

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SNAPAID, LTD.  
Patent Owner.

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CASE NO. PGR2025-00083  
U.S. PATENT NO. 12,250,452

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

**TABLE OF CONTENTS**

I. Introduction .....1

II. Background .....2

III. Settled Expectations Weigh in Favor of Discretionary Denial.....4

IV. The *Fintiv* Factors Weigh in Favor of Discretionary Denial .....9

    A. The district court litigation has not been stayed and there is no  
    evidence a stay will be granted. ....9

    B. The proximity of the court’s scheduled trial date to the Board’s  
    Final Written Decision weighs in favor of denying institution. ....11

    C. There will be significant investment in the district court before  
    any Decision on Institution. ....12

    D. Petitioner’s *Sotera* stipulation does not resolve the potential  
    overlap and is not dispositive. ....13

    E. The parties are identical in the district court proceeding. ....15

    F. The arguments in the Petition are not compelling.....15

V. The ’452 Patent is Not Eligible for PGR Review.....16

VI. Conclusion.....20

**TABLE OF AUTHORITIES**

**Cases**

*ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*  
694 F.3d 1312 (Fed. Cir. 2012) .....15

*Am. Honda Motor Co., Inc. v. Neo Wireless LLC*  
IPR2023-00797, Paper 29 (Sep. 3, 2024)..... 17, 20

*Amazon.com Servs. LLC et al v. Audio Pod, LLC*  
IPR2025-00757, Paper 15 (Aug. 14, 2025).....8

*Apple Inc. v. Apex Beam Techs. LLC*  
IPR2025-00896, Paper 10 (Sept. 3, 2025) .....8

*Apple Inc. v. Fintiv, Inc.*  
IPR2020-00019, Paper 11 (Mar. 20, 2020) .....12

*Apple Inc. v. Fintiv, Inc.*  
IPR2020-00019, Paper 15 (May 13, 2020) .....14

*Aquestive Therapeutics, Inc., v. Iono Pharma, LLC*  
IPR2025-00874, Paper 11 (Oct. 3, 2025) .....8

*AT&T Servs. Inc. v. RightQuestion, LLC*  
IPR2025-00360, Paper 12 (July 29, 2025) .....9

*Cambridge Indus. USA Inc. v. Applied Optoelectronics, Inc.*  
IPR2025-00433, Paper 8 (Apr. 28, 2025) .....13

*Ecto World, LLC et al. v. RAI Strategic Holdings, Inc.*  
PGR2024-00049, Paper 10 (Mar. 10, 2025) .....16

*Huawei Techs. Co., Ltd. v. Samsung Elecs. Co., Ltd.*  
IPR2017-01980, Paper 9 (Feb. 27, 2018).....20

*Inguran, LLC v. Premium Genetics (UK) Ltd.*  
PGR2015-00017, Paper 8 (Dec. 22, 2015).....16

*Initiative for Medicines, Access & Knowledge (I-Mak), Inc. v. Gilead  
Pharmasset LLC, IPR2018-00121, Paper 10 (May 21, 2018) ..... 19, 20*

*LizardTech, Inc. v. Earth Res. Mapping, Inc.*  
424 F.3d 1336 (Fed. Cir. 2005) .....18

*MicroSurgical Tech., Inc. v. The Regents of the University of Colorado*  
PGR2021-00026, Paper 12 (June 16, 2021).....16

*Nvidia Corporation v. Neural AI, LLC*  
IPR2025-00606, Paper 18 (July 31, 2025).....8

*Peloton Interactive, Inc. v. Flywheel Sports, Inc.*  
2019 WL 3826051 (E.D. Tex. Aug. 14, 2019).....9

*Phison Elecs. Corp. v. Vervain LLC*  
IPR2025-00212, Paper 10 (May 28, 2025) .....15

*Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*  
2024 WL 1149223 (E.D. Tex. Mar. 15, 2024).....9

*Samsung Elecs. Co. v. SiOnyx, LLC*  
IPR2025-00065, Paper 16 (June 6, 2025) .....14

*Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*  
IPR2025-00354, Paper 11 (June 12, 2025) .....12

*Yamaha Golf Car Co. v. Club Car, LLC*  
IPR2017-02142, Paper 63 (Apr. 2, 2019) .....18

