

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EYESMATCH LTD.,
Patent Owner

Case No. IPR2024-00810
U.S. Patent No. 8,982,110

**PATENT OWNER EYESMATCH LTD.'S PRELIMINARY RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,982,110**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	BACKGROUND.....	1
A.	THE 110 PATENT.....	1
B.	OVERVIEW OF THE REFERENCES	4
1.	Haan	4
2.	Francois.....	5
3.	Rosenberg	6
4.	Park	7
5.	Geisner.....	8
6.	Lizee	9
III.	PERSON HAVING ORDINARY SKILL IN THE ART (“POSITA”)	10
IV.	CLAIM CONSTRUCTION	10
V.	THE PETITION FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD OF PREVAILING IN ITS CHALLENGES TO ANY CLAIMS.....	11
A.	Ground 1: Petitioners Fail to Show a Motivation to Combine Haan and Francois as to Limitation 1(f).....	11
B.	Ground 1: Petitioners Have Failed to Show Obviousness of Claims 1-6, 10-12, and 16-17 in View of Haan and Francois.....	13
C.	Ground 2: Petitioners Fail to Show a Motivation to Combine Rosenberg and Park as to Limitation 1(f)	14
D.	Ground 2: Petitioners Fail to Show Obviousness of Claims 1-6 and 10-12 in View of Rosenberg and Park	17
E.	Ground 3: Petitioners Fail to Show a Motivation to Combine Geisner and Lizee.....	18

F. Ground 3: Petitioners Fail to Show Obviousness of Claims 1-18 in View of Geisner and Lizee..... 21

G. Ground 4: Petitioners Fail to Show a Motivation to Combine Haan, Francois, and Geisner 23

H. Ground 4: Petitioners Fail to Show Obviousness of Claims 7-9, 13-15 and 18 in View of Haan, Francois, and Geisner 24

I. Ground 5: Petitioners Fail to Show a Motivation to Combine Rosenberg, Park, and Geisner 25

J. Ground 5: Petitioners Fail to Show Obviousness of Claims 3-4, 7-9, and 11-18 in View of Rosenberg, Park, and Geisner 26

VI. The Board Should Exercise its Discretion To Deny the Petition under § 314(A) 27

A. The *Fintiv* factors collectively weigh in Favor of discretionary denial..... 27

1. Factor One Favors Denial 29

2. Factor Two Favors Denial 30

3. Factor Three Favors Denial 31

4. Factor Four Favors Denial 32

5. Factor Five Favors Denial 33

6. Factor Six Favors Denial 34

VII. CONCLUSION 34

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Fintiv</i> , IPR2020-00019, Paper 15 (P.T.A.B. May 13, 2020).....	28, 30, 33
<i>BOE Tech. Grp. Co. v. Element Capital Commercial Co. PTE Ltd.</i> , IPR2023-00808, Paper 9 (P.T.A.B. Nov. 15, 2023)	31
<i>Chevron Oronite Co. LLC v. InfineumUSA L.P.</i> , IPR2018-00923, Paper 9 (P.T.A.B. Nov. 7, 2018)	34
<i>Commscope Techs. LLC v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 24 (P.T.A.B. Mar. 17, 2023)	29, 32
<i>Deeper, UAB v. Vexilar, Inc.</i> , IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019).....	34
<i>Duplo U.S.A. Corp. v. MGI Digital Tech. S.A.</i> , IPR2023-00936, Paper 8 (P.T.A.B. Dec. 5, 2023).....	31
<i>Hulu LLC v. SITO Mobile R&D IP, LLC</i> , IPR2021-00298, Paper 11 (P.T.A.B. May 19, 2021).....	29
<i>IBM Corp. v. Digital Doors, Inc.</i> , IPR2023-00967, Paper 7 (P.T.A.B. Dec. 1, 2023).....	31, 33
<i>Johns Manville Corp. v. Knauf Insulation, Inc.</i> , IPR2018-00827, Paper 9 (P.T.A.B. Oct. 16, 2018)	11, 15, 19
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018)	28
<i>Samsung Elecs. Co., Ltd. v. Cal. Inst. of Tech.</i> , IPR2023-00130, Paper 10 (P.T.A.B. May 4, 2023).....	31
<i>Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd.</i> , Case No. 2:17-cv-00671-JRG, 2018 U.S. Dist. LEXIS 120999 (E.D. Tex. July 19, 2018)	30
<i>William Wesley Carnes, Sr., Inc. v. Seaboard Int'l Inc.</i> , IPR2019-00133, Paper 10 (P.T.A.B. May 8, 2019).....	12, 15, 19

Zhuhai Cosmx Battery Co. Ltd. v. Ningde Ampere Technology Ltd.,
IPR2023-00585, Paper 12 (P.T.A.B. Oct. 24, 2023) 33

Other Authorities

Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022)..... 28

List of Patent Owner's Exhibits

Ex. No.	Description
2001	Declaration of Matthew D. Powers in Support of Patent Owner's Unopposed Motion for <i>Pro Hac Vice</i> Admission
2002	Declaration of William P. Nelson in Support of Patent Owner's Unopposed Motion for <i>Pro Hac Vice</i> Admission
2003	Declaration of Natasha M. Saputo in Support of Patent Owner's Unopposed Motion for <i>Pro Hac Vice</i> Admission
2004	Docket Navigator, E.D. Texas Time to Trial (Jan. 1, 2019-Aug. 13, 2024)
2005	Defendants' Invalidity Contentions and P.R. 3-3 and 3-4 Disclosures, and Exhibits A-00 through B-29; E.D. Texas Case No. 2:23-cv-00363-JRG-RSP
2006	Defendants' Unopposed Motion for Leave to Supplement Invalidity Contentions to Add Three Related Prior Art References, [Proposed] Order, and Exhibits 1-7; E.D. Texas Case No. 2:23-cv-00363-JRG-RSP
2007	Order Granting Motion for Leave to Supplement Invalidity Contentions to Add Three Related Prior Art References; E.D. Texas Case No. 2:23-cv-00363-JRG-RSP

I. INTRODUCTION

The Petition should be denied because Petitioners fail to demonstrate a reasonable likelihood of prevailing as to any of the challenged claims.

