

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

EYESMATCH LTD.,
Patent Owner.

IPR2025-00296
Patent 8,982,110 B2

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

POWELL, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
Granting Motion for Joinder
35 U.S.C. §§ 314, 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. BACKGROUND

Microsoft Corporation (“Petitioner”) filed a Petition for *inter partes* review of claims 1–18 of U.S. Patent No. 8,982,110 B2 (Ex. 1001, “the ’110 patent”). Paper 2 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder. Paper 3 (“Joinder Motion”). In the Joinder Motion, Petitioner seeks to join this proceeding with *Samsung Electronics Co., Ltd. v. EyesMatch Ltd.*, IPR2024-00810 (“the ’810 IPR”), which concerns the ’110 patent at issue here. Joinder Motion 1.

The ’810 IPR was initiated by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC (collectively, “the ’810 IPR petitioners”). We instituted trial in the ’810 IPR on November 26, 2024. ’810 IPR, Paper 20 (“’810 Institution Decision”).

In this proceeding, on January 21, 2025, EyesMatch Ltd. (“Patent Owner”) filed a Notice of Non-Opposition to the Joinder Motion. Paper 10 (“Notice”). Patent Owner did not file a preliminary response to the Petition.

For the reasons described below, we institute an *inter parties* review of all challenged claims and grant Petitioner’s Joinder Motion.

B. RELATED PROCEEDINGS

The parties indicate that the ’110 patent is involved in *EyesMatch Ltd. v. Samsung Electronics America, Inc.*, No. 2:23-cv-00363-JRG-RSP (E.D. Tex.). Pet. 1; Paper 4, 1. Petitioner also notes that the ’110 patent was involved in *EyesMatch Ltd. v. Facebook, Inc.*, No. 1:21-cv-00111-RGA-JLH (D. Del.). Pet. 1. Petitioner further notes that the ’110 patent was challenged in a petition in IPR2022-00490. *Id.* Additionally, Petitioner has challenged claims of related U.S. Patent No. 8,982,109 B2 (“the ’109

patent”) in a pending petition filed in IPR2025-00297, seeking joinder of that proceeding to the instituted trial in IPR2025-00856, which also involves the ’109 patent. Pet. 1; IPR2025-00297, Papers 2, 3.

C. ASSERTED GROUNDS OF UNPATENTABILITY

The Petition in this proceeding asserts the same grounds as those in the ’810 IPR, which are:

Claims Challenged	35 U.S.C. §	References
1–6, 10–12, 16, 17	103	Haan ¹ , Francois ²
1–6, 10–12	103	Rosenberg ³ , Park ⁴
1–18	103	Geisner ⁵ , Lizee ⁶
7–9, 13–15, 18	103	Haan, Francois, Geisner
3, 4, 7–9, 11–18	103	Rosenberg, Park, Geisner

¹ U.S. Patent Application Publication No. 2011/0298910 A1, published Dec. 8, 2011 (Ex. 1005, “Haan”).

² Francois, *Software Architecture for Computer Vision: Beyond Pipes and Filters*, Institute for Robotics and Intelligent Systems, 2003 (Ex. 1009, “Francois”).

³ U.S. Patent Application Publication No. 2007/0040033 A1, published Feb. 22, 2007 (Ex. 1006, “Rosenberg”).

⁴ U.S. Patent Application Publication No. 2007/0065039 A1, published Mar. 22, 2007 (Ex. 1011, “Park”).

⁵ U.S. Patent Application Publication No. 2011/0246329 A1, published Oct. 6, 2011 (Ex. 1007, “Geisner”).

⁶ International Patent Application Publication No. WO 2006/108278 A1, published Oct. 19, 2006 (Ex. 1008, “Lizee”).

II. DECISION

The challenges to the '110 patent's claims in this Petition are identical to the challenges in the '810 IPR's petition. *See, e.g.*, Pet. 6; '810 IPR, Paper 1, 8. Additionally, in this proceeding, Patent Owner has not argued that the Petition's challenges lack sufficient merit to institute trial. *See, e.g.*, Notice 1. For the same reasons we explained in the '810 Institution Decision, we institute *inter partes* review of all challenges in the Petition.

III. JOINDER MOTION

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

To be considered timely, a motion for joinder must be filed no later than one month after the institution date of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Petition in this proceeding has been accorded a filing date of December 20, 2024, which is within one month of the '810 IPR's November 26, 2024 institution date. Paper 6; '810 IPR, Paper 20. Thus, the Petition meets the timing requirement for joinder.

Petitioner contends that joinder with the '810 IPR is appropriate for a number of reasons. Joinder Motion. 4–8. Petition explains that its Petition presents grounds of unpatentability that are identical to the grounds on

which the Board instituted trial in the '810 IPR, relying on the same prior art, the same substantive arguments, and the same expert testimony as the '810 IPR's petition. *Id.* at 5. Petitioner argues that joining this proceeding with the '810 IPR "presents an opportunity to streamline review of the '110 Patent's Challenged Claims," avoiding inefficient duplicative efforts in the '810 IPR and this proceeding. *Id.* at 5–6. Petitioner contends that joining the proceedings will not affect the '810 IPR's schedule or prejudice Patent Owner. *Id.* at 6–8. "[S]o long as Samsung and Google [(the '810 IPR petitioners)] remain active parties," Petitioner agrees to adhere to certain conditions, under which it would participate as a "silent understudy." *Id.* at 7.

In the Notice, Patent Owner explains that "[u]pon due consideration, and without endorsing the merits of any assertions made in the Motion for Joinder, Patent Owner, . . . does not oppose the joinder of this proceeding with *Inter Partes Review* No. IPR2024-00810." Notice 1.

Joinder is a matter within the Board's discretion based on the particular circumstances of each proceeding. In this proceeding, we are persuaded that Petitioner has demonstrated that joinder with the '810 IPR would avoid duplication and promote the efficient resolution of both proceedings.

IV. CONCLUSION

Based on the record before us, we institute an *inter partes* review in IPR2025-00296 and grant Petitioner's Joinder Motion, joining this proceeding with the '810 IPR.

V. ORDER

In consideration of the foregoing, it is:

ORDERED that *inter partes* review of claims 1–18 of the ’110 patent is instituted on all grounds in the Petition;

FURTHER ORDERED that Petitioner’s Joinder Motion is granted, and IPR2025-00296 is joined with IPR2024-00810;

FURTHER ORDERED that the Scheduling Order entered in IPR2024-00810 (Paper 21) is not modified and shall govern the joined proceedings’ schedule;

FURTHER ORDERED that, throughout the joined proceedings, aslong as any of the ’810 IPR petitioners remains a party, Petitioner and the ’810 IPR petitioners will file papers, except for motions that do not involve the other party, as a single, consolidated filing; that the filing party (either Petitioner or the ’810 IPR petitioners) will identify each such filing as a Consolidated Filing, and will conduct coordinated (not separate) discovery;

FURTHER ORDERED that Petitioner shall not be permitted to raise any new grounds not already instituted by the Board in the ’810 IPR;

FURTHER ORDERED that, as long as any of the ’810 IPR petitioners remains a party, Petitioner shall not introduce any argument or discovery not already introduced by the ’810 IPR petitioners;

FURTHER ORDERED that, as long as any of the ’810 IPR petitioners remains a party, Petitioner shall be bound by any agreement between Patent Owner and the ’810 IPR petitioners in the ’810 IPR concerning discovery or depositions;

FURTHER ORDERED that, as long as any of the ’810 IPR petitioners remains a party, Petitioner shall not receive any direct, cross examination, or redirect time beyond that permitted for the ’810 IPR

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petitioners alone, under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the '810 IPR petitioners;

FURTHER ORDERED that IPR2025-00296 is terminated under 37 C.F.R. § 42.72 and all further filings in the joined proceedings are to be made in IPR2024-00810;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2024-00810; and

FURTHER ORDERED that the case caption in IPR2024-00810 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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Example Case Caption for Joined Proceeding

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
GOOGLE LLC, and MICROSOFT CORPORATION
Petitioner,

v.

EYESMATCH LTD.,
Patent Owner.

Case IPR2024-00810¹
Patent 8,982,110 B2

¹ IPR2025-00296 has been joined with this proceeding.