

Filed: September 4, 2025

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.

Case No. IPR2024-00856¹
U.S. Patent No. 8,982,109 B2

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

¹ The petitioner in IPR2025-00297 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, and the cited testimony all finds its basis in the Petition and original expert declaration submitted with the Petition. Accordingly, the Reply arguments are not new, and at most properly elaborate on arguments already found in the Petition. Even if the Board were to conclude that the Reply arguments are new, they are properly of record because they 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 deposition testimony should be stricken because it failed to identify the passages it seeks to strike, much of the cited testimony does not reference the magistrate judge’s recommended construction, and Patent Owner elicited Dr. Karam’s testimony and never objected to her responses, thus waiving its current objections.

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

The Petition demonstrates how the Rosenberg/Nakazawa combination

discloses the claimed “mirror mimicking” 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 (Claim Construction Order), 19.

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 ’109 patent admits were known, are taught by Rosenberg. Ex. 1001 (’109 Patent), 2:19-27, 23:60-24:3; Ex. 1004 (Karam Decl.), ¶¶ 42-43. 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.), ¶¶ 67-69; *see also* Ex. 1046 (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, 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 Rosenberg discloses the first feature—a reversed reflection. *See, e.g.,* POR (Paper 22), 30 (agreeing that “Rosenberg repeatedly describes a standard or traditional mirror as simply one that inverts the user’s image.”); *see also* Pet. (Paper 1), 21.

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 Rosenberg “scales” the image, causing the subject’s size and distance to appear as though the subject is viewing a mirror. For example, in relation to disputed limitation 1[c], the Petition explains that “Rosenberg discloses flipping video images about a vertical axis and *scaling them so the user has the impression of viewing a mirror* (‘mimic a reflection of a mirror’).” Pet., 21 (emphasis added). This refrain is repeated elsewhere, including in the following passages.

- “In its digital-mirror state, Rosenberg’s camera captures real-time video images, which are left-right inverted and scaled to give the user the impression of standing before a mirror” Pet., 10.

- “In traditional-mirror mode, Rosenberg’s system . . . scales the image; and (iv) displays the image so the user ‘is given the visual impression’ of ‘standing before a traditional wall mirror.’” Pet., 19.
- “A POSITA would have understood Rosenberg’s scaling would have adjusted the size of the image (‘resizing the image’) to mimic a mirror reflection even if the size of the image from the camera would vary with the user’s distance to the camera” Pet., 26.
- “Rosenberg displays real-time video images after performing left-right inversion (‘flipping’) and scaling/zooming (‘resizing’)” Pet., 27.
- “Rosenberg’s processor . . . performs . . . left-right inversion (‘flipping’), scaling (‘resizing’), and displaying the modified images in real-time to give the impression of ‘standing before a traditional wall mirror’ (‘displaying’).” Pet., 29.

It is difficult to imagine how the Petition’s scaling/resizing discussion 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 in support of their Reply arguments. Reply (Paper 26), 9-18 (citing the Petition 15 times in the sections Patent Owner seeks to exclude). It is also why, during her deposition, Dr. Karam repeatedly pointed

Patent Owner to her declaration that accompanied the Petition. *See, e.g.*, Ex. 2012 (Karam Tr.), 47:1-52:2, 72:9-24, 85:13-87:25, 104:19-106:13, 107:24-112:14 (Dr. Karam referring to her Petition declaration discussing how the prior art discloses these known features of mirror images).

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.

Patent Owner hopes to persuade the Board that because the exact words of the magistrate judge’s recommended construction are not in the Petition, the Petition must not address the substance of the recommended construction, and the arguments in the Reply must be new. *See, e.g.*, POR, 23 (referring to “a simple word search of the Petition and expert declaration”). But the Board has correctly rejected similar arguments that place form over substance and would require reciting “magic words” in a petition.

