

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
Petitioners,

v.

EYESMATCH LTD.,
Patent Owner.

Case No. IPR2024-00856¹
U.S. Patent No. 8,982,109

PATENT OWNER'S MOTION TO STRIKE

¹ IPR2025-00297 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 “it appears to mimic a reflection of a mirror” recited in limitation 1[c] of all claims of the 109 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 and argument regarding how the Asserted Grounds allegedly disclose or render obvious “mirror mimicking” under Petitioners’ own claim construction.

For the reasons set forth herein, Patent Owner requests that the Board strike as untimely and improper: (1) the following portions of Petitioners’ Reply (Paper 26) (“Reply”) advancing previously undisclosed theories, and arguments: Sections III.A.1, III.A.2, III.A.3; and (2) the portions of Dr. Karam’s deposition relied upon by Petitioners offering new opinions and theories as to the 109 Patent.

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

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 “it appears to mimic a reflection of a mirror” in limitation 1[c] that Petitioner Samsung advocated for (and ultimately obtained) in district court prior to Institution of this IPR. Ex.2008 at 19; *see also*, Ex.2013, ¶¶ 25-26, Ex.2009, at 12-16, Ex.2010, ¶¶ 58-65. Petitioners were indisputably aware of this construction *prior* to Institution because it was Petitioner Samsung’s own construction. Yet nowhere in the Petition or prior to Institution did Petitioners assert, as they do for the first time in their Reply, that “*no construction* is needed here because the Petition/evidence shows the art discloses ‘mirror mimicking’ under the magistrate’s construction” (Reply at 5 (emphasis in original)) or that “*Rosenberg and Nakazawa* render obvious this limitation” (including the Double Distance, Same Size Requirement) (Reply at 9).

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-III.A.3 (regarding the *Rosenberg/Nakazawa* combination alleged to disclose or render obvious “appears to mimic a mirror” in limitation 1[c] for every asserted claim). Sections III.A.1. through III.A.3 of Petitioners’ Reply are directed exclusively to such arguments and should be stricken in their entirety.

For example, for the first time in their Reply, Petitioners contend that the Asserted Grounds disclosed the Double Distance, Same Size Requirement all along: “a POSITA would have understood that the *Rosenberg/Nakazawa* transformations mimicking a standard household mirror (*Rosenberg*, [0027], [0038], [0077]) provide such well-known features.” Reply at 10. *See also* Reply at 12-13 (The “Petition/evidence show[s] the POSITA would understand such *mirror replication* creates the reversed, double-distance, same-size conventional-mirror features” (emphasis in original)); Reply at 17 (“Dr. Karam explained that the POSITA would have understood a virtual mirror would simulate the properties of a traditional mirror as accurately as possible”). But neither the Petition nor Dr. Karam’s declaration discussed how a POSITA’s knowledge means that a POSITA would understand *Rosenberg/Nakazawa*’s bare description of emulating a “traditional mirror” to disclose the Double Distance, Same Size Requirement. Indeed, the Petition does not discuss the Double Distance, Same Size Requirement or anything similar in connection with limitation 1[c], reciting “it appears to mimic a reflection of a mirror”.

Similarly, Petitioners contend for the first time that a POSITA would find it obvious to modify *Rosenberg/Nakazawa* to add the Double Distance, Same Size Requirement, *e.g.*, contending that “[e]ven if the Board adopts this construction, the Petition and evidence demonstrate *Rosenberg* and *Nakazawa* render obvious this

limitation” (Reply at 9); and “*Rosenberg* and *Nakazawa* therefore render obvious ‘mirror mimicking,’ even under the magistrate judge’s construction” (Reply at 12). Petitioners never made such an argument in the Petition. And the Reply repeatedly relies on self-serving deposition testimony inserting new opinions addressing the same topics which are nowhere in Dr. Karam’s first Declaration. *See* Reply at 5, 10, 11, 12, 13, 14, 16, 17, 18.

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 they **chose** not to address, despite knowing their position in the district court prior to Institution. Moreover, *Axonics* does not authorize a petitioner to rely on additional prior art, such

as art supplying the missing purported “background knowledge” of a POSITA, to teach a claim limitation, as Petitioners do here: “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 specific optical properties required by the Double Distance, Same Size Requirement. *See* Petition (Paper 1) (“Petition”) at 21-26. Petitioners’ new arguments for how the Asserted Grounds meet their own construction should be stricken. 37 C.F.R. § 42.22(a)(2); 37 C.F.R. § 42.23(b).

