

Opposition to Patent Owner's Request for Discretionary Denial
PGR2025-00083

IN THE 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

U.S. PATENT NO. 12,250,452

Case PGR2025-00083

**OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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Exhibit No.	Description
1001	U.S. Patent No. 12,250,452
1002	File History of U.S. Patent No. 12,250,452
1003	<i>Curriculum Vitae</i> of Dan Schonfeld
1004	Declaration of Dan Schonfeld in support of <i>Inter Partes</i> Review
1005	U.S. Patent No. 8,508,622 (“Anon”)
1006	U.S. Pat. App. Pub. No. 2010/0149361 (“Takeuchi”)
1007	U.S. Pat. App. Pub. No. 2004/0012682 (“Kosaka”)
1008	U.S. Pat. App. Pub. No. 2009/0296989 (“Ramesh”)
1009	U.S. Pat. App. Pub. No. 2011/0150447 (“Li”)
1010	U.S. Pat. App. Pub. No. 2012/0133746 (“Bigioi”)
1011	Tsung-Jung Liu and Wei Lin, “Image Quality Assessment Using Multi-Method Fusion,” IEEE Transactions on Image Processing, Vol. 22, No. 5, May 2013 (“Liu”)
1012	U.S. Pat. App. Pub. 2011/0222724 (“Yang”)
1013	Provisional Application No. 61/717,216, filed on October 23, 2012
1014	Provisional Application No. 61/759,643, filed February 1, 2013
1015	U.S. Pat. App. Pub. 2013/0076856 (“Wakabayashi”)
1016	Excerpts from Hector Garcia-Molina et al., “DATABASE SYSTEMS The Complete Book,” 2009 (“Garcia-Molina”)
1017	U.S. Pat. App. Pub. No. 2005/0270381 (“Owens”)

¹ Unless otherwise specified, citations are to the original page, column, and line numbers in exhibits, and all emphasis is added unless otherwise noted.

I. INTRODUCTION

The Petition demonstrates that the earliest priority date to which the '452 patent is entitled is after March 16, 2013, making it PGR-eligible. Neither of SnapAid's provisional applications discloses critical features recited by all challenged claims, such as selecting from a pre-stored table of suggestions based on a total quality indicator. Samsung's expert evaluated the provisional applications and confirmed the absence of such disclosures. The '452 patent's claims are not entitled to either provisional's filing date and are subject to PGR.

SnapAid's additional arguments for discretionary denial are unpersuasive and unsupported by relevant facts or precedent. First, SnapAid's reliance on the age of earlier, patents in the family does not and cannot create settled expectations for the recently issued '452 patent, **which has been in force for less than one year.** Although SnapAid spends much of its brief attempting to establish that Samsung had knowledge of the original PCT application and older patents that issued from that application—Samsung does not challenge any of these older patents in IPR. The record before the Office establishes that the '452 patent and the other patents Samsung does challenge claim independent inventions: not one of those patents is subject to a terminal disclaimer over any of the older three. And SnapAid's own positions, both in its past interactions with Samsung and in the present litigation, concede that the patents Samsung has challenged in IPR/PGR stand on their own.

The Office has repeatedly emphasized that PGR challenges are favored. That is what Samsung has done here.

Second, SnapAid's assertion that no efficiencies are gained by Samsung's *Sotera* stipulation because its three older patents are not challenged in IPR is unfounded and contrary to Board precedent. The *Fintiv* factors strongly support institution: the Final Written Decision will issue before the district court trial, and the parties and court have not yet made significant investments in the parallel litigation. The fact that three patents remain unchallenged does not undermine the substantial efficiencies achieved by resolving the validity of the majority of asserted patents in a single, expert forum. Moreover, Samsung's broad *Sotera* stipulation precludes duplicative validity arguments in district court, eliminating the risk of inconsistent outcomes.

Third, the examiner's failure to discover and apply the primary reference applied in the Petition, Anon, constitutes a material error that undermines the integrity of the examination process for the '452 patent. This error is highly relevant to the question of discretionary denial and strongly supports the position that such a denial would be inappropriate.

