

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. IPR2025-01521
U.S. PATENT NO. 11,252,325

PATENT OWNER'S SUR-REPLY

TABLE OF CONTENTS

I. Introduction 1

II. Petitioner has *Still* not Explained its Alternative Positions2

III. Petitioner Failed to Explain its Interpretation of the Claims in its
Petition.....5

IV. Conclusion.....5

TABLE OF AUTHORITIES

American Airlines, Inc. v. Intellectual Ventures I LLC,
 IPR2025-01055, Paper 11 (PTAB Nov. 21, 2025).....2

Blackberry Corp. v. Mobilemedia Ideas LLC,
 IPR2013-00036, Paper 65 (PTAB March 7, 2014)2

Cambridge Mobile Telematics, Inc. v. Sfara, Inc.,
 IPR2024-00942, Paper 12 (PTAB Dec. 13, 2024)3, 5

ipDataTel, LLC et al. v. ICN Acquisition,
 IPR2018-01822, Paper 19 (PTAB Apr. 22, 2019)5

Kiosoft Techs., LLC v. PayRange, Inc.,
 IPR2021-00086, Paper 12 (PTAB Mar. 22, 2021)5

Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.,
 IPR2025-00632, Paper 20 (Squires Nov. 3, 2025).....3, 5

Samsung Elecs. Co., Ltd. v. Wilus Institute of Standards and Tech. Inc.,
 IPR2025-00933, Paper 14 (PTAB Dec. 31, 2025)4

Sonix Tech. Co. v. Publ’ns Int’l, Ltd.,
 844 F.3d 1370 (Fed. Cir. 2017)2

Tesla, Inc. v. Intellectual Ventures II LLC,
 IPR2025-00340, Paper 18 (Squires Nov. 5, 2025).....3

Other Authorities

83 Fed. Reg. 51,342 (Oct. 11, 2018)2

Patent Owner's 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 1 of the '325 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 IPR2025-01521 |
| 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) |

| Exhibit No. | Description |
|-------------|---|
| 2027 | <i>Smartphones v. Cameras: Closing the gap on image quality</i> DXOMARK, https://www.dxomark.com/smartphones-vs-cameras-closing-the-gap-on-image-quality/ |
| 2028 | Chansanchai, A., <i>More than a quarter of photos taken on smartphones</i> , NBC News, https://www.nbcnews.com/tech/tech-news/more-quarter-photos-taken-smartphones-flna118322 , Dec. 22, 2011 |
| 2029 | <i>DxOMark Mobile first quick glance: Smartphones beat 5-year-old DSCs</i> , DXOMARK, https://web.archive.org/web/20121011194829/http://www.dxomark.com/index.php/News/DxOMark-news/Smartphones-beat-5-year-old-DSCs , October 9, 2012 (collected from WayBack Machine) |
| 2030 | Excerpts from file history of International Publication No. WO2014064690 |
| 2031 | Excerpts from file history of U.S. Patent No. 9,338,348 |
| 2032 | U.S. Patent No. 9,338,348 |
| 2033 | Excerpts from file history of U.S. Patent No. 9,661,226 |
| 2034 | European Patent Office – Supplemental Search Report for Application EP 13 84 9379 (03/06/2015) |
| 2035 | U.S. Patent No. 9,661,226 |
| 2036 | Excerpts from file history of U.S. Patent No. 10,009,537 |
| 2037 | U.S. Patent No. 10,009,537 |
| 2038 | <i>SnapAid, Ltd. v. Samsung Electronics Co., Ltd. et al</i> , 2-25-cv-00378-RWS-RSP (E.D. Tex.), Samsung's Invalidation Contentions dated December 1, 2025. |
| 2039 | <i>Exhibit number not used in this proceeding.</i> |
| 2040 | <i>Exhibit number not used in this proceeding.</i> |
| 2041 | <i>Exhibit number not used in this proceeding.</i> |
| 2042 | Certified File History of U.S. Patent No. 10,659,682 |

| Exhibit No. | Description |
|--------------------|--|
| 2043 | Certified File History of U.S. Patent No. 10,944,901 |

I. Introduction

Petitioner's Reply fails to address the precise issue the Director authorized this briefing to resolve: *explaining* its alternative claim construction positions.

In the parallel district court litigation, Samsung asserts that specific '325 Patent claim phrases are indefinite. Here, however, Petitioner and its expert state that no construction is necessary and that a POSITA would find those same limitations disclosed in the prior art. The Director and Board have made clear that, while alternative positions can be permissible in some circumstances, a petitioner must provide a sufficient explanation for them. Petitioner had multiple opportunities to do so—in its Petition, in its opposition to Patent Owner's discretionary denial request, and in its Reply—but at no stage has it cured this defect.

Instead, the Reply offers five pages of procedural conjecture about why Samsung should be allowed to take alternative positions, without addressing the specific claim language at issue in any capacity. A proper response would have explained *why* the plain and ordinary meaning of the allegedly indefinite phrases should apply here. Petitioner does not attempt to do so, and its silence warrants denial of institution.

This omission is part of a broader pattern the Director has cautioned against: asserting multiple, conflicting validity challenges without reconciling them—wasting Board and party resources and undermining predictability between forums.

II. Petitioner has *Still* not Explained its Alternative Positions

The Director and Board have recognized the inherent tension between prior art-based challenges and indefiniteness positions, and have made clear that petitioners must address that tension directly:

Under 37 C.F.R. § 42.104(b)(3), *petitioners* must clearly articulate *in the petition* “[h]ow the challenged claim is to be construed.” If, according to Petitioner, many limitations in claim 1 (and other claims) are indefinite, then how does Petitioner propose that the Board construe such limitations to assess Petitioner’s invalidity challenges—*Petitioner is silent*.

