

Filed: December 31, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

EYESMATCH LTD.,
Patent Owner.

Case No. IPR2024-00810
U.S. Patent No. 8,982,110

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST¹

¹ This Response was authorized by e-mail dated December 19, 2025 (Ex. 3100).

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I. Introduction

The essence of Patent Owner’s Director Review Request (Paper 57, “DR Req.”) is not about any error in the Final Written Decision. Paper 56 (“FWD”). It is about Patent Owner’s dissatisfaction with the outcome. From the outset, Google maintained that the challenged claims are unpatentable under any reasonable claim construction. Pet. 10–13; FWD at 10–13. That is precisely what occurred here. The Board found that the Magistrate Judge’s claim construction in the parallel district court litigation—issued after institution—was reasonable, adopted that claim construction, and found the claims unpatentable. FWD at 14–15, 50–51.

Unable to accept this result, Patent Owner now asserts that Google was “inconsistent” and that this purported inconsistency should undo the Final Written Decision. DR Req. at 1–12. That narrative is misleading. Google’s position never changed: it consistently maintained that no express construction was necessary because the prior art teaches the limitations under any reasonable interpretation. It was Patent Owner—not Google—that abandoned its own district court construction, advanced a different claim construction late in the IPR proceeding, and then attempted to block Google from addressing the construction. Director Review does not exist to relieve a party of the consequences of its own tactical reversal, and Patent Owner’s Request should be rejected.

Indeed, the circumstances in this IPR bear no resemblance to *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Director Nov. 3, 2025) (precedential). Google and former Petitioner Samsung filed the Petition in this case months before claim construction activities commenced in Patent Owner’s parallel district court litigation against Samsung. FWD at 10–13; Ex. 2008, 1; Ex. 1020, 4; Paper 6. Google was not a defendant in the parallel district court litigation and has filed a separate action seeking declaratory judgement of non-infringement against Patent Owner.² FWD at 12–13; Paper 54, 20:24–21:7. Throughout this IPR, Google maintained a consistent position: no express construction was necessary because the prior art teaches the challenged limitations under any reasonable interpretation. FWD at 10–13; Pet. 13–14.

Patent Owner, by contrast, reversed course. By the time of the Preliminary Response, claim construction in the district court had advanced to the point that former Petitioner Samsung had proposed the disputed claim construction. Despite knowing about Samsung’s construction, Patent Owner did not mention it or otherwise suggest that the Board should adopt it. FWD at 10–13; Ex. 2008, 1;

² Google’s action is currently stayed and claim construction has not yet occurred. *Google LLC v. EyesMatch Ltd.*, No. 5: 25-cv-02964, Dkt. No. 29 (N.D. Cal. Dec. 7, 2025).

Ex. 1020, 4. Quite the opposite. In its Preliminary Response, Patent Owner expressly told the Board no construction was necessary. POPR (Paper 17) at 10–11.

After institution, however, Patent Owner, for the first time in the Patent Owner’s Response, urged the Board to adopt the Magistrate Judge’s construction solely because it aligned with Samsung’s position—even though Patent Owner had opposed that claim construction in the district court. Ex. 2008, 14–19, 40–41 (noting Patent Owner argued for a different construction that would cover any reflective surface and that its construction was “vastly overbroad”); Paper 54, 41:6–42:2 (admitting that Patent Owner opposed the construction).

Consistent with Patent Owner’s arguments in this IPR, the Board adopted the Magistrate Judge’s construction and reasoning. FWD at 14–15; DR Req. at 3. Patent Owner now complains that the Board should not have considered Petitioner’s Reply arguments and supporting evidence responsive to the construction Patent Owner itself requested. DR Req. at 6–15. The Board carefully evaluated—and rejected—these arguments, finding no procedural impropriety or prejudice under controlling Federal Circuit precedent. FWD at 47–50.

Having failed on its procedural gambit and losing on all arguments on the merits, Patent Owner now seeks a second bite at the apple by invoking generalized concerns with inconsistency or gamesmanship under *Revvo*. DR Req. at 1, 12–14. But Patent Owner minimizes the significance of the fact that, before oral hearing, it

settled with former Petitioner Samsung and the parallel district court litigation was dismissed with prejudice, rendering any concern about inconsistent claim constructions moot. DR Req. at 13; Papers 46, 48; *EyesMatch Ltd. v. Samsung Elecs. Co., Ltd. et al.*, No. 2:23-cv-00363, Dkt. No. 64 (E.D. Tex. Sept. 9, 2025); *see Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 (Director Aug. 6, 2025).

Director Review is reserved for correcting errors or addressing important policy issues. It is not for rehashing arguments that fall well within existing precedent and have already been thoroughly evaluated and rejected, as Patent Owner's Request does here. The Request should therefore be denied.