**Other Authorities**

35 U.S.C. § 100(i) .....16

Leahy-Smith America Invents Act

Pub. L. No. 112–29, 125 Stat. 284 (2011) §§ 3(n)(1), 6(f)(2)(A). .....16

**Patent Owners' Exhibit List**

<b>Exhibit No.</b>	<b>Description</b>
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 <a href="https://public-inspection.federalregister.gov/2025-19580.pdf?utm_campaign=subscriptioncenter&amp;utm_content=&amp;utm_medium=email&amp;utm_name=&amp;utm_source=govdelivery&amp;utm_term=">https://public-inspection.federalregister.gov/2025-19580.pdf?utm_campaign=subscriptioncenter&amp;utm_content=&amp;utm_medium=email&amp;utm_name=&amp;utm_source=govdelivery&amp;utm_term=</a>
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)

<b>Exhibit No.</b>	<b>Description</b>
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 PGR2025-00083
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.

In addition, the '452 Patent is not eligible for PGR. The asserted patent family, including U.S. Patent No. 12,250,452, claims priority through a chain of continuation applications to U.S. Provisional Patent Application Nos. 62/153,154 and 62/156,918, filed October 12, 2012, and February 1, 2013. Samsung has not met its burden to establish that the '452 Patent is not entitled to a filing date before March 16, 2013. Its "analysis" consists solely of conclusory assertions that certain claim

limitations purportedly lack support in the provisional applications—an approach that falls well short of the evidentiary showing required. Because the '452 Patent is entitled to a pre-March 16, 2013 effective filing date, it is ineligible for post-grant review, providing another independent and dispositive basis for denial.

## **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.”<sup>1</sup> 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 IPR/PGR proceedings, leaving the three earliest-issued patents—with largely similar claims—uncontested at the PTAB and proceeding toward trial in district court.<sup>2</sup> 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

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<sup>1</sup> 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”).

<sup>2</sup> The parallel IPR proceedings are: IPR2025-01519, IPR2025-01520, IPR2025-01521, and IPR2025-01522. 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.

presented here in connection with the unchallenged patents, risking inconsistent outcomes and duplicative consumption of party and judicial resources.

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.

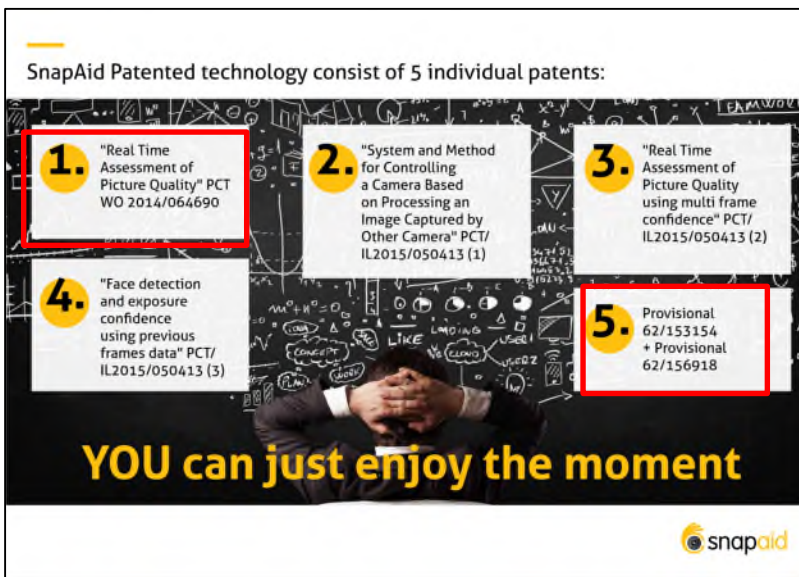
In October 2012 and February 2013, SnapAid's founder and CEO, Ishay Sivan, filed two U.S. provisional patents applications, which have since developed into one patent family containing the eight Asserted Patents. All Asserted Patents share a common specification and inventor, Ishay Sivan. While distinct, the claims have similar scope. As an example of those similarities, Claim 1 of the challenged

'452 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.

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 in red):

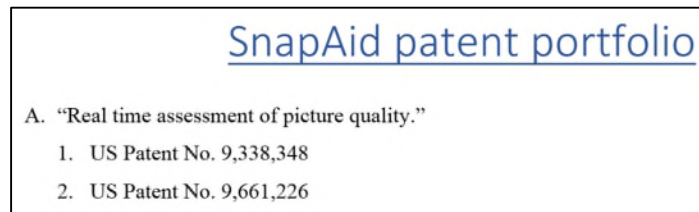


Ex. 2014 at 20.

