

Filed: September 4, 2025

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 No. IPR2024-00810¹
U.S. Patent No. 8,982,110 B2

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE**

¹ The petitioner in IPR2025-00296 has been joined with this proceeding.

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I. Introduction

The Trial Practice Guide states that “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.” CTPG, 80. This is not one of the rare instances that justifies this exceptional remedy. The arguments in the Reply do not rely on new prior art or otherwise modify the grounds of unpatentability. At most, they properly elaborate on arguments already found in the Petition. Even if the Board were to conclude that the Reply arguments are new, they properly respond to arguments in the Patent Owner’s Response, which raised the magistrate judge’s recommended construction for the first time in this IPR.

Patent Owner has also not demonstrated that Dr. Karam’s testimony should be stricken because it failed to identify the specific deposition passages it seeks to strike. Patent Owner elicited Dr. Karam’s deposition testimony and never objected to her responses, thus waiving its current objections. And much of her deposition and second declaration respond to Patent Owner’s expert’s opinions and do not refer to the magistrate judge’s recommended construction.

II. The Petition Explains How the Prior Art Discloses a “Mirror Tracking Mode” Under the Magistrate Judge’s Recommended Construction, So Petitioners’ Reply Arguments Are Not New

The Petition demonstrates how the prior art discloses the claimed “mirror tracking mode” features under the magistrate judge’s recommended construction. That construction essentially requires three features: (1) a “reversed reflection,” (2)

“appearing at roughly double the distance from the camera,” and (3) “the reflection maintains roughly the same size regardless of the user movement.” Ex. 2008, 41.

Both experts agree that these are known properties of conventional mirrors. Dr. Karam’s declaration submitted with the Petition explains how these features, which the ’110 patent admits were known, are features of conventional mirrors. Ex. 1001, 22-39 (incorporating by reference the application that issued as the ’109 patent); Ex. 1021 (’109 Patent), 2:19-27, 23:60-24:3 (’109 patent admissions); Ex. 1003 (Karam Decl.), ¶¶ 53-54, 65-67. Dr. Forsyth opined that, with a conventional mirror:

- “the image of the person looking into the mirror appears left-right reversed,”
- “the image of the person looking into the mirror appears at approximately double the distance,” and
- “the image of the person looking into the mirror is always approximately the same size regardless of the person’s movement toward or away from the mirror.”

Ex. 2013 (Forsyth Decl.), ¶¶ 58-60; *see also* Ex. 1034 (Forsyth Dep. Tr.), 32:9-14 (a “POSITA should certainly have known” the features of “a conventional mirror”), 157:6-11 (one skilled “should have known” the “double the distance to the mirror and roughly the same size” features because “those had been known for millennia and they’re standard simple exercises in geometry.”). But Patent Owner had

advanced a “vastly overbroad” construction that would encompass any “reflective surface,” such as a car window. Ex. 2008 (Claim Construction Order), 18. To give the effect to the word “mirror” and to “assist the jury,” the magistrate judge chose to expressly identify these already-apparent features in his recommendation. *Id.*

Patent Owner does not dispute that Francois and Rosenberg disclose the first feature—a reversed reflection. *See, e.g.*, POR (Paper 27), 27 (“Francois discloses only reversing or mirroring a user’s image”), 34 (“Rosenberg repeatedly describes a standard or traditional mirror as simply one that inverts the user’s image.”). And the Petition explains how the Geisner/Lizee combination discloses a reversed reflection. Pet. (Paper 1), 81 (“the displayed image 1050 is a flipped image of the user”).

But the Petition likewise demonstrates that the other two features are present. While the Petition and expert declaration do not use the terms verbatim, they repeatedly explain how the prior art “scales” or “resizes” the image, causing a point of view change, and thus the subject’s size and distance appear as though the subject is viewing a mirror. Taking the Rosenberg/Park combination as an example, the Petition explains that “Rosenberg discloses scaling (resizing) user’s images that are captured as real-time video images by the camera so that each of the scaled video images appear to emulate ‘a traditional life-size mirror image.’” Pet., 63. It is difficult to imagine how Rosenberg’s scaling/resizing, as discussed in the Petition, could have meant anything *other than* the Double Distance, Same Size features that

the magistrate judge eventually recommended. Indeed, the primary purpose of scaling is to adjust the size and apparent distance of the virtually “reflected” image. This is why Petitioners so extensively cited the Petition and Dr. Karam’s first declaration in support of their Reply arguments. Reply (Paper 32), 7-13, 16-19, 22-24 (citing the Petition and Ex. 1003 twenty-one times in the sections Patent Owner seeks to exclude).

