UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PAYGEO, LLC,
Patent Owner.

Case IPR2025-01555
U.S. Patent No. 12,014,347

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. INTRODUCTION 1

II. SAMSUNG'S PROPOSED UNPATENTABILITY GROUNDS 1

III. ARGUMENT: THE PETITION SHOULD BE DENIED 2

A. Strong Settled Expectations Favor Discretionary Denial 2

B. The Director Should Deny Institution Under *Fintiv* 5

1. *Fintiv* Factor 1 Favors Denial Because a Stay Is Unlikely 6

2. *Fintiv* Factor 2 Favors Denial Due to the Trial's Proximity to the Final Written Decision Deadline 10

3. *Fintiv* Factor 3: the Parties' Investment in the Case Favors Denial 12

4. *Fintiv* Factor 4 Favors Denial Because Samsung's Stipulation is Not a True Alternative to the District Court Action 13

5. *Fintiv* Factor 5 Favors Denial Because the Parties Are the Same 15

6. *Fintiv* Factor 6 Favors Denial Because Samsung's Challenge is an Inefficient Use of Board Resources 15

IV. CONCLUSION 15

TABLE OF AUTHORITIES

Page(s)

Cases

Amazon.com, Inc. v. KAIFI LLC,
No. IPR2025-00624, Paper 16 (P.T.A.B. July 29, 2025) 11

Apple Inc. v. Fintiv, Inc.,
No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) .....*passim*

Arm Ltd. v. Daedalus Prime LLC,
No. IPR2025-00207, Paper 10 (P.T.A.B. May 16, 2025) 6

Cisco Sys. Inc. v. WSOU Investments LLC,
No. IPR2025-00188, Paper 14 (P.T.A.B. Aug. 22, 2025).....13

Dabico Airport Sols. Inc. v. AXA Power ApS,
No. IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) 3, 5

Force Mos Tech. Co., Ltd. v. ASUSTek Comput., Inc.,
No. 2:22-cv-00460-JRG, 2024 WL 1586266 (E.D. Tex.
Apr. 11, 2024).....9

Google LLC v. Soundclear Techs., LLC,
No. IPR2025-00344, Paper 15 (P.T.A.B. Aug. 4, 2025).....4

Ingenico Inc. v. IOENGINE, LLC,
136 F.4th 1354 (Fed. Cir. 2025) 14

iRhythm Techs., Inc. v. Welch Allyn, Inc.,
No. IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) 5

Kirsch Rsch. and Dev. LLC v. DuPont de Nemours, Inc.,
No. 5:20-cv-00057-RWS, Dkt. No. 269 (E.D. Tex. July 7, 2021).....8

Maxell Ltd. v. Apple Inc.,
No. 5:19-cv-00036-RWS, 2020 WL 10456915 (E.D. Tex.
Apr. 27, 2020).....9

Maxell Ltd. v. Apple Inc.,
No. 5:19-cv-00036-RWS, 2020 WL 10458088 (E.D. Tex. Nov. 17, 2020) 8

Micron Tech., Inc., et al. v. Palisade Techs., LLP,
No. IPR2025-01008, Paper 15 (P.T.A.B. Oct. 17, 2025).....11

Murata Mfg. Co. v. Ga. Tech Rsc. Corp.,
No. IPR2025-00383, Paper 14 (P.T.A.B. July 29, 2025).....4

Papst Licensing GmbH & Co., KG v. Apple, Inc.,
No. 6:15-cv-01095-RWS, 2018 WL 3656491 (E.D. Tex. Aug. 1, 2018) 9

Resonant Sys., Inc. v. Sony Grp. Corp.,
No. 2:22-cv-00424-JRG, Dkt. No. 84 (E.D. Tex. July 9, 2024) 7

Samsung Elecs. Co. v. iCashe, Inc.,
No. IPR2025-00643, Paper 11 (P.T.A.B. Aug. 14, 2025).....3

