Patent"), 10,944,901 (the "'901 Patent"), 11,252,325 (the "'325 Patent"), 11,671,702 (the "'702 Patent"), and 12,250,452 (the "'452 Patent") (collectively, the "Asserted Patents").

IPR/PGR proceedings, leaving the three earliest-issued patents—with largely similar claims—uncontested at the PTAB and proceeding toward trial in district court.² The district court action is moving forward without a stay and trial is scheduled to begin just one month after any Final Written Decision would issue if review were instituted. The district court is likely to address the same prior art and arguments presented here in connection with the unchallenged patents, risking inconsistent outcomes and duplicative consumption of party and judicial resources.

The Director has cautioned that “serial and parallel patent challenges ... remain a significant problem” and that when PTAB proceedings “cover the same ground as district court litigation, they cease to be an ‘alternative’ and can substantially increase litigation costs.” Ex. 2003 at 3, 5. Samsung’s piecemeal approach invites duplicative claim construction, overlapping prior-art and expert disputes, and conflicting rulings between the PTAB and the district court, as well as among PTAB panels, while burdening SnapAid with parallel, staggered proceedings

² The parallel IPR proceedings are: IPR2025-01519, IPR2025-01520, and IPR2025-01521. The parallel PGR proceeding is PGR2025-00083. The ’348 Patent, the ’226 patent, and the ’537 Patent have not been challenged. As the related proceedings involve a single family of U.S. Patents and the reasons for discretionary denial are largely identical, this brief is similar to those filed in the related proceedings.

on closely related claims that Samsung knew about well before filing.

Samsung's decision to carve up a single inventive family across selective IPR/PGR petitions while district court litigation proceeds—despite its long-standing knowledge of the asserted technology—presents exactly the circumstances in which discretionary denial avoids inefficient, overlapping adjudication. Denial will conserve administrative and judicial resources, avoid inconsistent outcomes, and align with the Director's guidance discouraging fragmented attacks on related patents where a unified forum can more efficiently and fairly resolve the dispute.

III. Settled Expectations Weigh in Favor of Discretionary Denial

Samsung has long been aware of the Asserted Patents through NDA-protected exchanges, pre-suit communications from 2015 to 2017, and the district court complaint. Despite this, Samsung has chosen a selective and fragmented challenge strategy, seemingly to circumvent the Director's review of settled expectations. As detailed below, these settled expectations strongly support discretionary denial.

In October 2012 and February 2013, SnapAid's founder and CEO, Ishay Sivan, filed two U.S. provisional patents applications, which have since developed into one patent family containing the eight Asserted Patents:

U.S. Patent	Issue Date	Other Information
9,338,348	May 10, 2016	U.S. Non-Provisional Parent Asserted against Samsung in District Court Not challenged in any post-grant proceeding

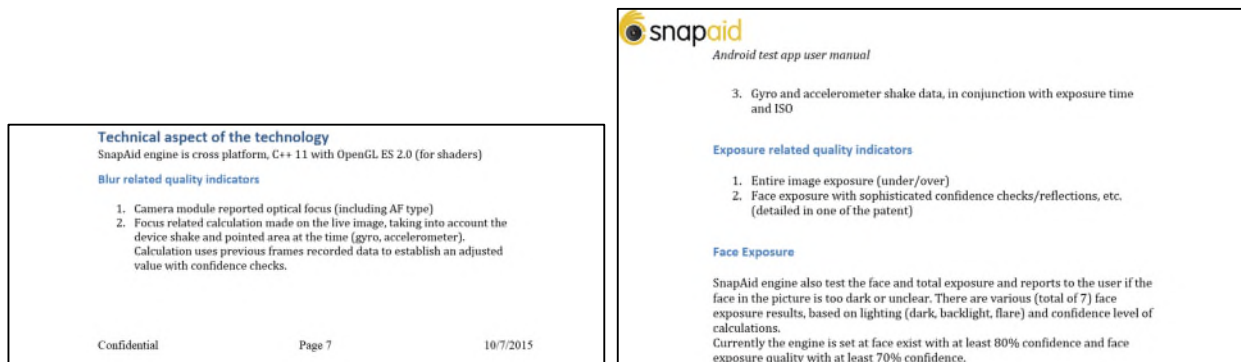
9,661,226	May 23, 2017	Continuation of earlier family member Asserted against Samsung in District Court Not challenged in any post-grant proceeding
10,009,537	June 26, 2018	Continuation of earlier family member Asserted against Samsung in District Court Not challenged in any post-grant proceeding
10,659,682	May 19, 2020	Continuation of earlier family member Asserted against Samsung in District Court Challenged in the instant IPR
10,944,901	March 9, 2021	Continuation of earlier family member Asserted against Samsung in District Court Challenged in IPR2025-01519
11,252,325	February 15, 2022	Continuation of earlier family member Asserted against Samsung in District Court Challenged in IPR2025-01521
11,671,702	June 6, 2023	Continuation of earlier family member Asserted against Samsung in District Court Challenged in IPR2025-01520
12,250,452	March 11, 2025	Continuation of earlier family member Asserted against Samsung in District Court Challenged in PGR2025-00083

All Asserted Patents share a common specification and inventor, Ishay Sivan. While distinct, the claims have similar scope. As an example of those similarities, Claim 17 of the challenged '682 Patent is presented alongside Claims 1 of the unchallenged

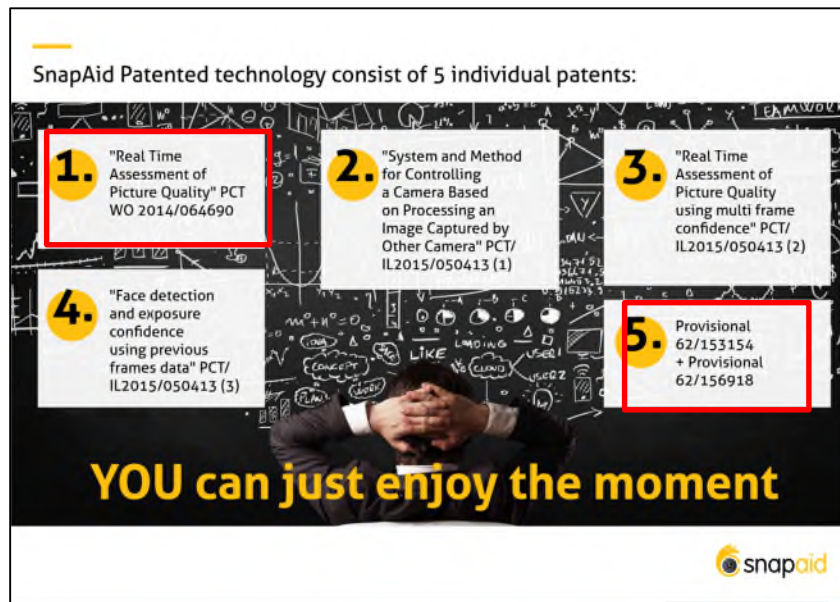
'226 and '537 Patents in Exhibit 2004.

In 2015, SnapAid sought a partner to commercialize its technology and began discussions with Samsung. By this time, SnapAid had developed a Software Development Kit ("SDK") and was looking for a client to implement its technology. The technology aimed to reduce reliance on user skills, providing a real-time, automatic picture-taking experience. The system performs real-time assessment of picture or video quality by aggregating various indicators, often derived from both image analysis and device hardware sensors, to generate a quality score and provide immediate, actionable guidance or assistance to the user during the capture process.

In September 2015, the parties negotiated and executed an NDA, and Samsung requested access to SnapAid's Android Application Package ("APK"). Ex. 2007; Ex. 2008; Ex. 2009; Ex. 2010. SnapAid provided Samsung the APK along with a detailed manual describing the use of various quality indicators, user feedback, and related examples, emphasizing the confidentiality of this disclosure. Ex. 2011; Ex. 2012. Exemplary screenshots below:



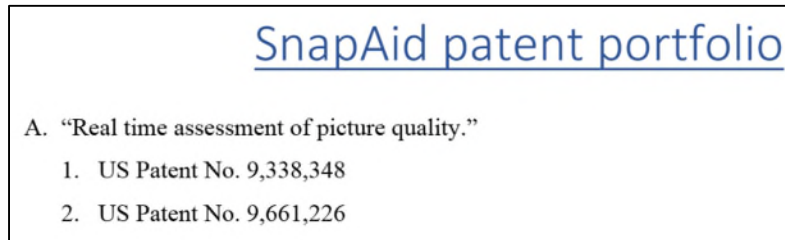
Ex. 2012. On October 7, 2015, Samsung received a confidential presentation detailing SnapAid's technology and identifying the relevant patent applications. Ex. 2013. The presentation also explicitly identified the U.S. provisional applications and PCT application to which all the Asserted Patents claim priority (annotated here by the red boxes):



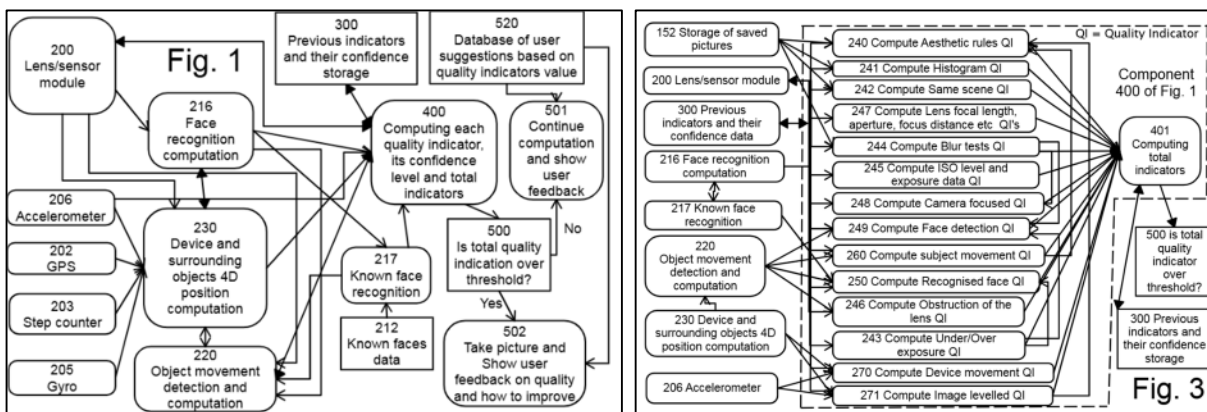
Ex. 2014 at 20.

Over the following months, SnapAid and Samsung exchanged communications disclosing and describing technical features of the SnapAid technology and evaluating SnapAid's APK. *See e.g.*, Ex. 2015; Ex. 2016. Samsung considered and proposed projects for use of SnapAid's technology. *See, e.g.*, Ex. 2017. However, ultimately, the parties went their separate ways, unable to reach an agreement for continued work together.

Over a year later, in September 2017, SnapAid again approached Samsung, but this time inquiring if Samsung would be interested in purchasing or directly licensing SnapAid's "patents & technology." Ex. 2018. By this time, two of the Asserted Patents had issued, and SnapAid's next application in this family, eventually issuing as the '537 Patent, had published. See Ex. 2020. SnapAid included a description of its patent portfolio as it currently stood at that time, specifically identifying two of the Asserted Patents that had issued, the '348 and '226 Patents:



Ex. 2019. SnapAid provided a general description of the inventions within the family and included two figures that are also found in all the Asserted Patents and challenged patents:



Id.; see also, '682 Patent at Figs. 1, 3. Samsung reported back to Mr. Sivan that they

could not “find any team that is interesting [sic] in SnapAid IP.” Ex. 2021. As illustrated in Exhibit 2004, and for purposes of evaluating issue overlap and procedural efficiency, the claim scope of the unchallenged ’226 Patent (which Samsung was expressly made aware of, see Ex. 2019) closely parallels that of the challenged ’628 Patent.³

In summary, between 2015 and 2017, SnapAid disclosed both the details of its technology under NDA and the existence of the Asserted Patent family, including U.S. Provisional Patent Application Nos. 62/153154 and 62/156918, PCT Publication No. WO 2014/064690, and the ’348 and ’226 Patents—all in direct lineage with the ’682 Patent. Moreover, while Samsung selectively avoided challenging the Asserted Patents that issued more than six years ago, the concept of settled expectations is not a bright-line six-year rule and “there may be good reasons why a patent owner has strong settled expectations in a patent that has been in force for two, three, or four years.” *Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896,

³ The full scope of Samsung’s knowledge and potential investigation into the Asserted Patents is unknown to SnapAid at this time. Given the content of Ex. 2018 and Ex. 2021, it stands to reason that some consideration or investigation of the patent family was conducted before declining any interest in SnapAid’s IP. This issue will be more fully litigated in the district court.

Paper 10 at 3 (Sept. 3, 2025).

This history underscores that SnapAid does have strong settled expectations. More than a decade ago, SnapAid made detailed disclosures to Samsung in a good-faith attempt to partner and implement its technology. In both 2015 and 2017, SnapAid disclosed its patent portfolio, including priority documents and unchallenged but asserted parent patents. The challenged and unchallenged Asserted Patents are closely related in claim scope and specification, making Samsung's selective challenges appear to be an attempt to avoid settled expectations arguments while simultaneously pursuing multiple parallel validity challenges on similar claims.

As such, this scenario aligns with recent decisions denying institution under § 314(a), where prior relationships and knowledge of asserted patents created strong settled expectations in favor of the patent owner. *See, e.g., Amazon.com Servs. LLC et al v. Audio Pod, LLC*, IPR2025-00757, Paper 15 at 3 (Aug. 14, 2025) (denying institution where “Patent Owner informed Petitioner of its patent portfolio, including an issued ancestor patent to the challenged patents” finding that “Petitioner appears to have had notice of the challenged patents ***or patent family*** for a significant period of time.” (emphasis added)); *Aquestive Therapeutics, Inc., v. Iono Pharma, LLC*, IPR2025-00874, Paper 11 at 2 (Oct. 3, 2025) (petitioner's knowledge of “a provisional application in 2016, as well as the publication of the non-provisional

PCT patent application that matured into the challenged patent” weighed in favor of discretionary denial); *see also Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025) (“actual notice of a patent or of possible infringement is not necessary to create settled expectations.”). Additionally, and again, while ’682 Patent has been in force for about five and a half years, the ’682 Patent is a direct descendant from unchallenged Asserted Patents that go back nine years with a common specification and generally related claim scope. *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2–3 (July 31, 2025) (denying institution of patent claims granted in 2023 based on, *inter alia*, evidence regarding a prior commercial relationship and knowledge of the patent owner’s patent portfolio weighed in favor of discretionary denial, even though the challenged claims had not been issued at the time petitioner gained the knowledge). Ultimately, Samsung’s failure to seek review of the Asserted Patents before now, despite having knowledge of the patent family since at least 2015, weighs strongly in favor of denial.

IV. The *Fintiv* Factors Weigh in Favor of Discretionary Denial

A. The district court litigation has not been stayed and there is no evidence a stay will be granted.

The parallel district court litigation has not been stayed, and there is no indication that a stay will be granted. Samsung has not moved for a stay, and eight Asserted Patents are at issue in that case—only five of which are challenged in the related IPR/PGR proceedings. Because three remain unchallenged, it is unlikely the

court would grant a stay. *See, e.g., Peloton Interactive, Inc. v. Flywheel Sports, Inc.*, 2019 WL 3826051, at *3 (E.D. Tex. Aug. 14, 2019) (denying stay and finding “the simplification factor weighs against a stay” where the PTAB had instituted IPRs on fewer than all asserted patents and where invalidity theories under §§ 101, 102, 103, and 112 would still be litigated); *Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, 2024 WL 1149223, at *5–6 (E.D. Tex. Mar. 15, 2024) (denying stay where IPR was instituted on less than all asserted patents). Statistical data confirms this trend as, since 2020, motions to stay pending IPR/PTAB proceedings in the Eastern District of Texas have been granted only approximately a quarter of the time or less. Ex. 2022 (Motion to Stay Pending IPR is granted approximately 15% of the time per Docket Navigator); Ex. 2023 (Motion to Stay Pending PTAB is granted approximately 26% of the time per Lex Machina). Where “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial,” this factor supports discretionary denial. *AT&T Servs. Inc. v. RightQuestion, LLC*, IPR2025-00360, Paper 12 at 2 (July 29, 2025).

The district court is already set to resolve the entire dispute—including validity, infringement, and damages—for all eight Asserted Patents by April 2027. This IPR challenges only the validity of the '682 Patent under § 103, with a final written decision expected in March 2027—one month before trial, after expert discovery, dispositive motions, and the pretrial order are complete. *See* Ex. 2002. By

then, the case will be trial-ready. The IPR process will not meaningfully simplify the district court case or conserve resources.

SnapAid anticipates that, if any post-grant proceedings are instituted, Samsung will move for a stay. This is a common tactic among large technology companies—one aimed more at delay than genuine efficiency. But as the Director recently observed, such strategies rarely produce streamlined resolution: “[r]esolution of the dispute is delayed by at least 18 months during the IPR proceedings, and potentially longer if the stay remains in place pending any appeal or remand,” which is the opposite of what Congress intended when enacting the AIA. *See* Ex. 2003 at 6.

Speculative stay requests should carry no weight in the Board's analysis. The *Fintiv* framework focuses on whether there is actual evidence that a stay will be granted—not conjecture. There is no such evidence here, and the district court has given no indication it would grant a stay. Allowing both proceedings to proceed in parallel on nearly the same schedule risks duplication of effort and inconsistent outcomes. To preserve the Board's resources for cases where a co-pending district court litigation will not proceed in parallel, this factor weighs in favor of exercising discretionary denial.

B. The proximity of the court's scheduled trial date to the Board's Final Written Decision weighs in favor of denying institution.

The Board's projected Final Written Decision in this proceeding is due **March 15, 2027**, with the district court trial scheduled to begin just over one month later, on **April 19, 2027**. Ex. 2002 at 1. In the Eastern District of Texas, the average time to jury trial in patent cases since 2020 is approximately 22.6 months. Ex. 2024. Given this trial date—approximately 24 months from the filing of the Complaint—it is unlikely the date will slip significantly if at all.

By the time the Board issues its decision, the parties and the district court will have already expended substantial resources: completing fact and expert discovery, claim construction, summary judgment briefing, preparing the pretrial order, and likely holding the pretrial conference.⁴ Although the Final Written Decision is expected before trial, the proximity is so close that there will be no meaningful efficiency gained. The district court will already have considered overlapping validity issues—potentially the same prior art—through the pretrial process.

When PTAB and district court schedules reach resolution at nearly the same time, PTAB proceedings cease to be an “alternative” forum, as Congress intended, and instead become a parallel forum that allows petitioners multiple attempts to

⁴ Scheduled for March 15, 2027, at 9:00 a.m. in Marshall, Texas. Ex. 2002 at 2.

invalidate the same patents. Here, if the district court case proceeds as scheduled, it will resolve validity (on all grounds), infringement, and damages for all eight Asserted Patents by April 2027, while the Board will decide only the § 103 validity of the '682 Patent. Where trial is scheduled at or around the FWD, this overlap weighs against institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9–10 (Mar. 20, 2020) (precedential); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2 (June 12, 2025) (holding that “it [would] be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the projected final written decision due date are in close proximity.”).

Because the district court will resolve the full dispute almost concurrently with the Board's decision, and the Board's review will not streamline or simplify the litigation, this factor strongly supports discretionary denial under § 314(a).

C. There will be significant investment in the district court before any Decision on Institution.

The related district court litigation has been pending since **April 2025**, with trial scheduled for **April 2027**. The deadline for issuing a decision on institution in this IPR is **March 15, 2026**—nearly halfway to trial.

By the time the Board reaches its institution decision, the parties will have completed most of the requirements under the Eastern District of Texas's Local

Patent Rules for contentions and related document productions. SnapAid has already served its infringement contentions and produced supporting documents in compliance with Patent Rules 3-1 and 3-2. Samsung must serve its invalidity contentions and produce corresponding documents under Patent Rules 3-3 and 3-4 by December 1, 2025—more than three months before the institution decision.

In addition, both parties have already served the majority of their interrogatories, with responses due well in advance of the institution decision. Thus, by March 2026, the parties' primary infringement and invalidity theories will be fully set, and a substantial portion of document production and written discovery will be complete. The district court will have already invested significant time in managing these exchanges, and the case will be well into its pretrial schedule.

As such, because the court and parties will have completed major case milestones before institution, making PTAB review duplicative rather than efficient. *See Cambridge Indus. USA Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 8 at 20 (Apr. 28, 2025) (describing that the parties have exchanged contentions and fact discovery is underway) and Paper 12 at 2 (June 27, 2025) (denying institution).

D. Petitioner's *Sotera* stipulation does not resolve the potential overlap and is not dispositive.

Samsung stipulated that, if this IPR is instituted, it would not pursue in the

district court:

- (i) the specific grounds raised in IPR2025-01522;
- (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications); or
- (iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01522.

Ex. 2025. While on its face the stipulation may appear to simplify issues, that is precisely what it is designed to do—create the appearance of narrowing overlap. As the Director has recently cautioned, “petitioners still frequently bring ‘repetitive challenges based on slightly rebranded evidence.’” Ex. 2003 at 5 (citing and quoting cases). Here, the overlap remains significant because only a portion of the Asserted Patents are challenged, and Samsung has already asserted the same prior art against related patents in the district court. Thus, there is still a risk of arguments relating to the same prior art against the same patent family in two different forums.

The '537, '348 and '226 patents all precede the '682 in the priority chain, share the same specification, inventor, title, and priority to the same provisional applications, and are directed to the same subject matter—real-time assessment of image quality. Samsung has raised the same prior art against the related patents in the district court action as it has in this IPR against the '682 patent. Ex. 2026 at 27.

Adjudicating these patents in separate forums will result in duplication of effort, as the district court will still have to consider these references in the context of similar claims. *See Samsung Elecs. Co. v. SiOnyx, LLC*, IPR2025-00065, Paper 16 at 15 (June 6, 2025) (denying institution where the district court would have to consider claims not challenged in the IPR which “include the same prior art references as asserted [in the IPR]”); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 4 (Mar. 28, 2025) (denying institution where “Petitioner's invalidity arguments in the district court [were] more expansive” than those in the IPR).

Win or lose in this IPR, nothing prevents Samsung from repackaging the same, or substantially the same, prior art and asserting it against the unchallenged '537, '348, and '226 Patents in the district court. In addition, Samsung is challenging the validity of the '682 Patent under §§ 101 and 112 in district court—issues that fall outside the scope of this IPR and Samsung's stipulation. *See Ex. 2026* at 27. Accordingly, the stipulation does not eliminate the substantial overlap in prior-art-based validity issues between the two forums, and validity will remain at issue in the district court even if the challenged claims survive institution.

