UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation,
Petitioner,

v.

EyesMatch Ltd.,
Patent Owner.

Case No. IPR2025-00297

Patent No. 8,982,109

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)

I. INTRODUCTION

Petitioner moves the Patent Trial and Appeal Board ("Board") for joinder of this *inter partes* review (Case No. **IPR2025-00297**), "Microsoft IPR") to a recently instituted *inter partes* review case filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (collectively "Samsung") and Google LLC ("Google") (Case No. **IPR2024-00856**, "Samsung IPR"). The Microsoft IPR is concurrently filed with this motion and is intentionally identical to the Samsung IPR in all substantive aspects. Both seek *inter partes* ("IPR") review of claims 1-18 (the "Challenged Claims") of EyesMatch Ltd.'s ("Patent Owner" or "PO") U.S. 8,982,109 (the "'109 Patent"). Further, the Microsoft and Samsung IPRs rely upon the same analytical framework (*e.g.*, same expert declarant and prior art) in addressing the Challenged Claims. Accordingly, resolving the Microsoft and Samsung IPRs will necessarily involve considering the same issues by all parties and the Board.

Petitioner is filing this petition and joinder motion to ensure that the instituted trial is completed if the petitioners in the Samsung IPR reach a settlement with the PO or if they otherwise cease to participate. Joinder of these proceedings also presents the best opportunity to secure the just, speedy, and inexpensive resolution of the related proceedings without any prejudice to the PO. This includes consolidated filings and discovery and eliminating the duplicate hearings

and briefing that might otherwise be required. Joinder should also provide for case-management efficiencies for the Board.

Given the similarities of the proceedings and the efficiencies realized via joinder, Petitioner respectfully requests that the Board join the Microsoft IPR with the Samsung IPR.

II. BACKGROUND

Samsung and Google filed a petition requesting *inter partes* review of the ’109 Patent on May 29, 2024. Samsung IPR, Paper 1.

Patent Owner has asserted the ’109 Patent in (1) *EyesMatch Ltd. v. Facebook, Inc.*, No. 1:21-cv-00111-RGA-JLH (D. Del.) (settled); and (2) *EyesMatch Ltd. v. Samsung Electronics America, Inc.*, No. 2:23-cv-00363-JRG-RSP (E.D. Tex.) (pending).

III. LEGAL STANDARD

When more than one petition for *inter partes* review of the same patent is properly filed and those petitions warrant institution, the Board has the authority and discretion to join the proceedings. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). Joinder of one *inter partes* review with another *inter partes* review is appropriate where it secures the just, speedy, and inexpensive resolution of the *inter partes* review proceedings. *See* 37 C.F.R. § 42.1(b).

A petitioner may request joinder, without prior authorization, up to one

month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b) (addressing timing to request joinder); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-782, Paper 5 at 3 (May 29, 2014) (prior authorization not required before one month deadline). Typically, such a joinder request: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; and (3) explains what impact (if any) joinder would have on the trial schedule for the existing review. *See, e.g., Microsoft Corp. v. IPR Licensing, Inc.*, IPR2015- 00074, Paper 21 at 4 (Mar. 4, 2015). A joinder request can additionally address specifically how briefing and discovery may be simplified. *See, e.g.*, *Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 3 (Sep. 16, 2013); *Fujitsu Semiconductor Ltd. v. Zond, LLC*, IPR2014-00845, Paper 14 at 304 (Oct. 2, 2014).

Petitioner next addresses each of these points in turn below.

IV. ANALYSIS

Given that the *inter partes* review of the '109 Patent was instituted based on the Samsung IPR, Petitioner respectfully requests that the Board grant this motion for joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

A. This Joinder Motion Is Timely

This motion is timely. Under 37 C.F.R. § 42.122(b), joinder can be

requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. *Taiwan Semiconductor*, IPR2014-00781 and IPR2014-782, Paper 5 at 3. Because this motion is being filed within one month after the Board's decision instituting trial in the Samsung IPR (December 3, 2024), it meets the timing requirements of § 42.122(b). *See, e.g.*, *Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. Joinder Is Appropriate

Joinder of the Microsoft IPR with the Samsung IPR is the most practical way to secure the just, speedy, and inexpensive resolution of these related proceedings. *See* 37 C.F.R. § 42.1(b). The petition in the Microsoft IPR is intentionally identical to the petition in the Samsung IPR in all substantive aspects.[1] That is, the same claims are challenged (1-18 of the '109 patent) based on the same prior art under the same grounds. The same expert declarant is used, and the expert's declarations in the two cases are substantively identical. Further, unity of exhibits and exhibit numbering (particularly with respect to prior art) with the Samsung IPR have also been maintained, with only non-substantive minor exceptions such as to the exhibit

[1] Minor changes were made to the Petition to properly identify the Petitioner, and to address discretionary-denial issues.

stamps. Accordingly, resolving the Microsoft IPR and Samsung IPR will necessarily involve considering the same issues and same papers. Joining these *inter partes* reviews thus presents an opportunity to streamline review of the '109 Patent's Challenged Claims and eliminate unnecessary duplication of filings, papers, and efforts of the Petitioner, the PO, and the Board. On the other hand, if the Microsoft IPR and Samsung IPR proceed separately, duplicate effort could result. Petitioner's counsel reached out to respective counsel for Samsung and Google to confirm their non-opposition to this joinder request. Samsung and Google (via their respective counsel) agreed to not oppose this joinder request.

C. No New Grounds of Unpatentability

The Microsoft IPR raises no new grounds of unpatentability from those raised in the Samsung IPR. This is because, as noted above, the petitions and expert declarations in the Microsoft IPR and Samsung IPR are substantively identical.

D. No Impact on IPR Trial Schedule

This motion is being filed after the Board's institution decision on the Samsung IPR, and Petitioner has agreed to adhere to all applicable deadlines set forth in the Samsung IPR Scheduling Order. Accordingly, the trial schedule for the Samsung IPR should not be adversely affected.

Moreover, as discussed below, Microsoft is willing to limit its participation in the proceeding as a "silent understudy" to Samsung, only assuming an active

role in the event that the petitioners there cease active participation. Microsoft does not anticipate that any extension of the trial schedule will be required as a result of joinder.

E. Consolidated Filings and Discovery

As a "silent understudy," Microsoft agrees that, if joined, the following conditions will apply so long as Samsung and Google remain active parties, as previously approved by the Board in other joinder circumstances:

(a) All filings by Microsoft in the joined proceeding will be consolidated with the filings of Samsung and Google, unless a filing solely concerns issues that do not involve Samsung and Google;

(b) So long as Samsung and Google remain active participants, Microsoft shall not be permitted to raise any new grounds not instituted by the Board in the Samsung IPR or introduce any argument not introduced by Samsung and Google; and

(c) With regard to taking of testimony, Microsoft will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Samsung and Google concerning the provision of testimony. *See DRL Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5–6 (PTAB Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not

require introducing any additional arguments, briefing, or discovery."). Microsoft is also willing to abide by any additional conditions that the Board deems appropriate.

F. Joinder Will Streamline the Proceedings and Result in No Prejudice to Patent Owner

Joinder will streamline the proceedings and reduce the costs and burden on Petitioner, PO, and the Board. Joining these proceedings will eliminate duplicate papers that must be filed, reviewed, and managed in each proceeding if the proceedings are not joined. Joinder will therefore also create case-management efficiencies for the Board and all parties. Further, joinder will also reduce by half the time and expense for depositions and other discovery that would otherwise accompany separate IPR proceedings. As such, joinder will simplify briefing and discovery, without any foreseeable prejudice to PO.[2]

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board

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[2] The argument that joinder may theoretically frustrate settlement between any particular petitioner and Patent Owner is not a basis to deny joinder because that same possibility exists in every joinder situation. *Global Foundries U.S. Inc. v . Godo Kaisha IP Bridge 1*, IPR2017-00925 and IPR2017-00926, Paper 13 at 10 (June 9, 2017).

institute its Petition for *Inter Partes* Review of U.S. Patent No. 8,982,109 and grant joinder of the Microsoft IPR with the Samsung IPR.

Dated: December 20, 2024 Respectfully submitted,

/ Alexander B. Stein /

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, lead counsel for Petitioner hereby certifies that on December 20, 2024, a copy of the foregoing PETITIONER'S MOTION FOR JOINDER was sent via Priority Mail Express to the correspondence address of record for the '109 patent:

Womble Bond Dickinson (US) LLP
ATTN: IP Docketing
P.O. Box 570489
Atlanta GA 30357-0037

Womble Bond Dickinson (US) LLP
ATTN: IP Docketing
P.O. Box 7037
Atlanta GA 30357-0037

A courtesy copy of this PETITIONER'S MOTION FOR JOINDER was also served via email on December 20, 2024 on Patent Owner's counsel of record in *EyesMatch Ltd. v. Samsung Electronics Co.*, No. 2-23-cv-00363 (E.D. Tex.):

josh@joshmaness.com;
kurt@truelovelawfirm.com;
natasha.saputo@tensegritylawgroup.com;
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Dated: December 20, 2024

Respectfully Submitted,

/ Alexander B. Stein /
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