Toyota Motor Corp. v. AutoConnect Holdings LLC,
No. IPR2025-00890, Paper 9 (P.T.A.B. Sept. 19, 2025).....6

Uniloc 2017 LLC v. Samsung Elec. Am., Inc.,
No. 2:19-cv-00259-JRG-RSP, 2020 WL 1433960 (E.D. Tex. Mar. 24, 2020) 9

Other Authorities

Director Revisions to the Rules of Practice before the PTAB,
90 Fed. Reg. 48335 (Oct. 17, 2025) 6, 7, 14

USPTO Memorandum – Interim Processes for PTAB Workload Management (Mar. 26, 2025) 2

PATENT OWNER'S EXHIBIT LIST

EXHIBIT	DESCRIPTION
2001	Excerpts of File History for U.S. Patent Application Publication No. 2015/0161592
2002	Complaint for Patent Infringement, *PayGeo, LLC v. Samsung Elecs. Co.*, No. 25-cv-00334-RWS-RSP, Dkt. No. 1 (E.D. Tex. Apr. 2, 2025)
2003	Second Amended Docket Control Order, *PayGeo, LLC v. Samsung Elecs. Co.*, No. 25-cv-00334-RWS-RSP, Dkt. No. 52 (E.D. Tex. Oct. 2, 2025)
2004	Order, *Resonant Sys., Inc. v. Sony Grp. Corp*., No. 2:22-cv-00424-JRG, Dkt. No. 84 (E.D. Tex. July 9, 2024)
2005	Excerpts of Defendants' Invalidity Contentions, *PayGeo, LLC v. Samsung Elecs. Co.*, No. 25-cv-00334-RWS-RSP (E.D. Tex.), served on November 3, 2025
2006	Docket Navigator webpage, Motion Outcomes for Motions to Stay Pending *Inter Partes* Review in the Eastern District of Texas, dated January 1, 2020 through November 21, 2025
2007	Lex Machina webpage, Motion Metrics for Stay Pending PTAB in the Eastern District of Texas, dated January 1, 2020 through November 21, 2025
2008	Excerpts from U.S. District Court – Federal Case Management Statistics, Median Time from Filings to Trial (E.D. Tex.), 12-Month Periods Ending June 30, 2025, available at https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf
2009	Docket Navigator webpage, Time to Trial in the Eastern District of Texas, dated January 1, 2022 through November 21, 2025
2010	U.S. Patent Application Publication No. 2013/0024360-A1

EXHIBIT	DESCRIPTION
2011	Order, *Kirsch Rsch. and Dev. LLC v. DuPont de Nemours, Inc.*, No. 5:20-cv-00057-RWS, Dkt. No. 269 (E.D. Tex. July 7, 2021)

Patent Owner, PayGeo, LLC ("PayGeo"), respectfully requests that the Director discretionarily deny this Petition challenging claims 1-10 (the "Challenged Claims") of U.S. Patent No. 12,014,347 (Ex. 1001, "the '347 Patent"). This request for discretionary denial is authorized by the "Interim Processes for PTAB Workload Management" and "Interim Director Discretionary Process." PayGeo will discuss, in full, the reasons why the '347 Patent is patentable on the merits in its Patent Owner Preliminary Response.

I. INTRODUCTION

The Director should exercise his discretion to deny this Petition because:

(1) Samsung has long been on notice of PayGeo's patents, specifically, one other related PayGeo patent also challenged by Samsung has been in force for over twelve years; and

(2) the advanced stage of the corresponding litigation between PayGeo and Samsung in the Eastern District of Texas (the "District Court Action") means that the District Court promises to be the faster and more efficient forum to address the same validity issues raised here, with a trial date set around the same time the final written decision ("FWD") is due in this proceeding.

II. SAMSUNG'S PROPOSED UNPATENTABILITY GROUNDS

The Petition presents the following grounds for challenging the claims of the '347 Patent.