All the challenged claims, directly or via claim dependency, require limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1. Petitioners have not asserted that any single reference anticipates any claim of the 110 Patent. Rather, Petitioners rely on combinations of references to meet limitation 1(f) of Claim 1 but fail to show motivation to combine. Therefore, at least because a person of ordinary skill in the art would not be motivated to combine Petitioners’ asserted references for this limitation, institution should be denied.

II. BACKGROUND

A. THE 110 PATENT

On March 17, 2015, the United States Patent and Trademark Office duly and legally issued U.S. Patent No. 8,982,110 (the “110 Patent”), entitled “Method for Image Transformation, Augmented Reality, and Telepresence,” to Ofer Saban and Nissi Vilcovsky. EyesMatch is the owner of the right, title, and interest in and to the 110 Patent, with the exclusive right to enforce the 110 Patent.

The field of endeavor of U.S. Patent No. 8,982,110 (the “110 Patent”) is imaging and display systems, including digital mirror systems that emulate traditional mirrors and “situations where a natural appearance is preferable over standard video image, such as in, e.g., video conferencing.” (*See, e.g.*, Ex. 1001 (110 Patent) at 1:43-51.) As the 110 Patent explains, a conventional mirror “is the common and most reliable tool” to evaluate one’s appearance [Ex. 1001 (110 Patent) at 1:55-57] and while other techniques have emerged, they “are not convincing and are not yet accepted as a reliable image of the individual as if he was looking at himself in a conventional mirror. This is mainly because the image generated by a camera is very different from an image generated by a mirror.” [*Id.* at 1:59-64]. The 110 Patent is directed to methods of modifying a stream of images of a user with adaptive transformation mapping so that the images appear to be captured from a different point of view than that of the camera’s actual point of view, including by, for example, rotating, resizing, or varying image magnitude, additionally applying virtual effects to the user’s image including generating different backgrounds, and transmitting the images across a network for display. (*See* Ex. 1001 (110 Patent) at Claims 1, 5, 6, 10, 11, 12, 16, and 17.) The 110 Patent claims and teaches, *inter alia*, an unconventional way to use cameras, computers, and display devices to modify a stream of images of a user such that the displayed images appear to be captured from a different point of view than that of the camera taking the images. As the 110 Patent

explains, this transformation technique “can be used to create a reliable video conference when the user/users on the other side of the line can see the participant as if the participant were looking directly at them, rather than having an image from the view-point of the camera. Alternately, transformation can be used to create an image as if a user were looking into the eyes of another user in order to provide a convincing, live experience.” [Ex. 1001 (110 Patent) at 7:35-41].

The 110 Patent includes 18 claims, one of which is an independent claim. [Ex. 1001 (110 Patent)]. Petitioners challenge all 18 claims as unpatentable. Specifically, Ground 1 of the Petition asserts obviousness of claims 1-6, 10-12, and 16-17. Ground 2 of the Petition asserts obviousness of claims 1-6 and 10-12. Ground 3 of the Petition asserts obviousness of claims 1-18. Ground 4 of the Petition asserts obviousness of claims 7-9, 13-15, and 18. And Ground 5 of the Petition asserts obviousness of claims 3-4, 7-9, and 11-18. All the challenged claims require a novel combination of elements.

Independent Claim 1 claims a computerized method for operating a display system having a camera, a monitor, and a processor with steps comprising: (i) operating the camera to generate a stream of images of the user; (ii) operating the processor to detect the presence of the user in the stream of images; (iii) operating the processor to apply adaptive transformation mapping to the stream of images captured by the camera to generate modified images that appear to be captured from

a different point of view of the camera's actual point of view; and, (iv) displaying the modified images on the monitor; (v) wherein the different point of view corresponds to an image taken from a different angle and a different distance than the actual images captured by the camera; and (vi) wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera. Claims 5-6, 10-11, 12, and 16-18 are all dependent directly or indirectly from Claim 1.

B. OVERVIEW OF THE REFERENCES

1. Haan

Haan is directed to a “mirror device” that determines the position of a body part and based on this position, the viewpoint from which the displayed image is recorded is changed. [Ex. 1005, Abstract]. Haan’s preferred embodiment is a reflective physical mirror with semi-transparent surface that can switch between both states. [Ex. 1005, ¶ 0029].

Haan discloses both a single and a multiple camera embodiment. In the single camera embodiment the camera is physically moved to change the point of view. [Ex. 1005, ¶ 0026]. The multiple camera embodiment synthesizes the images obtained from the several cameras to “construct a virtual camera position and/or magnification” [Ex. 1005, ¶ 0058]. “The position of the virtual viewpoint is

dependent on the determined face orientation”. [Ex. 1005, ¶ 0058]. Haan does not disclose the mapping transformation of the captured image as required by claims of the 110 Patent. Although Haan discloses overlaying derived images – “a composite of the recorded image with some artificial compounds” [Ex. 1005, ¶ 0118] – on the user’s image to simulate application of makeup or alternative hairstyles or clothing [Ex. 1005, ¶¶ 0110-0117], these modifications are performed on the image that is generated by physical movement of the camera or a stitching together of images from multiple cameras.

Further, Haan does not disclose use of the device in connection with transmitting images over a network or enabling telepresence of the user as required by certain claims of the 110 Patent. Nor does Haan disclose generating or replacing background segmentation as required by certain claims of the 110 Patent.

2. Francois

Francois is a paper discussing the development and application in demonstration projects of Software Architecture for Immersipresence (“SAI”). [Ex. 1009, §§ 1.2-1.3].

One of the demonstration projects disclosed in Francois is a virtual handheld mirror simulation comprised of an “LCD screen manipulated by the user, a single camera fixed on the screen, and a tracking device.” [Ex. 1009, § 4.3]. The image displayed on the screen is described as a “close approximation of what the user

would see on the screen surface if it were a real mirror.” [Ex. 1009, § 4.3, Figure 12]. While Francois discloses an “image transform” that is “simple,” it does not disclose what that transformation is. [Ex. 1009, § 4.3]. Specifically, Francois does not disclose modifying the image such that it appears to be captured from a different point of view than the camera’s actual point of view as required by claims of the 110 Patent. The mirror simulation detects the user’s face based on the magnetic trackers. [Ex. 1009, § 4.3]. This is not a disclosure of detecting the user in the captured image as required by claims of the 110 Patent.

Petitioners combine several different demonstration projects to meet the limitations of the challenged claims of the 110 Patent. However, Petitioners identify no basis for how or why a person of ordinary skill in the art would combine these different demonstration projects discussed in Francois. In any event, in none of these demonstration projects does Francois disclose utilizing the angle of the images and modifying the image to change the apparent perspective or point of view as required by claims of the 110 Patent.

3. Rosenberg

Rosenberg discloses a “digital mirror system” which “emulates a traditional mirror by displaying real-time video imagery of a user who stands before it. [Ex. 1006 at Abstract]. Rosenberg’s mirror system is also “adapted to provide real-time captured images that approximate what a user would see when viewing an ordinary

mirror, with the addition of various other image processing features.” [Ex. 1006, ¶¶ 0006, 0050, 0075, 0077. *See also, id.*, ¶ 0028]. However, Rosenberg does not disclose modifying the image such that it appears to be captured from a different point of view than the camera’s actual point of view as required by claims of the 110 Patent because all the disclosed perspective manipulations in Rosenberg are performed based on physical manipulation of the camera but the resulting image of Rosenberg is still an image from the actual point of view of the camera..

Additionally, Rosenberg does not disclose modifying the user’s image or representation to change the apparent perspective or point of view as required by claims of the 110 Patent. Rosenberg’s transformation of images is limited to simply inverting the image. [Ex. 1006, ¶ 0026]. Nor does Rosenberg disclose the generation of an avatar or representation of the user as required by certain claims of the 110 Patent. And, Rosenberg also does not disclose the use of virtual objects on the user’s image generating or replacing background segmentation as required by claims of the 110 Patent.

4. Park

Park is directed to an image capturing apparatus and image capturing method to compensate for 3D distortion which occurs when the user’s image is captured while looking down towards a camera, such as a phone camera, based on the determined tilt of the device capturing the image. [Ex. 1011, ¶¶ 0009, 0010].

Park discloses a “tilt sensing unit 120 [that] can sense the tilt of the device in which the image capturing unit 110 is installed against a specified reference plane by using a device that can sense the tilt against the specified reference plane, such as, by way of a non-limiting example, a tilt sensor and an accelerometer.” [Ex. 1011, ¶ 0041]. Park’s “perspective transform refers to typical matrix-based image transform algorithm” [Ex. 1011, ¶ 0060] based on a provided algorithm in which the “transform matrix coefficients of Equation (1), are adjusted on the basis of the ground reference tilt of the image capturing unit 110” [Ex. 1011, ¶ 0061]. However, Park does not disclose modifying the user’s image or representation to change the apparent perspective or point of view as required by claims of the 110 Patent.

5. Geisner

Geisner is directed to a shopping application of a virtual system with display interface on which a representation of a user is displayed, the user’s motions are tracked, and an interface is provided allowing the user to interact with virtual articles. [Ex. 1007, Abstract, ¶¶ 003, 0024]. However, Geisner does not disclose modifying images to appear to have been captured from a different point of view than the camera’s actual point of view, nor utilizing the angles of the captured images and modifying the user’s image or representation to change the apparent perspective or point of view as required by claims of the 110 Patent.

6. Lizze

Lizze is directed to a virtual presence system. [Ex. 1008, Abstract]. Lizze discloses an image capture device to capture a user's image "from which a virtual representation of the user may be generated and displayed" "by applying a mirrored silhouette transformation to the user image" [Ex. 1008, Abstract, ¶¶ 0012, 0014]. Both the orientation of the user and directions of the user in the real world "are substantially the same in the virtual environment". [Ex. 1008, ¶ 0035]. Unlike claims of the 110 Patent, Lizze is not directed to displaying a user's image in the real world. Lizze does not disclose modifying images to appear to have been captured from a different point of view than the camera's actual point of view, nor utilizing the angle of the captured images and modifying the user's image or representation to change the apparent perspective or point of view as required by claims of the 110 Patent.

Lizze discloses that "the user silhouette could be replaced by a graphical representation of a character in the virtual environment" and that "additional objects and clothing may be added to the user representation". [Ex. 1008, ¶ 0074]. Lizze further discloses the possibility of using "various visual enhancements" on the processed image including "image transparency, accessories, distortions, character overlays, add-ons". [Ex. 1008, ¶ 0088]. However, unlike claims of the 110 Patent regarding generation of an avatar, the graphical representation of the character in

Lizee is not a representation of the user and is not based on the user's image at all. Rather, the user's image/silhouette is only used to animate such a character. [Ex. 1008, ¶ 0076]. Additionally, Lizee does not disclose generating or replacing background segmentation as required by certain claims of the 110 Patent.

III. PERSON HAVING ORDINARY SKILL IN THE ART (“POSITA”)

Petitioners propose a POSITA as of “December 18, 2012, would have a bachelor's degree in electrical or computer engineering, or a closely related field such as computer science, and two years of work experience with image capture and processing systems or related fields. A person with less and/or different education, but more relevant practical experience, or vice versa, may also meet this standard.” [Pet. at 8]. Patent Owner applies Petitioners' proposed level of skill for purposes of this Preliminary Response and reserves the right to propose a different level of skill should the Board grant institution.

IV. CLAIM CONSTRUCTION

Claim construction briefing of certain terms proposed by both Samsung and Patent Owners in the pending district court litigation is ongoing. In the Petition, Petitioners do not identify any claims requiring construction. Patent Owner does not believe that resolution of any claim construction issue is necessary at this time to conclude that Petitioners have not shown that there is a reasonable likelihood that they would prevail with respect to at least one of the challenged claims. 35 U.S.C. §

314(a). Patent Owner reserves the right to raise claim construction should the Board grant institution.