These are not new arguments. Nor are they transformed into new arguments merely because Petitioners further explained them in the context of the magistrate judge’s recommended construction introduced in the Patent Owner’s Response. *See infra* Section III. Instead, they properly elaborate on the arguments in the Petition, further explaining the Petition’s discussion of scaling and resizing to emulate a mirror, which the Federal Circuit has confirmed is permissible in IPRs.

In particular, “a reply argument is proper when it responds to the patent owner’s arguments or the Board’s observations without ‘point[ing] to any new embodiments’ of a prior art reference not previously identified in the petition.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1009 (Fed. Cir. 2023) (quoting *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1385 (Fed. Cir. 2023)). As such, “a reply may be proper if it is responsive and simply expands on previously raised arguments,” as Petitioners’ arguments do here. *Id.*

In addition, “the petitioner in an inter partes review proceeding may introduce

new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner, or if it is used to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.” *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380-81 (Fed. Cir. 2018) (internal quotations omitted). Of particular relevance here, the Federal Circuit found that “[i]t was not improper for the Board to cite [prior art references] Segal and Mertin (along with Nimura) as evidence of the knowledge that a skilled artisan would bring to bear in reading Austin and Brehove, even though those references were not cited in the petition.” *Id.*, 1381.

Here, the grounds remain unchanged, and Petitioners do not rely on any new prior art. In fact, the Reply never mentions Straka and Francois II, the discussions of which Patent Owner seeks to strike.² *See* Paper 42, 1-2. Instead, those exhibits support Dr. Karam’s explanation of how a person of ordinary skill in the art would have understood the terminology in the references within the grounds, just as in *Anacor*.

Patent Owner hopes to persuade the Board that because the exact words of the

² Patent Owner chose not to file the motion to exclude that it had previously discussed with the Board (*see* Paper 36 at 3), so Patent Owner has waived any argument that Straka and Francois II themselves should be excluded from the record.

magistrate judge’s recommended construction are not in the Petition, the Petition must not address the substance of the recommended construction, and thus the arguments in the Reply must be new. *See, e.g.*, POR, 17 (referring to “a simple word search of the Petition and expert declaration”). But the Board has rejected similar arguments that place form over substance and would require reciting “magic words” in a petition. *Meta Platforms, Inc., v. Wrinkl, Inc.*, IPR2021-00882, Paper 42 at 13 (P.T.A.B. Nov. 23, 2022) (denying motion to strike because “[a]lthough we agree with Patent Owner that the Petition does not include the phrase ‘quoted message identifier,’ [prior art reference] Sarafa explains that the quoted message cited in the Petition and the ‘quoted message identifier’ are part of the same message package.”).

III. Petitioners Are Entitled to Address the Proposed Claim Construction and Teaching-Away Arguments in the Patent Owner’s Response

The Petition states that “[n]o terms require construction because the claims encompass the prior-art mappings under any reasonable construction.” Pet., 13. This remains true. *See* Reply, 4. While Patent Owner attempts to cast the magistrate judge’s recommended construction as “substantially narrow[ing]” the claims (Paper 42, 7), this view is at odds with Patent Owner’s own expert’s testimony, which confirms that conventional mirrors possessed all the listed features. Ex. 2013, ¶¶ 58-60; *see also* Section II above (quoting testimony).

To the extent any narrowing has been proposed, it is through Patent Owner’s

narrow interpretation of the magistrate judge’s recommended construction. For example, in attempting to distinguish the prior art, Patent Owner argues that the claims require a “difficult,” “complex,” or “unconventional” transformation to “imitat[e] a mirror convincingly,” or “detailed 3D geometric information.” POR, 20, 29, 35, 37; Ex. 2013, ¶¶ 57, 65, 105, 116, 117. Patent Owner proposed these features for the first time in its Patent Owner’s Response, where it also urged that the Board adopt the magistrate judge’s recommended construction. *Compare* POR, 13 (“the same construction should be adopted here”), *with* Patent Owner’s Preliminary Response (Paper 17) at 10 (“Patent Owner does not believe that resolution of any claim construction issue is necessary at this time”).

As the Federal Circuit has held, “where a patent owner in an IPR first proposes a claim construction in a patent owner response, a petitioner must be given the opportunity in its reply to argue and present evidence of anticipation or obviousness under the new construction, at least where it relies on the same embodiments for each invalidity ground as were relied on in the petition.” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023); *see also Apple Inc. v. Omni MedSci, Inc.*, No. 23-1034, 2024 WL 3084509, at *6 (Fed. Cir. June 21, 2024) (finding the Board abused its discretion in refusing to consider a reply argument addressing the patent owner’s proposed claim construction).