Ground	Claims	Basis	References Relied Upon
1A	1-10	§ 102	*Grigg* (Ex. 1005)
1B	1-10	§ 103	*Grigg* (Ex. 1005)
2	1-10	§ 103	*Grigg* (Ex. 1005) and *Carter* (Ex. 1006)
3A	1, 2, 6, 7	§ 102	*Google* (Ex. 1007)
3B	1, 2, 6, 7	§ 103	*Google* (Ex. 1007)
4	3-5, 8-10	§ 103	*Google* (Ex. 1007) and *Carter* (Ex. 1006)

Pet. at 9.

III. ARGUMENT: THE PETITION SHOULD BE DENIED

A. Strong Settled Expectations Favor Discretionary Denial

The parties' strong settled expectations favor discretionary denial of institution because (1) Samsung filed IPRs challenging the validity of other, related PayGeo patents that issued long ago and is also challenging their validity in the District Court Action, and (2) Samsung has long had notice of the other, related PayGeo patents. "Settled expectations of the parties, such as the length of time the claims have been in force," is a relevant factor when determining whether to deny institution. USPTO Memorandum – Interim Processes for PTAB Workload

Management (Mar. 26, 2025)[1] at 2. "Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be." *Dabico Airport Sols. Inc. v. AXA Power ApS*, No. IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025).

First, the strong settled expectations with respect to PayGeo's related patents support denial here. Samsung filed petitions for IPR of other PayGeo patents, including IPR2025-01551, challenging U.S. Patent No. 8,554,671, which issued over twelve years ago (on October 8, 2013); IPR2025-01552, challenging U.S. Patent No. 10,796,296, which issued over five years ago (on October 6, 2020); IPR2025-01553, challenging U.S. Patent No. 10,937,018, which issued almost five years ago (on March 2, 2021); and IPR2025-01554, challenging U.S. Patent No. 11,087,307, which issued over four years ago (on August 10, 2021). Given the strong settled expectations for those long-standing patents, institution should be denied on those petitions, which supports denial of this Petition as well. *Samsung Elecs. Co. v. iCashe, Inc.*, No. IPR2025-00643, Paper 11 at 2-3 (P.T.A.B. Aug. 14, 2025) (declining to institute IPRs against patents that issued approximately two

[1] https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf

years ago in view of denial of IPRs against related patents that issued eight to twelve years ago).

Second, Samsung's awareness of the '347 Patent's family further creates settled expectations. *See Google LLC v. Soundclear Techs., LLC*, No. IPR2025-00344, Paper 15 at 2-3 (P.T.A.B. Aug. 4, 2025) (a petitioner's prolonged knowledge of the challenged patents creates strong settled expectations); *Murata Mfg. Co. v. Ga. Tech Rsc. Corp.*, No. IPR2025-00383, Paper 14 at 2-3 (P.T.A.B. July 29, 2025) (finding strong settled expectations because petitioner was aware of patent owner's technology space "for a significant amount of time before filing its Petition challenging Patent Owner's patent").

Samsung was put on notice of PayGeo's patents and applications related to the '347 Patent by no later than April 4, 2017, more than eight years before Samsung filed this Petition. Specifically, during prosecution of Samsung's U.S. Patent Application Publication No. 2015/0161592 titled "Method for payment using membership card and electronic device thereof," one of PayGeo's patent application publications—U.S. Pat. Appl. Pub. No. 2013/0024360 of the '671 Patent (as defined below), to which the '347 Patent claims priority from and shares common subject matter with—was cited as prior art in a Notice of References dated April 4, 2017. Ex. 2001 (File History of U.S. Patent Application Publication No. 2015/0161592) at 25 (citing '671 Patent's Patent Application Publication No. 2013/0024360 (Ex.

2010)); *see Dabico Airport Sols. Inc.*, Paper 21 at 3 (noting that actual notice of a particular challenged patent is unnecessary to create settled expectations because published applications are searchable).

