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Paper No. 24
Date: January 10, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
GOOGLE LLC,
Petitioner,
v.
EYESMATCH LTD.,
Patent Owner.

IPR2024-00810 (Patent 8,982,110 B2)

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,
v.
EYESMATCH LTD.,
Patent Owner.

IPR2024-00856 (Patent 8,982,109 B2)

Before THOMAS L. GIANNETTI, NEIL T. POWELL, and SCOTT RAEVSKY, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

The Board received an email dated Jaunary 6, 2025, from Patent Owner's counsel, requesting authorization to submit supplemental information relating to the claim construction activities in the District Court Litigation (*EyesMatch Ltd. v. Samsung Electronics Co., Ltd., et al.*, No. 2:23-cv-363 (E.D. Tex.)) concerning the same patents as those before us in these proceedings. Specifically, Patent Owner sought authorization to move to submit as supplemental information: (1) the Declaration of Harley R. Myler, Ph.D. Regarding Claim Construction (Dkt. No. 47-2) filed in the District Court Litigation by Defendants Samsung Electronics Co., et al.; (2) the Claim Construction Hearing Transcript from the District Court Litigation, dated December 6, 2024; and (3) the Claim Construction Order (Dkt. No. 56) issued in the District Court Litigation, on December 11, 2024. The email also sought permission to file this motion more than one month after the institution of trial. *See* 37 C.F.R. § 42.123(b) (setting a one-month period after trial is insituted for submitting supplemental information).

In an email to the Board dated January 8, 2025, Petitioners stated their opposition to Patent Owner's request: "Petitioners oppose because Patent Owner should instead file the identified papers with its upcoming Patent Owner's Response in each IPR." Petitioners also opposed the request for failure of Patent Owner to meet and confer before approaching the Board and on the basis of timeliness.

The Board held a conference with counsel for the parties to discuss this request on January 8, 2025.[1]

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[1] Judges Giannetti, Powell, and Raevsky participated in the conference; Petitioners Google and Samsung were represented by Erika Arner and Eliot

Regarding the District Court's Claim Construction Order, the Board cited the PTAB's Consolidated Trial Practice Guide (Nov. 2019),[2] which states, at page 47: "Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available." After further discussion, the parties agreed that Patent Owner may file the Claim Construction Order promptly, without the need to file a motion. The Board determined that the short delay in filing the request was excusable in light of the recent holidays.

The parties further agreed that the Declaration of Harley R. Myler and the Claim Construction Hearing Transcript may be filed with the Patent Owner Response.

Petitioners retain their right to object to these submissions and to respond to them in their Reply.

It is, therefore,

ORDERED that Patent Owner is authorized to file in these proceedings the Claim Construction Hearing Transcript from the District Court Litigation, dated December 6, 2024;

FURTHER ORDERED that Patent Owner may file (1) the Declaration of Harley R. Myler, Ph.D. Regarding Claim Construction filed in the District Court Litigation by Defendants Samsung Electronics Co., et al.; (2) the Claim Construction Hearing Transcript from the District Court Litigation, dated December 6, 2024, with its Patent Owner Response;

Williams, and Patent Owner was represented by John Pierce and William Nelson.

[2] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

FURTHER ORDERED that Petitioners may respond to these submissions in their Petitioner Reply and retain their right to object to them;

FURTHER ORDERED that no further briefing on this issue is authorized at this time; and

FURTHER ORDERED that the Board's meet and confer requirements will be strictly enforced, and the parties are directed to meet and confer before addressing the Board with any substantive matter.

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