II. Legal Standard

There are four recognized grounds for granting Director Review, including when a final decision implicates (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law. USPTO Website, *Director Review Process*, Section 5.A, <https://www.uspto.gov/patents/ptab/decisions/director-review-process> (last visited Dec. 29, 2025).

III. Argument

None of the four recognized grounds for Director Review are present here. Patent Owner simply complains that the Board rejected its motion-to-strike arguments, permitting Petitioner to reply to Patent Owner's proposed claim

construction. *See generally* DR Req. But the Board has thoroughly addressed Patent Owner’s arguments under the Office’s precedential *Revvo* decision and Federal Circuit precedent. FWD at 10–13, 46–50. As such, Patent Owner presents no basis to disturb the Board’s conclusions, which are well supported by the record and case law.

A. The Board Evaluated Patent Owner’s Procedural Argument and Correctly Found *Revvo* Inapplicable Because Google Was Not a Defendant in the Parallel District Court Proceeding.

The Board evaluated Patent Owner’s procedural argument under *Revvo* and correctly found *Revvo* inapplicable because the circumstances here bear no resemblance to the inconsistency or gamesmanship that concerned the Director there. FWD at 12–13. In *Revvo*, the petitioner advanced different claim construction positions in district court and before the Board without explanation. *Revvo*, IPR2025-00632, Paper 20 at 4–5. Here, as the Board correctly found, Google was not a defendant in the parallel district court proceeding against Samsung and has maintained a consistent position before the Board from the outset: no express construction was necessary in the IPR because the prior art teaches the challenged limitations under any reasonable interpretation. FWD at 10–13; Pet. 13–14. That position fully complies with the PTAB’s Trial Practice Guide (“TPG”) and Federal Circuit precedent. TPG, § II.B.6 (“[A] petitioner may include a statement that the

claim terms require no express construction.”); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

The litigation and IPR timelines confirm the absence of inconsistency or gamesmanship by Google. The Petition was filed May 10, 2024—over three months *before* Patent Owner and former Petitioner Samsung exchanged Preliminary Claim Constructions, and approximately seven months before the Magistrate Judge issued a claim construction order in the parallel district court litigation. Ex. 2008; FWD at 13; Paper 6. Throughout this IPR, Google’s claim construction position did not change. FWD at 10–13; Pet. 13–14.

If there has been any gamesmanship, it has been by Patent Owner changing its claim construction positions throughout this IPR and using its shift to claim that Google’s arguments are somehow inappropriate. In particular, before institution, Patent Owner stated in its Preliminary Response that “Patent Owner does not believe that resolution of any claim construction issue is necessary at this time,” while “reserv[ing] the right to raise claim construction should the Board grant institution.” POPR at 10–11. Shortly after, Patent Owner filed joint proposed constructions in the parallel district court litigation, including its proposed construction for the term “mirror tracking mode” of claim limitation 1[f]—a construction the Magistrate Judge later found was “vastly overbroad.” Ex. 1020, 4; Ex. 2008, 1, 18–19, 40–41; FWD at 13. Despite knowing about both its own proposed construction and

Samsung's before filing its Preliminary Response, Patent Owner did not mention either construction to the Board before institution. *See* Ex. 1020, 4 (showing the parties exchanged Preliminary Claim Constructions on August 23, 2024); POPR at 37.

At institution, the Board acknowledged the parties' positions in the pre-institution briefing and concluded that no claim terms needed to be construed to resolve a controversy. Paper 20 ("ID") at 12 ("Neither party has proposed claim constructions for our consideration."), 13 ("we need not construe any claim terms and phrases to resolve a controversy").

Only after institution did Patent Owner inject the Magistrate Judge's construction into this proceeding. After deposing Petitioner's expert Dr. Karam and repeatedly questioning her regarding the Magistrate Judge's construction of "mirror tracking mode," including the "reversed reflection," "double the distance," and "same size" features, and the prior art's teaching of these features, Patent Owner urged the Board to adopt that construction wholesale, without offering any independent analysis or evidence. POR at 9–27, 30–39, 46–52; Reply at 6–7; FWD at 49. But Patent Owner did not agree with and in fact opposed in the parallel district court proceeding the construction it now asked the Board to adopt. Ex. 2008, 14–19, 40–41 (noting Patent Owner argued for a different construction that would cover any reflective surface and is "vastly overbroad"); Paper 54, 41:6–42:2 (admitting that

Patent Owner opposed the construction). Nonetheless, because Patent Owner asked the Board to adopt the Magistrate Judge's construction, Patent Owner now has no basis to complain that the Board erred in adopting it. FWD at 14–15.

Google's claim construction position has remained consistent throughout this proceeding. FWD at 13. By contrast, Patent Owner changed claim construction positions. It knew both its own and former Petitioner Samsung's claim construction positions before filing its Preliminary Response, but it introduced the Magistrate Judge's claim construction order containing these positions only after institution and then sought to prevent Google from addressing the Magistrate Judge's claim construction. FWD at 13–14; Ex. 1020, 4; POPR at 10; POR at 13.

Even if *Revvo* were relevant, any alleged inconsistency no longer exists. The Board adopted the Magistrate Judge's construction and reasoning, resolving any potential inconsistency. FWD at 14–15. *See Caption Health, Inc. v. Univ. of British Columbia*, IPR2025-01422, Paper 15 (Director Dec. 18, 2025) (finding Petitioner's stipulation to adopt same construction proposed in the district court resolves any potential inconsistency in claim construction positions between forums and does not require further explanation under *Revvo*).

In addition, one week before the oral hearing, Patent Owner settled with former Petitioner Samsung and moved to terminate this IPR as to Samsung. Papers 46, 48. The parallel district court litigation was then dismissed with

prejudice. *EyesMatch*, No. 2:23-cv-00363, Dkt. No. 64. With the district court litigation dismissed, Patent Owner’s purported concern with inconsistent claim construction positions between proceedings is now moot. *See Arm*, IPR2025-00207, Paper 14 (vacating initial discretionary denial decision after the parallel district court litigation that drove the original denial was dismissed with prejudice).

In short, Google’s position has been consistent in this IPR. The Board’s conclusions that no procedural error occurred and *Revvo* is inapplicable are firmly supported by the record.

B. The Board Evaluated Patent Owner’s Arguments and Correctly Found That Google’s Allegedly New Arguments and Evidence Are Fair Responses to Patent Owner’s Claim Construction Advanced for the First Time in the Patent Owner’s Response.

The Board properly rejected Patent Owner’s contention that Petitioner’s Reply introduced “new” arguments or evidence. FWD at 48–50; DR Req. at 10–15. As the Board explained, there was no procedural impropriety because the Petition was filed months before claim construction activities in the parallel district court litigation began, particularly where both parties agreed pre-institution that no claim construction was necessary. Paper 6; Ex. 2008; FWD at 10–13, 48–49.

The Board found that Petitioner’s Reply appropriately elaborated on positions set forth in the Petition and addressed claim construction arguments raised for the first time in the Patent Owner’s Response. FWD at 41–43, 48–49. Walking through

the evidence in the record, the Board found that a person of ordinary skill in the art would have understood that a conventional mirror image would have the three features identified in the Magistrate Judge’s construction of “mirror tracking mode”—“reversed reflection,” “double the distance,” and “same size,” noting that both experts agree on this well-known knowledge. *Id.* The Board further found that these features were at least suggested if not expressly taught by Rosenberg alone or in combination with Park, consistent with the Petition’s mapping. *Id.* Patent Owner identified no error in the Board’s analysis. *See generally* DR Req.

The Board also found that Petitioner’s Reply was a fair response under *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1381 (Fed. Cir. 2023), which permits a petitioner to address claim construction arguments first raised in a patent owner’s response. FWD at 48–49. The Board detailed the claim construction development in this proceeding: “prior to institution, both Petitioner and Patent Owner took the position that no claim construction was necessary;” “[n]ot until the filing of its Response did Patent Owner urge us to adopt the District Court’s claim construction;” “Patent Owner opened the door to [Google’s expert’s] testimony by cross-examining Dr. Karam on the District Court’s Order.” *Id.*

The Board further evaluated Patent Owner’s “gap-filling” argument and rejected it. FWD at 49. After thoroughly analyzing the record, the Board found that both experts agreed on the three features of a conventional mirror image, noted that

“Dr. Karam’s declaration submitted with the Petition explains how these features ... were known,” and confirmed that Petitioner’s reliance on background prior art to show general background knowledge was not improper “gap-filling” under the law. *Id.* (citing *Shockwave Med., Inc. v. Cardiovascular Sys., Inc.*, 142 F.4th 1371, 1378–79 (Fed. Cir. 2025)). The Board also evaluated Dr. Karam’s deposition testimony and found that it was elicited by Patent Owner and properly responds to the claim construction order and questions raised during cross-examination. FWD at 49.

Moreover, Petitioner’s Reply pointed to no new prior art references or embodiments in the grounds of unpatentability. It relied on the same references cited in the Petition, and addressed Patent Owner’s claim construction and its expert’s opinions by showing the knowledge that a skilled artisan would have brought when reading Rosenberg as addressed in the Petition. Paper 45 at 1–6.

This approach is consistent with Federal Circuit precedent. A reply is proper when it responds to arguments raised by the patent owner without introducing new embodiments. *Id.* (citing *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1009 (Fed. Cir. 2023) (“[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”), quoting *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1385 (Fed. Cir. 2023)); *see also*

Anacor Pharms., Inc. v. Iancu, 889 F.3d 1372, 1380–81 (Fed. Cir. 2018) (internal quotations omitted) (“[T]he petitioner in an inter partes review proceeding may introduce new evidence after the petition stage if the evidence is ... used to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.”); *id.* at 1381 (“It 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.”).

In short, Petitioner’s Reply and supporting evidence were an appropriate response to Patent Owner’s new claim construction arguments in its Patent Owner’s Response. The Board’s conclusion that these arguments were proper and not “gap filling” is well supported by the record and Federal Circuit precedent.

C. The Board Evaluated Patent Owner’s Motion to Strike and Found It Lacked Specificity, Was Inconsistent with Federal Circuit Precedent, and Was Unwarranted Under the Trial Practice Guide.

As explained above, the Board did not err in finding that Petitioner’s Reply and Dr. Karam’s testimony were fair responses to the claim constructions first raised in Patent Owner’s Response, citing the Federal Circuit’s precedent *Axonics*. For the same reasons, the Board did not err in denying Patent Owner’s Motion to Strike Petitioner’s Reply arguments and supporting evidence. FWD at 48–49.

Additionally, the Board did not err in denying Patent Owner's Motion to Strike because the motion was unreasonably broad, did not identify the specific testimony that should be stricken, and did not demonstrate that it warrants the "exceptional remedy" of striking Petitioner's arguments. *Id.* at 49.

In particular, Patent Owner asked the Board to strike Petitioner's arguments responding to Patent Owner and its expert's theory that Rosenberg teaches away from performing transformations other than simple flipping. Paper 42 at 2; Paper 45 at 9. Those teaching-away arguments appeared for the first time in the Patent Owner's Response. POR, 32–36, 38; Ex. 2013, ¶¶ 86, 106, 112. Petitioner is permitted to respond to such teaching-away arguments raised in Patent Owner's Response. *See* Reply at 16–19; 37 C.F.R. § 42.23(b) (a reply may respond to arguments raised in patent owner response); *Corephotonics*, 84 F.4th 990 at 1009; *Rembrandt Diagnostics*, 76 F.4th 1376 at 1385.

Second, Patent Owner asked the Board to strike Petitioner's Reply arguments and Dr. Karam's testimony regarding the prior art's teaching of emulating a traditional life-size mirror. Those arguments and testimony were not tied to the Magistrate Judge's claim construction but instead addressed Patent Owner's own new positions on how Rosenberg and other references disclose mirror emulation, and thus are permitted for Reply. Paper 42 at 2; Paper 45 at 9–10. Patent Owner's request was also fatally vague. It did not identify any specific testimony that should

be stricken, leaving the Board with no practical basis to grant such sweeping relief. FWD at 49; TPG, § II.K .

Finally, Patent Owner sought to strike the entirety of Dr. Karam’s second declaration, which also included a section addressing Patent Owner’s expert Dr. Forsyth’s opinion on the “occlusion effect.” Paper 45 at 10; Ex. 1033, ¶¶ 31–35; FWD at 49. Again, Patent Owner’s motion was unwarranted. The testimony of that section of Dr. Karam’s second declaration was not related to the Magistrate Judge’s claim construction of limitation 1[f]; it addressed an “occlusion effect” theory in the Patent Owner’s Response and expert testimony concerning claim limitations 1[c] and 1[e]. POR at 39–40; Ex. 2013, ¶¶ 65, 117; FWD at 40 (finding Patent Owner failed to tie its “occlusion effect” argument to the ’110 patent). Such testimony is permissible Reply evidence. Paper 45 at 10; *Corephotonics*, 84 F.4th 990 at 1008 (citing *Anacor Pharms.*, 889 F.3d 1372 at 1380–82 (petitioner “may introduce new evidence after the petition stage if the evidence is a legitimate reply to evidence introduced by the patent owner”).

As such, the Board correctly concluded that Patent Owner’s Motion to Strike was unsupported and unwarranted under PTAB practice and Federal Circuit law.

IV. Conclusion

For these reasons, Petitioner requests that the Director deny Patent Owner's Director Review Request.

Dated: December 31, 2025

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner, Lead 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 December 31, 2025, a copy of the foregoing **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST** was served via email directed to counsel of record for the Patent Owner at the following.

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