II. THE '452 PATENT IS ELIGIBLE FOR POST-GRANT REVIEW

The '452 patent is eligible for PGR. The '452 Patent issued from an application filed after March 16, 2013, but attempts to claim the benefit of two

provisional applications filed before March 16, 2013 (*i.e.*, transition applications).

For a patent such as the ’452 patent which claims priority to a transition application, eligibility for post-grant review depends on whether the patent contains or contained at any time a claim that lacks written description and enabling support in the translation application[s]. See MPEP § 2159.04 (9th ed. Rev. 10.2019, June 2020). The Petition (Section III.B) establishes that the priority date of the ’452 patent is after March 16, 2013, and thus the ’452 patent is eligible for PGR.

SnapAid disagrees, arguing that the Petition is deficient because it allegedly (i) fails to consider the provisional applications’ disclosure of suggestions and (ii) does not have Samsung’s expert evaluate that disclosure from the perspective of a POSITA. SnapAid is incorrect on both points. **First**, the written description standard is not whether the disclosure conveys possession of the broader concept as SnapAid asserts. DD Brief at 18 (emphasis added). That is a remarkable—and unsupported—proposition. As the Federal Circuit explained in *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997), “[a] description which renders obvious the invention for which an earlier filing date is sought is not sufficient.” That is precisely the situation here. Neither provisional application discloses “selecting based on the total quality indicator at least one appropriate suggestion from a pre-stored table of suggestions,” as required by all Challenged

Claims. Petitioner’s expert reviewed the provisional applications and concluded that there is no disclosure of a “pre-stored table of suggestions.” See EX1004, ¶ 36.

SnapAid points to a section of one provisional entitled “Using the total quality indicator,” which states that “the user may *choose to get suggestions from the application* on how to improve the next shot.” But this passage does not disclose—or even suggest—“selecting based on the total quality indicator at least one appropriate suggestion *from a pre-stored table of suggestions*” as required by all challenged claims.

Second, Petitioner’s expert did, in fact, evaluate the disclosure for written description support from the perspective of a POSITA. In paragraph 24 of his declaration (EX1004), Dr. Schonfeld states that he understands “that for a patent claim to satisfy the written description requirement, the disclosure must reasonably convey to a POSITA that the inventor had possession of the claimed subject matter.” In paragraphs 35–38, he applies that standard in evaluating the provisional applications. Thus, Patent Owner’s assertion that Samsung’s expert did not assess the written description from the correct perspective is clearly erroneous.

As pointed out in the Petition, the provisional applications suffer from additional deficiencies, specifically failing to provide written description support for “calculating an aesthetic quality indicator QI2 that uses a background blurring test of said face or object,” also required by all challenged claims. Patent Owner cites a

variety of “quality indicators” that “relat[e] to face detection, focus, aperture, depth-of-field, exposure, horizon identification.” DD Brief at 19. But none of these indicators convey to a POSITA possession of a quality indicator for testing *background* blurring, much less the background blurring *of a face or object*. See EX1001 at 14:1-2.

Patent Owner’s other references to the provisional applications are likewise unavailing. Vague gestures to “methods to evaluate image blur or evaluate image details” do not convey to a POSITA possession of the feature at issue: testing *background* blurring *of a fact or object*. See DD Brief at 19. Nor is it enough that the provisional application discloses that “there are many quality indicators.” *Id.* In a similar vein, contrary to Patent Owner’s suggestion, a POSITA would not have understood the term “aesthetic quality indicator” to convey possession of testing background blurring of a face or object. *See id.*

SnapAid also bemoans Samsung’s analysis as conclusory. It is not. Samsung and its expert analyzed the provisional applications and found nothing that provides plausible written description support, even implicitly. The Petition reflects the fruits of that scavenge. SnapAid’s own cited caselaw makes clear that “Petitioner first must *raise* the issue of whether Patent Owner is entitled to its effective filing date by ‘*identifying, specifically, the features, claims, and ancestral applications*’ allegedly *lacking written description* support for the claims based on the identified

features.” *Huawei Techs. Co., Ltd. v. Samsung Elecs. Co., Ltd.*, IPR2017-01980, Paper 9 at 10 (Feb. 27, 2018). Petitioner did just that. It identified two features that lack written description support, the claims that lack those features (all of them), and the relevant ancestral applications.

The provisional applications therefore fail to provide written description support for the claims of the ’452 patent. The ’452 patent is accordingly eligible for PGR.

III. SNAPAID HAS NOT FORMED SETTLED EXPECTATIONS

Although the ’452 Patent issued *less than one year ago*, SnapAid claims settled expectations, arguing that Samsung “selectively avoided challenging the Asserted Patents that issued more than six years ago” and that “the ’452 patent is a direct descendant from unchallenged Asserted Patents that go back nine years with a common specification and generally related claim scope.” DD Brief at 7-8. SnapAid’s arguments fail.

The Director has consistently recognized that settled expectations do not weigh in favor of discretionary denial where the challenged patent has not been in force for a significant period or where early challenges are involved, such as the case is here. *See e.g., Suzhou Mojawa Intelligent Elec. Co., Ltd. v. Shenzhen Shokz Co., Ltd.*, IPR2025-00842, Paper 14, Director Decision (Sept. 19, 2025) (“[T]he challenged patents have not been in force for a significant period of time (issued in

2021 and 2022). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.”); *Intel Corp. v. Advanced Cluster Sys., Inc.* IPR2025-00913, Paper 13, Director Decision (Sept. 19, 2025) (same); and *Google LLC v. BrodTi Inc.*, IPR2025-00472, Paper 19, Director Decision (Sept. 19, 2025) (same).

SnapAid nevertheless argues for discretionary denial by contending that the ’452 patent should benefit from alleged settled expectations attaching to three older patents—patents that it concedes Samsung has not challenged in IPR. DD Brief at 6-7. In this regard, SnapAid’s reliance on *Apple Inc. v. Apex Beam Techs. LLC* is misplaced. DD Brief at 8. In the *Apex Beam* decision, the Director referred the petitions to the Board making clear that “[a]lthough 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, Patent Owner has not sufficiently articulated such reasons in these proceedings. In the absence of such information, Patent Owner has not demonstrated that it has developed strong settled expectations that favor discretionary denial.” *Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10, Director Decision (Sept. 3, 2025). That is the case here: as explained below, SnapAid does not sufficiently articulate reasons why settled expectations could exist for the recently issued patents at issue in these proceedings.

At bottom, SnapAid's alleged settled expectations rely exclusively on the age of certain patents within the asserted family **that are not subject to challenge before the Board**. SnapAid presents no other facts suggesting that its recently issued patents have acquired any settled expectations. Nowhere does SnapAid allege that the patents that Samsung has actually challenged—including the '452 patent—have ever been previously asserted in litigation prior to the current district court action or adjudicated elsewhere. Nor does SnapAid claim that any party, including Samsung or any third party, has ever taken a license to the '452 patent or any of the other asserted patents. SnapAid makes no allegation that the '452 patent has been commercialized, widely adopted, or otherwise recognized in a manner that would give rise to any industry acquiescence. Simply put, SnapAid does not point to any conduct or representations by Samsung or others that would suggest the '452 patent—the patent at issue here—has acquired a status that would warrant the application of the settled-expectations doctrine.

