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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.

IPR2024-01030 (Patent 8,708,483 B2)
IPR2024-01069 (Patent 10,613,355 B2)
IPR2024-01070 (Patent 8,801,174 B2)
IPR2024-01071 (Patent 8,905,541 B2)
IPR2024-01072 (Patent 10,598,960 B2)

Record of Oral hearing
Held: October 6, 2025

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

IPR2024-01030 (Patent 8,708,483 B2)
IPR2024-01069 (Patent 10,613,355 B2)
IPR2024-01070 (Patent 8,801,174 B2)
IPR2024-01071 (Patent 8,905,541 B2)
IPR2024-01072 (Patent 10,598,960 B2)

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IPR2024-01030 (Patent 8,708,483 B2)
IPR2024-01069 (Patent 10,613,355 B2)
IPR2024-01070 (Patent 8,801,174 B2)
IPR2024-01071 (Patent 8,905,541 B2)
IPR2024-01072 (Patent 10,598,960 B2)

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The above-entitled matter came on for hearing on October 6, 2025, commencing at 9:30 a.m..

1 P R O C E E D I N G S
2 - - - - -
3 JUDGE MARSCHALL: This is a consolidated hearing involving
4 several proceedings between Petitioner Luxottica of America Inc. and Patent
5 Owner E-Vision Optics, LLC. This combined oral hearing covers IPR2024-
6 01030 involving patent number 8,708,483; IPR2024-01069 involving patent
7 number 10,613,355; IPR2024-01070 involving patent number 8,801,174;
8 IPR2024-01071 involving patent number 8,905,541; and IPR2024-01072
9 involving patent number 10,598,960.
10 I'm Judge Marschall. With me are Judges Hamann and O'Hanlon.
11 Let's start with the party's appearances, please. And who do we have for
12 Petitioner?
13 MR. EVERTON: Ben Everton on behalf of Petitioner Luxottica.
14 JUDGE MARSCHALL: And for Patent Owner?
15 MS. STONE: Mikaela Stone on behalf of E-Vision Optics.
16 JUDGE MARSCHALL: Thank you and welcome. The argument
17 will proceed as set forth in the Hearing Order and the emails that followed
18 where we clarified some of the timing issues. The parties are reminded that
19 this is a joint hearing and a joint transcript covering all of the proceedings
20 will be filed in each case, so there is no need to repeat arguments that may
21 be applicable to multiple proceedings to avoid any waiver issues.
22 During your presentation, please refer to exhibit or slide numbers

1 to aid us in following along and to make the transcript clear. Please do not
2 interrupt the other party's presentation. You may object only during your
3 argument time or following the rebuttal. We note that some objections to
4 demonstratives have been filed. The parties are free to argue those issues
5 during their allotted time. But we do not plan on ruling on those issues here
6 today from the bench.
7 Please be aware that we provided a public access line for the public
8 to watch this hearing. Each side was provided a total of 30 minutes of
9 argument time for the first two proceedings today. And we'll start with
10 those, obviously, and the first matter is IPR2024-01030 as set forth in the
11 email. We're going to take short breaks between each proceeding and also a
12 lunch break after the first two proceedings.
13 So Petitioner will go first in the -01030 case. And would you like
14 to reserve any time for rebuttal?
15 MR. EVERTON: Yes, Your Honor. I'll reserve 10 minutes.
16 JUDGE MARSCHALL: Okay. We're going to set the timer for
17 20 minutes. So obviously, when that time runs out, you're then running into
18 your rebuttal time. And if you're all set up, you can begin when you're
19 ready.
20 MR. EVERTON: Thank you, Your Honor. We'll go straight into
21 Petitioner slides. We'll go to Slide number 2. This IPR relates to the '483
22 Patent. Now, this is the patent that focuses on the frame of the eyewear and
23 having a sealed module in that frame, specifically in the temple. And I have

1 here just a summary showing the figure from the '483 Patent with the
2 module and the temples of the frame. And then also the prior art that we're
3 relying on here, as you can see, is very similar.
4 For most of the disputes in this IPR, it's not whether the element is
5 disclosed by the prior art but whether there is sufficient motivation to
6 include that element in the combination. So we'll go through each of these
7 prior art references in detail.
8 Moving to Slide number 3, here we have a quick summary of the
9 disputed features, there's just a handful of them. You can see that these are
10 trivial features. We have in the dependent claims, using a flex circuit to
11 connect two components or hermetically sealing the module, substantially
12 wear-resistant module. And then last in Claim 19 is the positioning of the
13 sealed module at least partially behind the ear.
14 Moving to Slide 4, this shows the two independent claims. Claim
15 1, there is no dispute. Patent Owner does not dispute that Claim 1 is
16 invalidated, at least on the Howell grounds. And then for the other
17 Independent Claim 19, the only dispute relates to the frame being -- or the
18 module being configured to be at least partially behind the ear in that
19 limitation.
20 Now, let's jump into the grounds. We move to Slide 6. First, we'll
21 start with Claim 3. Claims 3 and 21 require a flex circuit connecting the
22 components. Here, we have the combination of the Howell-596, Blum
23 reference and Spitzer. So in this combination, Howell-596 has the module

1 on the temple of the frame. And then Blum-741 has the electro-active lenses
2 for this combination.
3 And then Spitzer's brought in for the specific teachings of the flex
4 circuit. And the flex circuits were known to connect different components in
5 eyewear. So it was obvious to use a common flex circuit to connect the two
6 parts, this module from Howell with the lenses in Blum. Now, there's no
7 dispute that Spitzer discloses a flex circuit, multiple different embodiments
8 of flex circuit.
9 So we'll skip to Slide 9. So here's a quick summary of the
10 motivations that Petitioner has provided for including a flex circuit -- using a
11 flex circuit to connect the module to the lenses. And Spitzer itself provides
12 motivations, describes how the flex circuit can reduce the strain on the leads.
13 It also describes the shape and dimensions of the flex circuit having a flat
14 cross section.
15 And you can envision why a flex circuit would be useful,
16 particularly in that hinge area between the frame and the lenses. With its
17 dimensions and its flat shape, it could connect those components and be
18 useful and provide these benefits. We've also walked through the different
19 *KSR* motivations for using a flex circuit in this combination.
20 JUDGE MARSCHALL: Could you address Patent Owner's
21 argument that there's no need for a flex circuit in this application because
22 your primary references use a PCB and there's really no flexible nature to
23 the eyeglass frames at issue?

1 MR. EVERTON: Yes. So if we go to Slide 12 here, they do argue
2 that Howell-596 uses PCBs, printed circuit board. But as we can see that's
3 -- it's not limited to that. Howell and Spitzer described also using flexible
4 wires which are similar to a flex circuit. They don't say exclusively that you
5 have to use a PCB in either of those. PCB is just a common -- another
6 common way to do it, but equally as common is the flex circuit or flexible
7 wires to connect the components.
8 Now, going back to Slide 6. Another argument that Patent Owner
9 has made here is that it would be unnecessary and wasteful to use a flex
10 circuit because there would be no movable parts once you do this
11 combination of Howell and Blum. But Patent Owner is really focusing on
12 the specific embodiments, a sliding mechanism and other moving things in
13 the Spitzer reference. But Spitzer generally teaches the use of a flex circuit.
14 Patent Owner provides no evidence that this combination of Howell and
15 Blum would result in something that has no movable parts, something that's
16 fixed.
17 For example, Patent Owner does nothing to address Howell-596's
18 hinge 109 that connects the temples to the lens frame. There's just no real
19 evidence or support that the resulting combination here would be fixed
20 without any movement. So it's unclear why Patent Owner says that the
21 frame and the lens and the temples would be fixed, there's just no support for
22 that argument.
23 Now, moving to Slide 10. Not only has Patent Owner failed to

1 support this argument, but the Federal Circuit has established that using a
2 component, like a flex circuit, does not need to be the preferred or most
3 desirable option. It can just be an option that has motivations and reasons to
4 combine it with the references. And Patent Owner's arguments do not
5 undermine or rebut these established motivations that we provided. And on
6 top of that, Patent Owner's own expert admitted that flex circuits were
7 known and that they were a viable option in this context.
8 Moving to Slide 12, that's the one we already talked about with the
9 PCBs. Going on to Slide 13. Patent Owner also argues that including a flex
10 circuit would add more cost. Now, first of all, there's no support for this.
11 There's no evidence that a flex circuit would be more costly or more
12 expensive. But on top of that, we know from the Federal Circuit case law
13 that a slight increase in the cost is not relevant where there are explicit
14 motivations as we have here.
15 We now move to Slide 15. There is a lot of discussion in the
16 briefing about Spitzer's strap embodiment. So this is another flex circuit
17 embodiment that Spitzer discloses. And Patent Owner argues that, well, the
18 strap is too big, the strap has different things in it, it would not work to put
19 that into the combination. But this assumes bodily incorporation. They're
20 making these arguments about the strap and its dimensions and how that
21 would not work if you directly implemented it into the Howell reference.
22 But that's not what we're proposing.
23 If you go to Slide 16, there's some well-known case law from even

1 *KSR* that a person of skill is not an automaton. A person of skill would
2 know how to look at Spitzer and its disclosure of flex circuits and how to
3 implement a simple flex circuit in the combination of Howell and Blum.
4 Also, the test for obviousness is not bodily incorporation. We're not trying
5 to bodily incorporate a strap or any other configuration exactly as it is from
6 Spitzer but just this general concept and the use that was well-known of
7 using flex circuits.
8 Lastly here, Patent Owner also make some non-analogous art
9 arguments about these references, which is surprising. These references are
10 eyewear with electronic modules within the frame, very similar references.
11 But when Petitioner raised this in the briefing, Patent Owner seems to back
12 down and then say, well no, these actually aren't non-analogous art
13 arguments. We're just saying that there are different goals between the
14 references.
15 But there's no legal basis for that. Even the *Polygroup* case that
16 they cited is not about just different goals between the references, it's
17 actually a non-analogous art case.
18 Now, let's turn to the next ground here, this would be Ground 9.
19 So same claims, Claims 3 and 21, relating to the flex circuit. But now these
20 are the arguments under the Blum grounds. So for, for the Blum grounds,
21 Patent Owner argues that the references do not include, or at least that we
22 haven't identified, the sealed moisture resistant module that I have here in
23 Claim 1.

1 But we have, Petitioner has identified in the Hattori reference, for
2 example, the hollow part 30 there, and then there's electronic components
3 that fit inside the hollow part and are sealed inside the hollow part with this
4 waterproof ring. So specifically, in Slide 21, the petition pointed to this
5 green-colored module, that is the module, the sealed moisture-resistant
6 module. And you can see that it fits with -- inside that opening in the frame.
7 And then the frame is sealed together with the O-ring and you have a sealed
8 moisture-resistant module.
9 JUDGE MARSCHALL: Are you saying that it's the green module
10 30 that's sealed before it's inserted or after it's inserted?
11 MR. EVERTON: If it's --
12 JUDGE MARSCHALL: I'm sorry, it's not number 30, that
13 reference number is 20.
14 MR. EVERTON: Number 20.
15 JUDGE MARSCHALL: Are you saying that it is sealed prior to
16 insertion?
17 MR. EVERTON: It can be in some of the embodiments that I'll
18 get to where it has actually a protective layer over it. But as shown here, at
19 least one way that it's sealed, it is placed inside that opening and then the
20 frame is sealed with the O-ring. So in one way, it is sealed within the frame.
21 In another way, that I'll get to next, it's sealed itself using a protective film.
22 So now, the arguments the Patent Owner argues actually conflict
23 with their infringement contentions. They say that it's not enough for it to be

1 sealed by an O-ring within the frame. But in their infringement contentions,
2 they argued the exact opposite. They argued that, as you can see here in this
3 figure on Slide 22, that various modules sealed within the frame, as shown in
4 the images below, that those qualify as a sealed moisture-resistant module.
5 It's the same situation where you have the frame sealed around a module
6 inside the frame.
7 JUDGE MARSCHALL: And those weren't adopted by any Court,
8 right? These are just proposed infringement contentions and there's no claim
9 construction briefing, there's nothing that we can sink our teeth into as far as
10 an order from another tribunal on this issue, correct?
11 MR. EVERTON: That's correct. And we're just trying to point out
12 that there's two inconsistent arguments that they're making here. On one
13 end, they're trying to argue that this infringes, on the other, they're saying,
14 well, in the prior art it would not invalidate and they can't do that.
15 We'll now go to Slide 24. Even if Patent Owner's argument was
16 somehow persuasive, as I mentioned, Hattori's module is also sealed and
17 moisture resistant because it is coated with a protective film 41. Now, the
18 experts agree that this type of a film would make the module sealed and
19 moisture resistant. We have the testimony here from both experts that the
20 coated with protective film 41 forms a sealed moisture resistant module.
21 Now, going to Slide 25. For this combination of Blum and Hattori,
22 Petitioner did provide several motivations for sealing and using a sealed
23 module. It would protect from moisture, dirt, and chemicals but also allow

1 for easily removable and swappable for maintenance, cleaning, and so forth
2 as you can see on this slide.
3 Now, again, finally moving to Slide 26. Patent Owner made more
4 non-analogous art arguments. But again, they are improper. They are
5 comparing whether the references themselves are analogous to one another.
6 We know that under the Federal Circuit case law that this is not the analysis.
7 You're supposed to compare the references to the patent. So their non-
8 analogous arguments again fail in this ground.
9 Okay. Now, I'd like to move on to Grounds 2 and 8. These are
10 Claims 13 and 16 I have here on Slide 28. These claims deal with -- first,
11 Claim 13 requires that the module is hermetically sealed. And then 16, the
12 module is substantially wear resistant. First of all, in Slide 29, the '483
13 Patent equates the hermetically sealing with waterproofing. And it doesn't
14 differentiate or say how or why hermetically sealing would be different from
15 the waterproof embodiments.
16 If we go to Slide 30, Dr. Feland explained that a person of skill
17 would have known to hermetically seal the module, would have known how
18 to do that, and would have been motivated to do that to keep it clean, dust
19 free, et cetera.
20 JUDGE O'HANLON: Counselor?
21 MR. EVERTON: Yeah.
22 JUDGE O'HANLON: Is it your position that hermetically sealed
23 means just moisture resistant or does it mean airtight as well?

1 MR. EVERTON: It's our position that it's at least moisture
2 resistant. And that's all the patent said. The patent does not say that it is
3 airtight. But the patent does suggest that in some embodiments, there are no
4 windows or other things that would allow passage of air. But it's the
5 waterproofing, and I'll get into that a little bit more later. But the
6 hermetically sealed is equivalent at least in the specification to the
7 waterproof.
8 JUDGE MARSCHALL: I'll just put a finer point on that. As a
9 matter of claim construction, hermetically sealed in Petitioner's view does
10 not require impervious to air?
11 MR. EVERTON: No. It does not require being impervious to air;
12 that is correct.
13 So now, going to Slide 31. And this is -- and important to note
14 here that Patent Owner argues that it would not have been obvious to make
15 the sealed module hermetically sealed. And it says that there -- that
16 hermetically sealing requires this higher degree of protection that's not
17 included in the specification at all. In fact, in view of the '483 disclosure,
18 hermetically sealing is really not inventive or beyond the skill of a person of
19 ordinary skill in the art.
20 If you look at the '483 Patent, there's no detailed instruction on
21 how to hermetically seal the module. There's no -- it doesn't purport to solve
22 any problems related to hermetically sealing. Really, it just confirms that
23 such sealing techniques were already within the knowledge of a person of

1 ordinary skill.
2 And under the case law that I have listed here on Slide 31, we
3 know that Patent Owner cannot demand this highly specific disclosure in the
4 prior art about hermetically sealing and how to do so when the '483 Patent
5 itself does not provide any of that detail or suggests that it is important in
6 any way or needs to be done in a certain way. Patent Owner can't demand
7 more of the prior art than is provided in the '483 Patent.
8 Going to Slide 32, I provided the examples of where hermetically
9 sealed is used in the '483 Patent. It just says that the module can be
10 hermetically sealed without any other detail. In fact, here on the left-hand
11 side, column 6, 47 through 53, just says that an electronic frame component
12 that is hermetically sealed to prevent water from contacting the electronics.
13 It doesn't say anything about air, being airtight.
14 JUDGE MARSCHALL: Is it your opinion or Petitioner's opinion
15 that hermetically sealed generally in the art means merely water resistant and
16 not airtight?
17 MR. EVERTON: Yes. I mean, there's no construction proposed
18 by either side on hermetically sealed.
19 JUDGE MARSCHALL: But it seems like that's a critical issue
20 that's now before us, even though there's no separate claim construction
21 argument. But just as a layperson, hermetically sealed usually means
22 airtight. So I'm wondering if you are setting forth some different definition
23 based on the usage in the specification that it only means resistant to water

1 or what you're relying on there?
2 MR. EVERTON: Yeah. Just that the experts in the context of the
3 specification and in that context hermetically sealing just is equated to
4 waterproof and nothing beyond that, doesn't require airtight.
5 Now, if we move to Slide 33, I'll just touch quickly on this
6 limitation where it needs -- the module needs to be substantially wear
7 resistant here. We've shown in the prior art and Dr. Feland explained that
8 Howell-596 discloses this module, and it explicitly says that the module
9 housing 1700 protects the module and that is at least substantially wear
10 resistant.
11 And just as I explained with the previous limitation, the '483 Patent
12 does not describe or go into any detail on what wear resistant means or why
13 it would be special and not just something in the knowledge of a person of
14 ordinary skill. It just says that it could be wear resistant or moisture
15 resistant, that's the only use of wear resistant in the specification.
16 I'd like to move now to Claim 19. So Claim 19 is the only
17 independent claim that they argue is, at least for the Howell grounds -- that
18 argues over the Howell grounds. And here, they focus specifically on this
19 last limitation. The portion -- the module is disposed at least partially on a
20 portion of the frame configured to be behind the ear.
21 Going to Slide 37. The combination here is Howell-596. You
22 have the module on the temple of the frame. And then Howell-833
23 specifically discloses placing that module with the electronics in a position

1 behind the ear.

2 Slide 38. Actually, Howell-596 itself discloses placing electronics
3 behind the ear. This is the primary reference. So it's undisputed that this
4 UV sensor 2104 is positioned behind the ear. This is disclosure from
5 Howell-596. So there isn't much need for a motivation or for any other
6 disclosure of positioning the electronics behind the ear. It's already in the
7 primary reference.

8 But we did bring in the other Howell reference, 833, which clearly
9 discloses behind the ear. Now, Patent Owner argues against Howell's
10 explicit teachings and argues that, oh, if there's longer hair or if there's
11 apparel that could block the UV sensor. But this doesn't change the
12 disclosure of Howell itself that these electronics in the module can be placed
13 behind the ear. The UV sensor can be placed back there.

14 Howell-833 specifically teaches placing a UV detector behind the
15 ear. If you look at Figure 1 here, item 112, that is the module with the
16 electronics that is placed behind the ear. There's no dispute. And then
17 electronic components 112, if we look at Figure 4, we know that those
18 include, among other things, many different thing -- electric components can
19 be there. But you can see that there's a UV sensor radiation detector.

20 And even looking at the '483 Patent itself in the background
21 section, it mentions that, you know, in the prior art in the background there
22 are these different positions where electronics can be positioned. And it lists
23 there in the background that it could be the endpiece of the temple. So this

1 just reinforces that there are only so many options of where to put this
2 electronics module. And even the '483 Patent admits that one of those
3 known positions is at the endpiece of the temple, which would be behind the
4 ear. So this would be at least obvious to try to put it in that location.
5 So if there are no further questions, I'll reserve the remainder of my
6 time.
7 JUDGE MARSCHALL: Okay. You've got eight minutes left.
8 Counsel for Patent Owner, would you like to reserve any time for rebuttal?
9 MS. STONE: I'd like to reserve six minutes, please.
10 JUDGE MARSCHALL: You may begin when ready.
11 MS. STONE: Thank you. Good morning, Your Honors. Now, on
12 Slide 2, I have a summary of the issues which mostly aligns with the list of
13 issues that Petitioner provided. I just wanted to flag that we do have also
14 called out sealed moisture-resistant modules separately, although, this was
15 addressed by Petitioner. There's several that I want to focus on in order to
16 respond to Petitioner's arguments.
17 First is Spitzer's flex circuit. This is relevant to Grounds 5 and 9
18 which challenge Dependent Claims 3 and 21. One thing I wanted to note
19 very quickly is that all of the grounds within the petition are nested within
20 each other. So for example, a claim disputed under Ground 5 is building
21 upon Ground 4, which builds upon Ground 3, which builds upon Ground 2.
22 So while we did flag this in objections filed with the Board, the
23 Petitioner listed a certain list of disputed claims. We do want to flag that

1 because some of the disputes relate to a ground that is applied to multiple
2 claims or an independent claim, that those additional claims, the dependent
3 claims are in fact disputed as well.
4 Now, here's Claim 3, the relevant limitation we're focused on for
5 the flex circuit is this last one, where the module is electrically connected to
6 the external device by a flex circuit. This is on Slide 5.
7 If we switch over to Slide 6, there's just a couple of embodiments
8 of Spitzer that I want to address directly. So on Slide 6 is Figure 11 of
9 Spitzer. Spitzer is directed to an eyeglass interface system. This is a really
10 complex system that involves, for example, a display device, multiple
11 audiovisual components, power supplies. And it can be mounted on the
12 eyewear as well as, for example, attached on a strap to be slipped into the
13 wearer's pocket.
14 In Figure 11, it illustrates a bone conductivity transducer A10,
15 which is a type of speaker, and it works through vibrations in the temple. So
16 it's very important that the transducer be located in the correct position on
17 the eyewear. Because of this, Spitzer discloses a sliding base 520 and says
18 that many of the components that it discloses including an image sensor or
19 the transducer can be mounted on this sliding base 520.
20 The user grabs the handle and is able to move it into position. So
21 you can understand why a flex circuit would be necessary in Spitzer, where,
22 for example, you might have bunching of a wire or stretching of it as it is
23 moved into place.

1 In Figure 11 on Slide 8, you can see lead 820 extending out the
2 back of the eyewear. Spitzer discloses that this might be flexible wire,
3 flexible coaxial cable, or flexible circuitry.
4 On Slide 9, you see Figure 20 of Spitzer, which is also relied upon
5 by Petitioner. You heard them explain that the flexible connection is
6 disclosed within a strap that's connecting both sides of the eyewear. This is
7 so that, for example, other accessories might be attached to it. It even
8 explains that you could detach one side and place the module into your
9 pocket.
10 Again, it's understandable why a flexible connection, either wire,
11 coaxial cable, or circuitry might be necessary for this. Both embodiments
12 rely on adjustable or have adjustable or movable components that make the
13 flex circuitry useful.
14 On Slide 10 are pictures of Ground 5's base combination, which is
15 Howell-596's frames and the UV detection system located on its temple,
16 combined with Blum-741's electroactive lenses. These do not have movable
17 components. That's not disputed. Petitioner has not identified adjustable
18 components.
19 For the first time today, Petitioner argued that, well, it might be
20 useful in the hinge. That's not contained in the petition or the reply brief.
21 As the papers discuss, Howell-596 already relies on connections on an
22 existing printed circuit board. When the Petitioner advocated for
23 implementing the flex circuit within this base combination, it does not detail

1 how the flex circuit would be implemented.

2 The petition stops it merely saying it would have been obvious to
3 connect these two components with a flex circuit. It doesn't say how it's
4 implemented. It doesn't say if it's integrated into the frames. It doesn't say if
5 it's connected via a strap. Today was the first time that they said, well, it
6 could be implemented across a hinge. There's no details again on the on this
7 in the petition.

8 Furthermore, Spitzer also discloses using flexible wire. This is
9 also bendable, it's unclear why that kind of wire might not also be acceptable
10 for something like a hinge. The flex circuit specifically was used in Spitzer
11 not only for flexibility but also because of this -- how I've described that it
12 might bunch in the frame if it's extending out the back and being attached to
13 something going to a pocket, if it's on a sliding mechanism that's being
14 moved within the frame. A flex circuit is itself a little more contained and
15 protected. But again, there's no adjustable components within their base
16 combination of Howell-596 and Blum-741.

17 They've listed five motivations to combine. This aligns with the
18 ones that they listed up on their slides as well. I've just addressed the first
19 one. They argue on slide -- I'm on Slide 12. They argue that a PHOSITA
20 would have implemented Spitzer's teachings to allow or to reduce lead strain
21 for adjustable components. As we've just discussed, there aren't adjustable
22 components, and Petitioner identifies none in the briefing.

23 They also argue that the flex circuit would have been lower profile

1 because it has a flat cross section. First, Spitzer teaches a variety of flexible
2 connections, not all of them having low profile flat cross sections. Second
3 of all, it's unclear to me how a flex circuit would be lower profile than, for
4 example, a wire on an existing PCB. It would not have motivated a
5 PHOSITA. Third, fourth, and fifth, all rely on general restatements of *KSR*
6 rationales, while the petition provides no details or analysis under those
7 rationales.
8 First, they say flex circuits were well-known, therefore there was a
9 reasonable expectation of success. But just because something was known
10 does not mean that there was a reason a PHOSITA would have implemented
11 it in the way that they're describing in the prior art. They haven't provided
12 that. The last two kind of go together, they say it's a known technique ready
13 to improve a similar device. But as we've established, this is not a similar
14 device. And it would not have been -- it would not have yielded predictable
15 results or been improved in the same way as Spitzer because it does not have
16 the movable components.
17 I wanted to flag something very quickly with Ground 9. It relies
18 on a different base combination of Blum-741's frames while incorporating
19 some portion of Hattori-912. We'll get a little bit more into that in detail
20 with the sealed moisture resistant module. But in building this combination,
21 the petition provides no ground-specific motivation to combine. Rather,
22 there is one paragraph at page 78 of the petition that merely cross references
23 its analysis under Ground 5.

1 But Ground 5 has a different base combination, it's based on
2 Howell-596. This borrowing of this -- of the rationales is not only
3 insufficient to meet their burden to show a motivation to combine. But it
4 also really highlights the generic nature of these rationales and that it wasn't
5 specific to the prior art. Regardless, we've discussed these motivation to
6 combines, and there were none.
7 There's a few more points Petitioner raised during its presentation
8 that I want to address. First, they argue again that a combination does not
9 need to be the most desirable combination. This was addressed in the sur-
10 reply at page 5 citing *Virtek Vision*, which explains that the existence of an
11 alternative arrangement alone is not enough, there still must be a showing of
12 a motivation to combine. They still must articulate a reason to substitute one
13 arrangement for another and the benefits that would flow from them.
14 They also touched on no bodily incorporation. I don't think that's
15 disputed. However, the only reason Petitioner would make such an
16 argument is if it's saying that they want to implement Spitzer's flex circuit in
17 a way that's slightly different from how it's implemented in Spitzer. But as I
18 said, they haven't done that here. In the petition, they provide no detailed
19 explanation of how a flex circuit will be implemented within the proposed
20 combination.
21 At the sur-reply on page 10, it cites *Lowe's Home Centers*, which
22 explains that it is Petitioner's burden to specifically explain how the
23 references would be combined to produce the claimed invention. Finally, I

1 think the parties are talking past each other as to the non-analogous
2 argument. So Petitioner takes issue with the fact that the Patent Owner has
3 compared the references to each other as opposed to the patent itself.
4 Well, one thing I want to note is that on Slide 26 of the
5 presentation, which they didn't use today. But in case it's considered by the
6 Board, it cites a quote from *Sanofi-Aventis*. This quote doesn't exist. That
7 was flagged in the sur-reply brief at page 8 because this same quote was
8 cited in their reply brief at page 7. Patent Owner could not locate this quote
9 in the case, or in any other case for that matter.
10 But regardless, Petitioner still focused on the wrong issue. Even if
11 it's not required that prior art references be analogous to each other,
12 discussion of what technology they relate to, what their goals were, that's all
13 still relevant to whether a PHOSITA would have looked to combine their
14 teachings and would have been motivated to combine their teachings.
15 Finally, they also raised an argument based on expense. They say
16 the law doesn't exclude complex or expensive solutions, but that's based on
17 an assumption that's not applicable here. First of all, it has to be a solution.
18 Whether or not it's expensive, it has to be resolving or there has to be a
19 reason that it's there. And as we've discussed, there was no reason to include
20 the flex circuitry in the proposed combinations.
21 Let's move on to sealed moisture-resistant module. This is in
22 Grounds 8 and 9, which is applied to both the independent claims and is
23 therefore relevant to all of the disputed claims. Here, we see an Independent

1 Claim 1, the relevant limitation, which Petitioner talked about.
2 So I'm going to jump through to Slide 21. Both Grounds 8 and 9
3 rely on a combination of Blum-741's electroactive lenses as modified by
4 Hattori-912. The problem that was discussed mostly in the briefing is how
5 is Blum modified? What is the sealed moisture-resistant module? I want to
6 point out some consistencies. Slide 22 shows Figure 4, this is taken straight
7 from the petition, so the coloring and annotations are Petitioner's alone.
8 At page 55 of the petition, they identify this integrated circuit as
9 green and label it as a module. My understanding is that their argument is
10 that it's sealed by virtue of being contained within the frames within a
11 waterproof ring. But under this read, the module isn't sealed or moisture
12 resistant. The frame is sealed. I believe Petitioner used the words "the
13 frame is sealed" in his presentation today.
14 Page 56 of the petition, Petitioner changes this read slightly. It
15 argues that a PHOSITA would have placed Blum's components into a recess
16 sealed by a waterproof ring. That sounds to me like we're getting rid of the
17 integrated circuit and switching over to Blum's components. So now, it
18 sounds like the sealed moisture resistant module might be some combination
19 of those components plus a portion of the frame, or it's unclear to me if
20 they're making the same argument that's focused on Blum's components.
21 This failures to articulate exactly what the sealed moisture resistant
22 module is -- also pervades their motivation to combine. So Petitioner is very
23 nonspecific as to whether Blum's components or Hattori's components are

1 being implemented alone, or together, and exactly how that's being done.
2 The details and the boundaries matter in this case. Because Claim 1, which
3 is the independent for several of the disputed claims, requires also that at the
4 certain components in a list be included within the seal and also that the
5 sealed module is attached to the frame. So again, the boundaries of what
6 Petitioner is claiming is the sealed module matter.
7 Petitioner points to the infringement contentions from the district
8 court, essentially trying to justify their high levelness here by saying, well,
9 you were high level at the district court. It's important to note that these
10 were preliminary infringement contentions based on publicly available
11 information. These were served in an early part of discovery without details
12 on electronics. It's often very difficult for Patent Owners to provide details
13 as to the accused product.
14 For example, whether or not components within eyewear
15 -- whether or not and how they might have been treated during the
16 manufacturing process. But to use these high-level statements in an
17 infringement contention to that -- they should not be used to redefine the
18 degree to which Petitioner has to make its grounds here to invalidate a
19 patent.
20 JUDGE HAMANN: Counsel, I'm just trying to follow that. It
21 seems to me that Petitioner was trying to argue really how Patent Owner
22 viewed the correct reading of the claim language rather than how much
23 specificity was needed in the petition. And so it seems like your focus at

1 least seems misaligned with at least my understanding of what Petitioner
2 was arguing.
3 MS. STONE: I think it's important to dive into the infringement
4 contentions and review the statements made there. So it is true that the
5 infringement contentions do highlight, you know, publicly available
6 documents saying that this eyewear was waterproof, it was moisture
7 -- something along those lines, that it was waterproof.
8 But the important thing to understand is at the preliminary
9 infringement contention stage, it may have been impossible for Patent
10 Owner to provide more details into the inner workings of the electronics and
11 the manufacturing process as to how things might have been sealed. So I
12 think it's reasonable for a Patent Owner at the district court, in an early stage
13 of the proceeding, to believe that there may be an infringement claim there
14 based on the fact that this is waterproofed eyewear. What if they treated that
15 module in a certain way such that it is sealed?
16 I don't think the infringement contentions are inconsistent with
17 Patent Owner's positions here. The statements are very broad and very
18 generalized, as they usually are in preliminary infringement contentions.
19 The accused eyewear did not have, for example, a waterproof ring that I'm
20 aware of. And this wasn't called out in the infringement contentions.
21 So the infringement contentions did not come out right out and,
22 you know, make the exact same argument here, so there is no inconsistency.
23 It's more so that - to me, it seems like Petitioner is justifying its high level of

1 detail by pointing at the high level of detail in the infringement contentions.
2 JUDGE HAMMAN: Well, I'm not sure I agree with that, Counsel.
3 But I'm just trying to understand, again, whether the meaning that Patent
4 Owner may have provided a certain terms in the past. And looking at least
5 Slide 22 of Petitioner's deck, which is the portion of the infringement
6 contentions, it talks about various modules sealed within the frame.
7 MS. STONE: Mm-hm.
8 JUDGE HAMANN: I think that might at least suggest that Patent
9 Owner, at least at one point, had taken the position that would -- the frame in
10 a sense could be, you know, part of the sealing, the components within, for
11 example, which doesn't seem to be a specificity level to me. Again, it seems
12 to be potentially arguably a position that Patent Owner took as to the scope
13 of the claims, at one point.
14 MS. STONE: But I do think it's unfair to hold Patent Owner to
15 those statements made in preliminary infringement contentions when it
16 necessarily didn't have -- you know, when we're analyzing this prior art that
17 Petitioner is relying on, we have exactly how much level of detail there is.
18 We have the specification of this prior art. There is no more detail to be had,
19 and we debate whether or not these meet the limitations.
20 However, in preliminary infringement contentions, the Patent
21 Owner was discussing a product based on publicly available information and
22 on a tear down, but did not have, you know, inside specifications or the level
23 of detail that might have been necessary to identify exactly how the

1 components when -- for example, the components with an eyewear were
2 treated during a manufacturing process.
3 JUDGE HAMANN: So is Patent Owner suggesting that, how
4 claims should be construed depends on how products are configured?
5 MS. STONE: I don't think that's the case at all. I just don't think
6 that Patent Owner should be held to high-level statements that were not
7 meant to narrow the claims or -- you know, there was only a certain level of
8 detail that the Patent Owner could provide at that stage. And so it was
9 limited in how much it could say as far as what it was pointing to because it
10 was such an early stage of discovery.
11 It's also important to note that that case has been stayed since the
12 early stage of discovery. It has stayed pending the outcome of these IPRs.
13 So there has been no determination made on those statements.
14 JUDGE HAMANN: Thank you.
15 MS. STONE: Given all of that, I really want to -- actually, looking
16 at the time, I want to jump very quickly to make sure that I have time to
17 touch on the hermetic seal that was discussed. I am going to jump to Slide
18 26, although I'm not even sure I need the slides. This shows Claim 13. The
19 Petitioner addressed hermetic seal. Specifically, Petitioner today was asked,
20 does that mean it's not impervious to air?
21 And they confirmed that hermetically sealed -- or sorry, they said
22 that hermetic seal does not require that it be airtight. I think the exact words
23 during the hearing were whether or not it was impervious to air. This

1 contradicts the petition. I'm sorry, I'm going to grab my binder.
2 Today, Petitioner said repeatedly that it did not need to be airtight.
3 This is a direct quote from their petition at page 28, "Something that is
4 hermetically sealed is sealed so as to be airtight." They cite Exhibit 1010 at
5 page 269, and it defines a hermetic seal as airtight. They cite their expert
6 declaration at paragraph 103, which explains that a hermetic seal is airtight.
7 JUDGE MARSCHALL: Is it Patent Owner's position that we
8 should construe hermetically sealed or that we must construe it before
9 addressing the prior art?
10 MS. STONE: Based on the briefing alone, the parties seemed to
11 be in agreement that hermetically sealed meant airtight. I believe it has
12 crystallized during this hearing that Petitioner now disputes what it argued
13 was hermetically sealed. I think Petitioner should be locked into its original
14 arguments, which would mean a construction is not necessary because based
15 on the papers, the parties agreed as to the definition of hermetically sealed.
16 JUDGE MARSCHALL: If we adopted that construction in our
17 final decision, would Patent Owner think we needed any additional briefing
18 to address claim construction of hermetically sealed after this hearing?
19 MS. STONE: No. The sur-reply addresses -- in the reply, the
20 Petitioner raises for the first time some of the disclosures in the '483 Patent
21 that allegedly support that waterproof might be the same as airtight. So this
22 is addressed in the sur-reply briefing. We address those disclosures and Dr.
23 Oliver explains why those are not -- why airtight does not necessarily mean

1 the same as waterproof -- or sorry, it's the other way, Dr. Oliver explained
2 that waterproof does not necessarily mean airtight.
3 I'm trying to decide where to focus my last minute. I'm going to
4 jump to the discussion of within the last issue, so whether or not the UV
5 detection system of Howell-596 would have been located behind the ear on
6 the eyewear. I'm going to jump to Slide 38 of Patent Owner's deck. There
7 are two figures that Petitioner raises in the reply brief for the very first time
8 within this context. Figure 21 discloses window 2104 at the back of the
9 eyewear that corresponds to a UV sensor.
10 What Petitioner has critically missed is this sensor is not part of the
11 UV detection system. It is connected to the UV detection system. And they
12 have identified the UV detection system as the alleged electronics module.
13 But even more important, this figure illustrates the inner side of a temple. It
14 is meant for that UV sensor to be blocked from UV light. And that's because
15 Howell discloses at paragraph 205 that it's effectively working as a being
16 worn sensor.
17 So when the user puts on the eyeglasses, that sensor underneath
18 window 2104 will be blocked from UV light and will notify the UV
19 detection system that the glasses are now being worn. This really just
20 supports Patent Owner's and Dr. Oliver's interpretation, which is that it
21 understood that placing electronics back there would block them from light,
22 just as the UV detection system would be blocked from functioning and
23 receiving light if located back there.

1 JUDGE MARSCHALL: Doesn't it arguably cut against your
2 argument that there'd be no motivation to have a UV sensor behind the ear or
3 covered by hair? Because it may be just detecting the presence of an ear or
4 hair and saying, hey, this is on a person's body.
5 MS. STONE: I think a UV sensor alone is a different question
6 from the question we have in this proceeding. They've identified this UV
7 radiation monitoring system as the alleged module. So the question is,
8 would a PHOSITA have placed that UV detection system back behind the
9 ear? But the UV sensor within that detection system, the entire goal of it is
10 to monitor radiation.
11 And for example, there's even a display device on the circuit board
12 that has, for example, an LED color that would indicate the radiation level.
13 So by moving that UV detection system back, you're frustrating the entire
14 purpose of Howell-596's invention.
15 I'm going to reserve my remaining time for rebuttal.
16 JUDGE MARSCHALL: Okay. Thank you. You have five
17 minutes left.
18 MR. EVERTON: Okay. Your Honor, I just first wanted to touch
19 on -- if we go to Slide 6, Petitioner slides, this movable components
20 argument. I just wanted to emphasize that the movable components
21 argument was Patent Owner's argument in response to the motivations that
22 are explicit in Spitzer.
23 Now, we are very clear in the petition that the combination is

1 taking the flex circuit -- a flex circuit, like the ones described in Spitzer, and
2 connecting the module which is in the temple on the side frame with the
3 electroactive lenses of Blum, which are the lenses. So clearly, the proposed
4 combination was always to use a flex circuit to connect the side -- the
5 module and the side with the lenses which would go through the hinge 109.
6 That has been the combination since the petition.
7 And now, it's Patent Owner's argument that, oh, there would be no
8 movable components. But that is unsupported and just doesn't make sense
9 in view of the combination set forth in the petition, where you do have
10 movable components.
11 Also, going to Slide 21, there was argument about whether or not
12 this module -- whether or not Petitioner is arguing that the module is sealed
13 in the frame or if the frame is sealed.
14 JUDGE MARSCHALL: Before we move on to that --
15 MR. EVERTON: Yeah.
16 JUDGE MARSCHALL: -- if you could address Patent Owner's
17 argument that you improperly incorporate by reference a motivation to
18 combine argument from a previous ground into Ground 9 --
19 MR. EVERTON: Right.
20 JUDGE MARSCHALL: -- when it comes to the flex hinge.
21 MR. EVERTON: And because of the motivations are -- they are
22 similar, right? Because we're still relying on Spitzer. It's in the same
23 ground. Both grounds include Spitzer and Spitzer itself provides

1 motivations for using a flex circuit. So yes, the motivations are very similar
2 between the two grounds. Really, the only difference is what eyewear are
3 you starting with.
4 And they're similar, right? They both have the modules, the
5 lenses, the frames. But it's really the motivation to bring in the flex circuit,
6 which is Spitzer's motivations that we provide. And so that's why there's
7 that similarity. It's not that we're just wholesale adopting, it's that there are
8 similar motivations explicit in the prior art.
9 Now, going to Slide 21. Our argument is that the module is sealed
10 within the frame, right? The claims don't say what has to do with the
11 sealing. The module, the green module, when placed within this opening in
12 the frame and then the O-ring seals that that module is sealed. They're
13 trying to make some argument that, oh, well, it's the frame that's sealed.
14 Well, the claims don't say whether or not -- what does the sealing. And at
15 least in this way, the module is sealed within the frame, so it is sealed itself.
16 And then on top of that, as I explained, it's also sealed because of the
17 protective layer.
18 Now, I'd like to turn to Slide 28 and address the hermetically
19 sealed. So there was argument, again, about this hermetically sealed and
20 what we said in our petition. But I think it's important to actually go back to
21 the petition. Patent Owner is taking this airtight statement out of context.
22 So if we go back to page 28 of the petition. At the bottom, if you
23 read the context in the paragraph, it's clear that what we're saying in the

1 petition is the airtight is being equated to the waterproof. It says, as
2 discussed above, Howell-596 discloses that the module may be waterproof.
3 For the same reasons, a POSITA would have understood Howell-596 to
4 disclose that the module is hermetically sealed. So waterproof and
5 hermetically sealed for the same reasons. Something that is hermetically
6 sealed is sealed so as to be airtight.
7 Howell-596 contrasts its waterproof arrangement without vents or
8 holes with one that includes one or more vents or holes so that the air can
9 circulate through the module housing 1700. So then we say, a POSITA
10 would have understood that in Howell-596's configuration that does not
11 include vents or holes, air could not circulate through the module, and thus,
12 it would be airtight.
13 So there, we're not saying that there's a construction or the
14 hermetically sealed needs to be airtight. We're just saying that the examples
15 provided in the specification of waterproof would also be airtight. They
16 don't have the vents. They don't have the windows that would allow the air
17 to go through. So it's the same thing whether you have the waterproof
18 embodiments or airtight, those mean the same thing.
19 There's nothing in the specification that says hermetically sealed
20 must be airtight or that has a different definition. So we don't think that it
21 needs to be construed. And a person of ordinary skill would understand its
22 meaning in view of the specification.
23 JUDGE MARSCHALL: If we think that it does need to be

1 construed as part of our final decision, would Petitioner like the chance to
2 provide additional briefing on that issue or is it Petitioner's position, similar
3 to Patent Owner, that we have enough briefing on what hermetically sealed
4 means and we can just decide that claim construction issue in the final
5 decision without further --
6 MR. EVERTON: Oh, yeah. We think if the Board is going to
7 construe any claims without proposals by the parties, then yes, we would
8 want briefing on that and be able to address it.
9 Now, lastly, if we go to Slide 38, I just want to quickly address the
10 behind the ear limitation. So as we were just hearing, Howell has different
11 purposes, right, for this UV sensor. And one can be whether, you know, it
12 detects light or not, so it can tell whether the glasses are being worn or not.
13 And as Your Honor pointed out, that is a purpose and a motivation for using
14 it behind the ear. And that's what the Howell does, it does not suggest that
15 any teaching away or that a person of skill would not place the sensor behind
16 the ear. In fact, it confirms that they would. And that's the reason why it
17 was provided behind the ear in the 596.
18 The claims don't say why, right? They don't say what the
19 components need to do behind the ear. They just say that there are
20 components behind the ear and that's what we've seen in 596 and also
21 confirmed in Howell-833.
22 JUDGE MARSCHALL: Can you respond to Patent Owner's
23 argument that in this context with UV radiation detector, you wouldn't want

1 to place it behind the ear because you wouldn't be able to detect radiation if
2 it's covered by hair or the ear.
3 MR. EVERTON: Yeah. I just don't think there's any support for
4 that. I think there's support for people having hair and that the sensor might
5 be covered. But there's just no support or evidence that such a sensor would
6 not work. And where you have both references, both 596 and the 833,
7 suggesting that it could be behind the ear. There's just no reason to think
8 that those electronics, those sensors would not be placed behind the ear by a
9 person of ordinary skill in the art. I see my time is up, so I'll rest, unless
10 there's any questions.
11 JUDGE MARSCHALL: No further questions. Thank you.
12 MS. STONE: I'll just respond quickly to each of those arguments
13 in turn. First, addressing movable components within the context of the
14 Grounds 5 and 9, Howell-596 and Blum, in the briefing, Petitioner does not
15 identify any movable components or any adjustable components. Today, for
16 the very first time was the first time they mentioned the hinges, this is new.
17 Furthermore, I'm not sure that that's right that that would
18 necessarily mean a flex circuit. A PHOSITA would have been motivated to
19 implement a flex circuit. There are other flexible connections that are
20 disclosed within Spitzer that are not a flexible circuit, flexible wires, flexible
21 coaxial cable. They have provided no specific motivation to combine to
22 incorporate a flex circuit into the hinge.
23 Furthermore, they have -- the most that the petition says is that a

1 flex circuit would be used to couple, for example, the UV radiation
2 monitoring system to the multifocal lenses. There is no explanation of how
3 the flex circuit is implemented. The arguments today that the flex circuit
4 would have been implemented through a hinge are new and have not been
5 briefed.
6 Furthermore, if you look at the figures in Blum-741, the electro-
7 active lenses appear to extend all the way to the temple frames. It's unclear,
8 based on the briefing and based on the figures looked at today, that a flex
9 circuit would even necessarily need to bend. Again, a flexible wire might
10 have been enough to duly accomplish that. Jumping to -- we focused on the
11 sealed moisture resistant module as the module itself.
12 Another thing that's really important is, you know, they now try to
13 say, well, we didn't mean that hermetically sealed actually meant airtight.
14 They're correct in that their briefing does mention waterproof, but they
15 equate waterproofing with airtight. They still say that hermetically sealed
16 needs to be airtight. They just try to then equate waterproof to that. There's
17 evidence on this in Patent Owner's expert's declaration, Exhibit 2019, in
18 which he explains that water molecules are bigger than air molecules.
19 Therefore, waterproof does not equal airtight.
20 There's an alternative argument that they have based on Hattori,
21 which instead of incorporating the integrated circuit 20 as the alleged
22 module -- or sorry, instead of relying on the sealed waterproof ring, they rely
23 on Hattori's disclosure of a protective film. Protective film is mentioned

1 exactly twice in Hattori-912. There's no explanation as to how it's applied or
2 what it protects from.
3 They also, in the presentation today and in their reply brief, rely on
4 Dr. Oliver's testimony about a conformal coating. But they're equating
5 conformal coating and protective film without any explanation. Those two
6 things are not the same.
7 As Dr. Oliver explained, both a protective film and a conformal
8 coating both have the same problem and that there's no detail provided in
9 Hattori as to what the film is being used to protect from. It might be
10 protecting from physical wear and damage as opposed to moisture. A
11 conformal coating can be used to protect from many different things, such as
12 chemical damage or friction.
13 I think one of the most important -- apologies, let me jump through
14 my notes here. I think one of the most important things to note here is that
15 Petitioner is effectively relying on these alternative arrangements and saying
16 it was known. For example, we saw with Howell-596, him saying, but you
17 could have put a UV detection system back there.
18 But that's not the question, could have is not the same as would
19 have. And a PHOSITA would not have been motivated to relocate this UV
20 radiation monitoring system to a place where it was highly likely that it
21 would not actually be able to monitor radiation. That is the sole -- that is the
22 purpose of Howell-596. Howell-596 is not even limited to eyewear. It
23 discloses a radiation monitoring system. It explains that it might be placed

1 on eyewear, jewelry, clothing, accessories, or bags. And so the purpose of
2 that circuit board, that they have identified as the alleged module, was to
3 capture UV radiation.
4 With no further questions, I see that my time is up.
5 JUDGE MARSCHALL: Thank you. Counsel for Petitioner, I just
6 want to understand, and you might have to step to the podium to respond,
7 how critical the hermetically sealed claim construction issue might be. Do
8 you have an argument in your favor if we construe that term hermetically
9 sealed to mean airtight? Do you have any argument based on the prior art if
10 we come up with that narrow construction in our final decision?
11 MR. EVERTON: Yes. Howell-596 still discloses both a
12 waterproof and airtight module.
13 JUDGE MARSCHALL: Just the Howell-596, not the other
14 ground that goes to --
15 MR. EVERTON: Hattori as well. Yeah, sealed.
16 JUDGE MARSCHALL: Well --
17 MR. EVERTON: And that's where we're trying to get to is that
18 really the 48 -- the patent itself, '483, equates the two. And if something is
19 waterproof, it would also be airtight. Therefore, yeah, the prior art that we
20 pointed to in those modules would therefore be airtight as well.
21 JUDGE MARSCHALL: Well, I understand that position. I'm
22 saying if we construe hermetically sealed to mean airtight and that
23 waterproof is not necessarily airtight, do you have any reference that that

1 discloses airtight?
2 MR. EVERTON: Yes. We believe that those same references that
3 are sealed with an O-ring, for example, would be airtight. And for example,
4 the protective layer, again, airtight, so for those same reasons. There just
5 wasn't such a construction. So yeah. But we still think that those references
6 have that limitation.
7 JUDGE MARSCHALL: I understand your position. And Patent
8 Owner's counsel, if you'd like to respond to that very briefly, that's fine. If
9 not, that's fine as well.
10 MS. STONE: I'll just briefly respond that waterproof is not the
11 same as airtight as explained by Dr. Oliver in his declaration.
12 JUDGE MARSCHALL: Okay. Thank you. That's the end of the
13 -01030 proceeding. We'll take a short break now and we'll come back for
14 the next case. I will take about eight minutes, so 10:45, return time. Thank
15 you.
16 (Whereupon, the above-entitled matter went off the record at 10:37
17 a.m. and resumed at 10:45 a.m.)
18 JUDGE MARSCHALL: Okay. We're back on the record. The
19 proceeding that we're on now is IPR2024-01071. We're going to start with
20 Petitioner. And if Counsel for Petitioner could introduce himself first.
21 MR. RAZAI: Good afternoon -- or still good morning, Your
22 Honors. Ali Razai from Morgan Lewis on behalf of the Petitioner.
23 JUDGE MARSCHALL: Okay. You have 30 minutes total.

1 Would you like to reserve any time for --
2 MR. RAZAI: I'm going to try to reserve seven minutes. I'm going
3 to do my best to get there.
4 JUDGE MARSCHALL: So it's --
5 MR. RAZAI: It's quite a bit to get through.
6 JUDGE MARSCHALL: It's very precise. Of course, if you go
7 over, that's fine. It'll just cut into your rebuttal time.
8 MR. RAZAI: Absolutely, Your Honor.
9 JUDGE MARSCHALL: You can begin when ready.
10 MR. RAZAI: Thank you, Your Honor. We're going through the
11 '541 Patent, Your Honors. The '541 Patent is -- relates to electronics
12 embedded in the temples of eyewear. And it has an insulating layer to be
13 disposed between the electronics and the frames of the glasses.
14 Now, let's get into Claim 1. This is Claim 1, the party's dispute
15 solely relates to the last limitation, which is where an insulating layer is
16 disposed between one or more electronic components located within the
17 electronics module and the frame of the first device. That's the entire
18 limitation. There's not much more to it. Although, there's some arguments
19 trying to expand that to something that it's not.
20 Going into Slide 6. Howell-596 and Howell-158 render the claim
21 obvious. There's no dispute that Howell-596 discloses everything but the
22 claimed insulating layer.
23 And going into Slide 7, what you'll see here is Howell-158. And it

1 says that Howell-158 has, quote, "An insulating layer between the electrical
2 components or circuit board and the metallic frames," almost mirroring the
3 language of the claim.
4 Going to Slide 8. As shown in Slide 8, the petition says, for its
5 several reasons, a POSITA would be motivated to combine the disclosure of
6 Howell-596 and 158 to render the claims obvious. And for the sake of time,
7 I'm not going to read those motivations, they're on petition pages 22 to 23.
8 Now, the first argument that Patent Owner makes is they say that
9 the petition doesn't adequately specify where Howell-158's insulating layer
10 would be applied. But as an initial matter, the claims don't require the level
11 of specificity that the Patent Owner demands. Instead, the claims merely
12 require that the insulating layer be disposed between an electrical component
13 and the frames. And that's exactly what Howell-158 discloses.
14 Next, the petition expressly states, for example, that the insulative
15 layer would be applied, quote, "between the electronics and other
16 components located within Howell-596's electric -- electronics module and
17 its frames." So the claim is met, we have disclosed where.
18 Next argument, Patent Owner argues that the petition fails to
19 adequately specify how Howell-158's insulating layer would be applied. But
20 like PO's first argument, this argument also lacks merit. First, Patent Owner
21 admits that Howell-158 discloses an insulating layer between the metal
22 frames and the electronics components. There's no dispute about that.
23 But the Patent Owner can't point to anything in the '541 Patent

1 teaching that somehow explains the application of a claimed insulating layer
2 above and beyond what the -- with a person of ordinary skill in the art would
3 know. And as the law explains, Patent Owner can't demand more from the
4 prior art than what was disclosed in the patent.
5 And the lack of any specific disclosure in the '541 Patent is pretty
6 telling as to what the ordinary skill in the art would be. And that's *Abbott*
7 *Labs v. Andrx Pharms*, 452 F.3d 1331 and *In re Epstein*, 32 F.3d 1559, and I
8 will touch on this briefly. In their papers and the objections, they object to
9 the slide saying this is somehow a new obviousness argument. It's not. The
10 obviousness argument is that the combination of these references render the
11 claim obvious.
12 What they're arguing now is that they're asking for specificity that
13 they demand the petition tell us how to apply this insulating layer. And this
14 case is meant to illustrate. Well, we do tell their skilled artisan would know
15 how to do it. And the disclosure of the '541 Patent is probably the best
16 evidence to show that it's within the skill of the art.
17 Going to Slide 15. Nonetheless, Howell-158 describes exemplary
18 methods by which the insulating layer can be applied. And again, if you
19 look at Howell-158, it keeps saying for example, for example. And for
20 example, tape to encapsulate the dielectric tape to cover the top and bottom
21 of a PCB, double-sided tape stuck to the temple frame.
22 Now, Petitioner's expert also confirmed that insulating layers have
23 been widely used before the priority date, and that Howell-158, quote,

1 "identifies several ways to incorporate such well-known insulating layers."
2 So the petition does explain how Howell-158's insulating layer is to be
3 applied.
4 Now, at the end of the day, the test for obviousness is what the art
5 suggests to the skilled artisan. There's been a lot of discussion today. And
6 there will be a lot of discussion today further about specificity that's not
7 needed to render a claim obvious.
8 Now, if we look at the law, *In Re:CALA* from 1981, it's a great
9 case to look at. The test of obviousness is not whether -- sorry, this is not
10 the right case that I was pointing to. But it's what does the art suggest to the
11 skilled artisan? What would a skilled artisan take from the art and try to see
12 how it would be incorporated and beneficial in a different embodiment?
13 That's what we're after here. And the fact that there's an insulated layer
14 suggested by a reference and there's another reference that it could benefit
15 from, that's all you need. How you would do it and where you would do it, a
16 skilled artisan would know how to do that.
17 Moving on to Slide 17. Claim 1 is broadly directed to eyewear
18 with a frame. But PO argues that Howell-596 doesn't need an insulated
19 layer unless you use metal frames. But as an initial matter, Claim 1 is on its
20 frames. The skilled artisan would use that -- if there was metal frames, there
21 would be no hesitation to assert that claim against metal frames. There's no
22 specific requirement to disclose metal frames. And so we're not really
23 talking about obviousness here, but it is still in the papers.

1 Looking at Claim 18, Howell-158 incorporates by reference
2 Howell-596 which recites the use of metal frames. The Patent Owner's
3 expert admitted that a POSITA would have been -- would have considered
4 metal as a candidate material for frames. PO's argument regarding metal
5 frame simply fails.
6 Going to Slide 19. PO then argues that Howell-158's insulating
7 layer would render Howell-596's UV sensor inoperable because the sensor
8 needs to be exposed to sunlight. We have to remember that a POSITA is not
9 an automaton. A POSITA would know how to apply the insulative layer
10 without affecting the functionality of what it's trying to encapsulate.
11 But neither the claims nor the petition required the insulating layer
12 to cover all the electronic components of Howell-596. This just has to be
13 disposed between one of the electronic components in the frames. And
14 there's no question that Howell-596 has many different electronic
15 components besides just the UV sensor.
16 Going to Slide 21. The Patent Owner then argues that the
17 insulating layer would impede aesthetics and the functionality of Howell-
18 596's glasses. But the Patent Owner speculation regarding subjective
19 considerations, like aesthetics, lacks merit. PO hadn't submitted any
20 credible evidence that the combination would be heavier or more
21 complicated, much less that it would be so heavy or so complicated that it
22 just wouldn't work.
23 PO then argues that Howell-596 doesn't need insulation because it

1 discloses alternatives, like air gaps or holding the electronics modules in
2 fixed positions. Now, if those alternatives were even better than including
3 an insulated layer, that argument still would fail. The Federal Circuit has
4 established that mere disclosure of alternative designs doesn't teach away.
5 Further, even if alleged alternatives were better, the law clearly states that
6 even if, and I quote, "better alternatives exist in the prior art, it doesn't mean
7 that inferior combination is inapt for obviousness purposes." So this is *In re*:
8 -- I'm going to butcher that name -- *Mouttet*, 686 F.3d 1322 at 1334.
9 Now, we're going to go into Dependent Claim 12 of the '541
10 Patent. Now, Claim 12 requires a cavity in the temple of the eyewear and a
11 housing module that can selectively be placed in that cavity.
12 Now, going to Slide 30. There's no dispute that Howell-596
13 discloses a cavity in the temple that can accommodate an electronics
14 module. And Howell-158 discloses a collection of electronics encapsulated
15 in an insulating layer. Now, Howell-158 actually expressly says that the
16 insulating layer can encapsulate the electronics components and can provide
17 mechanical stiffness to the electronics module.
18 So basically, what you have is this package of electronics that's
19 insulated. A POSITA would have been motivated to combine Howell-158
20 and Howell-596. But the petition and Dr. Feland set forth multifold reasons
21 to combine the disclosure. And those include to prevent circuits from being
22 shorted, to insulate adjacent electrical conductive elements from each other,
23 and it was standard practice to insulate electronic components since long

1 before the priority date.
2 Going to Slide 32. Patent Owner then argues that a POSITA
3 would have understood that Howell-158's insulating layer could not function
4 as a housing or container. But the claims don't require a housing or
5 container, only an electronics module. Howell-158's electronics components
6 encapsulated in an insulated layer is an electronics module. And this is
7 supported by the express disclosure of the '541 Patent. The '541 Patent --
8 JUDGE MARSCHALL: I'll step in there for a second. Doesn't the
9 specification of the patent all but define the term module as a housing or
10 container? I'm looking at column 7, lines 45 to 51.
11 MR. RAZAI: Your Honor, if we were to do a construction of that
12 and get -- and make that a housing or a container, the argument still fails.
13 The point that I was making is the claims, right now, recite electronics
14 module. And if the housing or container is still there, it wouldn't make any
15 difference to the obviousness analysis. Because the way that you would
16 wrap this up, basically, you would have a housing or a container.
17 Because the '541 Patent goes on to say that the outside walls of the
18 container -- and this is what's on Slide 33 in front of Your Honors right now
19 -- states that the outside wall could be an insulative layer. And that's exactly
20 what you would have if you had the Howell-596's disclosure of the
21 electronic components in an insulated wrapping that creates mechanical
22 stiffness. There's nothing that prevents that outside of that wall from being
23 an insulative layer that you then drop into the temple of the Howell-158

1 reference.
2 JUDGE MARSCHALL: Okay. But when the challenged patent
3 relies on -- or talks about this embodiment where the housing module itself
4 can actually be the insulating layer and kind of satisfy two claim limitations
5 with one structure, it's an actual housing in the specification, it's not just
6 some wrapping of some kind, correct?
7 MR. RAZAI: But I guess what I'm failing to understand is, is there
8 something special about a housing or a the wall of a container that's different
9 than what you would have when you're wrapping something? It's the same
10 thing.
11 JUDGE MARSCHALL: I understand it's your position. I'm trying
12 to get my head around that. Because when I think of housing or container, I
13 think of a box-like structure. And you're talking about some almost
14 conformal layer or wrapping around electronics that's almost shrink fit on
15 and it's less housing-like or container-like in my mind. But I understand
16 your position. And when you're talking about a layer, are you talking about
17 wrapping it around the entire -- all of the electronics or just some of them?
18 I'm trying to understand.
19 MR. RAZAI: When you're using this as a housing, you would
20 wrap it around the relevant portions of the electronics. Now, for example
21 -- I'm not -- the skilled artisan would know how much to wrap or where to
22 wrap. And for example, if there's an argument about a window for a UV
23 sensor, you obviously wouldn't want to cover the UV sensor. But again,

1 those are all within the skill of the art. This is not an argument that I'm
2 making. The argument that I'm making is that you would basically wrap it
3 in this insulative layer and drop it in.
4 And back to your original argument, we're taking an electronics
5 module to then a housing or container and now construing what the walls of
6 the housing or container are made of. But if you go back to the claim
7 language, all it requires is an electronics module, which basically is a
8 collection of electronics.
9 JUDGE MARSCHALL: Okay. I think I got that. I guess, what
10 I'm getting at is if you only partially enclose electronics, maybe one or two
11 pieces of electronics and not the rest, it looks a little less like a housing or
12 container. And that's where I'm having a little difficulty. But I think I
13 understand your position.
14 MR. RAZAI: But again, that would be a different embodiment if
15 you were to wrap one or two, not the entire bundle that you would want to
16 drop into that cavity.
17 JUDGE MARSCHALL: Right. But you're saying that it might
18 only be one or two things because of what you need to cover.
19 MR. RAZAI: What I'm saying here is that if you're wrapping the
20 electronics module and, for example, you need to have a window that's left
21 open --
22 JUDGE MARSCHALL: Right.
23 MR. RAZAI: -- a skilled artisan would understand how to wrap it

1 in a way where you would allow access to the portions that don't -- that can't
2 be wrapped. That was the point, not that you would selectively wrap. That
3 was a prior argument for a different set of combinations.
4 JUDGE MARSCHALL: Okay. Thank you.
5 MR. RAZAI: Thank you, Your Honor. Going to the next slide,
6 this is Claim 18. Claim 18 requires the housing module to be less than or
7 equal to approximately 0.7 millimeters. Now, the Patent Owner argues that
8 the Petitioner provides no evidence that a person of ordinary skill would be
9 motivated to combine or modify Howell-596, 158 as recited in Claim 18.
10 But that's incorrect. The obviousness -- the motivations to
11 combine are included in the petition. And they include maintaining
12 proportions of traditional eyewear, reducing weight, and increasing comfort,
13 offsetting bulkiness, ergonomic and aesthetic considerations, reducing
14 disturbance of design features, making the glass cosmetically pleasing,
15 avoiding a thick temple or frame.
16 But the Patent Owner argues that the petition doesn't explain how
17 to make electronic eyewear that's less than 0.7 centimeters. But there's no
18 dispute that the art discloses eyewear in this range. And the petition
19 explains that it was within knowledge in the advanced field of electronic
20 eyewear to do so. And there was no pushback, there's no expert declaration
21 saying, no, that wasn't within skill of the art. And the Patent Owner cites to
22 nothing it did to advance that field within the '541 Patent itself. And again,
23 under *In re: Epstein*, the specification is the best place to look for that.

1 Moving on to Slide 39. Again, discovering workable ranges is not
2 inventive. And that's *In re Aller*, 220 F.2d 454 at 456; *In re Applied*
3 *Materials*, 692 F.3d 1289 at 1295; and *In re Epstein*, 32 F.3d 1559 at 1568.
4 Moving on to the next argument, Ground 3. Ground 3 is a single
5 reference obviousness combination based on Howell-596. It would have
6 been obvious for a POSITA to simply select an insulating material for
7 module housing 1700, in which case there would be an insulating layer
8 between an electronic component and the frames.
9 Moving on to Slide 42. The Patent Owner argues that Howell-
10 596's exterior wall is not an insulating layer because there's nothing to
11 insulate the electronics module. Now, as an initial matter, the insulated
12 properties of a material do not change simply based on the presence or
13 absence of a conductive material that's adjacent.
14 Next, the motivation to insulate conductive electrical components
15 to prevent leakage current and protect electrically conductive elements from
16 each other is not affected by the presence or absence of a conductive frame.
17 The use of insulated material as the exterior wall of the electronics module is
18 expressly contemplated by the '541 Patent, as we just saw.
19 And although expressly contemplated by the '541 spec, the Patent
20 Owner argues it expressly disclaimed an embodiment where the wall of the
21 electronics module and the insulating layer are the same thing, but not so.
22 There, the examiner rejected Claim 49 that was pending in view of
23 Kokonaski-166 on the basis that it inherently disclosed that insulting layer

1 -- an insulating layer.

2 Based on the examiner's speculation that Kokonaski, quote, "can
3 have insulating material, for example, the wire on wires." In response, the
4 Patent Owner argued that Kokonaski does not necessarily have an insulating
5 layer. The applicant never even discussed the claims, much less disclaimed
6 any embodiment.

7 Patent Owner's disclaimer arguments fail. The disclaimer is very
8 exacting. You can look at *Trivascular v. Samuels*, 812 F.3d 1056 at 1064;
9 *Profectus v. Huawei Tech*, 2014 Westlaw 1575719 at 6; and *Telecom*
10 *Limited v. Samsung*, 215 F.3d 1281 at 1294.

11 Now, next argument is that Kokonaski-166 and Howell-158 render
12 Claim 1 obvious. Because Kokonaski alone discloses sealing its electronics
13 module using silicone, which is insulated. Based on the motivation to
14 include an insulative layer, it would have been obvious to a POSITA to
15 apply the insulation to Kokonaski-166's electronics module.

16 So you have Kokonaski itself disclosing silicone. And so it would
17 have been obvious to use that silicone as an insulative layer within
18 Kokonaski itself. But the Patent Owner erroneously argues there's no
19 motivation to combine because Kokonaski does not disclose reliance on
20 metal frames. But Kokonaski-166 expressly discloses the use of metal
21 frames, and that's at paragraph 84.

22 Next, Patent Owner argues that Petitioner provides no evidence
23 besides its expert that silicone is insulative. I'm not sure what else Patent

1 Owner would want besides the experts saying that silicone is insulative.
2 Moving on to Slide 56. Once again, Patent Owner tries to invoke
3 its disclaimer argument by contending that Kokonaski did not disclose an
4 insulated layer. But as discussed, there was no such disclaimer.
5 Moving on to Slide 58. In Ground 6, the petition sets forth that
6 Howell-158's insulative -- insulating layer could be applied in Kokonaski-
7 999 to insulate electronics from the explicitly disclosed metal frame of
8 Kokonaski-999.
9 At Slide 59, the Patent Owner argues that applying Howell-158's
10 insulating layer would ruin the functionality of Kokonaski-999's glasses
11 because they rely on the conductive portions of the frame for functionality,
12 so basically saying that the frame itself somehow conducts and you would
13 need that, you don't want to insulate that. But again, they're focusing on one
14 embodiment.
15 In Slide 60, Kokonaski-999 is not limited to electrical
16 communication using conductive portions of the frame. In fact, it provides
17 four alternative means that don't rely on any conductive portions of the
18 frame, conductive wires, optical link, conductive layers of the electric active
19 lenses, wireless communications links.
20 Finally, Patent Owner argues that the ground fails because
21 Petitioner overlooked superior alternatives to Petitioner's proposed
22 combinations. But again, alternatives don't teach away from the proposed
23 combination, nor must the combination be optimal. There just needs to be a

1 motivation, and the motivation was presented, Your Honors. And that's,
2 again, *In re Mouttet*, 686 F.3d at 1322.
3 And surprisingly, I finished with three minutes more than I thought
4 I would have. If you have no other questions, I will reserve the remaining
5 time for rebuttal.
6 JUDGE MARSCHALL: Thank you.
7 MR. RAZAI: Thank you, Your Honor.
8 JUDGE MARSCHALL: It looks like we have a new counsel for
9 Patent Owner as well. Could you introduce yourself to the Court?
10 MR. AISIKU: Good morning, Your Honor. My name is Ojeiku
11 Aisiku on behalf of E-Vision.
12 JUDGE MARSCHALL: Thank you. And would you like to
13 reserve any time for rebuttal?
14 MR. AISIKU: Yes, Your Honor. I would like to reserve five
15 minutes for rebuttal.
16 JUDGE MARSCHALL: Great. Proceed whenever ready.
17 MR. AISIKU: So I wanted to discuss three issues during this
18 hearing, Claims 1, 18, and 12. Claim 12 is distinct and has certain issues.
19 And so I'd like to address that first and then take Claims 1 and 18 in tandem
20 following that. And so the main crux of the issue regarding Claim 12 is
21 whether the double-sided sticky tape teaches or renders obvious the actual
22 electronics module.
23 And so as you can see, Claim 1 distinctly claims an electronics

1 module and an insulating layer. In contrast, Claim 12 doesn't include that
2 information. And what you'll note is, starting on claims -- I'm sorry, Slide 7,
3 the Petitioner changed their approach between Claims 1 and Claim 12. They
4 changed their mapping.
5 And as opposing counsel mentioned earlier on in his discussion,
6 Claim 1, they pointed to the housing 1700 as the electronics module. They
7 changed the approach in Claim 12 so that the electronics module is now just
8 the double-sided sticky tape, which renders the entirety of Claim 12
9 -- renders the entirety of Howell-596 entirely defeats the stated purpose,
10 Your Honor.
11 And the reason why I want to begin with Claim 12 is the fact that
12 that's the only claim with one ground of invalidity and that's Ground 1. And
13 that's the combination of Howell-596 and Howell-158. And replacing the
14 housing or container of the electronics module discussed in Howell-596, it
15 actually provides several differences and difficulties that defeat the purpose
16 of Howell-596.
17 And I would like to note that in the Patent Owner response, we
18 note the fact that the form factor is used in Howell-596 to regularize it for
19 the UV's detection system and to make sure that the form factor wouldn't be
20 adjusted in a way that impedes the UV sensor. However, replacing the
21 housing or the container of Howell-596, which regularizes or standardized
22 the form factor and using double-sided sticky tape, number one, that defeats
23 the purpose of Howell-596 entirely; number two, there isn't any motivation

1 to actually do so. And opposing counsel states numerous times that a person
2 of ordinary skill is not an automaton, or they would have been able to kind
3 of figure out what to do with these teachings.
4 But that is not what the law states and that's not their burden.
5 Their burden is to actually articulate a basis for taking the combined
6 teachings and incorporating them in a way that would disclose the
7 challenged claims. Instead, what they do is they take disparate components
8 of the prior art and then they just assume that a person of ordinary skill in
9 the art would have figured it out.
10 And as you can see, the only part that they use for support or their
11 basis of an insulating layer, or I guess in the case of Claim 12 of an
12 electronics module or housing container is Howell-158, particularly
13 paragraph 53 as you can see here in Slide 6, that is the only component or
14 element that they use to support their claim that a person of ordinary skill in
15 the art would have used the insulating layer as the electronics module. And
16 again, the only thing that Howell-158 teaches is double-sided sticky tape.
17 Now, I want to address a few other points that opposing counsel
18 mentioned during --
19 JUDGE HAMANN: Counsel --
20 MR. AISIKU: Yes.
21 JUDGE HAMANN: -- this is Judge Hamann. Just real quick, I
22 think we're on Slide 6, still in paragraph 53. What does Patent Owner make
23 of the mechanical stiffness disclosure in the context of the tape and how that

1 may relate to being a housing or module or container or not?
2 MR. AISIKU: Yes, Your Honor. So just as illustration -- so while
3 double-sided sticky tape might provide mechanical stiffness, it's not actually
4 a housing or container and it doesn't regularize the form factor in the way
5 that an actual housing of an electronics module would provide. And so
6 simply saying that it provides mechanical stiffness is insufficient.
7 In addition to that, Howell-153 says, that to a certain degree, it can
8 also provide mechanical stiffness. So it's not saying that it would be as
9 suitable as a housing for the electronics module. And in addition, in fact,
10 when it talks about mechanical stiffness, it's discussing it in the context of
11 really supporting another actual structure, another electronics module, not
12 simply replacing it entirely.
13 And in fact, it talks about, here in this portion, that it can -- you can
14 cut it certain pieces into certain sections, then combine that with certain
15 elements of an actual housing or container. And again, Howell-596
16 specifically indicates that it needs that kind of structure to regularize the
17 factor of the UV detection module.
18 JUDGE HAMANN: So is Patent Owner suggesting that container
19 in this context requires some type of structure?
20 MR. AISIKU: In this particular context and in the proposed
21 combination by the Petitioner, yes, it does. Specifically, and as noted in the
22 Patent Owner response on, I believe it was page 8, effectively, the
23 electronics module discussed by Howell-596, it actually is discussing a

1 container, a housing, and so just using double-sided sticky tape would defeat
2 that purpose.
3 JUDGE HAMANN: Thank you.
4 MR. AISIKU: So I also want to note that there is a lot of
5 discussion that opposing counsel made regarding encapsulating, and this is
6 on Slide 10. And again, he noted, for example, that a person of ordinary
7 skill in the art -- in the context of his discussion on Slide 33, he said the
8 person of ordinary skill in the art would have found it obvious to simply
9 wrap the entire collection of electronics into the double-sided sticky tape and
10 then just drop it into the to the frame or the housing module of Howell-596.
11 I just want to note, number one, that this is a new unsupported
12 argument. Number two, there is no support in the -- from the expert or from
13 the combination of elements that actually says that a person of ordinary skill
14 in the art would have actually considered just wrapping a collection of
15 electronics into double-sided sticky tape and then simply dropping it into the
16 temple of a pair of eyewear.
17 And this wasn't discussed by Petitioner, actually. When we noted
18 that a large part of their reliance throughout their briefing was that a person
19 of ordinary skill in the art would have appreciated that you can encapsulate
20 the UV detection system of Howell-596. And again, Howell-596 needs to
21 be exposed in a way that the sensor has access to the internal and external
22 environment, so it can detect the UV radiation. And there was no discussion
23 in the briefing about having a window or how you would incorporate that

1 into Howell-596.

2 In addition to that, given the fact that it's simply adhesive and it's
3 tape and it doesn't necessarily regularize the form factor as an actual
4 structure, there isn't any discussion as to how a person of ordinary skill in
5 the art would actually be able to account for that and actually be able to
6 provide those elements. And it's important because of the fact that the
7 context of Howell-596 is that it's detecting radiation from sunlight.

8 And I'll discuss this later on. But the entirety of Petitioner's
9 grounds, they rely on this assumption that you would be using metal frames
10 for the glasses, for the combination. And metal frames would defeat the
11 purpose for other reasons. In addition to added weight and added
12 complexity, especially in the context of Howell-596 where you're exposing
13 the glasses to heat and then measuring the effects of sunlight in that regard
14 and measuring the UV radiation, having a pair of eyewear that conducts
15 heat, that adds to the weight of the glasses, and adds to the complexity, all of
16 that being put on a person's face would further defeat the purpose because
17 that is not the intention of Howell-596.

18 And again, all of these considerations weren't discussed in any of
19 the papers, weren't discussed by the expert. And a lot of these discussions
20 were made effectively on the fly by opposing counsel today.

21 And then again, I just want to note that opposing counsel again
22 makes certain deviations and says that you can effectively drop the
23 electronics wrapped in double-sided sticky tape. And that's something that

1 they state consistently throughout their petition and their reply brief. They
2 talked about encapsulating the entirety of the double-sided -- of the
3 electronics as opposed to just certain components. And this is crucially
4 different from their discussion of Claim 1 where they talk about just
5 wrapping the circuit board from the -- with the insulating layer.
6 So again, there's a difference between encapsulating one portion
7 versus the entirety. And their proposal with respect to Claim 12 is
8 encapsulating the entirety of the UV detection system.
9 And so I just want to summarize these points, so the main basis of
10 their combination, with respect to Claim 12, is to incorporate just double-
11 sided sticky tape into the electronics module to encapsulate any electronics.
12 And number one, this would imply covering the UV sensor. Number two, it
13 would eliminate the form factor regularization and the mechanical stiffness
14 to a certain degree is insufficient to replace that.
15 And then in addition, and as I'll discuss in more detail, the fact that
16 it involves the use of metal frames which could conduct heat and cause other
17 difficulties that involve the UV sensor and the adhesive and the double-sided
18 sticky tape, all of that renders Claim 12 patentable. And Petitioner's grounds
19 have not met their burden.
20 I'd like to move to the second point, which is the insulating layer.
21 And as I noted, all of their grounds for Claims 1 through 18 involve metal
22 frames. And I'd like to discuss the state of the art in greater detail because
23 this is extremely important and something that Petitioners didn't discuss very

1 clearly. But one of the issues with wearable electronics is that it has to have
2 a lot of consideration that makes sense not just in the market but also for
3 consumers.
4 And there were a lot of difficulties in using and adopting wearable
5 electronics, especially in the context of wearing them on a person's -- again,
6 on a person's head. And this has actually been a major drawback. And one
7 of the examples actually was the Oakley Thump and the fact that it was
8 especially prone to failure.
9 And the reason why this is problematic is because, again, as noted
10 at the bottom, an important aspect was making them as light as possible.
11 Now, when you incorporate metal frames into eyewear, especially the
12 eyewear of Howell-596, what you're doing is you're adding the metal
13 frames, you're adding the weight, you're creating the problems of short
14 circuits and issues that involve the conduction of heat and other problems.
15 And then you're adding in this insulating layer to solve the problems that
16 you've created yourself.
17 And again, just to go into some of opposing counsel's discussion,
18 specifically in Slide 22 of their presentation, they mentioned that alternatives
19 that we raised are irrelevant. And I want to clarify our position because
20 that's not actually what we're arguing. We're not simply arguing that
21 existence of alternatives defeat a motivation to combine.
22 We're saying that Petitioner has an affirmative requirement and
23 burden to articulate a motivation to combine the disparate elements from the

1 prior art that they have argued should be incorporated. And the lack of a
2 motivation is exemplified by the fact that metal frames would cause
3 significant drawbacks to the way that the prior art works, specifically
4 Howell-596 and the fact that it needs access to an external environment and
5 then the fact that it's incorporating the insulating layer. All of those
6 additions and incorporations defeat the purpose of the prior art.
7 And just as another example, Kokonaski was discussed in the
8 prosecution history. And the patent applicant specifically noted that there is
9 one way to not have an insulating layer at all. In fact, opposing counsel did
10 note that during prosecution, we described an instance in which an insulating
11 layer would not exist, that is where there are not metal frames in the glasses.
12 So effectively, without metal frames or without something to
13 insulate, then there isn't any insulating that is occurring. And so that
14 functional limitation of an insulating layer isn't met because there is actually
15 no insulation occurring.
16 And so just as another example, and this is Figure 17B from
17 Howell-596, they discussed all of these different components and what
18 they're describing is an optical filter, additional sensors, a thermal sensor,
19 motion detector, stress sensor, and all of these components are supposed to
20 be integrated into a single pair of glasses without sacrificing the aesthetics
21 and the wearability and the functionality of the components. And Petitioner
22 doesn't really address any of these issues, other than saying that a person of
23 ordinary skill in the art, not being an automaton, would have simply come up

1 with the combination.

2 And again, this is taken from only one section of Howell-158.
3 This is the only area where there was any discussion of insulating layer in
4 the prior art. And it says, explicitly, for glasses with metal frames. That is
5 the only instance in which you would want to do that. And Howell-158 also
6 is directed to something that doesn't have the same weight issues as Howell-
7 596 because it's not incorporating all of the components that Howell-596
8 needs for a UV detection sensor into one form factor that would be
9 regularized.

10 Instead, you have a lightweight pair of glasses that connects to
11 another device. And again, this is only one embodiment. And it's only
12 referring to an insulating layer and its double-sided dielectric sticky tape.

13 JUDGE HAMANN: I have a question about that. Because I think
14 you have a much tougher argument here because Howell-158 expressly
15 discloses metal frames and electronics within them and the need to prevent
16 short circuits by using an insulating layer. So it's hard to get my head
17 around your argument that using a metal frame with electronics would not
18 be obvious or at least one of the very well-known combinations with well-
19 known trade-offs.

20 I get all of the arguments against metal frames and if none of the
21 references mention them, if Petitioner had said it would have been obvious
22 to use metal, maybe those arguments would be a bit stronger. But when the
23 Howell-158 expressly discloses metal frames used with electronics, why

1 wouldn't that undermine your argument that it wouldn't be obvious to do so?
2 MR. AISIKU: So Your Honor, I think the crux of the issue is the
3 combination that the Petitioner proposes, which is specifically Howell-596
4 with Howell-158, and this is specifically regarding Ground 1, Your Honor.
5 And Howell-596 would be defeated by using metal frames for a few reasons.
6 Number one, again, it's in the context of detecting UV radiation, for
7 example, from sunlight.
8 And so that would increase the likelihood that there's excessive
9 heat conducted by the metal frames that could cause damage, not only to the
10 wearer but the internal components. It's also an element that needs to have
11 exposure to sunlight. And so having the double-sided sticky tape that's
12 taught as encapsulating the electrical components in general, that would also
13 defeat the purpose.
14 And then in addition, there's discussion of it being simply the
15 circuit board. But this is why we discuss alternatives. Because not
16 necessarily that the simple existence of alternatives defeats their motivation
17 to combine, but coupled with the fact that employing metal frames and then
18 employing an insulating layer would be problematic and have all these
19 shortcomings for the combination of Howell-596 and 153 -- I'm sorry, 158,
20 the alternatives that are disclosed, such as the air gap or simply not having
21 metal frames, those are important alternatives that are already employed by
22 Howell-596 because of the fact that incorporating metal frames would defeat
23 their stated purpose.

1 JUDGE HAMANN: Thank you.
2 MR. AISIKU: And relating to what Your Honor noted, so Howell-
3 158 discusses, as you mentioned a moment ago, metallic frames, and
4 Kokonaski-166 was what was expressly discussed in the prosecution history.
5 And as I noted actually, Your Honor, in Slide 20, the applicant mentioned
6 that there's a specific embodiment or a specific element in Kokonaski that
7 would not have any need for an insulating layer. And that's where there are
8 no metal frames. And this is exactly the embodiment that we discussed, and
9 what we indicated would not be within the scope of the claims.
10 And so there is no motivation to combine specifically with
11 Kokonaski because it would be -- a person of ordinary skill in the art would
12 have been motivated not to actually use metal frames in Kokonaski. And
13 while Kokonaski mentions, as I note in Slide 23, Kokonaski has several
14 functions of its own, and a major part of it is, again, user acceptance. And
15 so incorporating the metal frames would also defeat the purpose of
16 Kokonaski-166.
17 And I actually would like to discuss this discussion of the epoxy,
18 which is in Ground 5. Again, the insulating layer being a functional
19 element, without metal frames, there is no insulation. And Howell-166
20 simply teaches the epoxy is being used for water resistance, not for
21 insulation. And there is no discussion that a person of ordinary skill in the
22 art actually would have used the watertight seal as an insulating layer for
23 electrical insulation.

1 And every argument that the Petitioner makes are largely
2 speculative in their own. And then I want to raise another point that
3 Petitioner makes. They discussed Kokonaski-999, and they mentioned that
4 there were several different examples and several different embodiments. I
5 want to note that this is a complete abandonment of their entire basis set
6 forth in the petition. Because in the petition, they only discussed one
7 disclosure and one aspect of Kokonaski-999.
8 And as you can see on Slide 27, this is precisely what they noted is
9 that the broader disclosure of Kokonaski-999 includes conductive wires,
10 optical sensors, wireless links. But if you note the petition itself, their
11 motivation to combine is that the glasses of Kokonaski-999 include
12 conductive portions of the frame. And so their motivation to combine is
13 either metal frames or using these conductive links in Kokonaski-999.
14 And so if they abandoned their entire basis for Kokonaski-999, as
15 they appear to have done in the reply brief, then there is no motivation to
16 combine at that point. And they effectively have admitted that Kokonaski-
17 999 doesn't have metal frames in this particular embodiment, so there is no
18 motivation to combine at that point.
19 And then lastly, I would like to discuss Claim 18, which is the
20 housing module. So throughout their discussion -- and this is on Slide 29.
21 Throughout the discussion, opposing counsel discusses that it would have
22 been obvious to combine or incorporate the knowledge of a POSITA,
23 specifically as stated in Dudli or Della, into the form factor described in

1 Claim 18.

2 But I want to note that Claim 18 is directed to a housing module
3 with a thickness of 0.7 millimeters. Dudli and Della do not say anything at
4 all about electronic eyewear or electrical components whatsoever. And one
5 of the things that opposing counsel has done -- and I actually want to note
6 that this was something that was objected to during our opening prior to this
7 discussion -- they rely on Slides 14 and 39 and they say that a person of
8 ordinary skill in the art would have known how to incorporate certain
9 elements that are not described in the specification.

10 First, this is false, and this is an argument that was never addressed
11 in any of the papers. It is a brand-new argument that opposing counsel has
12 raised today.

13 And one of the reasons why it's important is that the parties didn't
14 have an opportunity to brief this. But if the parties did have an opportunity
15 to brief this, it would have been clear that the specification actually goes into
16 significant detail as to the insulating layer and the width of the housing
17 module. And I'd like to direct Your Honor's attention to the Patent Owner
18 response at pages 16 and 17 where we discuss the '541 Patent on column 66,
19 lines 10 through 34. And in that location, we actually discussed in
20 significant detail the optimal width of the housing module and how that can
21 be coincided with the insulating layer and how all of these considerations of
22 form factor and size and insulation are balanced by the disclosure and
23 discussion in the '541 Patent.

1 So even with opposing counsel's late discussion and late arguments
2 that were never raised in either of the papers, their point is still false.
3 Because the '541 Patent actually goes in significant detail into the insulating
4 layer, into the housing module, and into all the elements that were discussed
5 in the claims. And again, they're simply arguing that a person of ordinary
6 skill in the art would have been able to not being automaton made whatever
7 combinations that Petitioner proposes. But they don't have any support in,
8 again, the papers or their expert declaration to that.
9 And I also would like to note that their basis for combining Dudli
10 and Della with the knowledge of a POSITA is that it would have been
11 desirable to simply use the form factor of standard eyewear. But again,
12 these aren't simply standard eyeglasses. They're actually the electronic
13 eyewear in Claim 1 and Claim 18.
14 And so what Petitioner is effectively saying that a person of
15 ordinary skill in the art would have basically known how to incorporate all
16 of these electronic components and then taken whatever knowledge is
17 provided by standard run-of-the-mill eyewear. And they would have been
18 able to incorporate these components to have the form factor of standard
19 eyewear that have no electrical components whatsoever.
20 And just to illustrate, Howell-596 includes all of these electronic
21 components. And they don't explain how all of those components would be
22 converted into the standard eyewear of Della and Dudli. And again, that's
23 another example of Howell-158, and they don't show how any of these

1 components would be incorporated into Della and Dudli. Same thing with
2 Kokonaski-166, all of these electronic components, there is no discussion in
3 the briefs or in the expert declaration as to how all these electronic
4 components would have been incorporated into the form factor of Dudli or
5 Della.
6 And lastly, there is Kokonaski-999, which I would just like to note,
7 Your Honors, that there is no discussion at all in the petition or the
8 Petitioner's reply brief that discusses Kokonaski-999. And so any
9 combination of -- or any ground with respect to Claim 18 in the combination
10 of Kokonaski-999 has been waived because there isn't any discussion of
11 Kokonaski-999.
12 And with that I will use the rest of my -- reserve the rest of my
13 time.
14 JUDGE MARSCHALL: I have a question on Claim 18.
15 MR. AISIKU: Yes, Your Honor.
16 JUDGE MARSCHALL: One of Petitioner's arguments is that the
17 thickness limitation is a result-effective variable. Does Patent Owner
18 dispute that aspect of their argument?
19 MR. AISIKU: Yes, Your Honor. So one of the reasons why a
20 result-effective variable could be one of the requirements, in the first place,
21 is that they have to show that it's actually a result-effective variable. And by
22 doing that, there has to still be some teaching in the prior art references as to
23 what the result effect would be. But again, there is no discussion in any of

1 the prior art references as to the width of the housing module in the width of
2 the form factor. The only portion that they cite to is Dudli and Della, which,
3 again, nonelectronic eyewear in the first place.
4 And in addition, Dudli and Della, neither of them disclose a
5 housing module, neither of them disclose an electronics module, neither of
6 them disclose an insulating layer. They don't describe any of that. And so
7 the fact that Claim 18 requires a housing module that has a width of 0.7
8 millimeters, that is entirely lacking in the prior art. There's no discussion of
9 the optimal width of a housing module or the optimal width of the
10 electronics module or anything like that.
11 And I just would like to note, given the fact that, again, this was a
12 new argument as far as the Patent Owner's disclosure in the specification
13 versus the arguments that were raised today for the first time. I also just
14 want to note, in case Your Honors do consider these new cases that opposing
15 counsel stated, column 52 at lines 24 of -- and 41 of the '541 Patent; in
16 column 59, lines 4 through 29; along with column 66, lines 10 through 34,
17 go into significant detail as to why you have certain widths of the housing
18 module, which involves the side of the housing module, not the entirety of
19 the housing module, not the entire form factor of the housing module, but
20 certain sides to it, which, again, relate to how you can incorporate an
21 insulating layer, a sensing mechanism, and other elements while maintaining
22 the proper functionality.
23 And with that, if Your Honors don't have any other questions, I'll

1 reserve the rest of my time.
2 JUDGE MARSCHALL: Yes. And I started questioning you,
3 you're about two minutes over, so you got about three minutes left.
4 MR. AISIKU: Understood. Thanks.
5 MR. RAZAI: Thank you, Your Honors. There is a lot of
6 discussion today about apparently what I said and how I characterized
7 arguments and how things were new. I'm very, very happy that there's a
8 record and I urge Your Honors to go back and look at some of the waiver
9 arguments that were made today regarding -- by Patent Owner. There was
10 no such waiver of the arguments. They were all in the petition and have
11 been preserved.
12 Getting into Howell-158, there's been a lot of disclosure about all
13 Howell-158 teaches is double-sided tape. Over and over and over again, all
14 it teaches is a double-sided tape. Howell-158 teaches an insulated layer.
15 That's what it tells a skilled artisan that can be done.
16 There's various different ways of incorporating insulating layer.
17 And in the actual reference itself, it talks about die cutting insulative
18 material, for example, double-sided dielectric tape. There's various different
19 teachings in just that reference alone. And what does it suggest to a skilled
20 artisan? I don't think that as of 2006 or whatever the earliest prior date of
21 this patent was, that a skilled artisan would know what an insulative layer
22 may or may not consist of.
23 We did have some discussion about -- Howell-596 discusses a

1 housing to be this and to be that. What I don't understand is why that
2 matters. We're talking about how one -- for Claim 12, we're talking about
3 dropping the electronics module that's created by Howell-158 into a cavity
4 of Howell-596. What Howell-596 may or may not talk about a housing
5 module is irrelevant.
6 But looking at Howell-158, looking at the teachings of Howell-158
7 and looking at what the '541 Patent says could be a housing or it could be
8 electronics module, I just don't understand the argument at all. Why is it that
9 the bundle of electronics that's wrapped in an insulative layer, whether it's
10 double-sided tape or die-cut material of insulated material that be dropped
11 into a cavity wouldn't satisfy Claim 12? It does.
12 There were discussions about certain deviations and arguments on
13 the fly, especially with regards to -- get into this portion --
14 JUDGE MARSCHALL: Before you move on, paragraph 53 of
15 Howell-158 when they're talking about insulating layer and tape, at least
16 when it comes to the providing a certain degree of mechanical stiffness, it's
17 referring specifically to the tape, correct?
18 MR. RAZAI: In that portion, it is referring to the tape basically
19 saying the insulated layer could provide a degree of stiffness but telling the
20 skilled artisan that you could have an encapsulate -- that's actually what I
21 wanted to talk about is paragraph 53, talking about arguments made on the
22 fly regarding encapsulation, regarding the electrical components.
23 And if you look at that limitation, look at petition at 34, look at the

1 reply at page 10, and look at Howell-158, Exhibit 1006 at paragraph 53, as
2 explained in the petition, Howell-158's insulating layer not only satisfies the
3 insulating layer limitation of Claim 12 but also meets the, quote, "electronics
4 module limitation" because it, quote, "encapsulates the electrical
5 components," end quote, and provides, quote, "mechanical stiffness," end
6 quote. I didn't make that up. It was in the petition, it was in the reply, it's in
7 the reference.
8 Then we talked about wrapping the entirety of the module up. No
9 one talked about wrapping the entirety. We're talking about wrapping the
10 electronics module creating stiffness. And now, one of the things that I
11 think is very evident here is that we're taking the entire skill of the artisan
12 out of this equation and requiring some disclosure and some specificity that
13 just isn't required by the law.
14 We have to understand that by the time 2006 came along, we had
15 over 50 years of development in the electronic eyewear space. In here, we're
16 not talking about three-dimensional projections on screens. We're not
17 talking about the ability of eyewear to cut through metal. We're talking
18 about insulation within electronics eyewear, at least with respect to this
19 patent. The skill in the art was very developed by that point.
20 The state of the art is what I'd like to talk about next. Talking
21 about -- and when we were -- when Patent Owner was discussing --
22 JUDGE MARSCHALL: Before we move on, I just want to clarify
23 that part. You mentioned that you're never alluding to wrapping the entire

1 module up, correct, with the insulating tape?
2 MR. RAZAI: That's correct, Your Honor. It's with respect to --
3 JUDGE MARSCHALL: It's like a layer on top of certain
4 electronics.
5 MR. RAZAI: That's correct, Your Honor.
6 JUDGE MARSCHALL: Okay. Thank you.
7 MR. RAZAI: But with respect to certain ones -- with respect to
8 the housing module, you could have a housing that has certain electronics
9 modules wrapped within it and then put into that cavity and you still would
10 have a housing module -- electronics module, I apologize.
11 JUDGE MARSCHALL: I understand. But it's a layer on one side
12 of the structure that covers one or more electronics.
13 MR. RAZAI: You could have a layer on all sides as well.
14 JUDGE MARSCHALL: Wouldn't that wrap the entire thing?
15 MR. RAZAI: I mean, you could, I'm not saying that you would
16 necessarily. The argument isn't that you wouldn't encapsulate the entire
17 thing. The argument is that you -- that a skilled artisan would understand
18 how much to wrap to get the effect that the skilled artisan would like to get.
19 JUDGE MARSCHALL: So it could be entirely wrapped, but it
20 doesn't need to --
21 MR. RAZAI: It doesn't need to be entirely wrapped.
22 JUDGE MARSCHALL: Okay. I understand your position.
23 Thank you.

1 MR. RAZAI: Right. And then going to the state of the art, talking
2 about metal frames, we talked about the state of the art and all the drawbacks
3 of metal frames. Kokonaski-166 discloses metal frames. Kokonaski-999
4 discloses metal frames. Howell-158 discloses metal frames. The '541
5 Patent that we're discussing discloses metal frames. If all these -- if metal
6 frames were so terrible that you wouldn't want to do it, why are they in the
7 art?
8 And if Patent Owner wanted claims to plastic frames or to
9 insulated frames, it should have claimed that. But even still, there still
10 would have been a motivation to include an insulative layer for the reasons
11 that are set forth in the petition.
12 With respect to this thickness portion, there was a lot of discussion
13 about why. The patent has all this disclosure of why you would want it to be
14 thick, so does the petition. It sets forth that you would want the electronic
15 eyewear to get as close to regular eyewear as possible, to not be bulky, to not
16 be cumbersome. The why is there. What they complained about in the
17 context of the Patent Owner response and in their sur-reply is how.
18 Well, what we're saying is that the how would have been within
19 the skill of the art. Getting the optimal range, getting it below 0.7 was in the
20 art. How you would do it is within the skill in the art. This is 50, 60 years
21 of development and there is not a single bit of evidence from their expert
22 that says the skilled artisan would not know how to get that thickness to
23 where it needs to be.

1 If there's no other questions, Your Honors, I will rest my argument.
2 JUDGE MARSCHALL: It looks like that's it. Thank you for your
3 time.
4 MR. RAZAI: Thank you, Your Honors.
5 JUDGE MARSCHALL: We'll take a one-hour break now.
6 MR. AISIKU: I'm sorry. (CROSSTALK) --
7 JUDGE MARSCHALL: Oh, geez, I suppose you do get a few
8 more minutes. Oh, geez.
9 MR. AISIKU: I will try to keep it very quick, Your Honor. So I
10 just want to note one overarching issue with opposing counsel's arguments
11 on rebuttal. A lot of it is just unsupported attorney argument that has been
12 made on the fly today. For example, they talked about how everything
13 discloses metal frames. That's just false. Howell-596 doesn't disclose metal
14 frames.
15 Howell -- sorry, Kokonaski-166 only discloses metal frames with
16 certain -- I'm sorry, frames with certain portions that may have combination
17 or have elements of metal. And then similarly, Kokonaski-999 only talks
18 about there being conductive portions of a frame which then facilitates their
19 electrical components and functionality. And so that is a new argument, but
20 it's also just false.
21 Another thing that opposing counsel asked is about the form factor
22 and the standardization in Howell-596. And he asked, why does it matter?
23 The answer to that is the fact that Howell-596 is directed to a very sensitive

1 device that is supposed to be detecting UV radiation that a person is
2 encountering. So that also is a very important consideration and important
3 function in the first place.
4 And so if you have a malfunctioning UV detection sensor, that's
5 going to cause a lot of problems both with public, with health and with the
6 functionality of the device. And it talks about having access to the sunlight.
7 It talks about having the, again, regularized form factor. And simply using a
8 piece of tape, a double-sided sticky tape, doesn't meet those needs.
9 And then one other part, again, there's a lot of burden shifting by
10 opposing counsel because they talk about how a person of ordinary skill in
11 the art is not an automaton. They would have known how to do this; they
12 would have known how to do that. And our expert doesn't explain how a
13 person would not have been able to do that.
14 That's burden shifting, Your Honors. Their job is to articulate a
15 basis for why and how a person of ordinary skill in the art may combine
16 certain elements, not to simply rely on vague statements that a person of
17 ordinary skill in the art would have figured it out and then ignored all of the
18 deficiencies that we noted that such a combination would have created.
19 Other than that, I think -- if you can give me one moment, I
20 apologize, Your Honor. Oh, and then I just wanted to point to another point,
21 another argument that opposing counsel made. They said that the double-
22 sided sticky tape of Howell-158 doesn't need to encapsulate fully, that,
23 again, is a brand new argument. And there's no explanation as to how a

1 person of ordinary skill in the art would have decided how to make these on
2 the fly changes that Petitioner proposes today. None of that is described in
3 the papers or the expert report.
4 With that, I'm --
5 JUDGE MARSCHALL: I had a question -- I'll stop your time. I
6 had a question about Claim 18. And Petitioner's argument that the "why"
7 was known, that everyone of skilled in the art would have known that
8 achieving that thickness would have been desirable because that's a
9 thickness that's in frames without electronic components. Does Patent
10 Owner dispute that that was a known goal to make them as thin as possible
11 and 0.7 millimeters is one example of that?
12 MR. AISIKU: Yes, Your Honor. It was not -- there wasn't any
13 evidence in the papers or the expert report that it was a known goal to have a
14 side or a thickness of a portion of the housing module to be 0.7 millimeters,
15 so that specific desirability was not disclosed in the prior art. Now,
16 generally speaking (INDISCERNIBLE - TECHNICAL DIFFICULTY) of
17 the electronics need to be 0.7 millimeters.
18 JUDGE MARSCHALL: Thank you for your time. If there's no
19 further questions from my panel.
20 JUDGE O'HANLON: No further questions.
21 MR. AISIKU: Thank you, Your Honors.
22 JUDGE MARSCHALL: Now we've concluded the proceeding in
23 the -01071 matter. We'll take an hour break, return at about 12:45.

1 (Whereupon, the above-entitled matter went off the record at 11:48
2 a.m. and resumed at 12:45 p.m.)
3 JUDGE MARSCHALL: Okay. The public line is live. We're
4 going to resume our hearing. The case we'll be discussing next is IPR2024-
5 01069. And for this case, the parties have 40 minutes total per side.
6 Petitioner, would you like to reserve any time for rebuttal?
7 MR. RAZAI: Yes. I'm going to try to reserve about seven minutes
8 for rebuttal, Your Honor.
9 JUDGE MARSCHALL: Seven minutes. Okay. You may begin
10 when ready.
11 MR. RAZAI: Thank you, Your Honor. Going to Slide 2, this is
12 the '355 Patent. The specification of the '355 Patent is directed to, for
13 example, electronic focusing eyeglasses, electro-active eyeglasses, electronic
14 eyewear providing 3D capabilities. But if we go to the claim, the claim
15 stands for the unremarkable position for claiming regular electronics in an
16 eyewear.
17 One of the limitations in dispute here today is a conformal layer.
18 And what we'll see here just the one commonalities, you'll see that
19 Sikonowiz is present in all these grounds. And Sikonowiz is where we get
20 the conformal layer from.
21 Going to Slide 6. Sikonowiz's teachings relate to conformal
22 coating. For example, the purpose of a conformal coating is to cover a
23 printed circuit assembly and protect it from environmental hazards, such as

1 moisture, dirt, and chemicals. Of these, moisture protection is probably of
2 the greatest general significance.
3 Go to Slide 7. Sikonowiz -- there's an argument from the Patent
4 Owner that Sikonowiz is not analogous art because it's not from the same
5 field of endeavor and it's not reasonably pertinent to the problem faced by
6 the inventors of the '355 Patent. In support of this notion, Patent Owner
7 notes that Sikonowiz does not concern eyewear.
8 But let's step into -- just kind of take a step back and look at
9 analogous art broadly. And analogous art is a disjunctive test. One, it can
10 be from the same field of endeavor regardless of the problem addressed; and
11 two is that the reference is not within the same field of endeavor whether the
12 reference is still reasonably pertinent to the particular problem with which
13 the inventor is involved, and that's *In re Bigio*, 381 F.3d 1320.
14 Going on to Slide 9. The scope of analogous broad is -- analogous
15 art is construed broadly. And looking at the Federal Circuit's decision in
16 *Wyers* from 2010, the Supreme Court's decision in *KSR* directs us to
17 construe the scope of analogous art broadly, that's *Wyers v. Master Lock*,
18 616 F.3d 1231 at 1238. In *In re Bigio*, the Federal Circuit stated it's
19 necessary to consider the reality of the circumstances, in other words,
20 common sense when deciding analogous art, that's *In re Bigio* 381 F.3d 1320
21 with a pin site of 1326.
22 Sikonowiz is from the same field of endeavor as the '355 Patent.
23 The '355 Patent is directed to consumer electronics according to the petition

1 and to Dr. Feland, Sikonowiz is also directed to consumer electronics.
2 Moreover, on Slide 11, Sikonowiz is also reasonably pertinent.
3 References are reasonably pertinent if a person of ordinary skill would
4 reasonably have consulted those references and applied their teachings in
5 seeking a solution to the problem that the inventor was attempting to solve.
6 Slide 12, we see that the '355 Patent explains that an electronic
7 eyewear can suffer short circuits in environments with high humidity. And
8 as we saw earlier and we see again here, Sikonowiz explains that conformal
9 coatings protect PCBs and electronics from environmental hazards. In fact,
10 Sikonowiz considers moisture prevention to be of the greatest general
11 significance -- or of great general significance. Sikonowiz does focus on the
12 same problem as the '355 Patent.
13 Let's look at what Patent Owner's expert said. His testimony
14 supports that Sikonowiz was reasonably pertinent. At page 30, lines 1
15 through 10 of his transcript. Would a POSITA have considered a conformal
16 coating as a solution to address the issue of high moisture and liquids in
17 electronic eyewear prior to the '355 Patent? The answer, conformal layer is
18 very common. And he said he wouldn't be surprised if others had attempted
19 to use that to make moisture resistant electronics potentially an eyewear.
20 Same transcript, page 48, lines 4 through 12. If a student
21 approached you and asked you for resources about conformal coatings prior
22 to 2006, what resources would you have directed the student to? Well,
23 there's many textbooks on creation of printed circuit boards and their

1 protection, I think there's two in our exhibits; well, Sikonowiz is one of
2 them. Sikonowiz is reasonably pertinent, and this is Patent Owner's expert,
3 not the Petitioner's expert.
4 Patent Owner misapplies *In re Bigio* and relies on that for the
5 proposition that Sikonowiz must reference eyewear to be in the same field of
6 endeavor as the '355 Patent. In *In re Bigio*, the Federal Circuit held that a
7 reference describing toothbrushes was in the same field as endeavor as a
8 reference describing hairbrushes. There's no requirement that Sikonowiz
9 mention eyewear to be analogous art.
10 Go to Slide 15. In its sur-reply, Patent Owner argues for the first
11 time that a POSITA would immediately dismiss Sikonowiz's discussion of
12 conformal coatings for bulky cumbersome integrated circuit chips as
13 outdated and irrelevant to the small form factor sophisticated circuit designs
14 demanded by consumer electronics. They don't provide any support for the
15 statement; they just say it.
16 But let's look deeper. Sikonowiz describes the identical conformal
17 coatings described in the '355 Patent. Looking at Sikonowiz for printed
18 circuit applications, the most important coatings are, for example, underlined
19 are epoxy, acrylic, polyurethane, silicone. Those are the same things that the
20 '355 Patent discloses. I don't understand why it wouldn't be applicable.
21 Moving on to Slide 17. Given the foregoing, it's unsurprising that
22 again Patent Owner's own expert admitted that conformal coatings were very
23 common, very standard applications for moisture proofing PCBs. It also,

1 again, admitted that he wouldn't be surprised if someone else had already
2 done it. PO's argument that conduits is somehow inapplicable fails.
3 Going to Slide 18. The '355 Patent uses a conformal layer to
4 protect against moisture. The petition clearly explained that a POSA would
5 be motivated to use Sikonowiz's conformal coating for the exact purpose.
6 Further, and contrary to Patent Owner's unsupported speculation, Petitioner's
7 expert testified that Sikonowiz is absolutely applicable to eyewear.
8 He testified that a POSA would have had reasonable expectation of
9 success because conformal coatings were commonplace with PCBs as early
10 as the 1980s and into the 2000s. Also, Patent Owner's suggestion that the
11 PCBs of Sikonowiz are too, quote, "bulky" or, quote, "cumbersome" is
12 undermined by Dr. Feland's testimony that conformal coatings remained
13 common well into the 2000s, by which time PCBs had already become
14 generally smaller.
15 Now, the next argument has to do with the motivation that
16 combines Sikonowiz with various other references. Slide 21, the petition
17 lists several motivations to combine Sikonowiz with the primary references.
18 These are recited on -- at the petition paragraphs 24 -- sorry, pages 24 to 26
19 and given that I have over 80 slides, I'm not going to read these.
20 Slide 22, Patent Owner argues that a POSA would not be
21 motivated to combine Howell-719 in Sikonowiz because a POSA would
22 interpret Sikonowiz as requiring the entire PCB to be coated with a
23 conformal layer. And the conformal layer would impair the speaker's

1 functionality because the speaker is on the PCB. Now, this argument fails
2 for multiple reasons.
3 Going to Slide 24, Howell-719 does not require mounting the
4 speaker to the PCB, but the electronics can be on the PCB. Similarly,
5 Petitioner explained that the electronics mounted on the PCB can be
6 connected to offboard electronic components, for that independent reason it
7 fails.
8 Next, again, we discussed this earlier with respect to the '541
9 Patent to post as not an automaton. You would understand what to coat and
10 what not to coat so as to not a pair functionality.
11 Slide 26. Sikonowiz and Dr. Feland explained that a POSITA
12 could mask portions of the PCB to ensure that they're not coated. In other
13 words, even if the speaker were on the PCB where it's not required it doesn't
14 have to be coated. And Patent Owner's own expert testified that prior to
15 2006, a POSA would know not to code an electrical connection because they
16 would impair it.
17 JUDGE O'HANLON: Mr. Razai, let me interrupt you for a
18 minute. But you're saying the speaker doesn't necessarily have to be on the
19 printed circuit board. Excuse me. But does the petition say it is? I'm
20 looking at page 20 of the petition. It talks about the audio system can
21 contain certain pieces of electronics, and then you have a quote here, "All
22 the electronics for the radio are at least --" I'm sorry, "the electronics can be
23 on a printed circuit board."

1 MR. RAZAI: Can be.
2 JUDGE O'HANLON: So what is your petition saying, they are,
3 they are not, or --
4 MR. RAZAI: The petition is with respect to where the speaker is.
5 It's irrelevant with respect to the conformal coating. The conformal coating
6 is supposed to be on the PCB, encoating the PCB, for example. And with
7 respect to the arguments that were made by the Patent Owner, they argued,
8 well, you would necessarily quote the speaker, for example, that impairs
9 functionality. And the responsive argument to that is that, first of all, there's
10 no requirement that the speaker have to be mounted on there, so it's -- there's
11 not some problem that's created by conformal coating. That's the initial
12 position.
13 JUDGE O'HANLON: Well, the -- and that was why I asked the
14 question. I'm just looking at the language in the petition. And arguably, it
15 can be read to say that -- well, you have here, in quotes -- "electronics can be
16 on a printed circuit board." So are you saying the electronics, including the
17 speaker, are on the printed circuit board?
18 MR. RAZAI: So there, we're saying that they can be, there's no
19 requirement. And again, when they -- if they are on the printed circuit
20 board, a person of ordinary skill in the art would know how to coat it
21 -- would know how to coat the PCB without affecting the function of the
22 speaker.
23 JUDGE O'HANLON: Thank you.

1 MR. RAZAI: Moving on to Slide 28, the use of a capacitive touch
2 switch. Patent Owner next argues that a POSA would not apply Sikonowiz
3 conformal layer because it would interfere with the functionality of the
4 capacitive touch switch, very similar to the arguments that were made for the
5 speaker. But again, those arguments all fail for several independent reasons.
6 Again, Howell-719 doesn't require mounting the capacitive touch
7 switch to the PCB. It says that the electronics for controlling the speaker can
8 be on the PCB. Thus, coating the PCB would not necessarily require coating
9 the capacitive touch switch. Similarly, in his declaration, Dr. Feland noted
10 that the electronics for controlling the speaker, for example, the capacitive
11 touch switch, need only be operably coupled to the speaker, not physically
12 coupled.
13 Slide 31, again, same automaton language. As we've discussed
14 already, a POSA would know to mask off portions of the PCB or portions of
15 electronics if for some reason their functionality will be impeded by a
16 conformal coating. Conformal coatings having been around for 30, 40, 50
17 years at this point.
18 Thus, even if the petition or the claims required the capacitive
19 touch switch, or as Judge O'Hanlon pointed out, the speaker to be on the
20 actual PCB,the POSA would understand how to mask off those portions so
21 as to not affect functionality if the functionality would be affected by the
22 conformal coating.
23 Going to Slide 32. Howell-719 doesn't require mounting the

1 capacitive touch switch of the PCB. It says that the electronics for
2 controlling the speaker can be on the PCB.
3 Slide 33. Even if the capacitive touch switch was required to be
4 mounted, the PCB coated, the argument would still fail. Because as noted
5 by Dr. Feland, the conformal coating wouldn't necessarily destroy the
6 capacitive touch switch, it could protect it.
7 If we go to Slide 34, we see that the '355 Patent itself talks about
8 protecting the capacitive touch switch with a conformal coating. So any
9 arguments that it would necessarily destroy it are actually negated and
10 contradicted by the patent itself.
11 Going to Slide 35, Patent Owner argues that the combination of
12 Sikonowiz and Blum-130 would be inoperable because Blum-130 discusses
13 the need to reprogram the controller chip, and the conformal layer would
14 interfere with that reprogram. And the Patent Owner also notes that
15 conformal coating would interfere with the repairs of Blum-130's controller.
16 But again, that argument also fails for several reasons. Blum-130
17 doesn't require a reprogrammable controller. In fact, it describes a read-only
18 type controller that is replaced rather than reprogrammed, that's an
19 alternative embodiment. Patent Owner's argument is thus based on a false
20 premise.
21 In Slide 38, we see that in response to Patent Owner's argument
22 that the conformal layer would interfere with Blum's replaceable controller.
23 They argued that the conformal layer would also interfere with this

1 replaceable controller because conformal layers are hard to remove.
2 Now, this argument was raised for the first time on sur-reply, but
3 I'll address it here. Second, Patent Owner merely posits that the
4 reprogrammable controller could prevent or hinder the operation of the
5 controller, not that it would.
6 Going to Slide 39, regardless, Patent Owner's argument is entirely
7 refuted by Sikonowiz, which specifies that acrylic conformal coatings are
8 desirable when repair work is needed and that components remain accessible
9 for adjustments or repair when certain conformal layers are used.
10 Go to Slide 40, even if the Patent Owner were correct that the
11 conformal layer would make Blum less convenient to repair or hinder the
12 replaceability his controller, the patent argument -- the Patent Owner's
13 argument would still fail because the mere disclosure of alternative ways of
14 doing something don't necessarily teach away from it.
15 Going to Slide 42 now -- or sorry, Slide 41, we're going to Ground
16 6. Now that we've discussed Sikonowiz, I'd like to get into the specific
17 grounds and go through some of those in a little bit more detail with respect
18 to the arguments that were made by the Patent Owner.
19 Slide 42. The only dispute with regards to Claim 6 is the
20 capacitive touch switch of Claim 14. Now, the petition sets forth the
21 motivation to replace one of the multiple switches topped by Blum-130 with
22 the capacitive touch switch in Howell-719. The petition explains that a
23 POSITA would be motivated to make the combination for several different

1 reasons and those are explained in the declaration paragraph 148 to 149 as
2 well as the petition 54 to 56, that includes the capacitive touch which is are
3 not susceptible to wear, fatigue, and loosening due to mechanical movement.
4 They permit glasses to have a switch without disrupting the typical
5 smooth, slim profile of the glasses. And they eliminate the need to carry a
6 second device to remotely control the lens. And it's a known option for
7 decades to use a capacitive touch switch. There's nothing new there.
8 Relying on *Xerox*, the Patent Owner argues that Petitioner's expert
9 testimony is insufficient to support the stated motivations to combine. But
10 the reliance on *Xerox* is misplaced. In *Xerox*, the Court -- the PTAB said,
11 the expert can't use his common knowledge to supply a missing element.
12 But providing a motivation to combine is precisely what the expert is there
13 to do, and *Xerox* actually expressly says that.
14 Moving on to Slide 46, Patent Owner next relies on attorney
15 argument to claim that a POSITA wouldn't have been motivated to use a
16 capacitive touch switch because it wouldn't have been suitable for Blum-
17 130's electro-active eyewear. But Patent Owner argument fails because the
18 Patent Owner doesn't suggest that Blum-130 teaches away or that Howell-
19 719 teaches away. The unsuitability arguments really aren't couched under
20 any area of law that I can actually respond to and be happy to reply if there's
21 in the rebuttal if it comes up.
22 The Patent Owner also argues that the combination fails because
23 Blum-130 and Howell-719 are not analogous to each other. But it's accepted

1 principle that they don't have to be analogous to each other, just analogous to
2 the patent, which has been established.
3 The Patent Owner next argues that the combination of Howell-719
4 and Blum-130 fails because Blum-130 discloses a specific alternative to the
5 manual switch, i.e., an eye tracker. But again, the mere disclosure of
6 alternative designs doesn't teach away the mere disclosure of alternative
7 designs. The Court has further explained that just because better alternatives
8 exist -- and there's no saying here that an eye tracker is a better alternative,
9 it's just an alternative -- it doesn't mean that inferior combination is inapt for
10 obviousness purposes. We're not even saying the capacitive touch switch is
11 inferior; even if it were, that argument would still fit.
12 Moving on to Slide 50, we're going to get into this continuous
13 variance argument and accusations of pivoting our new arguments. And let's
14 go through the history of this argument. In the petition -- this is Slide 51.
15 The petition states that a POSITA would be motivated to combine Blum-130
16 and Howell-719 because the capacitive touch switch would accommodate
17 frequent switching operations to change the focal distance of a lens.
18 In the Patent Owner response, Patent Owner argues that Howell-
19 719's capacitive touch switch would not be implemented because it couldn't
20 accommodate Blum-130's requirement for continuous variance. In the reply,
21 we pointed out that Blum-130 doesn't require continuous variance. In fact,
22 Blum is explicit that is in the simplest embodiment, the focal lens can be
23 changed by either an off or an off -- or an on position. And in one position,

1 they have one focal length; in a different position, they have a different focal
2 length.
3 Slide 54. The Patent Owner argues that the Petitioner pivoted to
4 the simplest embodiment of Blum. Not so, the petition's motivation to
5 combine was premised only on changing focal length, which can be
6 accomplished by this simple on/off function. It doesn't depend on any
7 continuous variance. PO's allegations of pivot lack merit. It was only in
8 response to, well, there's continuous variance. And the response was
9 continuous variance is not required; it can be accomplished by on or off.
10 Going to Slide 55. PO also argues that enabling a continuous
11 variance with a capacitive touch switch would require a very complex touch
12 switch with slide capabilities, which would have been cost prohibitive. But
13 as discussed above, Blum-130 doesn't require continuous variance.
14 Even if it did, the law does not exclude from an obviousness
15 determination solutions which are more complex, and that's in *Polaris*
16 *Wireless v. TruePosition*, IPR2013-00323, Paper 62 at 36; and *Orthopedic*
17 *Equipment v. United States*, 702 F.2d 1005 with a pin site at 1013.
18 Moving on to Slide 57, we're going to hit Claim 13. Claim 13 is a
19 method claim. But the Patent Owner disputes that the prior art discloses the
20 method. As an initial matter, prior art is prior art for everything that it
21 teaches. An example of that site is *Bradium v. Iancu*, 923 F.3d 1032,
22 pinpoint 1049.
23 Moving on to Slide 61. But Howell-719 and Blum-130 each

1 disclose a method. Slide 62. Howell-719 discloses a method of
2 manufacturing. It explains that the invention can be implemented in
3 numerous ways, including a method. It also explains that certain well-
4 known methods have been omitted to avoid unnecessarily obscuring aspects
5 of the invention.
6 Slide 63. Similarly, Blum-130 discloses a method. In fact, its title
7 is method. It also describes method steps, like attaching. Finally, Claim 27
8 of Blum-130 claims a method for constructing glasses.
9 Slide 64. The Patent Owner hasn't pointed to anything specific
10 about the claimed method in a '355 Patent that somehow advances some
11 method over the disclosure of these various different structures that are also
12 in the references. And again, based on *Abbott Labs v. Andrx* and *In re*
13 *Epstein*, that argument fails for that independent reason as well.
14 Moving on to Claim 14, I'm on Slide 65 now. Slide 66. As we can
15 see here, Claim 14 requires both an accelerometer, gyroscope, and a
16 capacitive touch switch. There was some disclosure in the -- some
17 information in the institution decision that had some -- that raised some
18 questions on this issue as well, so I'd like to get into it a little bit further.
19 In Ground 5, Howell discloses everything, including multiple
20 sensors and switches, but it doesn't disclose using an accelerometer or
21 gyroscope. Blum-130 discloses microscope -- a micro gyroscope or micro
22 accelerometer in the temple to allow the wearer to use head movement to
23 change the functionality of the glasses or control the switch. It would have

1 been obvious to add Blum-130's accelerometer, gyroscope in place of one of
2 the switches disclosed in Howell-719.
3 The Patent Owner makes the same argument against Grounds 4
4 and 5, that the combination improperly eliminates the claimed capacitive
5 touch switch. But going to Slide 69, Howell-158 disclosed an
6 accelerometer-based worn sensor. Howell-719 disclosed a magnetic ready-
7 to-be-worn sensor.
8 For Ground 4, the petition proposes substituting the magnetic
9 sensor of Howell-719 with the accelerator-based switch of Howell-158.
10 There's no substitution of Howell-719's capacitive touch switch. It preserves
11 both. The combination would have both the capacitive touch switch and the
12 accelerometer.
13 Going to Ground 5, the petition explains that Blum's accelerometer
14 would be incorporated to Howell-719's glasses in place of a physical switch.
15 There was a lot of disclosure about physical switch versus capacitive touch
16 switches in the briefing, and I'll rely on the briefing for that. But capacitive
17 touch switch is not a physical switch. And that's one of the motivations why
18 you would want to use it is to avoid the drawbacks of a physical switch. The
19 substitution doesn't replace the capacitive touch switch.
20 But even if Petitioner did propose replacing one of Howell-719's
21 capacitive touch switches with an accelerometer, the Patent Owner's
22 argument would still fail because Howell-719 repeatedly explains that his
23 glasses can have multiple switches. Thus, replacement of one switch with

1 an accelerometer wouldn't necessarily eliminate the claimed capacitive touch
2 switch, and that's Howell-719 at paragraphs 93, 74, 87, 62, and 75.
3 Moving on to Slide 72. The Patent Owner admits that Howell-719
4 discloses multiple switches but contends for the first time that Howell-719
5 doesn't disclose using two different types of switches. The Patent Owner
6 also argues it wouldn't be obvious to have switches of different types. But
7 these arguments are unsupported attorney argument. But moreover, they're
8 actually inconsistent with the Howell-719's disclosure, which expressly
9 discloses the use of multiple switch types, paragraphs 75, 87, and 93.
10 Getting into the Eichelberger grounds. In contrast to Ground 6,
11 Ground 7 relies on Eichelberger's disclosure of a capacitive touch switch
12 instead of Howell-719. Patent Owner's first argument has to do with
13 analogous art. First, Patent Owner argues that Eichelberger is not from the
14 relevant field of endeavor because it doesn't explicitly disclose eyewear.
15 Again, general test for analogous art and the fact that it's broad.
16 The scope -- the '355 Patent is clearly directed to consumer
17 electronics and so is Eichelberger. Next, Eichelberger is reasonably
18 pertinent to the problem being solved. Based solely an attorney argument,
19 the Patent Owner speculates that Eichelberger is not reasonably pertinent
20 because its 1980s designs would likely have been inapplicable to demands of
21 complex moisture-proof eyewear. No support for that.
22 But Dr. Feland's unrebutted testimony on this point explains that
23 capacitive touch switches have been known for decades, including in

1 electronic eyewear. Dr. Feland explains that combining Eichelberger with
2 Blum-130 will be a simple substitution of one known switch for another
3 known switch.
4 Slide 85. Patent Owner's argument is also undermined by the '355
5 Patent itself, which clearly voices a concern with moisture proofing
6 consumer electronics. This is precisely what Eichelberger is concerned
7 with, as evidenced in this side-by-side juxtaposition of Eichelberger against
8 the '355.
9 Patent Owner's final argument is that even if Eichelberger was
10 analogous, it wouldn't -- it would be an inappropriate mechanism by which
11 to implement the continuous various functionality. But again, we've already
12 discussed there's no continuous variance that's required by Blum-130 and
13 that argument likewise states.
14 If there are no other questions, I will reserve the remainder of my
15 time for rebuttal.
16 JUDGE MARSCHALL: Okay. Thank you.
17 MR. RAZAI: Thank you, Your Honors.
18 JUDGE MARSCHALL: If you could please introduce yourself
19 since this is your first appearance here today.
20 MR. EUTERMOSER: Good afternoon, Your Honor. My name is
21 Brian Eutermoser with King & Spalding and on behalf of E-Vision Labs.
22 JUDGE MARSCHALL: Would you like to reserve any time for
23 rebuttal today?

1 MR. EUTERMOSER: I'd like to reserve 10 minutes, Your Honor.
2 I'd like to start with Claim 14. So I have Slide 4 up on the board. And it
3 should be clear by now. Claim 14 requires that two things be present in
4 addition to the conformal coating that we've talked a lot about. Claim 14
5 requires both the accelerometer or a gyroscope and also a capacitive touch
6 switch. Now, the problem with two and potentially all four of Petitioner's
7 grounds directed to Claim 14 is it eliminates the capacitive touch switch.
8 So Slide 5 has a summary of the different grounds. I won't dwell
9 on this because I think Counsel went through those at some length.
10 Okay. So let's take a look at -- actually, let's not start with that.
11 And take a look at Petitioner Slide 70 and specifically Ground 5. And this
12 sets forth Petitioner's combination for Ground 5 and their motivation for
13 combining Howell-158 -- or excuse me, Blum-130 with Howell-719. And
14 we see that they refer to a simple substitution of the accelerometer and
15 gyroscope-based motion detector for a component, physical switches serving
16 the same purpose.
17 Now, so we see Petitioner substituting out a component, which it
18 describes as physical switches, from Howell-719 and replacing it
19 -- replacing them with an accelerometer/gyroscope-based motion detector.
20 If we go back to Patent Owner Slide 7, you see, this is the problem
21 that the Board noted in its institution decision where it specifically
22 recognized that replacing Howell-719's physical switch with Blum's
23 accelerator/gyroscope-based motion detector eliminates the capacitive touch

1 switch, and therefore one of the required elements of Claim 14.
2 Now, Petitioner doesn't directly address the Board's decision in its
3 reply. It instead argue that the petition didn't really propose substituting out
4 Howell-719's capacitive touch switch. Well, there are two problems with
5 that argument. First, there is no support for Petitioner's belated attempt to
6 distinguish between a capacitive touch switch on the one hand and a
7 physical switch on the other.
8 So Counsel kind of glossed over that distinction and said there was
9 a lot of briefing as to the fact that allegedly a capacitive touch, which is not a
10 physical switch. Well, the only briefing came from Petitioner. There is no
11 basis, there is no evidence in the record to support any such distinction.
12 Dr. Feland, Petitioner's own expert, distinguishes a capacitive
13 touch switch from a mechanical switch, arguably from a manual switch, as
14 you can see in Petitioner's Slide 70 at paragraph 148 of his declaration,
15 Exhibit 1002. But he never distinguishes and makes no attempt to
16 distinguish a capacitive touch switch from a, quote, unquote, "physical
17 switch." That distinction is solely attorney argument concocted for purposes
18 of its reply and for this argument by Petitioner's counsel.
19 Now, I'll just point out, without a slide for this one, in the reply at
20 page 16, Petitioner is misleading on this point. Petitioner says that Dr.
21 Feland effectively testifies that a capacitive touch switch is not physical.
22 One of the things they cite is the same paragraph 148 of his declaration.
23 Again, that is not Dr. Feland's testimony. He does not address the term

1 physical switch as it relates to a capacitive touch switch.
2 The other problem with this alleged distinction between a
3 capacitive touch switch and a physical switch is it contradicts Howell-719
4 itself -- I'm not good at navigating this thing, apologies, Your Honors. So if
5 we look back at Patent Owner's Slide 8, we see disclosures from Howell-719
6 in paragraph 81 and 82. And note that in both of these paragraphs, you have
7 Howell-719 referring to the switch, implying a single switch or type of
8 switch. And in particular what's described here is a switch that can be
9 activated depending on electrical forces 158, and that's in paragraph 82, such
10 that in one embodiment the electrical force depends on capacitive effect.
11 Now, what that's saying is you have a single switch -- a single type
12 of switch, a single function that the switch might control. But you could
13 have different, essentially, embodiments of that single switch. That is what
14 Howell-719 is disclosing.
15 Okay. So I mentioned there are two problems with this issue with
16 trying to describe a -- or distinguish between a capacitive touch switch and a
17 physical switch. Second one is that, again, Howell-719 discloses the
18 capacitive touch switch as one of several options for a single physical
19 switch. And that's what I just described in part based on these disclosures
20 we're looking at in paragraphs 81 and 82 of Howell-719.
21 Now, Petitioner takes issue with that and points to various
22 disclosures in Howell-719. The Petitioner contends show the disclosure of
23 multiple switches or types of switches or functions performed in a single

1 embodiment of 719. Let's take a look back at those disclosures. This is
2 Petitioner's Slide 71. If we look at the snip in the top left portion of the
3 slide, that's from paragraph 93 of Howell-719, the extent that Howell-719
4 discloses pairs of switches, we see our switches providing the same
5 functionality and that are controlled in the same manner.
6 So we see two mechanical switches, but both are performing the
7 same function, volume control of the speaker, for example. And that's true
8 of all the disclosures that Howell-719 makes concerning multiple switches
9 or at least those cited by Petitioner in his petition and its reply in here today.
10 So turning ahead to Petitioner's Slide 73. Now, again, this
11 paragraph 75 clarifies or confirms what I just described. You have a single
12 switch -- or a single switch performing a single function, albeit it can be
13 acted upon by various forces, including mechanical, radiation, magnetic,
14 electrical, et cetera.
15 Paragraph 87 says the same thing. Switch can provide different
16 degrees of ranges or controls, although each perform generally the same
17 control, each the same function -- general function of the device.
18 Figure 4 in Howell-719, which I won't put up on the screen, shows
19 essentially the same thing that's described here in paragraph 75, where you
20 have a single switch or single type of switch with various activation forces
21 acting on that same -- that single switch.
22 So let's go back to Petitioner's own description of its Ground 5
23 combination. So again, we saw Petitioner referring to replacing Howell-

1 719's component physical switches with the motion detector of the
2 secondary reference. And so I would submit that this was not an oversight.
3 This was an implicit acknowledgment that what Howell-719 is disclosing as
4 an embodiment with only a single type of switch controlling a single
5 operator.
6 And so once -- so the Board -- in other words, the Board was
7 correct to recognize that once you substituted out Howell-719's switch, there
8 is nothing left to satisfy the capacitive touch switch limitation of Claim 14.
9 So turning to Ground 4, Petitioner does not make that same implicit
10 acknowledgment. But Petitioner's combination suffers for the same
11 deficiency as Ground 5, and that's because of what I just described.
12 You have Petitioner here substituting out Howell-719's ready-to-
13 be-worn detector, replacing it with an accelerometer-based being-worn
14 detector from Howell-158. Again, you're removing the capacitive touch
15 switch that's required in Claim 14.
16 And note in Petitioner's description of Ground 4, like its
17 description of Ground 5, Petitioner does not propose adding a being-worn
18 detector from Howell-158 or any other switch to Howell-719. The proposed
19 combination substitutes one for an existing switch. And again, because
20 Howell-719 discloses only a single switch, that has the effect of eliminating
21 any possibility of a capacitive touch switch in Petitioner's proposed
22 combination.
23 JUDGE O'HANLON: Mr. Eutermoser, I'm not so sure about this

1 Ground 4. To me, reading the petition, it seems to say the capacitive touch
2 switch -- I'm looking at page 48 of the petition -- is operably coupled to the
3 speaker to control the speaker. And then when it talks about the -- sorry, I
4 lost -- when it talks about using the accelerometer, the gyroscope, that is for
5 the ready-to-be-worn sensor. So this Ground 4 seems to address two
6 different sensors, which I think is a little different than the Ground 5
7 mapping.
8 MR. EUTERMOSER: I'm sorry, where were you looking, Your
9 Honor? You said page 48 of the petition?
10 JUDGE O'HANLON: Right. Page 48 of the petition discusses the
11 capacitive touch switch being used to control the speaker, whereas the
12 accelerometer is being used to detect when the glasses are being worn. So to
13 me, that's referring to two separate sensors, which I think is a distinction
14 from Ground 5.
15 MR. EUTERMOSER: Well, that might be what the petition is
16 describing, but that's mischaracterizing Howell-719. Based on disclosures
17 that I've been referring to and the Petitioner put up on the slides, Howell-719
18 is describing a single switch performs a single function. Now, it could be a
19 pair of functions of like-type, but what Howell-719 discloses a single switch.
20 So to the extent the petition suggests otherwise, it's inconsistent
21 with the expressed disclosure of Howell-719. And Petitioner doesn't
22 propose any basis for modifying Howell-719 to incorporate two different
23 types of switches that perform two different functions and then replacing one

1 of them with an accelerometer-based switch from a different reference.
2 JUDGE O'HANLON: So is it your position that the ready-to-be-
3 worn sensor and the radio control -- oh, I'm sorry, ready-to-be-worn switch
4 -- or maybe it is a sensor and the capacitive touch switch are the same?
5 There's only one, that's -- a singular switch?
6 MR. EUTERMOSER: What Howell-719 discloses is -- let's say,
7 you want to control -- you want volume control. There is a single control for
8 volume control. Now, it might be two speakers, so two separate dials if it's a
9 manual switch. What Howell-719 discloses is, okay, if you don't want to use
10 the manual switches, you could have a different force acting on the switch
11 that controls the volume or the frequency or whatever, and that could be a
12 being-worn switch. In other words, an accelerometer-based sensor where it
13 uses a head movement to interpret -- to trigger the change of volume or
14 whatever.
15 JUDGE O'HANLON: So you read ready-to-be-worn sensor as
16 controlling the speaker. Is that what you were just saying?
17 MR. EUTERMOSER: Controlling some functionality. Now,
18 Howell-719 does describe, I think, fairly potentially different operations, but
19 only one in any particular embodiment. So if we take the speaker example,
20 then the being-worn switch -- is that -- I want to make sure that I'm using the
21 right terminology here. Right. What I'm saying is what Howell-719
22 discloses is the ready-to-be-worn switch is -- would be used in lieu of
23 mechanical switch controlling the speakers.

1 JUDGE O'HANLON: Okay. I think I understand your position.
2 Thank you.
3 MR. EUTERMOSER: If we look back at Patent Owner's Slide 8,
4 which I think this just repeats the discussion we just had, Your Honor. But
5 if I didn't say it before, paragraphs 81 and 82 and, again, these are
6 paragraphs that Petitioner relies on as allegedly disclosing multiple switch
7 types in a single embodiment. It's clear from the broader discussion -- or the
8 broader specification within Howell-719 that they refer back to paragraph
9 75, for example, which has essentially there is "a switch" or "the switch" that
10 can be activated by different forces.
11 And then there's the subsequent paragraphs through and including
12 paragraphs 81 and 82 say, essentially, "the switch" can be activated in
13 different ways. But there is never a second switch type, never a separate
14 controller in 719 that could be replaced with a different type of switch or a
15 second type of switch.
16 So again, so ultimately, while the Petitioner set out its grounds
17 differently and it made more clear in 5, I think, than 4 that was substituting
18 the one capacitive touch switch out of Howell-719. They have the same
19 problem with Ground 4 because of what Howell-719 discloses.
20 So if we turn to Ground 6 -- I'll get there in a second, Your Honor.
21 Now, so this combination uses Blum-130 as a base reference. I'll set aside
22 Sikonowiz for now because we'll turn back to the conformal error in
23 connection with different grounds. But in Ground 6, Petitioner uses Howell-

1 719 for the capacitive touch switch limitation. There is not a capacitive
2 touch switch in Blum-130. Petitioner says in his petition that it is adding or
3 substituting this capacitive touch switch from 719.
4 Now, they explained that combination in pages 53 to 55 of the
5 petition, and it's not clear whether they're adding or substituting. They say
6 both -- actually, they say specifically incorporating Howell-719's capacitive
7 touch switch into Blum-130 would constitute a simple substitution or
8 addition.
9 And their basis for making that combination or that addition or
10 substitution is conclusory. It lacks specificity and rests on hindsight. And
11 we can see that -- if I can find it -- the only basis, if you look at the petition
12 at 54 and 55, is Dr. Feland's testimony where he does not cite to any
13 evidence whatsoever. It's his speculation.
14 And notably, if you look at Patent Owner's Slide 10, it's almost
15 verbatim. And one of the paragraphs in Dr. Feland's declaration is in fact
16 verbatim taken from -- apparently copied directly from the petition. So we
17 see that here on this slide, Slide 10, comparing page 54 of the petition with
18 Dr. Feland's declaration of paragraph 148.
19 Now, as I mentioned, there are two problems with this testimony
20 and it being the sole basis for Petitioner's motivation to combine. The first is
21 that Dr. Feland doesn't cite any supporting evidence. And for that reason
22 alone, under cases like *ActiveVideo Networks* cited at page 23 of the Patent
23 Owner's response and *Magnum Oil Tools* cited on the same page, it's entitled

1 to little, if any, weight.

2 Now, Petitioners counsel talked about the *Xerox* case. Contrary to
3 Petitioner's suggestion, Patent Owner isn't citing *Xerox* for the idea that
4 -- Patent Owner is not suggesting that Dr. Feland is supplying a missing
5 limitation. But the rationale of *Xerox* applies with equal force to a -- an
6 expert -- to expert testimony, providing a missing motivation to combine. It
7 still must be supported with evidence. And in this case, it is not and should
8 not be able to form the basis for Petitioner's motivation to combine.

9 *Xerox* is relevant also because it notes clearly that the -- an expert's
10 testimony that is just copied directly from the petition, it's essentially
11 expertizing an attorney argument without any further explanation, evidence,
12 anything else is also entitled to no weight, so that's a second problem.
13 Essentially, it's just -- it's taken directly from the petition, and it doesn't have
14 -- cite any evidence of its own. And that's why *Xerox* is relevant to this
15 argument.

16 So if we look at the substance of Petitioner's motivation to
17 combine, we see disclosures from Blum-130 that explain why -- or at least
18 support Patent Owner's argument that a person of ordinary skill would not
19 have been motivated to replace a mechanical switch in Blum-130 with a
20 capacitive touch switch, as Petitioner urges from Howell-719.

21 And we see this explicit disclosure in Blum-130 at 2855 through
22 58 where the switch provides continuous variance, which makes sense given
23 Blum-130's disclosure of electromagnetic -- or excuse me, blanking on the

1 term, but lenses where you need to modify the focal length. And I recognize
2 and Petitioner is very focused on the simplest embodiment, which Blum-130
3 describes, where you can have an on/off switch. And in that instance, for
4 example, you would be switching between reading glasses and regular
5 glasses.
6 But the generally speaking Howell-71 -- or excuse me, Blum-130
7 is directed to variable focal length glasses and that's why they describe a
8 mechanical switch so you can have a continuous variance across that range.
9 And even in the simple embodiment, you still have a switch with two
10 different positions. There is simply nothing in Blum-130 that suggests
11 replacing its mechanical switch or any of the other alternatives it discloses
12 with the capacitive touch switch.
13 Again, this simplest embodiment was not cited in the petition.
14 Petitioner relied on the -- this disclosure here, essentially, the continuous
15 variance of the focal length. That was the basis for their combination.
16 Now, Petitioner spends a lot of time on -- or essentially seeking to
17 disregard Patent Owner's argument as to why a person of ordinary skill
18 would not have been motivated to add a capacitive touch switch. Well,
19 again, there's no supported rationale in the petition for doing so at all.
20 Petitioner's argument amounts to speculation from its attorneys and its
21 expert that the capacitive touch switch because it doesn't have any moving
22 parts, it's less prone to failure. That's the argument.
23 And then Petitioner discounts all of Patent Owner's evidence as to

1 why a person of ordinary skill would not have been motivated to replace
2 mechanical switches or a mechanical switch in Blum-130 with a capacitive
3 touch switch. Now, I would submit that the factfinder, the Board here,
4 should consider evidence going both ways, at least if it's supported by
5 appropriate expert testimony. And Patent Owner provided that, Petitioner
6 didn't.
7 But even if Petitioner had properly supported Dr. Feland's
8 testimony, that would show potentially a reason to combine, potentially.
9 What Petitioner would have pointed to was a reason why a person of
10 ordinary skill could have added capacitive touch switch. Petitioner never
11 explains why it would have -- other than the mechanical -- the failure issue,
12 Petitioner provides no reason why a person of ordinary skill in the art would
13 have chosen that versus any other option.
14 Turning to Ground 7 briefly, which adds Eichelberger in place of
15 Howell-719. Even if Eichelberger were analogous, even if there were
16 motivation to combine, combination would fail for the same reason the
17 Ground 6 combination did. There's no good reason to substitute the
18 capacitive touch switch for Blum-130's mechanical switch.
19 There's also the problem that Eichelberger is in fact not analogous.
20 Petitioner alleges that it's from the same field. Well, that's defining the
21 fields -- granted, the field can be defined broadly, but that is a definition of
22 the field that's so broad as to lose all meaning. It's not just consumer
23 electronics. Eichelberger, like Sikonowiz, is directed to a component of an

1 electrical system, not even consumer electronics more generally.
2 It's hard to see what within the field of electronics more generally
3 or printed circuit boards would be excluded from that field, which is why the
4 proper definition of the field is the one set forth in the '355 Patent, eyewear.
5 So if Eichelberger's not from the same field, then it would have to be
6 reasonably pertinent to be included in Petitioner's Ground 7 combination.
7 Well, Eichelberger does not address whether, when, or how you
8 might incorporate a capacitive touch switch into eyewear or anything else.
9 What Eichelberger discloses, what it's directed to, is an improved capacitive
10 touch switch. So if a person of ordinary skill had already incorporated a
11 capacitive touch switch into eyewear, then Eichelberger might be pertinent
12 to the problem of how to improve that.
13 That's not what we have here. We have just a reference directed to
14 a small electrical component. It does not command itself to the attention of
15 an inventor who has not already decided or is not already motivated to
16 incorporate a capacitive touch switch into his device.
17 Since I've managed my time so poorly, I'm going to skip Claim 1
18 and move on to Claim 13, which is the method claim. Now, I believe I
19 heard counsel for Petitioner say that Blum -- I think it was Blum-130
20 discloses a method of manufacture. That is not consistent with the evidence,
21 Your Honor. None of the references the Petitioner relies on discloses any
22 method of manufacturing eyewear.
23 JUDGE O'HANLON: I'm sorry, what slide did you just --

1 MR. EUTERMOSER: Excuse me, I skipped ahead to Petitioner's
2 Slide 30 because it addresses Blum-130's mention of methods. So what we
3 see here is the diagram of embodiment of dispensing method 400,
4 prescription method 600, and dispensing method 2700. None of those
5 methods have anything to do with manufacturing eyewear. And I skipped
6 ahead because I just recalled that comment from Petitioner's counsel.
7 But if we look at the other reference -- actually, let me go back to
8 that language of Claim 13. So we see there are -- it's not just the preamble,
9 method of manufacturing and we see number of method steps, disposing
10 electronic components on a touch switch, connecting the components,
11 depositing a conformal layer, coupling the electronic assembly and the
12 capacitive touch switch. It is -- it was and still is Petitioner's burden to show
13 that those limitations are disclosed in the prior art. Petitioner has made
14 almost no attempt to do that.
15 So if we look at Howell-719, the other base reference for Claim 13,
16 we see references to method or methods, but nothing disclosing or
17 suggesting a method of manufacturer. Now, Petitioner has suggested that
18 -- essentially, that you can gap fill -- you know, if there's not sufficient
19 disclosure concerning the -- enabling the claimed invention, then there need
20 not be significant disclosure in the prior art.
21 Well, they didn't make that argument in this proceeding until we
22 got their slides. And candidly, I don't recall if Petitioner's counsel raised it at
23 oral argument. But I just want to flag the reason why they didn't brief this

1 issue is because this isn't a case, as in *Abbott* and *Epstein*, when there was no
2 disclosure enabling the claimed invention in the specification.
3 Here, for Claim 13, the '355 Patent discloses Figure 25, which is a
4 very detailed flowchart describing the method of manufacture, along with
5 more than a full column explaining that disclosure and supporting the claim
6 language. So in other words, there is nothing that relieves Petitioner from its
7 burden to show that every element of a challenged claim is satisfied by its
8 prior art combination. Petitioner made no attempt to do that and instead just
9 said, well, here's a product or here's an apparatus, a person of ordinary skill
10 would have been able to figure it out and would have known how to
11 manufacture that via the claim method described in Claim 13.
12 There's essentially no evidence in the record showing those
13 limitations in Petitioner's prior art combination. And they've simply failed to
14 carry their burden to show that Claim 30 -- Claim 13 is allegedly
15 unpatentable.
16 So unless there are questions, I'll reserve the balance of my time.
17 JUDGE MARSCHALL: That's it. You got just over nine minutes
18 remaining. And Petitioner, you have about 15 minutes, should you need it.
19 MR. RAZAI: Thank you, Your Honor. All right. Just a couple of
20 quick points. So for Claim 14 in the '355 Patent, in Slide 70, Howell-719
21 says, for replacing for a component, and then in parentheses says, physical
22 switch is serving the same purpose, a component. There's no dispute that
23 Howell-719 discloses multiple switches.

1 I don't think that I heard anyone argue with that. It was just that
2 what those switches are. And so the fact that you would replace one switch
3 for a capacitive touch switch would not eliminate the -- or a gyrometer
4 would not replace the capacitive touch switch, that's for Ground 5. That
5 there's a statement that was made during argument that replacing them,
6 meaning the physical switch, is that nothing in this petition requires
7 replacing them, just replacing a component.
8 And then there was discussion about the difference between a
9 capacitive touch switch and the physical switch. And if you actually look at
10 the motivation to combine provided by Dr. Feland, you actually see the
11 difference between a physical switch that creates a fatigue and wear and a
12 capacitive touch switch that is touch switch that doesn't have the same issues
13 as a physical switch does.
14 In Slide 8, the Patent Owner talked about Howell-719 and a single
15 paragraph that talked about an embodiment with a switch. But it ignores the
16 various disclosures in Howell-719 that include multiple switches.
17 For Ground 4, Howell-719 disclose a single switch, but Howell-
18 719 disclose a ready-to-be-worn sensor as well, as Judge O'Hanlon pointed
19 out. The replacement of the magnetic sensor with a ready-to-be-worn sensor
20 as stated in the -- in page 44 of the petition, says using an accelerometer
21 instead of a magnetic-based sensor to detect when the temple is in the
22 extended position, such that the glasses are ready to be worn.
23 This type of ready-to-be-worn sensor can't control the volume of

1 the speaker. It controls whether it's off or on and the capacitive touch, which
2 would still be required to control the volume whether the speaker is on or
3 off, whether it's on the eyewear or closed and not on would preserve the
4 power abilities of the speaker. Not necessarily control the speaker, it would
5 not eliminate the capacitive touch switch in Ground 4.
6 And that's what -- actually, the petition just talks about the
7 accelerometer being replaced for that ready-to-be-worn sensor. And it's
8 unsurprising that the motivation to use the capacitive touch switch would be
9 the same when we're talking about the same capacitive touch switch.
10 We talked a little bit about experts and Dr. Feland's opinions on
11 motivation and combine, and that's what an expert is normally there for.
12 And there was nobody expertizing the petition. It was the petition
13 borrowing from Dr. Feland's motivation to combine that stated why these
14 references would be combined. And expert is allowed to state a motivation
15 to combine. And none of the cases cited by Patent Owner change that
16 established rubric of law that that's what an expert is there to do.
17 Going to this issue of continual variance, the petition set forth that
18 a switch can change the focal length, replace that switch with a capacitive
19 touch switch based on the disclosure set forth. The Patent Owner came back
20 and said, you require continuous variance to change the focal length. And
21 we pointed back at the reference and said, no, you do not. The on or off will
22 change the focal length. In the off position, there is a particular focal length;
23 and in the on position, it changes the focal length.

1 Claim 13 is that method claim. And there's no dispute that Blum-
2 130 discloses, it even claims a method of making eyewear. Going to
3 Howell-179, Howell 179 says that its teachings can be implemented as a
4 method. And what we're talking about is a teaching or suggestion to a
5 skilled artisan. Based on the teaching of Howell-179, would a skilled artisan
6 understand how to implement a method? And that's what the obviousness
7 combination is; yes, it would.
8 If there's no other questions, Your Honors, I will rest my case here.
9 Thank you, Your Honor.
10 MR. EUTERMOSER: Petitioner's counsel didn't leave me a lot to
11 respond to with the balance of my time, which I'm sure everyone is happy
12 about. But I just want to point out that regardless of what Howell-719 says
13 about a method, it doesn't disclose the method of a manufacturer. And even
14 if it suggests one, it does not suggest the claimed method steps recited in
15 Claim 13 of the '355 patent.
16 And even if it did, or even if there was some suggestion there, it
17 was Petitioner's obligation and burden to explain Howell-719 or any of its
18 other prior art references or the combination that was proposing teaches or
19 suggests those method steps to a person of ordinary skill. And this has been
20 a theme throughout the hearing, I think will continue to be.
21 It is not enough for a Petitioner just to say in constructing a
22 combination that it claims -- renders a challenged claim obvious, that a
23 person of ordinary skill could have taken disparate concepts across various

1 references and figured it out, put them together in some way that somehow
2 renders claim limitations obvious. They haven't done that, particularly with
3 respect to Claim 13. That's all, Your Honors.
4 JUDGE MARSCHALL: Okay. Thank you. That concludes the
5 portion of this proceeding devoted to the -01069 case. We'll take a short
6 break and return in about five minutes to 2:00, about a seven-minute break.
7 And we'll go off the record.
8 (Whereupon, the above-entitled matter went off the record at 1:48
9 p.m. and resumed at 1:56 p.m.)
10 JUDGE MARSCHALL: Okay. We're back on the record. And
11 this portion of the proceeding will address IPR2024-01070. And if you
12 could introduce yourself since this is your first time appearing so far today.
13 MR. ANGER: Happy to. Good afternoon, Your Honors. My
14 name is Ben Anger, on behalf of Petitioner Luxottica.
15 JUDGE MARSCHALL: Okay. For this proceeding, we have 30
16 minutes per side. Would you like to reserve any of that time for rebuttal?
17 MR. ANGER: Yes, please. I'd like to reserve eight minutes,
18 please.
19 JUDGE MARSCHALL: You can begin when ready.
20 MR. ANGER: Good afternoon, Your Honors. I'll start here on
21 Slide 2. Claim 1 of the '174 Patent is directed to a first device, essentially,
22 eyeglasses. The primary dispute between the parties is this limitation 1[i].
23 The limitation recites that the first and second electrical conductors are

1 configured to couple the electronics module to the first temple to constrain
2 the electronics module. This is the primary dispute.
3 The term "constrained" is discussed in the '174 Patent
4 specification. There, the patent describes, in column 11, the constrained
5 limitation and it refers to it as this idea when the electrical conductor is
6 configured to provide support, i.e., a restraining force for the electronics
7 module to retain the module in a fixed position within the temple. That is
8 the first electrical conductor may be configured to hold the electronics
9 module in place.
10 Turning now to Slide 4. The parties now agree in this IPR that this
11 -- excuse me, this definition in the specification is consistent with the term's
12 plain and ordinary meaning.
13 If we turn to Slide 5. However, in this IPR, Patent Owner has
14 actually added a negative limitation to this definition. They've added
15 without minor movement. So they've deviated from the plain and ordinary
16 meaning. And that was here in their sur-reply that we have referenced on
17 Slide 5.
18 This construction is actually the exact opposite of the position that
19 Patent Owner took in the district court case. And this is where Patent Owner
20 is asserting in the Central District of California the '174 Patent against
21 Luxottica. In its opening claim construction brief, Patent Owner argued that
22 in the context of the '174 Patent, the term constrained does not even require
23 a fixed position. They've argued that the specification permits a module, the

1 electronics module, to be movable and even removable from the eyewear.
2 And in that situation, it would still meet the constrained limitation.
3 Turning now to Slide 7. Here again, in the district court, Patent
4 Owner pointed to the specification to support its construction. In this
5 example here on Slide 7, they point to the specifications use of the term
6 "restraining force." And if you'll remember, the definition we looked at in
7 the '174 Patent uses the term restraining force to describe constraining. And
8 they've used it here, they've cited to it, and used it to argue that it doesn't
9 require even a fixed position.
10 So I think it's going to be helpful if we take a look at that portion
11 that they're citing in their district court briefing. If we look at that portion in
12 the 174 patent itself, so let's turn there. I'm on Slide 8. It says, in this
13 portion, that the first electrical conductor need not continually apply a force
14 to the electronics module or the components therein but could apply a force
15 when the electronics module begins to move in a particular direction, e.g., a
16 restraining force, there's that term a restraining force, and thereby restricts
17 the movement of the module and thus couples the module to the temple.
18 So this is an embodiment in the '174 Patent that constrains the
19 electronics module while allowing for minor movement. This is contrary to
20 their construction in this IPR.
21 So let's go back to the IPR briefing, and this is Patent Owner's sur-
22 reply. This is where they try to justify deviating from the plain and ordinary
23 meaning. So they point to this -- the specifications discussion of the term

1 "substantially constrained," and try to use that discussion to narrow the
2 meaning of the term "constrain." They say the specification describes
3 substantially constrained as allowing for some minor movement of the
4 electronics module within the temple. So therefore the term constrain must
5 mean without minor movement.
6 So they've relied on a different phrase in the term -- in the
7 specification to describe -- or try to define the term constrain different than
8 its ordinary meaning. But again, this is the opposite -- this is the exact
9 opposite of what Patent Owner argued in the district court case. So instead
10 of arguing for a more narrow construction, like they did in the district court
11 case -- I'm sorry, in the IPR, in the district court case, they said the same
12 portion of the specification provides for an expansive reading of the term
13 constrain. So they've argued that it means holding one end of the module
14 substantially in place, just one end, but would certainly allow for some
15 minor movement of the electronics module.
16 So I think it's helpful if we go ahead and look at that portion that
17 they've cited in the district court case as well as cited in the IPR in
18 conflicting context to try to understand what is actually being said there. So
19 this is on Slide 11. So this is the '174 Patent at column 11, lines 50 to
20 column 12, line 3. This is the section that both parties have actually cited for
21 the discussion of the constrained limitation. So that's underlined there at the
22 top.
23 And you also see that it includes a discussion of substantially

1 constrain. And this context here is really important. It says here that the
2 electrical conductor can be inserted into the electronics module on one end,
3 and there it holds or restrains one end of the electronics module, which
4 restricts that side from movement. Then it says -- and this is highlighted
5 there -- in this manner, the conductor may hold or restrain one end of the
6 electronics module in place or substantially in place.
7 The term "substantially constrain" is used in this context to account
8 for some minor movement of the electronics module within the temple. So
9 in this context is this idea of holding one end. But you have to remember,
10 we're in the larger context of the term "constrain," which is, as we saw
11 before, to provide support, a restraining force for the electronics module to
12 retain the module in a fixed position. So we're allowing for some minor
13 movement.
14 This isn't saying that substantially constrained is a completely
15 different concept. It's under the umbrella of what constrain means. We're
16 holding one end of it tight with the electrical conductors inserted in, it's the
17 example it gives here, and that holds it. But it's considering the fact that
18 there may be some movement on the other end. So it is accounting for some
19 minor movement of the opposite end. And that's exactly what it says in the
20 last clause here at the bottom of the page. It says, "But the conductor may
21 generally hold the electronics module within the temple in place such that it
22 remains in an operative position."
23 Okay. So let's look at an example here. I'm on Slide 12. So the

1 '174 Patent has an embodiment under Figure 12 and it's discussing the fact
2 that the electrical conductors are inserted into the opening of the electronics
3 module 106. And here this is the highlighted portion, "And apply a force
4 that retain --" sorry, "restrains the electronics module 106 in the cavity 112,
5 (i.e., holds the module in place and prevents the module from moving
6 particularly in a direction directly away from the frames)." So there, the
7 patent is contemplating that there may be some movement. But it's trying to
8 keep it from moving, particularly in a direction away from the frames.
9 And this is important if we continue on in that same example
10 related to Figure 12. Now, I'm on Slide 13. It discusses that a fastener may
11 be inserted through on the other end of the electronics module, the opposite
12 of the end of the one that is coupled by the electrical conductors. So here,
13 it's saying if you want to prevent any movement, you're going to add this
14 fastener on the opposite end.
15 But if you look at Claim 1, Claim 1 does not require a fastener be
16 inserted on the other end or any end of the electronics module. It only
17 recites that there are first and second electrical conductors that are
18 constraining the electronics module. And in the prior examples, as we saw,
19 that allows for some minor movement.
20 This is another example in the '174 Patent, an embodiment that
21 uses removable electronics modules. This is a portion that's even cited in
22 Patent Owner's district court claim construction briefing where they cite to
23 this portion that discusses the idea of a removable electronics module but

1 still meets the constrained limitation.
2 Turning now to Slide 15. So even if there were embodiments in
3 the 17 -- sorry, even if there were embodiments in the '174 Patent that
4 required no movement, which there are none, that's not what the claims
5 require. So Patent Owner has not established or even argued that
6 lexicography or disavow or disclaimer would require importing the negative
7 limitation that they have, that negative limitation being without minor
8 movement.
9 Turning to Slide 16. So here, we've seen in the sur-reply that
10 Patent Owner has raised the straw man argument that Petitioner is somehow
11 asserting judicial estoppel, and that's just not the case. We're arguing that
12 Patent Owner's construction in district court shows that Patent Owner
13 actually understands what the '174 Patent means by the term constrain. And
14 that meaning does not allow for importing a negative limitation without
15 minor movement.
16 So let's turn to the grounds. I'm on Slide 17, this is Grounds 1 and
17 2 under -- or that rely on the Brunton reference as the primary reference.
18 And having addressed the claim construction already related to the constrain
19 limitation, we can see that that is met by the Brunton reference.
20 So this is on Slide 18. Brunton discloses spectacles and it
21 discloses a hearing aid unit which satisfies the electronics module limitation.
22 Patent Owner has only dispute with respect to Grounds 1 through 3 actually
23 related to Brunton is this limitation 1[i] the constrain limitation. But

1 Brunton absolutely satisfies this limitation and that's true under either party's
2 construction.
3 So we turn to Slide 19. It's important to look at the object of
4 Brunton's invention. Brunton itself says the object of its invention is to
5 mount the hearing aid unit in the temple with these embedded sockets. And
6 another object of the invention is to provide a means for mounting the
7 hearing aid unit. Why? Why would you be wanting to mount the hearing
8 aid unit?
9 So that the casing with the elements. That casing with the
10 elements is our hearing aid unit. So that it can keep that hearing aid unit
11 continuously in a fixed or stationary position so that means without minor
12 movement. This meets the claim limitation even under Patent Owner's
13 construction of limitation 1[i].
14 Let's turn to Slide 20. So how does Brunton go about fulfilling
15 these objectives? It does so by snapping the unit into sockets. We have
16 these portions here that are excerpted on Slide 20. Brunton refers back to
17 other objects and advantages that we were just talking about. Then it says
18 that the invention is a pair of spectacles, and it includes contacts on the
19 hearing aid unit that are adapted to be snapped into the sockets that are
20 embedded in the temples.
21 And in the second quote, Brunton is describing the improved
22 spectacles of this invention. And there, part of that invention is to position
23 the hearing aid unit in the cavity where it is adept to be snapped into the

1 sockets.
2 Turning to Slide 21. We see, again, how Brunton implements its
3 invention. So the hearing aid unit includes contact pins. These pins are then
4 inserted into the tubular contacts in the sockets, and the pins are frictionally
5 retained in the sockets. One thing I'll note is that it refers there to a
6 corresponding number of tubular contacts that allow to be frictionally
7 retained. A person of skill in the art would understand the number of tubular
8 contacts, the number of pins that are needed to be able to fulfill Brunton's
9 objectives. So in sum, Brunton satisfies the constrain limitation under either
10 party's construction.
11 So Turning to Slide 23. Patent Owner has argued that it must be
12 the cover plate that is holding things in place. But we've seen no support in
13 the specification that this is the case. Patent Owner has actually admitted
14 that Brunton teaches merely placing a cover plate over the entirety of the
15 unit, not that it is constraining any of those components, but never states or
16 even implies that the cover plate does anything than cover the frictionally
17 retained unit that is snapped into the sockets in the temple of the eyewear.
18 Okay. Moving on to the next grounds. We'll actually jump ahead
19 in the interest of time, and we'll go to Slide 27. This is the Hattori reference
20 for Ground 5. So the Hattori reference, and this is specifically Hattori-913,
21 discloses eyeglasses with the display device. And it includes an integrated
22 circuit that satisfies the electronics module limitation. And it includes a
23 zebra connector that satisfies the electrical conductor's limitations. So in this

1 one, Patent Owner is disputing whether the conductors are coupled to the
2 temple and also limitation 1[i], this again is the constrain limitation.
3 So turning to the coupled two limitation, if we look at Slide 29, the
4 '174 Patent describes coupled two in very broad terms. We don't even need
5 to rely on that broad definition in the '174 Patent. That's because the Hattori
6 reference meets the coupled two limitation under any reasonable
7 construction.
8 So let's turn to Slide 30. So in Slide 30, we have on the left
9 Petitioner's translation of the reference, and then on the right we have Patent
10 Owner's translation of the Hattori reference. And so here, we have a
11 discussion of the semiconductor integrated circuit, which, again, meets the
12 electrical -- the electronics module limitation.
13 And then if we look here, it says at the underlying portion that the
14 zebra connector is embedded in the temple. But right before that, it says that
15 the semiconductor integrated circuit is connected to the zebra connector
16 embedded in the temple. So in that way, the output terminal group of the
17 integrated circuit is connected to the zebra connector, which itself is
18 embedded in the temple.
19 And on the right, even under Patent Owner's translation, we have
20 the same disclosure using just slightly different terminology with the same
21 meaning. The integrated circuit's output terminal group is connected to the
22 zebra type connector, which itself is incorporated in the temple.
23 Now, I think it's also important on -- at this stage to address the

1 constrain limitation. Hattori has great evidence in this regard also. So if we
2 look at the translation from Patent Owner -- sorry, from Petitioner on the
3 left, that next sentence after the underlying portion, it says, it is locked by a
4 staked portion on the semiconductor integrated circuit 18, it being the zebra
5 connector. So the zebra connector is locked by a staked portion 26 on the
6 semiconductor integrated circuit. And even in the translation on the right,
7 under Patent Owner's translation, it being the zebra connector is secured to
8 the semiconductor integrated circuit by a barbed connection -- or sorry, a
9 barbed 26 thereon.
10 JUDGE O'HANLON: Mr. Anger, is that barb an electrical
11 conductor?
12 MR. ANGER: That, I'm not sure at this point, Your Honor. But if
13 we turn to the next slide, we can address the constrain limitation in more
14 detail and then I can get you an answer on that. So on Slide 31, we have an
15 abundance of evidence discussing that the zebra connector disclosed in
16 Hattori satisfies the constrain limitation.
17 First, on the top left, we have Petitioner's expert Dr. Feland, who
18 describes the zebra connectors providing mechanical stability. And then on
19 the bottom left in the next portion, he discusses the fact that it exerts
20 pressure on the integrated circuit's output terminals and compresses against
21 it.
22 And then he explains that it physically couples the integrated
23 circuit to the temple to retain it in a fixed position. That satisfies the

1 constrain limitation. Then on the upper right portion, we've included the
2 testimony from Patent Owner's expert, Dr. Oliver.
3 And here, Patent Owner has asserted that there is a typo in his
4 testimony. Well, for one, they already have submitted a corrected version of
5 Dr. Oliver's testimony, his declaration. They did not correct anything with
6 respect to the portion here. But separate and apart from that, even if we
7 ignore the underlying testimony - actually, what is even better testimony
8 from Dr. Oliver is the portion above that, where he says that the elastomeric
9 material from the zebra connector is applying pressure to keep the
10 conductive parts in contact. So this idea of keeping the conductive parts in
11 contact, that's actually doing the constraining.
12 Same thing for Patent Owner's response where they've said that
13 Hattori's zebra connector makes the conductive parts of touch and maintain
14 contact. That's constraining the electronics module within the temple. And
15 that other quote as well, they say that the elastomeric material, that's its job.
16 It keeps the conductors in contact between the electronics module and the
17 zebra connector, which serves as the electrical conductors. Separately, from
18 Hattori, it's DiSanto reference which Dr. Feland cites to describe the zebra
19 connector and describes it as exerting pressure between contact surfaces that
20 constrains the electronics module in the temple.
21 Moving on to Ground 6, 7. Here we have the Delorenzo reference.
22 And Delorenzo is -- it discloses eyeglasses with the hearing aid unit also in
23 the temple, it includes bifurcated connectors. So here, Patent Owner has

1 disputed two limitations and – 1[d] and 1[i]. The issue with Delorenzo here,
2 it may be one of just nomenclature.
3 So you'll see in the front left, the temple tip is the front portion.
4 And it includes a temple in the back. And that temple -- what it calls a
5 temple, actually includes the electrical components and serves as the claimed
6 electronics module. That's -- we have disclosure -- or sorry, testimony there
7 from Dr. Feland to that extent.
8 Now, here we have limitation 1[d] for Claim 1. The electronics
9 module disposed at least partially within the temple. The institution decision
10 questioned this point. So I just wanted to clarify it, that the claimed temple
11 here is the temple tip 13 plus the temple 13, which includes the electronics
12 module. Those together satisfy the claimed temple limitation. And that is
13 when the temple, those two portions together, are fully assembled.
14 Delorenzo also discloses the conductors to couple and constrain
15 the limitation -- sorry, to constrain the electrical -- electronics module.
16 That's express disclosure in the reference as well as supporting testimony
17 from Dr. Feland.
18 We turn now to Grounds 8 and 9.
19 JUDGE O'HANLON: Before you do that, Mr. Anger, can we turn
20 back? Can you explain to me how the requirement that the electronics
21 module is disposed at least partially within the first temple, how that
22 recitation is met when with the Delorenzo grounds, please?
23 MR. ANGER: Absolutely, Your Honor. Yeah. So the Delorenzo

1 includes a bifurcated -- a -- two portions of the temple, that when fully
2 assembled, meet the claimed temple limitation. The back portion is the
3 electronics module by itself. You put that together. And then that back
4 portion is at least partially within the fully assembled temple, the claimed
5 temple.
6 JUDGE O'HANLON: So by attaching the back part, 15 I believe it
7 is, to the front part 13, just that connection is embedded within? Is that your
8 argument, your position?
9 MR. ANGER: Yes. That's right, Your Honor. And if we look at
10 the limitation here, it's at least partially within the temple. That's right.
11 JUDGE O'HANLON: Okay. Thank you.
12 MR. ANGER: Okay. We'll quickly touch on Independent Claim
13 15, the Patent Owner has made an argument that the preamble is not met, it
14 absolutely is. There's been no dispute that the prior art discloses all the
15 limitations, and therefore, the preamble is met as well.
16 Let's -- we turn to Slide 43, Ground 8. The Kokonaski two
17 references disclose all the limitations. That's not something that Patent
18 Owner has even disputed. So in terms of meeting the limitations or Claim
19 15, this is their only argument. So if you find that Kokonaski, both of them
20 together, disclose all the limitations, then we've met the requirements for
21 Claims 15 to 19. Separately for Ground 9, Howell-596 in Eichelberger also
22 disclose methods.
23 Ground 9, they've made separate arguments. We've discussed

1 many of these already in the context with the other matters. So in the
2 interest of preserving a few minutes, I'll go ahead and stop at this point,
3 unless Your Honors have any questions.
4 JUDGE MARSCHALL: That's it for now. You're four minutes
5 into your time, so you have four minutes left.
6 MR. ANGER: Thank you.
7 JUDGE MARSCHALL: Patent Owner, you have 30 minutes total.
8 Would you like to reserve any of that time for rebuttal?
9 MS. STONE: I'll reserve eight minutes, thank you.
10 JUDGE MARSCHALL: Okay.
11 MS. STONE: Good afternoon, Your Honors. All right. Now, this
12 table summarizes all of the issues that are still live in the '174 IPR. I do
13 want to flag quickly just because I do think a lot of our focus today is going
14 to be on the first couple issues. But I do want to flag some overlap with
15 some of the previous proceedings. For example, issue 3, the Petitioner's
16 burden as to method claims overlaps slightly in its discussion with the
17 proceeding we just heard from on the '355 IPR.
18 Similarly, we heard a little bit about Eichelberger's capacitive
19 touch switch in issue 4 here as well as the -- as well as Sikonowiz's
20 conformal coating, which is relevant to issue 6 here. I'm going to try to
21 focus my discussion to the issues that are unique to this IPR. For context,
22 there are two claim sets. The first claim set is challenged by Grounds 1
23 through 7, a variety of different base references.

1 And the second claim set is challenged by Grounds 8 and 9.
2 Conductors to constrain the module, this is the primary issue that Petitioner
3 has addressed. This is relevant to Grounds 1, 2, and 4 through 7. Ground 3
4 challenges dependent claims only and relies back on the same basis,
5 Grounds 1 and 2.
6 Now, on Slide 4, you can see Claim 1 is really, really long. I've
7 tried to keep the language that we may need to reference back to on this
8 slide. But again, the key limitation is first and second electrical conductors
9 configured to couple the electronics module to the first temple to constrain
10 the electronics module.
11 Now today, Petitioner frames this is primarily a claim construction
12 dispute. I want to break this down because I think this is really critical to
13 understand that there are two levels of claim construction happening. So this
14 limitation refers to constraining the electronics module. Both parties have
15 cited the same definition in the specification of constrain. There's no dispute
16 there.
17 Both sides paper cites the description and if I jump forward onto
18 Slide 5, here it is from the '174 Patent. So both parties have cited this
19 disclosure as meaning constrain. In the petition, they say that this comports
20 with the plain and ordinary meaning. So there's no dispute as to this first
21 level. What does constrain mean? There's then a second level that has
22 developed a little bit in the briefing, which is what does it mean to be in a
23 fixed position? To what degree must there be a restraining force to keep it in

1 a fixed position?
2 One thing that's important to note is that I do think that dispute is
3 more nuanced than the district court claim construction dispute. At the
4 district court, they were construing the entire limitation, not just constrain.
5 And the briefing really focused on the coupled to language of the limitation.
6 At the district court, Patent Owner argued that no claim construction was
7 necessary and that it should be the plain and ordinary meaning. Whereas
8 Petitioner focused really on that coupling language within that whole
9 limitation.
10 Now, in this IPR, this specific dispute arose in the context of this
11 prior art. But I do want to note, the PTAB will decide this issue for the first
12 time. The district court has not given a claim construction order, and the
13 case is stayed pending the outcome of this proceeding. So the parties will
14 likely be governed by the -- or will likely have to re-brief and will be
15 governed by the determinations made here.
16 But in calling out these two levels to the claim construction, the
17 point I want to make is that I don't even think the Board needs to reach that
18 second level of claim construction, the disputed portion, because regardless,
19 the prior art does not disclose it.
20 Therefore, I'd like to jump into the prior art because I do think that
21 the parties agree that constrain should be governed by that definition within
22 the specification of constrain. Both parties rely on that in their papers. And
23 I don't think we need to get to that second level of construction. The

1 Petitioner relies on three different references, which you heard them discuss,
2 Brunton, Hattori-913, and Delorenzo. I just do want to note that in the
3 ground in which they pair it with Kokonaski-999, they are still relying on
4 Brunton's disclosure for the conductors to constrain limitation.
5 In Slide 8, you can see figures illustrated from Brunton. And I
6 apologize, the drawings are a little poor, so I've tried to blow them up as big
7 as I can. But on the left is slide -- or on the left of Slide 8 is Figure 1.
8 Brunton is a 1953 reference that is directed to mounting a hearing aid into
9 spectacles. You can see over here on the left side the long vertical white
10 rectangle is the hearing aid. And then there's also components out to the
11 ends of it within that frame temple.
12 Figure 6 takes this portion of the temple and blows it up. It does
13 look a little funny because in the middle they've cut out the extraneous white
14 rectangle that's representing the hearing aid. But this is illustrating
15 specifically the cavity 18 and the recess that this is being put into. I know
16 it's a little wonky looking at it sideways, but I did want to get it as big as
17 possible so we could walk through Brunton's Figure 6. Because I think it's
18 really important to understand that the hearing aid is not the only thing
19 placed into cavity 18.
20 So let's walk through this from the -- we see first that we are
21 looking at the temple pieces. On the very far left and the very far right are
22 the white solid temple 13 pieces. As we walk in, this striped frame
23 illustrates what is within -- everything inside that striped frame shows what

1 is within cavity 18. So at the left side, we see, for example, transistor 29,
2 which in itself includes a contact numbered 30. And this transistor is
3 described as removably mounted in the cavity.
4 We also have sockets 19 and 20. And the sockets 19 and 20 hold
5 contacts 27 and 28. And Brunton specifically teaches that these may be
6 frictionally held in the cavity. You can see that contact 27, for example,
7 aligns on the back end -- or on the left side with the transistors contact and
8 on the front end with pin 25 of the hearing aid. The pins 25 and 26 of the
9 hearing aid make contact with these sockets pins -- or with these sockets
10 contacts.
11 So I do think it's important to understand that this cavity 18 is not
12 just for the hearing aid, it's holding essentially a row of components within.
13 With this context, it's easier to understand why Brunton discloses a cover
14 plate that is then screwed in, not just over the hearing aid, but over all of
15 these components that are held within the recess.
16 Petitioner references language by Brunton saying that Brunton
17 teaches that the hearing aid unit is continuously in a fixed or stationary
18 position. I do think it's important to note that Breton never attributes this
19 stationary position to the contact pins. Of course, it would be held in a
20 stationary position when there is a cover plate screwed over the top of it. It
21 never attributes this directly to the pins.
22 Similarly, they also rely on language of Brunton describing it as
23 being -- as they -- describing the hearing aid as being snapped into place. It

1 still doesn't attribute it to the contact pins. It says that the hearing aid is
2 snapped into place. It does not specifically describe the pins as being
3 snapped in.
4 JUDGE O'HANLON: But doesn't Brunton disclose that the pins
5 are what hold the hearing aid in place? Wouldn't it have them?
6 MS. STONE: I don't think that Brunton does disclose that the pins
7 are what holds the hearing aid in place. It's placed into this cavity 18 along
8 with a variety -- along with these components aligning together. All of the
9 language that Petitioner cites as far as the hearing aid being stationary is
10 nonspecific.
11 JUDGE O'HANLON: I'm looking at this column that says
12 Brunton in column 3, starting -- paragraph starting around line 57, I believe.
13 And the last sentence there talks about the contact pins, which of part -- as I
14 understand it, part of the hearing aid unit are received in the sockets. And
15 there, the pins are frictionally retained within the socket.
16 MS. STONE: That is correct. But I do believe that frictionally
17 held does not sufficiently establish that those are responsible for what's
18 holding the hearing aid in place. You can imagine a contact pin making a
19 contact with a contact and perhaps that little vibration at the end, you know,
20 it's being frictionally retained there. But it's not responsible necessarily for
21 applying a restraining force to the hearing aid to hold it in a fixed position.
22 And there's no explicit teaching on that.
23 JUDGE O'HANLON: But if you combine that portion of the

1 written description I just talked about with Figure 6, which shows the other
2 ends of the pinswithin the contact -- I forgot the exact language. Then the
3 -- shoot, so within the tubular contacts, those seem to -- seems to be a pretty
4 good showing of the hearing aid being firmly held in place. If those pins are
5 frictionally held within its tubular contacts.
6 MS. STONE: I do think it's important to note that Brunton does
7 describe that the sockets may be frictionally held in place as well. I question
8 the ability of the sockets to hold the hearing aid in place via the -- I mean,
9 this is kind of -- so I question the socket's ability to then hold the hearing aid
10 through the tubular contact, making contact with the pin when they
11 themselves may only be frictionally held in place. What's more likely
12 -- especially looking at Figure 6, you see these two pins just touching at the
13 ends. And I think what's more likely is that these components -- and I think
14 what Brunton's Figure 16 shows is that these components are placed within
15 the cavity side by side, and then it's the hearing plate that actually holds
16 them all in place.
17 JUDGE O'HANLON: So column 3, the last paragraph says that
18 those are the sockets that can be frictionally held in place, or they may be
19 embedded in the material of the temple. They're not necessarily frictionally
20 retained. They can be part of the temple.
21 MS. STONE: Even if they were embedded into the temple, I still
22 don't think there's any teaching in Brunton that specifically attributes the
23 restraint of the hearing aid to the conductors. I'd like to also address Hattori-

1 913, in which Petitioner relies on a zebra connector. There is no dispute
2 -- I'm on Slide 11, which illustrates the zebra connector.
3 There is no dispute as to how a zebra connector works. Both
4 experts acknowledge that a zebra connector relies on pressure between
5 contacting surfaces to maintain a connection. But maintaining contact is not
6 the same as applying a restraining force to the integrated circuit. So
7 Petitioner relies on the term embedded in Hattori to argue that it must
8 necessarily be restrained or bound in the temple in some unspecified way.
9 Hattori is silent on this and does not explicitly teach that the zebra
10 connector is bound to the temple in any way. Petitioner disputes Patent
11 Owner's description that the zebra connector is placed within the temple.
12 But this is consistent with Petitioner's translation, which describes the zebra
13 connector as being incorporated within the temple, just as the module is
14 incorporated in the temple's recess.
15 Looking here at Figure 6 of Hattori, which is illustrated on Slide
16 11. Hattori is really light on the details. There's not much disclosure there.
17 We see the integrated circuit coming in from the left side of Figure 6 and the
18 zebra connector 24 and then the connection to the hinge of the eyewear. It's
19 unclear how this would be embedded when it's part of this connection that's
20 being movably connected together. Unfortunately, or fortunately, Hattori
21 does not explicitly describe exactly how this connection is made. But we
22 know that those two must come together somehow.
23 Now, they did raise Dr. Oliver's declaration with the typo. I do

1 just want to quickly flag this, it was filed in Patent Owner's objection.
2 Specifically, in their slide, they removed the sentence right before and right
3 after Dr. Oliver's conclusion statement. There is the word "not" missing
4 from that quote. This is on Petitioner Slide 31, it cites Exhibit 2016 at
5 paragraph 11. The only thing I'll note is that if you read the sentences on
6 either side of the quote the Petitioner pulled out it is very obvious that there
7 is the missing word "not."
8 Now, I wanted to address something that came up during
9 Petitioner's presentation in Hattori. Specifically, for the first time, Petitioner
10 pointed to this description. It's ambiguous, that says something is connected
11 to a stake. I'm looking for the exact language here. It is locked down by a
12 stake like -- sorry, it is locked down by a staked portion 26.
13 This is the language Petitioner cited on page 68 of Hattori. It
14 appears in the left column at the first paragraph on these -- this is kind of
15 hard to describe, at the first full paragraph, inciting this -- first of all, new
16 argument. This isn't mentioned anywhere in the briefing, and the parties
17 haven't briefed it.
18 But I think at best, this is ambiguous as to whether it's actually
19 referring to the zebra connector or the integrated circuit. I think it's more
20 likely that it's referring to the integrated circuit. When you read it with the
21 sentences before it -- and there's multiple -- there's another instance of it
22 does this its output terminal. It's referring to the integrated circuit's output
23 terminal.

1 And then it says it is locked by a staked portion 26. I think, in
2 citing this, it's actually -- it actually supports Patent Owner's position that the
3 zebra connector is not applying a restraining force to hold anything in the
4 frames there. Rather, according to this disclosure cited by the Petitioner, it
5 sounds more like the integrated circuit is locked by a staked portion 26.
6 Now, the -- I'd also like to really quickly touch on Delorenzo. I
7 know we're short on time on this one. In Delorenzo, the early briefing went
8 back and forth on exactly what might be the electronics module versus the
9 first frame portion. Now, Petitioner has stated that temple 15 is in fact part
10 of the first frame as well as the electronics module.
11 I think this is problematic for two limitations. If temple 15 is the
12 alleged electronics module, then the connections that are happening, 30 and
13 31, don't apply a restraining force to keep or to hold that -- or to couple that
14 electronics module to the frame because the electronics module is part of the
15 frame. I also think that -- and I will go on to the next issue, which is the
16 electronics module within the temple as you guys -- as Your Honors
17 previously flagged.
18 When we look at this language, we have to realize that there are
19 two limitations relevant here, so conductors configured to couple the
20 electronics module to the first temple and an electronics module disposed at
21 least partially within the first temple. It's unclear to me how temple 15 is
22 disposed within anything. Connectors 30 and 31 are what Petitioner points
23 to as the alleged conductors and those are being inserted into the back

1 portion of temple 15.

2 So Patent Owner raised this issue in its Patent Owner response,
3 specifically that it did not look according to their proposed mapping that
4 temple 15 was within anything. Petitioner did not respond to this in the
5 reply. And at page 57 of the petition, the only sentence they have on this is a
6 one sentence assertion that is conclusory. It merely states that the fully
7 assembled temple of the eyewear, temple tip 13 plus temple 15. That is the
8 full explanation. There is no explanation as to how temple 15 is disposed
9 within anything.

10 I am going to jump to Slide 18 to also just touch very briefly on the
11 capacitive touch switch as I know we heard a little bit about this earlier. But
12 a PHOSITA would not have been motivated to combine Eichelberger's
13 capacitive touch switch with Howell-596's UV detection system. We've
14 already talked about Howell-596 during the '483 proceeding earlier today.
15 This is the one that discloses a UV detection system in the form of a circuit
16 board.

17 And Howell-596 already discloses a mechanical switch button,
18 which is more suited both in size and -- or better suited both in size and lack
19 of complexity for the system disclosed in Howell-596. This mechanical
20 switch button is illustrated on Slide 20 in Howell-596's Figure 16-D.
21 Particularly, when space is an issue, as you can see here, the electronics
22 circuit or the radiation detection system specifically refers to this circuit
23 board contained within Figure 16-D.

1 And there's a lot of competing components that do need to be
2 exposed to the external environment, like the UV sensor, also the display
3 device at -- by which the user, the wearer, can see the level of radiation that's
4 being detected. There's also a solar cell that's disclosed as a power supply,
5 which would also need access to UV light.
6 All of these are exposed and therefore space on the UV radiation
7 detection system that would in fact, you know, place something, like a
8 switch, in a position where it's easily accessible by the wearer, space was at
9 a premium. Furthermore, petition doesn't detail how the capacitive switch
10 would be implemented with Howell-596's UV detection system.
11 And I'm going to go ahead and reserve my eight minutes.
12 MR. ANGER: Your Honors, thank you for your time today. I'll
13 briefly respond to Patent Owner's comments. I'll start with Brunton.
14 Brunton expressly discloses the limitation, the constrain limitation. If you
15 look at column 2, it talks about -- starting at line 1, it talks about the object
16 of the invention and it says that the sockets may be embedded in the
17 materials of the temple. They're secure in there.
18 If you move down to column 2, starting at line 17, a further object
19 of the invention is to provide means for mounting the hearing aid unit. And
20 the hearing aid unit is continuously in a fixed or stationary position. The
21 way that it implements that is the use of the contact pins on the hearing aid
22 unit and they secure them in the -- sorry, in the tubular contacts of the
23 sockets. That's disclosed in column 3, starting at line 57 through 65, and it

1 concludes that those contacts are frictionally retained.
2 I think that's very clear, Your Honors. And it's not the cover that is
3 doing any sort of constraining. It's going over the top of all the elements as
4 Patent Owner has discussed. But never attributes any of the -- constraining
5 any of this -- retaining as it discloses here to the cover plate. It discloses
6 specifically related to the sockets that are embedded in the material.
7 If we turn to the Hattori reference, the zebra connector, the
8 disclosure is clear there that it does do the constraining -- meets the
9 constraining limitation because it compresses. Its whole purpose is to hold
10 things in place. The testimony from both Patent Owner's expert as well as
11 Petitioner's expert says the purpose there is to maintain contact. It does that
12 by pressure and it also uses the conductors in the zebra connector to
13 maintain the contact, to couple the components together, and to constrain it
14 within the temple cavity.
15 Briefly referring to the Howell 9 -- sorry, 596 reference, Patent
16 Owner discussed that briefly, that's the one with the -- whether a capacitive
17 touch switch would be used in the combination there. And I'll note that
18 Howell-596 expressly discloses a capacitive touch switch. So Patent
19 Owner's argument about whether you would go about, you know, switching
20 one out, how you would do that, it's expressly disclosed in there. That's all
21 you -- a patent -- sorry, a person of skill in the art would need. It's disclosed
22 in there it meets the limitation. Thank you, Your Honors.
23 MS. STONE: I'm just going to follow up quickly on two points.

1 Let me -- first, on the capacitive touch switch. When Petitioner says that it's
2 explicitly disclosed in -- the capacitive touch switch is explicitly disclosed in
3 Howell-596, my understanding is that what he's referring to is that Howell-
4 596 incorporates by reference, another application that discusses a capacitive
5 touch switch. This is discussed at the Patent Owner response at pages 61
6 through 62.
7 But one thing I want to note with that is that it discloses a variety
8 of switches. But the fact that a capacitive touch switch is acknowledged to
9 exist does not provide the motivation to specifically implement a capacitive
10 touch switch within that combination.
11 In the petition, they also referenced, I believe, it's paragraph 88 of
12 Howell-596, which refers to the being-worn switch instead of the sensor at
13 the back of the frames -- or sorry, implemented for the being-worn switch. I
14 will just note that the being-worn switch is a different disclosure, for
15 example, than from Howell-596's disclosure of the mechanical switch that is
16 used on the UV detection system circuit board.
17 And in this reference to the being-worn sensor, that is the sensor
18 that we discussed previously in the '483 proceeding that is located at the
19 very back of this temple frames. So it's important to note that this is the
20 sensor -- this is not part of the UV detection system that is part of the
21 electronics board in the front of the temple. These are two different
22 disclosures.
23 And since I have time, I -- bear with me while I just check

1 something. There we go. So at paragraph 88 of Howell-596, specifically,
2 this is where it references that application and incorporates it by reference.
3 But the point I wanted to make was that it refers the reader to this
4 application when discussing the being-worn sensor.
5 And finally, with respect to Hattori-913, I just want to point out,
6 again, that this -- the argument based on, I believe, in one translation it's
7 "stake" and in one translation it's "barb." This argument was new and was
8 not previously contained in the papers.
9 If there are no further questions, then I will end.
10 JUDGE O'HANLON: I've got no questions.
11 JUDGE MARSCHALL: Okay. Thank you.
12 MS. STONE: No questions, got it.
13 JUDGE MARSCHALL: We'll take one more break, about two
14 minutes after, about seven minutes. We'll all meet back. Thank you.
15 (Whereupon, the above-entitled matter went off the record at 2:56
16 p.m. and resumed at 3:04 p.m.)
17 JUDGE MARSCHALL: Okay. We're going back on the record.
18 We're now going to address our final proceeding of the day in IPR2024-
19 01072. And for this part of the proceeding, the parties have 20 minutes per
20 side. Petitioner, first, you're going to introduce yourself and then let me
21 know if you'd like to reserve time for rebuttal.
22 MR. PETERSON: Yes, Your Honor. My name is Jacob Peterson
23 with Morgan Lewis here on behalf of Petitioner Luxottica.

1 JUDGE MARSCHALL: And any time for rebuttal?
2 MR. PETERSON: Yes, please, five minutes.
3 JUDGE MARSCHALL: Okay. You can begin when ready.
4 MR. PETERSON: Your Honors, this last IPR is about applying
5 well established law to a patent that added nothing new to electronic
6 eyewear. The prior art already taught everything the '960 Patent claims.
7 Patent Owner does not dispute that the first 10 claims are unpatentable and
8 the remaining claims all fall on similar issues to one another. The only
9 defenses Patent Owner advances here are inoperability, non-analogous art,
10 and alleged missing limitations. But those defenses are contradicted by the
11 prior art on the '960 Patent's own disclosure and by the record before the
12 Board.
13 JUDGE HAMANN: Counsel, this is Judge Hamann just real
14 quick. As to the first 10 claims, even if they're undisputed, you'd agree that
15 we still have to evaluate Petitioner's showing to make certain that petitions
16 show preponderance of evidence, you know, unpatentability of those claims;
17 is that fair?
18 MR. PETERSON: Yes, Your Honor.
19 JUDGE HAMANN: Thank you.
20 MR. PETERSON: Turning to Slide 2. The '960 Patent claims are
21 directed to electronic eyewear having communications functionality. That's
22 it. This is just eyewear with communication with electronics, exactly what
23 the prior art already taught years earlier. There is nothing new here.

1 So turning to Slide 3. Let's begin with what's not in dispute here.
2 Independent Claim 1 and dependent Claims 2 through 10 are unpatentable.
3 Patent Owner offered no arguments under Grounds 1 through 3 to defend
4 them. Now, that leaves independent Claims 11 and 22. And as shown here
5 by yellow highlighting on Slide 4, the differences from Claim 1 are minor.
6 Claim 11 adds presence detection. Claim 22 adds password
7 transmission. Both features are disclosed in the prior art and Patent Owner
8 doesn't even dispute that. Claims 11 and 22 accordingly fall with Claim 1.
9 Now, let's first turn to Ground 4, the first ground in dispute here. This
10 ground combines Jannard-740 with Rosenblatt. Jannard-740 discloses
11 electronic eyewear with an application module, where Rosenblatt discloses
12 wireless presence detection.
13 Together, these two references disclose every limitation of Claims
14 11 and 22. And a skilled artisan would have been motivated to combine
15 them because one looking to add hands-free wireless control to smart
16 eyewear would naturally look to Rosenblatt's wireless key system. It
17 provides exactly the functionality that Jannard's eyewear was designed to
18 support.
19 Turning to Slide 7. Patent Owner does not dispute that Jannard-
20 740 discloses the claim structures or that Rosenblatt discloses the claimed
21 functions. Patent Owner's only defense here is inoperability.
22 As shown on Slide 8, Patent Owner argues that Rosenblatt's
23 circuits are too large and too power hungry to be implemented in eyewear.

1 But Patent Owner's arguments rely on its expert's erroneous analysis of
2 Rosenblatt and the unsupported assertions regarding the state of the art. On
3 the left on Slide 9 is showing Patent Owner's expert's speculation that
4 necessary circuitry at the time wouldn't fit in eyewear.
5 On the right is showing Patent Owner's -- or excuse me, is showing
6 Petitioner's expert's analysis of Jannard-740, that Jannard-740 already had
7 the structure and Rosenblatt supplies the functionality. Wireless
8 components were well within the art. And the Board should credit the prior
9 art's disclosure and Petitioner's expert.
10 The '960 patent adds no special software, no special hardware to
11 solve the alleged problems Patent Owner identifies. The Federal Circuit has
12 said in *Abbott Labs* and *Epstein* that when a patent adds no implementation
13 detail, that confirms the claim feature was routine. And that's exactly our
14 situation here.
15 And also at issue here is Patent Owner's motion to strike Howell-
16 158 and Petitioner's associated arguments, which Petitioner raised on reply.
17 Regardless of how the Board resolves that motion, the result is the same.
18 The '960 Patent's claims are unpatentable. Jannard-740 and Rosenblatt
19 already disclosed the claim limitations and the '960 Patent's own meager
20 disclosure confirms a skilled artisan could implement them. Howell-158
21 simply corroborates what the prior arts and common sense already show,
22 that Patent Owner and its experts portrayal of the state of the art is
23 inaccurate.