**V. THE PETITION FAILS TO DEMONSTRATE A REASONABLE
LIKELIHOOD OF PREVAILING IN ITS CHALLENGES TO ANY
CLAIMS**

**A. Ground 1: Petitioners Fail to Show a Motivation to Combine
Haan and Francois as to Limitation 1(f)**

Petitioners have failed to demonstrate why a POSITA would be motivated to combine Haan and Francois to meet the limitations of the challenged claims, including limitation 1(f): “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera”. All the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Petitioners contend that because “Haan discloses a mirror device” [Ex. 1003 (Karam Decl.), ¶ 139; Pet. at 23] and “Francois describes a handheld virtual mirror” [Ex. 1003 (Karam Decl.), ¶ 140; Pet. at 23] the references are in the same field of endeavor as each other and the 110 Patent [Pet. at 22; Ex. 1003, (Karam Decl.), ¶ 138]. But that alone is not sufficient for motivation to combine. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10 (P.T.A.B. Oct. 16, 2018) (denying institution and holding “Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to

establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.”); *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10 at 18 (P.T.A.B. May 8, 2019) (denying institution and holding that a “statement of similarity, however, does not constitute an articulated reasoning with rational underpinning as to why a POSITA would combine elements of one reference with another, and why a POSITA would modify the teachings of the references to arrive at the claimed invention.”). Petitioners also assert that “an exemplary implementation in Francois is a virtual mirror similar to the one described in Haan.” [Ex. 1003 (Karam Decl.), ¶ 146]. However, there is no disclosure in Francois concerning techniques to change the apparent perspective of the image captured by the camera or any suggestion that such a change would be desirable. While both references generally concern “mirrors,” their technical disclosures are distinctly different. In Haan, for example, perspective modifications are performed by physical movement of the camera or a stitching together of images from multiple cameras, but the resulting image is still an image from the point of view of the camera. Francois features a stationary camera. The mirror disclosed in Francois offers nothing to the techniques disclosed in Haan to change the apparent perspective of the image captured by the camera involving physical manipulation of the camera or stitching multiple images together (neither of which meet limitation 1(f)), and Petitioner does not describe why a POSITA

would be motivated to abandon the technical approach of Haan in favor of Francois. Therefore, there would be no motivation based on the subject matter of limitation 1(f) for a POSITA to look to combine these references.

Petitioners assert that a POSITA would have looked to combine Haan with Francois to offer additional enhanced user experiences based on the “network communication module (IMSC Communicator)”. [Ex. 1003 (Karam Decl.), ¶ 142; Pet. at 24-26]. Notably, this proffered motivation to combine has nothing to do with the mirror disclosure in Francois and also is wholly irrelevant to motivation to combine to with respect to limitation 1(f) which is a required limitation, directly or through claim dependency, for all the claims in the 110 Patent.

B. Ground 1: Petitioners Have Failed to Show Obviousness of Claims 1-6, 10-12, and 16-17 in View of Haan and Francois

Even assuming that there was motivation to combine Haan and Francois, which there is not, this combination would not render obvious any of Claims 1-6, 10-12, and 16-17 at least because the combination would still fail to meet limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1, and all the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Neither Haan nor Francois discloses limitation 1(f). Haan discloses either physical movement of a single camera or a synthesis of the images from multiple cameras to change perspective. [Ex. 1005, ¶¶ 0026, 0058]. The 110 Patent is directed to changing a captured image digitally to change the apparent perspective without moving the camera or stitching multiple images together. [Ex. 1001 (110 Patent) at 2:15-24]. Francois does not attempt to change the apparent perspective at all. Indeed, the image displayed on the screen is a mirror image from the user's viewpoint. [Ex. 1009, § 4.3, Figure 12]. Consequently, neither Haan nor Francois alone or in combination meet limitation 1(f).

C. Ground 2: Petitioners Fail to Show a Motivation to Combine Rosenberg and Park as to Limitation 1(f)

Petitioners have failed to demonstrate why a POSITA would be motivated to combine Rosenberg and Park to meet the limitations of the challenged claims, including limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1. All the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Petitioners contend that Rosenberg and Park are in the same field of endeavor as each other and the 110 Patent. [Pet. at 52]. But they are not. Rosenberg is directed to a “digital mirror system” that “emulates a traditional mirror”. [Ex. 1006

at Abstract]. Conversely, Park is directed to an “image capturing apparatus” with a “compensation unit compensating the captured image in accordance with the determined tilt” [Ex. 1011 at Abstract]. Park does not discuss mirrors at all, let alone emulating a traditional mirror, and a POSITA would not understand an “image capturing apparatus” to be in the same field of endeavor as a “digital mirror system”. Even assuming, that Rosenberg and Park are in the same field of endeavor, that alone is not sufficient for motivation to combine. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10 (P.T.A.B. Oct. 16, 2018) (denying institution and holding “Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.”); *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10 at 18 (P.T.A.B. May 8, 2019) (denying institution and holding that a “statement of similarity, however, does not constitute an articulated reasoning with rational underpinning as to why a POSITA would combine elements of one reference with another, and why a POSITA would modify the teachings of the references to arrive at the claimed invention.”).

Petitioners claim that “Park concerns transforming images”. [Pet. at 54]. However, Park is not directed toward changing the apparent perspective of the image

captured by the camera. Rather, Park is directed toward the particular issue of user gaze due to the tilt of a mobile phone. [Ex. 1011, ¶¶ 0006-0007, 0009, Fig. 5].

Petitioners admit that “Rosenberg discloses a hardware-based solution to prevent image distortion”. [Ex. 1003 (Karam Decl.), ¶248; Pet. at 54]. Indeed, Rosenberg is not directed toward digitally changing the apparent perspective of the image captured by the camera. Rosenberg only discloses inversion – flipping a live image from left to right – and zooming, neither of which is disclosed in connection with utilizing the angle of the captured image and changing the apparent perspective. [Ex. 1006, ¶¶ 0006, 0050, 0077]. In fact, A POSITA would regard Rosenberg’s emphasis on a complex physical placement of the camera [*see, e.g.*, Ex. 1006, ¶¶ 0075-0076] as actually teaching away from a digital transformation solution for perspective changes. Petitioners’ assertion that “a POSITA would have been motivated to implement Park’s software-based image compensation solution because it avoids the need for Rosenberg’s optical components and specialized displays” [Ex. 1003 (Karam Decl.), ¶248; Pet. at 54-55] is incorrect. There would be no such motivation to combine because the invention disclosed by the Rosenberg reference *is* the optical components and specialized displays. The entire inventive concept of Rosenberg is the hardware solution. Consequently, Petitioners have failed to demonstrate why a POSITA would have been motivated to combine it with a software solution such as Park.

There especially would not have been motivation to combine Rosenberg's virtual mirror with the software-based image compensation solution of Park with respect to the subject matter for Limitation 1(f) because Park is directed to the distortion of user gaze based on the vertical tilt of a mobile phone camera. [Ex. 1011, ¶¶ 0006-0007, 0009]. This would have very limited applicability to a virtual mirror system where the user may not be directly in front of the camera and transformations are needed to change the apparent angle of the camera relative to the user.