To the contrary, the only facts SnapAid relies on are (1) the mere passage of time since the issuance of certain older, unchallenged patents in the family, and (2) the existence of communications with Samsung that referenced the patent family generally. SnapAid asserts that it made detailed disclosures to Samsung in both 2015 and 2017 and alleges that this scenario aligns with recent decisions denying institution under Section 314(a), citing *Amazon.com Servs. LLC v. Audio Pod, LLC*,

IPR2025-00757, Paper 15 at 3 (Aug. 14, 2025). In contrast to *Amazon*, however, SnapAid’s disclosures to Samsung identify several separate inventions, each with its own technical focus. For example, in Ex. 2019, SnapAid identifies at least five categories of disclosures A-E (e.g., A. “Real time assessment of picture quality” and C. “Estimating and using relative head pose and camera field-of-view”) and provide separate “Short summery {sic} of inventions.” Each of these categories is described as a separate technical solution, and the documentation provides summaries of their unique contributions and applications. *Id.*

SnapAid’s marketing and technical presentations (Ex. 2014) reinforce their belief that their portfolio consists of “individual patents.” Ex. 2014, 20. This presentation represents SnapAid’s belief that it was in possession of multiple, distinct inventions, not just incremental improvements or embodiments of a single inventive concept. Moreover, SnapAid’s Complaint is consistent with each of its asserted patents as being patentably distinct. *See e.g.*, of Ex. 2001 ¶ 100 (“None of the claims of the ’452 patent are representative of the ’452 patent’s other claims or claims of the other Asserted Patents”). According to SnapAid, the claims of the ’452 patent recite “specific improvements over prior art and conventional systems, apparatuses, and methods and represent meaningful limitations and/or inventive concepts.” *See* Ex. 2001 ¶ 79.

This distinction is critical. The fact that SnapAid itself has repeatedly emphasized the individuality of its patents undermines any presumption that the older, unchallenged patents cover the same inventions or subject matter as the newer, challenged patents—such as the '452 patent. No basis exists to assume that the settled expectations, if any, associated with SnapAid's older patents extend to the '452 patent or any other later-issued patent in the family. Each patent stands on its own, as acknowledged by SnapAid's own representations.

Indeed, the prosecution histories of SnapAid's patents confirm this point. The Examiner of the application that led to the '452 patent recognized that application to cover an invention patentably distinct and different from SnapAid's earlier patents as the Examiner never made an obviousness-type double patenting rejection and never required a terminal disclaimer over those earlier patents. Indeed, of the eight patents claiming priority to SnapAid's original PCT application, only U.S. Patent No. 11,671,702 is subject to a terminal disclaimer, and that terminal disclaimer is tied to U.S. Patent No. 10,944,901. Both the '702 and '901 patents are recently issued and are currently subject to IPR challenges by Petitioner. SnapAid's six other patents are not subject to any terminal disclaimer and are therefore presumed to be patentably distinct from one another.

Nevertheless, contrary to its own Complaint and the file history of the '452 patent, SnapAid now asserts that claim 1 of the '452 patent has “similar scope” to

claim 1 of the unchallenged '226 and '537 patents. DD Brief at 4-5. This assertion is incorrect. Claim 1 of the '452 patent expressly requires (1) calculating “a quality indicator QI1 of a face or object”; (2) “calculating an aesthetic quality indicator QI2 that uses a background blurring test of said face or object”; and (3) using “pre-stored table of suggestions, suggesting to the user to move the device to a different location[,]” aspects which are not found in claim 1 of the '226 or '537 patents. Moreover, claim 1 of the '452 patent specifies a particular set of quality indicators; claim 1 of the '226 and '537 patents are not directed to this combination of quality indicators.

The file history of the '452 patent demonstrates that the Examiner believed—albeit mistakenly—that the combination of limitations recited in claim 1, which are absent from claim 1 of the '226 and '537 patents, constitutes the point of novelty of the '452 patent. The examiner expressly found that the prior art did not disclose:

calculating from an image received by at least one sensor and lens, a quality indicator of a face or object, and calculating an aesthetic quality indicator QI2 [sic] that uses a background blurring test of said face or object, and calculating a total quality indicator that is based at least partially on at least one of QI and QI2; selecting based on the total quality indicator at least one appropriate suggestion from a pre-stored table of suggestions, and suggesting to the user to move the device to different location; and presenting the selected suggestion to the user

when taken in combination with all the limitations of the independent claim.

