

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUXOTTICA OF AMERICA INC.,

Petitioner

v.

E-VISION OPTICS, LLC

Patent Owner

Case No. IPR2024-01030

Patent No. 8,708,483

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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EXHIBIT LIST

Exhibit	Description
2001	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Denying Defendants' Motion to Stay, Dkt. 75 (Aug. 21, 2024 C.D. Cal.)
2002	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Re Civil Jury/Court Trial, Dkt. 54 (April 4, 2024 C.D. Cal.)
2003	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Scheduling Additional Dates and Correcting Scheduling Order, Dkt. 58 (April 18, 2024 C.D. Cal.)
2004	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Lenovo Group, Ltd., et al.</i> , Case No. 8:23-cv-01860 AB (SHK) Defendants' Preliminary Invalidity Contentions (July 19, 2024 C.D. Cal.) (excerpted)
2005	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Defendants' Invalidity Contentions (July 12, 2024 C.D. Cal.)
2006	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, Order re Civil Jury/Court Trial, Dkt. 54 (April 3, 2024 C.D. Cal.)
2007	Lex Machina – Federal Court – Federal District Court Cases in C.D. Cal, Pending Between 2019-09-01 and 2024-09-19
2008	Vacancies in the Federal Judiciary 118th Congress, last updated on 9/23/2024, https://www.uscourts.gov/judges-judgeships/judicial-vacancies/current-judicial-vacancies

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Exhibit	Description
2009	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Scheduling Additional Dates and Correcting Scheduling Order, Dkt. 58 (April 18, 2024 C.D. Cal.)
2010	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, Order Granting Joint Stipulation to Schedule Additional Dates, Dkt. 56 (April 18, 2024 C.D. Cal.)
2011	U.S. Patent Application Pub. No. 2006/0023158 A1, Eyeglasses With Electrical Components, Thomas A. Howell et al., dated Feb. 2, 2006 (“Howell-158”)
2012	U.S. Patent Application Pub. No. 2005/0264752 A1, Eyewear Supporting After-Market Electrical Components, Thomas A. Howell et al., dated Dec. 1, 2005 (“Howell-752”)
2013	U.S. Patent No. 6,491,394, Method For Refracting and Dispensing Electro-Active Spectacles, Ronald D. Blum et al., dated Dec. 10, 2002 (“Blum-394”)
2014	U.S. Patent Application Pub. No. 2005/0140924 A1, Electro-Active Multi-Focal Spectacle Lens, Ronald D. Blum et al., dated June 30, 2005 (“Blum-924”)
2015	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) (IN CHAMBERS) Order Continuing Claim Construction Hearing, Dkt. 97 (Oct. 7, 2024 C.D. Cal.)
2016	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, (IN CHAMBERS) Order Continuing Claim Construction Hearing, Dkt. 74 (Oct. 7, 2024 C.D. Cal.)

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Exhibit	Description
2017	U.S. Patent No. 7,030,411, Electronic Unit Integrated Into A Flexible Polymer Body, Peter A. Krulevitch et al. dated Apr. 18, 2006 (“Krulevitch”)

E-Vision Optics, LLC (“Patent Owner”) submits this Preliminary Response to the Petition of Luxottica of America Inc. (“Petitioner”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 8,708,483 (“the ‘483 patent”).

I. INTRODUCTION

Patent Owner respectfully requests that the Board exercise its discretion and deny institution for two reasons. First, denial under Section 314(a) and *Fintiv* is appropriate, because the ‘483 patent is asserted against two defendants in parallel litigations that are scheduled for—and expected to reach—trial three-to-five months before the Board’s final written decision. In October 2023, Patent Owner filed suit against both Petitioner and third-party Lenovo in the Central District of California for infringement of the ‘483 patent, as well as infringement by Petitioner of four additional patents and infringement by Lenovo of six additional patents:

ASSERTED PATENT	LENOVO	LUXOTTICA
8,905,541	X	X
8,708,483	X	X
8,801,174	X	X
10,613,355		X
10,598,960	X	X
8,931,896	X	
10,795,411	X	
11,586,057	X	

While the cases have not been formally consolidated, the extent of overlap has resulted in the parties coordinating a near-identical schedule and a shared claim construction hearing.

Despite its acknowledgment of the parallel litigation on the '483 patent against Lenovo (Petition at 84), Petitioner is silent regarding the overlap between this proceeding and the proceeding against Lenovo when assessing whether a *Fintiv* denial is appropriate. (Petition at 82.) In particular, Petitioner fails to address the fact that even if Petitioner has filed a stipulation to purportedly limit the overlap of the issues, Lenovo has not joined in such a stipulation and will continue—even past institution—to litigate the validity of the '483 patent based on the very same prior art references and arguments contained in the petition. Given the advanced stage of the parallel litigations and that expert reports on validity will be exchanged before the Board's institution decision, institution of yet another proceeding on the validity of the '483 patent would needlessly waste party, Board, and district court resources.

Second, denial under Section 325(d) and *Advanced Bionics* is appropriate, because: (a) four out of seven prior art references cited in the petition, including the two primary references relied on across all grounds, are substantially the same prior art previously considered by the Patent Office; and (b) the other three references are relied upon as part of three- or four-reference combinations asserted against only six

dependent claims out of 37 claims in total. Institution under such circumstances would be a colossal waste of Board, party, and district court resources.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

The Board should decline to institute IPR of the '483 patent under *Fintiv* because instituting this IPR would undermine Congress's stated goals in creating IPR proceedings: to provide "quick and cost effective alternatives to litigations" and "limit unnecessary and counterproductive litigation costs." H.R. Rep. No. 112-98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69. An IPR here would be neither quicker than, nor an alternative to, ongoing district court litigation.

The '483 patent is one of eight patents asserted in claims against two different defendants in a series of cases pending in the Central District of California. The district court will hear all claim construction arguments more than a month before the Board's institution decision is due. Furthermore, the district court is on track to adjudicate all but one of the same prior art references raised in the petition more than five months before the Board issues a final written decision. Instituting a parallel IPR proceeding lagging well behind the district court would needlessly increase the cost of resolving the underlying dispute. Under these circumstances, the Board should exercise its discretionary authority to deny institution under 35 U.S.C. § 314(a).

Because Congress's goal in enacting post-grant proceedings was "to ... limit unnecessary and counterproductive litigation costs," Director Vidal has instructed the Board not to institute IPRs that would "increase, rather than limit, litigation costs." Director's Memo, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* ("Guidance") at 1 (June 21, 2022).

Instituting this IPR would cause just such an increase. The district court has already denied a motion to stay. And although that denial was without prejudice, the court will continue to consider the same prior art regardless because at least one another defendant has asserted the same invalidity grounds in parallel litigation. Accordingly, for more than a year, the Board and the district court will labor to decide the very same issues, thereby "increas[ing], rather than limit[ing], litigation costs," creating "potential conflict between the ... (PTAB) and district court proceedings," and generally increasing "the potential for inefficiency and gamesmanship." Guidance at 1. This is precisely the situation that the precedential *Fintiv* decision seeks to avoid by instructing the Board to take "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020).

A. Factor 1: The District Court Has Denied A Stay.

The first *Fintiv* factor asks “whether [1.] the court granted a stay or [2.] evidence exists that one may be granted if a proceeding is instituted.” *Fintiv*, IPR2020-00019, Paper 11 at 6. Here, the undisputed answer to both questions is **no**: a stay has not been granted, and Petitioner has identified no evidence that one will be. To the contrary, specific evidence indicates that a stay is unlikely.

On August 21, 2024, the district court denied Petitioner’s motion to stay the parallel litigation pending the outcome of this proceeding. (EX-2001.) While the district court denied the motion without prejudice, allowing Petitioner to move again upon a potential institution, the very same three factors that persuaded the district court to deny the stay will only become more persuasive as time passes, making a stay unlikely. (See EX-2001 at 2 (citing *Universal Elecs., Inc. v. Universal Remote Control, Inc.*, 943 F. Supp. 2d 1028, 1030-31 (C.D. Cal. 2013)).

First, a trial date has already been set, and fact discovery in the parallel litigation will close on November 8, 2024¹—two months before the Board’s institution decision is due. (EX-2002 at 3.) Indeed, expert discovery will close

¹ The district court later corrected a typographical error and confirmed the close of fact discovery is November 8, 2024, and not November 8, 2025. (EX-2003 at 2.)

January 31, 2025—just a few weeks after the Board's institution decision. (EX-2002 at 3.) The district court is unlikely to stay the case *after* the completion of discovery and after the parties have already expended the time and expense of submitting initial and rebuttal expert reports. *Universal Elecs.*, 943 F. Supp. 2d at 1030-31 (considering stay factor (1) whether discovery is complete and whether a trial date has been set).

Second, a stay will not simplify issues before the district court, because the '483 patent will also be asserted at trial against third party Lenovo. *Universal Elecs.*, 943 F. Supp. 2d at 1030-31 (considering stay factor (2) whether a stay will simplify the issues in question and trial of the case). Lenovo asserts all but one of the same prior art references relied upon in the petition: Howell-596; Howell-833; Blum-741; Spitzer; Ogren; and Jannard-868. (EX-2004 at 6-8.) Only Hattori-912, which is a secondary reference relied upon in less than half of the petitioned grounds, is not asserted by Lenovo. The district court is unlikely to stay the case against Petitioner when it will move forward to a trial on the validity of the '483 patent based on the same primary prior art and most of the same invalidity contentions.

Finally, undue prejudice and disadvantage against Patent Owner would only increase if the district court were to stay the litigation against Petitioner, while another related case moved forward to trial. *Universal Elecs.*, 943 F. Supp. 2d at

1030-31 (considering stay factor (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party). A stay would effectively give Petitioner two bites at the apple, letting its co-defendant fight the battle for it in district court while not being bound by any adverse results in those cases. The district court is unlikely to force Patent Owner, after having completed both fact and expert discovery, to then wait an additional year to resolve its claims against one party while continuing through trial on the same issues against another party.

As a stay has been denied and any renewed request for a stay is unlikely to be granted, *Fintiv* factor 1 weighs heavily in favor of the Board's exercising its discretion to deny institution.

B. Factor 2: A District Court Trial Is Expected More Than Five Months Before The Final Written Decision Deadline

Factor 2—the implications of the district court and IPR schedules—also weighs for denial. “[A] parallel proceeding in an advanced state implicates considerations of efficiency and fairness, which can serve as an independent reason to apply discretion to deny institution.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 11-12, 17 (PTAB May 13, 2020) (*informative*); Guidance at 1.

Trial on the '483 patent is scheduled against both defendants for July 2025—nearly six months before the Board's final written decision is expected. (EX-2002

at 3; EX-2006 at 3.) The median time-to-trial in the Central District of California for civil cases is 700 days (i.e., roughly 23 months). (EX-2007 at 2.) That is, one would expect trial in the parallel litigations to commence by September 25, 2025—still more than three months before the Board's final written decision is expected on January 11, 2026.

Petitioner cites 29.7 months as the median time-to-trial, but focuses on 2023 in isolation—which, as demonstrated by Petitioner's own evidence, is an outlier for the Central District of California. (Petition at 81.) The median time-to-trial for civil cases in the Central District of California over the last five years—700 days or roughly 23 months—is much more representative of civil time-to-trial in this district. (See Ex-1021 (listing median time-to-trial for prior years as ranging from 20 months to 24 months).)

In other words, if the Board institutes IPR here, the IPR proceeding would not produce a result until four-to-six months after the district court litigation has concluded, and the parties will have expended precisely the “duplicative,” “unnecessary[,] and counterproductive litigation costs” that the AIA was designed to avoid. *Fintiv*, IPR2020-00019, Paper 11 at 5 (citing *Magellan Midstream Partners L.P. v. Sunoco Partners Mktg. & Terms. L.P.*, IPR2019-01445, Paper 12 at 10 (Jan. 22, 2020)); see *id.*, Paper 15 at 17 (discretionarily denying institution where district

court trial was scheduled two months before the final decision deadline); *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (*precedential*) (finding that institution of IPR when the district court trial would resolve validity before the PTAB “would not be consistent with an objective of the AIA...to provide an effective and efficient alternative to district court litigation”); *Samsung Elecs. Co. v. California Institute of Tech.*, IPR2023-00131, Paper 10 at 15, 24 (PTAB May 4, 2023) (discretionarily denying institution where “[r]egardless of whether we consider the scheduled trial date or the trial date expected based on time-to-trial statistics, the trial in the underlying litigation would commence several months before the expected date of our final written decision”); *Eclinical Works, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (discretionarily denying institution where CDCA trial was scheduled “roughly one to two months before any final decision would have been due”).

While Petitioner cites the filing of 17,000 new cases (both civil and criminal) and judicial vacancies as reasons for concern (Petition at 81), Petitioner's own evidence demonstrates that this number of cases is typical for the Central District of California—indeed, it is still lower than the average number of filings before the global Covid-19 pandemic. (Ex-1021.) Furthermore, Petitioner cites nothing to suggest an unusual number of judicial vacancies that would cause concern, and the

current report as of September 23, 2024, shows only two vacancies in the Central District of California. (EX-2008.)

Because the district court will resolve validity well before the Board reaches its final written decision, the second *Fintiv* factor also heavily favors discretionary denial.

C. Factor 3: The Parties Have Invested Significant Resources In The District Court Proceeding

Factor 3—the resources invested in the parallel district court proceeding—favors denial “if, at the time of the institution decision, the district court has issued substantive orders related to the patent.” *Fintiv* at 9-10; *see also id.* at n.16 (collecting cases). *Fintiv* holds specifically that “claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

Both the parties and the district court have invested significant resources in the two parallel proceedings over the last year. A hearing to construe the claims in both cases involving the '483 patent will be held December 6, 2024—ensuring that the district court's claim construction order will be issued before the Board's institution decision. (EX-2015; EX-2016.) Additionally, the parties will have

completed fact discovery by November 8, 2024,² and submitted expert reports on the issue of validity several weeks before the Board's institution decision is due. (EX-2002 at 3.) Accordingly, while Petitioner proffers a stipulation in this proceeding, the stipulation is meaningless, because Petitioner asserts the same prior art in the parallel litigation and the parties will have already expended the resources to litigate that prior art in preparation for trial. (EX-2005 at 3-6, 10 ("incorporate[ing] in their entirety the proceedings in IPR2024-01030" in Petitioner's district court invalidity contentions).)

