

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADLENS USA, INC. AND ADLENS, LTD.,
Petitioner,

v.

SUPERFOCUS HOLDINGS LLC, SUPERFOCUS, LLC,
INSOLVENCY SERVICES GROUP, INC., AND
DR. STEPHEN KURTIN,
Patent Owner.

Case IPR2015-01821
Patent 8,967,797 B2

Before GRACE KARAFFA OBERMANN, *Vice Chief Administrative
Patent Judge*, LORA M. GREEN and ELIZABETH M. ROESEL,
Administrative Patent Judges.

ROESEL, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318 and 37 C.F.R. § 42.73

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Adlens USA, Inc. and Adlens, Ltd. (“Petitioner”) challenge the patentability of claims 1–17 of U.S. Patent No. 8,967,797 B2 (Ex. 1001, “the ’797 Patent”), owned by Superfocus Holdings LLC, *et al.* (“Patent Owner”).¹

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–12 and 14–17 of the ’797 Patent are unpatentable.

I. BACKGROUND

A. *Procedural History*

On August 26, 2015, Petitioner filed a Petition requesting *inter partes* review of claims 1–17 of ’797 Patent. Paper 2 (“Pet.”). On December 18, 2015, Patent Owner filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

On February 17, 2016, we instituted *inter partes* review of claims 1–12 and 14–17. Paper 10 (“Decision to Institute” or “Dec.”).

On May 16, 2016, Patent Owner filed a Patent Owner Response. Paper 16 (“PO Resp.”) On August 12, 2016, Petitioner filed a Reply to Patent Owner’s Response. Paper 22 (“Pet. Reply”).

Petitioner submitted a Declaration of Dr. Nickolaos Savidis with the Petition. Ex. 1003. Patent Owner cross-examined Dr. Savidis on April 19,

¹ Patent Owner identifies the following parties as comprising Patent Owner: Superfocus Holdings LLC; Superfocus, LLC; Insolvency Services Group, Inc., solely in its capacity as Assignee for the benefit of creditors of Zoom Focus Eyewear, LLC; and Dr. Stephen Kurtin. Paper 13.

2016, and filed a transcript of the deposition testimony as Exhibit 2003. Patent Owner submitted a Declaration of William T. Plummer, Ph.D, with the Patent Owner Response. Ex. 2002. Petitioner cross-examined Dr. Plummer and filed a transcript of the deposition testimony as Exhibit 1015.

Petitioner submitted a Second Declaration of Dr. Nickolaos Savidis with the Reply. Ex. 1014. Patent Owner cross-examined Dr. Savidis on September 14, 2016 and filed a transcript of the deposition testimony as Exhibit 2006. On September 19, 2016, Patent Owner filed a Motion for Observation regarding the Cross-Examination of Dr. Savidis. Paper 30. On October 3, 2016, Petitioner filed a Response to Patent Owners' Motion for Observation regarding the Cross-Examination of Dr. Savidis. Paper 32.

An oral hearing was held October 31, 2016. A transcript of the hearing was entered in the record. Paper 41 ("Tr.").

B. Related Proceedings

The parties state that the '797 Patent was asserted in *Superfocus Holdings LLC v. Adlens USA, Inc.*, No. 1:14-cv-14189 (D. Mass.), which was filed on November 18, 2014 and dismissed without prejudice on March 11, 2015. Pet. 1–2; Paper 13.

The '797 Patent is a continuation of and claims priority to the application that issued as U.S. Patent No. 8,708,487 B2 (Ex. 1002), which is the subject of co-pending IPR2015-01824 between the same parties.

C. The '797 Patent (Ex. 1001)

The '797 Patent discloses variable focus spectacles (eyeglasses) in which each eye's lens can be adjusted independently of the other eye's lens. Ex. 1001, Title, Abstract, 1:56–58. The '797 Patent describes the invention

in connection with variable focus spectacles and lenses of the type disclosed in Kurtin '532,² which is incorporated by reference in the '797 Patent. *Id.* at 1:59–61, 1:66–67, 2:13–30, 3:36–39. Such lenses include a rigid lens, a distensible membrane, and a transparent liquid filling a space between the rigid lens and membrane. *Id.* at 2:13–17. The rigid lens and membrane are each held by rings spaced from one another and joined by a flexible sealing member, which keeps the liquid from escaping and allows the inter-ring spacing to be varied, thereby causing the membrane to bulge or recede and changing the optical power of the lens. *Id.* at 2:17–20, 2:24–28. According to the '797 Patent, Kurtin '532 discloses a bilateral adjustment using an actuator within the bridge of the eyeglasses, while the inter-ring spacing at a point substantially opposite the bridge is set by a leaf hinge. *Id.* at 2:1–9, 2:20–24.

In the invention of the '797 Patent, the leaf hinge of Kurtin '532 “is replaced by a hinge means with controllable axial length ('H/CAL') which can be manually set by the wearer.” *Id.* at 2:31–33; *see also* 3:52–55. The H/CAL, also referred to as a “fluctuating vision compensation mechanism,” allows the inter-ring spacing and optical power of each lens of the eyeglasses to be adjusted for each eye separately. *Id.* at 2:33–48, 3:4–9.

The variable focus spectacles are shown in Figures 1–3 of the '797 Patent, reproduced below:

² Kurtin, US 2008/0084532 A1, published April 10, 2008 (“Kurtin '532”).