EX1002 at 366 (Notice of Allowability). Accordingly, neither SnapAid’s Complaint nor the ’452 patent file history supports SnapAid’s argument that claim 1 of the ’452 patent and claim 1 of the ’226 and ’537 patents “have similar scope.”

In sum, SnapAid has not established any settled expectations regarding the ’452 patent. The ’452 patent issued less than a year ago and the SnapAid patents are presumptively patentably distinct, as evidenced by the absence of terminal disclaimers, the lack of obviousness-type double patenting rejections, and SnapAid’s own representations that each patent embodies a separate and independent inventive contribution. SnapAid has not articulated any specific reliance or investment that would give rise to settled expectations, and the distinctions in claim scope—particularly the unique limitations of the ’452 patent—further undermine any such argument. Accordingly, the record does not support discretionary denial under § 324(a) for settled expectations.

IV. *FINTIV* FACTORS WEIGH IN FAVOR OF INSTITUTION

The application of the *Fintiv* factors in this case strongly supports institution of PGR.

A. Factor 1: The *Sotera* Stipulation Minimizes Duplicative

Investment

No motion to stay has been filed, so the Board should not infer the outcome of such a motion. *Sand Revolution II, LLC v. Cont’l Intermodal Grp.–Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative). Furthermore, if trial is instituted, Samsung’s *Sotera* stipulation will significantly reduce the potential for duplicative investment between the PTAB and the Eastern District of Texas (“EDTex”), even in a scenario where a stay of the EDTex case is not achieved. Under the *Sotera* stipulation, Samsung has agreed not to pursue in EDTex any invalidity grounds that were raised or could reasonably have been raised in the PGR proceeding. Ex. 2025, ’425 *Sotera* Stipulation Email. This broad commitment ensures that, regardless of the outcome at the PTAB, the same invalidity arguments will not be relitigated in the district court. *See e.g., Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9, Director Decision (June 13, 2025) (“Other considerations, however, counsel against discretionary denial. For example, Petitioner has filed a broad stipulation”).

By making this stipulation, Samsung effectively narrows the scope of issues that EDTex must address, focusing the court’s attention on other issues such as infringement and damages. This approach substantially reduces the risk of duplicative work, conflicting decisions, and unnecessary expenditure of resources.

See Samsung Elects. Co., v. Wilus Inst. of Standards and Tech., IPR2025-00933,
Paper 11, Director Decision (Oct. 10, 2025).

Because the claims in the five challenged patents are not the same as those in the three unchallenged patents, the district court’s role with respect to the challenged patents will be substantially narrowed. The *Sotera* stipulation ensures that all invalidity grounds that could be raised in the PGR will not be relitigated in the district court for those five patents. As a result, to the extent the three unchallenged patents remain in the litigation, have not been otherwise disposed of or dismissed, the jury and the court can focus their validity analysis exclusively on those patents, while for the four challenged patents in IPR, the district court’s attention will be limited to issues such as infringement, damages, and any validity challenges under Sections 101 or 112. And for this patent challenged in PGR, the district court’s attention will be limited to issues such as infringement and damages.

B. Factor 2: The Anticipated FWD Predates the EDTex Trial Date

When the Board’s projected FWD is scheduled to issue before the district court trial—here by over one month—this timing, in combination with a broad *Sotera* stipulation, weighs strongly in favor of institution and against discretionary denial. For example, in *Apple Inc. v. Apex Beam Techs. LLC*, the Director denied discretionary denial where the FWD was projected to issue three weeks before the district court trial, finding that this timing reduced the concern of inconsistent

outcomes or significant duplication of efforts. *See Apex Beam Techs.*, IPR2025-00896 at 2.

C. Factor 3: The Overall Investment in EDTex Has Been Limited

The record does not support SnapAid's assertion that there has been significant investment in the EDTex litigation. According to the scheduling order, Ex. 2002, the case remains in its early stages, with trial not scheduled until April 19, 2027. Key pretrial deadlines, such as the final invalidity theories (April 5, 2027) and final election of asserted claims (March 29, 2027), are set for just weeks before trial, and the parties are still in the process of exchanging contentions and written discovery. The claim construction hearing is set for October 22, 2026 and mediation and expert-related motions are contingent on future events, such as the issuance of the claim construction order, further underscoring that the case has not yet reached advanced stages of litigation or significant judicial investment.

Under *Fintiv* and *Sotera*, if a claim construction hearing in the parallel district court litigation is scheduled to occur after the institution of (which is the case here), this timing indicates that the district court has not yet made significant substantive investment in resolving the patent issues, such as issuing claim construction orders or conducting key hearings. As emphasized in *Sotera*, when the court and parties have not yet completed major milestones like the *Markman* hearing, the overall investment in the parallel proceeding is considered limited, and much substantive

work remains to be done. *Sotera Wireless, Inc., v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16 (Dec. 1, 2020) (precedential). This limited investment, weighs against discretionary denial and in favor of institution, as it reduces concerns about duplicative efforts and inefficiency.

Furthermore, petitions for PGR are favored because they must be filed no later than nine months from the grant of the patent. 35 U.S.C. § 321(c). *See LifeVac, LLC v. DCSTAR Inc.*, IPR2025-00454, Paper 11 at 2, Director Decision (July 11, 2025) (indicating that petitions for PGR are favored). In order to satisfy the nine-month filing requirement, petitioners in PGR must file diligently. *See Snap v. SRK Tech.*, IPR2020-00820, Paper 15 at 12–13 (Oct. 21, 2020) (precedential).

D. Factor 4: The *Sotera* Stipulation Substantially Reduces Overlap

As discussed above, for each of the five PTAB proceedings, Samsung agreed to enter a *Sotera*+ stipulation (or in the case of this PGR a *Sotera* stipulation). By making these stipulations, Samsung has significantly narrowed the scope of issues that EDTex would need to address if the trials are instituted. SnapAid argues that, even though Samsung has agreed not to pursue in EDTex any prior art grounds that were or could have been raised in the IPR/PGRs—including combinations involving system prior art and the references asserted in the four IPRs—Samsung could still assert the same or similar prior art against the three unchallenged patents in EDTex. SnapAid’s concerns, however, are overstated.

The *Sotera+ / Sotera* stipulations substantially narrow the issues that the EDTex must address regarding the five SnapAid patents challenged in the IPR/PGRs. By unequivocally precluding Samsung from asserting in EDTex any invalidity grounds that were or could have been raised in the IPR/PGRs, the stipulation ensures that all such arguments are resolved exclusively in the PTAB.

While SnapAid cites the three unchallenged patents as a source of potential overlap, their existence does not diminish the efficiency gained by removing all prior art-based invalidity disputes for the five challenged patents from EDTex’s docket. The *Sotera* stipulation fulfills the core purpose of the Director’s discretionary denial framework. Any remaining overlap is limited and outweighed by the substantial narrowing of issues achieved by the stipulation.

E. Factor 5: The Identity of the Parties Is Not Dispositive

SnapAid argues that the parties are identical, and that the PGR will not simplify the EDTex case. However, the identity of parties is only one factor and is not dispositive. *See e.g., Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11, Director Decision (June 26, 2025).

F. Factor 6: The Merits of the Petition are Strong

SnapAid argues that the Petition is not compelling because it relies on complex, multi-reference combinations. This assertion is incorrect. To avoid any reliance on expert testimony to “fill gaps,” the Petition instead uses secondary

references to teach the various combinations of quality indicator weights and values. Specifically, while the primary reference, Anon, discloses the core of the claimed invention—a composition and feedback (“C&F”) engine that uses a “weighted combination of parameters” to make suggestions to a user—secondary references such as Takeuchi and Kosaka are cited to teach specific parameters.