Patent Owner attempts to distinguish this IPR from *Axonics* by arguing that

Axonics concerned new constructions proposed by the patent owner or the Board, while the magistrate judge’s recommended construction is “Petitioners’ own that they *chose* not to address.” Paper 42, 4 (emphasis in original). But Petitioners continue to believe that no construction is necessary to resolve the disputes before the Board. Patent Owner is the one who now insists that the Board adopt the magistrate judge’s recommended construction, and Patent Owner proposes even further narrowing. The principles discussed in *Axonics* apply with full force here.

In addition, *Haag-Streit AG v. Eidolon Optical, LLC*, IPR2018-01311, Paper 31 at 13 (P.T.A.B. Sept. 5, 2019), cited by Patent Owner, is distinguishable because Petitioners do not rely on the common knowledge of one of ordinary skill in the art “as an alternative to” the prior art in the Petition’s grounds. Instead, Petitioners rely on the same prior art and embodiments to address Patent Owner’s arguments.

Patent Owner is not prejudiced by Petitioners’ Reply arguments that refer to the magistrate judge’s recommended construction. Patent Owner chose not to raise any claim construction issue in its Patent Owner’s Preliminary Response, but then questioned Dr. Karam regarding the magistrate judge’s recommended construction and devoted much of its response to addressing it. *See* Paper 17, 10; POR, 9-27, 30-39, 46-52. It also devoted much of its Sur-Reply to it. *See* Patent Owner Sur-Reply (Paper 37), 1-18, 21-24. This issue has been amply briefed, so there is no prejudice to Patent Owner.

Finally, Reply Sections III.B.1-2, which Patent Owner seeks to strike, respond to Patent Owner's arguments that Rosenberg teaches away from replicating a conventional mirror. POR, 32-36, 38; 37 C.F.R. § 42.23; CTPG, 74-75.

IV. The Board Should Not Strike Dr. Karam's Testimony

Patent Owner elicited Dr. Karam's deposition testimony, introducing the magistrate judge's order as an exhibit and repeatedly asking her questions about it. *See, e.g.*, Ex. 2012 (Karam Tr.), 44:11-17; 47:10-22; 48:10-15; 50:5-8; 84:11-18; 85:17-22; 187:25-188:2; 189:1-11; 192:25-193:4; 253:6-13. Dr. Karam's answers were directly responsive to Patent Owner's questions and drew no objections. 37 C.F.R. § 42.53(f)(8) ("Any objection . . . is waived unless made on the record during the deposition"). The Board has refused to exclude or strike testimony when the patent owner "opened the door" to the disputed testimony. *See, e.g., Pfizer, Inc. v. Biogen, Inc.*, IPR2017-01168, Paper 59 at 38 (P.T.A.B. Oct. 31, 2018).

Moreover, Patent Owner seeks to strike "the portions of Dr. Karam's deposition advancing these new theories and references relied upon by Petitioners," (Paper 42, 2), but it never identifies which passages it contends meet this description. In fact, Patent Owner's motion cites only two passages. Paper 42, 6 (citing Ex. 2012, 189:13-190:1), 8 (citing Ex. 2012, 181:25-182:8). While the Reply cites additional passages in the sections Patent Owner seeks to strike, many of those passages are about how the prior art discloses mimicking a mirror, without regard to how the

disclosure relates to the magistrate judge's recommended construction. For example, Dr. Karam's testimony (Ex. 2012) at 63:9-22 and 71:6-13 (cited on Reply page 19) merely discusses how Rosenberg discloses emulating a traditional life-size mirror. If Patent Owner actually seeks to strike every passage cited in Reply Sections III.A.1.a-d, III.B.1, III.B.2, and III.C.1, the request is overly broad and the Board should not sustain it.

The Board also should deny Patent Owner's request to strike the entirety of Dr. Karam's second declaration. In addition to properly presenting background information (*see* Section II above), declaration Section III.D properly responds to Dr. Forsyth's opinion on the "occlusion effect" and Haan's alleged "gross error," which have nothing to do with the claim construction. Ex. 1033 (Karam 2nd Decl.), ¶¶ 31-35.

Dr. Karam's deposition and declaration testimony also properly respond to the claim construction arguments in Patent Owner's Response (*see* Section III above) and Dr. Forsyth's opinion that the prior art teaches away from incorporating the optical properties of conventional mirrors (*see* Ex. 2013, ¶¶ 86, 106, 112).

V. Conclusion

For the reasons stated above, Petitioners respectfully request that the Board deny Patent Owner's motion to strike.

Dated: September 4, 2025

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner, Back-up Counsel

Reg. No. 57,540

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on September 4, 2025, a copy of the foregoing **Petitioners' Opposition to Patent Owner's Motion to Strike** was served via email directed to counsel of record for the Patent Owner at the following.

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