1 Moving now to Ground 7. Ground 7 combines Chen with
2 Rosenblatt. Chen discloses also --
3 JUDGE HAMANN: Counsel --
4 MR. PETERSON: Sure, Your Honor.
5 JUDGE HAMANN: -- this is Judge Hamann. Before we do that,
6 I'm more focused on Ground 4. And maybe we can also go back to -- if we
7 could to Petitioner's Slide 4. And this slide just sets out, you know,
8 independent Claims 11 and 22. I'm just trying to understand sort of what
9 Petitioner set forth and what this claim generally recites.
10 And starting with Claim 11, obviously, there's an eyewear
11 component. But if I understand correctly, the wherein clause at the end is
12 just what's with -- just a computer that's communicated with. And the
13 functionality is supplied by that computer; is that fair?
14 MR. PETERSON: The wireless-enabled device? So you're
15 referring to Claim 22, Your Honor?
16 JUDGE HAMANN: Claim 11.
17 MR. PETERSON: Claim 11.
18 JUDGE HAMANN: The wireless-enabled device. I believe the
19 parties, for purposes of this proceeding, have basically said, you know, a
20 computer is an example of that; is that fair?
21 MR. PETERSON: I believe one of the dependent claims gets to
22 that. But I believe what you're referring to is dependence off of Claim 22
23 where some of those dependents refer to a wireless-enabled device. And

1 then there's a lack of antecedent basis in Claim 22 for that, which we put
2 forth -- what must have been intended is that a computer was -- intended to
3 be referred to there, rather than a wireless-enabled device. But --
4 JUDGE HAMANN: But let me just try to understand Claim 11.
5 And it just seems like to me, you know, an eyewear frame, and you have an
6 application module which comprises of, you know, wireless chip. And that's
7 all you have as to the, you know, eyewear component. The other, you know,
8 aspect of the Claim 11 is what received this. And so it's not, you know, part
9 and parcel in any way with the eyewear frame, at least as the Claim 11. Am
10 I missing something on that? It just seems --
11 MR. PETERSON: No. I agree, Your Honor. I agree. This
12 wherein clause is directed to functionality of the wireless enabled device that
13 is not a part of the eyewear. And --
14 JUDGE HAMANN: So then --
15 MR. PETERSON: Yeah.
16 JUDGE HAMANN: I'm sorry, I didn't mean to cut you off.
17 MR. PETERSON: Oh, no, go ahead, Your Honor.
18 JUDGE HAMANN: So I understand, you know, the two
19 references that are cited for Ground 4 and, I believe, the other is -- if I
20 remember correctly, Rosenblatt. What has Petitioner argued? Rosenblatt,
21 you know, adds to the combination because it's not obviously, I don't
22 believe, part of the eyewear frame itself.
23 MR. PETERSON: It's the presence detection feature that

1 Rosenblatt brings in. But I agree the structure of the eyewear, the eyewear
2 frame application module, including a wireless chip to communicate with
3 another device that is in Jannard-740 and Rosenblatt. If I could turn just two
4 more slides here. Rosenblatt adds this idea of proximity clouds around
5 devices and individuals that allows other devices to react if they're within the
6 proximity cloud.
7 So it's our, I would say, giving respect to the limitations, although
8 we agree that those limitations are not limiting the eyewear, it's limiting this
9 other device that's not a part of the eyewear. I think that's consistent also
10 with some of the dependent claims that go into great detail about features of
11 this wireless-enabled device when that's not claimed to be part of the
12 eyewear.
13 JUDGE HAMANN: Thank you.
14 MR. PETERSON: Any other questions, Your Honor?
15 JUDGE HAMANN: Not at the moment.
16 MR. PETERSON: All right. So Ground 7 combines Chen with
17 Rosenblatt. And Chen has the eyewear temple assemblies with cartridges
18 designed to hold electronics. And Patent Owner repeats its same ground for
19 inoperability story in Ground 7. But Chen shows the same thing as Jannard,
20 eyewear temple assemblies with add-on electronics. And Chen even
21 discloses Bluetooth in an eyewear's temple.
22 And Patent Owner's inoperability arguments fail in Ground 7 for
23 the same reason they fail in Ground 4. And as the Federal Circuit has made

1 clear in *Abbott Labs* and E*pstein*, when a patent adds no implementation
2 detail, that only reinforces that the claim featured was routine and well
3 within the skill of the art. And then additional arguments here, Patent
4 Owner tries to exclude Chen by arguing it's non-analogous art. And that test
5 requiring that the art be in the same field. And then as we'll discuss in a
6 moment, Patent Owner is highlighting of -- addressing the same problem.
7 But as we'll see here, Chen meets both prongs of the analogous art test.
8 On Slide 15. First, Patent Owner tries to exclude Chen by
9 narrowing its field to thermal-regulated coating. But as shown on Slide 16,
10 Chen's disclosure is far broader. Chen's title is eyewear temple assembly.
11 Its field of invention describes its present invention as related to temple
12 components that provide additional functions, and its cartridge is comprised
13 of materials and components, which will provide useful functions.
14 And then second, Patent Owner tries to exclude Chen by
15 arguments directed to a different problem than the '960 Patent. But like the
16 '960 Patent, Chen addresses wearable electronics. And Patent Owner's own
17 arguments on sur-reply confirm this by acknowledging that Chen's thermal
18 regulating cartridges may be electric.
19 Patent Owner admits that Chen also addresses the problem of
20 wearable embedded electronics. Chen expressly teaches its cartridges can
21 include electronic components. And specifically, Chen says its cartridge can
22 hold any functional component that fits.
23 But here, Patent Owner mischaracterizes Petitioner's analysis and

1 asserts that Petitioner argues that Chen's thermal cartridges themselves
2 communicate wirelessly. That is not Petitioner's position. Petitioner
3 explained that Chen discloses incorporating Bluetooth communication in
4 eyewear, and that based on that disclosure, a POSITA would have been
5 motivated to include a wireless chip in Chen's cartridge.
6 Now next, turning to one of the dependent claims in Grounds 4 and
7 7, Dependent Claim 24, which depends on Claim 22. Patent Owner claims
8 here that the prior art does not disclose adjusting a computer's brightness and
9 makes two specific arguments: the first is that the prior art fails to disclose
10 or render obvious a computer; and the second that mere mention of a display
11 does not disclose or suggest brightness control.
12 But if we turn to Slide 22, Patent Owner admits in its Patent Owner
13 response that Rosenblatt discloses a computer with a display. Turning to
14 Slide 23, Petitioner's expert, Dr. Feland explained that such a computer
15 adjusts its brightness to visually present information to a user. And as a
16 result, Patent Owner's own admission syncs its Claim 24 arguments.
17 JUDGE HAMANN: Counsel, obviously, I'm looking at Slide 23
18 and, I believe, paragraph 208 reference in which references a Microsoft
19 dictionary. I'm trying to get a better understanding. I'm not sure that
20 dictionary definition says all displays have, you know, the ability to vary the
21 brightness, although obviously that's not necessarily unknown. What is
22 -- this is your -- Dr. Feland's support for this testimony?
23 MR. PETERSON: That a display varies its brightness to visually

1 present information. So first of all, the turning on and off of a display is
2 itself a changing of the brightness of a display. And looking at this
3 definition here, a visual output device, it is the change of eyewear -- a
4 change of light intensity that is the very nature of visual perception for
5 humans. And I think based on the dictionary definition of a display being a
6 visual output device, he's linking from the perspective of POSITA, the
7 reference to visual here with the reference to brightness in the display itself.
8 JUDGE HAMANN: Thank you.
9 MR. PETERSON: And turning briefly to Grounds 5 and 8, these
10 address Claim 19, which depends on Claims 16 and 11. And then Claim 16
11 adds that the wireless-enabled device of Claim 11 is located in an
12 automobile. And then Claim 19 further requires that the wireless-enabled
13 device control an automobile functionality to wake a wearer if the wearer
14 falls asleep.
15 And notably, Rosenblatt already discloses automobiles reacting to
16 devices in proximity. But as shown in Slide 26, these combinations further
17 add Gunaratne to the combinations of Jannard-740 and Rosenblatt; and Chen
18 and Rosenblatt. And Gunaratne describes the functionality in which a motor
19 vehicle awakes a wearer who's fallen asleep.
20 And Patent Owner raises several arguments here. And I'll just
21 address one now in the interest of time, and that's the third bullet. And that's
22 how Patent Owner flips Petitioner's position on its head. Patent Owner
23 suggests that Petitioner puts Gunaratne's system into eyewear. But the

1 combination adds Gunaratne's functionality to the automobile in the
2 combination of Jannard-740 and Rosenblatt; and in the automobile in the
3 combination of Chen and Rosenblatt.
4 And briefly turning to Ground 6 and 9, this addresses Claim 25,
5 which depends on Claim 22. And this claim requires adjusting the font size
6 of an application in a computer. And these grounds add Nielsen to the
7 combination. And Nielsen discloses font size adjustment in computers. And
8 here, Patent Owner raises several arguments, again, and the one I'll address
9 now in the interest of time is that third bullet and how Patent Owner again
10 flips Petitioner's position on its head.
11 And Petitioner's combination uses Nielsen's font size adjustment in
12 the computer of the combinations of Jannard-740 and Rosenblatt; and Chen
13 and Rosenblatt. But Patent Owner suggests that Petitioner moves Nielsen's
14 font size adjustment into eyewear. And that's simply wrong.
15 And to close, Your Honors, there is no dispute that Independent
16 Claim 1 and its dependents are unpatentable. And for the other independent
17 claims, Patent Owner's only defense under Ground 4 is inoperability. A
18 theory contradicted by both the prior art and the '960 Patent's own meager
19 disclosure. Under Ground 7, Patent Owner tries two additional defenses,
20 non-analogous art and alleged missing limitation. But those rest on
21 mischaracterizations of Chen and Petitioner's arguments. And finally, Patent
22 Owner's challenges to the dependent claims are just more
23 mischaracterizations and none of Patent Owner's defenses withstand

1 scrutiny.
2 And in sum, every claim here simply repackages known eyewear
3 and known wireless functionalities. The record leaves no patentable
4 invention. And I respectfully reserve the remainder of my time.
5 JUDGE MARSCHALL: Thank you. You have three minutes left.
6 I'm sorry, do you have another question, Judge Hamann? No?
7 JUDGE HAMANN: I do not.
8 JUDGE MARSCHALL: If you could introduce yourself again just
9 so the record's clear. And then let me know if you'd like to reserve any time
10 for rebuttal.
11 MR. EUTERMOSER: Thank you, Your Honor. Brian Eutermoser
12 again on behalf of Patent Owner. I'll reserve five minutes, please. Let me
13 start by responding to Petitioner's assertion that our only defense is
14 inoperability for at least some of the claims. The defense is broader than
15 that. The argument is that there is no motivation to combine or more
16 specifically, the Petitioner has not carried its burden to prove motivation to
17 combine. In part because the combination or combinations Petitioner
18 proposes would be inoperable or have not been sufficiently explained by
19 Petitioner.
20 So let's start with Claim 11, and I'm looking at a Patent Owner's
21 Slide 4. And so as we've seen, Claim 11 requires an application module in
22 the eyewear with a wireless chip to communicate with a wireless-enabled
23 device. And the wireless device must be configured to recognize the

1 presence of a wearer.
2 JUDGE HAMANN: Counsel, this is Judge Hamann. And to sort
3 of pick up on what I asked Petitioner's counsel, obviously, we're looking
4 here at Claim 11 on your Slide 4. It seems to me that, you know, the first as
5 you have -- first two elements relate to the eyewear. And you have a frame
6 and basically a wireless chip or transceiver, in this context probably. And
7 that's all that I think, you know, that's on the eyewear.
8 And then the wherein part, as I understand the parties have argued
9 for, at least for this proceeding is -- can be a computer, for example, that has
10 this functionality. The computer receives, I think, the signal from the
11 wireless chip. And so I'm trying to understand the argument that Patent
12 Owner has put forward, you know, as I understand it from Patent Owner's
13 response on page 18 talking about the excessive size and power
14 requirements needed to implement Rosenblatt's teachings, that Petitioner,
15 you suggest has argued.
16 And I don't know exactly what that implementation is since it all
17 seems to be focused on the computer that receives the signals. I don't even
18 know if there's any change off Jannard from a structural standpoint.
19 Because Petitioner has talked about, you know, modifying with Rosenblatt's
20 key or its functionality. So it's what Petitioners said. So I'm just trying to
21 understand, really, the crux of the argument, at least to Claim 11. Because it
22 doesn't seem to be much more than the frame and the transceiver that's on
23 the eyewear. So I don't understand where the excessive size and priority

1 requirements come from in Patent Owner's argument.
2 MR. EUTERMOSER: Your Honor, we understand Petitioner to
3 -- Petitioner's position to be the same. I think that you do, and we don't
4 dispute it for purposes of this proceeding. I think our -- the argument is that
5 even though you have functionality and hardware on a separate wireless-
6 enabled device, the size and power requirements of -- required for the
7 hardware necessary to create the personal area network or whatever else it is
8 that signals the presence of a wearer to the remote device, that is the
9 technology, that is the hardware that has size, power, and weight
10 requirements that make Rosenblatt's keys that support that functionality
11 inappropriate and incompatible with eyewear.
12 JUDGE HAMANN: Where does Patent Owner argue that
13 structure, those power requirements, whatever, to implement Rosenblatt as
14 presence? I didn't take from Petitioner's arguments that it's in the eyewear.
15 MR. EUTERMOSER: I'm not sure I'm following, Your Honor.
16 JUDGE HAMANN: Looking at Claim 11, I think it's, you know,
17 eyewear, frame, with a transceiver on. And I think that's clear from the
18 record, at least as to that aspect of it. I'm not sure if that aspect is disputed
19 by Patent Owner for this proceeding that Jannard teaches that, you know.
20 This functionality of the computer -- we'll use the term loosely -- that
21 receives the signal, obviously, has its own power requirements and
22 everything else, but that's not tethered -- it seems disjoint to me. That's not
23 tethered to the eyewear, at least for Claim 11, that it's nothing more than a

1 signal being transmitted, arguably. Now, 22 may be a little bit more
2 involved with the particular information transmitted. But Claim 11 certainly
3 doesn't seem to be that limited.
4 MR. EUTERMOSER: Well, we understand Petitioner to identify a
5 wireless chip and a transmitter as disclosed by Rosenblatt as providing the
6 required functionality that it must be on the wireless -- or excuse me, that
7 must be on the eyewear. And that contains sufficient functionality to allow
8 the wireless-enabled device to recognize the presence of a wearer. So there
9 at least needs to be -- and maybe this is the same thing you're saying, Your
10 Honor, but we understand it to be the wireless chip and the transmitter.
11 And that's what our expert, Dr. Oliver, opines would have size,
12 weight, and power requirements based on Rosenblatt's disclosures of keys
13 that could provide that wireless chip and transmitter and that functionality of
14 creating the personal area network or whatever it is that lets -- again, that lets
15 the wireless-enabled device recognize the presence of the wearer. And it is
16 that functionality that we understand to be in the Rosenblatt's keys and then
17 essentially incorporated into the eyewear under Petitioner's proposed
18 combination.
19 JUDGE HAMANN: As I understand, Patent Owner's position is
20 more than just the transceiver that Jannard teaches on the eyewear.
21 MR. EUTERMOSER: Right. You need a chip and a transceiver, I
22 think, at least. Well, like I said, we understand Petitioner's position to be
23 that you at least have to have the chip and the transceiver and that has to be

1 sufficient to signal the presence of the wearer to the wireless-enabled device.
2 And we understand Rosenblatt's disclosures as Petitioner identifies them to
3 be things like creating a personal area network that then signals the -- that
4 then, you know, is recognized by the remote device.
5 JUDGE HAMANN: I understand Patent Owner's position. Thank
6 you.
7 MR. EUTERMOSER: So if we look at Rosenblatt's disclosure of
8 those keys -- the issue here is that Rosenblatt discloses a variety of different
9 devices that can serve as its keys. It also discloses multiple types of
10 functionality that those keys can provide. And it's not immediately clear
11 from the disclosure of Rosenblatt which goes with which. So what Dr.
12 Oliver did is look at the disclosure of Rosenblatt and say, essentially, okay,
13 we see these functionalities or this functionality that Petitioner has identified
14 as necessary to allegedly meet the claim limitation.
15 Now, which of Rosenblatt's keys within the understanding of a
16 person of ordinary skill would have allowed for that technology? And what
17 Dr. Oliver concluded was that only some of the larger keys, such as
18 cellphones and similarly sized devices would have provided the necessary
19 hardware to provide the functionality that's required. And that I don't think
20 is disputed by Petitioner's expert.
21 And again, Dr. Oliver, as I've just mentioned, in paragraph 50, for
22 example, points to size requirements, weight requirements. And he says that
23 the -- some of these smaller components -- some of the smaller keys

1 identified in Rosenblatt could provide limited connectivity, like RFID tag for
2 example and -- I might be looking at the wrong thing, but let me just speak
3 from memory, RFID and then a simple remote control via, I think, infrared
4 and radio.
5 But again, we understand Petitioner to identify something more
6 complex, to identify the presence of a wearer, such as a personal area
7 network. And it's those devices that Dr. Oliver's unrebutted testimony said
8 could only be contained in the larger keys disclosed by Rosenblatt. And
9 that's the basis for what Petitioner calls inoperability, but it's really a
10 motivation to combine. The argument is that if you had these large devices
11 and that were essentially incompatible with eyewear, there was no
12 motivation to combine that functionality with the eyewear of Jannard.
13 JUDGE HAMANN: So just in sum, it seems like Patent Owner's
14 argument is Jannard's transceiver on the eye frame is insufficient to allow
15 Rosenblatt's teachings for the presence determination; is that fair?
16 MR. EUTERMOSER: I think that is fair, Your Honor. Like,
17 again, we understand what Petitioner is pointing to as providing the claim
18 functionality to be to be incompatible with what's disclosed in Jannard.
19 JUDGE HAMANN: Thank you.
20 MR. EUTERMOSER: Let me turn to Ground 7, which substitutes
21 Chen for Jannard. And I will sum this up by saying essentially that we've
22 talked about non-analogous art. But I don't know that the Board needs to
23 reach that because the deficiency with this combination is the same as the

1 Ground 4 combination, and it depends on Rosenblatt.
2 And for the same reasons that Rosenblatt is incompatible with and
3 would not have motivated a person of ordinary skill to incorporate the claim
4 functionality into the Jannard reference. The same issues, probably
5 magnified, apply also to Chen.
6 And the Ground 7 combination fails for the additional reason, that
7 Chen does not disclose an application module. As we've explained in the
8 papers in our expert testimony, the thermal regulation cartridge is not the
9 same thing as the claimed application module, does not have a wireless chip.
10 And our position is that Petitioner has not done enough to show that there
11 was motivation to add -- first add a wireless chip to Chen before then
12 combining it with Rosenblatt.
13 Moving on to Claim 19. Again, this is the dependent claim that
14 adds a limitation of controlling the functionality of an automobile to awake
15 the wearer. Now, the issue here is there was no motivation to combine the
16 awake functionality of Gunaratne with the eyewear referenced in the rest of
17 the Petitioner's combination. For a number of reasons that we put -- set forth
18 in the briefing, I think one of the strongest ones is the Petitioner doesn't say
19 how this system would acquire a driver's image.
20 Now, it doesn't talk about a camera, for example. It talks about
21 eyewear. Eyewear is on the user's face, presumably. And there needs to be
22 some explanation from Petitioner as to how this combined system works.
23 And once again, as we've discussed in other proceedings, Petitioner has

1 failed to provide that explanation and fully describe that motivation. So it's
2 not enough just to say, okay, we have one reference that deals with
3 essentially a database for comparing drowsy faces to some other image.
4 Petitioner also needed to explain, okay, well how would we
5 integrate these two things? And at least in respect to the idea of image
6 acquisition, Petitioner has not done that and has not shown how any of the
7 other references or any of the teachings they rely on would have provided
8 that missing functionality.
9 Turning to Claim 24. Now, Petitioner addressed this one at length
10 during his presentation, this is the requirement of adjusting the brightness of
11 a computer. Now, I don't think there's any dispute that Rosenblatt discloses
12 a computer. I don't think there's any dispute that computer has a display.
13 But what is in dispute is whether Petitioner has shown that this claim
14 limitation is met.
15 There is no disclosure, and Petitioner has not explained why its
16 proposed combination discloses using a wireless device to adjust the
17 brightness on a computer display. Turning on a display is not the same thing
18 as adjusting the brightness. And there needs to be some disclosure in the
19 prior art and some explanation as to how and why a person of ordinary skill
20 would have combined the teachings to create this claim limitation. And it's
21 just not in the record.
22 The other thing I want to point out with Claim 24 --
23 JUDGE HAMANN: Counsel, just real quick on 24, it seems

1 -- again, I'm going to use, I think, the paraphrase where the computer is
2 configured to adjust the brightness, you know. I think, assuming that there
3 is a display, don't all displays have the ability to adjust brightness in the
4 computers -- computer to do that or is that -- I'm trying to understand the
5 crux of -- it seems like to a certain degree Petitioner is putting it certainly in
6 better words than I am by sort of saying that, that that would be a well-
7 known thing. Why is that not correct?
8 MR. EUTERMOSER: Well, we read the claim as requiring the
9 brightness control to happen from the eyewear or some remote device.
10 Otherwise, what we're talking about here is just a computer, an adjustable
11 display. And Patent Owner is not disputing in this proceeding that most
12 computers have a brightness adjustment of some kind.
13 JUDGE HAMANN: Thank you.
14 MR. EUTERMOSER: Turning to Claim 25. We have the same
15 issue here where, again, we have a reference, Nielsen, the Petitioner relies
16 on for font adjustment. But what we don't have is an explanation for how
17 the wireless-enabled device is configured to adjust the font size of the
18 application. And again, the assumption here, and I think the fair
19 interpretation of the claim language, is that needs to happen in connection
20 with, in combination with the eyewear. And again, that's what Petitioner has
21 failed to show.
22 A couple of other quick points. Petitioner's Slide 10, again,
23 references the *Abbott* and *Epstein* cases that we talked about earlier, which

1 in an apparent attempt to point to the alleged lack of disclosure in the '960
2 Patent specification as a reason to reduce the burden of showing sufficient
3 disclosure in the obviousness combination. I want to point out that in that
4 argument they have not made with respect to any claims other than 19 and
5 25. So the suggestion that they have made that argument in connection with
6 Claims 11 or 24 is inconsistent with their papers.
7 And just one final point, Petitioner throughout its briefing accuses
8 Patent Owner of advancing a non-enablement theory in this and other
9 proceedings. And that's a straw man. Like Petitioner, I don't think in any of
10 the proceedings, says that the prior art is not enabled. And that's not the
11 argument in any of these 103 cases. Petitioner's -- excuse me, Patent
12 Owner's argument is that the combination is not operable or not enabled.
13 That's not the same thing as arguing that a prior art disclosure is
14 not enabled. The point is that there is not sufficient motivation to combine
15 when there -- when the resulting combination has not been fully described.
16 It would not work in the way the Petitioner says it would.
17 Unless there are additional questions, I'll reserve the rest of my
18 time.
19 JUDGE HAMANN: I do not.
20 MR. EUTERMOSER: Thank you, Your Honor.
21 JUDGE MARSCHALL: There are about three and a half minutes
22 left, Patent Owner; and about two and a half to three minutes for Petitioner.
23 MR. PETERSON: Your Honors, first, I'd like to draw Your

1 Honors' attention to paragraph 43 of Rosenblatt. And paragraph 43, the very
2 first sentence reads, "Key 200 may be any suitable device that includes at
3 least communication circuitry 202 and memory 204." I think that establishes
4 the baseline for what a key must include. And these additional requirements
5 introduced by Patent Owner, I struggle to understand where those
6 requirements are coming from.
7 Turning to Claims 24 and 25 briefly. I think the discussions we've
8 had -- if you look on the slide, eyewear of Claim 22, and then there's a
9 wireless-enabled device. I'm going to show Claim 23 -- sorry, Claim 25
10 here also depends on Claim 22 introduces a wireless-enabled device.
11 I'm going to go back to Claim 22 at the beginning and show there
12 is no wireless-enabled device on this claim. So we've done our best to treat
13 the claim with respect and presume that what they meant is computer
14 because there is no wireless-enabled device. So this discussion around
15 where -- I mean difficult to say where the wireless-enabled device comes in,
16 other than that the claims seem to refer to, the computer performing these
17 further tasks of, for example, in 24. For example, the read would be wherein
18 the computer is configured to adjust the brightness or the volume of the
19 computer.
20 And with regards to Slide 10, I just wanted to briefly note that we
21 did discuss this legal principle, and this legal principle applies. And we did
22 observe throughout our briefing the sparse disclosure that these claims were
23 built on and how to the extent that there are features disclosed, they're all

1 disclosed in the prior art.
2 So unless Your Honors have any further questions, I'll rest our
3 case.
4 JUDGE HAMANN: I have a quick question about Claim 19 and
5 an argument that Patent Owner just put forward. And this gets to sort of the
6 operability. Obviously, where a computer in a car for Claim 19 and I'm not
7 going to pronounce the reference correctly but -- Gunaratne, I guess, Patent
8 Owner makes the point, where is the visual image of the face coming from if
9 you're -- the eyewear is facing outward? But is that relevant?
10 MR. PETERSON: I think, no, it's not relevant. So if we read the
11 claim limitations, Claim 16 requires that the wireless-enabled device is
12 located in an automobile. And then now, we're going to say that the
13 wireless-enabled device that's in the automobile is going to control the
14 functionality of the automobile to wake a wearer should the wearer fall
15 asleep.
16 I would say these features are entirely disjointed from the features
17 of Claim 11. So what we really have is an automobile was introduced and
18 then this automobile has some functionality. So we've shown a combination
19 where Rosenblatt discloses an automobile with this proximity
20 responsiveness. And that one of skill, for a myriad of reasons that we go to
21 in the petition, would have been motivated to add Gunaratne's functionality
22 to Rosenblatt and Jannard; and Rosenblatt and Chen's automobile in the
23 combination to add greater safety to that automobile so that it's safer to

1 drive.

2 JUDGE HAMANN: Okay. Thank you.

3 MR. PETERSON: And if no further questions, I'll --

4 MR. EUTERMOSER: Your Honor, regardless of what order they
5 combine the functionality in Claim 19, they have not shown that their
6 combination discloses their required claim limitations. And then my only
7 other point, Counsel referred back to Slide 10 and said that these are legal
8 principles that apply. Well, that may be, but Petitioners and Patent Owners
9 don't get credit for every legal principle that applies unless they've explicitly
10 made the argument in their papers. And that hasn't happened. And those
11 arguments should be deemed waived. Thank you, Your Honor.

12 JUDGE MARSCHALL: Thank you. This has been very helpful.
13 All counsel represented their parties well. And we'll take all this under
14 advisement. This hearing is adjourned.

15 (Whereupon, the above-entitled matter went off the record at 3:44
16 p.m.)

IPR2024-01030 (Patent 8,708,483 B2)
IPR2024-01069 (Patent 10,613,355 B2)
IPR2024-01070 (Patent 8,801,174 B2)
IPR2024-01071 (Patent 8,905,541 B2)
IPR2024-01072 (Patent 10,598,960 B2)

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