For example, claim 1 of the ’452 patent is directed to a method for presenting suggestions to a user and estimating the quality of images. The method involves obtaining and weighting multiple quality indicators (QIs) based on image and sensor data: (QI1) quality indicator of a face or object; and (QI2) aesthetic quality indicator that uses a background blurring test of the face or object. Anon similarly describes providing feedback on image composition using its C&F engine. The method analyzes multiple characteristics, computes a composition measure, and provides user feedback or suggestions to improve the image. Anon explicitly contemplates the detection and recognition of faces within the image. EX1005, 3:62-4:3.

The secondary references teach additional QIs that a POSA would have been motivated to use as inputs for Anon’s C&F engine. For example, Takeuchi teaches using a blue/focus test to determine how well the subject of the photograph is in focus, which evaluates whether the background is focused. *See* EX1006, ¶¶ [0143], [0291]. Kosaka teaches a digital camera system that is designed to detect whether a user’s finger is unintentionally obstructing the lens. *See* EX1007, Fig. 6A; EX1004,

¶ 85. And Li provides a detailed discussion of how depth of field may be determined in a digital camera. *See* EX1004, ¶¶ 94-95.

V. EVIDENCE OF MATERIAL ERROR WEIGHS AGAINST DISCRETIONARY DENIAL

The failure of the examiner to discover and apply Anon during prosecution of the '452 patent constitutes a material error that weighs heavily against any discretionary denial. Other than the examiner's statement of reasons for allowance, which merely copied the method steps recited by claim 1, the Examiner provided no indication as to why the claims were allowable. EX1002 at 366-67.

Each of the references identified in the Examiner's Notice of References Cited is assigned specific codes that correspond to the technological field and subject matter, indicating that the cited references are relevant to the '452 Patent's technical area. EX1002 at 93. Given the breadth and specificity of these classifications, any comprehensive search that revealed the listed references would necessarily encompass the same technological fields and subject matter as Anon. Therefore, a highly relevant reference such as Anon should have been discovered.

Yet it was not. Anon is classified in H04N 5/76; H04N 5/228; H04N 5/222; G06K 9/62; and G06K 9/64—classifications that overlap directly with those searched and relied upon in the examination of the '452 patent. EX1005, cover. The omission of Anon from the list of references cited is not a mere oversight, but a significant lapse given the clear overlap in both classification and technological

domain. Moreover, the subject matter of Anon is highly material to the '452 claims. Anon discloses a system and method for providing automatic, real-time feedback on image composition using a camera, with an integrated engine that analyzes image characteristics and external context to suggest adjustments and improve aesthetic quality. EX1005, Abstract. This is directly relevant to the '452 patent's focus on assessing picture quality and the provision of user suggestions for improving image capture. Both patents address the core problem of assisting users in capturing better photographs or videos through real-time analysis and feedback, and both employ similar technological approaches.

Anon's teachings should have had a direct and substantial impact on the scope and patentability of the '452 patent's claims, and its absence from the record cannot be justified by the volume of prior art or by minor differences in terminology. The error is particularly acute in a field as crowded and well-classified as digital imaging, where the expectation of thorough prior art consideration is especially high. *See Carbyne, Inc. v. Trittech Software Sys.*, IPR2025-00959, Paper 11 at 2, Director Decision (Oct. 3, 2025).

VI. CONCLUSION

SnapAid's request for discretionary denial does not present circumstances that warrant denial under Board and Director precedent. The Petition should proceed to institution and be addressed on the merits.

Opposition to Patent Owner's Request for Discretionary Denial
PGR2025-00083

Dated: December 15, 2025

Respectfully submitted,

/s/ Robert A. Appleby

**Robert A. Appleby
Counsel For Petitioner
Reg. No. 40,897**

CERTIFICATE OF COMPLIANCE

This Opposition to Patent Owner's Request for Discretionary Denial complies with the 20-page limitation as mandated by the Interim Director Discretionary Process III.C.

/Robert A. Appleby/

Robert A. Appleby (Reg. No. 40,897)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document was served on December 15, 2025, via electronic service.

December 15, 2025

/Robert A. Appleby/
Robert A. Appleby (Reg. No. 40,897)