

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAGIC LEAP, INC

Petitioner,

v.

PERCEPT TECHNOLOGIES INC.

Patent Owner.

IPR2023-00494

Patent 9,010,929

PATENT OWNER'S RESPONSE

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EXHIBIT LIST

EXHIBIT NO.	DESCRIPTION
2001	[Reserved]
2002	Statutory disclaimer in U.S. Pat. 9,010,929

I. INTRODUCTION AND SUMMARY OF ARGUMENTS

The Board should confirm the patentability of claims 1-6, 8, 11, 17, and 22 of U.S. Patent No. 9,010,929 (the “’929 patent”) over Magic Leap, Inc.’s (“Magic Leap”) challenges based on Mann ’895 & Perner. The proposed Mann ’895-Perner combination fails to teach or suggest “the eye sensor activating the circuitry responsive to eye motion of a user,” as recited in each of the challenged independent claims. By specifying that the eye sensor activates circuitry “responsive to” eye motion, the claims specify that such circuitry must be activated *in reaction to* the eye motion. In a Mann ’895-Perner combination, on the other hand, a “license to see” would be granted according to whether or not an “edge pattern” produced from a pair of images compares favorably (or not) to reference images in a database. An iris feature detector of a Mann ’895-Perner combination would invoke, rather than be *responsive to*, eye motion. Accordingly, the challenged claims are not obvious in view of such a combination and the Board should enter a final decision confirming same.

II. BACKGROUND, THE '929 PATENT, AND CLAIM CONSTRUCTION

In its petition, Magic Leap presented two groups of challenges to the claims of the '929 patent; one based on the combined teachings of Mann '895 (Ex. 1005) and Perner (Ex. 1006), and the other based on the teachings of Jannard:

Ground		References	Claims
1	§ 103	Mann '895 & Perner	1-8, 10, 11, 15, 17, and 22
2	§ 103	Jannard	7, 9, 10, and 15

See Pet. at 6. The Board correctly denied review of claims 7, 9, 10, and 15 because they had been disclaimed. Paper 10 (Institution Decision) at 8. Therefore, it is only the challenge to claims 1-6, 8, 11, 17, and 22 based on Mann '895 and Perner that remains for adjudication.

A. The '929 Patent

The '929 patent describes eyewear that is made up of a frame member and a lens. The frame member includes circuitry for enhancing the use of the eyewear in a variety of ways. For example, imaging techniques to improve a wearer's vision and enhancements that allow for integration with telecommunication devices and entertainment devices are all described. Ex.

1001 at Abst.; 1:44-59; 2:21-33, 42-45; 3:4-17, 20-25. According to the specification, the circuitry included in the eyewear may be sensors for allowing a wearer's eyes to direct certain activities. Indeed, eye movement sensors are cited as a specific example which could be used to activate and control features of the eyewear. *Id.* at 3:20-25. Each of the challenged claims recites such an eye sensor that activates circuitry responsive to eye motion of a user. *Id.* at 5:62-64; 6:12-14, 22-24, 31-33, 39-41, 53-55; 7:16-18, 26-29; 8:1-3, 36-38.

B. Claim Construction

In *inter partes* reviews such as this one, the Board applies the same claim construction standard used to construe a claim in a civil action under 35 U.S.C. § 282(b). *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340 (Oct. 11, 2018). Accordingly, the claims should be construed consistent with their plain and ordinary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history. *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc)). “The ordinary and

customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips* at 1313.

In the co-pending district court litigation, *Percept Technologies Inc. v. Magic Leap, Inc.*, 1:22-cv-00025 (DDE), the Court has entered an order construing the term “the eye sensor activating the circuitry responsive to eye motion of a user,” consistent with its “[p]lain and ordinary meaning.” Ex. 1015 at 1. The Court’s order specifically addressed this term as it appears in claim 7, but the identical term appears in all of the independent claims:

Claim of '929 Patent	Term
1	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
7	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
8	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
9	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion

	of a user
10	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
11	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
15	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
17	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user
22	an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user

Ex. 1001 at 5:62-64; 6:12-14, 22-24, 31-33, 39-41, 53-55; 7:16-18, 26-29; 8:1-3, 36-38. Because the same term is used identically in each of these claims, it should be construed consistently across all of these claims. *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345 (Fed. Cir. 1998).

In its Institution Decision, the Board indicated that it was not adopting a construction for “the eye sensor activating the circuitry responsive to eye motion of a user,” instead deciding that no construction was needed. Paper

10 at 14-15. But the Institution Decision went on to contradict this pronouncement by relying upon a claim construction:

Mann '895 includes an iris scanner for activating circuitry in order to implement Mann's sight license feature. Perner in turn discloses an iris scanner that is responsive to eye motion of a user, because Perner's user authentication algorithm relies on motion of the user's eye between first light source 112 and second light source 114.

Based on the present record, nothing more appears to be required by claim 1.

Id. at 23-24. This was legal error.

While it is true that, “The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy,’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019), here the meaning of the disputed claim limitation is “in controversy” inasmuch as the parties disagree as to whether or not the prior art references relied on by Magic Leap teach or suggest same. The Federal Circuit has recognized that even “[d]espite no express construction of [a claim term], Board findings establishing the scope of the patented subject matter may fall within the ambit of claim construction. *HTC Corp. v.*

Cellular Commc'ns Equip., LLC, 877 F.3d 1361, 1367 (Fed. Cir. 2017).

Therefore, in order not to repeat the error contained in the Institution Decision, the Board should adopt an explicit construction for the disputed claim term as part of this trial.

The Institution Decision also noted that while the District Court found that the disputed claim term should be accorded its plain and ordinary meaning, the District Court's order failed to specify what that plain and ordinary meaning was. Paper 10 at 15. To the extent the plain and ordinary meaning of "the eye sensor activating the circuitry responsive to eye motion of a user" is in doubt, the specification provides some guidance. For example, the '929 patent provides, "[e]ye movement sensors [] could be used to activate and control the binocular glasses." Ex. 1001 at 3:23-25. And further in the same column, eye motion is distinguished from other actions: "It would also be possible to detect facial and eye movements (squinting, for example), as well as changes in the pupil and iris." *Id.* at 3:40-43. Thus, the "eye motion" recited in the claims is actual movement of the eye and not merely "changes in the pupil and iris" and is also distinct from facial movements.

Furthermore, the claims demand that the recited "circuitry" be activated "responsive to" eye motion. To be "responsive," the circuitry must

be activated *in reaction to* eye motion, for that is what the word “responsive” means. To be *responsive to something* is to react or answer quickly in relation to that something. It implies that someone or something reacts or adapts appropriately or in a specific way when influenced or affected by a particular stimulus, situation, or input. This notion of temporal immediacy and action, cause and effect if you will, is inherent in the term. Thus, the “plain and ordinary” meaning of the limitation at issue is that the eye sensor activates the circuitry in reaction to motion of a user’s eye.

The Board should adopt this plain and ordinary construction of the term because not only would it be consistent with the District Court’s determination that the plain and ordinary meaning should be used, it also fully comports with the way in which the term is used in the ’929 patent and the application of widely accepted meanings of commonly understood words. *See Phillips*, 415 F.3d at 1314. Magic Leap does not allege that this term has a special meaning in the art—indeed, Magic Leap offers no construction at all for the term, *see* Pet. at 4—and the patentee did not provide the term any other or exceptional meaning in the specification of the ’929 patent. Accordingly, there is no reason to depart from this plain and ordinary meaning of the disputed term. *Ancora Technologies Inc. v. Apple Inc.*, 744 F.3d 732, 734 (Fed. Cir. 2014) (“A claim term should be given its

ordinary meaning in the pertinent context, unless the patentee has made clear its adoption of a different definition or otherwise disclaimed that meaning.”).

III. THE PETITION FAILS TO DEMONSTRATE THAT ANY CHALLENGED CLAIM IS UNPATENTABLE

A petition must be judged as it is written. The Board may not overlook flaws in the petition or reformulate its challenges to enhance their suitability. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“[I]t’s the petitioner, not the Director, who gets to define the contours of the proceeding.”); *see also id.* (“[T]he petitioner is master of its complaint . . .”); *see also id.* at 1353 (forbidding the Board from “curat[ing]” the petition).

Furthermore, because the petition relies on conclusions of obviousness, the analyses set forth in the petition must include some articulated reasoning with some rational underpinning to support those conclusions. *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The challenger must supply the factual basis for the challenge and “may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Additionally, in cases such as the present, where the obviousness challenges involve a modification or combination of teachings, the Petitioner must also establish that one skilled

in the art would have had a reasonable expectation of success to make the modification or combination. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016). The modification or combination must not “require a substantial reconstruction and redesign of the elements” in a reference or “a change in the basic principles under which [a reference] was designed to operate.” *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959). Nor can the modification or combination render a reference unsatisfactory or “inoperable for its intended purpose.” *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Last but not least, the Supreme Court has emphasized that obviousness cannot be established by hindsight combination to produce a claimed invention:

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. *See Graham [v. John Deere Co.]*, 383 U.S. [1,] 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 [(1966)] (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into use of hindsight”) (quoting *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (6th Cir. 1964)).

KSR Int'l, 550 U.S. at 421.

A. The Challenged Claims are Patentable Over Mann '895 and Perner

As noted above, Magic Leap's challenges are based on the teachings of Mann '895 and Perner. Pet at 6. In relevant part, Magic Leap contends Mann '895 in view of Perner teaches “an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user.” Pet. at 13-15. Although presented in the context of claim 1, Magic Leap relies on the same analysis for this limitation as it appears in each of the challenged independent claims. *Id.* at 31 (claim 8), 40 (claim 11), 43 (claim 17), 46 (claim 22).

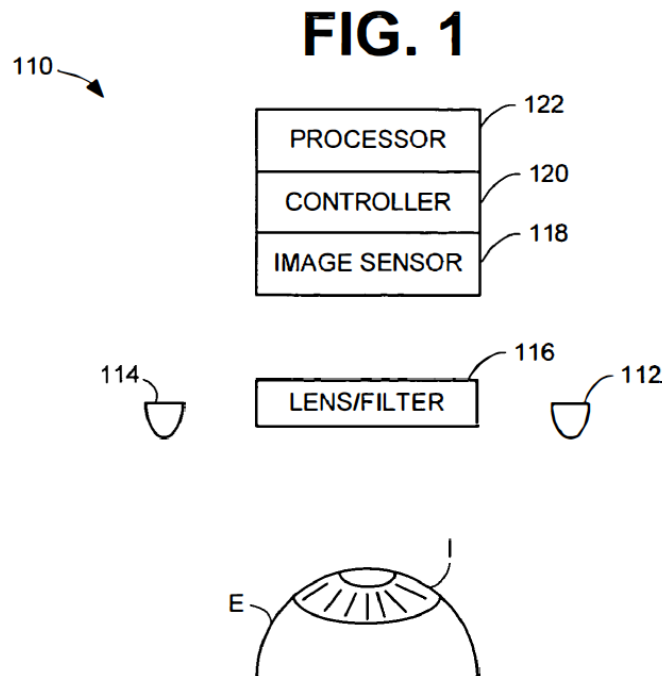
Mann '895 describes a pair of eyeglasses which can present “a computer mediated reality environment” to a wearer via various display elements and optics, allowing the wearer to view data and images. Ex. 1005 at 4:6–9; 5:6–8, 20–21; 11:15–16; 16:17–24. The eyeglasses may employ a so-called “sight license feature,” which Mann '895 characterizes as “a license to see.” *Id.* at 11:21–23. “For example, a retinal or iris scanner in the eyeglasses may license the eyeglasses to provide sight to the wearer, but not to others who might steal the eyeglasses.” *Id.* at 11:23–25. Magic Leap alleges the retinal scanners and iris scanners are examples of “eye sensors

that scan and detect components of the human eye,” Pet. at 13 (citations omitted), and Magic Leap therefore maps these elements to the claimed “eye sensor coupled to the frame member.” *Id.* at 14. Magic Leap further argues that, “the sight license granted by the retinal or iris scanner can ‘enable the eyeglasses to operate,’” and, therefore, that the “eye sensor is activating the circuitry.” *Id.* (emphasis omitted).

Magic Leap offers no specific allegation as to how Mann ’895 alone can be read to teach an eye sensor that activates circuitry *responsive to eye motion of a user*, as required by the challenged claims. This is not surprising because no such teaching exists in Mann ’895. The only discussion of a retinal or iris scanner in Mann ’895 appears in the context of the so-called “license to see.” Ex. 1005 at 11:23-25. There is no mention or suggestion of such a retinal or iris scanner activating any circuitry *responsive to eye motion of a user*. Nothing in Mann ’895 suggests that the sight license is somehow *responsive to eye motion of a user*. Indeed, if the sight license is to operate to exclude persons other than the owner of the eyeglasses from using them for seeing, it seems the granting or denial of the sight license must somehow be tied to a distinctive biometric characteristic of the wearer as determined by the retinal or iris scanner, not eye motion of whomever happens to be wearing the eyeglasses. Therefore, it is not surprising that the

Institution Decision correctly recognized that, “Petitioner does not rely on Mann ’895 for disclosing the eye sensor being ‘responsive to eye motion of the user’ per claim 1.” Paper 10 at 22. Instead, “[Magic Leap] argues Perner discloses an eye sensor that is responsive to eye motion of the user.” *Id.*

Perner describes an iris feature detector, Ex. 1006 at Abst., [0006], [0017], and illustrates an example of same in Figure 1, reproduced below.



Id. at [0009], [0017]. The iris feature detector 110 includes a pair of light sources 112, 114 (collectively referred to as a reflexive eye movement source), optics 116, image sensor 118, controller 120, and processor 122. *Id.* at [0017]. According to Perner, controller 120 turns on the first light source 112, waits for the subject’s eye (E) to fix on the first light source, and

commands the image sensor to acquire a first image of the subject's iris (I). *Id.* at [0029]. Then, controller 120 turns off the first light source 112 and turns on second light source 114, causing the subject's eye to be drawn to and fixate on second light source 114. During that time, controller 120 causes image sensor 118 to capture a second image of the subject's iris. *Id.* at [0030]. Processor 122 then determines differences between the two images to "yield[] a pattern of edges of shapes (the iris) contained in the eye," which is sufficiently "unique to an individual" that the pattern can "be used to identify or authenticate the subject." *Id.* at [0024]–[0026], [0032], [0035], [0057]. The authentication process involves comparing the edge pattern produced by differences in the two captured images to a database of reference images. *Id.* at [0026], [0035]. If the subject is authenticated through a match between the edge pattern and one of the reference images, then the subject is "granted certain privileges" such as "access allowed." *Id.* at [0035], [0059] (referring to a "biometric password").

Magic Leap alleges it would have been obvious for a person of ordinary skill in the art to "adopt Perner's suggestion and advantageously use the iris feature detector of Perner in place of the iris scanner of Mann '895." Pet. at 16. But even if a person of ordinary skill in the art were to proceed in this fashion, the result would not be the subject matter recited in

the challenged claims. That is, the product of the Mann '895-Pemer combination is ***not*** an eye sensor that activates circuitry *responsive to eye motion of a user*.

First, it appears both Mann '895 and Pemer rely on the use of a “biometric password” to authorize (or not) certain privileges. In the case of Mann '895, the privilege is a sight license. Ex. 1005 at 11:23-25. In the case of Pemer, it is privileges such as access, use of an ATM machine, and authorization at a security access point. Ex. 1006 at [0035], [0059]. Accordingly, if a person of ordinary skill in the art were to consider the combination of Mann '895 and Pemer, the person of ordinary skill in the art would conclude that it is such a biometric password that should control whether or not the sight license is granted. That is, the granting or not of the sight license would be responsive to successful identification of the user through the biometric password, not something else.

Second, Pemer is clear: the iris feature detector *causes*, rather than *reacts to*, eye movement. According to Pemer, “A conventional iris scanner centers the eye in a field of view, creates one or more images of the eye, identifies an outer boundary of the iris in the images, extracts the image of the iris, scales and filters the extracted image, and generates a code corresponding to the iris” which can be used for identification or

authentication. Ex. 1006 at [0004]. This process is reported to be “computationally intensive” and “can take a relatively long time.” *Id.* at [0004]. In contrast, the proposed iris feature detector “*causes the eye movement source to cause rapid eye motion*, and the sensor to capture first and second iris images over a time interval in which only an iris can move in the first and second images.” *Id.* at [0006] (emphasis added). These two images are then used to create an “edge pattern” which can be compared to reference images in a database. *Id.* at [0035]. And it is the result of such a comparison that will determine whether or not any privileges (such as access) are granted. *Id.* This process is said to provide “faster detection of iris features, as well as faster processing for identification and authentication.” *Id.* at [0025].

Thus, rather than the iris feature detector of Perner, or a Mann ’895-Perner combination, being *responsive to eye motion of a user*, as required by the challenged claims, the iris feature detector of Perner, or a Mann ’895-Perner combination, actually ***causes eye motion of a user***. More specifically, the controller 120 of the iris feature detector, “causes the first light source 112 to illuminate, whereby the iris of the subject's eye is drawn to and becomes fixed on the illuminated first light source 112.” *Id.* at [0019]. Thereafter, “the controller 120 turns off the first light source 112 and

immediately causes the second light source 114 to illuminate. Reflexively, the eye moves quickly and becomes fixed on the illuminated second light source 114.” *Id.* at [0020]. Perner’s iris feature detector does not grant (or deny) any permissions in response to such eye movement. Instead, permissions are granted (or not) responsive to the results of subsequent image comparisons. *Id.* at [0035].

The combination of Mann ’895 and Perner advocated by Magic Leap sees a person of ordinary skill in the art “adopt[ing] Perner’s suggestion and advantageously us[ing] the iris feature detector of Perner in place of the iris scanner of Mann ’895.” Pet. at 16. Consider how such a system would operate. In Mann ’895, the retinal or iris scanner in the eyeglasses licenses the eyeglasses to provide sight to the wearer, but not to others who might steal the eyeglasses. Ex. 1005 at 11:23–25. If the iris feature detector of Perner is used for this purpose, then, presumably, the “edge pattern” obtained using the iris feature detector would be compared to reference images in a database (as taught by Perner) and if there is a match, the Mann ’895 sight license would be authorized. *See* Ex. 1006 at [0035]. The edge pattern would be obtained as the difference between two images captured by the Perner iris feature detector. *Id.* at [0032]. And, those images would be

obtained by the iris feature detector *causing* (***not*** reacting or responding to) eye motion. *Id.* at [0019]-[0021].

The Institution Decision reads Perner as describing a “user authentication algorithm [that] relies on motion of the user’s eye between first light source 112 and second light source 114.” Paper 10 at 23-24 (citing Perner at Fig. 1 and [0017]-[0020], [0024], [0025], [0029]-[0030]). Of course, the petition did not rely on an authentication algorithm of Perner for making its case. *See* Pet. at 14-15. Instead, the allegation was that the iris feature detector of Perner would be used in the system of Mann ’895. *Id.* at 16. The system of Mann ’895 apparently has its own “authentication algorithm,” presumably based on some biometric characteristic of the wearer so as to be able to distinguish an authorized wearer from a thief. *See* Ex. 1005 at 11:21-25.

Even if one reads the petition as alleging the use of Mann’s “authentication algorithm,” that authentication algorithm is not responsive to eye motion of a user, nor is mere *reliance* upon eye motion sufficient to demonstrate activation “*responsive to*” eye motion, as recited in the challenged claims. As explained above, authentication or identification of a user in Perner is determined according to a comparison between an “edge pattern” derived from images captured by the iris feature detector and

reference images in a database. Ex. 1006 at [0035]. While the eye motion in Perner may be needed in order for the initial images to be obtained, it is the matching (or not) of the edge pattern obtained from those images with a reference pattern from a database that determines “access” (or not). *Id.*

Stated differently, the “authentication algorithm” of Perner conditions the granting of privileges (such as access, or, in the case of a Mann ’895-Perner combination, a sight license) on finding a match in a reference pattern from a database and **not** in response to eye motion of a user. One thing cannot be *responsive to* another unless it is a reaction to that other and, in Perner and/or Mann ’895-Perner, granting access (e.g., the sight license) is **not** reactive to movement of the eye.

The Institution Decision postulates that, “Patent Owner’s [] opposition appears to be premised on an overly narrow claim construction, whereby claim 1 would require some sort of passive monitoring of the eye by the eyewear circuitry, thereby excluding Perner’s circuitry because it uses light sources 112 and 114 to cause movement of the eye.” Paper 10 at 24. That is not Patent Owner’s case. It is because a Mann ’895-Perner combination would grant a sight license or not responsive to finding or not finding a match for the edge pattern in a database, and **not** in response to any eye motion. It should be beyond dispute that Perner’s detector uses light

sources 112 and 114 to cause movement of the wearer's eye. But, in Perner and in a Mann '895-Perner combination, eye motion is **not** what the granting or denying of privileges is reacting to. It is instead the results of an image comparison that determines whether or not access (or a sight license) authorized. Ex. 1006 at [0035]. While it is true that other things have to happen prior to that image comparison, that does not make the outcome of the image comparison "responsive to" those prior activities. Responsiveness requires temporal immediacy and action (i.e., cause and effect) that is absent in the Mann '895-Perner combination.

The Institution Decision concludes that, "the combination of Mann '895 and Perner leads to an eye sensor activating circuitry responsive to eye motion of a user," Paper 10 at 24, because the Board apparently believed that the claims require only *reliance on* motion of the user's eyes. *Id.* at 23-24. This is not true. The claims are specific and recite not mere *reliance on* eye motion, but being actually *responsive to* eye motion. The two notions are not synonymous and the Board failed to articulate why they should be regarded as such.

To be clear, reliance and responsiveness are two very different concepts that involve different aspects of interaction or dependence. Reliance implies dependence upon something for support or assistance. It

may imply a degree of confidence in the thing being relied upon.

Responsiveness, on the other hand, means a reaction or adaptation to something in a way that acknowledges that thing's presence or influence. It implies a dynamic relationship in which one thing changes, adjusts, or responds to changing conditions or stimuli, typically external factors. Responsiveness does not necessarily imply dependence or trust, as is required for reliance. These distinctions demonstrate why the Board's initial conclusions in the Institution Decision were incorrect.

As explained above, while Perner invokes eye motion when capturing images, the images themselves are not captured *responsive to* eye motion. Perner explains, "The controller turns on the first light source (310), waits for the subject's eye (E) to fix on the first light source (312), and *commands the image sensor to start acquiring the first image* (314). . . . The controller turns off the first light source and turns on the second light source (320), and *commands the image sensor to begin acquiring the second image* (322)." Ex. 1006 at [0029]-[0030] (emphasis added). The controller issues actual commands to perform the image capture and those commands are not *responsive to* eye motion. Rather, they are sequenced according to the controller's commands to the different LEDs. "The controller causes the eye movement source to cause rapid eye motion, and the sensor to capture first

and second iris images over a time interval in which only an iris can move in the first and second images.” *Id.* at [0006].

Nor is the granting of privileges *responsive to eye motion*. *Id.* at [0035] (“During authentication or identification, iris features of a subject are detected, and an edge pattern is generated. The database is searched for a reference pattern that matches the edge pattern. If a match is found, the subject is identified or granted certain privileges.”). There is simply no basis for equating reliance upon eye motion with being *responsive to eye motion*. Indeed, eye motion would be irrelevant if the edge pattern produced by the images captured by the Perner iris feature detector did not match a reference image obtained from a database. There is no *responsive* connection between the eye motion and the granting of privileges as alleged. The eye motion is not the external stimulus that leads to the grant of the privileges. Instead, it is image comparison that is responsible for same.

Thus, for at least the foregoing reasons, the proposed Mann ’895-Perner combination fails to teach or suggest “an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user,” as recited in independent claim 1. Hence, claim 1 is not unpatentable in view of Mann ’895-Perner. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *see also* 37 C.F.R. § 42.108(c);

Harmonic Inc. v. Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (the burden of persuasion never shifts to the Patent Owner); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (a petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements”).

Independent claims 8, 11, 17, and 22 also each recite “an eye sensor coupled to the frame member, the eye sensor activating the circuitry responsive to eye motion of a user,” and are, therefore, not unpatentable in view of the proposed Mann ’895-Pemer combination for at least the same reasons as claim 1.

Claims 2-6 depend from claim 1. Each respective dependent claim is not unpatentable in view of the proposed Mann ’895 and Pemer combination for at least the same reasons as claim 1. *Hartness Int’l. Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100 (Fed. Cir. 1987) (a claim that depends from

a nonobvious independent claim is nonobvious because it contains all of the limitations of that independent claim plus a further limitation).

IV. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of claims 1-6, 8, 11, 17, and 22.

Dated: October 25, 2023

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WORD-COUNT CERTIFICATE

I certify that the foregoing document complies with the type-volume limitation of 37 C.F.R. § 42.24(a) and (b) and contains 5,119 words (including words in drawings created by the Patent Owner or as annotations added by the Patent Owner to images reproduced in this document) based on the word count indicated by Microsoft® Word for Mac v. 16.49, excluding those portions exempted by the rule.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing:

PATENT OWNER'S RESPONSE

and its accompanying exhibits were served on October 25, 2023, by filing this document through the PTAB P-TACT System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following addresses:

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