American Airlines, Inc. v. Intellectual Ventures I LLC, IPR2025-01055, Paper 11 at 13 (PTAB Nov. 21, 2025). A claim must be understood before it can be challenged under §§ 103 or 112. *See Blackberry Corp. v. Mobilemedia Ideas LLC*, IPR2013-00036, Paper 65 at 7 (PTAB March 7, 2014), *Sonix Tech. Co. v. Publ’ns Int’l, Ltd.*, 844 F.3d 1370, 1378 (Fed. Cir. 2017).

Balancing this tension with the need for uniformity and predictability, the procedures to promote consistent claim interpretation across forums have been adopted. *See e.g.*, 83 Fed. Reg. 51,342 (Oct. 11, 2018) (adopting federal court claim construction standard to promote “uniformity and predictability”). Consistent with this approach, multiple decisions confirm that while petitioners may take alternative positions in different forums, they are ***required*** to explain why those positions are

warranted. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3 (Squires Nov. 5, 2025) (informative), *Revvo Techs., Inc. v. Cerebrum Sensor Techs. Inc.*, IPR2025-00632, Paper 20 at 3–5 (Squires Nov. 3, 2025) (precedential), *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00942, Paper 12 at 8–9 (PTAB Dec. 13, 2024) (informative).

In the parallel litigation, Samsung's invalidity contentions assert that five different claim phrases are indefinite and “do not have a meaning that can be clearly determined from the patent.” Ex. 2038 at 169; *see also* POPR at §V.A. In its petition, however, Petitioner states that “terms in the Challenged Claims need not be construed” (Pet. at 7; *see also* Ex. 1003 at ¶53) and purportedly applies the plain and ordinary meaning to map those same phrases to alleged prior art. *See* POPR at §V.A. In other words, Petitioner tells the District Court these terms cannot be understood, while telling the Board they require no construction and are taught in the prior art—offering neither a justification for its different positions nor any articulation of the plain and ordinary meaning of the claim terms.

Notably, Petitioner's Reply does not recite, address, or analyze *a single disputed claim term*. The Reply instead offers only the conclusory statement that “the claims of the '325 Patent are sufficiently clear to permit a meaningful comparison to the prior art.” Reply at 4. That is no explanation, and it is exactly the type of conclusory assertion the Director has rejected. *See Tesla*, IPR2025-00340,

Paper 18 (petitioner's explanation that it could not argue indefiniteness in an IPR is insufficient to show why different claim construction positions are warranted).

Petitioner claims to address "all reasonable interpretations" but identifies none, and asserts differences are "justified" by Patent Owner's infringement contentions without providing reasoning or examples. Reply at 2. Petitioner is simultaneously saying that the identified phrases "do not have a meaning that can be clearly determined from the patent" (Ex. 2038 at 169), but also that the indefiniteness is not "so severe" as to preclude construction (Reply at 3). These are plainly inconsistent positions that require explanation, yet Petitioner offers no analysis of how even one disputed term should be construed. In short, the Reply contains no substantive explanation of its claim construction or indefiniteness positions.

Petitioner's reliance on the "early stages of litigation" is also misplaced. The District Court litigation has a trial set for April 2027, with indefiniteness arguments due as part of *Markman* briefing in September 2026, just months after any potential institution. Ex. 2002 at 1, 4, and 6. Moreover, Samsung has not indicated that it will refrain from pursuing inconsistent positions, instead asserting without explanation that its positions are not inconsistent. *See Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-00933, Paper 14 at 6 (PTAB Dec. 31, 2025). Petitioner also describes its invalidity contentions as "comprehensive." Reply at 1. Given those "comprehensive" contentions, its refusal to reconcile positions here is

particularly deficient.

III. Petitioner Failed to Explain its Interpretation of the Claims in its Petition

The requirement to explain differing claim construction positions applies at the time of filing the petition. Numerous decisions that predate the petition hold that a petitioner must provide this explanation in the petition itself. *See, e.g., Cambridge Mobile*, IPR2024-00952, Paper 12 at 8–9, *Kiosoft Techs., LLC v. PayRange, Inc.*, IPR2021-00086, Paper 12 at 16 (PTAB Mar. 22, 2021), *ipDataTel, LLC et al. v. ICN Acquisition*, IPR2018-01822, Paper 19 at 13–14 (PTAB Apr. 22, 2019).

Petitioner had multiple opportunities to meet this obligation: in its Petition, in its opposition to Patent Owner's request for discretionary denial, and in the additional briefing it sought and received. Yet at each stage, Petitioner failed to explain—or even address—a single claim term. As *Revvo* cautions, “[a]llowing petitioners to continue this practice [of proposing different claim constructions without explanation] does not further the Office's goal of providing greater predictability and certainty in the patent system.” *Revvo*, Paper 20 at 4 (internal quotations omitted). That policy concern applies squarely here: Petitioner's silence invites inconsistent interpretations of the same claim terms in parallel proceedings, eroding predictability, wasting resources, and prejudicing the Patent Owner.

IV. Conclusion

Petitioner's unexplained alternative positions warrant denial of institution.

Dated: January 5, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on the fifth day of January 2026, a complete and entire copy of the foregoing "PATENT OWNER'S SUR-REPLY" 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: January 5, 2026

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

Counsel for Patent Owner,
SNAPAID LTD.

CERTIFICATE OF COMPLIANCE

This Patent Owner's Sur-Reply complies with the 5-page limitation required by the Director's December 29, 2025 email message (Ex. 3101).

Dated: January 5, 2026

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

Counsel for Patent Owner,
SNAPAID LTD.