UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,
Patent Owner.

Case IPR2025-00628
Patent No. 8,451,339

PETITIONER'S STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Samsung") has filed two petitions challenging claims of U.S. Patent No. 8,451,339.[1] Samsung's two petition approach for challenging the '339 Patent is aimed at simplifying proceedings before the Board and is driven by a unique combination of prior petitions filed by petitioners unrelated to Samsung, litigation timing, and Patent Owner's assertion of claims that had not been previously challenged in IPR. Both petitions should be instituted.

One of Samsung's petitions presents the same evidence and arguments as those presented by another party's petition. Samsung intends to seek joinder and assume an understudy role in that proceeding. Samsung's second petition challenges claims that were first asserted against Samsung after other petitioners had filed their petitions. On these facts, Samsung will only be actively participating in one challenge to the '339 Patent and seeks to streamline proceedings as much as possible.

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[1] *See Patent Trial and Appeal Board Consolidated Trial Practice Guide* ("*TPG*") available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated (last visited Feb. 18, 2025). Samsung is filing this paper in both of its IPR proceedings. This filing is authorized by the *TPG*.

I. OVERVIEW OF THE PENDING IPRS AGAINST THE '339 PATENT

Four IPR proceedings are pending against the '339 Patent. One was filed by Sony, one was filed by a group led by Nikon, and Samsung has filed two.

The Sony and Nikon petitions were filed before Samsung filed either of its petitions. *See Sony Corp. v. Optimum Imaging Techs. LLC*, IPR2024-00925; *Nikon Corp., et al. v. Optimum Imaging Techs. LLC*, IPR2024-01372. Both Sony and Nikon's petitions also predated Patent Owner's infringement contentions in litigation. Ex-1035 (served Sept. 27, 2024). In those contentions, Patent Owner asserted claims 6-13 of the '339 Patent. *Id.* at 4. On January 21, 2025, Patent Owner provided a court ordered reduction of asserted claims but continues allege infringement of claims 6, 7, and 10. Ex-1052. Neither Sony's nor Nikon's petition challenges those claims. Samsung's -628 Petition is the only petition that challenges claims 6, 7, and 10, each of which remain asserted against Samsung.

Samsung's two petitions permit streamlining proceedings before the Board because one of them is a "copycat" of the Nikon IPR petition, and Samsung will seek joinder and assume an understudy role if trial is instituted in the Nikon IPR. Samsung filed its first petition ("the -462 Petition") on January 25, 2025 to challenge claims 1-5 and 14-18 of the '339 Patent. *See* IPR2025-00462, Paper No. 1. The -462 Petition "presents the same arguments and evidence presented in IPR2024-01372 ['the Nikon IPR']." *See* IPR2025-00462, Paper 1 at 1. If the Nikon IPR is instituted,

Samsung will move for joinder. Samsung will also agree to accept an understudy role to avoid burdening the Board and parties.

Samsung's second petition ("the -628 Petition") challenges only patent claims that Patent Owner asserted in litigation after the Nikon IPR was filed—*i.e.*, claims 6, 7, and 10. These claims have not been challenged in any prior IPR petition. Samsung's two petition approach allows Samsung to assume an understudy role in the Nikon IPR—thus streamlining Samsung's challenge to most of the '339 Patent claims—while still preserving its ability to challenge the claims that have not been challenged in any prior IPR petition but are asserted against it in litigation.

Under the Board's prevailing decisions on multiple petition practice and joinder, had Samsung filed a single petition challenging all claims, it would have compromised Samsung's ability to undertake a true understudy role because had Samsung combined its petitions, the resulting petition would have challenged additional claims using additional prior art, relied upon additional evidence, and still duplicated evidence and arguments presented in the Nikon proceeding against the commonly challenged claims. On these facts, a single petition would have likely cut against Samsung's joinder motion and would have led to duplicative challenges to many '339 Patent claims across multiple proceedings. Samsung's approach avoids this.

II. PETITIONER'S STATEMENT REGARDING THE NECESSITY OF MULTIPLE PETITIONS

Under the circumstances presented here, two petitions allow for (1) streamlining of the challenges to most of the '339 Patent claims, while (2) enabling Samsung to present its patentability challenges to all claims asserted against it in litigation. Samsung submits that both of its petitions should result in institution of trial, and that its forthcoming joinder motion should be granted. Doing so will simplify proceedings for the parties and the Board without providing Samsung multiple bites at the proverbial apple.

The differences between the -462 Petition and the -628 Petition are material. The -462 Petition challenges different claims based on different combinations of prior art using different evidence and employing different obviousness theories than those presented in the -628 Petition. There is no overlap of claims or grounds between petitions. Indeed, claim 6 of the '339 Patent includes features that are absent from other claims of the '339 Patent, including "wherein at least one optical and/or digital aberration in the image file are identified by comparing image files in the database management system by using the system software and the integrated circuit." Ex-1001, 38:39-42. The differences between claims required Samsung to present a different prior art combination, different underlying rationales demonstrating obviousness, and different evidence than has been presented in the earlier-filed petitions, including its own -462 Petition.

Both of Samsung's petitions should be instituted. Not only do the petitions demonstrate that the threshold for institution has been met under 35 U.S.C. § 314(a), but the filing of multiple petitions challenging the '339 Patent reflect Samsung's steps to *avoid* unduly burdening the Board and Patent Owner. If the Nikon IPR is instituted and Samsung's joinder motion is granted, Samsung will only be actively participating in a single IPR proceeding against the '339 Patent because it will assume an understudy role in the Nikon IPR.

III. CONCLUSION

As demonstrated above, Samsung has taken affirmative steps to limit the burden on the parties and Board, and based on the unique facts presented here, including the timing of Patent Owner's disclosure of asserted claims in litigation, the timing of earlier-filed petitions, and Samsung's attempts to simplify issues, Samsung respectfully requests that the Board institute trial on both the -462 Petition and the -628 Petition.

Dated: February 21, 2025

Respectfully Submitted,

/*Andrew R. Sommer*/

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Statement Regarding Multiple Petitions** was served by UPS Priority Overnight on the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 8,451,339:

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