Petitioner's analysis of this factor fails to account for any of these resource expenditures, as it wrongly considers only those resources expended at the time the petition was filed (Petition at 82) and not at the time of institution, as directed by *Fintiv*. *Fintiv* at 6; *NXP v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 7 (PTAB Aug. 25, 2022) (Board should consider "the duplicative efforts that will occur during the [] duration of a review"); *Cisco Sys., Inc. v. Monarch Networking Solutions LLC*, IPR2020-01227, Paper 11 at 11-12 (PTAB Mar. 4, 2021) (finding that more work

² The district court later correct a typographical error and confirmed the close of fact discovery is November 8, 2024, and not November 8, 2025. (EX-2003 at 2.)

completed by the parties and the court suggests that institution would lead to duplicative costs).

Petitioner's delay in filing this petition further weighs for denial. Petitioner waited more than seven months after receiving Patent Owner's October 26, 2023 complaint before filing its petition. Petitioner offers no explanation for its delay, which weighs for denial. *Fintiv*, IPR2020-00019, Paper 11 at 11-12; *Ericsson Inc. v. Collision Comms., Inc.*, IPR2022-01233, Paper 12 at 15 (PTAB Jan. 19, 2023) (finding that where the parties invested significant resources and petitioner waited to file its petition, "this factor weighs decidedly in favor of discretionary denial"); *Regeneron Pharmas. Inc. v. Novartis Pharma AG*, IPR2020-01317, Paper 15 at 17 15 (PTAB Jan. 15, 2021) (finding that even where the petition was filed "less than a month after learning of the complaints," the investment by the parties in the parallel proceeding "outweighs the effort expended so far in this proceeding").

In light of the significant resources already invested at the district court, factor 3 weighs decidedly in favor of denial.

D. Factor 4: The Issues And Parties Overlap Significantly.

Factor 4—the degree of overlap between the issues in the petition and those before the district court—also supports denial.

Regarding this fourth factor, *Fintiv* explains that “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where “the Board [is] presented with substantially identical prior art arguments...at issue in district court.” *Fintiv*, IPR2020-00019, Paper 11 at 12. “Accordingly, if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Id.*

There is complete overlap between the petitioned grounds and both parallel litigations:

Petitioned Prior Art Reference	Petitioner's Invalidity Contentions	Lenovo's Invalidity Contentions
Howell-596	Yes. (EX-2005 at 4 and 10.)	Yes. (EX-2004 at 7, 9, 10, and 69.)
Howell-833	Yes. (EX-2005 at 5 and 10.)	Yes. (EX-2004 at 7.)
Blum-741	Yes. (EX-2005 at 4, 10 and 11.)	Yes. (EX-2004 at 8 and 69.)
Spitzer	Yes. (EX2005 at 4.)	Yes. (EX-2004 at 8 and 69.)
Ogren	Yes. (EX2005 at 4.)	Yes. (EX-2004 at 8 and 69.)
Hattori-912	Yes. (EX-2005 at 3 and 11.)	No
Jannard-868	Yes. (EX-2005 at 3.)	Yes. (EX-2004 at 8.)

While Petitioner has submitted a stipulation purporting to reduce the issues before the district court, Lenovo has filed no such stipulation. That is, even if the Board were to institute this proceeding, the parallel district court case against Lenovo will move forward to determine the validity of the challenged patent on the very same prior art at issue in the petition.

Petitioner's stipulation should carry no weight here because: (a) Petitioner and Patent Owner will have already expended the resources to litigate the same prior art through the completion of validity expert reports before the Board's institution decision; and (b) the stipulation does not bar Lenovo from litigating the very same invalidity challenges before the district court. Institution will multiply the burden on Patent Owner while permitting Petitioner to benefit from Lenovo's continued assertion of the same prior art in the district court. In light of these parallel tracks, and Lenovo's failure to join in Petitioner's stipulation, instituting IPR will multiply the burden on Patent Owner and create the possibility of inconsistent decisions between the district court and the Board.

Because Petitioner's stipulation does not "mitigate[] any concerns of duplicative efforts between the district court and the Board," or "of potentially conflicting decisions," Factor 4 weighs heavily in favor of discretionary denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020); *Google LLC v. EcoFactor, Inc.*, IPR2021-00454, Paper 9 at 12-14 (PTAB July 22, 2021).

E. Factor 5: Both Parties Are Parties In The Parallel Litigation.

Factor 5—the overlap of the parties between the petition and the parallel litigation—suggests denial because (1) Petitioner is a defendant in the parallel

litigation and, as such, will have a full, fair opportunity to litigate the petitioned grounds, and (2) all but one of the prior art references Petitioner raises are the same ones another defendant has *also* raised in the parallel litigation.

Under *Fintiv*, “[i]f a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution.” *Fintiv*, IPR2020-00019, Paper 11 at 13-14. That is not the case here because Petitioner is a defendant in the litigation. Accordingly, the circumstances raise no fairness concerns that denial would deprive Petitioner of its “day in court.” *See Vizio, Inc. v. Maxell, Ltd.*, IPR2022-01459, Paper 7 at 21-22 (PTAB Apr. 11, 2023) (“Because Petitioner is the litigation defendant, factor 5 weighs in favor of discretionary denial”); *Nokia of Am. Corp. v. Godo Kaisha IP Bridge*, IPR2022-00755, Paper 9 at 13 (PTAB Nov. 2, 2022) (holding that Factor 5 weighed for discretionary denial where Petitioner was defendant in parallel proceeding).

That another defendant is *also* litigating all but one of the petitioned prior art references at the district court further suggests denial. *Fintiv* holds that, “[e]ven when a petitioner is unrelated to a defendant, ... if the issues are the same as, or substantially similar to, those ... about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.” *Id.* at 14. Because of this consideration, *Fintiv*

requires that “[a]n unrelated petitioner ... discuss why addressing the same or substantially the same issues would not be duplicative of the [other] case even if the petition is brought by a different party.” *Id.*

Petitioner offers no such explanation here. (Petition at 83.) That another defendant is currently litigating most of the same prior art raised in the petition raises serious concerns of duplicative work by adjudicators, and any public-policy concerns regarding patent validity will be thoroughly addressed by the parallel litigation. Thus, that *another* defendant in the district court proceedings is *also* litigating most of the petitioned prior art weighs yet further for discretionary denial.

F. Factor 6: The Petition Does Not Present “Compelling Evidence Of Unpatentability.”

Factor 6—the merits of the petition—also weighs against institution, because the petition fails to pass the higher threshold of a “compelling” unpatentability challenge that could preclude discretionary denial. Guidance at 4. “[T]he compelling merits standard is a higher standard than the standard for institution set by statute.” *Commscope Techs. v. Dali Wireless, Inc.*, IPR 2022-01242, Paper 23, 3 (PTAB Feb. 27, 2023). That higher standard requires determining that Petitioner is “*highly likely*” to succeed on the merits. *Id.* at 4. The opposite is true here.

As discussed below in more detail, relevant disclosure in four of the seven prior art references cited in the petition were previously presented to the patent office

during prosecution of the '483 patent; the other three references are only offered in support of challenging six dependent claims (out of 37 claims in total). See Section III, *infra*. Petitioner incorrectly states that the PTO has not considered “substantially the same prior art or arguments” and, as a result, unsurprisingly fails to explain how the Examiner erred when considering identical prior art subject matter during prosecution. (Petition at 83-84.)

Because the petition merely retreads old grounds previously presented to the Patent Office, it is not reasonably likely – and is certainly not *highly* likely – to succeed on the merits. Accordingly, this factor weighs in favor of discretionary denial.

* * *

In sum, all six factors weigh for discretionary denial. Accordingly, Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d) AND/OR § 314(a)

The Board has discretion to deny institution of a petition when “the same or substantively the same prior art or arguments previously were presented to the Office,” 35 U.S.C. § 325(d), as well as when institution “would not be an efficient use of the Board’s time and resources.” 35 U.S.C. § 314(a).

Here, discretionary denial is proper because (a) relevant disclosure of four of the seven prior art references cited in the petition (including both primary references) are included in prior art previously considered by the Patent Office, with the other three references being asserted against only dependent claims; and (b) even if the three references presented new material relevant to six dependent claims, it would not be an efficient use of the Board's time and resources—nor the parties'—to institute all eleven grounds against all 37 claims, all of which rely on previously considered prior art arguments. *See Monolithic Power Sys., Inc. v. Volterra Semiconductor LLC*, IPR2020-01348, Paper 19 at 12-13 (PTAB Mar. 4, 2021) (discretionarily denial where Section 325(d) “is sufficiently implicated such that its statutory purpose would be undermined by instituting on the remaining claims”); *Biofrontera Inc. v. DUSA Pharms.*, No. IPR2018-01585, Paper 10 at 14, 43 (PTAB Feb. 26, 2019).

When deciding whether to exercise its Section 325(d) discretion, the Board considers a two-part framework: “(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 Gerate GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

**A. The Same Or Substantially The Same Prior Art And Arguments
Were Previously Presented To The Office**

Four references, including the two primary references across all eleven grounds, are the same or substantially the same prior art previously presented to the Patent Office. Disclosures of Howell-596, Howell-833, and Blum-741 upon which the petition relies are included in references previously reviewed or even distinguished by the Patent Office, and Hattori-912 is duplicative of Krulevitch.

In the first part of the *Advanced Bionics* framework, the Board may consider the relevant *Becton Dickinson* factors: (a) the similarities of the asserted art and the art previously considered; (b) the cumulative nature of the asserted art and the art previously considered; and (d) the extent of the overlap between the arguments made during examination and the petitioner's arguments. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9-10 (citing *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (informative)).

Petitioner asserts eleven grounds that include varied combinations of just seven references:

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Reference(s)	Grounds	Previous Consideration
Howell-596	1, 2, 3, 4, 5, 6, 7	U.S. Patent Application Publication No. 2006/0023158A1 ("Howell-158") claims priority of, and incorporates by reference, Howell-596. (EX-2011 at 31.) Howell-158 is listed in a signed IDS. (Ex-1019 at 114.)
Howell-833	3, 4, 5, 6, 7	Disclosure of Howell-833 relied on in the Petition also appears in U.S. Patent Application Publication No. 2005/0264752A1 ("Howell-752") (EX-2012), which is listed in a signed IDS. (Ex-1019 at 114.)
Blum-741	4, 5, 8, 9, 10, 11	Disclosure of Blum-741 relied on in the Petition also appears in U.S. Patent No. 6,491,394 ("Blum-394") (EX-2013), which was discussed by Examiner in the prosecution history and overcome by Applicant to allow the current claims in the '483 patent. (Ex-1019 at 137-145, 181-185.) In addition, U.S. Patent Application Publication No. 2005/0140924A1 ("Blum-924") is a divisional application of Blum-741 and shares the same specification of Blum-741. (EX-2014.) Blum-924 was also listed in a signed IDS. (EX-1019 at 114.)
Hattori-912	8, 9, 10, 11	Cumulative to US Patent No. 7,030,411 <i>et al</i> ("Krulevitch") (EX-2017) for purported disclosure of "a sealed moisture resistant module attached to the frame." (Ex-1019 at 110-111.)
Spitzer	5, 9	Allegedly new reference; only asserted against claims 3 and 21.
Ogren	6, 10	Allegedly new reference; only asserted against claims 11 and 29.

Reference(s)	Grounds	Previous Consideration
Jannard-868	7, 11	Allegedly new reference; only asserted against claims 12 and 20.

With the exception of six dependent claims out of thirty-seven (37) challenged claims, the petition presents no new prior art disclosure and instead asks the Board to reconsider the Examiner's previous findings.

1. Grounds 1 – 7

The disclosures of Howell-596, Howell-833, and Blum-741 upon which the petition relies are the same prior art previously presented to the Patent Office.

Ground	Reference(s)	35 U.S.C. §	Challenged Claims
1	Howell-596	102	1, 9-10, 14-15, 18
2	Howell-596	103	1-2, 6-10, 13-16, 18
3	Howell-596 and Howell-833	103	19-20, 24-28, 31-35, 37
4	Howell-596, Howell-833, and Blum-741	103	4-5, 7, 17, 22-23, 25, 36
5	Howell-596, Howell-833, Blum-741, and Spitzer	103	3, 21
6	Howell-596, Howell-833, and Ogren	103	11, 29
7	Howell-596, Howell-833, and Jannard-868	103	12, 30

Howell-596 is the same prior art previously presented to the Patent Office. Under Grounds 1-7, Petitioner relies on Howell-596, either alone or in combination with Howell-833, in challenging the independent claims of the '483 patent. (Petition at 10.) Regarding claim 1, Petitioner relies on Howell-596, alone. (Petition at 14-18.)

In the prosecution history of the '483 patent, the Examiner signed an IDS disclosing Howell-158, explicitly noting that “[a]ll references [were] considered except where lined through.” (Ex-1019 at 114.) Howell-158 cites priority to Howell-596's application (U.S. Application No. 11/078,857) and incorporates the application by reference. (Ex-2011, [0003].) Accordingly, the entirety of Howell-596 is part of the disclosure of Howell-158, which in turn was considered by the Examiner during the prosecution. *Arbutus Biopharma Corp. v. Modernatx, Inc.*, 65 F.4th 656, 663-664 (Fed. Cir. 2023) (holding that when a reference or material from various documents is incorporated in the prior-art reference, the incorporated items are effectively part of the host document as if they were explicitly contained therein).

Accordingly, Petitioner's only invalidity theories against independent claim 1, under Grounds 1-7, require that the Board revisit prior art disclosure that was previously reviewed by the Patent Office.

Howell-833 is also the same prior art previously considered by the patent office. Regarding independent claim 19, Petitioner asserts that Howell-833 further discloses that “the module is disposed, at least partially, on a portion of the frame configured to be [sic] behind the ear of a wearer of the eyewear.” (Petition at 31-33.) The disclosure of Howell-833 relied on in the Petition, i.e., Howell-833 at 21:41-22:2, and Figs. 1 and 10A-10C (see Petition at 31) is identical to the disclosure of Howell-752, see EX-2012 at [0101]-[0104] and Figs. 1 and 10A-10C. Howell-752 is included in a signed IDS as having been reviewed and considered by the Examiner during prosecution. (Ex-1019 at 114.) Therefore, as to both independent claims and many of the dependent claims, Grounds 1-7 all rely on the same subject matter previously considered by the Examiner during prosecution.

Petitioner appears to substitute Howell-158 with Howell-596 and substitute Howell-752 with Howell-833 in an effort to evade discretionary denial while seeking reconsideration of the same subject matter. Reconsideration of the same reference and the same subject matter would duplicate the Examiner's efforts and needlessly expend Board and party resources.

That Howell-158 was not discussed in a rejection is irrelevant. The Board has previously instructed that references need not have been included in a rejection to satisfy the first prong. See *Medtronic Corevalve LLC v. Speyside Medical, LLC*,

IPR2021-00310, Paper 9 at 26 (PTAB July 23, 2021) (“Petitioner...seems to limit this factor to references that are expressly included in a rejection by the Examiner. This factor is not so limited.”). Indeed, the Board has confirmed that “[p]reviously presented art includes...art provided to the Office by an applicant, such as on an [IDS].” *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8.

Accordingly, the first prong of *Advanced Bionics* has clearly been met.

Spitzer, **Ogren**, and **Jannard-868** are asserted only in Grounds 5-7, each of which is a three- or four-reference combination against two dependent claims. (Petition at 10.) Petitioner does not rely on Spitzer, Ogren, or Jannard-868 as allegedly disclosing any of the independent claim limitations. (Petition at 44-52.) Petitioner cites Spitzer as relevant only to dependent claims 3 and 21, Ogren as relevant only to dependent claims 11 and 29, and Jannard-868 as relevant only to dependent claims 12 and 30. (*Id.*) Even if Spitzer, Ogren, and Jannard-868 presented new prior art subject matter and even if Petitioner's obviousness assertions were correct (which they are not), Grounds 5-7 would still rise or fall based on Petitioner's request that the Board reconsider the subject matter of the Howell references as allegedly anticipating or rendering obvious independent claims 1 and 19.

Accordingly, Grounds 1-7 present no new prior art disclosure in challenging 31 of the 37 challenged claims, including the independent claims, as the same or substantially the same prior art was previously reviewed by the Examiner.

2. Grounds 8 – 11

Blum-741 and Hattori-912 are substantially the same prior art previously considered by the patent office. Grounds 8-11 all rely on a combination of Blum-741 and Hattori-912 as allegedly rendering obvious the independent claims 1 and 19.

Blum-741 is the same or substantially the same as at least two prior art references previously presented to the Patent Office. *First*, Blum-942 is a divisional application of Blum-741 and they share the same specification. (Ex-2014 at 1.) And Blum-924 was listed in a signed IDS and considered by the Examiner during prosecution. (Ex-1019 at 114.)

Second, the disclosures of Blum-741 cited in the Petition are also duplicative of the disclosure of Blum-394, which was discussed by the Examiner in a rejection and overcome by the applicant to allow the patented claims. (Ex-1019 at 137-145, 181-185.)

For example, the below table compares the disclosures of Blum-741 cited in the petition to the duplicative disclosure contained in Blum-394:

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Disclosure of Blum-741 Cited in Petition	Disclosure of Blum-394
Blum-741 at FIG. 5, <i>see</i> Petition at 54.	EX-2013 at FIG. 5.
Blum-741 7:59-8:2, <i>see</i> Petition at 56.	EX-2013 at 6:22-32
Blum-741 at 29:66-30:13, <i>see</i> Petition at 57.	EX-2013 at 27:8-22.
Blum-741 at 31:29-32:57, 36:7-31, <i>see</i> Petition at 58.	EX-2013 at 28:37-29:65; 30:38-62.
Blum-741 at 45:49-46:42, <i>see</i> Petition at 59.	EX-2013 at 30:15-62.
Blum-741 at 32:7-52, <i>see</i> Petition at 61.	EX-2013 at 29:15-65.
Blum-741 at 32:58-34:62, <i>see</i> Petition at 61.	EX-2013 at 29:66-30:38.
Blum-741 at 4:63-35:15, <i>see</i> Petition at 62.	EX-2013 at 30:38-62.
Blum-741 at 37:14-24, <i>see</i> Petition at 62.	EX-2013 at 31:21-32.
Blum-741 at 5:61-67, 37:49-65, FIG. 5, <i>see</i> Petition at 64.	EX-2013 at 4:23-29, 31:55-32:4, and FIG. 5.
Blum-741 at 5:61-67, 7:52-58, 34:65-67, FIG. 5, <i>see</i> Petition at 64.	EX-2013 at 4:23-29, 6:14-21, 30:38-47, and FIG. 5.

Accordingly, Blum-741 is the same prior art previously reviewed by the patent office.

Hattori-912 is substantially the same as prior art previously reviewed by the patent office. Specifically, the disclosures of Hattori-912 cited in the petition are cumulative to the disclosures contained in U.S. Patent No. 7,030,411 (“Krulevitch”). During prosecution of the ’483 patent, then pending claims were rejected as obvious over Blum-394 and Krulevitch in a non-final office action dated June 11, 2013. (Ex-1019 at 110-111.) The Examiner conceded that Blum-394 did not disclose “a sealed moisture resistant module attached to the frame” but alleged that Krulevitch cured this deficiency. (*Id.* at 111.) In response, the applicant of the ’483 incorporated the allowable subject matter of a dependent claim into the independent claim to advance the prosecution. (Ex-1019 at 143-144.) The Examiner subsequently allowed the patented claims. (Ex-1019 at 181-185.)

Here, Petition relies on Hattori-912 purportedly for the disclosure of the same element, i.e., “a sealed moisture resistant module attached to the frame.” (Petition at 55-56.) Even if Hattori-912 does disclose this element (which it does not), it still adds no new subject matter for the Board to consider because the same element is allegedly disclosed in Krulevitch. Accordingly, Hattori-912 is substantially the same as prior art that was previously before the patent office.

Grounds 9-11 further rely on **Spitzer**, **Ogren**, and **Jannard-868** in the same way as Grounds 5-7, i.e., they are part of a three- or four-reference combination

against only six dependent claims. (Petition at 10.) For the same reasons discussed above (see Section III.A.1, *supra*), they do not save Grounds 9-11 from rising or falling based on Petitioner's request that the Board reconsider the subject matter of the Blum-741 and Hattori-912 as allegedly rendering obvious independent claims 1 and 19.

Accordingly, Grounds 8-11 present no new prior art disclosure in challenging thirty-one of the thirty-seven challenged claims, including the independent claims, as the same or substantially the same prior art was previously reviewed by the Examiner.

* * *

Petitioner asks the Board to reconsider the same or substantially the same prior art previously considered by the Examiner. *Advanced Bionics*, IPR2019-01469, Paper 6 at 14-17 (denying institution despite petitioner's combining a previously examined reference with three new references, finding new references duplicative of disclosure and arguments already considered by the Office).

B. Petitioner Makes No Claim that the Examiner Erred During Prosecution

Becton Dickinson factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469,

Paper 6 at 10; *see Becton Dickinson*, IPR2017-01586, Paper 8, 17–18 (designated as informative). Petitioner has not.

In fact, Petitioner does not even acknowledge that the disclosure of primary references Howell-596 and Blum-741 relied on in all grounds were already considered by the Examiner (*see* III.A. *supra*), much less allege any specific Examiner error during prosecution.

The Examiner did not err. The disclosure of Blum-741 to which Petitioner cites merely discloses that some electric components (e.g., view detector) may be disposed in a temple. Petition at 64-65 (citing Ex-1005, 5:61-67, 7:52-58, 34:65-67, Fig. 5). The Examiner would have correctly found such a disclosure irrelevant, because the cited portions do not disclose that the entire “sealed moisture resistant module” is within the first temple. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9 (“If reasonable minds disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” Therefore, the Examiner made no error in issuing the ’483 patent over Blum-394, which includes all the disclosure of Blum-741, in view of Krulevitch. Accordingly, the *Advanced Bionics* framework supports discretionary denial of institution under Section 325(d) and/or Section 314.

IV. CONCLUSION

For all the reasons stated herein, Patent Owner respectfully requests the Board exercise its discretion to deny the petitioned grounds.

Date: October 11, 2024

Respectfully submitted,
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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. § 42.24 have 6042 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 365 v.2022.

Date: October 11, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001 – 2017** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on October 11, 2024 and courtesy copies were also served via electronic mail, in their entireties on the following:

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