Once Samsung was put on notice of PayGeo's technology, it had every reason to avail itself of "the Office's automated search systems as well as publicly available resources on the Internet" to understand the scope of PayGeo's IP rights as they developed. *Dabico Airport Sols. Inc.*, Paper 21 at 3. Therefore, from its patent prosecution activities, Samsung has had actual notice of PayGeo's patents related to the '347 Patent for at least eight years, which further supports strong settled expectations. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, No. IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) (finding that settled expectations favored denial of institution because the petitioner was aware of the patent owner's patents during prosecution of its own patents).

Thus, strong settled expectations favor discretionary denial. *See id.* (denying institution in view of the settled expectations of the parties).

B. The Director Should Deny Institution Under *Fintiv*

The *Fintiv* Factors overwhelmingly support denial under 35 U.S.C. § 314(a). *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential). PayGeo asserted the '347 Patent in the District Court Action against Samsung on April 2, 2025. Ex. 2002 (Complaint) at 7-8. Trial in the District Court

Action is scheduled for April 19, 2027. Ex. 2003 (Second Amended Docket Control Order) at 1. In the event this IPR is instituted, a FWD would not be expected until April 7, 2027, less than two weeks before the scheduled trial date. *See Toyota Motor Corp. v. AutoConnect Holdings LLC*, No. IPR2025-00890, Paper 9 at 2 (P.T.A.B. Sept. 19, 2025) (denying institution in part because it was unclear whether the FWD will occur before or after trial based on different time-to-trial statistics). Thus, this Petition will not serve as an efficient alternative to resolution of the parties' validity dispute in the District Court Action.

1. *Fintiv* Factor 1 Favors Denial Because a Stay Is Unlikely

Fintiv Factor 1 favors discretionary denial in this case because the District Court Action has not been stayed and there is no indication that a stay will be granted. Factor 1 favors discretionary denial where "there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial." *Arm Ltd. v. Daedalus Prime LLC*, No. IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025) (denying institution in part due to the absence of evidence of a likelihood of a stay, vacated on other grounds).

As the Director observed, "an IPR proceeding does not often materially reduce the resources necessary to resolve the district court dispute." *See* Director Revisions

to the Rules of Practice before the PTAB, 90 Fed. Reg. 48335 (Oct. 17, 2025).[2] The District Court Action is already set to resolve the entire dispute—including validity, infringement, and damages—for all five Asserted Patents[3] by April 2027, which is the same time frame as the Board's FWD on this IPR that challenges only the validity of the '347 Patent under §§ 102 and 103. Ex. 2003 (Second Amended Docket Control Order) at 1. By the time the Board issues its FWD, the case will be trial ready, *i.e.*, the parties and the District Court will have already expended substantial resources on completing fact and expert discovery, claim construction, summary judgment briefing, and pretrial order, and held the pretrial conference. *Id.* at 2-5. Thus, the IPR will not meaningfully simplify the district court case or conserve resources.

Samsung has not moved for a stay in the District Court Action. Any such request would be unlikely to succeed because it is the practice of the Eastern District of Texas to deny pre-institution motions to stay as premature. *See* Ex. 2004,

---

[2] https://www.federalregister.gov/d/2025-19580/p-21.

[3] The asserted patents in the District Court Action are U.S. Patent Nos. 8,554,671 ("'671 Patent"); 10,796,296 ("'296 Patent"); 10,937,018 ("'018 Patent"); 11,087,307 ("'307 Patent"); and 12,014,347 ("'347 Patent") (collectively, the "Asserted Patents"). Ex. 2002 (Complaint) at 5-8.

Resonant Sys., Inc. v. Sony Grp. Corp., No. 2:22-cv-00424-JRG, Dkt. No. 84 at 3 (E.D. Tex. July 9, 2024) ("This Court routinely denies pre-institution motions to stay as premature."). To the extent Samsung files a motion to stay ***after*** April 7, 2026, the institution decision deadline in this case, such a motion would be unlikely to succeed given the advanced stage of the case.

First, Judge Schroeder denies motions to stay "when not all claims in a case are subject to PTAB review, finding that proposed simplification by IPR is speculative." Ex. 2011, *Kirsch Rsch. and Dev. LLC v. DuPont de Nemours, Inc.*, No. 5:20-cv-00057-RWS, Dkt. No. 269 at 4 (E.D. Tex. July 7, 2021) (recognizing that "this Court has denied a discretionary stay [even] where all claims were under some form of review at the PTAB") (citing cases); *see also Maxell Ltd. v. Apple Inc.*, No. 5:19-cv-00036-RWS, 2020 WL 10458088, at *3 (E.D. Tex. Nov. 17, 2020) (denying discretionary stay when only 8 of the 20 asserted claims were under review).

Although Samsung has filed IPR petitions for all five Asserted Patents challenged in the District Court Action, Samsung did not challenge all asserted claims of the Asserted Patents. Specifically, regarding the '671 Patent, to which the '347 Patent claims priority, PayGeo is asserting claims 1-3, 22, and 24 in the District Court Action, however, Samsung has only challenged a subset of those claims, 1-3 and 22, in the '671 Patent's IPR proceeding. Therefore, Claim 24 of the '671 Patent

"would remain live" in the District Court Action and the District Court still has to litigate the case "even in a situation where the PTAB invalidates every instituted claim[.]" *See Force Mos Tech. Co., Ltd. v. ASUSTek Comput., Inc.*, No. 2:22-cv-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (denying defendant's motion to stay *with* prejudice because "the IPRs cannot simplify the issues to the extent necessary to justify a stay" since one of the three Asserted Patents are unchallenged).

With no chance of simplifying the case, the District Court is highly unlikely to stay the proceeding. *See Papst Licensing GmbH & Co., KG v. Apple, Inc.*, No. 6:15-cv-01095-RWS, 2018 WL 3656491, at *3 (E.D. Tex. Aug. 1, 2018) (stating that whether an "*inter partes* review proceeding will result in simplification of the issues before the Court" is the "most important factor bearing on whether to grant a stay").

Second, Judge Schroeder denies motions to stay where "the parties have nearly completed fact discovery" such that the case is "far enough along that a stay would interfere with ongoing proceedings. *Maxell Ltd. v. Apple Inc.*, No. 5:19-cv-00036-RWS, 2020 WL 10456915, at *2 (E.D. Tex. Apr. 27, 2020) (citing *Uniloc 2017 LLC v. Samsung Elec. Am., Inc.*, No. 2:19-cv-00259-JRG-RSP, 2020 WL 1433960, at *5 (E.D. Tex. Mar. 24, 2020) (finding progress of a case partially through discovery weight slightly against a stay even though the defendant was not

dilatory in filing the IPR petitions)). By the time an institution decision is expected in this proceeding, the parties to the District Court Action will have already exchanged preliminary infringement, invalidity, and subject-matter eligibility contentions, reviewed over 250 GBs of source code to supplement contentions, and completed a substantial portion of document production and written discovery. *See infra* § III.B.3 (Factor 3); Ex. 2003 at 6-7.

Statistical data since 2020 confirms that motions to stay pending PTAB proceedings in the Eastern District of Texas have been granted only approximately a quarter of the time or less. Ex. 2006 (Motion to Stay Pending IPR is granted approximately 15% of the time per Docket Navigator); Ex. 2007 (Motion to Stay Metrics, Jan. 2020-Nov. 2025) (Motion to Stay Pending PTAB proceedings is granted approximately 26% of the time per Lex Machina).

Accordingly, Factor 1 favors denying institution because it is unlikely that the District Court Action will be stayed.

2. *Fintiv* Factor 2 Favors Denial Due to the Trial's Proximity to the Final Written Decision Deadline

Fintiv Factor 2 strongly favors discretionary denial because trial in the District Court Action is scheduled to commence on April 19, 2027, less than two weeks after the Board's April 7, 2027, deadline to issue a FWD in this case. Ex. 2003 at 1.

Although the FWD is expected before trial, the proximity is so close that there will be no meaningful efficiency gained since all claims challenged in this IPR are

also challenged in the District Court Action. *See, e.g., Amazon.com, Inc. v. KAIFI LLC*, No. IPR2025-00624, Paper 16 at 2 (P.T.A.B. July 29, 2025) (denying institution where a one-month gap between the trial date and FWD deadline "would result in the significant duplication of effort, additional expenses for the parties, and a risk of inconsistent decisions"). At minimum, time-to-trial neither favor nor counsel against discretionary denial. *See Micron Tech., Inc., et al. v. Palisade Techs., LLP*, No. IPR2025-01008, Paper 15 at 2 (P.T.A.B. Oct. 17, 2025) (denying institution where the scheduled trial date is two months before the FWD deadline, but the estimated time-to-trial date is approximately six months after the FWD deadline).

According to U.S. Courts reporting as of June 2025, the median time-to-trial in the Eastern District of Texas is 25.1 months (*i.e.*, approximately May 2027) (Ex. 2008); and according to Docket Navigator, the median time-to-trial in the Eastern District of Texas for the past two years is 21 months (*i.e.*, approximately January 2027) (Ex. 2009). Although the time-to-trial statistics suggest that it is possible that a trial might occur before the projected FWD due date, the difference in timing does not outweigh the efficiencies gained by avoiding parallel proceedings under these circumstances.

Allowing both proceedings to proceed in parallel on nearly the same schedule risks duplication of efforts and inconsistent outcomes, therefore, *Fintiv* Factor 2 strongly favors discretionary denial of institution.

3. *Fintiv* Factor 3: the Parties' Investment in the Case Favors Denial

Fintiv Factor 3 favors discretionary denial because the parties will already have invested significant resources in the District Court Action by the time the Board's institution decision is due. The parties have already briefed a motion to strike a pleading and a motion for judgment on the pleadings, both of which are currently pending.

By April 2026, the parties will have already exchanged preliminary infringement, invalidity, and subject-matter eligibility contentions; reviewed over 250 GBs of source code to supplement contentions; and completed a substantial portion of document production and written discovery. Ex. 2003 at 6-7. The district court will have already invested significant time in managing these exchanges, and the case will be well into its pretrial schedule. Because the district court and parties will have invested significant amount of time and resources to complete major case milestones before institution, Factor 3 weighs in favor of denial.

4. *Fintiv* Factor 4 Favors Denial Because Samsung's Stipulation is Not a True Alternative to the District Court Action

Fintiv Factor 4 favors denial because Samsung's Petition raises "the same or substantially the same claims, grounds, arguments, and evidence" as are at issue in the parallel District Court Action. *Fintiv*, Paper 11 at 12-13. Here, all of the claims challenged by Samsung in this IPR Petition (Claims 1-10) are in Samsung's invalidity contentions in the District Court Action (Claims 1-3, 5-8, and 10). *See* Ex. 2005 (Samsung's Invalidity Contentions) at 1. Moreover, there is substantial overlap between the references and arguments Samsung elected to assert in both forums. *Fintiv*, Paper 11 at 12-13. Samsung's invalidity contentions assert *Grigg* (Ex. 1005), *Carter* (Ex. 1006), and *Google* (Ex. 1007), the same references at issue in its Petition. Each of Samsung's seven invalidity grounds for the '347 Patent in the District Court Action include at least one or more of the above as a reference. Ex. 2005 at 43-44.

Samsung's stipulation does not represent a true alternative to the validity portion of the District Court Action. *See* Paper 7; *Cisco Sys. Inc. v. WSOU Investments LLC*, No. IPR2025-00188, Paper 14 at 2-3 (P.T.A.B. Aug. 22, 2025) (vacating decision granting institution and denying institution because petitioner's stipulation did not ensure the proceeding would be a true alternative to the district court proceeding). In its stipulation, Samsung expressly reserved the right to assert, in the District Court Action, any combination of prior art based on printed

publications that could have been raised in the Petition, so long as the combination also includes evidence (such as a prior art product) that could not have been raised in the Petition. Paper 7.