For example, in *Meta Platforms, Inc., v. Wrinkl, Inc.*, the patent owner argued that the phrase “quoted message identifier” did not appear in the petition and that the Board should strike the petitioner’s reply arguments. IPR2021-00882, Paper 42 at 13 (P.T.A.B. Nov. 23, 2022). The Board rejected this argument, stating that “[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.” *Id.* The Board denied the motion to strike, finding that “these arguments properly elaborate on the Petition, in response to the proposed construction of ‘link’ in Patent Owner’s Response.” *Id.*

Here, too, the arguments in the Reply at most elaborate on the arguments in the Petition. *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019) (“Parties are not barred from elaborating on their arguments on issues previously raised.”). The grounds remain unchanged, Petitioners do not rely on any new prior art, and the cited testimony all finds its basis in the Petition and original expert declaration. This alone is sufficient to deny Patent Owner’s motion to strike.

III. Petitioners Are Entitled to Address the Claim Constructions Proposed 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 consistent with Phillips.” Pet., 8. This remains true. *See* Reply, 6-8. While Patent Owner attempts to cast the magistrate judge’s recommended construction as “substantially narrow[ing]” the claims (Patent Owner’s Motion to Strike (Paper 36), 9), this view is at odds with Patent Owner’s own expert’s testimony, which confirms that

conventional mirrors possessed all the listed features, so no narrowing has occurred. Ex. 2013 (Forsyth Decl.), ¶¶ 67-69; *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 Rosenberg, Patent Owner argues that the claims require a “difficult,” “complex,” or “unconventional” transformation to “convincingly mimic[] a conventional mirror,” or “detailed 3D geometric information.” POR, 30, 31; Ex. 2013, ¶¶ 66, 74, 439-441; *but see* Ex. 1046, 56:7-64:19 (Dr. Forsyth admitting that the transformation does not use 3D geometric information). 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, 19 (“the same construction should be adopted here”), *with* Patent Owner’s Preliminary Response (Paper 12), 13 (“Patent Owner does not believe that resolution of any claim construction issue is necessary at this time”).

When a patent owner urges the Board to adopt a construction that the petitioners believe is unnecessary, and especially when a patent owner attempts to further narrow that construction through its arguments, the petitioners are entitled to respond. *See, e.g., Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1384 (Fed. Cir. 2023) (“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”); *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 36, 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 to the facts 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.

Finally, 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 when it filed 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 12, 13; Ex. 2008; POR, 15-32, 37-41, 50-52. It also devoted much of its Patent Owner Sur-Reply to it. *See* Sur-Reply (Paper 32), 1-18. Given that the claim construction issue has been amply briefed, there is no prejudice to Patent Owner.

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

Patent Owner never mentions that it was Patent Owner who elicited Dr. Karam's testimony by introducing the magistrate judge's claim construction 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 from Patent Owner. 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, it is unclear which testimony Patent Owner seeks to strike. Patent Owner states that it seeks to strike “the portions of Dr. Karam’s deposition relied upon by Petitioners offering new opinions and theories as to the 109 Patent,” (Paper 36, 1), but it never identifies which passages it contends meet this description. We should not be left to guess which passages Patent Owner seeks to strike.

Indeed, many passages of Dr. Karam’s testimony cited in Petitioners’ Reply are about how Rosenberg discloses mimicking a mirror as explained in her declaration, without regard to how its disclosure relates to the magistrate judge’s recommended construction. For example, Dr. Karam’s testimony (Ex. 2012) at 49:6-23 discusses the background section of her declaration, 53:12-54:8 discusses Rosenberg’s digital mirror system as discussed in paragraph 71 of her declaration, 59:7-60:20 discusses how Rosenberg discloses emulating a traditional life-size mirror, and 74:24-75:13 and 83:1-16 discuss Rosenberg’s image scaling as discussed in the Petition and in her declaration. *See supra* Section II. If Patent Owner actually seeks to strike every passage cited in Sections III.A.1, III.A.2, and III.A.3 of Petitioners’ Reply, the request is overly broad and the Board should not sustain it.

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, 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 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.

John Pierce
john.pierce@tensegritylawgroup.com

Matthew D. Powers
matthew.powers@tensegritylawgroup.com

William P. Nelson
william.nelson@tensegritylawgroup.com

Natasha M. Saputo
natasha.saputo@tensegritylawgroup.com
eyesmatch_team@tensegritylawgroup.com

Date: September 4, 2025

By: /Lisa C. Hines/
Lisa C. Hines
Case Manager
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP