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Eye-Sensor Patent Owner Slams Samsung Over Late AIA Move

By **Jimmy Hoover**

Law360, Washington (April 27, 2016, 4:42 PM ET) -- An Ontario college pummeled Samsung before the Patent Trial and Appeals Board Wednesday for bringing up late invalidity arguments attacking the school's eye-sensor patents in an America Invents Act review, telling a panel the move puts it at a serious disadvantage with little means to respond.

During a marathon hearing at the board, Queen's University accused Samsung Electronics Co. Ltd. of raising a handful of never-before-heard prior art theories in its reply brief, most of which it was unable to respond to in a surreply.

On behalf of Queen's, Robert Sterne of Sterne Kessler Goldstein & Fox PLLC argued that the tech giant's foul play amounted to "very real violations of the spirit and the intent of these proceedings," referring to the inter partes regime established by the AIA as an alternative to federal district court litigation.

"We cannot as patent owners deal with this type of process," Sterne said. "How do we defend our claims? These are valuable claims."

Arguing for Samsung, W. Karl Renner of Fish & Richardson PC offered a swift rebuttal to the allegations Wednesday, explaining that the company had merely sought to offer a "fuller picture" of the record following the university's patent owner response, which he said gave "interpretations of the intrinsic record that were believed to be wrong."

Renner said they were virtually compelled to respond to the college's "partial view" of the record.

"Are you to not give evidence to the record to make sure it's complete? We believe that you should."

"There's no injustice here," he added, referring to the limited scope to which Queen's was bound in their surreply. "There's nothing unfair."

In consolidated IPRs, Samsung has challenged the validity of four patents it was accused of infringing in Texas federal court for its Galaxy S4 and Galaxy Note 3 smartphones, which utilize eye-sensor technology that base computer actions — such as scrolling or pausing — on user eye movement.

According to Samsung, the technology is unpatentable in view of several prior art references known as "Goldstein," "Ho" and others, which the company says previously disclosed all of the elements of the challenged claims.

Samsung opened its arguments to the board Wednesday, countering defenses proffered by Queen's that the prior art references do not include critical technological specifications, or limitations, that are included in the patents.

As to one limitation that the sensor must be located in or on the controlled device, Renner said "the record demonstrates sufficient information that the prior art meets this limitation in Goldstein and Ho."

Regarding the university's assertion that the prior art fails to cover a system that has "immediacy" or "instantaneousness" in response to eye movement, Renner insisted that "the claim is not encumbered with such a limitation," as Queen's has "no basis" to sustain such a construction.

Sterne shot back, saying that the board should be "very concerned" about using hindsight to render invalid a "very elegant invention."

"It's very easy to fall into this hindsight mindset where you say, 'Oh, I could have thought of that,'" Sterne said.

He argued to the board that there was "no express disclosure" of the sensor location limitation in any of the prior art references and, as a result, "Samsung here has not met it's burden of proof" for anticipation.

The allegedly anticipating technology, Sterne said, is "like three times the size of a movie device … it doesn't unequivocally disclose that [the sensor is] right next to the screen like petitioners have argued."

"We have to look at today's technology, where you have pinhole cameras you can put anywhere on the device."

On the instantaneous limitation, Sterne's co-counsel Michelle K. Holoubek argued that the whole point of the patents were to immediately "modulate" a device to an action like scrolling, or pausing in response to a diversion of attention, while the asserted prior art simply measures a "series of inputs" to determine a user's concentration.

Sterne also made arguments surrounding the "objective indicia" of non-obviousness, describing Samsung's alleged repeated interest in collaborating with the inventor of the patents before abandoning the talks and developing their allegedly infringing smartphones.

The patents-in-suit are U.S. Patent Nos. 8,672,482; 8,322,856; 8,096,660; and 7,762,665.

Samsung is represented by W. Karl Renner and Jeremy J. Monaldo of Fish & Richardson PC.

Queen's is represented by Robert G. Sterne, Michelle K. Holoubek, Mark Consilvio and Lestin Kenton of Sterne Kessler Goldstein and Fox PLLC.

The cases are Samsung Electronics Co. Ltd. v. Queen's University, IPR numbers 2015-00583, 2015-00584, 2015-00603, 2015-00604, before the U.S. Patent Trial and Appeals Board.