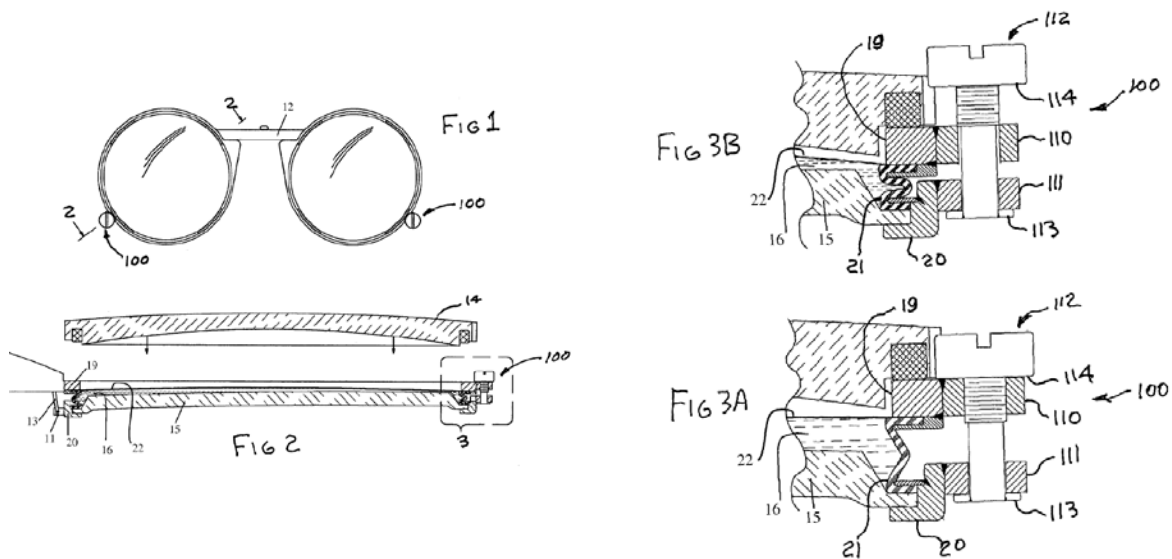


Figure 1 shows a front view of a pair of eyeglasses. *Id.* at 3:23–24. Figure 2 shows a cross-sectional view of one lens unit, and Figures 3A and 3B show an enlarged view of the H/CAL adjustment mechanism set to provide minimum and maximum optical power, respectively. *Id.* at 3:25–31, 3:60–62.

As shown in Figures 1–3, the eyeglasses include bridge 12, and each lens unit includes rear lens 15, transparent optical liquid 16, front ring 19, rear ring 20, bellows 21, and distensible membrane 22. According to the '797 Patent, each of these components is disclosed in Kurtin '532 with the same identification numbers, and components added by the '797 Patent are given numbers over 100. *Id.* at 3:36–39.

Figure 1 shows two “fluctuating vision compensation mechanisms 100” in a pair of variable focus spectacles. *Id.* at 3:50–52. As shown in Figures 3A and 3B, each mechanism 100 includes tab 110 attached to front ring 19 and tab 111 attached to rear ring 20, each tab having a hole to receive controllable spacing screw 112 having head 114 and retainer 113 to keep the screw from coming out of tab 111. *Id.* at 3:63–4:11. The hole in

tab 110 is tapped (threaded), such that rotation of screw 112 adjusts the distance between front ring 19 and rear ring 20 at the location of mechanism 100. *Id.* at 3:65–67, Figs. 3A, 3B.

D. Illustrative Claim

The '797 Patent includes 17 claims, of which claims 1, 3, 9, and 15 are independent. Claim 1 is reproduced below with bracketed lettering and paragraph breaks added to correspond to Petitioner's contentions:

1. [a] Variable focus spectacles comprising first and second lens units, each lens unit comprising:
 - [b] a transparent member;
 - [c] a membrane support structure, having an opening therein, being disposed adjacent to and within a field of view of the transparent member,
 - [d] the membrane support structure being manually movable by a wearer of the variable focus spectacles to change a distance between the membrane support structure with respect to the transparent member at one location around a periphery of the membrane support structure,
 - [e] while at another location around the periphery of the membrane support structure, a distance between the membrane support structure and the transparent member is maintained substantially constant;
 - [f] a transparent membrane attached to the membrane support structure across the opening;
 - [g] a flexible seal extending between the transparent member and the membrane support structure, the flexible seal permitting motion between the transparent member and the membrane support structure; and
 - [h] liquid having a predetermined index of refraction substantially filling a space between the transparent member and the membrane support structure within the seal,

[i] wherein the membrane support structures of the first and second lens units are independently moveable by the wearer to independently change the respective distances between the respective membrane support structures with respect to the corresponding transparent members at the respective one locations.

Ex. 1001, 4:40–5:2. Claims 3, 9, and 15 of the '797 Patent each recites limitations identical to paragraphs [a], [b], [c], [f], [g], and [h] of claim 1 and limitations similar to, but not the same as, paragraphs [d], [e], and [i] of claim 1. See Ex. 1009 ('797 Independent Claims – Comparison).

E. Petitioner's Asserted References

Petitioner's patentability challenges are based on the following references:

Reference	Patent/Publication No.	Date	Exhibit
Gordon	US 1,269,422	June 11, 1918	1013
Kurtin et al. ("Kurtin '629")	US 5,371,629	Dec. 6, 1994	1012
Cronin et al. ("Cronin")	US 5,526,067	June 11, 1996	1011
Kurtin ("Kurtin '532")	US 2008/0084532 A1	Apr. 10, 2008	1004

F. Instituted Grounds

Whether claims 1–12 and 14–17 are unpatentable under 35 U.S.C. § 103(a) as obvious over Kurtin '532 and Kurtin '629 in view of Gordon and/or Cronin; and

Whether claims 3–12 and 14–17 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Cronin.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, we generally give claim terms their ordinary and customary meaning, as understood by a person of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). “Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification . . . when [it] expressly disclaim[s] the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We construe claim terms only to the extent necessary to resolve the controversy. *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

1. “*manually movable*” (claim 1)
“*manually adjustable*” (claims 3 and 9)
“*manually operable*” (claim 15)

Patent Owner contends that each of these terms should be construed to mean “capable of being manually [moved / adjusted / operated] by a wearer of the spectacles.” PO Resp. 8.

Petitioner contends that Patent Owner’s proposed construction improperly incorporates an extraneous limitation—by a wearer—into the claims. Pet. Reply 3.

We agree with Petitioner. Claim 1 expressly recites “by a wearer” (Ex. 1001, 4:46), but there is no such limitation in any of claims 3, 9, or 15. Patent Owner identifies various specification passages discussing adjustment by a wearer or user. PO Resp. 8–9. None of these passages amounts to an express definition or disclaimer requiring that “by a wearer” be read into the claims not reciting that phrase. *Bigio*, 381 F.3d at 1325 (“[T]his court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages.”).

2. “*adjustable element*” (claim 3)
“*controllable spacing member*” (claim 15)

Patent Owner contends that each of these terms should be construed as means-plus-function elements under 35 U.S.C. § 112 ¶ 6. PO Resp. 10. Petitioner does not contest Patent Owner’s position. See Pet. Reply 4–5.

Our reviewing court instructs that “merely because an element does not include the word ‘means’ does not automatically prevent that element from being construed as a means-plus-function element.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc) (quoting *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed.Cir.1996)). “Generic

terms such as ‘mechanism,’ ‘element,’ ‘device,’ and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word ‘means’ because they ‘typically do not connote sufficiently definite structure’ and therefore may invoke § 112, para. 6.” *Id.* at 1350.

We agree with Patent Owner that the terms, “adjustable element” (claim 3) and “controllable spacing member” (claim 15), should be construed as means-plus-function terms. The words “element” and “member” are the same as or similar to the words the Federal Circuit indicated are “tantamount to using the word ‘means.’” *Williamson*, 792 F.3d at 1350. Dr. Savidis agrees that the terms, “adjustable element” and “controllable spacing member,” do not define a particular structure. Ex. 2003, 76:4–21, 77:1–7, 80:8–17. Accordingly, we construe these terms in accordance with 35 U.S.C. § 112 ¶ 6.

Construing a means-plus-function claim term is a two-step process. We first identify the claimed function, and then we determine what structure disclosed in the specification corresponds to the claimed function. *Williamson*, 792 F.3d at 1351; *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc).

The parties agree that the recited function for “adjustable element” in claim 3 is:

“allowing adjustment of a distance between the transparent member and the membrane support structure at one location around a periphery of the membrane support structure while, at another location along the periphery of the membrane support structure, a distance between the transparent member and the membrane support structure is kept unchanged” in a way that is “manually adjustable independent of [the other adjustable

element] to allow independent adjustments of the respective distances between the respective transparent members and the corresponding membrane support structures at the respective one locations.”

PO Resp. 11–12 (quoting Ex. 1001, 5:11–40); *see also* Pet. Reply 4 (the recited functions are set forth on pages 11–12 of Patent Owner’s Response).

The parties agree that the recited function for “controllable spacing member” in claim 15 is:

“being operative to control a distance between the transparent member and the membrane support structure at one location along a periphery of the transparent member and the membrane support structure, while a distance between the transparent member and the membrane support structure at another location along the periphery of the transparent member and the membrane support structure is kept constant” in a way that is “manually operable independently of [the other controllable spacing member] to independently control the respective distances between the respective transparent members and the corresponding membrane support structures at the respective one locations.”

PO Resp. 12 (quoting Ex. 1001, 7:6–22); Pet. Reply 4.

The parties agree that the structure disclosed in the ’797 Patent Specification for performing each of these functions includes front tab 110, rear tab 111, and screw 112, as shown in Figures 3A and 3B. PO Resp. 12; Pet. Reply 5. Patent Owner’s identification of corresponding structure includes additional descriptions from the specification. PO Resp. 12–13. We see no need to include Patent Owner’s additional descriptions in the claim construction because they are inherent characteristics of a screw and

tabs and are not relied upon to distinguish the structures disclosed in Petitioner's references.³

Accordingly, we construe the terms, “adjustable element” (claim 3) and “controllable spacing member” (claim 15), as the combination of a front tab, a rear tab, and a screw and equivalents thereof. 35 U.S.C. § 112 ¶ 6; *Donaldson*, 16 F.3d at 1195.

B. Person of Ordinary Skill in the Art

We determine that a person of ordinary skill in the art would have an undergraduate degree in mechanical engineering or equivalent education and one to two years of experience with optics. Our determination is supported by the testimony of Dr. Plummer (Ex. 2002 ¶ 49), as well as the testimony of Dr. Savidis (Ex. 2003, 66:24–67:7, 67:16–20, 69:14–20).

We also rely on Petitioner's asserted references as establishing the level of skill in the art at the relevant time. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Based upon their stated qualifications, we consider both Dr. Savidis and Dr. Plummer qualified to opine from the viewpoint of a person of ordinary skill in the art regarding the subject matter of the '797 Patent. Ex. 1002 ¶¶ 5–11, Appendix A (Savidis CV); Ex. 2002 ¶¶ 9–22, Attachment A (Plummer CV).

³ The parties dispute whether the corresponding structure disclosed in the '797 Patent Specification includes a flexure. PO Resp. 13 (citing Ex. 1001, 4:34–37); Pet. Reply 5 n.3. It is not necessary for us to resolve this dispute because a flexure is not relevant to any ground of unpatentability raised in the Petition.

C. Obviousness

1. Kurtin '532 (Ex. 1004)

The disclosure of Kurtin '532 is discussed in Section I.C. As discussed above, the '797 Patent acknowledges that the invention is a modification of Kurtin '532 consisting of replacing the disclosed leaf hinge “by a hinge means with controllable axial length ('H/CAL') which can be manually set by the wearer.” Ex. 1001, 2:31–33; *see also id.* at 1:59–61, 3:52–55. The '797 Patent further acknowledges that Kurtin '532 discloses all elements of the invention, except for the H/CAL adjustment mechanism, also referred to as a “fluctuating vision compensation mechanism.” *Id.* at 2:13–40, 3:36–49.

2. Kurtin '629 (Ex. 1012)

Kurtin '629 discloses spectacles having variable focal length lenses including frame 10, rigid lens 12, membrane 15 attached at its periphery to membrane support 14, flexible seal 13 between the rigid lens and membrane support, and liquid 21 between the rigid lens and membrane. Ex. 1012, Abstract, Figs. 1–3, 3:10–33, 3:40–45. The optical power of the lenses is varied by turning nut 20, which is threaded on screw 21 and engages actuating tabs 19 of membrane supports 14, causing them to pivot relative to frame 10 via hinges 16 and pins 17 and causing membranes 15 to bulge or recede. *Id.* at Abstract, Figs. 2–3, 3:50–4:9.

3. Gordon (Ex. 1013)

Gordon discloses spectacles having adjustable focus lenses. Ex. 1013, Figs. I–IV, 1:9–23, 1:41–42. Gordon discloses a first embodiment shown in Figure I and a second embodiment shown in Figures II–IV. *Id.* at 1:30–52,

2:5–6. In both embodiments, the focus of each lens 7 can be adjusted by turning screw 5, which changes the diameter and circumference of the lens and causes lens side portions 8 to move toward or away from each other with the help of transparent liquid 11 that fills a pocket between side portions 8. *Id.* at Figs. I–IV, 1:67–80, 1:87–100, 2:5–22. In the Figure I embodiment, screw 5 connects ears 4 of lens frames 3 to bridge seats 4, and in the Figure II embodiment, screw 5 connects ears 12 of lens frames 3 to each other. *Id.* at Figs. I, II, and IV, 1:45–52, 2:5–19.

4. Cronin (*Ex. 1011*)

Cronin discloses variable focal length eyeglasses having a frame, a pair of lens assemblies, and an actuation mechanism. *Ex. 1011*, Abstract, 2:48–50, Fig. 1. Each lens assembly includes a rigid transparent substrate, a membrane support spaced from the rigid substrate, a flexible seal extending between the rigid substrate and the membrane support, a transparent elastomeric membrane sealed around its periphery to the membrane support, and a transparent liquid filling the space between the rigid substrate and the membrane forming a liquid lens. *Id.* at Abstract, 2:50–57. The actuation mechanism causes relative motion between the membrane and the rigid substrate so that both optical and prismatic power of the liquid lens changes by varying a force applied to the flexible seal along one section, while another section of the seal acts as a hinge. *Id.* at Abstract, 2:57–64.

In Cronin's disclosed embodiment, the actuation mechanism includes slider assembly 11. *Ex. 1011*, 4:66–5:1. When activated by either the left or right slider, slider assembly 11 adjusts the focus of both the left and right lens assemblies simultaneously. *Id.* at 5:25–36, 5:63–6:14. The actuation mechanism includes left and right lens actuators 4L and 4R having left and

right calibration screws 42L and 42R, respectively. Ex. 1011, 5:9–22. Screws 42L and 42R allow independent calibration (i.e., adjustment) of the focal length of the left and right lenses, respectively. *Id.* at 4:27–32, 5:9–22, 5:66–6:2, Figs. 2 and 4.

5. *Independent Claims*

Petitioner asserts that the subject matter of independent claims 1, 3, 9, and 15 would have been obvious to one of ordinary skill in the art based upon the disclosures of Kurtin '532 (Ex. 1004) and Kurtin '629 (Ex. 1012) in view of Gordon (Ex. 1013) and/or Cronin (Ex. 1011). Pet. 42–50 (claim 1), 51 (claim 3), 53–55 (claim 9), 57–59 (claim 15). Patent Owner disputes Petitioner's contentions. PO Resp. 36–74.

There is no dispute, and we find, that Kurtin '532 teaches all limitations of independent claims 1, 3, 9, and 15, except for the adjustment limitations.⁴ We base our finding on the arguments and evidence presented by Petitioner at pages 42–44, 51, 53, and 57–58 of the Petition, which we adopt as our own. Our finding is further supported by the '797 Patent, which describes the invention in connection with variable focus spectacles and lenses of the type disclosed in Kurtin '532 and indicates that components other than the fluctuating vision compensation mechanism are the same as disclosed in Kurtin '532. Ex. 1001, 1:59–61, 2:13–30, 3:36–39.

Petitioner contends that it would have been obvious to modify Kurtin '532 to provide independent adjustability of each lens, as taught by Gordon or Cronin, by replacing Kurtin '532's non-adjustable connector (leaf hinge

⁴ The adjustment limitations are recited in paragraphs [d], [e], and [i] of claim 1 and the corresponding paragraphs of claims 3, 9 and 15. See Ex. 1009.

23) with an adjustable connector, such as the screw, nut, and tab arrangement of Kurtin '629 or that arrangement modified by the screw and tabs taught by Gordon. Pet. 44–50. Petitioner contends that the proposed modification of Kurtin '532 would have resulted in variable focus spectacles satisfying the adjustment limitations of independent claims 1, 3, 9, and 15. *Id.* at 44–50, 51, 53–55, 57–59.

Patent Owner challenges the sufficiency of Petitioner's rationale for modifying Kurtin '532 and contends that the proposed modifications would render the spectacles of Kurtin '532 undesirable and inoperable for its intended purpose. PO Resp. 38.

We find that a person of ordinary skill in the art would have had a reason or motivation to modify the spectacles of Kurtin '532 to provide independent adjustability of each lens. Our finding is supported by the undisputed testimony of Dr. Savidis that “the desirability of having independently and manually adjustable, liquid filled, variable focus lenses was known in the art well prior to 2010.” Ex. 1003 ¶ 101. Our finding is further supported by Dr. Savidis' testimony that both Gordon (Ex. 1013) and Cronin (Ex. 1011) describe adjustable, liquid filled, variable focus eyeglasses in which each eye's lens can be manually adjustable independently of the other eye's lens. *Id.*

Dr. Savidis' testimony (and our finding) is further supported by Gordon, which discloses that the focus of each lens can be independently adjusted by turning a screw. Ex. 1013, Figs. I–IV, 1:67–80, 1:87–100, 2:5–22; *see also* Ex. 1015, 75:9–13 (Plummer agrees that Gordon's screws are independently adjustable.). Dr. Savidis' testimony (and our finding) is also supported by Cronin, which discloses left and right calibration screws for

allowing independent adjustment of the focal length of the left and right lenses, respectively. Ex. 1011, 4:27–32, 5:16–22, 5:66–6:2, Figs. 2 and 4. We also rely on Cronin’s disclosure of the purpose and advantage of the independent adjustment feature: According to Cronin, it allows the focal lengths of the left and right lens assemblies to be matched or related to each other in a pre-determined manner to compensate for unusual visual disorders, thereby avoiding visual discomfort by focusing each of the user’s eyes at sensibly the same object distance. *Id.* at 5:9–16.

The preponderance of the evidence establishes that one way suggested by the prior art to provide independent adjustability of each eye’s lens would have been to replace the non-adjustable connector (leaf hinge 23) of Kurtin ’532 with an adjustable connector, such as the nut, screw, and tab arrangement of Kurtin ’629. See PO Resp. 36–37 (describing Petitioner’s first proposed modification); Tr. 14:16–20 (Petitioner is relying on modifications 1 and 3.). Our finding is supported by Dr. Savidis’ testimony that, in order to have independent adjustability of each lens unit, a person of ordinary skill in the art would have been motivated to seek a suitable adjuster structure to replace the non-adjustable connector of Kurtin ’532. Ex. 1003 ¶ 101. Our finding is also supported by Dr. Savidis’ testimony that a person of ordinary skill in the art “would have exercised no more than routine skill in the art to implement this substitution by utilizing existing seal 21 of Kurtin ’532 shown in Figure 3 and by attaching tabs to or creating tabs for Kurtin’s ’532 front and rear rings to accommodate Kurtin’s ’629 screw and nut.” *Id.* ¶ 103. Our finding is further supported by Kurtin ’532 Figure 5, which shows leaf hinge 23 connecting the front and rear rings, and Kurtin ’532 Figure 3, which shows elastomeric bellows 21 allowing the rear ring to

move with respect to the front ring. Ex. 1004 ¶¶ 32, 33, Figs. 3, 5. Our finding is further supported by Kurtin '629, which discloses adjustable spectacles including nut 20, screw 21, and actuating tabs 19, where nut 20 can be turned by the wearer to adjust the optical power of the lenses. Ex. 1012, Abstract, Figs. 1–3, 3:50–4:9.

The preponderance of the evidence establishes that another way suggested by the prior art to provide independent adjustability of each eye's lens would have been to replace the non-adjustable connector (leaf hinge 23) of Kurtin '532 with an adjustable connector, such as the nut, screw, and tab arrangement of Kurtin '629, modified by the screw and tabs taught by Gordon. See PO Resp. 37–38 (describing Petitioner's third proposed modification); Tr. 14:16–20. Our finding is supported by the testimony of Dr. Savidis, who states that it would have been “routine design choice” to replace a nut and screw combination with a threadably engaged screw, as disclosed by Gordon, because “both connectors function to adjust the distance between the tabs, thereby resulting in changing the optical power of the fluid filled lens.” Ex. 1003 ¶ 107. Our finding is also supported by the disclosures of Kurtin '532 and Kurtin '629 cited in the preceding paragraph. Our finding is further supported by Gordon's Figure II embodiment, including screw 5 for adjusting the distance between ears (tabs) 12. Ex. 1013, Figs. II and IV, 2:5–19.

We are persuaded that the independent claims of the '797 Patent are directed to a combination of prior art elements, with each element performing the same function it had been known to perform, where the combination yields no more than one of ordinary skill in the art would have expected from such an arrangement. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S.

398, 415–16 (2007). More specifically, we are persuaded that the independent claims of the '797 Patent are directed to the adjustable focus spectacles of Kurtin '532, where the non-adjustable connector (leaf hinge 23) on each of the left and right lens assemblies is replaced by an adjustable connector, such as the screw, nut, and tab arrangement of Kurtin '629 or that arrangement modified by the screw and tabs taught by Gordon. In this combination of prior art elements, the screw, nut, and tabs (modification 1) or screw and tabs (modification 3) perform the same function as they had been known to perform—allowing the distance between the tabs to be adjusted in order to change the focus of the lens. Furthermore, the combination yields no more than would have been expected by a person of ordinary skill in the art—allowing each eye's lens to be adjusted independently of the other eye's lens. Ex. 1003 ¶¶ 104, 105, 107.

Patent Owner argues that a person of ordinary skill in the art would not have looked to Gordon to modify Kurtin '532 because Gordon discloses rigid, rather than flexible, lenses and an adjustment mechanism (screw 5 and ears 12) oriented parallel, rather than perpendicular, to the lens frame. PO Resp. 39–43. When viewed through the lens of applicable law, Patent Owner's argument does not support a conclusion of nonobviousness. Patent Owner identifies several differences between the lenses and adjustment mechanisms disclosed in Kurtin '532 and Gordon. *Id.* The preponderance of the evidence establishes, however, that Gordon discloses eyeglasses having an adjustment mechanism on each eye's lens, such that the focus of each eye's lens can be adjusted independently of the other eye's lens. Ex. 1013, Figs. I–IV, 1:67–80, 1:87–100, 2:5–22; Ex.1015, 75:9–13. This

same evidence establishes that a person of ordinary skill in the art reading Gordon would have recognized the independent adjustability feature.

Gordon is persuasive evidence to show a reason or motivation to modify Kurtin '532 to provide independent adjustability, regardless of whether Gordon's adjustment mechanism is physically combinable with Kurtin '532. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, but rather whether a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention." *Allied Erecting and Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) (quotes and citations omitted); *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) ("a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements"). Accordingly, Patent Owner's argument is not sufficient to counter the evidence supporting Petitioner's rationale for combining Kurtin '532 and Gordon.

Patent Owner argues that neither Gordon nor Cronin discloses independent adjustment by a **wearer** of the eyeglasses, as opposed to a trained **technician**. PO Resp. 44–46. We find, however, that each of these references discloses independent adjustment that can be performed by a wearer. Our finding is supported by Gordon, which discloses "an adjustable focus lens whereby the lens can be quickly and readily adjusted to any focus desired . . . without removing the [lens] from the frame." Ex. 1013, 1:13–20. We credit Dr. Savidis' testimony that "in light of Gordon's disclosure and figures, Gordon's lenses are flexible enough to allow a wearer to adjust the power of his lenses by rotating screw 5." Ex. 1014 ¶ 5. Dr. Savidis'

testimony is consistent with Gordon, which discloses that the focus of each lens can be changed by tightening screw 5, which causes portions 8 of the lenses to “spring . . . away from each other sufficiently to change the foci of the lenses.” Ex. 1013, 1:87–100, Fig. III; *see also id.* at 2:20–22 (“by adjusting the screw 5 the side portions of the lenses may be adjusted to obtain various foci”).

Dr. Plummer testifies that “**assembly** of Gordon’s spectacles would have to be performed by a skilled technician.” Ex. 2002 ¶ 165 (emphasis added). That testimony does not persuasively support Patent Owner’s argument, PO Resp. 45, that Gordon’s **adjustment** can only be performed by a skilled technician. To the extent that Dr. Plummer’s testimony could be read to support Patent Owner’s argument, we give greater weight to Dr. Savidis’ testimony, which is consistent with Gordon’s disclosure of an adjustment that can be performed “quickly and readily.” Ex. 1013, 1:14, 1:18.

We find that Cronin also discloses an independent adjustment that can be performed by the wearer of the eyeglasses. Our finding is based on Cronin, which discloses that calibration screws 42L and 42R can be used to adjust the focus of each lens independently. Ex. 1011, 4:27–32, 5:9–22, 5:66–6:2, Figs. 1, 2 and 4. Patent Owner argues that Cronin’s calibration screws are “inaccessible by the wearer after final assembly.” PO Resp. 45. Patent Owner’s argument is not consistent with Cronin Figures 1, 2, and 4, which show lens actuators 4, including blocks 40 and calibration screws 42, in a position where the calibration screws are accessible by the wearer after

assembly.⁵ More specifically, Cronin Figures 1, 2, and 4, show that screw 42 extends through a hole in block 44, which extends over rear ring 70, such that screw 42 engages and presses against rear ring 70. Ex. 1011, 5:63–6:2. In this regard, neither party identifies error in our preliminary finding that, in Cronin, rear ring 70 and front ring 60 are both positioned between screw 42 and frame 2. Dec. 15.

Patent Owner argues that Cronin’s calibration screws can only be adjusted by “a trained technician equipped with the proper tools.” PO Resp. 45. Aside from the inaccessibility argument addressed above, however, Patent Owner does not specifically identify other structural differences between Cronin’s calibration screws and screws 112 disclosed in the ’797 Patent such that only the latter can be adjusted by the wearer.

Patent Owner argues that Petitioner’s references would have discouraged a person of ordinary skill in the art from replacing leaf hinge 23 of Kurtin ’532 with a rigid adjuster. PO Resp. 46–51. According to Patent Owner, Cronin, Kurtin ’629, and Kurtin ’532 each requires a hinge opposite the simultaneous adjustment mechanism so that the membrane support can move angularly about the hinge. *Id.* at 46–50.

Patent Owner’s argument is insufficient to counter Petitioner’s evidence for three reasons. First, Patent Owner does not direct us to prior art teachings that “criticize, discredit, or otherwise discourage” replacing a hinge with an adjustment mechanism. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Petitioner, on the other hand, directs us to a prior art

⁵ Except where helpful to explain our analysis, we omit the reference numeral suffixes, L and R, which Cronin uses to designate similar structures of the left and right lens assemblies, respectively. Ex. 1011, 4:9–10.

teaching supporting the viability of Petitioner's proposed replacement. Pet. Reply 9. Kurtin '629 describes "replac[ing] hinges 16 with rigid spacers." Ex. 1012, 4:65–5:4. Although this teaching relates to an embodiment in which bending of the membrane support is desired, *id.* at 4:25–64; Ex. 1015, 111:8–22, 112:7–15, such an embodiment is not outside the scope of the '797 Patent. The challenged claims do not, for example, limit motion of the membrane support structure to angular motion or exclude embodiments in which the membrane support structure also bends or flexes.

Second, after considering the testimony of both experts, we credit the testimony of Dr. Savidis that a person of ordinary skill in the art would have understood that a hinge could be replaced by a screw-containing adjustment mechanism and still provide for sufficient angular motion. Ex. 1014 ¶¶ 9–20 (A person of ordinary skill in the art would have understood that standard clearance between a screw and its corresponding hole is sufficient to allow for angular motion and could have used routine skill to create a looser fit, if needed.); *cf.* Ex. 2002 ¶¶ 168–187 (A POSITA would have understood that replacing a hinge with a rigid adjuster would result in bending of the membrane support, introducing distortion.). Dr. Savidis' testimony is supported by objective evidence, including the testimony of Patent Owner's expert regarding screw clearances, standards for eyeglass screws, and Gordon's disclosure of screws and tabs that would be understood as permitting angular motion. Ex. 1014 ¶¶ 10–19; Ex. 1015, 53:8–55:12 (Dr. Plummer: clearance necessary to permit angular motion is less than a thousandth of an inch); Exs. 1017–1019 (standards for clearance between screw and corresponding hole for eyeglasses); Ex. 1012, Fig. 3 (space between tab 19 and screw 21); Ex. 1013, 2:10–22, Figs. II, IV (ears (tabs) 12

and screw 5); Ex. 1015, 91:20–92:12 (Gordon’s tabs move from parallel to unparallel when distance between tabs changes). Accordingly, we give substantial weight to Dr. Savidis’ testimony.

Third, as discussed above, we find that Petitioner has shown that a person of ordinary skill in the art would have been motivated to modify the adjustable eyeglasses of Kurtin ’532 in order to provide independent adjustability of each eye’s lens. To the extent that Patent Owner’s evidence shows a possibility that angular motion might be compromised by replacing the hinge of Kurtin ’532 with an adjustable connector, Patent Owner’s evidence does not, in our estimation, outweigh Petitioner’s evidence showing a motivation to combine. *See Allied Erecting*, 825 F.3d at 1381 (“A given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”) (quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006)).

Patent Owner argues that Petitioner’s proposed modification would not meaningfully practice the independent adjustment limitations because elastomeric seal 21 of Kurtin ’532 does not have a bellows shape at or near the substituted adjustable connector. PO Resp. 58–60. We do not agree with Patent Owner’s argument, which is based on an overly narrow reading of Petitioner’s proposed modification. The Petition asserts that a person of ordinary skill in the art would have made the proposed substitution “by utilizing existing seal 21 of Kurtin ’532 shown in Figure 3.” Pet. 46. There is no dispute that seal 21, as shown in Kurtin ’532 Figure 3, has a bellows shape that allows the distance between the front and rear rings to be adjusted. PO Resp. 58–59; Pet. Reply 10; Ex. 1004 ¶¶ 32, 40, Fig. 3.

Although the portion of seal 21 shown in Kurtin '532 Figure 5 does not have a bellows shape, the quoted sentence of the Petition is reasonably interpreted as proposing a bellows-shaped seal, as shown in Kurtin '532 Figure 3, in the vicinity of the substituted adjustable connector. Pet. 46.

Patent Owner argues that a person of ordinary skill in the art would not have made Petitioner's proposed modifications to Kurtin '532 because the proposed modifications would have rendered the spectacles inoperable and caused problems that a person of ordinary skill in the art could not have resolved without undue experimentation. PO Resp. 61–73. The problems identified by Patent Owner and Dr. Plummer include: lateral movement of the membrane support structure, bending of the membrane support structure, and “crosswise prism” distortion. *Id.*; Ex. 2002 ¶¶ 207–228. As discussed below, after considering the testimony of both experts, we give greater weight to the testimony of Dr. Savidis and find that the problems posited by Patent Owner are speculative and not sufficient to counter Petitioner's evidence that a person of ordinary skill in the art would have had a reason to replace the non-adjustable connector (leaf hinge 23) of Kurtin '532 with an adjustable connector.