Samsung's stipulation, therefore, merely creates the appearance of narrowing overlap. *See* Director Revisions to the Rules of Practice before the PTAB, 90 Fed. Reg. 48335 (Oct. 17, 2025) (citing and quoting cases) (cautioning that "petitioners still frequently bring 'repetitive challenges based on slightly rebranded evidence'").[4] Samsung's grounds E1 and E3 are the only ones affected by its stipulation, while the other five grounds are unaffected other than that Samsung cannot rely on *Grigg*, *Carter*, and *Google*, which are cited in this Petition. Ex. 2005 (Samsung's Invalidity Contentions) at 43-44.

Accordingly, Samsung's stipulation seeks to exploit the loophole recognized by the Federal Circuit, without meaningfully narrowing its invalidity grounds in the District Court Action. *See Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that IPR estoppel does not preclude a petitioner from relying on a prior art system in combination with patents and printed publications); *see also* Director Revisions to the Rules of Practice before the PTAB, 90 Fed. Reg. 48335 (Oct. 17, 2025) (the Director observing that "the simplification of the district

[4] https://www.federalregister.gov/d/2025-19580/p-18.

court case is often limited" since "the petitioner substitutes a new invalidity theory in district court for the ones it may be estopped from raising in district court.").[5]

Therefore, Factor 4 weighs in favor of denial.

5. *Fintiv* Factor 5 Favors Denial Because the Parties Are the Same

Fintiv Factor 5 weighs in favor of exercising discretionary denial because petitioners in this proceeding (Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.) are also defendants in the District Court Action. *Fintiv*, Paper 11 at 13-14 (when the parties to the parallel district court action are identical, that weighs in favor of discretionary denial).

6. *Fintiv* Factor 6 Favors Denial Because Samsung's Challenge is an Inefficient Use of Board Resources

Fintiv Factor 6 weighs in favor of denying institution because Samsung's proposed *inter partes* review of the '347 Patent would be an inefficient use of Board resources. *See also supra* § III.B.1, 3.

IV. CONCLUSION

For all of these reasons, PayGeo requests that the Director deny institution of *inter partes* review of the Challenged Claims of the '347 Patent.

[5] https://www.federalregister.gov/d/2025-19580/p-21.

Respectfully submitted,

Date: December 8, 2025

/James Hannah/
James Hannah (Reg. No. 56,369)
HERBERT SMITH FREEHILLS KRAMER (US) LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA 94065
Telephone: (650) 752-1700
james.hannah@hsfkramer.com

Jeffrey H. Price (Reg. No. 69,141)
Jeffrey Eng (Reg. No. 63,189)
Jenna Fuller (Reg No. 74,212)
HERBERT SMITH FREEHILLS KRAMER (US) LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-9100
jeffrey.price@hsfkramer.com
jeffrey.eng@hsfkramer.com
jenna.fuller@hsfkramer.com

Attorneys for Patent Owner
PayGeo, LLC

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, service was made on Petitioners as detailed below.

Date of service	December 8, 2025
Manner of service	Electronic Filing with the Board (joshua.goldberg@finnegan.com; benjamin.saidman@finnegan.com; nicholas.cerulli@finnegan.com; alexander.boyer@finnegan.com; christina.yang@finnegan.com; christopher.anderson@finnegan.com; connor.mcgregor@finnegan.com)
Documents served	PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL
Persons Served	Finnegan, Henderson, Farabow, Garrett & Dunner, LLP: Joshua L. Goldberg Benjamin A. Saidman Nicholas A. Cerulli Alexander M. Boyer Christina Ji-Hye Yang Christopher B. Anderson Connor M. McGregor

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner