

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAGIC LEAP, INC.
Petitioner,

v.

PERCEPT TECHNOLOGIES INC.
Patent Owner.

Patent No. 9,010,929

Inter Partes Review No. IPR2023-00494

PETITION FOR *INTER PARTES* REVIEW

UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *et seq.*

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Petitioner's Exhibit List

Exhibit Description	Exhibit #
U.S. Patent No. 9,010,929 to Lewis (“the ’929 Patent”)	EX-1001
Prosecution History of U.S. Patent No. 9,010,929	EX-1002
Declaration of Dr. Joseph J. LaViola Jr. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,010,929	EX-1003
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Canadian Patent Application No. CA 2,362,895 to Mann (“Mann ’895”)	EX-1005
U.S. Patent Application Publication No. 2005/0281440A1 to Perner (“Perner”)	EX-1006
U.S. Patent No. 7,278,734 to Jannard (“Jannard”)	EX-1007
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I. INTRODUCTION

Petitioner Magic Leap, Inc. (“Petitioner” or “Magic Leap”) petitions for *inter partes* review of claims 1-11, 15, 17, and 22 of U.S. Patent No. 9,010,929 (“the ’929 Patent” (EX-1001)). The ’929 patent is directed to eyewear with circuitry to provide additional functionality. The challenged claims do not present any patentable improvement over the prior art, as set forth in this Petition and in the supporting Declaration of Dr. Joseph J. LaViola Jr. (EX-1003).

Accordingly, Petitioner requests that the Board institute *inter partes* review of the ’929 patent and cancel the claims at the conclusion of the instituted proceeding.

II. SUMMARY OF THE ’929 PATENT

A. Background Of The ’929 Patent

The ’929 Patent describes eyeglasses that include circuitry within the frames to purportedly enhance the eyeglasses. (EX-1001, 1:44-59.) The ’929 Patent identifies three areas of enhancement:

- (1) Media focals, that is, utilizing the eyewear for its intended purpose and enhancing that use by using imaging techniques to improve the vision of the user.
- (2) Telecommunications enhancements that allow the eyeglasses to be integrated with telecommunication devices such as cell phones or the like.
- (3) Entertainment enhancements that allow the eyewear to be integrated with devices such as MP3 players, radios, or the like.

(Ex-1001, 1:44-59.)

As an example of the media focals, “a digital camera could be placed within the eyewear to allow for seeing certain of these images.” (EX-1001, 2:42-45.)

The '929 Patent further describes that the eyeglasses can include, or interface with, various features common to popular computing devices at the time. (EX-1003, ¶28.) For example, the '929 Patent describes an “information bar” (*e.g.*, a stock ticker), MP3 player, and cell phone; and states that the eyeglasses can “function within a client/server model.” (EX-1001, 2:59-62, 3:44-46, 3:62-63, 4:42-43; EX-1003, ¶28.)

B. Prosecution History Of The '929 Patent

The application that became the '929 patent is a continuation that was filed on Jan. 11, 2013, and claims priority to an application filed on October 7, 2005. For the purposes of this Petition, Petitioner assumes a priority date of October 7, 2005 for the challenged claims.

Following claim amendments by the applicant, the claims were allowed. But the Examiner found that the allowed claims overlapped substantially with the prior art. For example, in the Dec. 8, 2014 Notice of Allowability, the Examiner provided his reasons for allowance: “the prior art teaches eyewear comprising, a frame member, a lens, circuitry within the frame member for enhancing the use of the eyewear, and an eye sensor coupled to the frame member, the eye sensor

activating the circuitry responsive to eye motion of a user”. (EX-1002, 104.)

These elements are found in all challenged claims of the ’929 Patent. The claims were allowed on the basis of various additional limitations that were added by the applicant. (EX-1002, 104.) As set forth in this Petition, the prior art does in fact teach *all* limitations of the challenged claims, not just those that the Examiner found in the prior art.

C. Level Of Ordinary Skill

Based on the disclosure of the ’929 patent and a priority date of October 7, 2005, a person of ordinary skill in the art (“POSITA”) would have had a B.S. degree and a Masters degree in Computer Science, Computer Engineering, Electrical Engineering, Physics, or an equivalent field, as well as one to two years of academic or industry experience in wearable electronic devices or comparable industry experience. (EX-1003, ¶21.)

III. CLAIM CONSTRUCTION

The Board construes claims under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *see also* 83 Fed. Reg. 51,340 (Oct. 11, 2018) (Board adopting same claim construction standard used by Article III federal courts and the ITC). Under *Phillips*, claims are given their ordinary and customary meaning in light of the specification. 415 F.3d at 1315-17.

The ’929 patent is the subject of co-pending litigation as identified in

Section VIII. Patent Owner asserts that Petitioner infringes claims 7 and 10 of the '929 patent. The parties have exchanged briefing regarding the claim construction of certain terms of the challenged claims. (EX-1008 through EX-1011.) The parties' respective positions with respect to the terms of the '929 Patent are set forth in the chart below.

Petitioner does not believe any claim construction is necessary for this Petition, as the challenged claims are invalid under any reasonable interpretation of the claims.¹

Claim Term	Patent Owner's Proposed Construction	Petitioner's Proposed Construction
media focals	utilizing the eyewear for its intended purpose and enhancing that use by using imaging techniques to improve the vision of the user	circuitry that uses imaging techniques to improve the vision of the user

¹ In the event trial is instituted, Petitioner reserves its right to address construction of any terms raised at trial, or in the related district court action. Petitioner further reserves the right to raise invalidity issues under 35 U.S.C. § 112, including indefiniteness, in the related district court action because such issues cannot be raised in an IPR petition.

Claim Term	Patent Owner's Proposed Construction	Petitioner's Proposed Construction
the eye sensor activating the circuitry responsive to eye motion of a user	plain and ordinary meaning	the eye sensor making the inactive circuitry become active, in response to eye motion of a user
a lens	plain and ordinary meaning	plain and ordinary meaning ²
cell phone	plain and ordinary meaning	plain and ordinary meaning ³
MP3 player	plain and ordinary meaning	plain and ordinary meaning ⁴

IV. PRECISE REASONS FOR RELIEF REQUESTED

Pursuant to 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.* (including § 42.104(b)), Petitioner requests cancellation of claims 1-11, 15, 17, and 22 of the '929 Patent based on the following references and the accompanying Declaration of Dr. Joseph J. LaViola Jr. (EX-1003).

² Petitioner previously took the position that “a lens” should be construed to mean “a transmissive optical device which focuses a light beam by refraction.”

³ Petitioner previously took the position that “cell phone” should be construed to mean “circuitry that sends and receives telephone calls over a cellular network.”

⁴ Petitioner previously took the position that “MP3 player” should be construed to mean “circuitry that inputs a computer file in MP3 format and outputs an audio signal based on the computer file.”

Prior Art Reference	Abbreviation
Canadian Patent Application No. 2,362,895 to Mann (“Mann ’895”)	Mann ’895 (EX-1005)
U.S. Patent Application No. 10/871,220 to Perner (Published as U.S. Patent Appl. Pub. No. 2005/0281440A1) (“Perner”)	Perner (EX-1006)
U.S. Patent No. 7,278,734 to Jannard (“Jannard”)	Jannard (EX-1007)

The statutory grounds for the challenge of each claim are set forth below.

Throughout the Petition, all statutory citations are pre-AIA based on a priority date of October 7, 2005.

Ground	35 U.S.C. §	Claims(s)	Prior Art Reference(s)
1	103	1-8, 10, 11, 15, 17, 22	Mann ’895, Perner
2	103	7, 9, 10, 15	Jannard

Below, Petitioner discusses why the challenged claims are unpatentable, including by specifying how and where the prior art satisfies each limitation of each challenged claim, as required by 37 C.F.R. § 42.104(b)(4).⁵ Petitioner’s showing establishes a reasonable likelihood that it will prevail on each ground of

⁵ Petitioner also shows how each claim preamble is satisfied, but does not concede that any preamble is limiting for any ground in the Petition.

invalidity as to each challenged claim.

V. MANN '895 IN VIEW OF PEMER RENDERS OBVIOUS CLAIMS 1-8, 10, 11, 15, 17, AND 22

A. Ground 1: Claims 1-8, 10, 11, 15, 17, And 22 Are Obvious In View Of Mann '895 And Perner

1. Summary of Mann '895

Mann '895 is a Canadian patent application that was filed on Nov. 13, 2001, and laid open for public inspection on Dec. 26, 2002. (EX-1005, Cover Page; EX-1013.) Mann '895 is thus prior art to the '929 Patent under at least 35 U.S.C. § 102(a) and (b). (*See* Manual of Patent Examining Procedure, 9th ed., Rev. 10.2019 (June 2020), § 901.05 (“If anyone can inspect or obtain copies of the laid open application ... The full application is thus available as prior art as of either the date of publication of its notice or its laying open to public inspection if this is a later date.”) (citing *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981)); EX-1013.)

Mann '895 discloses “a wearable eyeglass based device allowing the wearer to view data,” such as from a wearable computer screen built into the eyeglasses, “where the device appears to others to be simply a pair of ordinary eyeglasses.” (EX-1005, 4; EX-1003, ¶37.) Fig. 3 illustrates an embodiment:

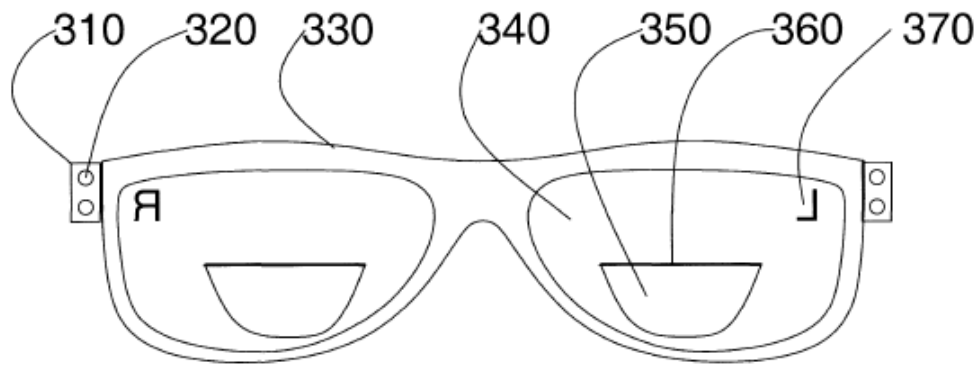


FIG. 3

(EX-1005, Fig. 3.)

Electronic circuitry built into the frames of the eyeglasses, such as included in “a microphone, speakers, indicator lights, cameras, etc.,” or a “pocke[t] sized computer,” allows the eyeglasses to perform various additional functions. (EX-1005, 10; EX-1003, ¶38.) For example, the eyeglasses can function as “a telephone, videophone, pocket organizer, personal safety device, or the like.” (EX-1005, 10; EX-1003, ¶38.) An information display in the lenses can present a computer screen, or other information such as an “organizer, calendar, clock, airline information, etc.” (EX-1005, 5, 9, 13, 15; EX-1003, ¶38.) The information display can also present “3D scene information and annotation,” which can be overlaid on an image captured by a camera in the eyeglasses. (EX-1005, 10, 11; EX-1003, ¶38.)

A “sight license” can be downloaded to the eyeglasses over a network to “enable the eyeglasses to operate.” (EX-1005, 11; EX-1003, ¶39.) A retinal or iris

scanner in the eyeglasses can be used to license the eyeglasses to provide sight to authorized users, but not to unauthorized users (e.g., those who might steal the eyeglasses). (EX-1005, 11; EX-1003, ¶39.) In some examples, certain markings, materials, or environmental lighting can be provided only to users who have a sight license. (EX-1005, 12; EX-1003, ¶39.) The sight license can also activate other eyeglass functionality, such as thermal imaging. (EX-1005, 12; EX-1003, ¶39.)

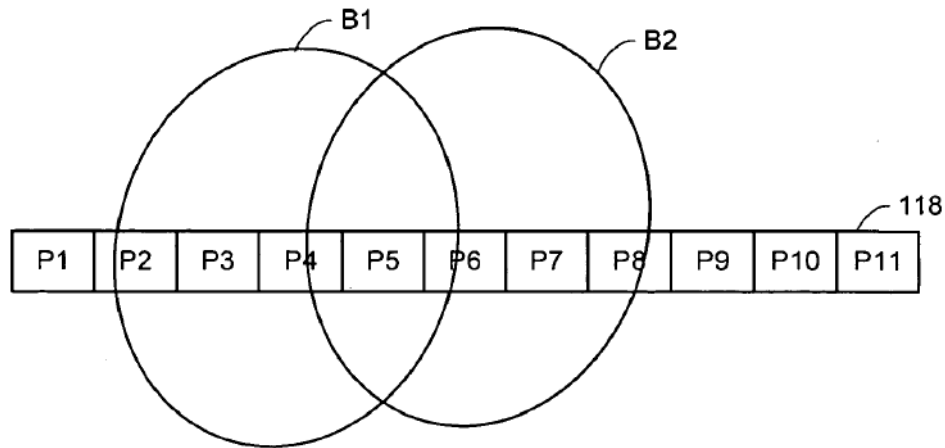
2. Summary of Perner

Perner is a U.S. patent application that was filed on June 18, 2004 and published on Dec. 22, 2005. Perner is thus prior art to the '929 Patent under at least 35 U.S.C. § 102(e).

Perner discloses an iris feature detector: an eye sensor in which sequential iris images are captured in response to a user's "rapid eye motion," and used to identify and authenticate the user. (EX-1006, [0006], [0025], [0035]; EX-1003, ¶41.) This can be used to grant the user certain privileges. (EX-1006, [0035]; EX-1003, ¶41.) Perner's iris feature detector improves on "conventional iris scanners" that do not respond to eye motion. (EX-1006, [0004]; EX-1003, ¶44.)

A reflexive eye motion is triggered by exposing the user's eye to first and second light sources, such as LEDs. (EX-1006, [0017]-[0020]; EX-1003, ¶42.) A controller 120 causes an image sensor to capture two sequential images of the eye during a tracking interval, which is an interval in which the eye motion occurs.

(EX-1006, [0020]-[0022]; EX-1003, ¶42.) A processor 122 determines a unique edge pattern based on the difference between the two images. (EX-1006, [0020]-[0022]; EX-1003, ¶43.) Fig. 2 of Perner shows an example of the eye motion with respect to the image sensor 118:



(EX-1006, Fig. 2, [0023]; EX-1003, ¶42.)

3. Claim 1

Mann '895 in view of Perner meets each limitation of claim 1. (EX-1003, ¶45.)

a. [Preamble] *Eyewear comprising:*

The preamble is taught by Mann '895 in view of Perner. (EX-1003, ¶46.) For example, Mann '895 discloses “a *wearable eyeglass based device* allowing the wearer to view data,” such as from a wearable computer screen, “where the device appears to others to be simply *a pair of ordinary eyeglasses.*” (EX-1005, 4 (emphasis added).) Fig. 3 illustrates an embodiment:

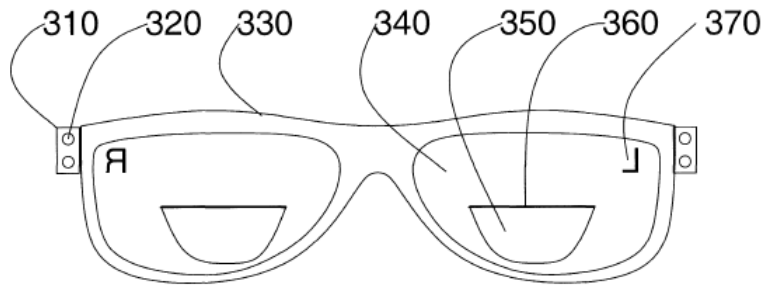


FIG. 3

(EX-1005, Fig. 3.)

b. [A] a frame member;

Mann '895 in view of Perner meets this element. (EX-1003, ¶47.) For example, Mann '895 discloses a pair of eyeglasses “having temple side pieces of *frame 100* with frames that support eyeglass lenses 100L.” (EX-1005, 8 (emphasis added).) Fig. 1 illustrates an example, showing frame member 100:

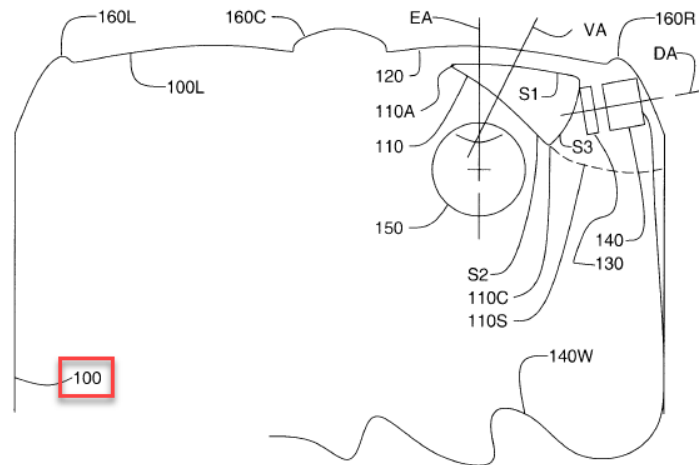


FIG. 1

(EX-1005, Fig. 1 (annotated).)

c. **[B]** *a lens*;

Mann '895 in view of Perner meets this element. (EX-1003, ¶48.) For example, Mann '895 discloses a pair of eyeglasses, “having temple side pieces of frame 100 with frames that support *eyeglass lenses 100L*.” (EX-1005, 8 (emphasis added); EX-1003, ¶48.) Fig. 1 illustrates an example of lens 100L:

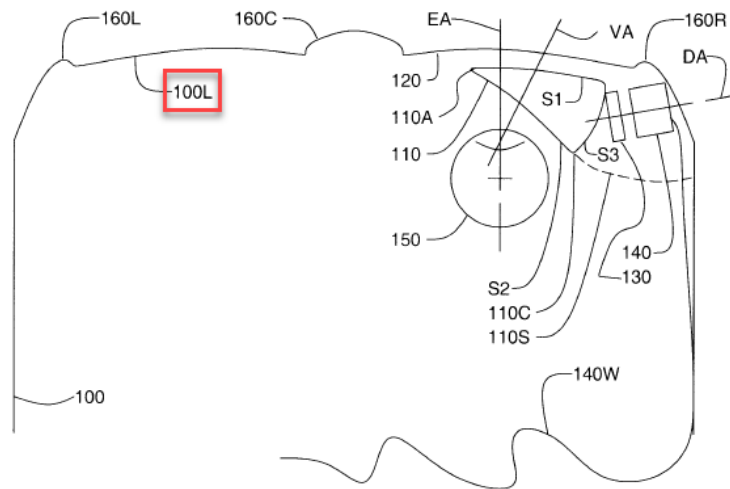


FIG. 1

(EX-1005, Fig. 1 (annotated).)

Mann '895 clarifies that the term “lens” is “used in the wide sense,” encompassing any reasonable interpretation of the term. (EX-1005, 8; EX-1003, ¶49.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Mann '895 in view of Perner meets this element. (EX-1003, ¶50.) For example, Mann '895 discloses that “the [pocket sized] computer may be built into the eyeglass frames.” (EX-1005, 10; EX-1003, ¶50.) Mann '895 explains that,

among other enhancements, the eyewear allows the wearer to view data from the screen of the wearable computer, while appearing to be a pair of ordinary eyeglasses. (EX-1005, 4; EX-1003, ¶50.) Thus the circuitry (computer) within the frame member is for enhancing the use of the eyewear. (EX-1003, ¶50.) Mann '895 further notes that “[o]ther devices in the eyeglasses such as a microphone, speakers, indicator lights, cameras, etc., allow the eyeglasses to function as a telephone, videophone, pocket organizer, personal safety device, or the like.” (EX-1005, 10; EX-1003, ¶50.) And Mann discloses that an electronic viewscreen in the eyeglasses can display the output of a camera that is “concealed in the eyeglass frames.” (EX-1005, 6-7; EX-1003, ¶50.) These are all examples in which circuitry (as in, *e.g.*, microphone, speakers, indicator lights, cameras) within the frame member enhances the use of the eyewear. (EX-1003, ¶50.)

- e. ***[D] an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user;***

Mann '895 in view of Perner meets this element. (EX-1003, ¶51.) For example, Mann '895 discloses a “sight license” feature by which a “retinal or iris scanner in the eyeglasses” can license the eyeglasses to provide sight to the wearer. (EX-1005, 11; EX-1003, ¶51.) Retinal scanners and iris scanners are examples of eye sensors that scan and detect components of the human eye (*i.e.*, the retina; the iris). (EX-1003, ¶51.) For example, an iris scanner senses an eye by scanning the

iris of the eye. (EX-1003, ¶51.) The retinal or iris scanner in the eyeglasses in Mann '895 thus meets the claimed *eye sensor coupled to the frame member*. (EX-1003, ¶51.)

Mann '895 further explains that the sight license granted by the retinal or iris scanner can “enable the eyeglasses to operate.” (EX-1005, 11; EX-1003, ¶52.) For example, the retinal or iris scanner can license the eyeglasses to provide sight to the wearer, but not to others. (EX-1005, 11; EX-1003, ¶52.) Thus the eye sensor is *activating the circuitry*, at least by enabling the eyeglasses to operate (e.g., by enabling the circuitry of the eyeglasses to provide sight to the licensed wearer). (EX-1003, ¶52.)

(i) *responsive to eye motion of a user*

To the extent that Mann '895 alone does not teach the eye sensor activating the circuitry *responsive to eye motion of a user*, this element is taught by Mann '895 in combination with Perner. (EX-1003, ¶53.) For example, as described above, Mann '895 discloses that an iris scanner is used to activate the circuitry of the eyeglasses. Perner discloses an iris feature detector with which sequential iris images are captured in response to a user's “rapid eye motion.” (EX-1006, [0006]; EX-1003, ¶53.) An edge pattern is determined based on these images of the eye motion, and the edge pattern is used to identify and authenticate the user. (EX-1006, [0024]-[0026], Fig. 2; EX-1003, ¶53.) If the eye is not in motion, no edge

pattern is produced. (EX-1006, [0027]; EX-1003, ¶53.) Perner's iris feature detector is thus an eye sensor that is responsive to the eye motion of the user. (EX-1003, ¶53.) And Perner's iris feature detector identifies and authenticates a user, analogous to Mann '895's iris scanner providing the sight license to authorized users. (EX-1003, ¶53.) The combination of Mann '895 with the eye motion-based iris scanner of Perner thus meets the limitation that the eye sensor activates the circuitry responsive to eye motion of a user. (EX-1003, ¶53.)

(ii) *Motivation to Combine Mann '895 and Perner with Reasonable Expectation of Success*

A POSITA would have been motivated to combine Mann '895 and Perner to meet the claim limitations with reasonable expectation of success. (EX-1003, ¶54.)

First, Mann '895 identifies that an *iris scanner* is used to selectively provide eyeglasses functionality to a licensed user. (EX-1005, 11; EX-1003, ¶55.) Perner invites its combination with Mann '895 by explaining how it improves on “conventional iris scanners,” and expressly suggesting that Perner's eye sensor be used in “identification and authentication systems,” “devices that use biometric passwords,” and other systems that use iris scans. (EX-1006, [0004], [0059]; EX-1003, ¶55.) The eyewear disclosed in Mann '895 is one such device, at least because Mann '895 uses an iris scanner to activate the eyewear for authorized

users, but not for unauthorized users (such as “others who might steal the eyeglasses”). (EX-1005, 11; EX-1003, ¶55.) The POSITA would thus have been motivated to adopt Perner’s suggestion and advantageously use the iris feature detector of Perner in place of the iris scanner of Mann ’895. (EX-1003, ¶55.)

Second, the iris feature detector of Perner would have been readily combinable with the eyewear of Mann ’895 by the POSITA with a reasonable expectation of success. (EX-1003, ¶56.) The teachings of Mann ’895 and Perner are implemented using analogous electronic components, such as the controller 120 and processor 122 of Perner (which may belong to a single chip, such as an ASIC), and the “programmable logic devices” of Mann ’895. (EX-1005, 8; EX-1006, [0017], [0037]-[0038]; EX-1003, ¶56.) And Mann ’895 discloses an iris scanner, analogous to Perner's iris feature detector, that operates in this system. (EX-1005, 11; EX-1003, ¶56.) The combination of Mann ’895 and Perner thus would have yielded predictable results with a reasonable expectation of success. (EX-1003, ¶56.)

Third, the POSITA would have been motivated to combine the iris feature detector of Perner with the eyewear of Mann ’895 to realize specific technical advantages of Perner that would improve the functionality, usability, and safety of the Mann ’895 eyewear. (EX-1003, ¶57.) As Perner explains, conventional iris scanners that do not respond to eye motion have drawbacks: they are “expensive”

and “computationally intensive.” (EX-1006, [0004]-[0005]; EX-1003, ¶57.) But Perner’s iris feature detector can identify and authenticate a user based on an edge pattern that is generated from the user’s eye motion. (EX-1006, [0023]-[0025], Fig. 2; EX-1003, ¶57.) Unlike conventional iris scanners, detecting iris features from the edge pattern “does not require complex processing” such as registration of the iris, extracting the iris from the background, and artifact removal. (EX-1006, [0025]; EX-1003, ¶57.) Perner’s eye sensor thus offers faster detection of iris features, as well as faster processing for identification and authentication, while reducing computational overhead. (EX-1006, [0025]; EX-1003, ¶57.) A POSITA would have been motivated to combine Perner with Mann ’895 to realize these technical advantages. (EX-1003, ¶57.)

The POSITA would have recognized that these advantages may be especially valuable for head-worn systems, such as the eyewear of Mann ’895. (EX-1003, ¶58.) In such devices, battery capacity and processing power are at a premium, because the size, mass, and thermal output of the device are limited by what the user can safely and ergonomically wear on his or her head. (EX-1003, ¶58.) By reducing the complexity of iris scanning operations, as described in Perner, the head-worn eyewear of Mann ’895 can benefit from, *e.g.*, smaller battery size, longer battery life, and reduced heat dissipation, improving the wearability and safety of the eyewear. (EX-1003, ¶58.)

f. [E] *wherein an information bar is provided on the lens.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶59.) For example, Mann '895 discloses “an information display having the appearance of ordinary eyeglasses.” (EX-1005, 7; EX-1003, ¶59.) The information display can present a computer screen, or other information such as an “organizer, calendar, clock, airline information, etc.” (EX-1005, 5; EX-1003, ¶59.) A POSITA would have understood these various elements to include an information bar. (EX-1003, ¶59.)

Mann '895's information displays are consistent with the '929 Patent's description that the information bar conveys “a variety of types of information.” (EX-1001, 2:55-64; EX-1003, ¶60.) They are further consistent with the '929 Patent's example information bar: a scrolling stock ticker that presents stock price information, analogous to, *e.g.*, the display of airline information expressly mentioned in Mann '895. (EX-1001, 2:55-64, Fig. 2; EX-1005, 5; EX-1003, ¶60.) Mann '895 in view of Perner thus meets the claimed *information bar*. (EX-1003, ¶60.)

The information display of Mann '895 is presented to the eye via optics 110. (EX-1005, 8-9; EX-1003, ¶61.) Optics 110 can be part of the lens 100L. (EX-1005, 13; EX-1003, ¶61.) Further, in some embodiments, “lens 350 *is* optics 110.” (EX-1005, 15 (emphasis added); EX-1003, ¶61.) By integrating the display optics

with the lens, the information bar can be “overlaid on top of [the user’s] visual field of view such that the information is relevant to the imagery being viewed.” (EX-1005, 5; EX-1003, ¶61.) Thus, the information bar is provided *on the lens*. (EX-1003, ¶61.)

4. Claim 2

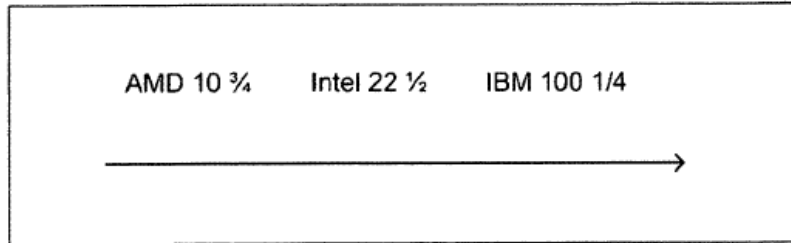
Mann ’895 in view of Perner meets each limitation of claim 2. (EX-1003, ¶62.)

a. [Preamble] *The eyewear of claim 1*

Mann ’895 in view of Perner meets the eyewear of claim 1 as described for claim 1. (EX-1003, ¶63.)

b. [A] *wherein the information bar is provided across the lens for a user.*

Mann ’895 in view of Perner meets this element as described for 1[E]. (EX-1003, ¶64.) The information bar is provided *across* the lens for a user at least because a POSITA would have understood that textual information such as “airline information” can be presented from left to right, or right to left, across the lens. (EX-1005, 5; EX-1003, ¶64.) This is consistent with the ’929 Patent’s description that a stock ticker is provided “across” the eyewear, as shown in Fig. 2 below, and the POSITA would have understood that information such as Mann ’895’s airline information can be presented in a similar fashion. (EX-1003, ¶64.)



(EX-1001, Fig. 2.)

5. Claim 3

Mann '895 in view of Perner meets each limitation of claim 3. (EX-1003, ¶65.)

a. [Preamble] *The eyewear of claim 1*

Mann '895 in view of Perner meets the eyewear of claim 1 as described for claim 1. (EX-1003, ¶66.)

b. [A] *wherein the lens is reflective.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶67.) For example, Mann '895 discloses that “a lens of said eyeglasses has a mirrored finish,” and is thus reflective. (EX-1005, 21; EX-1003, ¶67.)

6. Claim 4

Mann '895 in view of Perner meets each limitation of claim 4. (EX-1003, ¶68.)

a. [Preamble] *The eyewear of claim 1*

Mann '895 in view of Perner meets the eyewear of claim 1 as described for

claim 1. (EX-1003, ¶69.)

b. [A] *wherein the lens is partially reflective.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶70.) For example, Mann '895 discloses that lens 110L can be tinted to match the appearance of optics 110. (EX-1005, 13-14; EX-1003, ¶70.) A surface S1 of optics 110 can be “partially reflective,” and the lens 110L can be tinted to match this partially reflective surface. (EX-1005, 13-14; EX-1003, ¶70.)

7. Claim 5

Mann '895 in view of Perner meets each limitation of claim 5. (EX-1003, ¶71.)

a. [Preamble] *The eyewear of claim 1*

Mann '895 in view of Perner meets the eyewear of claim 1 as described for claim 1. (EX-1003, ¶72.)

b. [A] *wherein a logo is placed on a front surface of the lens.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶73.) For example, Mann '895 discloses that eyeglass lenses 340 can “contain markings 370 made directly on the glass.” (EX-1005, 16; EX-1003, ¶73.) These markings can include the manufacturer’s name or an abbreviation, such as the letters “GA” on a lens of Giorgio Armani glasses. (EX-1005, 16; EX-1003, ¶73.) Mann '895 in view of Perner thus teaches that *a logo is placed on a front surface of the lens.*

(EX-1003, ¶73.)

8. Claim 6

Mann '895 in view of Perner meets each limitation of claim 6. (EX-1003, ¶74.)

a. [Preamble] *The eyewear of claim 1*

Mann '895 in view of Perner meets the eyewear of claim 1 as described for claim 1. (EX-1003, ¶75.)

b. [A] *wherein the eyewear incorporates a camera to project a reciprocal display using a second lens.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶76.) As best understood, the claimed reciprocal display can refer only to the '929 Patent's description of using a second lens to present a camera image to an external viewer. (EX-1001, 2:52-54; EX-1003, ¶76.) In Mann '895, the eyewear can incorporate a camera, and a viewscreen in the eyewear can present the output of the camera to a user. (EX-1005, 6-7, 10; EX-1003, ¶77.) The camera output can be presented to the user via a display device that only the user can see. (EX-1005, 5; EX-1003, ¶77.) The camera output can also be projected to an "additional display device that the user can show to others". (EX-1005, 5; EX-1003, ¶77.) The additional display device, which is presented to an external viewer, meets the claimed *reciprocal display*, as best understood by Petitioner. (EX-1003, ¶77.) Mann '895 in view of

Pemer thus teaches that *the eyewear incorporates a camera to project a reciprocal display*. (EX-1003, ¶77.)

Further, Mann '895's display devices can be integrated into a lens, such as described for 1[E]. (EX-1003, ¶78.) And in a preferred embodiment, "both eyes have a display," such that the preferred embodiment includes two lenses. (EX-1005, 3; EX-1003, ¶78.) Mann '895 in view of Pemer thus teaches that the eyewear incorporates a camera to project a reciprocal display *using a second lens*. (EX-1003, ¶78.)

9. Claim 7

Mann '895 in view of Pemer meets each limitation of claim 7. (EX-1003, ¶79.)

a. [Preamble] *Eyewear comprising:*

Mann '895 in view of Pemer meets the preamble as described for 1[Preamble]. (EX-1003, ¶80.)

b. [A] *a frame member;*

Mann '895 in view of Pemer meets this element as described for 1[A]. (EX-1003, ¶81.)

c. [B] *a lens;*

Mann '895 in view of Pemer meets this element as described for 1[B]. (EX-1003, ¶82.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Mann '895 in view of Perner meets this element as described for 1[C]. (EX-1003, ¶83.)

e. [D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user*

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶84.)

f. [E] *wherein the circuitry provides any of a cell phone, media focals, and an MP3 player.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶85.) By the plain text of the claim, the circuitry provides “any of” the three recited features (1) a cell phone, (2) media focals, and (3) an MP3 player. This element is thus met if the references teach that the circuitry provides one or more of the three features. (*See Intell. Ventures II LLC v. BITCO Gen. Ins. Corp.*, 2019 WL 999902 at *3-4 (E.D. Tex. Feb. 28, 2019) (construing “manage *any* content” to mean “manage *one or more* stored content”) (emphasis added).) As described below, Mann '895 in view of Perner meets *all three* of the features, even though just one would be sufficient to satisfy this claim limitation. (EX-1003, ¶85.)

(i) *media focals*

Mann '895 in view of Perner meets this element. (EX-1003, ¶86.)

According to the '929 Patent, “media focals” is “utilizing the eyewear for its intended purpose and enhancing that use by using imaging techniques to improve the vision of the user.” (EX-1001, 2:25-27; EX-1003, ¶86.) In the co-pending litigation, the Patent Owner endorsed this exact description as its proposed construction of “media focals.” (EX-1008, 2.)

Mann '895 in view of Perner teaches that the circuitry provides media focals. (EX-1003, ¶87.) As an example, as described above for 1[C], Mann '895 discloses eyewear in which circuitry within the frame member includes a wearable camera coupled to a viewfinder. (EX-1005, 4; EX-1003, ¶87.) A “computational system” may be “built into the wearable camera” and “used to enhance images.” (EX-1005, 4; EX-1003, ¶87.) Mann '895 notes that the image enhancement “may be of value to the visually impaired.” (EX-1005, 4; EX-1003, ¶87.)

Mann '895's eyewear is “a wearable apparatus that provides the wearer with an electronic display device ... similar to or suitable for a camera viewfinder screen, or for a wearable computer information display.” (EX-1005, 2; EX-1003, ¶88.) Thus, the circuitry—including the wearable camera and the computational system—utilizes the eyewear for its intended purpose (*e.g.*, providing the wearer with an electronic display device). (EX-1003, ¶88.) The circuitry enhances that use (*e.g.*, is “used to enhance images”) by using imaging techniques, such as object recognition, face recognition, and combining images to increase “spatial extent,

spatial resolution, dynamic range, or tonal fidelity.” (EX-1005, 4, 5, 7; EX-1003, ¶88.) And the vision of the user is improved, at least by enhancing images to assist the visually impaired, as described in Mann ’895; and by overlaying relevant information on top of the user’s visual field of view. (EX-1005, 4, 5; EX-1003, ¶88.)

Mann ’895 describes various additional ways in which imaging techniques are used to improve the user’s vision: for example, by providing night vision, thermal vision, bifocal, or magnifying glass capabilities. (EX-1005, 10, 11, 15; EX-1003, ¶89.)

The above features are consistent with what the ’929 Patent calls a “key feature” of the media focals: “being able to more accurately and clearly see the objects” in the user’s field of view. (EX-1001, 3:4-7; EX-1003, ¶90.)

For the above reasons, Mann ’895 in view of Perner teaches that *the circuitry provides media focals*. (EX-1003, ¶92.) Thus, Mann ’895 in view of Perner also teaches that *the circuitry provides any of a cell phone, media focals, and an MP3 player*. (EX-1003, ¶92.)

(ii) a cell phone

Mann ’895 in view of Perner meets this element. (EX-1003, ¶93.) Mann ’895 discloses that “devices in the eyeglasses ... allow the eyeglasses to function as a *telephone, videophone*, pocket organizer, personal safety device, or the like.”

(EX-1005, 10 (emphasis added); EX-1003, ¶93.)

A POSITA would have understood Mann '895's "devices in the eyeglasses," that "allow the eyeglasses to function as a telephone," "videophone," or "pocket organizer," to teach that the circuitry of those devices provides a cell phone, as recited in the claim. (EX-1005, 10; EX-1003, ¶94.) First, by the effective filing date of October 7, 2005, cellular telephones (cell phones) were becoming ubiquitous. (EX-1003, ¶94.) For example, according to the U.S. Census Bureau, by 2005, 71 percent of U.S. households owned a cell phone (up from 36 percent in 1998); and, according to World Bank data, in 2005, there were over 203 million mobile cellular subscriptions in the United States—69 such subscriptions per 100 people. (*Cellphone Ownership Soared Since 1998*, WALL ST. J., Nov. 27, 2009 (<https://www.wsj.com/articles/BL-REB-8073>); World Bank, *Mobile cellular subscriptions – United States* <https://data.worldbank.org/indicator/IT.CEL.SETS?locations=US>; EX-1003, ¶94.)

In view of the prevalence of cell phones by 2005, the POSITA would have understood Mann '895's disclosure of "telephone" and "videophone" to include cell phones. (EX-1003, ¶94.) Second, the POSITA would have understood that a telephone or videophone in a mobile wearable device, such as Mann '895's eyewear, must also be a mobile device—such as a cell phone. (EX-1003, ¶94.) If it were not, the eyewear would not be mobile and wearable. (EX-1003, ¶94.)

In the co-pending litigation, the Patent Owner took the position that the claimed cell phone should be viewed in a “broad context of telecommunications enhancements”; and that “the patentee intended a broad interpretation of ‘cell phone’” to include “functions such as accessing voicemail, email, multimedia messages, and other data.” (EX-1008, 15 (citing EX-1001, 1:48-56, 4:46-5:39).) Under the Patent Owner’s position, the claimed cell phone is met at least by the “telephone,” “videophone,” and “pocket organizer” functions of Mann ’895’s eyewear. (EX-1003, ¶95.) For example, as the POSITA would recognize, a telephone allows a user to access voicemail; a videophone allows a user to access multimedia messages (*e.g.*, messages with audio and video); and a pocket organizer allows a user to access email and other data. (EX-1003, ¶95.)

For the above reasons, Mann ’895 in view of Perner teaches that *the circuitry provides a cell phone*. (EX-1003, ¶96.)

(iii) *an MP3 player*

Mann ’895 in view of Perner meets this element. (EX-1003, ¶97.) Mann ’895 discloses that a computer can be built into the eyeglass frames. (EX-1005, 10; EX-1003, ¶97.) Mann ’895 also discloses that “devices in the eyeglasses ... allow the eyeglasses to function as a telephone, videophone, pocket organizer, personal safety device, or the like.” (EX-1005, 10; EX-1003, ¶97.)

A POSITA would have understood the above devices in the eyeglasses to

teach that the circuitry of those devices provides an MP3 player, as recited in the claim. (EX-1003, ¶98.) By the effective filing date of October 7, 2005, MP3 players had become commonplace, with many portable electronic devices (such as mobile telephones) incorporating MP3 player functionality. (EX-1003, ¶98.)

For example, in December 2004, the technology website *Engadget* announced a prediction that the year 2005 would be “all about MP3 phones,” referencing numerous then-current trends: the popularity of the iPod (a dedicated portable MP3 player); the decreasing cost of flash memory; the growth of mini hard drives; the arrival of high-speed 3G data services; a partnership between Apple and Samsung to bring the iTunes MP3 player software to handsets; and the prevalence of “smartphones and regular cellphones already available now which can play MP3s.” (Peter Rojas, *2005 the year of the MP3 phone?*, ENGADGET (Dec. 29, 2004), <https://www.engadget.com/2004-12-29-2005-the-year-of-the-mp3-phone.html> (accessed Jan. 7, 2023); EX-1003, ¶98.)

The POSITA would thus have understood at least Mann ’895’s disclosure of “telephone” and “videophone” to include MP3 players, based at least on the factors identified above. (EX-1003, ¶98.) The POSITA further would have understood the computer in Mann ’895’s eyewear to include an MP3 player, at least because the computer (like many computers in 2005) would have been capable of running MP3 player software, such as the aforementioned iTunes software. (EX-1003,

¶98.)

In the co-pending litigation, the Patent Owner took the position that the claimed MP3 player should be viewed in a “broad context of playing or downloading music generally,” referencing a dictionary definition of an MP3 player as “a device for playing MP3s or other digital audio files.” (EX-1008, 17-18 (citing EX-1001, 4:3-7).) Under the Patent Owner’s position, the claimed MP3 player is thus taught at least by the “computer,” “telephone,” “videophone” and “pocket organizer” functions of Mann ’895’s eyewear. (EX-1003, ¶99.) A POSITA would have recognized that all of these devices can allow the user to play digital audio files, such as via the speakers of the Mann ’895 eyewear. (EX-1005, 10; EX-1003, ¶99.)

For the above reasons, Mann ’895 in view of Perner teaches that *the circuitry provides an MP3 player*. (EX-1003, ¶100.)

10. Claim 8

Mann ’895 in view of Perner meets each limitation of claim 8. (EX-1003, ¶101.)

a. [Preamble] *Eyewear comprising:*

Mann ’895 in view of Perner meets the preamble as described for 1[Preamble]. (EX-1003, ¶102.)

b. [A] *a frame member;*

Mann '895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶103.)

c. [B] *a lens;*

Mann '895 in view of Perner meets this element as described for 1[B]. (EX-1003, ¶104.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Mann '895 in view of Perner meets this element as described for 1[C]. (EX-1003, ¶105.)

e. [D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user;*

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶106.)

f. [E] *wherein the eyewear can be utilized in a client server system to allow for the display of certain information.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶107.) Mann '895 discloses at least three instances where the eyewear can be utilized in a client server system to allow for the display of certain information. (EX-1003, ¶107.) Any one of these instances, let alone all three, would be sufficient to meet the claim limitation. (EX-1003, ¶107.)

First, Mann '895 discloses a "Sight License server," and similarly discloses that the eyewear can download a sight license "over the network," to enable the eyeglasses to operate. (EX-1005, 11, 20; EX-1003, ¶108.) A POSITA would have understood downloading a file over a computer network, such as from the Sight License server, to teach downloading a file by *utilizing a client server system*, at least because client server systems are ubiquitous components of computer networks. (EX-1014, 4 ("[T]he client-server model ... is widely used and forms the basis of much network usage."); EX-1003, ¶108.) For example, in such a network, a client device (e.g., the Mann '895 eyewear) can download a file from a server, such as the Sight License server, that hosts the file. (EX-1003, ¶108.) This is analogous to the '929 Patent's description that the eyeglasses can use a client server system to retrieve live news or special reports from the Internet (a computer network). (EX-1001, 3:44-50; EX-1003, ¶108.) Mann '895's sight license *allows for the display of certain information* by providing a "license to see," such that downloading the sight license over the network, such as from the Sight License server, "enable[s] the eyeglasses to operate." (EX-1005, 11, 20; EX-1003, ¶108.)

Second, Mann '895 discloses that the eyewear "allows the storage and retrieval of images by transmitting and recording images at one or more remote locations." (EX-1005, 6; EX-1003, ¶109.) A POSITA would have understood the eyewear storing and retrieving images from a remote location to teach storing and

retrieving the images *utilizing a client server system* (e.g., in which the eyewear includes a client and the remote location includes a server). (EX-1003, ¶109.) This is at least because client server systems are a ubiquitous way for a device (e.g., a client device) to exchange data with a remotely located computer (e.g., a server). (TANENBAUM, 4-5; EX-1003, ¶109.) Retrieving the images from the server *allows for the display of certain information* (i.e., the images). (EX-1003, ¶109.)

Third, Mann '895 discloses that clocks in the environment may be equipped with “special license servers,” such that the clock “does not properly display time” to eyewear that does not have a license. (EX-1005, 13, EX-1003, ¶110.) A POSITA would have understood this to teach *utilizing a client server system* in which a client (the eyewear) connects to a server (the special license server) to *allow for the display of certain information* (the correct time). (EX-1003, ¶110.)

11. Claim 10

Mann '895 in view of Perner meets each limitation of claim 10. (EX-1003, ¶112.)

a. [Preamble] *Eyewear comprising:*

Mann '895 in view of Perner teaches preamble as described for 1[Preamble]. (EX-1003, ¶113.)

b. [A] *a frame member;*

Mann '895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶114.)

c. [B] *a lens;*

Mann '895 in view of Perner meets this element as described for 1[B]. (EX-1003, ¶115.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Mann '895 in view of Perner meets this element as described for 1[C]. (EX-1003, ¶116.)

e. [D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user;*

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶117.)

f. [E] *wherein the circuitry can provide any of texts, email; multimedia information; caller id.*

Mann '895 in view of Perner meets this element. (EX-1003, ¶118.) By the plain text of the claim, the circuitry can provide “any of” the four recited features: (1) texts, (2) email, (3) multimedia information, and (4) caller id. This element is thus met if the references teach that the circuitry can provide one or more of the above four features. (*See Intell. Ventures II LLC, supra* at *3-4.) But as described

below, the circuitry can provide *all four* of the features. (EX-1003, ¶118.)

(i) *texts*

Mann '895 in view of Perner meets this element. (EX-1003, ¶119.) As described for claim 1, Mann '895 discloses eyeglasses with circuitry within the frames; for instance, the eyeglasses can include a display (*e.g.*, a viewfinder) that allows the wearer to view data, such as from a wearable computer. (EX-1005, 4, EX-1003, ¶119.) This data can include texts. (EX-1003, ¶119.) As one example, Mann '895 describes that a camera within the eyeglasses can recognize the face of someone in the camera's field of view, and "superimpose the name of the person it recognized into the viewfinder." (EX-1005, 4, EX-1003, ¶119.) A POSITA would have understood superimposing the person's name on the display to teach that the circuitry provides *texts*. (EX-1003, ¶119.)

As another example, as described for 1[E], Mann '895 discloses that the display includes information including an "organizer, calendar, clock, airline information, etc." (EX-1005, 5, EX-1003, ¶120.) The information display can also present "3D scene information and annotation." (EX-1005, 11; EX-1003, ¶120.) The POSITA would have understood these features to teach that the circuitry provides *texts*. (EX-1003, ¶120.) For example, the POSITA would have understood in 2005 that each of the organizer, calendar, clock, and airline information would present texts on the display in order to convey their respective

information (*e.g.*, airline flight times). (EX-1003, ¶120.)

As another example, as described for 7[E], Mann '895 discloses that a computer can be built into the eyeglass frames. (EX-1005, 10; EX-1003, ¶121.) Mann '895 also discloses that “devices in the eyeglasses ... allow the eyeglasses to function as a telephone, videophone, pocket organizer, personal safety device, or the like.” (EX-1005, 10; EX-1003, ¶121.) The POSITA would have understood these features to teach that the circuitry provides *texts*. (EX-1003, ¶121.) For example, the POSITA would have understood in 2005 that a telephone, videophone, or pocket organizer in the eyeglasses would present text messages, such as SMS messages, to the user. (EX-1003, ¶121.) This is consistent with a position taken by the Patent Owner in the co-pending litigation, in which it characterized “accessing voicemail, email, multimedia messages, and other data” as “typical cell phone functions” in the context of the '929 Patent. (EX-1008, 15; EX-1003, ¶121.)

For the above reasons, Mann '895 in view of Perner teaches that *the circuitry can provide texts*. (EX-1003, ¶122.) Thus, Mann '895 in view of Perner also teaches that *the circuitry can provide any of texts, email; multimedia information; caller id*. (EX-1003, ¶122.)

(i) *email*

Mann '895 in view of Perner meets this element. (EX-1003, ¶123.) For

example, as described above, Mann '895 discloses that the eyeglass frames can include a computer, a telephone, a videophone, and a pocket organizer. (EX-1005, 10; EX-1003, ¶123.) The POSITA would have understood that each of these devices in 2005 would provide *email* to the user. (EX-1003, ¶123.) This is consistent with a position taken by the Patent Owner in the co-pending litigation, in which it characterized “accessing voicemail, *email*, multimedia messages, and other data” as “typical cell phone functions” in the context of the '929 Patent. (EX-1008, 15 (emphasis added); EX-1003, ¶123.)

For the above reasons, Mann '895 in view of Perner teaches that *the circuitry can provide email*. (EX-1003, ¶124.)

(i) *multimedia information*

Mann '895 in view of Perner meets this element. (EX-1003, ¶125.) For example, as described above, Mann '895 discloses that the eyeglass frames can include a computer, a telephone, and a videophone. (EX-1005, 10; EX-1003, ¶125.) The POSITA would have understood that each of these devices would present *multimedia information* to the user. (EX-1003, ¶125.) For example, by 2005, at least a computer and a videophone could provide multimedia information, at least by presenting multimedia content that includes video and audio; and at least a telephone and a videophone could provide multimedia information by sending multimedia messages (*e.g.*, in the Multimedia Messaging Service (MMS))

format). (EX-1003, ¶125.) This is consistent with a position taken by the Patent Owner in the co-pending litigation, in which it characterized “accessing voicemail, email, *multimedia messages*, and other data” as “typical cell phone functions” in the context of the ’929 Patent. (EX-1008, 15 (emphasis added); EX-1001, 5:36-39; EX-1003, ¶125.)

For the above reasons, Mann ’895 in view of Perner teaches that *the circuitry can provide multimedia information*. (EX-1003, ¶126.)

(i) *caller id*

Mann ’895 in view of Perner meets this element. (EX-1003, ¶127.) For example, as described above, Mann ’895 discloses that the eyeglass frames can include a telephone or a videophone. (EX-1005, 10; EX-1003, ¶127.) The POSITA would have understood that each of these devices would present *caller id* to the user. (EX-1003, ¶127.) For example, the ’929 Patent describes that cell phone circuitry allows “a telephone number ... to be displayed” on the lens of the eyewear. (EX-1001, 4:43-50; EX-1003, ¶127.) Displaying the telephone number for an incoming call was a ubiquitous feature of telephones and videophones in 2005. (EX-1003, ¶127.) Moreover, this is consistent with the position taken by the Patent Owner in the co-pending litigation, in which it characterized “accessing voicemail, email, multimedia messages, *and other data*” as “typical cell phone functions” in the context of the ’929 Patent. (EX-1008, 15 (emphasis added); EX-

1003, ¶127.) The POSITA would have understood the “other data” in this context to include incoming caller data. (EX-1003, ¶127.)

For the above reasons, Mann ’895 in view of Perner teaches that *the circuitry can provide caller id*. (EX-1003, ¶128.)

12. Claim 11

Mann ’895 in view of Perner meets each limitation of claim 11. (EX-1003, ¶129.)

a. [Preamble] *Eyewear comprising:*

Mann ’895 in view of Perner meets the preamble as described for 1[Preamble]. (EX-1003, ¶130.)

b. [A] *a frame member;*

Mann ’895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶131.)

c. [B] *a lens,*

Mann ’895 in view of Perner meets this element as described for 1[B]. (EX-1003, ¶132.)

d. [C] *wherein an information bar is provided on the lens;*

Mann ’895 in view of Perner meets this element as described for 1[E]. (EX-1003, ¶133.)

e. **[D] *a digital camera;***

Mann '895 in view of Perner meets this element as described for 1[C] and 6[A]. (EX-1003, ¶134.) For example, Mann '895 discloses a camera that is “concealed in the eyeglass frames.” (EX-1005, 6-7; EX-1003, ¶134.) Mann '895 broadly defines “cameras” to include digital cameras. (EX-1005, 8; EX-1003, ¶134.)

f. **[E] *circuitry within the frame member and coupled to the camera for enhancing the use of the eyewear,***

Mann '895 in view of Perner meets this element as described for 1[C]. (EX-1003, ¶135.) The circuitry is coupled to the camera as described for 1[C] and 6[A]. (EX-1003, ¶135.)

g. **[F] *wherein the circuitry provides any of a cell phone, media focal, and an MP3 player, or wherein the circuitry can provide any of texts, email; multimedia information; caller id; and***

Mann '895 in view of Perner meets this element as described for 7[E] and 10[E]. (EX-1003, ¶136.)

h. **[G] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user,***

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶137.)

- i. **[H] *wherein the eyewear can be utilized in a client server system to allow for the display of certain information, or wherein the eyewear includes a pushbutton system for control.***

Mann '895 in view of Perner meets this element as described for 8[E]. (EX-1003, ¶138.)

13. Claim 15

Mann '895 in view of Perner meets each limitation of claim 15. (EX-1003, ¶139.)

- a. **[Preamble] *Eyewear comprising:***

Mann '895 in view of Perner meets the preamble as described for 1[Preamble]. (EX-1003, ¶140.)

- b. **[A] *a frame member;***

Mann '895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶141.)

- c. **[B] *a lens; and;***

Mann '895 in view of Perner meets this element as described for 1[B]. (EX-1003, ¶142.)

- d. **[C] *circuitry within the frame member for enhancing the use of the eyewear utilizing a client server model; and***

Mann '895 in view of Perner meets this element as described for 8[E]. (EX-1003, ¶143.)

- e. **[D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user.***

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶144.)

14. Claim 17

Mann '895 in view of Perner meets each limitation of claim 17. (EX-1003, ¶145.)

- a. **[Preamble] *Eyewear comprising:***

Mann '895 in view of Perner meets the preamble as described for 1[Preamble]. (EX-1003, ¶146.)

- b. **[A] *a frame member;***

Mann '895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶147.)

- c. **[B] *a lens, wherein an information bar is provided on the lens;***

Mann '895 in view of Perner meets this element as described for 1[B] and [E]. (EX-1003, ¶148.)

- d. **[C] *wherein the lens has a set of integrated media enhancements,***

Mann '895 in view of Perner meets this element. (EX-1003, ¶149.) For example, as described for 1[E], Mann '895's eyewear can present various media

enhancements on the lens, such as 3D scene information and annotation overlaid on an image. (EX-1005, 11; EX-1003, ¶149.) The eyewear can also present texts (e.g., names), as described above for 10[E](i). (EX-1003, ¶149.) This set of media enhancements is *integrated* at least because it is provided by circuitry that is integrated into the frame of the eyeglasses; and presented via a display that is integrated into the lens of the eyeglasses, as described for claim 1. (EX-1003, ¶149.)

e. [D] *wherein an information is provided on the lens,*

Mann '895 in view of Perner meets this element as described for 1[E]. (EX-1003, ¶150.)

f. [E] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of the user, and;*

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶151.)

g. [F] *circuitry within the frame member for enhancing the use of the eyewear;*

Mann '895 in view of Perner meets this element as described for 1[C]. (EX-1003, ¶152.)

- h. [G] *wherein the circuitry includes voice recognition when a speaker is recognized, wherein the eyewear can be utilized in a client server system to allow for the display of certain information, or wherein the eyewear includes a pushbutton system for control, or wherein the circuitry can provide any of texts, email; multimedia information; caller id.***

Mann '895 in view of Perner meets this element at least as described for 8[E] (for *client server system*) and 10[E] (for *any of texts, email; multimedia information; caller id*). (EX-1003, ¶153.)

15. Claim 22

Mann '895 in view of Perner meets each limitation of claim 22. (EX-1003, ¶154.)

- a. [Preamble] *Eyewear comprising:***

Mann '895 in view of Perner meets the preamble as described for 1[Preamble]. (EX-1003, ¶155.)

- b. [A] *a frame member;***

Mann '895 in view of Perner meets this element as described for 1[A]. (EX-1003, ¶156.)

- c. [B] *a lens;***

Mann '895 in view of Perner meets this element as described for 1[B]. (EX-1003, ¶157.)

d. [C] *a binocular mechanism;*

Mann '895 in view of Perner meets this element. (EX-1003, ¶158.) For example, Mann '895 discloses that “*either or both eyes* may be accommodated with display capability,” and that, in a preferred embodiment, “*both eyes* have a display.” (EX-1005, 3, 9 (emphasis added); EX-1003, ¶158.) Mann '895's display is thus a *binocular mechanism*. (EX-1003, ¶158.)

Moreover, the '929 Patent describes that using the eyewear as binoculars can “allow for the user to see objects more closely based on certain activities of the user.” (EX-1001, 3:4-14; EX-1003, ¶159.) Mann '895's binocular mechanism allows the user to see objects more closely at least because the display is “magnified” by optics 110—for example, by “magnifying surface” S3. (EX-1005, 9; EX-1003, ¶159.) Further, the lens of Mann '895's eyewear can include an inset lens 350, which may be a “magnifying glass,” allowing the user to see objects more closely when the user looks through the inset lens. (EX-1005, 15; EX-1003, ¶159.)

e. [D] *circuitry within the frame member and coupled to the binocular mechanism for enhancing the use of the eyewear; and*

Mann '895 in view of Perner meets this element as described for 1[C] and 22[C]. (EX-1003, ¶160.)

- f. *[E] an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user.*

Mann '895 in view of Perner meets this element as described for 1[D]. (EX-1003, ¶161.)

VI. JANNARD RENDERS OBVIOUS CLAIMS 7, 9, 10, AND 15

A. Ground 2: Claims 7, 9, 10, And 15 Are Obvious In View Of Jannard

1. Summary of Jannard

Jannard is a U.S. patent that was filed on November 19, 2004, published on September 15, 2005, and issued on October 9, 2007. Jannard is thus prior art to the '929 Patent under at least 35 U.S.C. § 102(a) and (e). Jannard indicates that it was assigned to the eyewear company Oakley, Inc. (EX-1007, Cover Page.)

Jannard is directed to head-wearable audio devices. (EX-1007, 1:22-24; EX-1003, ¶164.) Jannard's wearable audio devices include eyeglasses with lenses, speakers, and circuitry integrated into the eyeglasses frame. (EX-1007, 11:11-27, 20:60-67, 45:59-46:8, Fig. 22; EX-1003, ¶164.) The circuitry of the audio device can be configured to "store and playback any desired type of electronic audio and/or video file," thereby functioning as an "audio storage and playback system." (EX-1007, 20:60-21:4; EX-1003, ¶164.) For example, the audio device can "store MP3 files in a memory" and "play back the MP3 files through the speakers." (EX-1007, 21:4-7; EX-1003, ¶164.) In some embodiments, one or more lenses can be a

“view finder or a video display unit.” (EX-1007, 12:41-43.)

Fig. 24 illustrates an embodiment 304 of a wearable audio device according to Jannard:

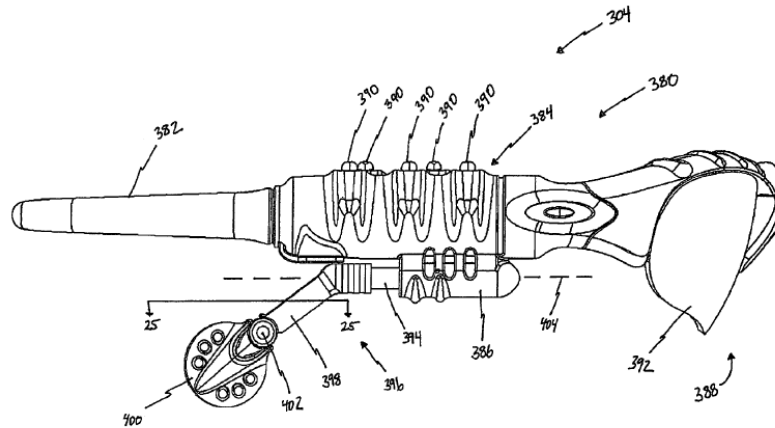


Figure 24

(EX-1007, Fig. 24; EX-1003, ¶165.)

With respect to Fig. 24, an electronic housing 384 is formed within frame 380 of audio device 304. (EX-1007, 45:59-46:8; EX-1003, ¶166.) Jannard discloses that “electronic components of the audio device 304,” such as “any one or all of the components described ... with respect to FIG. 22 and elsewhere [in Jannard],” are “at least partially enclosed within electronic housing 384.” (EX-1007, 46:5-8 (emphasis added); EX-1003, ¶166.) Fig. 22 illustrates electronic components that can be enclosed within the frame of the audio device 304:

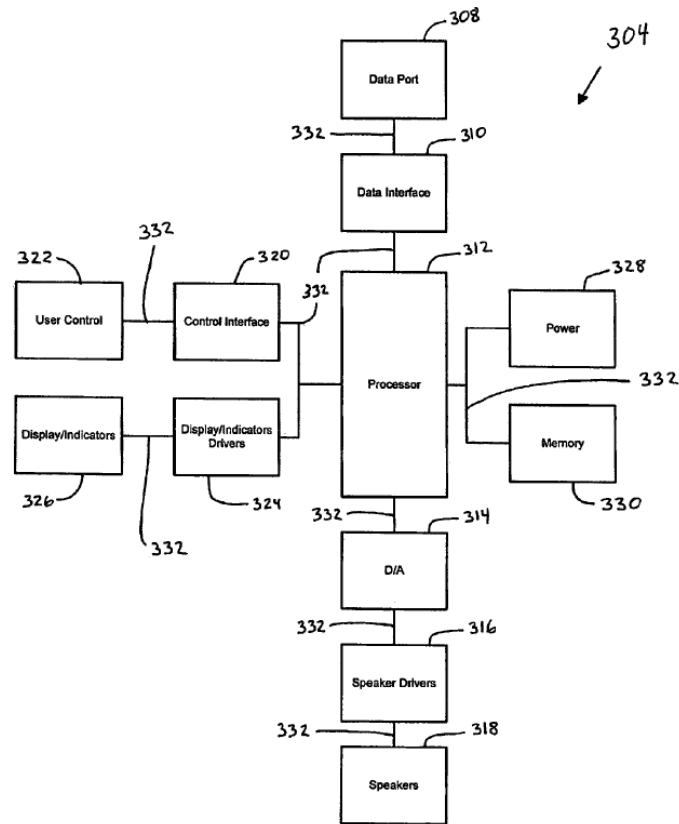


Figure 22

(EX-1007, Fig. 22; EX-1003, ¶166.)

One of those electronic components of the audio device is user controls 322, which can include a sensor to “monitor eye movement,” and control the audio device based upon, *e.g.*, “blinking of the user’s eyes.” (EX-1007, 42:67-43:2; EX-1003, ¶167.) For instance, user controls 322 can control media playback, or turn the audio device 304 on and off, based on the user’s eye movement. (EX-1007, 43:3-11; EX-1003, ¶167.) Another component can include processor 312, which “controls the overall function and operation” of the audio device. (EX-1007, 41:12-16, Fig. 22; EX-1003, ¶167.)

Audio devices can communicate with a content source 302 to send and receive content via a communications link 306. (EX-1007, 39:63-67; EX-1003, ¶168.) For example, audio device 304 can download music from the content source. (EX-1007, 40:31-36; EX-1003, ¶168.) Fig. 21 illustrates an example:

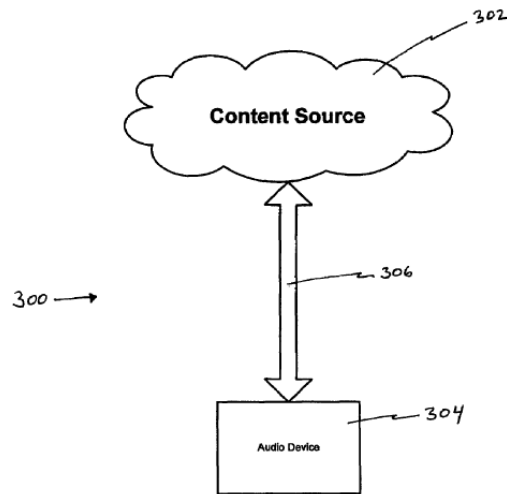


Figure 21

(EX-1007, Fig. 21; EX-1003, ¶168.)

Content source 302 can include, *e.g.*, a computer, a network, a storage device (such as a hard drive or USB drive), a Bluetooth-enabled telephone, a PDA, or a Blackberry device. (EX-1007, 39:67-40:12; EX-1003, ¶169.) The content source 302 can provide, *e.g.*, “audio files, entertainment, news, media, music, photos, videos, advertising, etc.” (EX-1007, 39:67-40:12; EX-1003, ¶169.) Communications link 306 can include, *e.g.*, a cable (such as a USB or Firewire cable), a wire, a conductor, a bus, or a Bluetooth signal. (EX-1007, 40:18-25; EX-

1003, ¶169.)

2. Claim 7

Jannard meets each limitation of claim 7. (EX-1003, ¶170.)

a. [Preamble] *Eyewear comprising:*

The preamble is taught by Jannard. (EX-1003, ¶171.) For example, Jannard's head-wearable audio devices can be "any of a variety of *eyewear* such as goggles, masks, face shields and eyeglasses." (EX-1007, 11:13-27 (emphasis added); EX-1003, ¶171.) Fig. 32 illustrates a view of an eyeglasses embodiment of an audio device 304:

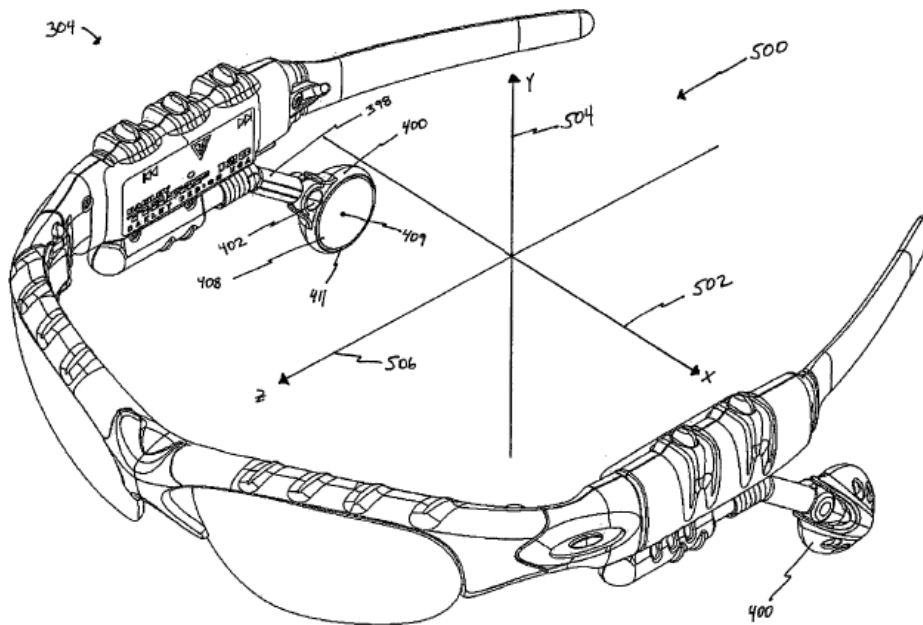


Figure 32

(EX-1007, 10:66-67, Fig. 32; EX-1003, ¶171.)

b. [A] a frame member;

Jannard meets this element. (EX-1003, ¶172.) For example, Jannard discloses that the audio device 304 “includes a *frame* 380,” as shown in Fig. 24 below:

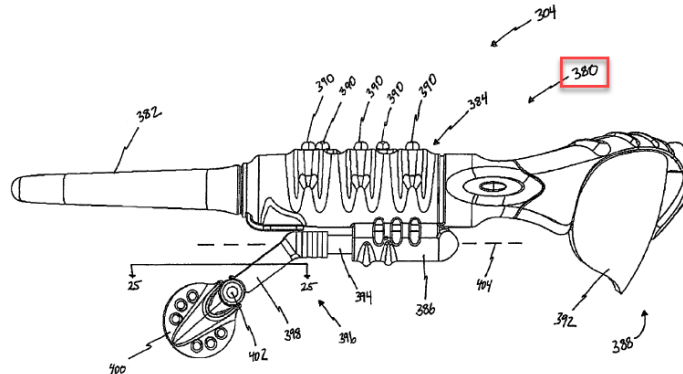


Figure 24

(EX-1007, 45:63-66 (emphasis added), Fig. 24 (annotated); EX-1003, ¶172.)

c. [B] a lens;

Jannard meets this element. (EX-1003, ¶173.) For example, Jannard discloses that the audio device 304 includes a *lens* 392, such as shown in Fig. 24 below:

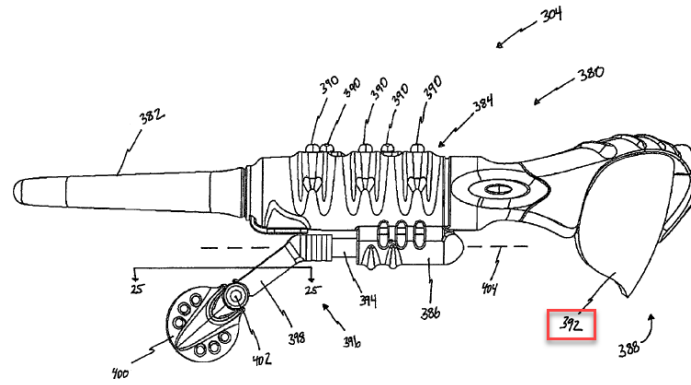


Figure 24

(EX-1007, 45:63-66, 46:12-13, Fig. 24 (annotated); EX-1003, ¶173.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Jannard meets this element. (EX-1003, ¶174.) For example, with respect to Fig. 24, an electronic housing 384 is formed within frame 380 of audio device 304. (EX-1007, 45:59-46:8; EX-1003, ¶174.) Jannard discloses that “*electronic components* of the audio device 304,” such as “*any one or all* of the components described ... with respect to FIG. 22 and elsewhere [in Jannard],” are “at least partially enclosed within electronic housing 384.” (EX-1007, 46:3-8 (emphasis added); EX-1003, ¶174.) Electronic housing 384 of frame 380 is shown in Fig. 24:

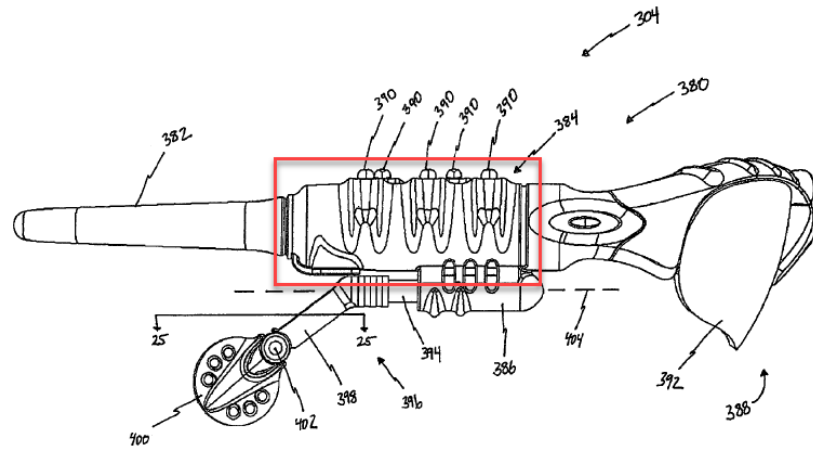


Figure 24

(EX-1007, 45:59-46:2, Fig. 24 (annotated); EX-1003, ¶174.)

Fig. 22 describes circuitry for audio device 304 that, as described above, can be enclosed within the electronic housing 384 of the frame:

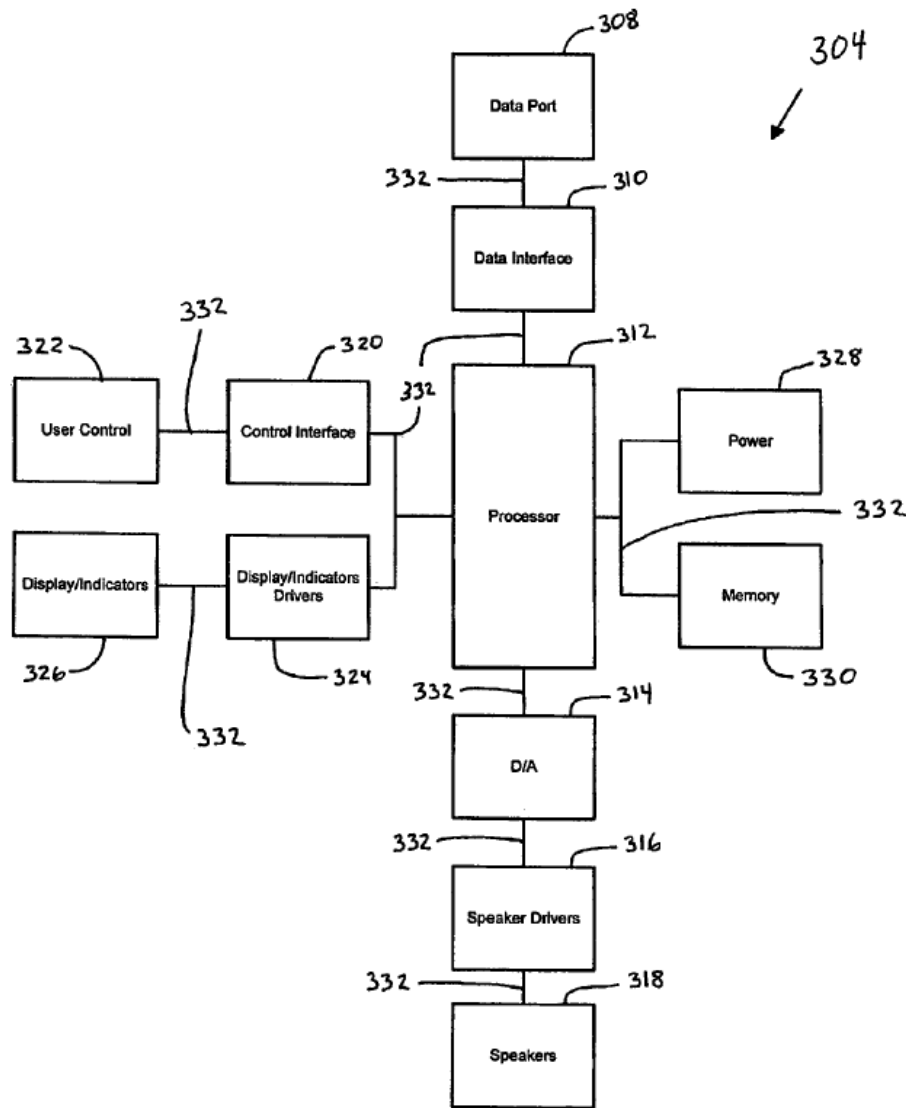


Figure 22

(EX-1007, 40:37-49, Fig. 22; EX-1003, ¶175.)

The circuitry in the frame member can include a processor 312, which “controls the overall function and operation of audio device 304.” (EX-1007, 41:12-16, Fig. 22; EX-1003, ¶176.) Processor 312 can be, for example, a microprocessor that executes software instructions. (EX-1007, 41:16-23; EX-

1003, ¶176.) Processor 312 “couples directly or indirectly to the various electronic components of the audio device 304.” (EX-1007, 41:12-16; EX-1003, ¶176.) For example, processor 312 can couple to a memory module 330, which can store audio data files, such as MP3 files. (EX-1007, 43:60-61, Fig. 22; EX-1003, ¶176.) Processor 312 can, among other tasks, “process encoded digitized audio data,” including stored MP3 files, for presentation to a user via speakers of the audio device 304. (EX-1007, 41:31-42:10, 45:36-58, Fig. 23; EX-1003, ¶176.)

Other circuitry components of Fig. 22 that can be included in the frame member include display/indicators 326 and display/indicator drivers 324, which can be used to display media information such as a song selection, a song title, or other data related to an audio file. (EX-1007, 43:12-26, Fig. 22; EX-1003, ¶177.)

To the extent not expressly disclosed in Jannard, it would have been obvious to a POSITA that circuitry of content source 302 can be located within the frame member of the audio device with reasonable expectation of success. (EX-1003, ¶178.) For example, Jannard provides that audio device 304 may “include any or all of the features of any of the audio devices described above with respect to FIGS. 1-23.” (EX-1007, 45:60-63; EX-1003, ¶178.) The POSITA would thus have understood the content source 302 to be one such feature, based at least on its description with respect to Fig. 21 of Jannard. (EX-1007, 39:63-40:36, Fig. 21; EX-1003, ¶178.)

Jannard additionally provides, as noted above, that “any one or all of the components described ... with respect to FIG. 22 *and elsewhere herein*,” are “at least partially enclosed within electronic housing 384” of the frame 380 of audio device 304. (EX-1007, 46:3-8 (emphasis added); EX-1003, ¶179.) The POSITA would have understood Jannard to teach that the content source 302 is one of the components described “elsewhere herein,” with respect to Jannard, that could be enclosed within the housing. (EX-1007, 28:3-9, 37:31-32, 37:66-38:1, Fig. 9A; EX-1003, ¶179.)

For example, the POSITA would have understood Jannard to teach that the content source 302—which may include, for example, telephone, PDA, or Blackberry functionality—could be implemented using components of Fig. 22, such as processor 312, memory 330, user control 322, display 326, speakers 318, power 328, conductors 332, and data interface 310. (EX-1007, 40:37-44:10; Fig. 22; EX-1003, ¶180.) This is so at least because the components of Fig. 22 include components common to content source 302. (EX-1003, ¶180.) For instance, memory 330 can include a memory card or a USB drive, and content source 302 can be a memory card or a USB drive. (EX-1007, 39:67-40:9; EX-1003, ¶180.)

The POSITA would have had a reasonable expectation of success in implementing Jannard in this manner, at least because the POSITA would have done so using the same electronic components already present in Jannard, as

shown in Fig. 22, and by using them in their usual manner. (EX-1003, ¶180.)

Furthermore, these electronic components are commonly used and well understood components, such as a processor, memory, display, and data interface, such that the POSITA would have known how to use them to implement content source 302 without undue experimentation. (EX-1003, ¶180.)

Further, content source 302 can include electronic communications devices such as telephones, PDAs, and Blackberry devices. (EX-1007, 39:67-40:12; EX-1003, ¶181.) As a POSITA would have recognized, these devices include circuitry that can be implemented using components such as processors, memory, power supplies, user controls, displays, conductors, data interfaces, and other components of Fig. 22 with a reasonable expectation of success. (EX-1007, 40:37-44:10; Fig. 22; EX-1003, ¶181.) The POSITA would thus have understood Jannard to teach that the content source 302 may include components, such as circuitry of a telephone or PDA, enclosed within the housing 384 of the frame. (EX-1003, ¶181.)

The circuitry *enhances the use of the eyewear* at least as described for element [E] below and for 10[E]. (EX-1003, ¶182.) For example, the circuitry enhances the use of the eyewear at least by providing any of a cell phone, media focals, and an MP3 player; and further by providing any of texts, email, multimedia information, caller id. (EX-1003, ¶182.)

- e. [D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user*

Jannard meets this element. (EX-1003, ¶183.) Jannard discloses circuitry within a frame member of audio device 304 as described for [C]. (EX-1003, ¶183.) Jannard further discloses that user controls 322 of audio device 304 include a “sensor,” and/or “any other input device that may be used by a user to control the audio device 304.” (EX-1007, 42:60-63; EX-1003, ¶183.) The user controls 322 may be responsive to a biometric provided by a user to control the audio device 304. (EX-1007, 42:65-66; EX-1003, ¶183.) As an example, the user controls “may *monitor eye movement*, and control the audio device 304 based upon blinking of the user’s eyes.” (EX-1007, 42:67-43:2 (emphasis added); EX-1003, ¶183.) A POSITA would have understood that a *sensor* of user controls 322, that *monitors eye movement*, meets the claimed *eye sensor*. (EX-1003, ¶183.)

To the extent not expressly disclosed in Jannard, it would have been obvious to the POSITA that the eye sensor of user controls 322 is *coupled to the frame member*, at least because Jannard discloses that “any one or all of the components described ... with respect to Fig. 22 ... are at least partially enclosed within electronic housing 384” of the frame 380; and because the components described with respect to Fig. 22 include the user controls 322. (EX-1007, 46:3-8, Fig. 22; EX-1003, ¶184.) The POSITA would have had a reasonable expectation of

success in coupling the eye sensor to the frame member, at least because Jannard describes in detail, including through detailed figures, example relationships between the electronic housing 384 and the frame 380 with respect to the audio device. (*See, e.g.*, EX-1007, Figs. 22, 24, 28, 32, 35; EX-1003, ¶184.)

The eye sensor *activates the circuitry* responsive to eye motion of the user at least by “turn[ing] power on or off”. (EX-1007, 43:5-11 (emphasis added); EX-1003, ¶185.) The eye sensor can additionally activate the circuitry by activating functionality of the MP3 player, described below with respect to section [E](i): for example, by activating media playback functions (e.g., fast-forward, skip, cue, play, pause, rewind), media file functions (e.g., load a playlist, delete a playlist), or “any other function related to an audio data file.” (EX-1007, 43:3-11; EX-1003, ¶185.)

Jannard’s eye sensor activating the circuitry by activating media playback or file management functions is consistent with the Patent Owner’s position in the co-pending litigation, in which the Patent Owner argued that “activate” means to “cause to function or act,” or to “make active or more active.” (EX-1008, 12 (emphasis in original); EX-1003, ¶186.) It is also consistent with the Petitioner’s narrower position in the co-pending litigation, under which “activating the circuitry” is to make “inactive circuitry become active” (e.g., by turning the power on as described above). (EX-1003, ¶186.)

Jannard’s teaching of blinking to control the audio device is also analogous to the ’929 Patent’s “preferred embodiment” of “controlling the digital media,” in which the user can “blink twice” to activate a function of the digital media (*e.g.*, zooming an image). (EX-1001, 3:36-40; EX-1003, ¶187.)

f. [E] *wherein the circuitry provides any of a cell phone, media focals, and an MP3 player.*

Jannard meets this element. (EX-1003, ¶188.) For example, as described for element [C], Jannard discloses circuitry within the frame of audio device 304. (EX-1003, ¶188.)

As described for Ground 1, the circuitry only needs to provide at least one of a cell phone, media focals, and an MP3 player in order to meet this claim element. (*See Intell. Ventures II LLC, supra* at *3-4.) For example, the claim is satisfied if the circuitry provides only the MP3 player. Nevertheless, all three of the cell phone, media focals, and MP3 player are provided by the circuitry of Jannard as described below. (EX-1003, ¶189.)

(i) *MP3 player*

Jannard meets this element. (EX-1003, ¶190.) For example, Jannard discloses wearable audio devices that can be configured to “store and playback any desired type of electronic audio and/or video file,” thereby functioning as an “audio storage and playback system.” (EX-1007, 20:60-21:4; EX-1003, ¶190.) The audio storage and playback system of the audio devices can “store MP3 files

in a memory” and “play back the MP3 files through the speakers.” (EX-1007, 21:4-7; EX-1003, ¶190.)

Fig. 23 below illustrates an example process 350 of playing MP3 files:

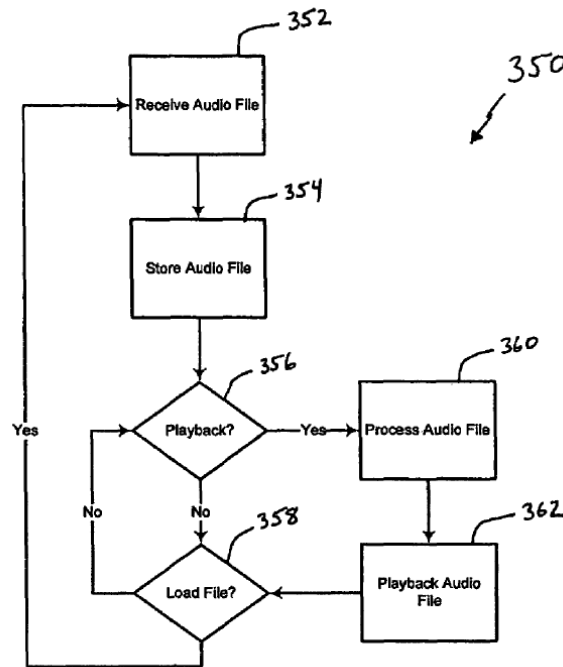


Figure 23

(EX-1007, 45:28-35, Fig. 23; EX-1003, ¶191.)

With respect to process 350 in the above figure, an “MP3 formatted audio file” is stored in the audio device 304 at block 354. (EX-1007, 45:34-37, Fig. 23; EX-1003, ¶192.) If the user has instructed the audio device 304 to play back the MP3 file (356), the circuitry processes the MP3 file (360), such as by adjusting the playback volume, tone, balance, bass, treble, or another audio parameter. (EX-1007, 45:45-53, Fig. 23; EX-1003, ¶192.) The MP3 file is then played back (362),

such as by decompressing the file, converting it to an analog signal, and sending the signal to speakers so that the MP3 file can be heard by a user. (EX-1007, 45:54-58, Fig. 23; EX-1003, ¶192.)

As described for [C], circuitry (*e.g.*, processor 312) in a frame member of audio device 304 can “process encoded digitized audio data,” including MP3 files, for presentation to a user via speakers of the audio device 304. (EX-1007, 41:31-42:10, 45:36-58, Fig. 23; EX-1003, ¶193.) To the extent not expressly disclosed in Jannard, it would therefore have been obvious to a POSITA for process 350—which includes processing (360) and presenting (362) MP3 audio data—to be performed by the circuitry (*e.g.*, processor 312) within the frame member of audio device 304, the circuitry thereby providing an *MP3 player*. (EX-1003, ¶193.)

The POSITA would have had a reasonable expectation of success in employing the circuitry to perform process 350 because Jannard specifically provides that process 350 is a process for playing an MP3 file; and explains that the circuitry of Jannard is suited to “store MP3 files in a memory” and “play back the MP3 files through the speakers,” such as described by process 350, by using well-understood circuitry components such as processors (*e.g.*, processor 312) and memory (*e.g.*, memory 330). (EX-1007, 21:2-10; EX-1003, ¶194.) Jannard additionally provides specific commercial examples of “suitable electronics for enabling and amplifying MP3 storage and playback,” indicating that the

technology for doing so had already been successfully applied and commercialized. (EX-1007, 21:2-10; EX-1003, ¶194.)

(ii) *cell phone*

Jannard meets this element. (EX-1003, ¶196.) For example, as described for [C], circuitry within the frame member of audio device 304 can include content source 302, which can include a “communications-enabled device,” such as a telephone (including a “BLUETOOTH enabled telephone”), PDA, or Blackberry. (EX-1007, 39:67-40:9; EX-1003, ¶196.) A POSITA would have understood these devices to teach a cell phone; for example, the POSITA would have understood a “BLUETOOTH enabled telephone” to include a cell phone, at least because Jannard discloses that a cell phone can use the Bluetooth protocol to communicate with an audio device. (EX-1007, 37:31-40; EX-1003, ¶196.)

(iii) *media focals*

Jannard meets this element. (EX-1003, ¶197.) As described for Ground 1, the '929 Patent describes “media focals” as “utilizing the eyewear for its intended purpose and enhancing that use by using imaging techniques to improve the vision of the user.” (EX-1001, 2:25-27; EX-1003, ¶197.) The Patent Owner has endorsed this description as a definition of the media focals. (EX-1008, 5-6.)

Jannard teaches that the circuitry in the frame of the audio device 304 provides the *media focals*. (EX-1003, ¶198.) For example, as described for

element [C], Jannard teaches that circuitry in the frames of audio device 304 can include display/indicator drivers 324, which can drive display/indicators 326. (EX-1007, 43:12-26, Fig. 22; EX-1003, ¶198.) As Jannard explains, the display/indicators 326 can be used to display information such as “a song selection, a power level, a volume, a remaining battery life” or various data related to an audio file. (EX-1007, 43:12-26, Fig. 22; EX-1003, ¶198.) It would have been obvious to a POSITA for display/indicators 326 to include a “view finder or video display unit,” which—as taught by Jannard—can be used for at least one of the lenses of the audio device eyewear. (EX-1007, 12:41-43, 47:41-48:50; EX-1003, ¶198.) This is so at least because Jannard discloses that the display/indicators 326 can include an LCD display, which is a type of display commonly used for such view finders or video display units (*e.g.*, electronic viewfinders). (TOM ANG, FUNDAMENTALS OF PHOTOGRAPHY 69 (Random House, Inc. 1st American Ed. 2008); EX-1007, 43:17-21; EX-1003, ¶198.) This application of the display/indicators 326 to the view finder or video display unit thus would have yielded predictable results with a reasonable expectation of success, owing to the use of common and well-known display components. (EX-1003, ¶198.)

It would have been obvious to the POSITA to use the display/indicators 326 in this manner to improve the vision of the user, akin to a “heads-up display” such as disclosed by Jannard. (EX-1007, 32:53-56, 33:54-60; EX-1003, ¶199.). (EX-

1003, ¶199.) For example, by using a view finder or video display unit as a lens of the audio device, such as Jannard discloses, the audio device could present the user with a view of the environment—using the audio device eyewear for its intended purpose—while displaying media information via the view finder or display unit, such as described for the display/indicators 326, thereby improving the user’s vision using imaging techniques by augmenting the field of view with contextual information (*e.g.*, “a song selection, a power level, a volume, a remaining battery life”). (EX-1007, 43:12-26; EX-1003, ¶199.)

3. Claim 9

Jannard meets each limitation of claim 9. (EX-1003, ¶200.)

a. [Preamble] *Eyewear comprising:*

Jannard meets the preamble as described for 7[Preamble]. (EX-1003, ¶201.)

b. [A] *a frame member;*

Jannard meets this element as described for 7[A]. (EX-1003, ¶202.)

c. [B] *a lens;*

Jannard meets this element as described for 7[B]. (EX-1003, ¶203.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Jannard meets this element as described for 7[C]. (EX-1003, ¶204.)

- e. **[D]** *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user;*

Jannard meets this element as described for 7[D]. (EX-1003, ¶205.)

- f. **[E]** *wherein the eyewear includes a pushbutton system for control.*

Jannard meets this element. (EX-1003, ¶206.) For example, with respect to Fig. 24 below, the audio device 304 includes “at least three *buttons* 390,” which “extend from the electronic housing 384” and “allow user *control* over operation of the audio device 304.” (EX-1007, 46:8-12 (emphasis added), Fig. 24; EX-1003, ¶206.)

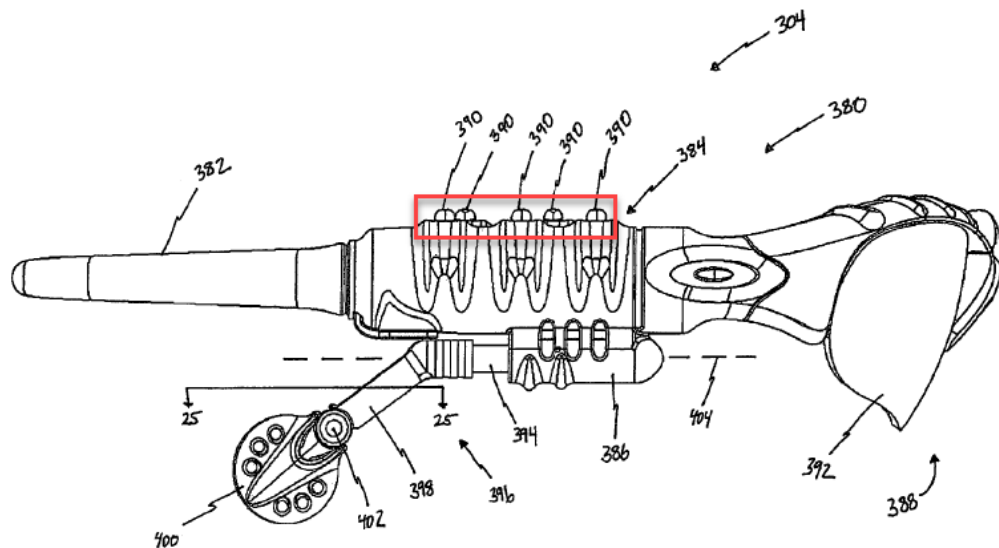


Figure 24

(EX-1007, Fig. 24 (annotated); EX-1003, ¶206.)

4. Claim 10

Jannard meets each limitation of claim 1. (EX-1003, ¶207.)

a. [Preamble] *Eyewear comprising:*

Jannard teaches preamble as described for 7[Preamble]. (EX-1003, ¶208.)

b. [A] *a frame member;*

Jannard meets this element as described for 7[A]. (EX-1003, ¶209.)

c. [B] *a lens;*

Jannard meets this element as described for 7[B]. (EX-1003, ¶210.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear; and*

Jannard meets this element as described for 7[C]. (EX-1003, ¶211.)

e. [D] *an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user;*

Jannard meets this element as described for 7[D]. (EX-1003, ¶212.)

f. [E] *wherein the circuitry can provide any of texts, email; multimedia information; caller id.*

Jannard meets this element. (EX-1003, ¶213.) As described for Ground 1, any one of texts, email, multimedia information, and caller id is sufficient to meet this claim element. (*See Intell. Ventures II LLC, supra* at *3-4.) For example, this claim element is met by the circuitry providing texts. However, as explained below, all of texts, email, multimedia information, and caller id are met by

Jannard. (EX-1003, ¶213.)

(i) *texts*

Jannard meets this element. (EX-1003, ¶214.) For example, as described for 7[C], circuitry in the frame of audio device 304 can include display/indicators 326. (EX-1003, ¶214.) Jannard discloses that “display/indicators 326 indicate a song selection, a power level, a volume, a remaining battery life, an artist, a song title ... or any other data related to an audio data file.” (EX-1007, 43:21-26; EX-1003, ¶214.) A POSITA would have understood the circuitry providing the above information, via display/indicators 326, to meet the circuitry providing *texts*. (EX-1003, ¶214.) For example, the POSITA would have understood at least a song selection, artist, and song title to include texts including that information. (EX-1003, ¶214.)

(ii) *email*

Jannard meets this element. (EX-1003, ¶215.) For example, as described for 7[C], the circuitry of audio device 304 can include content source 302, which can include a “communications-enabled device,” such as a PDA or Blackberry. (EX-1007, 39:67-40-12; EX-1003, ¶215.) As Jannard discloses, Blackberry devices (for example) can “communicate with a variety of wireless networks for receiving *email*, phone calls, and/or internet browsing.” (EX-1007, 39:34-37 (emphasis added); EX-1003, ¶215.) The circuitry thus provides *email*. (EX-1003,

¶215.)

(iii) *multimedia information*

Jannard meets this element for at least the reasons described for element [E](1) (*texts*). (EX-1003, ¶216.) For example, as described above, Jannard discloses that display/indicators 326 of the circuitry indicate a “song selection,” “an artist,” “a song title,” “time remaining during the playback of an audio file,” or “any other data related to an audio data file.” (EX-1007, 43:21-26; EX-1003, ¶216.) A POSITA would have understood the circuitry displaying the above textual and audio data to include the circuitry providing *multimedia information*, at least by presenting text media via display/indicators 326 “during the playback” of audio media. (EX-1007, 43:21-26; EX-1003, ¶216.)

In addition, as described for 7[E](i), Jannard discloses that audio device 304 can be configured to “store and playback any desired type of electronic audio and/or video file.” (EX-1007, 20:60-21:4; EX-1003, ¶217.) A POSITA would have understood storing and playing back electronic audio and video files to meet providing *multimedia information*, at least because the POSITA would have understood such files to comprise multimedia information (*e.g.*, audio and video information). (EX-1003, ¶217.) Similarly, Jannard discloses that content source 302 can provide audio device 304 with content such as “audio files, entertainment, news, media, music, photos, videos, advertising”—that is, *multimedia information*.

(EX-1007, 39:67-40:12; EX-1003, ¶217.)

The POSITA would have understood the storing and playing back of the audio and video files, or the content from content source 302, to be performed by circuitry within the frame of audio device 304, at least because, as described for 7[C], such circuitry can include memory 330, display/indicators 326, and speakers 318 as shown in Fig. 22. (EX-1007, Fig. 22; EX-1003, ¶218.) The POSITA would have understood that at least these components of the circuitry would be used for storage and playback of the audio and video files, or the various types of content provided by content source 302. (EX-1003, ¶218.)

(iv) *caller id*

Jannard meets this element for at least the reasons described for 7[E](ii) (*cell phone*). (EX-1003, ¶219.) To the extent not expressly disclosed by Jannard, it would have been obvious to the POSITA for the content source 302 of the circuitry—which, as described above, can include communications-enabled devices such as telephones, PDAs, and Blackberry devices—to provide caller information for incoming calls, given the ubiquity of that feature among telephones and other communications-enabled device in 2005. (EX-1007, 39:67-40:12; EX-1003, ¶219.) The POSITA would have had a reasonable expectation of success at least because caller information technology had been successfully commercialized and widely adopted in circuitry analogous to that of Jannard. (EX-1003, ¶219.)

5. Claim 15

Jannard meets each limitation of claim 1. (EX-1003, ¶220.)

a. [Preamble] *Eyewear comprising:*

Jannard meets the preamble as described for 1[Preamble]. (EX-1003, ¶221.)

b. [A] *a frame member;*

Jannard meets this element as described for 1[A]. (EX-1003, ¶222.)

c. [B] *a lens; and;*

Jannard meets this element as described for 1[B]. (EX-1003, ¶223.)

d. [C] *circuitry within the frame member for enhancing the use of the eyewear utilizing a client server model; and*

Jannard meets this element. (EX-1003, ¶224.) Jannard teaches *circuitry within the frame member for enhancing the use of the eyewear* at least as described for 7[C]. (EX-1003, ¶224.)

In addition, Jannard teaches that the circuitry enhances the use of the eyewear *utilizing a client server model*. (EX-1003, ¶225.) For example, as described above and shown in Fig. 21, Jannard discloses audio network 300, in which audio device 304 can send and receive data from a content source 302 via communications link 306:

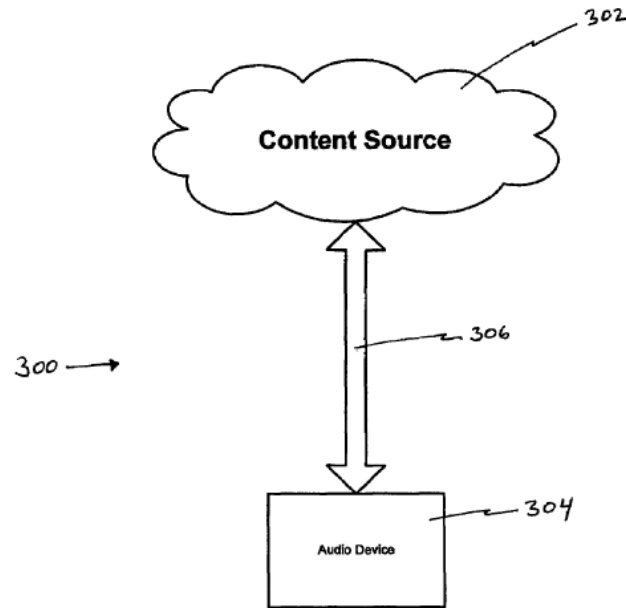


Figure 21

(EX-1007, 39:63-40:12, Fig. 21; EX-1003, ¶225.)

Audio device 304 can use audio network 300 to, for example, download music (such as MP3 files) from the content source 302 via communications link 306. (EX-1007, 40:31-36; EX-1003, ¶226.) The content source 302 can include “any of a variety of information sources,” including, in some embodiments, a computer, a network, a storage device (e.g., a hard drive), a database, or the Internet. (EX-1007, 39:63-40:9; EX-1003, ¶226.)

A POSITA would have understood at least audio device 304 downloading music from a network, or from the Internet, to meet *utilizing a client server model*, at least because a client server model is a ubiquitous model for downloading data

from a computer network. (EX-1014, 4; EX-1003, ¶227.) Moreover, Jannard discloses that content source 302 can include the Internet, a well-known example of a network of computers arranged in configurations including a client server model. (EX-1014, 4-5; EX-1003, ¶227.)

- e. ***[D] an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user.***

Jannard meets this element as described for 7[D]. (EX-1003, ¶228.)

VII. DISCRETIONARY DENIAL WOULD BE INAPPROPRIATE AND IMPROPER IN VIEW OF BINDING AGENCY GUIDANCE

A. District Court Litigation

The Board should not deny institution under § 314 on the basis of the litigation pending in the United States District Court for the District of Delaware. The *Fintiv* factors on balance favor institution here, but moreover, discretionary denial under *Fintiv* would be contrary to the Interim Guidance dated June 21, 2022. For example, the Interim Guidance directs that “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” (Interim Guidance at 5.) Such compelling evidence exists here: this Petition demonstrates the unpatentability of claims 1-11, 15, 17, and 22 for the reasons set forth above. Either of these grounds, let alone both of them, plainly lead to a conclusion that the claims are unpatentable.

Further, the Interim Guidance instructs that “the PTAB will not . . . deny

institution of an IPR ... in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” (Interim Guidance at 7.) *See also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01054, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020). Petitioner so stipulates. Under the Interim Guidance, the Board cannot deny institution based on *Fintiv* for at least these reasons.

B. Prosecution

The Board further should not deny institution under § 325(d) on the basis of the prosecution of the original patent application (U.S. Patent Appl. No. 13/739,929).

The Board applies a two-part framework for determining whether to deny institution under § 325(d) in view of prosecution of the original patent application: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (designated precedential on March 24, 2020).

Here, the Board need not reach the second part of the test, because the first part fails: neither the same (or substantially the same) art or arguments were previously presented to the Office. None of the references presented in this Petition—Mann '895, Perner, or Jannard —was considered during prosecution of the '929 patent. Nor do the references presented here present arguments cumulative of those raised in prosecution.

To the extent the same art or arguments were previously presented to the Office, the second part of the test fails, because the Office erred to the extent it failed to fully consider the significance of the art or arguments as detailed in this Petition, and as supported by the declaration of Dr. LaViola. Accordingly, even if the first part of the test is satisfied, the Board further should not deny institution based on the second part of the test.

VIII. NOTICES AND STATEMENTS

Pursuant to 37 C.F.R. § 42.8(b)(1), Magic Leap, Inc. is the real party-in-interest for Petitioner.

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related matters. The '929 Patent is asserted in the following litigation matter: *Percept Technologies Inc. v. Magic Leap, Inc.*, Case No. 1:22-cv-0025-RGA (D. Del.). The complaint in the litigation matter was served on Petitioner on January 21, 2022. (EX-1012.) In addition to the '929 Patent, the complaint also asserts U.S.

Patent No. 8,696,113. Petitioner is concurrently requesting *inter partes* review of U.S. Patent No. 8,696,113 (IPR2023-00495).

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner identifies the following counsel (and a power of attorney accompanies this Petition).

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Pursuant to 37 C.F.R. § 42.8(b)(4), service information for lead and back-up counsel is provided above. Petitioner consents to electronic service by email to MagicLeap-Percept-IPR@mofo.com.

Pursuant to 37 C.F.R. § 42.104(a), Petitioners certify that the '929 patent is

available for *inter partes* review and that Petitioners are not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in this Petition.

IX. CONCLUSION

Petitioner requests that the Board initiate *inter partes* review and cancel all challenged claims of the '929 Patent.

The USPTO is authorized to charge any required fees, including the fee as set forth in 37 C.F.R. § 42.15(a) and any excess claim fees, to Deposit Account No. 03-1952 referencing Docket No. 72800-00000.14.

Dated: January 20, 2023

Respectfully submitted,

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Certification of Word Count (37 C.F.R. § 42.24)

I hereby certify that this Petition for *Inter Partes* Review has 13,868 words (as counted by the “Word Count” feature of the Microsoft Word™ word-processing system), exclusive of “a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing.”

Dated: January 20, 2023

By /Mehran Arjomand/
Mehran Arjomand

Certificate of Service (37 C.F.R. § 42.6(e)(4) and 42.205(a))

I hereby certify that the attached Petition for *Inter Partes* Review and supporting materials were served as of the below date by U.S. Express Mail, on the Patent Owner at the correspondence address indicated for U.S. Patent No. 9,010,929.

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Dated: January 20, 2023

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