

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

EYESMATCH LTD.,
Patent Owner.

IPR2025-00297
Patent 8,982,109 B2

Before THOMAS L. GIANNETTI, NEIL T. POWELL, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

GIANNETTI, *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

Microsoft Corporation (“Petitioner”) filed a Petition for *inter partes* review of claims 1–18 of U.S. Patent No. 8,982,109 B2 (Ex. 1001, “the ’109 patent”). Paper 2 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder. Paper 3 (“Joinder Motion”). In the Joinder Motion, Petitioner seeks to join *Google LLC. v. EyesMatch Ltd.*, IPR2024-00856 (“the ’856 IPR”), which concerns the ’109 patent at issue here. Joinder Motion 1.

The ’856 IPR was initiated by Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “the ’856 IPR petitioners”). We instituted trial in the ’856 IPR on December 3, 2024. ’856 IPR, Paper 15 (“’856 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 *inter partes* review of all challenged claims and grant Petitioner’s Joinder Motion.

II. BACKGROUND

A. RELATED PROCEEDINGS

The parties indicate that the ’109 patent is involved in *EyesMatch Ltd. v. Samsung Electronics America, Inc.*, No. 2:23-cv-00363 (E.D. Tex.). Pet. 83; Paper 4, 1. Petitioner also discloses that the ’109 patent was involved in *EyesMatch Ltd. v. Facebook, Inc.*, No. 1:21-cv-00111 (D. Del.). Pet. 83. Petitioner further notes that the ’109 patent was previously challenged in IPR2022-00489 (terminated). *Id.* Additionally, Petitioner is challenging claims of related U.S. Patent No. 8,982,110 B2 (“the ’110 patent”) in IPR2025-00296. *Id.* Petitioner filed a motion in IPR2025-00296 to join

IPR2025-00810, which also involves the '110 patent, that has been granted.
See IPR2025-00296, Paper 13.

B. ASSERTED GROUNDS OF UNPATENTABILITY

The Petition in this proceeding asserts the same prior art references and grounds as those asserted in the '856 IPR (Pet. 2), namely:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis ¹
1	1–6, 8, 17	103(a) ²	Rosenberg, Nakazawa
2	1–6, 8, 11, 17	103(a)	Rosenberg, Nakazawa, Hatanaka
3	1–6, 8, 17	103(a)	Rosenberg, Nakazawa, Tripathi
4	11	103(a)	Rosenberg, Nakazawa, Tripathi, Hatanaka
5	7	103(a)	Rosenberg, Nakazawa, Iwai
6	7	103(a)	Rosenberg, Nakazawa, Hatanaka, Iwai
7	7	103(a)	Rosenberg, Nakazawa, Tripathi, Iwai
8	9	103(a)	Rosenberg, Nakazawa, Kubota
9	9	103(a)	Rosenberg, Nakazawa, Hatanaka, Kubota

¹ For further details on these references, *see* Pet. 1–2.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) amended 35 U.S.C. §103. Because the '109 patent has a filing date prior to the effective date of the applicable AIA amendment, we refer to the pre-AIA version of §103.

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis¹
10	9	103(a)	Rosenberg, Nakazawa, Tripathi, Kubota
11	10	103(a)	Rosenberg, Nakazawa, Cho
12	10	103(a)	Rosenberg, Nakazawa, Hatanaka, Cho
13	10	103(a)	Rosenberg, Nakazawa, Tripathi, Cho
14	12	103(a)	Rosenberg, Nakazawa, Park
15	12	103(a)	Rosenberg, Nakazawa, Hatanaka, Park
16	12	103(a)	Rosenberg, Nakazawa, Tripathi, Park
17	13–15	103(a)	Rosenberg, Nakazawa, Kuranov
18	13–15	103(a)	Rosenberg, Nakazawa, Hatanaka, Kuranov
19	13–15	103(a)	Rosenberg, Nakazawa, Tripathi, Kuranov
20	16	103(a)	Rosenberg, Nakazawa, Chang
21	16	103(a)	Rosenberg, Nakazawa, Hatanaka, Chang
22	16	103(a)	Rosenberg, Nakazawa, Tripathi, Chang
23	18	103(a)	Rosenberg, Nakazawa, Lizee
24	18	103(a)	Rosenberg, Nakazawa, Hatanaka, Lizee
25	18	103(a)	Rosenberg, Nakazawa, Tripathi, Lizee

III. DECISION ON INSTITUTION

Petitioner represents that the challenges to the claims of the '109 patent in the Petition are “intentionally identical . . . in all substantive aspects” to the challenges in the '856 IPR. *See* Joinder Motion 2; *compare* '856 IPR, Paper 1, 2–4, with Pet. 2–3. Petitioner further represents that this proceeding and the '856 IPR “rely upon the same analytical framework (*e.g.*, same expert declarant and prior art) in addressing the Challenged Claims.” Joinder Motion 2. Additionally, Patent Owner does not present an opposition to the Petition on the merits and does not oppose joinder. *See, e.g.*, Notice, 1. In view of the foregoing, for the reasons given above and in the '856 Institution Decision, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on its challenge to at least one claim of the '109 patent. We therefore institute *inter partes* review of all challenges in the Petition. *See* 35 U.S.C. § 314(a).

IV. JOINDER MOTION

A party to *inter partes* review may be joined to 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 was accorded a filing date of December 20, 2024, which is within one month of the '856 IPR's December 3, 2024 institution date. *See* Paper 6; '856 IPR Institution Decision. Thus, the Petition meets the timing requirement for joinder.

Petitioner contends that joinder is appropriate for a number of reasons. Joinder Motion, 4–8. As is discussed above, Petitioner explains that its Petition is “intentionally identical” to the petition on which the Board instituted trial in the '856 IPR. *Id.* at 5. Petitioner explains that it is relying on the same prior art, the same grounds, and the same expert testimony as the '856 IPR petition. *Id.* Petitioner argues that granting joinder with the '856 IPR “presents an opportunity to streamline review of the '109 Patent's Challenged Claims,” avoiding inefficient duplicative efforts in the '856 IPR and this proceeding. *Id.* at 6. Petitioner further contends that joinder will not affect the '856 IPR's schedule or prejudice Patent Owner. *Id.* at 6–8. “[S]o long as Samsung and Google remain active parties,” Petitioner agrees to consolidate its filings in the '856 IPR with Samsung and Google and adhere to other conditions under which it would participate as a “silent understudy.” *Id.* at 7–8.

As noted above, Patent Owner represents 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. IPR2024-00856.” Notice, 1.

Joinder is a matter within the Board's discretion based on the particular circumstances of each proceeding. For the reasons given above, we are persuaded that Petitioner has demonstrated that permitting Petitioner

to join the '856 IPR would avoid duplication and promote the efficient resolution of both proceedings and is therefore in the interests of justice.

V. CONCLUSION

Based on the record before us, we institute *inter partes* review in IPR2025-00297 and grant Petitioner's Joinder Motion, joining Petitioner as a party to the '856 IPR.

VI. ORDER

In consideration of the foregoing, it is:

ORDERED that *inter partes* review of claims 1–18 of the '109 patent is instituted on all grounds in the Petition;

FURTHER ORDERED that Petitioner's Joinder Motion is granted, and Petitioner is joined as a party in IPR2024-00856;

FURTHER ORDERED that the Scheduling Order entered in IPR2024-00856 (Paper 16) is not modified and shall continue to govern the schedule in that proceeding;

FURTHER ORDERED that, as long as '856 IPR petitioners Google and Samsung remain as parties to the '856 IPR, Petitioner and those petitioners (i) will file papers (except for motions that do not involve another party) as a single filing identified as a Consolidated Filing, and (ii) will conduct coordinated (not separate) discovery;

FURTHER ORDERED that, as long as '856 IPR petitioners Google and Samsung remain parties to the '856 IPR, Petitioner shall not introduce any argument or discovery not already introduced by those petitioners;

FURTHER ORDERED that Petitioner shall be bound by any agreements between Patent Owner and petitioners Google and Samsung in the '856 IPR, including agreements regarding discovery or depositions;

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FURTHER ORDERED that IPR2025-00297 is hereby terminated under 37 C.F.R. § 42.72 and all further filings are to be made in IPR2024-00856;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2024-00856; and

FURTHER ORDERED that the case caption in IPR2024-00856 shall be changed to reflect joinder of Petitioner 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

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

v.

EYESMATCH LTD.,
Patent Owner.

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¹ The petitioner in IPR2025-00297 has been joined with this proceeding.