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 Figures 1 and 3, which are also found in all the Asserted Patents and challenged patents. *Id.*; *see also*, '452 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, the claim scope of the unchallenged '226 Patent (expressly identified to Samsung as shown in Ex. 2019) and the challenged '452 Patent are very similar.<sup>3</sup>

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 '452 Patent. Moreover, while Samsung selectively avoided

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<sup>3</sup> The full scope of Samsung's knowledge and potential investigation into the Asserted Patents is unknown to SnapAid at this time.

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

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). Additionally, 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. *Nvidia Corporation 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 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); *Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, 2024 WL 1149223, at \*5–6 (E.D. Tex. Mar. 15, 2024). 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 PGR challenges only the validity of the '452 Patent, with a final written decision expected in March 2027—one month before trial, after expert discovery, dispositive motions, and the pretrial order are complete. By then, the case will be trial-ready.

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. 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 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 instant validity challenges of the '452 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. Stratasys, 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.”).

**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 PGR 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 PGR is instituted, it would not pursue the same prior-art-based invalidity grounds in the district court. 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. 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 '452 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 PGR against the '452 patent. Ex. 2026 at 29. 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).

Win or lose in this PGR, 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. Accordingly, the stipulation does not eliminate the substantial overlap in prior-art-based validity issues between the two forums.

**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.**

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 nine different prior-art based grounds against the twelve claims of the '452 Patent. While Ground I.A relies on a three-reference combination of “Anon, Takeuchi, and Garcia-Molina,” five grounds (Grounds I.B, I.C., I.E, I.G, and I.I) involve a four-reference combination, one ground (I.F) relies on a six-reference combination, and one ground (I.G) relies on a *seven-reference* combination. To explain these combinations, Samsung submitted a sixty-six-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., ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed.

Cir. 2012) (holding “conclusory” statements combining six prior art references as “not sufficient [to prove obviousness] and...fraught with hindsight bias.”).

#### **V. The '452 Patent is Not Eligible for PGR Review.**

A patent is eligible for post-grant review only if it issued from an application that, at some point, contained at least one claim with an effective filing date of March 16, 2013, or later. Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) §§ 3(n)(1), 6(f)(2)(A). The “effective filing date” for a claim is either the actual filing date of the application or the filing date of the earliest application that supports the claim. 35 U.S.C. § 100(i). Here, all twelve claims of the '452 Patent claim priority to provisional applications filed before March 16, 2013.

It is Samsung's burden to establish that the '452 Patent is eligible for post-grant review. *Ecto World, LLC et al. v. RAI Strategic Holdings, Inc.*, PGR2024-00049, Paper 10 at 15 (Mar. 10, 2025). To meet that burden, Samsung must prove that at least one challenged claim is not entitled to the benefit of the earliest priority date that supports it. *Id.* In particular, Samsung must show that at least one challenged claim “was not disclosed in compliance with the written description and enablement requirements of § 112(a) in the earlier application for which the benefit of an earlier filing date prior to March 16, 2013 was sought.” *Inguran, LLC v. Premium Genetics (UK) Ltd.*, PGR2015-00017, Paper 8 at 11 (Dec. 22, 2015); *see also MicroSurgical Tech., Inc. v. The Regents of the University of Colorado,*

PGR2021-00026, Paper 12 at 13–16 (June 16, 2021) (recognizing the “more complex” threshold determination of whether a “transition application” is eligible for post-grant review).

Samsung undertakes no meaningful analysis of the challenged claims. Instead, it merely identifies a claim term or clause and baldly asserts that the limitation is “not disclosed” in the priority documents. For example, its entire discussion of one limitation reads:

[N]either provisional application discloses “selecting based on the total quality indicator at least one appropriate suggestion from a pre-stored table of suggestions,” which is required by all Challenged Claims. See EX1013, EX1014. This claim limitation is new matter not contained in the provisional applications, and the disclosures of the provisional applications fail to reasonably convey to a POSITA the inventors had possession of this claim limitation as of the filing dates of the provisional applications. EX1004, ¶38.

Petition, Paper 3 at 6.

The threshold priority-date issue, remarkably, receives only *a single paragraph* in Samsung's sixty-two-page Petition. The accompanying expert declaration is equally conclusory. *See* Ex. 1004, ¶¶ 35–38. Neither the Petition nor the declaration contains any substantive comparison between the claims and the provisional disclosures, any explanation of why the cited language allegedly fails to support the claim, or any analysis of partial or implicit support. Instead, they offer

only unsupported conclusions. This is plainly insufficient to satisfy Samsung's burden. *See, e.g., Am. Honda Motor Co., Inc. v. Neo Wireless LLC*, IPR2023-00797, Paper 29 at 17–18 (Sep. 3, 2024) (rejecting Petitioner's priority date challenge where “despite ‘written description’ being a question of *fact*, and despite having its own technical expert...at the ready, Petitioner [did] not direct [the Board] to any evidence supporting [its] plain attorney arguments” on why the “[p]rovisional [application] allegedly does not explicitly or *inherently* disclose the subject limitation to the *skilled artisan*.”).

Samsung's assertions are not only conclusory but incorrect. Using the example above, the limitation “selecting based on the total quality indicator at least one appropriate suggestion from a pre-stored table of suggestions” appears in independent claim 1. While those exact words are not in the provisional applications, verbatim disclosure is not required. *Yamaha Golf Car Co. v. Club Car, LLC*, IPR2017-02142, Paper 63 at 11 (Apr. 2, 2019). Moreover, the section entitled “Using the total quality indicator” expressly states that “the user may ***choose to get suggestions from the application*** on how to improve the next shot.” Ex. 1013 at 7 (emphasis added). The focus of the written description inquiry is not whether the provisional uses the precise phrase or exact form of storage for suggestions, but whether it reasonably conveys to a POSITA that the inventors possessed the broader concept of selecting a suggestion based on the total quality indicator. *See*

*LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (“it is unnecessary to spell out every detail of the invention in the specification.”). Here, the concept is plainly disclosed. A proper analysis would have at least considered the disclosure of suggestions, and Samsung’s expert could—and should—have evaluated that disclosure from the perspective of a person of ordinary skill in the art. *Initiative for Medicines, Access & Knowledge (I-Mak), Inc. v. Gilead Pharmasset LLC*, IPR2018-00121, Paper 10 at 11 (May 21, 2018) (finding that petitioner “fail[ed] to sufficiently demonstrate that the [challenged] patent is not entitled to the priority benefit of the” provisional application where petitioner and its expert failed to “identify factual support for” their position and failed “to address portions of the...provisional contrary to [their] position.”). Samsung simply ignored it.

Similarly, the only other claim language discussed in the Petition is “calculating an aesthetic quality indicator QI2 that uses a background blurring test of said face or object.” Yet the provisional applications describe numerous quality indicators relating to face detection, focus, aperture, depth-of-field, exposure, horizon identification, and “methods to evaluate image blur or evaluate image details,” and state that “there are many qualities indicators, depending on device capabilities and implementation.” Ex. 2005 at 1–2. None of this is addressed in any detail by Samsung. Nor does Samsung consider whether a POSITA would

understand “aesthetic quality indicator” broadly enough to encompass these features.

A proper threshold analysis would have compared the claim language to the actual provisional disclosures and explained why those disclosures allegedly fail to provide written description support. Samsung does none of this. It relies instead on conclusory, undifferentiated statements and high-level references to expert testimony, without providing the underlying analysis or facts. There is no detailed comparison, no engagement with the possibility of partial or implicit support, and no recognition of the established legal principle that verbatim disclosure is unnecessary. Samsung's superficial treatment of this threshold issue stands in sharp contrast to other cases in which the Board has denied institution for failure to meet the eligibility burden. *See Huawei Techs. Co., Ltd. v. Samsung Elecs. Co., Ltd.*, IPR2017-01980, Paper 9 at 10 (Feb. 27, 2018) (according challenged claims the filing date of provisional where petitioner failed to “satisf[y] its initial production burden”); *I-Mak*, Paper 10 at 11; *Am. Honda Motor Co.*, Paper 29 at 17.

Because Samsung has failed to carry its initial burden to show that the '452 Patent is eligible for post-grant review, discretionary denial is warranted.

## **VI. Conclusion**

Because the '452 Patent is not eligible for post-grant review, and the proceeding would offer no efficiency while risking duplicative and inconsistent results in light of long-settled expectations, the Director should exercise discretion

and deny institution.

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.