B. Petitioners’ Reliance on Entirely New Opinions From Dr. Karam’s Deposition Should be Stricken

In support of their untimely new arguments, Petitioners rely on completely new opinions offered for the first time by Dr. Karam in her deposition that were not included in the Petition or in her Declaration (Ex.1004). *See* Reply at 5, 10, 11, 12, 13, 14, 16, 17, 18. The portions of Dr. Karam’s testimony offering such opinions (and Sections III.A.1-III.A.3 of Petitioners’ Reply that rely on them) should be stricken. *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”).

For example, as discussed above, in their Reply, Petitioners assert, for the first time, that “*Rosenberg* and *Nakazawa* therefore render obvious ‘mirror mimicking,’ even under the magistrate judge’s construction” (Reply at 12) based on Dr. Karam’s new opinions from her deposition testimony because, Petitioners assert: “According to Dr. Karam, if the art replicates the conventional mirror, a POSITA would have understood it provides the reversed, double-distance, same-size features.” (Reply at 11 (citing Ex.2012 at 47:1-52:2, 84:11-88:21, 254:3-255:8, 105:5-110:2)) and “[a] POSITA would have understood these transformations achieve the double-distance/same-size features of conventional mirrors.” (Reply at 12 (citing Ex.2012 at 53:12-54:8, 59:7-60:20, 74:24-75:13, 83:1-16, 106:20-107:16, 220:21-221:1, 229:2-17)). But Dr. Karam did not opine in her Declaration that a POSITA’s knowledge of the conventional properties of a mirror as described in background art showed that a POSITA would understand *Rosenberg* and *Nakazawa* to disclose or render obvious the Double Distance, Same Size Requirement in limitation 1[c]. Nor did she opine that a POSITA would find it obvious to add those requirements, based on their knowledge. She opined only that “*Rosenberg* in view of *Nakazawa* renders obvious this claim limitation,” without any discussion of the Double Distance, Same Size Requirement or how and whether a POSITA’s knowledge would supply it. *See* Ex. 1004, ¶124. It was only in her deposition that she asserted for the first time that the background section of her Declaration shows these things.

Q: You didn't apply the specific claim construction in offering your opinions in your declaration in the 109 IPR; is that correct?

A: I did apply – this is consistent with my declaration, and I do have the background – you can look at the background in my 109 declaration. It illustrates this.

Ex.2012 at 48:21-49:4; *see also, e.g., id.* at 50:5-51:15, 189:20-109:1. But nowhere in Dr. Karam's Declaration does she discuss Petitioner Samsung's proposed construction let alone opine that her opinions or the understanding of a POSITA is consistent with it.

Additionally, Dr. Karam asserted for the first time in her deposition that a POSITA would understand that the plain and ordinary meaning of “appears to mimic a reflection of a mirror” encompasses the construction that Petitioner Samsung argued for and ultimately obtained in district court, which Petitioners rely on.

Q. And Samsung's particular construction, and the construction that was adopted in the district court litigation, that specific construction is not part of your declaration in the 109 IPR; is that correct?

A: This is not correct. I disagree. As I showed you, I mean, my opinions are consistent also with this claim construction too. It doesn't change that. I mean, it encompasses this, and a POSITA would understand that. And I showed you the Background section, also, illustrating that based on prior art.

Ex.2012 at 85:1-15; *see also, e.g.*, 51:19-52:2. But nowhere in Dr. Karam’s Declaration does she discuss Petitioners’ own construction, let alone opine that it is consistent with how a POSITA would understand the prior art. This 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 added limitations”) (emphasis in original). Like the *Haag-Streit* Petitioner, Petitioners here do “not seek to *formally* change the asserted ground at issue to add [reference], with the discussion in the Reply summarized above (and the related testimony of [Petitioner’s expert], Petitioner improperly seeks to rely on [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.* at 6 (emphasis in original).

Any assertion that Patent Owner’s arguments regarding the construction of “it appears to mimic a reflection of a mirror” 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 their original arguments and opinions with respect to “mimic a mirror” are in fact consistent with the construction in the district court. Reply at 5, 13. *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 “mimic a mirror” and was never previously addressed – but if it were so, there would be no need to 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.”).

III. CONCLUSION

For all the foregoing reasons, the Board should strike as untimely and improper: (1) the following portions of Petitioners’ Reply (Paper 26) advancing previously undisclosed theories, arguments, and evidence: Sections III.A.1, III.A.2, III.A.3; and (2) the portions of Dr. Karam’s deposition offering new opinions and theories with respect to the 109 Patent.

Dated: August 21, 2025

Respectfully submitted.

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

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