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On behalf of **Luxottica of America Inc.**

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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 8,708,483

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Patent Owner asks for discretionary denial under *Fintiv* and § 325(d). The Board should not deny on either basis and should instead institute review.

I. THE *SOTERA* STIPULATION PRECLUDES A *FINTIV* DENIAL

Petitioner has provided a *Sotera* stipulation. Petition 82. The Director’s June 2022 Memorandum (“Director’s Memo”) is “binding agency guidance” that prohibits a *Fintiv* denial where the petitioner submits a *Sotera* stipulation. Memo at 3, *available at* <https://tinyurl.com/usptoDirMemo>; *see also Hilti AG v. Specified Techs. Inc.*, IPR2024-00193, Paper 17 at 10 (PTAB May 14, 2024) (“The [Director’s Memo] binds this panel.”). The Director’s Memo unambiguously states three times that the Board “will not” discretionarily deny institution due to parallel litigation when the petitioner files a *Sotera* stipulation. Memo at 3, 7, 9. “Because Petitioner has provided a *Sotera* stipulation, the Director Memo is controlling and the *Fintiv* factors are not a basis for denying institution.” *Meta Platforms, Inc. v. Immersion Corp.*, IPR2023-00946, Paper 13 at 16 (PTAB Dec. 8, 2023).

Patent Owner nevertheless argues the Board should create an exception to the Director’s Memo and accord Petitioner’s stipulation “no weight” for two reasons. POPR 14. First, Patent Owner argues, by the time the Board decides whether to institute, the parties will supposedly have “expended the resources to litigate the same prior art through the completion of validity expert reports.” *Id.* This first argument fails because the factual premise is false: the district court vacated the 2024

deadlines for expert reports and will not reset them until after it construes the claims. Ex. 1022. Moreover, the Director’s Memo acknowledges that considering the parties’ investment in parallel litigation is part of *Fintiv* factor 3, yet the Memo makes no exception to its rule that a *Sotera* stipulation precludes a *Fintiv* denial.

Second, Patent Owner argues “the stipulation does not bar Lenovo from litigating the very same invalidity challenges before the district court.” POPR 14. That argument is unavailing because Petitioner and Lenovo are independent and Petitioner is not a party to the suit Patent Owner freely chose to bring against Lenovo. In similar circumstances, the Board has rejected arguments seeking an exception to the Director’s Memo. In *Structural Wrap, LLC v. System Stormseal Pty Ltd.*, the patent owner argued a *Sotera* stipulation was insufficient because it did not bind the petitioner’s indemnitee. IPR2024-00084, Paper 13 at 12–13 (PTAB May 9, 2024). But the petitioner was not a party to the suit against its indemnitee. *Id.* at 14–15. Noting it could not “effectively ignore the Director Memo under these circumstances,” the Board rejected the patent owner’s argument. *Id.* at 13.

Similarly, in *Box, Inc. v. Topia Technology, Inc.*, the patent owner argued the petition failed to name a third party as a real party in interest. IPR2023-00427, Paper 17 at 9, 19 (PTAB Aug. 4, 2023). This third party was a defendant in a parallel lawsuit that the petitioners’ *Sotera* stipulation did not cover. *See id.* The third party was therefore “free to raise Petitioners’ same (and more) invalidity contentions.” *Id.*

at 19 (quoting patent owner). Nonetheless, the Board was unpersuaded that the stipulation fell outside the scope of the Director’s Memo. *Id.*

The Board has also rejected other proposed exceptions to the Director’s precept that a *Sotera* stipulation precludes a *Fintiv* denial. *See, e.g., Hilti*, Paper 17 at 11 (rejecting proposed “exception for parallel litigation where duplicative ‘product’ prior art is asserted”); *Meta*, Paper 13 at 15 (rejecting proposed exception “based on the advanced state of the district court case and the duplication of invalidity grounds asserted in this proceeding”).

Here, the Board should likewise decline to create an exception to the binding Director’s Memo. Petitioner and Lenovo are independent parties whom Patent Owner sued in separate suits. Petitioner’s *Sotera* stipulation precludes a *Fintiv* denial.

II. PATENT OWNER’S § 325(D) ARGUMENT FAILS

A. Patent Owner fails the first prong of *Advanced Bionics*.

1. Hattori-912 was not before the examiner and is not cumulative.

Grounds 8–11 rely on Hattori-912, which was not before the examiner. Ex. 1001 at 1–3; *see* Petition 7–8; POPR 27. Patent Owner does not deny this. Rather, Patent Owner argues Hattori-912 is cumulative of Krulevitch (Ex. 2017). But Patent Owner fails to cite any Krulevitch disclosure that Hattori-912 supposedly duplicates. Instead, Patent Owner argues the references are cumulative merely because Hattori-

912 discloses the limitation to which the examiner applied Krulevitch. POPR 27.

Patent Owner ignores that Petitioner applies Hattori-912 to many more limitations of the independent claims than just the one to which the examiner applied Krulevitch. *See* Petition 53–68. In particular, Petitioner applies Hattori-912 against the limitations that led to allowance. *Id.* at 64–68. Furthermore, Hattori-912 provides better motivations to combine than Krulevitch. For example, unlike Krulevitch, Hattori-912 is directed to eyewear. And unlike Krulevitch, Hattori-912 explicitly shows a sealed, moisture-resistant module enclosed within an eyeglass frame. *Id.* at 55, 65. Because Hattori-912 discloses more than Krulevitch and provides better motivations to combine, *Becton, Dickinson* (“BD”) factors (a), (b), and (d) weigh against denial. *See Masimo Corp. v. Apple Inc.*, IPR2023-00634, Paper 14 at 13–18 (PTAB Sept. 25, 2023) (declining to exercise discretion where the references “are stronger than and not substantially the same as the references previously before the Examiner”); *Halliburton Energy Servs., Inc. v. U.S. Well Servs., LLC*, IPR2021-01065, Paper 9 at 11–14 (PTAB Feb. 9, 2022) (references not cumulative “because they provide teachings that go to motivation to combine”).

2. Denial of the petition under § 325(d) is not warranted at least because Grounds 8–11 rely on Hattori-912 to challenge all claims.

Grounds 8–11 each rely on Hattori-912 and together challenge every claim. Petition 10. And because Hattori-912 teaches key limitations of each independent claim (Petition 53–79), it is central to one of Petitioner’s challenges to each claim.

Therefore, regardless of Grounds 1–7, Grounds 8–11 make discretionary denial under § 325(d) inappropriate. *E.g.*, *Shenzen Chic Elecs. v. Pilot, Inc.*, IPR2023-00810, Paper 12 at 21 n.11 (PTAB Nov. 8, 2023) (§ 325(d) denial inappropriate where challenges based on new art/arguments “address all challenged claims,” regardless of whether other challenges relied on previously considered art); *TP-Link Corp. Ltd. v. Netgear, Inc.*, IPR2023-01469, Paper 10 at 9–10 (PTAB Apr. 2, 2024) (same). Because Patent Owner fails the first prong of *Advanced Bionics*, the Board need not consider the second prong and should decline to deny under § 325(d).

3. The examiner also never evaluated multiple references on which Grounds 1–7 rely.

While Patent Owner’s failure to satisfy the first prong for Grounds 8–11 independently dooms its request for a § 325(d) denial, Patent Owner also fails the first prong on Grounds 1–7. Patent Owner identifies no IDS listing any of the six references asserted in Grounds 1–7. Indeed, Patent Owner does not contend the examiner considered three of the references (Spitzer, Ogren, and Jannard-868).

Patent Owner posits two of the other three references (Howell-596 and Howell-833) are cumulative of two references appearing in a signed IDS: Howell-158 and Howell-752. POPR 22–23. That IDS was 12 pages long and appears to list over 270 references. Ex. 1019 at 114–125. Patent Owner fails to show the examiner meaningfully considered Howell-158 or Howell-752. Indeed, Patent Owner acknowledges “Howell-158 was not discussed in a rejection.” POPR 23.

Consistent with the April 2024 Notice of Proposed Rule Making, 89 FR 28693, 28702, 28705, the Board has found that mere disclosure of a reference in an IDS does not establish the reference was previously presented to the Office for purposes of *Advanced Bionics*. If the patent owner fails to demonstrate the examiner meaningfully addressed the reference, the first prong of *Advanced Bionics* is unmet, and the Board has declined to deny under § 325(d). *JUUL Labs, Inc. v. NJOY, LLC*, IPR2024-00160, Paper 10 at 11–13 (PTAB May 24, 2024); *Samsung Elecs. Co. v. Maxell, Ltd.*, IPR2024-00867, Paper 9 at 17, 20 (PTAB Nov. 7, 2024). Particularly when an IDS lists 50 or more references, “a blanket statement printed on the bottom of the IDS that ‘all references considered except where lined through’” fails to establish the examiner substantively considered any one reference and thus fails to satisfy the first prong of *Advanced Bionics*. *Samsung*, Paper 9 at 17, 20.

Because the examiner did not meaningfully address at least Howell-596, Howell-833, Spitzer, Ogren, or Jannard-868, Patent Owner also fails the first prong of *Advanced Bionics* in connection with Grounds 1–7.

B. Patent Owner also fails the second prong of *Advanced Bionics*.

Patent Owner represents: “Petitioner Makes No Claim that the Examiner Erred During Prosecution.” POPR 28. But the whole point of the petition is that the claims should not have issued in light of the prior art. And Petitioner argued “the claims were allowed under a mistaken premise.” *E.g.*, Petition 8; *also id.* at 83–84

(citing Ex. 1019 at 138–45, 184). When providing reasons for allowance, the examiner cited the applicant’s remarks that what issued as claims 1 and 19 were allowable because they were dependent claims 18 and 26 written in independent form. Ex. 1019 at 143–44 (applicant’s remarks), 181–85 (examiner citing remarks). Because the examiner had rejected base claim 13, *id.* at 110–12, the additional limitations of claims 18 and 26 were what secured allowance. Those additional limitations recite that the claim’s sealed module is disposed within a temple of the eyewear frame (in issued claim 1) or disposed, at least partially, on a portion of the eyewear frame configured to be behind the ear of a wearer (in issued claim 19). *Id.* at 4–5 (claims 18 and 26 during examination). And Petitioner has shown that “prior art references not considered by the Examiner, including Howell-596, Hattori-912, and Howell-833, disclose these limitations.” Petition 7, 15–18, 31–33, 64–68, 84.

1. The examiner erred in not applying Howell-596 and Howell-833 to reject the claims as in Grounds 1–7.

Howell-596 discloses a sealed, moisture-resistant module disposed within the temple of an eyeglass frame. *E.g.*, Petition 15–18. Moreover, it would have been obvious to combine Howell-596 with Howell-833 to arrive at a sealed module disposed, at least partially, on a portion of an eyewear frame configured to be behind the ear of a wearer. *Id.* at 31–33. These references thus disclose the limitations that led the examiner to allow the claims.

The examiner never applied Howell-596, Howell-833, or any substantially

similar reference. *Supra* § II.A.3. Patent Owner does not contend otherwise. *See* POPR 28–29. When the asserted art “was not substantively remarked upon or applied in a rejection of the claims,” “the petitioner may show material error by showing that the Office failed to reject the claims over the asserted art.” *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10 at 13–14 (PTAB Oct. 10, 2023). In other words, Petitioner’s showing on the merits in Grounds 1–7 demonstrates material error, including “that the Office overlooked the prior art’s teachings of the limitations that were the basis for allowing the challenged claims.” *Id.* at 15. Patent Owner does not address this error.

2. The examiner erred in not applying Hattori-912 to reject the claims as in Grounds 8–11.

As discussed in Grounds 8–11, Hattori-912 discloses the limitations of issued claims 1 and 19 that led to allowance. *E.g.*, Petition 64–68. Because the examiner never applied Hattori-912, Petitioner’s merits showing in Grounds 8–11 demonstrates the examiner materially erred in allowing the ’483 patent without considering Hattori-912. *Quasar*, Paper 10 at 13–14. Patent Owner does not address this error either.

Because Petitioner showed the examiner materially erred with respect to each ground, Patent Owner fails the second prong of *Advanced Bionics*. For this reason as well, the Board should decline Patent Owner’s § 325(d) request and instead institute review.

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Dated: December 4, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of
PETITIONER’S REPLY TO PATENT OWNER’S PRELIMINARY RESPONSE
is being served by email on Patent Owner as follows:

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