

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
Petitioners,

v.

EYESMATCH LTD.,
Patent Owner.

Case No. IPR2024-00810¹
U.S. Patent No. 8,982,110

PATENT OWNER'S MOTION TO STRIKE

¹ IPR2025-00296 has been joined with this proceeding.

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I. INTRODUCTION

As the Board is aware, Petitioners *never* attempted in their Petition to show how the Asserted Grounds disclose or render obvious the claimed “mirror tracking mode” recited in limitation 1[f] of all claims of the 110 Patent, under the narrow claim construction that Petitioner Samsung obtained in the District Court Litigation.² That construction requires that the user appears at roughly double their distance from the mirror, and roughly the same size, regardless of movement (the “Double Distance, Same Size Requirement”) – a subject on which the Petition and its Grounds are entirely silent. Petitioners’ Reply belatedly seeks to remedy their failure of proof by presenting untimely new theories, argument, and evidence regarding how the Asserted Grounds allegedly disclose or render obvious “mirror tracking mode” under Petitioners’ own claim construction. Petitioners’ new arguments are supported by a Second Declaration from Dr. Karam (Ex.1033) which includes and discusses new prior art references and related opinions not included in her First Declaration, but which were available to her at the time of the Petition (and cited and relied on by her in IPR2024-00856 (the “109 IPR”) also brought by Petitioners in the same month). The Board should strike as untimely and improper: (1)

² *EyesMatch Ltd. v. Samsung Electronics America, Inc., et al.*, No. 23-cv-0363 (E.D. Tex.).

Petitioners’ assertion of two new references: Straka and Francois II as purported “background art”; (2) the entirety of Dr. Karam’s Second Declaration discussing and offering opinions regarding these references; (3) the portions of Dr. Karam’s deposition advancing these new theories and references relied upon by Petitioners; and (4) the following portions of Petitioners’ Reply (Paper 32) (“Reply”) advancing previously undisclosed theories, arguments, and evidence: at page 4, the entirety of the paragraph beginning with “Regardless, and as explained below”; at page 6, the entirety of the paragraph beginning with “The record reveals”, and Sections III.A.1.a-d, III.B.1, III.B.2, and III.C.1.

II. ARGUMENT

A. Petitioners’ Untimely New Arguments on How the Challenged Claims Are Met Should Be Stricken

In their Petition, Petitioners *chose* not to address the construction for “mirror tracking mode” that Petitioner Samsung advocated for (and ultimately obtained) in the District Court Litigation. Ex.2008 at 41. *See also*, Ex.2013, ¶¶25-26; Ex.2009 at 27-28, 13-14; Ex.2010, ¶¶97-100. Petitioners were indisputably aware of this construction *prior* to Institution of this Petition because it was Petitioner Samsung’s own construction. Yet nowhere in the Petition did Petitioners assert, as they do for the first time in their Reply, that “the grounds *expressly* disclose a ‘mirror tracking mode’ under any reasonable construction” (including the Double Distance, Same Size Requirement) (Reply at 4 (emphasis in original)) or that Petitioner Samsung’s

Double Distance, Same Size construction was “*consistent* with the meaning of ‘mirror tracking mode’ as applied in [Dr. Karam’s] First Declaration (EX1003) and the Petition” (*id.* at 6 (emphasis in original)). Throughout their Reply, Petitioners make the entirely new arguments that the Double Distance, Same Size Requirement is either disclosed by, or rendered obvious by, the Asserted Grounds. *See* Reply at Sections III.A.1.a-d (as to Ground 1), III.B.1, III.B.2 (as to Ground 2), and III.C.1 (as to Ground 3). For example, for the first time in their Reply, Petitioners assert that the Grounds disclosed the Double Distance, Same Size Requirement all along, contending that a “POSITA considering Haan would have recognized the intrinsic properties of a mirror and known that when Haan describes emulating a conventional mirror, it is describing the mirror effect well-known to POSITAs, ***including appearing at roughly the same size, double the distance, and left/right inverted.***” Reply at 8-9. Similarly, Petitioners contend for the first time that their newly advanced background art and expert opinion shows that a POSITA would find it obvious to modify the Grounds to add the Double Distance, Same Size Requirement, *e.g.*, contending that “a POSITA would have been motivated to use the techniques for emulating a mirror taught in Rosenberg-Park ***to faithfully replicate the optical properties of a mirror as would be expected based on experiences with traditional mirrors.***” Reply at 17 (citing Dr. Karam’s new declaration discussing new prior art, and new opinions from her deposition). And the Reply repeatedly relies on self-

serving deposition testimony from Dr. Karam inserting new opinions addressing the same topics which are nowhere in her first Declaration. *See* Reply at 6, 9, 13, 17, 19, 20, 22, 23.

Petitioners chose not to advance these arguments prior to Institution, even though they could have, and should not be permitted to evade the consequences of that choice now. The PTAB Trial Practice Guide is clear that “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g., to make out a *prima facie* case of unpatentability.” Consolidated Trial Practice Guide (Nov. 2019) (“TPG 2019”) at 73. Additionally, “a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.” *Id.* at 74.

This is not a case where Petitioners are merely responding to a new claim construction argument raised by the Patent Owner such as in *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 (Fed. Cir. 2023). The holding in *Axonics* concerned instances in which the Patent Owner or the Board has proposed a new construction. *Id.* at 1381. In this case, the construction at issue is Petitioners’ own that it ***chose*** not to address, despite knowing its own position in the district court prior to Institution. Moreover, *Axonics* does not authorize a petitioner to rely on new prior art, such as art supplying the missing purported “background knowledge” of a POSITA, to teach a claim limitation: “We have held that a petitioner may not in reply rely on new prior art to teach a claim limitation.” *Id.* at 1383. Petitioners and their expert never

contended prior to Institution that the background knowledge of a POSITA would supply the knowledge necessary to understand the Asserted Grounds as disclosing the Double Distance, Same Size Requirement, or that it would be obvious based on such background knowledge to modify the references to add the Double Distance, Same Size Requirement. These new arguments are improper and should be stricken. 37 C.F.R. § 42.22(a)(2); 37 C.F.R. § 42.23(b).

B. Petitioners' Reliance on Entirely New Prior Art References and Expert Opinions Should Be Stricken

In support of their untimely new arguments, Petitioners rely on completely new references not included in the Petition or Dr. Karam's First Declaration, to attempt to establish that a POSITA's background knowledge supports Petitioners' obviousness arguments. The entirety of Dr. Karam's Second Declaration is directed to discussing these previously undisclosed references, Exhibits 1035 ("Francois II") and 1037 ("Straka"), and providing opinions to support Petitioners' new arguments. This improper evidence and opinion requires striking not only the new references but also the entirety of Dr. Karam's Second Declaration, the portions of Dr. Karam's deposition testimony discussing these references, and the portions of Petitioners' Reply that rely on them. *See Lenovo Holding Co. Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, IPR2019-01279, Paper No. 25 at 6 (P.T.A.B. Sept. 9, 2020) (granting motion to strike: "an untimely argument and related evidence should be stricken from the brief").

Dr. Karam’s First Declaration did not discuss or include Francois II or Straka, even though Dr. Karam was aware of them as evidenced by her inclusion of them in her declaration in IPR2024-00856 (the “109 Patent IPR”) filed a little over two weeks after her First Declaration in this IPR (the “110 Patent IPR”). Dr. Karam now impermissibly uses Francois II and Straka to advance new opinions regarding the “technology background” a POSITA would have (*see generally* Ex. 1033), which Petitioners rely on to contend for the first time that a POSITA would understand the Grounds to disclose the Double Distance, Same Size Requirement, or would find it obvious to add it. In fact, Dr. Karam already provided what she believed to be her necessary opinions on this topic in her First Declaration, choosing to rely on other references such as Exhibits 1010 (“Hartley”) and 1028 (“Watt”) (Ex. 1003, ¶¶ 46-67).

Any assertion that Patent Owner’s arguments regarding the construction of “mirror tracking mode” justifies Petitioners’ new opinions since the claim construction order did not issue until after the Petition should be rejected at least because Petitioners were aware of the construction prior to Institution of this IPR. Moreover, Petitioners and Dr. Karam repeatedly assert that all of their original arguments and opinions with respect to “mirror tracking mode” are in fact consistent with the construction in the district court. *See, e.g.*, Ex. 1033 at ¶¶ 6, 30, Reply at 1, 2-3, 6. *See also* Ex. 2012 at 189:13-190:1 (Dr. Karam testifying “my opinions are

consistent with how the district court construed this.”). That assertion is facially untrue – the Double Distance, Same Size Requirement substantially narrows “mirror tracking mode” and was never previously addressed – but if it were so, there would be no need to cite to previously undisclosed sources or advance new opinions or arguments. But that is what Petitioners did. Petitioners were aware of their own arguments in district court and fully able to address them prior to the Institution of this IPR but chose not to do so and should not be allowed to do so now. TPG 2019 at 73 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g., to make out a prima facie case of unpatentability.”).

Dr. Karam’s Second Declaration, including opinions regarding entirely new, previously undisclosed references to establish the background of a POSITA’s knowledge, is precisely the impermissible type of gap-filling the PTAB Trial Practice Guide cites as improper. “It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to ‘gap-fill’ by teaching a claim element that was not present in the prior art presented with the petition.” TPG 2019 at 74-75. In *Haag-Streit AG v. Eidolon Optical, LLC*, IPR2028-01311, Paper 31 at 13 (P.T.A.B. Sept. 5, 2019), the Board struck portions of petitioner’s reply and related expert testimony where “[p]etitioner improperly seeks to rely on the common knowledge of one of ordinary skill in the art—as an *alternative* to

[reference]—to address” the requirements of the claim) (emphasis in original). Like the *Haag-Streigt* Petitioner, Petitioners here do “not seek to *formally* change the asserted ground at issue to add” new prior art. *Id.* at 6 (emphasis in original). Instead, “Petitioner improperly seeks to rely on [the new reference] to set forth new positions to address the [] limitation—i.e., not merely to show the state of the art at the time of the invention”. *Id.*

Petitioners’ assurances that there is no gap-filling is belied by the fact that they submitted not only an additional expert declaration but also submitted new references. If, as Petitioners contend, “There are no ‘gaps’ that need to be filled” (Reply at 12) then Petitioners should have no need to rely on Dr. Karam’s Second Declaration, nor the portions of her deposition testimony discussing these references and her opinions based on them, nor Petitioners’ untimely new theories and argument. Indeed, Dr. Karam testified during her deposition that in her First Declaration, “I provide sufficient discussion that’s consistent with the POSITA’s understanding and that of a traditional mirror, which has these characteristics, including double the distance, same size, flipping.” Ex. 2012 at 181:25-182:8.

Petitioners’ intent to rely on Dr. Karam to fill gaps in their proof is evident from the content of her Second Declaration. There, for example, Dr. Karam asserts that the equations and disclosures in the newly-disclosed Francois II and Straka references were background knowledge such that “a POSITA would have

recognized that applying the transformation as described above would result in a digital mirror in which the user sees their reversed reflection appearing at double the distance from the camera and the reflection maintains the same size regardless of the user movement, consistent with the Magistrate Claim Construction Order (Ex.2008).” Ex. 1033 at ¶30. This is improper gap-filling and should be stricken.

III. CONCLUSION

For all the foregoing reasons, the Board should strike as untimely and improper: (1) Petitioners’ reliance on two new references: Straka and Francois II; (2) the entirety of Dr. Karam’s Second Declaration discussing and offering opinions regarding these references; (3) the portions of Dr. Karam’s deposition discussing these new theories and references with respect to the 110 Patent; and (4) the following portions of Petitioners’ Reply (Paper 32) advancing previously undisclosed theories, arguments, and evidence: at page 4, the entirety of the paragraph beginning with “Regardless, and as explained below”; at page 6, the entirety of the paragraph beginning with “The record reveals”, and Sections III.A.1.a-d, III.B.1, III.B.2, and III.C.1.

Dated: August 21, 2025

Respectfully submitted.

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

The undersigned hereby certifies that on August 21, 2025, copies of the foregoing were served via Electronic Mail to the following:

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