D. Ground 2: Petitioners Fail to Show Obviousness of Claims 1-6 and 10-12 in View of Rosenberg and Park

Even assuming that there was motivation to combine Rosenberg and Park, which there is not, this combination would not render obvious any of Claims 1-6 and 10-12 at least because it would fail to meet Limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1 and all the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Neither Rosenberg nor Park discloses limitation 1(f). Rosenberg discloses complex, physical placement of one or more cameras to achieve a desired perspective. [see, e.g., Ex. 1006, ¶¶ 0075-0076]. The 110 Patent is directed to changing a captured image digitally to change the apparent perspective without having to elaborately and precisely position the camera. [Ex. 1001 (110 Patent) at

2:15-24]. Park’s disclosure of image “compensation” does not change the apparent perspective of the image as required by limitation 1(f), but rather compensates for the tilt of the image capturing device. [*See, e.g.*, Ex. 1011, ¶¶ 0041, 0060, 0061].

Consequently, neither Rosenberg nor Park, alone or in combination, meet limitation 1(f).

E. Ground 3: Petitioners Fail to Show a Motivation to Combine Geisner and Lizee

Petitioners have failed to demonstrate why a POSITA would be motivated to combine Geisner and Lizee to meet the limitations of the challenged claims, including limitation 1(f): “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” limitation of Claim 1. All the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Petitioners contend that the 110 Patent, Geisner, and Lizee are in the same field of endeavor [Ex. 1003 (Karam Decl.), ¶¶ 286-288]. However, to make this assertion, Petitioners change their account of the 110 Patent. Whereas Petitioners previously claimed that the 110 Patent is directed to “interactive virtual mirrors” [Pet. at 9], for this Ground Petitioners claim instead that it is directed focus on “imaging and display systems” in “retail and/or service environments” and “gaming” [Pet. at 73 (citing Ex. 1001 (110 Patent) at 1:43-51)]. This ignores that the foundation of

the disclosed applications of the invention of the 110 Patent is transforming the captured image of the user, such as to provide a virtual mirror system. A captured image of the user, and “a mapping transformation that changes imaging perspective of the images captured by the camera” [Ex. 1001 (110 Patent), limitation 1(f)], is a core requirement. Neither Geisner nor Lizée rely on a user image in this way and thus, there would be no motivation to combine them to meet limitation 1(f).

Petitioners contend that Geisner and Lizée “aim to solve a similar problem: enhancing techniques that create a user representation on a screen, track user movements, and enable user interactions with virtual objects and/or a virtual environment.” [Pet. at 73]. But even if it were true, that alone would not be sufficient to demonstrate motivation to combine. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10 (P.T.A.B. Oct. 16, 2018) (denying institution and holding “Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.”); *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10 at 18 (P.T.A.B. May 8, 2019) (denying institution and holding that a “statement of similarity, however, does not constitute an articulated reasoning with rational underpinning as to why a POSITA would combine elements of one reference with another, and why a POSITA would modify

the teachings of the references to arrive at the claimed invention.”). In fact, Geisner and Lizee disclose opposing ways of depicting a user in a virtual environment such that a POSITA would not be motivated to combine these references at all, let alone with respect to limitation 1(f).

Geisner is directed to creating a model of the user and using a camera to track a user’s movements to interact with virtual articles. [Ex. 1007, ¶ 0024]. The focus of Geisner is on user movement for virtual interaction and control of a virtual experience. [See, e.g., Ex. 1007, ¶¶ 0030-0033, 0037, 0045].

Lizee discloses the capture of a user’s image only for purposes of generating a silhouette that can then be used to control a wholly virtual and derived user representation in an entirely virtual world. [See, e.g., Ex. 1008, Abstract, ¶¶ 0012, 0014, 0039, 0060]. Lizee explicitly teaches away from using the actual image of the user (as in Geisner) in favor of a silhouette, stating that “it would be harder to respect the artistic direction of the virtual environment 22 if an *actual image* was used to overlay the virtual environment graphics”. [Ex. 1008, ¶ 0073]. Lizee further explicitly teaches away from Geisner by asserting that the silhouette model “avoids the complex analysis of the captured image 14 to infer the posture of the user” thereby reducing “computational load” and increasing “system responsiveness.” [Ex. 1008, ¶ 0076]. Petitioners provide no reason why a POSITA would be motivated to combine these divergent approaches.

Geisner does not address the issue of transforming apparent perspective of the user's captured image at all. And Lizée explicitly teaches away from use of the user's actual image with respect to perspective changes. Moreover, Lizée's disclosures with respect to perspective changes are in a 3D virtual world which a POSITA would understand are not possible to reproduce in the same way with a video stream depicting a user in the real world. [*See, .e.g.,* Ex. 1008, ¶¶ 0061, 0083]. Therefore, there would be no motivation based on the subject matter of limitation 1(f) for a POSITA to look to combine these references.

F. Ground 3: Petitioners Fail to Show Obviousness of Claims 1-18 in View of Geisner and Lizée

Even assuming that there was motivation to combine Geisner and Lizée, which there is not, this combination would fail to render obvious any of Claims 1-18 at least because it would fail to meet limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1 and all the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

Neither Geisner nor Lizée discloses limitation 1(f). Geisner does not address the issue of transforming apparent perspective of the user's captured image at all. Lizée does not change perspective of the captured image of the user and instead uses a silhouette to animate the movements of a representation of a user in an entirely

virtual space. [Ex. 1008, ¶¶ 11, 35, 39]. Fundamentally, any perspective changes disclosed in Lizée are done with respect to a virtual representation of a user that is not reflective of the user's actual appearance in a wholly virtual world. This does not meet the requirement of limitation 1(f) concerning utilizing the “the angle of the images captured by the camera” and “changes imaging perspective of the images captured by the camera”. Lizée discloses changes to the imaging perspective of an avatar in a wholly virtual environment and as such does not disclose that those changes alter the apparent perspective of those images. [See, .e.g., Ex. 1008, ¶ 0061]. Indeed, Lizée's disclosures as to perspective change is based on the movement of the silhouette (not the user's image) in furtherance of the virtual experience, e.g., game, and states that “3D positioning and visualization algorithm[s] may be implemented to produce the desired effect, that is to control the actions of the silhouette model”. [Ex. 1008, ¶ 0060]. Moreover, Lizée's disclosures with respect to perspective changes are in a 3D virtual world and are mathematically different than what would be needed to accomplish perspective changes (even digitally) with a live video stream of an actual person. [See, .e.g., Ex. 1008, ¶¶ 0061, 0083]. Consequently, neither Geisner nor Lizée, alone or in combination, meet limitation 1(f).

G. Ground 4: Petitioners Fail to Show a Motivation to Combine Haan, Francois, and Geisner

As discussed above in Section V.A., which is incorporated herein by reference, Petitioners have failed to show motivation to combine Haan and Francois to meet the limitations of the challenged claims, including limitation 1(f) which is a required limitation, directly or through claim dependency, for all the claims in the 110 Patent. Those same deficiencies are found here.

Additionally, Petitioners have failed to demonstrate why a POSITA would be motivated to combine Haan, Francois, and Geisner to meet limitation 1(f). Contrary to Petitioners' conclusory assertion [Pet. at 103], these references are not in the same field of endeavor as each other or the 110 Patent. Geisner is directed to creating a model of the user and using a camera to track a user's movements to interact with virtual articles. [Ex. 1007, ¶ 0024]. The focus of Geisner is on user movement for virtual interaction and control of a virtual experience. [See, e.g., Ex. 1007, ¶¶ 0030-0033, 0037, 0045]. Conversely, Haan and Francois are directed to mirror devices (although they adopt incompatible technical approaches) and depictions of a user in the real world. [See, e.g., Ex. 1005, Abstract; Ex. 1009, § 4.3].

Petitioners have failed to show motivation to combine these references with respect to limitation 1(f) because: (1) the mirror disclosed in Francois offers nothing to the techniques disclosed in Haan to change the apparent perspective of the image captured by the camera, which involve physical manipulation of the camera or

stitching multiple images together (neither of which meet limitation 1(f)); and (2) Geisner does not address the issue of transforming the apparent perspective of the user's captured image at all. Therefore, there would be no motivation based on the subject matter of limitation 1(f) for a POSITA to look to combine these references, and Petitioners have provided none.

H. Ground 4: Petitioners Fail to Show Obviousness of Claims 7-9, 13-15 and 18 in View of Haan, Francois, and Geisner

Even assuming that there was motivation to combine Haan and Francois, which there is not, this combination would not render obvious any of Claim 7-9, 13-15 and 18 at least because it would fail to meet limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1 and all the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

As discussed above in Sections V.B and V.F., which is incorporated herein by reference, Petitioners have failed to show that any of Francois, Haan, or Geisner discloses limitation 1(f). Unlike the digital change of apparent perspective of the captured image disclosed by the 110 Patent, Haan discloses either physical movement of a single camera or a synthesis of the images from multiple cameras to change perspective [Ex. 1005, ¶¶ 0026, 0058]. And neither Francois nor Geisner addresses the issue of transforming apparent perspective of the user's captured

image. Consequently, neither Francois, Haan, or Geisner, alone or in combination, discloses limitation 1(f) which is a required limitation, directly or through claim dependency, for Claims 7-9, 13-15 and 18 the 110 Patent.

I. Ground 5: Petitioners Fail to Show a Motivation to Combine Rosenberg, Park, and Geisner

As discussed above in Section V.C., which is incorporated herein by reference, Petitioners have failed to show motivation to combine Rosenberg and Park to meet the limitations of the challenged claims, including limitation 1(f) which is a required limitation, directly or through claim dependency, for all the claims in the 110 Patent.

Additionally, Petitioners have failed to demonstrate why a POSITA would be motivated to combine Rosenberg, Park, and Geisner to meet limitation 1(f). None of these references “are in the same field of endeavor” as each other or the 110 Patent as Petitioners cursorily assert. [Pet. at 105]. Like the 110 Patent, Rosenberg is directed to a “digital mirror system” that “emulates a traditional mirror”. [Ex. 1006 at Abstract]. Conversely, Park is directed to an “image capturing apparatus” with a “compensation unit compensating the captured image in accordance with the determined tilt”. [Ex. 1011 at Abstract]. And the focus of Geisner is on user movement for virtual interaction and control of a virtual experience. [See, e.g., Ex. 1007, ¶¶ 0030-0033, 0037, 0045].

Petitioners have failed to show motivation to combine these references with respect to limitation 1(f). First, Rosenberg is a hardware based solution to prevent image distortion [Ex. 1003 (Karam Decl.), ¶ 248; Pet. at 54] and is not directed toward digitally changing the apparent perspective of the image captured by the camera. Second, Park is software solution directed to the distortion of user gaze based on the tilt of a mobile phone camera [Ex. 1011, ¶¶ 0006-0007, 0009]. Third, Geisner does not address the issue of transforming the apparent perspective of the user's captured image at all. Therefore, there would be no motivation based on the subject matter of limitation 1(f) for a POSITA to look to combine these references, given their disparate technical approaches and concerns, and Petitioners have provided none.

J. Ground 5: Petitioners Fail to Show Obviousness of Claims 3-4, 7-9, and 11-18 in View of Rosenberg, Park, and Geisner

Even assuming that there was motivation to combine Rosenberg, Park, and Geisner, which there is not, this combination would not render obvious any of Claim 3-4, 7-9, and 11-18 at least because it would fail to meet limitation 1(f) “wherein during mirror tracking mode the processor utilizes the angle of the images captured by the camera and applies parametric input for a mapping transformation that changes imaging perspective of the images captured by the camera” of Claim 1 and all the challenged claims, directly or via claim dependency, require this limitation of Claim 1.

As discussed above in Sections V.D. and V.F., which is incorporated herein by reference, Petitioners have failed to show that any of Rosenberg, Park, or Geisner discloses limitation 1(f). Rosenberg does not disclose transforming the perspective of user's captured image at all beyond simply inverting it. [See, e.g., Ex. 1006, ¶ 0026]. Park's disclosure of image "compensation" only compensates for the vertical position of the image capturing device. [See, e.g., Ex. 1011, ¶¶ 0041, 0060, 0061] And, Geisner does not address the issue of transforming the apparent perspective of the user's captured image. Consequently, neither Rosenberg, Park, or Geisner, alone or in combination, meet limitation 1(f) which is a required limitation, directly or through claim dependency, for Claims 3-4, 7-9, and 11-18 of the 110 Patent.