Because the district court will still address overlapping validity arguments for related patents in the same family, and the stipulation fails to materially narrow that overlap, this factor weighs strongly in favor of discretionary denial under § 314(a).

E. The parties are identical in the district court proceeding.

The parties to this proceeding are identical to the parties in the parallel district court proceeding and Petitioner here is the defendant in district court. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (May 13, 2020).

F. The arguments in the Petition are not compelling.

SnapAid will detail the substantive and technical deficiencies in Samsung's Petition in its forthcoming Preliminary Response. However, even at this stage, the Petition does not present compelling merits, and this factor weighs in favor of discretionary denial. *Phison Elecs. Corp. v. Vervain LLC*, IPR2025-00212, Paper 10 at 14 (May 28, 2025) (denying institution where Petition's merits “do not...rise to the level of compelling”).

Samsung's Petition asserts ten separate grounds against the twenty claims of the '682 Patent. Each ground relies on a *minimum* four-reference combination that includes Anon, Takeuchi, and Jasinski (with a fourth reference depending on the claim). Seven grounds (Grounds 1B–1H) involve a four-reference combination, and two (Grounds 1I and 1J) rely on a five-reference combination. To explain these combinations, Samsung submitted a ninety-one-page expert declaration. The sheer complexity of these multi-reference combinations undermines their persuasiveness

and it is unlikely that Samsung will succeed on merits, particularly for all claims. *See, e.g., In Re Anova Hearing Labs, Inc.*, 2019-1507, Oral Argument at 24:28–25:24 (Fed. Cir. Feb. 3, 2020) (Judge Moore) (“And, what I’m worried about is a five-reference rejection is the hindsight bias concern of just picking and choosing elements from lots of different random prior art and saying they work together.”); *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (holding “conclusory” statements combining six references as “not sufficient [to prove obviousness] and...fraught with hindsight bias.”).

As SnapAid will further demonstrate in its Preliminary Response, these combinations fail to disclose all claimed limitations and are the product of impermissible hindsight. Given the substantive weakness of the Petition’s grounds and the fact that the parallel district court litigation will resolve all issues—including validity, infringement, and damages—on nearly the same schedule, there is no compelling reason for the Board to institute review. This factor therefore supports discretionary denial under § 314(a).

V. Conclusion

Samsung has been aware of the patent family at issue for nearly a decade, following detailed disclosures made under NDA during a prior commercial relationship, and several related patents have issued and remained unchallenged. These facts create strong settled expectations in favor of SnapAid. At the same time,

the district court will resolve all validity, infringement, and damages issues for all eight related Asserted Patents by April 2027, while Samsung asks the Board to decide limited challenges to five of those patents in March 2027—just weeks before trial. This parallel timing ensures there is no efficiency gained and instead risks the duplication of effort and inconsistent results that Congress sought to avoid. For these reasons, SnapAid respectfully requests that the Director exercise discretion and deny institution of the Petition.

Dated: November 17, 2025

Respectfully submitted,

/s/ James Nuttall

James Nuttall (Reg. No. 44,978)
jnuttall@steptoe.com

John Abramic (Reg. No. 50,031)
jabramic@steptoe.com

Daniel Gelwicks (Reg. No. 74,803)
dgelwicks@steptoe.com

STEPTOE LLP
227 West Monroe Street,
Suite 4700
Chicago, IL 60606
Tel: (312) 577-1300
Fax: (202) 429-3902

Counsel for Patent Owner,
SNAPAID LTD.

CERTIFICATE OF SERVICE

The undersigned certifies that on the seventeenth day of November, 2025, a complete and entire copy of the foregoing "PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL," including exhibits, if any, was served on the date below on the following counsel of record via email per Petitioner's consent to electronic service.

Dated: November 17, 2025

/s/ James Nuttall
James Nuttall (Reg. No. 44,978)

Counsel for Patent Owner,
SNAPAID, LTD.