

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.

IPR2024-01030
Patent 8,708,483 B2

Before RICHARD H. MARSCHALL, JOHN D. HAMANN, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Petitioner Luxottica of America Inc. filed a Petition requesting *inter partes* review of claims 1–37 of U.S. Patent No. 8,708,483 B2 (Ex. 1001, “the ’483 patent”). Paper 1 (“Pet.”). Patent Owner e-Vision Optics, LLC filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 8 (“Prelim. Reply”)) and Patent Owner filed a Preliminary Sur-Reply (Paper 10 (“Prelim. Sur-Reply”)).

We have jurisdiction under 35 U.S.C. § 314. Under § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the challenged claims in the petition.” *Id.* at § 314(a). If the Board institutes a trial, “the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a). Because we determine that Petitioner demonstrates a reasonable likelihood that at least one challenged claim is unpatentable, we institute an *inter partes* review of all claims as challenged in the Petition.

BACKGROUND

A. Real Parties-in-Interest and Related Matters

Petitioner states that “Luxottica of America Inc. and Luxottica Group S.p.A. are the real parties in interest for Petitioner.” Pet. 84. Petitioner also identifies EssilorLuxottica S.A. as the parent company to these companies. *See id.* Patent Owner identifies itself as the only real party-in-interest. Paper 6, 1. The parties are reminded of their continuing obligation to update their mandatory notice information “within 21 days of a change of the information.” 37 C.F.R. § 42.8(a)(3).

The parties indicate that the '483 patent is the subject of the following infringement actions: *e-Vision Optics, LLC et al. v. Luxottica Group S.p.A et al.*, No. 8:23-cv-02013 (C.D. Cal.) (“the Litigation”) and *e-Vision, LLC et al. v. Lenovo Group Ltd. et al.*, No. 8:23-cv-01860 (C.D. Cal.) (“the Lenovo Litigation”). Pet. 84; Paper 6, 1.

B. The '483 Patent

The '483 patent “relates to integrating electronic components into an electro-active frame for driving electro-active focusing lenses.” Ex. 1001, code (57). The '483 patent states that its device allows for user control of “an electroactive lens in a deliberate, hands free manner” while “minimizing the number of frame part SKUs [stock keeping units], and maintaining the aesthetics of the frame. *Id.* at code (57), 2:23–34. The disclosed device employs “one or more electronic modules” to achieve these goals. *Id.* at 2:35–47.

The electronic modules that the '483 patent discloses may be placed near the temples of the spectacles. Ex. 1001, 2:51–54, Fig. 6. Figures 1A–1C illustrate an electronic module in the electro-active spectacles and are reproduced below.

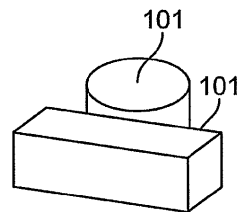
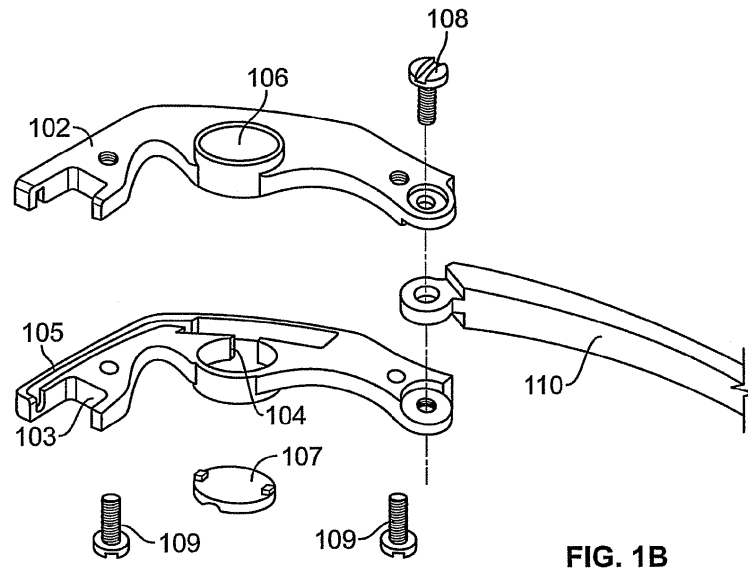
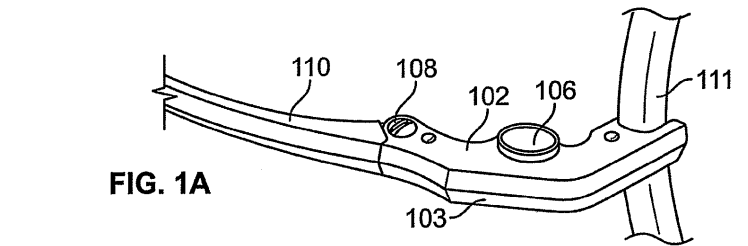


Figure 1A illustrates a universal frame housing including upper and lower lens frame component pieces 102, 103, manual touch switch 106, frame temple 110, and eye-wire 111. Ex. 1001, 3:27–29, 5:64–6:16. Figure 1B shows an exploded view of the universal frame housing of Figure. 1A, which includes receptacle 104 for electronic module 101, and receptacle cover 107. *Id.* at 3:30–31, 5:66–6:8. Figure 1C illustrates electronic module

101, illustrated here “as a cylinder and a block section attached to the side of the cylinder.” *Id.* at 3:32, 5:54–57.

The cylinder portion of electronic module 101 “may contain both the power source and the drive circuit,” while the “block portion may contain a sensing mechanism, for example a tilt switch.” Ex. 1001, 5:58–61.

Electronic module 101 “may also house an antenna, a receiver, a transmitter, a transceiver, a sensor, a rangefinder, a micro-processor, and a controller.” *Id.* at 5:61–63. “The module preferably houses any of the aforementioned electrical components in a substantially water-proof and wear resistant/moisture resistant environment and is preferably hermetically sealed.” *Id.* at 10:47–50.

C. The Asserted Challenges

Petitioner challenges claims 1–37 on the following grounds (Pet. 10):

Claims Challenged	35 U.S.C. §¹	Basis
1, 9, 10, 14, 15, 18	102	Howell-596 ²
1, 2, 6–10, 13–16, 18	103	Howell-596
19, 20, 24–28, 31–35, 37	103	Howell-596, Howell-833 ³

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the ’483 patent issued from an application having an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

² US Patent Pub. No. 2005/0230596 A1, published October 20, 2005 (Ex. 1003, “Howell-596”).

³ US 7,581,833 B2, issued September 1, 2009 (Ex. 1004, “Howell-833”).

4, 5, 7, 17, 22, 23, 25, 36	103	Howell-596, Howell-833, Blum-741 ⁴
3, 21	103	Howell-596, Howell-833, Blum-741, Spitzer ⁵
11, 29	103	Howell-596, Howell-833, Ogren ⁶
12, 30	103	Howell-596, Howell-833, Jannard-868 ⁷
1, 2, 4–10, 13–20, 22–28, 31–37	103	Blum-741, Hattori-912 ⁸
3, 21	103	Blum-741, Hattori-912, Spitzer
11, 29	103	Blum-741, Hattori-912, Ogren
12, 30	103	Blum-741, Hattori-912, Jannard-868

In support of these challenges, Petitioner submits the Declaration of Dr. John Feland. *See* Ex. 1002.

D. Challenged Claims

Petitioner challenges all 37 claims of the '483 patent, including independent claims 1 and 19. Claim 1 is illustrative and recites:

1. Eyewear comprising:
a frame; and
a sealed moisture resistant module attached to the frame
wherein the module comprises within the seal any two of: a

⁴ US 6,857,741 B2, issued February 22, 2005 (Ex. 1005, “Blum-741”).

⁵ US 6,091,546, issued July 18, 2000 (Ex. 1007, “Spitzer”).

⁶ WO 2005/119344 A1, published December 15, 2005 (Ex. 1008, “Ogren”).

⁷ US 5,760,868, issued January 2, 1998 (Ex. 1009, “Jannard-868”).

⁸ Japanese Unexamined Patent Application Publication Number S58-113912, published July 7, 1983 (Ex. 1006, “Hattori-912”) (original at Ex. 1006, Ex. A; translation at Ex. 1006, Ex. B). We cite to the translation of Hattori-912 at Ex. 1006.

switch, a detector, a processor, a power source, a drive circuit, a transmitter, a receiver, a transceiver, and a sensor, wherein the frame comprises a first temple and a second temple, and wherein the module is disposed within the first temple.

Ex. 1001, claim 1.

ANALYSIS

A. Discretionary Denial in View of Parallel District Court Litigation

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314 due to parallel district court litigation, citing the discretionary-denial factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). See Prelim. Resp. 3–17; Prelim. Sur-reply 1–2.

Institution of *inter partes* review is discretionary. See *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a). The Board may, in the interest of fairness and the efficient use of Board resources, deny institution under § 314(a) where there are parallel district-court proceedings involving the same or substantially the same parties and invalidity challenges. *Fintiv*, Paper 11 at 5–6, 12–13. *Fintiv* presents six factors, which “relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6.

Our analysis under *Fintiv* is guided by the Director’s Memorandum titled *Interim Procedure for Discretionary Denials in AIA Post-Grant*

Proceedings with Parallel District Court Litigation (June 21, 2022)⁹ (“*Fintiv* Memo”). The *Fintiv* Memo sets forth, *inter alia*, that the Board will not discretionarily deny institution under § 314(a) when a petitioner submits a so-called *Sotera* stipulation, i.e., the 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.” *Fintiv* Memo 7 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)). A *Sotera* stipulation mitigates concerns of potentially conflicting PTAB and district-court decisions and duplicative efforts between the district court and PTAB. *Id.*

Here, Petitioner provides a *Sotera* stipulation: “Petitioner hereby stipulates that, if the Board institutes review, Petitioner will not pursue in the Litigation invalidity of the ’483 patent based on any ground Petitioner raised or reasonably could have raised in this Petition.” Pet. 82. Petitioner argues that the *Fintiv* Memo “unambiguously states three times that the Board ‘will not’ discretionarily deny institution due to parallel litigation when the petitioner files a *Sotera* stipulation.” Prelim. Reply 1 (citing *Fintiv* Memo at 3, 7, 9).

We agree with Petitioner. In light of the Director’s *Fintiv* guidance regarding a *Sotera* stipulation, we decline to exercise discretion under § 314(a) to deny institution of *inter partes* review. *See Fintiv* Memo 3 (“[T]he PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue

⁹ Available at

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.”); *see also id.* (stating that the *Fintiv* Memo “is issued under the Director’s authority to issue binding agency guidance to govern the PTAB’s implementation of various statutory provisions”).

Moreover, we find unavailing Patent Owner’s arguments that the challenged patent also is asserted against a third party (i.e., Lenovo) in a separate litigation proceeding on a parallel track (i.e., the Lenovo Litigation), and that “Petitioner’s stipulation should carry no weight here because” it “does not bar Lenovo from litigating the very same invalidity challenges before the district court.” Prelim. Resp. 1, 13–14. Patent Owner adds that Petitioner’s stipulation thus does not mitigate any concerns of duplicative efforts between the district court and the Board, or of potentially conflicting decisions. *Id.* at 14.

We determine that Petitioner’s *Sotera* stipulation mitigates the concerns of potentially conflicting Board and district court decisions as to the disputes between Petitioner and Patent Owner. In addition, Patent Owner does not direct us to any evidence that Lenovo is a real party-in-interest or privy in this proceeding. Nor does Patent Owner direct us to evidence demonstrating any involvement or control by Lenovo in this proceeding. Thus, Lenovo’s actions, including whether Lenovo raises the same grounds of unpatentability in the Lenovo Litigation, should not be imputed to Petitioner. Moreover, as a third party, Lenovo could settle its litigation or change tack on its unpatentability arguments, leaving Petitioner’s unpatentability arguments still to be resolved. We also note that Patent Owner submits that it “is unaware of any post-Memo decision

discretionarily denying institution in the[] circumstances” we have here.

Prelim. Sur-reply 1.

In sum, in light of the above, we decline to exercise discretion to deny institution under § 314(a).

B. Discretionary Denial under 35 U.S.C. § 325(d)

Patent Owner urges us to deny the Petition under 35 U.S.C. § 325(d). Prelim. Resp. 17–29. Pursuant to 35 U.S.C. § 325(d), in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”¹⁰ In evaluating whether to exercise our discretion to deny institution under § 325(d), we weigh the following non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

¹⁰ The Board institutes trial on behalf of the Director. 37 C.F.R. § 42.4(a).

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential in relevant part).

The enumerated factors “should be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office during a proceeding pertaining to the challenged patent.” *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 10 (PTAB Feb. 13, 2020) (precedential). Factors (a), (b), and (d) relate to whether the art and arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Id.* Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* *Advanced Bionics* summarizes the two-part framework we use to decide whether to discretionarily deny institution under § 325(d):

Thus, under § 325(d), the Board uses the following 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 [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of [the] challenged claims.

Id. at 8.

1. Part One of the Advanced Bionics Framework

Applying the *Advanced Bionics* framework, we first determine whether the same or substantially the same art or arguments were presented previously to the Office. During prosecution of the application leading to the ’483 patent, the Examiner rejected the pending claims. Ex. 1019, 109–

113. In response, the applicant amended what is now independent claim 1 to add limitations directed to the sealed module within the temple of the eyewear frame and amended what is now independent claim 19 to add limitations directed to the sealed module on a portion of the eyewear frame configured to be behind the ear of a wearer. *Id.* at 137–45. The Examiner allowed the claims in response to the amendments. *Id.* at 181–185.

We focus on Petitioner’s challenges based at least in part on Blum-741 and Hattori-912, which include challenges to all of the claims of the ’483 patent. *See* Pet. 10. Patent Owner argues that Blum-741 “is the same or substantially the same as at least two prior art references previously presented to the Patent Office,” including another Blum reference that shares the same specification with Blum-741. Prelim. Resp. 25. Patent Owner also argues that “the disclosures of Hattori-912 cited in the petition are cumulative to the disclosures contained in U.S. Patent No. 7,030,411 (‘Krulevitch’).” *Id.* at 27. According to Patent Owner, the “Petition relies on Hattori-912 purportedly for the disclosure of the same element [Krulevitch discloses], i.e., ‘a sealed moisture resistant module attached to the frame.’” *Id.* (citing Pet. 55–56). Patent Owner asserts that “[e]ven 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.” *Id.*

Petitioner argues that “Patent Owner fails to cite any Krulevitch disclosure that Hattori-912 supposedly duplicates” and “[i]nstead, Patent Owner argues the references are cumulative merely because Hattori 912 discloses the limitation to which the examiner applied Krulevitch.” Prelim. Reply 3–4 (citing Prelim. Resp. 27). Petitioner also asserts that “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,” including “the limitations that led to allowance.” *Id.* at 4 (citing Pet. 53–68). Petitioner also alleges that Hattori-912 provides better motivations to combine than Krulevitch because Hattori-912, unlike Krulevitch, “is directed to eyewear” and “explicitly shows a sealed, moisture-resistant module enclosed within an eyeglass frame.” *Id.* (citing Pet. 55, 65).

In reply, Patent Owner argues that the Examiner considered Krulevitch for the same limitations at issue with respect to Petitioner’s reliance on Hattori-912, including considering a sealed module within an eyewear temple by virtue of the potential combination of Krulevitch with one of the Blum references. Prelim. Sur-reply 3–4. Finally, Patent Owner contends that “[e]ven were Hattori-912 to be found unique, discretionary denial would still be warranted to avoid wasted resources in retreading previously presented art in Grounds 1–7.” *Id.* at 4.

We agree with Petitioner that the record fails to show that Hattori-912 is cumulative of Krulevitch. As Petitioner correctly points out, Patent Owner does not adequately support its cumulativeness argument by comparing the disclosures of Hattori-912 and Krulevitch. *See* Prelim. Resp. 27. Patent Owner seems to assume that Petitioner’s mere reliance on Hattori-912 to teach similar limitations as those arguably disclosed by Krulevitch establishes the cumulative nature of the disclosures, but merely relying on new prior art to teach the same limitations as art before the Examiner, standing alone, does not establish cumulativeness of the art as a whole. *See id.* The situation here underscores this point, where the new

prior art (Hattori-912) expressly discloses aspects of eyewear that the prior art before the Examiner (Krulevitch) does not, rendering Hattori-912 arguably more readily combinable with other eyewear prior art such as Blum-741. *See* Pet. 53–65. Moreover, Petitioner expressly argues that Hattori-912 discloses eyewear limitations that Krulevitch does not. *See id.* at 55–59 (“Hattori-912 discloses an eyewear frame having a ‘hollow part 30’ in which electronic components are embedded”), 64–65 (“Hattori-912 discloses that the sealed module is embedded in the eyewear frame.”).

Under these circumstances, we do not view the disclosures of Hattori-912 and Krulevitch, or the obviousness arguments they raise, as sufficiently similar to satisfy the first prong of the *Advanced Bionics* framework. We also decline Patent Owner’s invitation to discretionarily deny on the basis that the grounds based on Blum-741 and Hattori-912 would present a waste of resources.

2. *Part Two of the Advanced Bionics Framework*

Although the failure to satisfy part one of the *Advanced Bionics* framework provides one basis to refuse Patent Owner’s request to discretionarily deny institution, for completeness we also consider whether Petitioner shows a material error under part two of the *Advanced Bionics* framework. Petitioner argues that the prior art discloses claim limitations added during prosecution to secure the allowance of the claims, such that “the claims were allowed under a mistaken premise.” Pet. 7–8. For example, Petitioner argues that Howell-596 discloses the limitation requiring a sealed module disposed within the temple of an eyewear frame. *See id.* at 7, 15, 17 (citing Ex. 1002 ¶¶ 61, 68; Ex. 1003 ¶¶ 194–195); Prelim. Reply 7.

Patent Owner argues that Petitioner makes no claim of Examiner error in the Petition. Prelim. Resp. 29. Patent Owner argues that the Examiner considered Howell-596, but does not argue that Howell-596 fails to disclose the limitations that Petitioner contends Howell-596 discloses. *See id.*; Prelim. Sur-reply 4.

We agree with Petitioner that it alleged the Examiner erred in failing to appreciate that Howell-596 discloses the limitations added to the independent claims to gain their allowance. *See* Pet. 7–8, 15–18. As more fully addressed below in our analysis of Petitioner’s anticipation challenge based on Howell-596, we agree with Petitioner, based on the current record, that Howell-596 discloses all of the limitations of claim 1 and anticipates claim 1. These limitations include the “sealed moisture resistant module attached to the frame” and “disposed within the first temple” limitations that allegedly distinguished over the prior art during prosecution, but which Howell-596 discloses. *See id.* at 15, 17; Ex. 1003 ¶¶ 194 (“Alternatively, the module housing 1700 does not include vents or holes, so as to be water-resistant or water-proof.”), 195 (“The module housing 1700 is then placed into an opening, cavity or container of an eyewear housing, such as a temple region of the eyewear housing.”).

Accordingly, we are persuaded that the Examiner erred in a manner material to patentability by overlooking these disclosures of Howell-596.

3. Conclusion

Based on our analysis within the *Advanced Bionics* framework, we find that the Petition does not implicate § 325(d) in a manner sufficient to warrant discretionary denial, and we decline to exercise our discretion to deny institution under § 325(d).

C. Level of Ordinary Skill in the Art

The level of ordinary skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including: “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Best Med. Int’l, Inc. v. Elekta Inc.*, 46 F.4th 1346, 1353 (Fed. Cir. 2022) (quoting *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007)). “The patent’s purpose can also be informative.” *Id.*

Petitioner contends that a person having ordinary skill in the art at the time of the invention would have had “at least a bachelor’s degree in mechanical or manufacturing engineering; mechatronics; electrical engineering plus coursework in mechanical engineering, manufacturing engineering, or mechatronics; or a similar technical degree, and at least 2 years of experience designing consumer electronics, such as eyewear with electronics.” Pet. 8 (citing Ex. 1002 ¶¶ 23–25). Petitioner contends that “[w]ork experience could substitute for formal education and additional formal education could substitute for work experience.” *Id.* Patent Owner does not contest Petitioner’s proposed definition or proffer a definition of its own. *See generally* Prelim. Resp.

We find Petitioner’s definition to be consistent with the problems and solutions disclosed in the ’483 patent and prior art of record, and adopt it as our own for purposes of this Decision. *See, e.g., GPAC*, 57 F.3d at 1579 (approving the determination of the level of ordinary skill in the art by appeal to the references of record).

D. Claim Construction

Pursuant to 37 C.F.R. § 42.100(b), we apply the claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under that standard, we give the words of a claim their plain and ordinary meaning as would have been understood by one skilled in the art at the time of the invention and in the context of the entire patent disclosure. *Id.* at 1312–13. Only terms in controversy need be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Here, Petitioner posits that “no claim terms require construction to resolve the patentability challenges here.” Pet. 9. Patent Owner does not oppose Petitioner’s contentions or proffer any constructions of its own. *See generally* Prelim. Resp.

At this time, we determine that no express construction of any term is necessary. We note that this determination does not preclude the parties from arguing their proposed constructions of the claims during trial. Indeed, the parties are hereby given notice that claim construction, in general, is an issue to be addressed at trial. A final determination as to claim construction will be made at the close of the proceeding, after any hearing, based on all

the evidence of record. The parties are expected to assert all of their claim construction arguments and evidence during the trial, as permitted by our rules.

E. Anticipation by Howell-596

Petitioner argues that Howell-596 anticipates claims 1, 9, 10, 14, 15, and 18. Pet. 10–20. Patent Owner does not argue that we should deny institution because Petitioner fails to show a reasonable likelihood of prevailing on this ground. *See* Prelim. Resp. 3–30. We first provide a brief overview of Howell-596 and then address Petitioner’s arguments.

1. Overview of Howell-596

Howell-596 discloses an electronic circuit within eyewear that allows a user to monitor its exposure to radiation, such as ultraviolet or infrared radiation or light. Ex. 1003, code (57).

We reproduce Figure 1 of Howell-596 below.

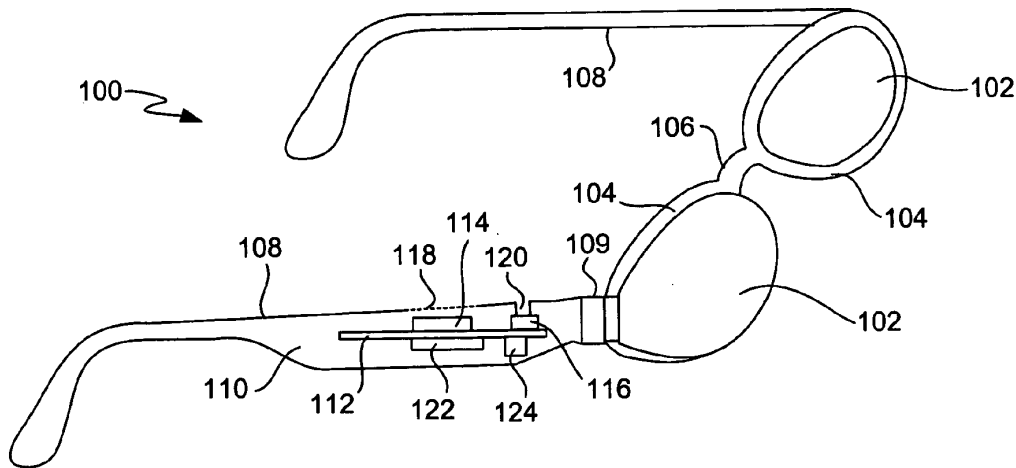


Figure 1 shows “a perspective view of UV monitoring glasses according to one embodiment of the invention.” Ex. 1003 ¶ 15. Figure 1 depicts glasses 100 that include a frame having lens holders 104 and a pair of temples 108.

Id. ¶ 73. Temples 108 include circuit board 112 within internal cavity 110. *Id.* Solar cell 114 and UV detector 116 are provided within cavity 110. *Id.* Circuitry 122 and display device 124 may be coupled to circuit board 112. *Id.*

Howell-596 discloses embodiments that include further details of module housings. In one embodiment, module housing 1700 houses UV detection system 1500, display device 1510, and power supply 1504, such as a solar cell. Ex. 1003 ¶ 194, Fig. 17A. Module housing 1700 may include vents or holes so that air can circulate through the housing, or, “[a]lternatively, the module housing 1700 does not include vents or holes, so as to be water-resistant or water-proof.” *Id.* Howell-596 states that module housing 1700 is “placed into an opening, cavity or container of an eyewear housing, such as a temple region of the eyewear housing.” *Id.* ¶ 195. In one embodiment, eyewear housing 1720 has an opening, cavity or container 1721 for receiving the module housing 1700, with module housing 1700 contained by the eyewear housing 1720. *Id.* ¶ 196, Fig. 17B.

2. Discussion

“Under 35 U.S.C. § 102 a claim is anticipated ‘if each and every limitation is found either expressly or inherently in a single prior art reference.’” *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010) (quoting *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998)). “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 1332 (Fed. Cir. 2010) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A reference inherently discloses an element of a claim “if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (citing *Cont’l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *Therasense*, 593 F.3d at 1332 (quoting *Cont’l Can*, 948 F.2d at 1269).

Petitioner asserts that Howell-596 discloses every limitation of claim 1, and points to specific portions of Howell-596 to support its assertions. Pet. 14–18. Petitioner relies on the testimony of Dr. Feland to support its assertions. *See id.* Patent Owner does not address any of Petitioner’s anticipation arguments.

For the preamble, “[e]yewear,” Petitioner contends that Howell-596 discloses eyewear. Pet. 14 (citing Ex. 1002 ¶ 59; Ex. 1003 ¶ 7). Assuming that the preamble limits the claim, an issue we need not reach at this point, and based on the current record, we are persuaded that Petitioner demonstrates, for purposes of this institution decision, that Howell-596 discloses “eyewear.”

Claim 1 further recites a “frame” and “a sealed moisture resistant module attached to the frame.” Ex. 1001, claim 1. Petitioner argues that Howell-596 discloses a frame, shown in Figure 1 reproduced above, and “water resistant or water-proof” module housing 1700 placed within, and therefore “attached to,” the eyewear frame. Pet. 14–15 (citing Ex. 1002 ¶¶ 60–61; Ex. 1003 ¶¶ 73, 194–195, 203–206, Fig. 1). Based on the current

record, we are persuaded that Petitioner demonstrates, for purposes of this institution decision, that Howell-596 discloses these limitations.

Claim 1 also recites “wherein the module comprises within the seal any two of: a switch, a detector, a processor, a power source, a drive circuit, a transmitter, a receiver, a transceiver, and a sensor.” Ex. 1001, claim 1. Petitioner contends that Howell-596 meets these limitations because it discloses a module that includes power source 1504 and UV detection system 1506, including UV detector 306, which meet the claim requirements of a “power source” and a “detector,” respectively. Pet. 15–17 (citing Ex. 1002 ¶¶ 62–66; Ex. 1003 ¶¶ 73–75, 78–82, 184, 194–195, 211–212, Fig. 17A). Based on the current record, we are persuaded that Petitioner demonstrates, for purposes of this institution decision, that Howell-596 discloses these limitations.

Finally, claim 1 recites “wherein the frame comprises a first temple and a second temple, and wherein the module is disposed within the first temple.” Ex. 1001, claim 1. Petitioner asserts that Howell-596 discloses a frame having first and second temples 108, as shown in Figure 1 reproduced above, and a module within the temple of the eyewear frame. Pet. 17 (citing Ex. 1002 ¶¶ 67–68; Ex. 1003 ¶¶ 195, 197, Fig. 1). Based on the current record, we are persuaded that Petitioner demonstrates, for purposes of this institution decision, that Howell-596 discloses these limitations.

3. Conclusion

Petitioner adequately establishes that Howell-596 discloses all of the limitations of claim 1, and therefore establishes a reasonable likelihood of proving that Howell-596 anticipates claim 1. We have also reviewed Petitioner’s arguments and evidence addressing claims 9, 10, 14, 15, and 18

subject to this challenge, which Patent Owner does not separately address. *See* Pet. 18–20; Prelim. Resp. 3–33. Based on our review of the current record, Petitioner also establishes a reasonable likelihood of proving that Howell-596 anticipates claims 9, 10, 14, 15, and 18.

F. Remaining Challenges

Petitioner asserts that all of the challenged claims would have been obvious based on various combinations of prior art. *See* Pet. 10, 20–79. Patent Owner does not address the merits of these challenges. *See* Prelim. Resp. 3–30.

Because Petitioner already demonstrates that at least one claim of the '483 patent meets the threshold for institution, we institute an *inter partes* review of all claims as challenged in the Petition, including these challenges. *See* 37 C.F.R. §§ 42.108(a), (c); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not address the merits of Petitioner's arguments for any claim for any ground. Those challenges, in our view, are best left for trial after full development of the record

CONCLUSION

For the foregoing reasons, we determine that Petitioner has shown a reasonable likelihood that it would prevail in proving the unpatentability of at least one of the challenged claims. We thus institute an *inter partes* review of all of the challenged claims on all grounds asserted in the Petition.

Any findings or conclusions in this Decision are made only for the purposes of institution and are not dispositive of any issue. We have not

made a final determination with respect to the patentability of any challenged claim. Our final determination will be based on the record as fully developed during trial, including any evidence or argument timely presented by the parties under our Rules.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the '483 patent is instituted on all of the challenged claims and all grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this Decision.

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