

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 REQUEST FOR DIRECTOR REVIEW

¹ IPR2025-00296 has been joined with this proceeding.

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List of Patent Owner's Exhibits

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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
2008	Claim Construction Order; E.D. Texas Case No. 2:23-cv-00363-JRG-RSP
2009	Samsung Responsive Claim Construction Brief (Dkt. No. 47); E.D. Texas Case No. 2:23-cv-00363-JRG-RSP
2010	Declaration of Harley R. Myler, Ph.D. Regarding Claim Construction (Dkt. No. 47-2); E.D. Texas Case No. 2:23-cv-00363- JRG-RSP
2011	Markman Hearing Transcript (December 6, 2024); E.D. Texas Case No. 2:23-cv-00363-JRG-RSP
2012	Deposition of Dr. Lina J. Karam (February 26, 2025)
2013	Declaration of Dr. David Forsyth in Support of Patent Owner EyesMatch Ltd.'s Response to Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,982,110
2014	Patent Owner EyesMatch Oral Argument Presentation [DEMONSTRATIVE EXHIBIT – NOT EVIDENCE]

I. INTRODUCTION

The Final Written Decision (“FWD”) in this matter finding all claims of the challenged U.S. Patent No. 8,982,110 (the “110 Patent”) unpatentable— a finding premised on argument and evidence indisputably made only in Petitioners’ Reply (Paper No. 32) – harms the predictability and transparency of the IPR process, ensures inconsistency between IPR and district court proceedings concerning the same claims, rewards gamesmanship by Petitioners, and flies in the face of the precedent set by the Director just weeks ago in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.* The FWD effectively eviscerates *Revvo* by creating a massive loophole for joint petitioners. Specifically, permitting the FWD to stand would improperly reward Petitioners’ decision to advance contradictory claim construction positions before the Board and in district court – and only address its own narrow district court construction in a Reply. To ensure the predictability, fairness, and consistency of the IPR process, and to ensure that Petitions—not Replies—must establish the *prima facie* case of unpatentability, the FWD must be reversed.

II. BACKGROUND

Petitioners Samsung and Google sought institution of this proceeding on May 10, 2024. Paper No. 1 (Petition (“Pet.”)) at 1. In the Petition, Petitioners assured the Board that “[n]o terms require construction” to find the claims unpatentable. Pet. at 13. At the time, Petitioner Samsung was a defendant in a district court litigation

involving the 110 Patent, *EyesMatch Ltd. v. Samsung Electronics Co., Ltd., et al.*, No. 2:23-cv-363 (E.D. Tex.) (“the District Court Litigation”). Ex. 2013, ¶25. On September 13, 2024, over two months *before* the Board instituted this proceeding based on the assurance that “[n]o terms require construction” (Pet. at 13), Samsung submitted in the District Court proceeding an expert declaration and briefing seeking narrow, non-plain meaning constructions of certain limitations of the same claims. *See, e.g.*, Ex. 2010 (Myler declaration), ¶¶97-100 (concerning “mirror tracking mode”), 58-65 (additional briefing).

Specifically, limitation 1(f) of the 110 Patent recites: “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.” Although Petitioners told the Board that no construction of this term was required, that was not what the district court was told. There, Petitioner Samsung argued for a construction of “mirror tracking mode” that would require “a mode of operation in which the user sees their reversed reflection appearing at approximately double the distance from the camera and the reflection maintains approximately the same size regardless of user movement.” Ex. 2009 at 27-28. Samsung relied on disclosures in the 109 Patent describing a conventional mirror as generating a reflection of a user “as if he was standing at a distance that is double the distance from him to the mirror” and

“roughly the same size” regardless of distance to the mirror. Ex. 2009 at 13-14. Samsung also submitted an expert declaration in support of this position. Ex. 2010, ¶¶97-100. Consequently, the District Court adopted Petitioner Samsung’s proposed construction for “mirror tracking mode” almost verbatim, construing the term as “a mode of operation in which the user sees their reversed reflection appearing at roughly double the distance from the camera and the reflection maintains roughly the same size regardless of the user movement.” Ex. 2008 at 41. *See also*, Ex. 2013, ¶¶25-26 (the “Double Distance, Same Size Requirement”).