Regarding lateral movement of the membrane support structure in Kurtin '532, we credit Dr. Savidis' testimony that front ring 19 cannot move laterally because it is welded to bridge 12 (Ex. 1014 ¶¶ 7, 8), and that rear ring 20 cannot move laterally due to link 13 and tab 11 of the vertical actuator (Ex. 2006, 23:20–24:7, 24:24–25:6, 25:15–21, 26:2–12, 29:15–30:1, 33:17–25). Dr. Savidis' testimony is consistent with Kurtin '532, which discloses that front ring 19 is fastened by laser welding to bridge 12,

as indicated by black triangles in Figure 2, and that rear ring 20 is attached via link 13 and tab 11 to the actuator. Ex. 1004, ¶¶ 12, 27, Figs. 2, 3.

Regarding bending of the membrane support structure, for the reasons discussed above, we credit the testimony of Dr. Savidis that a person of ordinary skill in the art would have understood that a hinge could be replaced by an adjustment mechanism and still provide for sufficient angular motion between the front and rear rings. Ex. 1014 ¶¶ 9–20.

Regarding “crosswise prism” distortion, we credit the undisputed testimony of Dr. Savidis that no such distortion occurs if the adjustment mechanisms are spaced 180 degrees apart on the circumference of the lens, as would be the case if leaf hinge 23 of Kurtin ’532 is replaced by an adjustable connector. Ex. 1014 ¶ 21; *see also* Ex. 2002 ¶ 219 (crosswise prism “will be diminished or removed” if the actuator is at point “A” directly opposite hinge or pivot point “B”).

Regarding undue experimentation, Dr. Plummer testifies that a person of ordinary skill in the art could not have resolved the problems caused by Petitioner’s proposed modifications to Kurtin ’532 and that “[o]nly the ’797 Patent discloses” the solution—a “somewhat loose” fitting screw that allows angular motion. Ex. 2002 ¶¶ 228, 229 (citing Ex. 1001, 4:2–4, 4:14–17). Dr. Savidis, on the other hand, testifies that, if faced with the problem of a tightly fitting screw impeding angular motion and causing distortion of the lens, “it would have been well within the skill of a POSA to simply create a looser fit by exercising routine skill in the art to have the hole made bigger.” Ex. 1014 ¶ 20. In our view, Dr. Savidis’ testimony is more consistent with the level of ordinary skill in the art set forth above, and we give greater weight to his testimony. *See Pride Mobility Prod. Corp. v. Permobil, Inc.*,

818 F.3d 1307, 1315 (Fed. Cir. 2016) (Board did not err in relying on expert testimony that a skilled artisan would have known to compensate for problems introduced by Petitioner's proposed modification).

6. Means-Plus-Function Elements

The Petition presents essentially the same obviousness analysis for claims 3 and 15 as it presents for claim 1, with no separate discussion of the elements we have construed pursuant to 35 U.S.C. § 112 ¶ 6. Pet. 51, 57–59 (referring to claim 1 invalidity analysis for each of claims 3 and 15).

Patent Owner argues that the Petition should be denied because it fails to propose constructions for the means-plus-function elements and fails to identify structures in the cited references that are the same or equivalent to the corresponding structures disclosed in the specification. PO Resp. 13–14, 16–17.

In reply, Petitioner contends that the Petition shows sufficiently where the recited function and corresponding structure can be found in the prior art and that both of its proposed modifications of Kurtin '532 result in the H/CAL structure of two tabs and a screw that perform the recited functions. Pet. Reply 29–30.

Under our rules, a Petition is required to include a proposed construction for each means-plus-function limitation identifying “the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. § 42.104(b)(3). Under applicable Federal Circuit case law, where a claim does not recite the word, “means,” there is a rebuttable presumption that § 112, ¶ 6 does not apply. *Williamson*, 792 F.3d at 1348.

At the pre-institution stage in this case, neither party contended that any claim element is a means-plus-function term or needed to be construed pursuant to § 112, ¶ 6. Nor did the Board address that issue in its Decision to Institute. Under the circumstances of this case, Petitioner was entitled to rely on the rebuttable presumption under *Williamson*. We are not persuaded that Petitioner failed to meet its burden of proof, merely because the Petition does not include an explicit construction for the claim elements that Patent Owner argues, for the first time in the post-institution phase, are means-plus-function limitations.

Furthermore, we hold that Petitioner has met its burden to identify structures in the cited references that are the same or equivalent to the corresponding structures disclosed in the '797 Patent Specification. As discussed in Section II.A.2. above, we construe the terms, “adjustable element” (claim 3) and “controllable spacing member” (claim 15), as the combination of a front tab, a rear tab, and a screw and equivalents thereof. Petitioner’s obviousness ground is based on replacing Kurtin ’532’s non-adjustable connector (leaf hinge 23) with an adjustable connector, such as the screw, nut, and tab arrangement of Kurtin ’629 or that arrangement modified by the screw and tabs taught by Gordon. Pet. 44–50. We find Petitioner has shown that screw 21, nut 20, tab 19, and part of rear frame 10, as disclosed in Kurtin ’629 (Ex. 1012, 3:50–60, Fig. 3) is the same as or equivalent to the combination of a front tab, a rear tab, and a screw, as disclosed in the '797 Patent (Ex. 1001, 3:63–67, Figs 3A, 3B). Ex. 1003 ¶¶ 102–105. We also find Petitioner has shown that replacing the nut and screw of Kurtin ’629 with a threadably engaged screw, as disclosed in Gordon (Ex. 1011, 2:5–22, Fig. IV; Pet. 49) results in a structure that is the

same as or equivalent to the combination of a front tab, a rear tab, and a screw, as disclosed in the '797 Patent (Ex. 1001, 3:63–67, Figs 3A, 3B). Ex. 1003 ¶¶ 106–107.

Patent Owner argues that Petitioner's proposed structural modifications are not the same or equivalent to structures disclosed in the '797 Patent, which allow for hinging without breaking or distorting the membrane and allow for the adjustable lens units to be stable and operable without the membrane support structure shifting laterally. PO Resp. 16–17. For the reasons discussed in Section II.C.5. above, we find that the problems posited by Patent Owner are speculative and do not identify a significant difference between the structures disclosed in the prior art (as modified and combined by Petitioner) and the structure disclosed in the '797 Patent, i.e., the combination of a front tab, a rear tab, and a screw.

7. Dependent Claims

Petitioner contends that its proposed modification of Kurtin '532 would have resulted in variable focus spectacles satisfying the limitations of dependent claims 2, 4–8, 10–12, 14, 16, and 17. Pet. 50, 52–53, 55–57, 59.

Patent Owner argues claims 1–12 and 14–17 as a group, presenting no argument regarding dependent claims 2, 4–8, 10–12, 14, 16, and 17 separate from its arguments regarding independent claims 1, 3, 9, and 15. PO Resp. 15–54.

We find that replacing Kurtin '532's non-adjustable connector (leaf hinge 23) with an adjustable connector, such as the screw, nut, and tab arrangement of Kurtin '629 or that arrangement modified by the screw and tabs taught by Gordon would have resulted in variable focus spectacles satisfying the additional limitations recited in of each of dependent claims 2,

4–8, 10–12, 14, 16, and 17. We base our finding on the arguments and evidence presented by Petitioner at pages 50, 52–53, 55–57, and 59 of the Petition, which we adopt as our own.

8. Conclusion

Accordingly, we hold that Petitioner has established by a preponderance of the evidence that claims 1–12 and 14–17 of the '797 Patent are unpatentable as obvious over Kurtin '532 and Kurtin '629 in view of Gordon and/or Cronin.

D. Anticipation

Petitioner contends that claims 3–12 and 14–17 of the '797 Patent are anticipated by Cronin (Ex. 1011). Pet. 27–42. Petitioner contends that Cronin discloses variable focus spectacles comprising elements [a], [b], [c], [d], and [e] of claim 3 and the corresponding limitations of claims 9 and 15. Pet. 27–29 (claim 3), 35 (claim 9), 39 (claim 15); *see also* Ex. 1009 (claims comparison). With respect to claim elements [f], [g], and [h] of claim 3 and the corresponding limitations of claims 9 and 15 (the “adjustment limitations”), Petitioner contends that Cronin “Figures 2, 3A, 3B, and 4 show an adjustable element comprising (a) adjusting screw 42, (b) dowel block 40 attached to dowel 44, and (c) tab 28 wherein adjusting screw 42 connects tab 28 to dowel block 40 attached to dowel 44.” *Id.* at 29–30 (claim 3), 35–36 (claim 9), 40–41 (claim 15).

Patent Owner contends that Cronin does not disclose the manual and independent adjustment limitations of claims 3, 9, and 15 and fails to provide an enabling disclosure of these limitations. PO Resp. 17–36. Regarding Cronin Figures 3A and 3B, Patent Owner contends that the screw

shown in these figures is an attachment screw, not a calibration or adjustment screw for adjusting the distance between the membrane support structure and the transparent member. *Id.* at 28–33.

We are not persuaded that Petitioner has met its burden to show anticipation by Cronin. Petitioner agrees that, if the terms, “adjustable element” (claim 3) and “controllable spacing member” (claim 15), are construed as means-plus-function terms, then Cronin does not anticipate claims 3–8 and 15–17. Tr. 29:13–22.

With respect to all challenged claims, Petitioner’s anticipation ground relies on Cronin Figures 3A and 3B, including the screw designated as “42L” in those figures. Pet. 27 (annotation of Figs. 3A, 3B), 29–30 (claim 3); 35–36 (claim 9), 40–41 (claim 15). Yet Petitioner fails to explain persuasively how rotation of screw 42L, as it is depicted in Cronin Figures 3A and 3B, would adjust, change, or control the distance between rear ring 70L and front ring 60L. *See, e.g.*, Pet. 34 (referenced by Petitioner at Tr. 75:12–21). Dr. Savidis’ testimony is merely conclusory on this point. Ex. 1003 ¶¶ 60, 75, 80, 82, 84, 86, 91. Such an adjustment, change, or control is recited in each of claims 3, 9, and 15. Ex. 1001, 5:35–40, 6:28–33, 7:17–22.

Dr. Plummer testifies that a person of ordinary skill in the art would understand that the screw shown in Cronin’s Figures 3A and 3B is simply an attachment screw, not an adjustment screw for adjusting the distance between the membrane support structure and the transparent member. Ex. 2002 ¶¶ 107–111, 116–129. Dr. Savidis’ reply declaration (Ex. 1014) does not respond to Dr. Plummer’s testimony regarding Cronin Figures 3A and 3B. Petitioner argues that Cronin’s screws 42 provide independent

adjustability and that Cronin Figures 3A and 3B illustrate an adjustment screw. Pet. Reply 25–28. Petitioner’s arguments provide no substantive response to Dr. Plummer’s analysis of Cronin’s Figures 3A and 3B and cannot take the place of evidence in the record in any event. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997). Although the Board’s institution decision includes a preliminary finding that Cronin provides an enabling disclosure of independent adjustment, that finding is not based on Cronin Figures 3A and 3B. Dec. 12–15. We credit the unrebutted testimony of Dr. Plummer, which establishes that Cronin Figures 3A and 3B do not disclose the adjustment recited in the challenged claims. Ex. 2002 ¶¶ 107–111, 116–129.

Because Petitioner presents no argument for anticipation that does not depend on Cronin Figures 3A and 3B (Tr. 30:5–10), we hold that Petitioner has not established that the challenged claims are anticipated by Cronin.

III. CONCLUSION

1. Petitioner has demonstrated by a preponderance of the evidence that claims 1–12 and 14–17 of the ’797 Patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Kurtin ’532 and Kurtin ’629 in view of Gordon and/or Cronin.

2. Petitioner has not demonstrated by a preponderance of the evidence that claims 3–12 and 14–17 of the ’797 Patent are unpatentable under 35 U.S.C. § 102(b) as anticipated by Cronin.

IV. ORDER

Accordingly, in consideration of the foregoing, it is hereby:

ORDERED that claims 1–12 and 14–17 of the '797 Patent are held unpatentable under 35 U.S.C. § 103(a); and

FURTHER ORDERED that, because this is a final written decision, any party to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2015-01821
Patent 8,967,797 B2

PETITIONER:

John A. Bauer
Boris Matvenko
Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, P.C.
jabauer@mintz.com
bmatvenko@mintz.com

PATENT OWNER:

Dion M. Bregman
Jason E. Gettleman
Ahren Hsu-Hoffman
Morgan, Lewis & Bockius LLP
dbregman@morganlewis.com
jgettleman@morganlewis.com
Ahren.hsu-hoffman@morganlewis.com