VI. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION UNDER § 314(A)

Even if Petitioners could meet the standard for institution on the merits, which it cannot, the Board should exercise its discretion to deny institution under 35 U.S.C. ¶ 314(a) and *Fintiv*.

A. The *Fintiv* factors collectively weigh in Favor of discretionary denial.

Under *Fintiv*, the Board evaluates the following non-exclusive factors:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

2. Proximity of the court’s trial date to the Board’s projected statutory deadline for final written decision;
3. Investment in the parallel proceedings by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceedings are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, IPR2020-00019, Paper 15 at 7-8 (P.T.A.B. May 13, 2020) (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018) (precedential)). “In evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 8; see Katherine K. Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022).

Here, discretionary denial is warranted under Section 314(a) and *Fintiv* because: (1) Patent Owner will oppose any motion for a stay; (2) there is every reason to believe that trial in the Eastern District of Texas will occur more than five months before the Board’s projected statutory deadline for any final written decision;

(3) the parties and district court will have substantially invested in claim construction, fact discovery, and expert discovery by the time of the Board’s institution decision; (4) all but one of the prior art references relied on by Petitioners are also being relied upon by the Samsung Petitioners in the district court proceeding; and (5) with the exception of Google, the parties to this proceeding are also parties to the district court proceeding. Thus, the first five factors favor denying institution. Moreover, based on the shortcomings in the Petition identified above, Petitioner has failed to “present[] a compelling unpatentability challenge” under the sixth factor. *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 24 at 50-51 (P.T.A.B. Mar. 17, 2023).

1. Factor One Favors Denial

The first factor is favors denial because although the Samsung Petitioners state in the Petition that they will seek a stay [Pet. at 109], they have not done so in the three months since the Petition was filed. Moreover, EyesMatch will oppose any motion for a stay, and the Board does not speculate on how the district court will rule. *Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 10-11 (P.T.A.B. May 19, 2021). Additionally, Petitioners filed their Petition for IPR just 3 months shy of the last day permitted by statute. This delay of 9 months after service of the complaint is beyond the time that courts have found to be reasonable. *See, e.g., Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd.*,

Case No. 2:17-cv-00671-JRG, 2018 U.S. Dist. LEXIS 120999 at *8 (E.D. Tex. July 19, 2018) (denying motion to stay and finding that IPRs filed by Samsung nine months after service of the complaint and five months after service of infringement contentions weighed against a motion to stay).

2. Factor Two Favors Denial

The second factor strongly favors denial. Trial in the parallel litigation is scheduled to begin on June 6, 2025 – more than five months before the Board’s projected statutory deadline for any final written decision. The Board “generally take[s] courts’ trial schedules at face value absent some strong evidence to the contrary.” *Fintiv*, IPR2020-00019, Paper 15 at 13. To the extent that consideration of median time-to-trial statistics is warranted, they confirm that the parallel litigation will almost certainly reach trial before the Board issues its final written decision. The median time to a jury trial for cases pending before Judge Gilstrap in the Eastern District of Texas is 19 months. [Ex. 2004 (Docket Navigator, E.D. Texas Time to Trial (Jan. 1, 2019-Aug. 13, 2024))]. Applying that statistic here results in a trial date projected for March 2025 – which is 8 months before any Board final written decision would be expected to issue. As a result, regardless of whether the Board “consider[s] the scheduled trial date or the trial date expected based on time-to-trial statistics,” it is clear that the trial in the parallel litigation will almost certainly “commence several months before the expected date” of any Board final written

decision. *Samsung Elecs. Co., Ltd. v. Cal. Inst. of Tech.*, IPR2023-00130, Paper 10 at 16 (P.T.A.B. May 4, 2023); *see IBM Corp. v. Digital Doors, Inc.*, IPR2023-00967, Paper 7 at 9-10 (P.T.A.B. Dec. 1, 2023).

3. Factor Three Favors Denial

There has been a substantial investment by the parties and district court in the parallel proceeding, so the third *Fintiv* factor strongly favors discretionary denial as well. The parties will exchange their initial and supplemental infringement and invalidity contentions prior to any institution decision. Substantial completion of document production will take place more than a month before any institution decision. Claim construction briefing will also finish on November 15, 2024, prior to any institution decision. And the claim construction hearing on December 6, 2024, will take place just one week after any institution decision. This investment by the court and parties is clearly substantial and accordingly strongly favors discretionary denial. *See Duplo U.S.A. Corp. v. MGI Digital Tech. S.A.*, IPR2023-00936, Paper 8 at 18 (P.T.A.B. Dec. 5, 2023) (“We agree with Patent Owner that there has been substantial investment by the parties and the district court in the parallel proceeding, including the completion of preliminary disclosures and claim construction, and the near-completion of discovery.”); *BOE Tech. Grp. Co. v. Element Capital Commercial Co. PTE Ltd.*, IPR2023-00808, Paper 9 at 23-24 (P.T.A.B. Nov. 15, 2023) (finding “significant progress” and that “the parties and the District Court have

invested substantial resources” where, at the time of the institution decision, “[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document requests and interrogatories, and proposed claim terms for construction”; the “date for the close of fact discovery is near”; and “the claim construction phase of the District Court Litigation is now completed”).