Before the Board, Petitioners never contended that “mirror tracking mode” should be given the narrow construction it obtained from the district court, and during the Board’s consideration of whether to institute an IPR proceeding over several months, Petitioners never told the Board that Samsung had sought a different, narrow construction in a parallel proceeding under the same claim construction standard. 37 C.F.R. § 42.100(b). In fact, Petitioners objected to Patent Owner’s efforts to promptly bring the district court’s claim construction to the attention of the Board, as required by the PTAB’s Consolidated Trial Practice Guide (Dec. 2025) (“TPG 2025”), § II.B.6. *See* Paper No. 24 at 2.

Moreover, the Petition and supporting expert declaration (Pet., Ex. 1003) never sought to show that the prior art grounds disclosed or rendered obvious the claims under Petitioners’ own narrow district court construction. The only argument

made in the Petition was that the enumerated grounds disclosed this limitation under a broad, plain meaning construction, resulting in a classic failure of proof.

In its Response (Paper No. 27), Patent Owner provided the Board with the claim construction order that Petitioners had failed to disclose to the Board, explained that the same construction Petitioners advocated for in district court to avoid infringement must be applied to assess validity, and demonstrated that Petitioners had failed to show their own construction was disclosed or rendered obvious by the prior art. POR at 9-14, 14-22, 31-47. Patent Owner explained that, under the rules, this fact should have ended the IPR with a finding that no claims were unpatentable. *Id.* at 13-14.

Petitioners' Reply (Paper No. 32) inexplicably argued that the Board should not adopt Petitioners' own construction to assess the validity of the claims. Reply at 2-7. Further, Petitioners' Reply improperly argued, for the first time, that the asserted grounds disclosed or rendered obvious the challenged claims under Petitioners' district court claim construction, including the Double Distance, Same Size Requirement. Reply at 7-12, 16-19, 22-24. In making these arguments, Petitioners relied both on *new prior art*, and a new expert declaration, that purportedly provided the "background knowledge" of a POSITA that would supply the missing "mirror tracking mode" limitation – itself a new argument. *See* Ex. 1033 (Second Declaration of Dr. Lina Karam); Ex. 1035 ("*Francois II*"); Ex. 1037 ("*Straka*"). Specifically,

Petitioners and their expert argued that *Straka* and *Francois II*, the new prior art references, demonstrated that a POSITA would know that a “mirror tracking” mode would require altering the user’s image to appear at roughly double the user’s distance to the mirror, and to appear at roughly the same size regardless of user movement. Ex. 1033, ¶¶7-30. Petitioners relied on this new art and expert opinion to contend, for the first time, that the disclosures in the prior art grounds relied upon in the Petition regarding emulating a “traditional mirror” would disclose or render obvious limitation 1(f) under Petitioners’ district court construction, despite the total lack of any explicit disclosure of the Double Distance, Same Size Requirement in the references themselves. *See, e.g.*, Reply at 10-11, 16-18.

All of this was new argument; none of it had been made in the Petition, and it should have been stricken or disregarded. *See, e.g.*, TPG 2025, § II.I. (“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.”). *See id.* (confirming “a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”). *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, No. IPR2025-00632, Paper 20 at 3–5 (Director Nov. 3, 2025) (precedential) (holding that “when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.”). *See also Hologic, Inc. v. Enzo Life Sciences, Inc.*, No. IPR2018-00019,

Paper 17 at 9–10 (P.T.A.B. April 18, 2018) (denying institution “[b]ecause the Petition does not map the challenged claims, as Petitioner considers them to be correctly construed, to the asserted prior art.”). Accordingly, Patent Owner moved to strike this new evidence and argument. Paper No. 42.

The FWD adopted the district court’s claim construction of limitation 1(f). FWD (Paper No. 56) at 14-15. The FWD then found the challenged claims unpatentable with respect to Ground 2 (the *Rosenberg* and *Park* references) (*id.* at 38-45), explicitly relying on Petitioners’ new arguments (*id.* at 40), new expert declaration (*id.* at 41-42), **and** the new prior art introduced in Petitioners’ Reply (*id.* at 41-42). The FWD further denied Patent Owner’s Motion to Strike (FWD at 46-49). Patent Owner respectfully requests Director review and reversal of the FWD.

III. ARGUMENT

A. The FWD Erred In Permitting Petitioners To Raise New Claim Construction Arguments and Evidence In Their Reply That Should Have Been Raised In The Petition

The FWD erred by permitting Petitioners to raise in Reply new arguments, and introduce new evidence, seeking to demonstrate the unpatentability of the challenged claims under Petitioners’ own claim construction that it proposed in district court well prior to institution of this proceeding. It is axiomatic that a patent may not, like a nose of wax, be twisted one way to find invalidity and another to avoid infringement. *See CommScope Technologies LLC v. Dali Wireless Inc.*, 10

F.4th 1289, 1299 (Fed. Cir. 2021). The Board’s rules and decisions reflect this concern, and do not permit the proverbial “second bite at the apple” that the FWD allowed here.

There can be no dispute that the Petition was required to set out all of Petitioners’ arguments and evidence for unpatentability, *including* under the claim construction Petitioners proposed and obtained in district court. “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.” TPG 2025, § II.I.; *see id.* (confirming “a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”). *See also* 37 C.F.R. § 42.104(b)(2)-(4) (“[T]he petition must set forth. . . How the challenged claim is to be construed” and “How the construed claim is unpatentable under the statutory grounds. . . .”)

Precedential and informative decisions from the Office show that this requirement extends to contradictory claim construction positions advanced in parallel proceedings. In *Revvo Techs.*, Paper 20 at 3–5, the Director vacated the Board’s decision granting institution of a petition where, like here, Petitioner had “proposed different constructions for the claim terms in the district court litigation” but “did not explain why it was taking a different position here.” *Id.* at 2. The Director’s decision noted that the “Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency

in claim construction between forums,” and to “that end, the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Id.* at 4. The Director continued:

“As the Office explained when it changed the claim construction standard used in *inter partes* reviews and post-grant reviews to match the standard used in litigation, “[petitioners] will have less flexibility to advance inconsistent arguments about claim scope, and will instead be required to choose a single claim construction that best captures the true meaning of the patent claim.” *Id.* That is not the case here, however, as petitioners continue to propose different claim constructions in the two forums. Allowing petitioners to continue this practice ***does not further the Office’s goal of ‘providing greater predictability and certainty in the patent system.’***” *Id.* (emphasis added).

Accordingly, as the Director explained in *Revvo Techs.*, “when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.”)” *Id.* This result is in accord with the numerous decisions from the Board finding that petitions which do not address Petitioners’ inconsistent claim construction positions necessarily fail to demonstrate unpatentability. *See Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, No. IPR2024-00952, Paper 12 (P.T.A.B. Dec, 13, 2024) (designated informative) (denying institution where the Petition presented an analysis based on the plain and ordinary meaning of a key term, while Petitioner took the position in district court

that the same limitation should be construed as a means-plus-function term); *Hologic*, Paper 17 at 9–10 (denying institution “[b]ecause the Petition does not map the challenged claims, as Petitioner considers them to be correctly construed, to the asserted prior art.”); *Kiosoft Techs., LLC v. PayRange, Inc.*, No. IPR2021-00086, Paper 12 at 16 (P.T.A.B. Mar. 22, 2021) (denying institution where petitioner and its expert advocated for different constructions at the district court and the PTAB, citing concerns that failing to apply a consistent claim construction between these parallel proceedings would undermine the “predictability” of a patent’s claim scope, as well as the “‘integrity of the patent system’ overall.”); *Google LLC v. Virentem Ventures, LLC*, No. IPR2019-01247, Paper 34 at 11 (P.T.A.B. Mar. 5, 2021) (rejecting proposed construction in part because it would result in “construing the claims in a manner inconsistent with the District Court.”); *OrthoPediatrics Corp. v. K2M, Inc.*, No. IPR2018-01548, Paper 9 at 11 (P.T.A.B. Mar. 1, 2019) finding that by “failing to reconcile its proffered claim construction here with its very different construction proffered in District Court—which the District Court agreed with—Petitioner fails to satisfy” its burden in its Petition.). None of these decisions authorized Petitioners to remedy their failure to identify all grounds of unpatentability in the Petition by making new arguments and introducing new evidence in a Reply, and the same result should have occurred here.

Here, it is undisputed that the Petition failed to address how the challenged claims were disclosed or rendered obvious by the prior art grounds under Petitioners' own district court construction, let alone explain why Petitioners had advanced inconsistent positions in the two proceedings, as *Revvo Techs.* and the other decisions from the Board require. The Petition makes no mention of Petitioners' proposed narrow construction for "mirror tracking mode," despite having been proposed to the district court nearly three months before the Board's institution decision. This failure of proof should have been fatal to the Petition, and the FWD should have found the claims not unpatentable, rather than relying on belated new evidence and argument made only in a Reply.

The FWD relies on *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374 (Fed. Cir. 2023) to justify Petitioners' new arguments and evidence in Reply, but *Axonics* does not help Petitioners or support the FWD. *Axonics* addressed the circumstance in which the **Patent Owner** has proposed a new construction in its POR, or the Board has adopted one, and held that under such circumstances, an "IPR petitioner must have adequate notice and an opportunity to respond under the new construction." *Id.* at 1383. That is not what happened here. Here, the construction at issue is Petitioners' own construction that it **chose** not to address in its Petition, despite knowing its own position in the district court prior to Institution. Nothing in *Axonics* permits Petitioners to fail to disclose their own, contradictory claim construction position

advanced in a parallel proceeding, then to follow up with new argument and evidence in a Reply when Patent Owner calls them out for it. And the *Axonics* Court’s concern with notice and a fair opportunity to respond are inapplicable here. Petitioners knew their claim construction position long before the Board’s Institution Decision, and had every opportunity to address it with the Board, but chose not to.

The FWD argues that the “Petition was filed before the District Court construed ‘mirror tracking mode’”, FWD at 48, but nothing in *Axonics* or common sense supports the contention that an inconsistent claim construction position taken *after* a Petition is filed, but well before an institution decision, should allow a second chance to Petitioner to provide new argument and evidence. Were it otherwise, all Petitioners would be enabled to “game” the system just as occurred here, by advancing one set of arguments and evidence in the Petition under a broad, “plain meaning construction,” and then later seek a noninfringement defense in district court under a narrow, inconsistent construction, all while preserving the ability to advance new arguments and evidence if necessary in a reply. This “shifting sands” approach to assessing patent validity is precisely what the Director has sought to preclude, including through the revisions currently proposed. *See* Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (proposed October 17, 2025) (to be codified at 37 C.F.R. pt. 42). Petitioners could have addressed their inconsistent claim construction positions by submitting a new

Petition that properly addressed it, or by submitting supplemental information pursuant to 37 C.F.R. § 42.123. *See* TPG 2025, § II.B.6. Petitioners did none of these things, and as a result, should have been found to have failed to show unpatentability.

In any event, even *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.” *Axonics*, 75 F.4th at 1383. But that is what happened here. Petitioners and their expert never contended prior to institution that the background knowledge of a POSITA, supplied by the new *Straka* and *Francois II* references, would supply the knowledge necessary to understand the prior art 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 this feature. For the *Rosenberg/Park* combination relied upon by the FWD, Petitioners contended only that “Rosenberg-Park renders obvious this limitation.” Pet. at 64. If the primary references didn't teach “Double Distance, Same Size” and the Petition didn't mention it, adding *Straka* and *Francois II* to teach it is a *new ground*. The addition of this purported “background knowledge” of a POSITA, supplied by new prior art references, was improper new argument.

None of the FWD's other excuses for permitting Petitioners to advance new arguments and evidence in Reply have any merit, either. For example, the FWD

found that *Revvo Techs.* “does not apply here” because “Google, the only remaining Petitioner in this proceeding,” was not “a party to the related district court proceeding or proposed any claim construction there.”² FWD at 12-13. That is no distinction at all. Google did not file its own, separate petition; at all relevant times, Google and Samsung were *co-petitioners* in a unitary filing. Google and Samsung addressed the Board with a single voice in seeking to invalidate the challenged claims, and by signing the Petition, Google attested that the grounds were complete. 35 U.S.C. § 312(a). This includes the Petition’s statement that no construction of limitation 1(f) was required, while one Petitioner advanced an inconsistent claim construction position in district court. If the Petition was legally defective *at the time of filing* and during the pendency of the institution decision because the “Petitioners” (collectively) failed to justify their inconsistent positions (violating *Revvo*), Petitioners cannot retroactively cure the defect just because one party settled. Google and Samsung are both bound to the benefits, and consequences, of the unitary petition they both filed. Any other result would allow the non-settling Petitioner to essentially file a new Petition in the guise of a Reply brief, bypassing

² The IPR was terminated as to Samsung in September 2025, on the basis of settlement. *See* Paper No. 49.

Revvo entirely and allowing the gamesmanship *Revvo* and the Director have sought to prevent.

The FWD next speculates that “Patent Owner likely knew of Samsung’s proposed claim construction for the District Court before the Patent Owner filed its Preliminary Response,” but did not propose any construction. FWD at 13. Petitioner Samsung did not file any brief asserting its inconsistent claim construction position until September 13, 2024, *after* the POPR (*see* Ex. 2010), but more fundamentally, it is irrelevant. It was Petitioners’ obligation, not Patent Owner’s, to explain their inconsistent positions (*Revvo Techs.*, Paper 20 at 3–5) and to demonstrate unpatentability in the petition, not through new argument and evidence in a reply.

B. The FWD Erred When It Denied Patent Owner’s Motion to Strike

For the same reasons discussed above, the FWD also erred when it denied Patent Owner’s Motion to Strike Petitioners’ new evidence and argument. The FWD’s reliance on *Axonics* is again misplaced. *Axonics* provides a fair opportunity to respond in Reply to a *new* claim construction; nothing in *Axonics* permits a Petitioner to contend that it should be able to introduce new argument and evidence to address *its own inconsistent claim construction* from a parallel proceeding, which it indisputably knew of during the pendency of the institution decision but did not disclose to the Board. Moreover, *Axonics* does not permit, and explicitly excludes,

the introduction of new prior art to supply the missing “background knowledge” of a POSITA to fill gaps in the original proof, as occurred here.

The FWD next faults Patent Owner for purportedly “open[ing] the door” to new argument and evidence about limitation 1(f) by cross-examining Petitioners’ expert regarding the Petition’s failure to address Petitioners’ own narrow claim construction. FWD at 49-50. This “gotcha” argument has no merit. Patent Owner’s questioning was limited to whether Dr. Karam had applied the District Court’s construction. (*See, e.g.,* Ex. 2012 (Karam Dep.) at 188:4-193:22). That was not “opening the door.” Cross-examining an expert to confirm a **failure of proof** (i.e., that they failed to address a limitation) does not open the door for the expert to **cure** that failure with new evidence in Reply. If the Board’s logic holds, cross-examination becomes a trap: if a Patent Owner exposes a deficiency in the expert’s declaration, the expert is granted a license to fix it with new prior art. This turns the adversarial process on its head, and cannot be the rule. *See Media LLC v. Rich Media Club LLC*, No. IPR2023-00953, Paper 74 (P.T.A.B. Aug. 19, 2024) (granting motion to strike Petitioner’s expert’s second declaration addressing previously unaddressed claim limitation).

IV. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Director reverse the FWD, and find all challenged claims not unpatentable.

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Respectfully submitted.

/John C. Pierce/

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

Matthew D. Powers, *admitted pro hac vice*
William P. Nelson, *admitted pro hac vice*
Natasha M. Saputo, *admitted 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

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

The undersigned hereby certifies that on December 19, 2025, copies of the foregoing were served via Electronic Mail to the following:

Erika H. Arner (Reg. No. 57,540)
**Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP**
1875 Explorer Street, Suite 800
Reston, VA 20190-5676
Tel: (571) 203-2754
Fax: (202) 408-4400
erika.arners@finnegan.com

Sydney R. Kestle (Reg. No. 78,725)
**Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP**
901 New York Avenue, NW
Washington, DC 20001-4413
(202) 408-4000
sydney.kestle@finnegan.com

Xirui Zhang (Reg. No. 78,809)
**Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP**
Two Seaport Lane
Boston, MA 02210-2001
(617) 646-1600
xirui.zhang@finnegan.com

Kara A. Specht (Reg. No. 69,560)
Jason E. Stach (Reg. No. 54,464)
**Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP**
271 17th Street, NW, Suite 1400
Atlanta, GA 30363-6209
Tel: (404) 653-6400
Fax: (404) 653-6444
kara.specht@finnegan.com

jason.stach@finnegan.com

Counsel for Google LLC

/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