4. Factor Four Favors Denial

The fourth *Fintiv* factor favors denial because five of the six references Petitioners are relying on in their Petition are also being relied on by the Samsung Petitioners in the parallel proceedings using the same or similar invalidity theories. *Commscope Techs.*, IPR2022-01242, Paper 24 at 59 (finding that “significant overlap between the issues raised in the petition and in the parallel proceedings” weighs in favor of denial). The 110 Patent has 18 claims. Of those 18 claims, 11 are being challenged as invalid in the parallel proceedings using, *inter alia*, five of the six references Petitioners rely on. Haan and/or combinations with Haan challenge all 18 claims in the Petition and all 11 claims asserted in the parallel proceedings. Francois and/or combinations with Francois challenge all 18 claims in the Petition and all 11 claims asserted in the parallel proceedings. Rosenberg and/or combinations with Rosenberg challenge all 18 claims in the Petition and all 11 claims asserted in the parallel proceedings. Geisner and/or combinations with Geisner challenge all 18 claims in the Petition and all 11 claims asserted in the

parallel proceedings. And Lizee and/or combinations with Lizee challenge all 18 claims in the Petition and 10 of the 11 claims asserted in the parallel proceedings. In short, 5 of the 6 references relied on by Petitioners for obviousness of all 18 claims of the 110 Patent are also relied on by the Samsung Petitioners for obviousness for 11 of those claims in the parallel proceedings. [Exs. 2005-2007 (Samung Invalidity Contentions; June 20, 2024 Samsung's Unopposed Motion for Additional References (Dkt. 39); Order Granting Motion (Dkt. 40)]. Such overlap mandates denying institution. See *Fintiv*, IPR2020-00019, Paper 15 at 15 (“Thus, because the identical claims are challenged based on the same prior art in both the Petition and in the District Court, this factor weighs in favor of discretionary denial in this case.”).

5. Factor Five Favors Denial

A. The fifth *Fintiv* factor strongly favors denial as well. With the exception of Google, the Petitioners are Defendants in the parallel district court proceedings, while Patent Owner is the Plaintiff. That the same parties are involved in both the district court litigation and the IPR—and that trial will almost certainly precede any final written decision—supports discretionary denial. See *IBM Corp.*, IPR2023-00967, Paper 7 at 12; *Zhuhai Cosmx Battery Co. Ltd. v. Ningde Amperex Technology Ltd.*, IPR2023-00585, Paper 12 at 17 (P.T.A.B. Oct. 24, 2023).

6. Factor Six Favors Denial

Finally, Petitioners have not presented compelling evidence of unpatentability. Indeed, the Petition has failed to demonstrate a reasonable likelihood that any of the 110 Patent claims is unpatentable, let alone a compelling unpatentability challenge, at a minimum because the Petition fails to show that any of the prior art in the Grounds renders obvious the 110 Patent claims as discussed above. Even if the Board were to conclude (and it should not) that Petitioners have shown a reasonable likelihood of unpatentability, its case does not come close to establishing so compelling a case that it can overcome the significant reasons to deny institution under *Fintiv*.

VII. CONCLUSION

None of Petitioners' grounds meet the institution standard. But even if the Board determined a claim or ground satisfied the standard, the vast majority of grounds fail, and thus, instituting a trial on all claims and all grounds would not be an efficient use of the Board's resources. *See Chevron Oronite Co. LLC v. InfineumUSA L.P.*, IPR2018-00923, Paper 9 (Denying Inter Partes Review) (P.T.A.B. Nov. 7, 2018); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (Denying Inter Partes Review) (P.T.A.B. Jan. 24, 2019).

Dated: August 29, 2024

Respectfully submitted,

/John C. Pierce/

John C. Pierce
USPTO Reg. No. 79,938
Tensegrity Law Group LLP
1676 International Drive
Suite 910
McLean, VA 22102
Telephone: 865-388-5914
Facsimile: 650-802-6001
Email: john.pierce@tensegritylawgroup.com

Matthew D. Powers, *pro hac vice*
William P. Nelson, *pro hac vice*
Natasha M. Saputo, *pro hac vice*
Tensegrity Law Group LLP
555 Twin Dolphin Drive, Suite 650
Redwood Shores, CA 94065
Telephone: 650-802-6000
Facsimile: 650-802-6001
Email:
matthew.powers@tensegritylawgroup.com
william.nelson@tensegritylawgroup.com
natasha.saputo@tensegritylawgroup.com
eyesmatch_team@tensegritylawgroup.com

Attorneys for Patent Owner
EyesMatch Ltd.

CERTIFICATION OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(b)(1) and (d), the undersigned hereby certifies that the Patent Owner's Preliminary Response complies with the type-volume limitation 37 C.F.R. § 42.24(b)(1) permitting a response of up to 14,000 words because, exclusive of the exempted portions, the response contains 8,242 words, as identified by Microsoft Word's word-counting feature.

Dated: August 29, 2024

Respectfully submitted.

/John C. Pierce/

John C. Pierce
USPTO Reg. No. 79,938
Tensegrity Law Group LLP
1676 International Drive
Suite 910
McLean, VA 22102
Telephone: 865-388-5914
Facsimile: 650-802-6001
Email: john.pierce@tensegritylawgroup.com
eyesmatch_team@tensegritylawgroup.com

*Attorneys for Patent Owner
EyesMatch Ltd.*

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that on August 29, 2024, copies of the foregoing were served via Electronic Mail to the following:

<u>Lead Counsel</u>	<u>Backup Counsel</u>
Eliot D. Williams (Reg. No. 50,822) Baker Botts L.L.P. 700 K Street, N.W. Washington, DC 20001 (202) 639-1334 DLBBSamsungEyesmatch@BakerBotts.com	Neil Sirota, (Reg. No. 38, 306) Margaret M. Welsh (Reg. No. 70,745) Chun Xu (Reg. No. 800,021) Joshua Friedman (Reg. No. 74, 908) Pallavi Mathur (Reg. No. 80,102) Baker Botts L.L.P. 30 Rockefeller Plaza New York, NY 10112 (212) 408-2500 DLBBSamsungEyesmatch@BakerBotts.com Jose Villarreal (Reg. No. 43,969) Baker Botts L.L.P. 401 South 1st Street Austin, TX 78704 (512) 322-2500 DLBBSamsungEyesmatch@BakerBotts.com Erika H. Arner (Reg. No. 57,540) Sydney R. Kestle (Reg. No. 78,725) Angeline L. Premraj (Reg. No. 80,472) Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue, NW Washington, DC 20001 (202) 408-4000 erika.arner@finnegan.com sydney.kestle@finnegan.com angeline.premraj@finnegan.com Xirui Zhang (Reg. No. 78,809)

	Finnegan, Henderson, Farabow, Garrett & Dunner, LLP Two Seaport Lane Boston, MA 02210 (617) 646-1600 xirui.zhang@finnegan.com
--	--

/John C. Pierce/

John C. Pierce
USPTO Reg. No. 79,938
Tensegrity Law Group LLP
1676 International Drive
Suite 910
McLean, VA 22102
Telephone: 865-388-5914
Facsimile: 650-802-6001
Email: john.pierce@tensegritylawgroup.com