

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUXOTTICA OF AMERICA INC.,

Petitioner

v.

E-VISION OPTICS, LLC

Patent Owner

Case No. IPR2024-01069

Patent No. 10,613,355

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

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EXHIBIT LIST

Exhibit	Description
2001	U.S. Patent 4,254,451, <i>Sequential Flashing Device For Personal Ornamentation</i> , James A. Cochran, Jr., dated Mar. 3, 1981 (“Cochran”)
2002	U.S. Patent Application Pub. No. 2005/0230596, Radiation Monitoring System, Thomas A. Howell et al., dated Oct. 20, 2005 (“Howell-596”)
2003	U.S. Patent Application Pub. No. 2011/0013136, Electrically Controllable Optical Component Comprising An Array of Cells, Samuel Archambeau et al., dated Jan. 20, 2011 (“Archambeau-136”)

E-Vision Optics, LLC ("Patent Owner") submits this Preliminary Response to the Petition of Luxottica of America Inc. ("Petitioner") seeking *inter partes* review ("IPR") of U.S. Patent No. 10,613,355 ("the '355 patent").

I. INTRODUCTION

Patent Owner respectfully requests that the Board exercise its discretion and deny institution under 35 U.S.C. § 325(d) and *Advanced Bionics* because the same or substantially the same prior art previously was presented to the Patent Office, and Petitioner has not demonstrated that the Patent Office erred in a manner material to the patentability of the challenged claims. Indeed, all grounds in the petition rely on two primary references that were previously considered by the Patent Office: Howell-719 (Grounds 1-6) and Blum-130 (Grounds 5-7). And all secondary references were either before the Patent Office (Howell-158 and Vogt) or cumulative of art considered and rejected during prosecution (Sikonowiz, Thomas, and Eichelberger). To proceed with an IPR under such circumstances would be an inefficient use of Board and party resources.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

Discretionary denial under 35 U.S.C. §325(d) is warranted because "the same or substantially the same prior art or arguments previously were presented to the Office." *Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH*,

IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (citing 35 U.S.C. § 325(d)). When deciding whether to exercise its Section 325(d) discretion, the Board applies a two-part framework: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.* at 8. “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics*, Paper 6 at 8–9. “[T]his framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

Here, both prongs support a discretionary denial, and Petitioner's cursory, three-page discussion does nothing to counter this conclusion. (Petition at 73-76.) Petitioner argues against a discretionary denial, alleging new material in only two of the seven references cited by the petition (Sikonowiz and Eichelberger). (Petition at 73-74.) But both references are substantially the same as prior art previously before the Patent Office, and Eichelberger is asserted merely as an alternative tertiary reference.

Because the petitioned prior art is the same or substantially the same as prior art previously before the Patent Office, and there is no evidence the examiner erred, discretionary denial is appropriate.

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

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

Petitioner asserts seven grounds that include varied combinations of seven references, as shown below. (Petition at 17.)

Ground	References	Basis	Challenged Claims
1	<i>Howell-719</i> and Sikonowiz	§ 103	1, 3-13
2	<i>Howell-719</i> , Sikonowiz, Thomas, and Vogt	§ 103	4
3	<i>Howell-719</i> , Sikonowiz, and Eichelberger	§ 103	13
4	<i>Howell-719</i> , Sikonowiz, and Howell-158	§ 103	14-21
5	<i>Howell-719</i> , Sikonowiz, and Blum-130	§ 103	14-21
6	<i>Blum-130</i> in view of Sikonowiz and Howell-719	§ 103	1-21
7	<i>Blum-130</i> in view of Sikonowiz and Eichelberger	§ 103	13, 14, 18

The primary reference for each ground is italicized.

Four of the references—including both primary references for all seven grounds—are the same prior art previously considered by the Patent Office, and the three remaining references are substantially the same. Specifically, Howell-719, Blum-130, Howell-158, and Vogt were previously reviewed by the Patent Office. Sikonowiz is duplicative of Howell-596 and Archambeau-136, both of which were examined during prosecution. Thomas is duplicative of Vogt¹ and asserted against only a single dependent claim. And Eichelberger is duplicative of Howell-719. Thus, the petition presents no substantively new prior art disclosure and instead asks the Board to reconsider the examiner's previous findings.

Reference(s)	Grounds	Previous Consideration
Howell-719	1-6	Cited in signed IDS. (Ex. 1003 at 271.)
Sikonowiz	1-7	Cumulative.
Thomas	2	Cumulative.
Vogt	2	Listed in examiner's search report. (<i>Id.</i> at 397.)
Eichelberger	1, 7	Cumulative.
Howell-158	4	Cited in signed IDS. (<i>Id.</i> at 271)
Blum-130	5-7	Cited in signed IDS. (<i>Id.</i> at 1111, 1370.)

¹ Additionally, both Thomas and Vogt are duplicative of Cochran, which was examined during prosecution.

1. Howell-719, Howell-158, Blum-130, and Vogt are the same prior art previously before the Patent Office.

Howell-719, Howell-158, Blum-130, and Vogt were before the examiner during prosecution of the '355 patent.

a) Howell-719, Howell-158, and Blum-130

Howell-719, Howell-158,² and Blum-130 appear on Information Disclosure Statements in which the examiner signed and explicitly noted that “[a]ll references [were] considered except where lined through.” (Ex. 1003 at 271, 1111, 1370.) None were lined through, and all (Howell-719, Howell-158 as well as its issued patent, and Blum-130) are listed in the “References Cited” section on the face of the '355 patent. (Ex. 1001 at 3, 4, 5.)

Petitioner admits Howell-719, Howell-158, and Blum-130 were disclosed by the applicant, but argues that because these references were not relied on or discussed in a rejection, they categorically cannot satisfy the first prong of *Advanced Bionics*. (Petition at 73.) This is incorrect. The notice of proposed rule-making and Board decision Petitioner cites merely clarify that just listing a reference in an IDS “will not *automatically* satisfy the first prong of the analytical framework.”

² Howell-158 later issued as U.S. Patent No. 7,500,747, which is also disclosed in the signed IDS. (Ex. 1003 at 1112.)

JUUL Labs, Inc. v. NJOY, LLC, IPR2024-00160, Paper 10 at 11–12 (PTAB May 24, 2024) (citing 89 FR 28693, 28702 (Apr. 19, 2024)). This does not nullify or contradict the Board's previous guidance that references also need not have been included in a rejection to satisfy the first prong. *See Medtronic Corevalve LLC v. Speyside Medical, LLC*, IPR2021-00310, Paper 9 at 26 (PTAB July 23, 2021) ("Petitioner...seems to limit this factor to references that are expressly included in a rejection by the examiner. This factor is not so limited.").

Indeed, the Board has confirmed that "[p]reviously presented art includes... art provided to the Office by an applicant, such as on an [IDS]." *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8; *see also Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 18 at 15–16 (PTAB June 13, 2023) ("Our precedent holds that providing a document to the Office in an Information Disclosure Statement is sufficient to satisfy prong one of the *Advanced Bionics* analysis as long as that 'previously presented' art is 'the same or substantially the same' as that presented in the Petition."); *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01155, Paper 12 at 14 (PTAB Jan. 20, 2022) (reference that "Examiner acknowledged having considered . . . by signing the IDS" and that was listed as a cited reference in the patent "is beyond dispute" before the Office during prosecution) (denying institution (*Id.* at 20)).

Because Howell-719, Howell-158, and Blum-130 were not merely listed on an IDS but also signed by the examiner as having been previously reviewed—and appear on the face of the '355 patent—the first prong of *Advanced Bionics* is satisfied. That is, Howell-719, Howell-158, and Blum-130 are the same prior art previously presented to the Office. *See Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 7-9, 17-18 (PTAB Feb. 22, 2021) (denying institution based on § 325(d) because prior art reference was considered by examiner, as it was cited in IDS and listed on the face of the patent).

Moreover, Howell-158 claims priority to Howell-596's application (U.S. Application No. 11/078,857) which was cited by the examiner (Ex. 1003 at 526), substantively discussed in a rejection (Ex. 1003 at 520), and overcome by the applicant. Howell-158 not only claims priority to Howell-596, but also incorporates the application by reference. (Ex. 1007 at [0003].) In Ground 4, Petitioner relies on Howell-158's disclosure of an accelerometer. (Petition at 43-44.) While the specifications are not identical, the same subject matter in Howell-158 on which Petitioner relies was disclosed in Howell-596 and previously considered by the examiner. Specifically, Howell-596 discloses eyewear with electronics components integrated into the temple of a frame. (EX-2002 at [0007].) Howell-596's eyewear

includes an accelerometer to detect motion and sense when the glasses are being worn. (*Id.* at [0085].)

b) Vogt

First, Vogt is asserted only in Ground 2 against dependent claim 4 (“wherein the at least one electrical connective element is a conductive compressible member or a multi-conductor cable.”) (Petition at 35-37.) While not included on an IDS, Vogt is listed in the examiner’s EAST Search History. (*See, e.g.*, Ex. 1003 at 397.) Examiners are required to conduct prior art searches and prepare a history of the materials “searched and considered.” MPEP § 719.05. The search history is created “to provide a complete, accurate, and uniform record of what has been searched and considered,” and the MPEP demands that examiners take “great care” in recording the search process. *Id.* (search history “is of importance to anyone evaluating the strength and validity of a patent”). Here, the examiner searched for Vogt (as “5606743”) several times before allowing the claims of the ’355 patent: search history item S390 dated 12/1/2015 (*id.*); search history item S464 dated 06/20/2016 (*id.* at 1240); search history item S479 dated 02/21/2017 (*id.* at 1242); and search history item S484 dated 02/22/2017 (*id.* at 1244). Thus, the record shows that the examiner identified and considered Vogt during prosecution of the ’355 patent.

Second, even if the examiner's search results are deemed insufficient, Petitioner relies on Vogt (and, alternatively, Thomas) for the same limitation of dependent claim 4. Because Vogt is duplicative of Cochran (EX-2001) (prior art considered during prosecution), as discussed below, Vogt adds nothing new.

For example, the examiner rejected previously pending claim 11 based on Cochran, which the examiner found to teach "wherein the electrical connective element is a conductive compressible member or a multiconductor cable (plurality of conductive copper strips in flex circuit 30, column 3, lines 43-48)." (Ex. 1003 at 634.) Similarly, Petitioner contends that "Vogt discloses eyewear with '[m]ultiple conductors 32, which may comprise a flexible strip circuit,' extending through frame 14, as well as a 'single wire or *multi-wire conductor* 28.'" Given Cochran's disclosure, Vogt is cumulative.

Lastly, even if the Board were to find that Vogt presents new subject matter, it would not be an efficient use of the Board's time and resources to institute all seven grounds against all 22 claims, all of which rely on previously considered prior art arguments, based solely on Vogt, a reference which is relevant to only one dependent claim. *See Monolithic Power Sys., Inc. v. Volterra Semiconductor LLC*, IPR2020-01348, Paper 19 at 12-13 (PTAB Mar. 4, 2021) (discretionarily denial where Section 325(d) "is sufficiently implicated such that its statutory purpose

would be undermined by instituting on the remaining claims”); *Biofrontera Inc. v. DUSA Pharms.*, IPR2018-01585, Paper 10 at 14 (PTAB Feb. 26, 2019).

2. Sikonowiz, Thomas, and Eichelberger are cumulative.

Sikonowiz, Thomas, and Eichelberger are substantially the same and, therefore, cumulative of prior art that was considered by the examiner. As is the case here, a reference is “merely cumulative because patents disclosing the ‘relevant limitations of the claims’ were already before the examiner.” *Larson Mfg. Co. of S. Dakota v. Aluminart Prod. Ltd.*, 559 F.3d 1317, 1332 (Fed. Cir. 2009).

a) Sikonowiz

Petitioner relies on Sikonowiz, for all grounds, as disclosing the claimed conformal layer limitations. (*See, e.g.*, Petition at 23-25; *id.* at 74 (“All grounds in this petition rely on Sikonowiz’s teaching of a conformal coating”).) According to Petitioner, “the examiner cited no conformal coating in any reference analyzed in a rejection.” (*Id.* 73.) Petitioner is wrong.

During prosecution, the examiner initially rejected the pending claims as obvious over Cochran in view of Howell-596 and Archambeau-136. (Ex. 1003 at 520-24). The examiner found that “Howell[-596] discloses an eyewear system (paragraph 0007, figures 14G, 19)” (1) “wherein [the] conformal layer (1490) is moisture proof and seals electrical connections (epoxy, paragraph 0151) of an

electronic component” (*id.* at 521); (2) “the conformal layer protects the electronic components from external environmental damage” (*id.* at 522); and (3) the conformal layer is “a conformal coating,” in particular, “epoxy encapsulant” (*id.*).³ The examiner further found that “Archambeau[-136] discloses an eyewear system (figures 1-3)” wherein the conformal coating is “less than 1 mm” in thickness (*id.* at 523, citing Archambeau-136 paragraph 0017) and “brush applied, spray applied, or dip applied” (Ex. 1003 at 524.)⁴

³ See also EX-2002 at [0151] (“[T]he UV detector arrangement 1480, except for the optical filter 1489, can be encapsulated by a top encapsulant 1490... [T]he top encapsulant 1490 can be epoxy.”)

⁴ See also EX-2003 at [0017] (“[E]ach cell is hermetically sealed by depositing a continuous, homogeneous film of a plastic having a constant thickness of 10 nm to 500 nm (nanometres), said film being between the cells and the electrodes. This continuous film, forming a conformal coating.”)

Previously presented: EX-2002 (Howell-596), FIGs 14G and 19

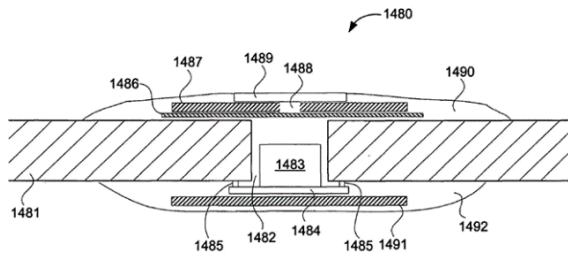


FIG. 14G

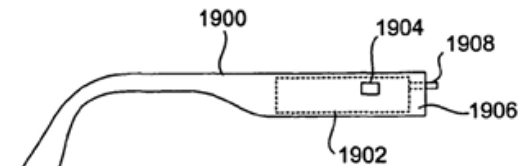


FIG. 19

Previously presented: EX-2003 (Archambeau-136), FIG 3

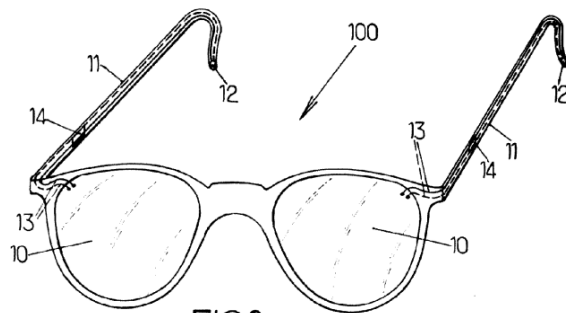


FIG. 3.

In a final rejection, the examiner added that Howell-596 “specifically teaches construction of a module housing in an eyewear system which excludes holes so as to be water proof (paragraph 0194).” (Ex. 1003 at 630.) Thus, not only did the examiner consider prior art related to the conformal layer limitations, but also references in the same field as the ’355 patent, i.e., electronic eyewear, unlike Sikowiz—a 1981 book on designing and creating printed circuits. In fact, the

portions of Sikonowiz cited by Petitioner do not even mention applying a conformal layer to electronic components in eyewear. Accordingly, Sikonowiz not only presents cumulative disclosure, but presents even less relevant disclosure than the prior art reviewed by the examiner.

b) Thomas

Like Vogt, discussed above, Thomas is cumulative of Cochran. *See* Section II(A)(1)(b), *supra*. Thomas is asserted only in Ground 2 against dependent claim 4 (“wherein the at least one electrical connective element is a conductive compressible member or a multiconductor cable.”), and only as an alternative argument. (Petition at 35-37.) Here, Petitioner contends that “Thomas discloses a ‘flexible multiple flat conductor electric cable.’” But as explained above, the examiner previously considered and discussed Cochran, which discloses a “plurality of conductive copper strips in flex circuit.” (Ex. 1003 at 634.) Accordingly, Thomas’s disclosure is duplicative of Cochran’s.

Moreover, Petitioner does not rely on Thomas as allegedly disclosing any of the independent claim limitations. Thus, even if Thomas presented new prior art subject matter (which it does not) and even if Petitioner’s obviousness assertions were correct (which they are not), Ground 2 would still rise or fall based on Petitioner’s request that the Board reconsider the subject matter of Howell-719 and

Sikonowiz as allegedly rendering obvious independent claim 1. Accordingly, discretionary denial would still be appropriate. *See Monolithic Power*, IPR2020-01348, Paper 19 at 12-13.

c) Eichelberger

Petitioner relies on a disclosure of Eichelberger that is substantially the same and, therefore, cumulative of Howel-719, which was previously before the Patent Office. *See* Section II(A)(1)(a), *supra*. Eichelberger is asserted in Grounds 3 and 7 against independent claims 13 and 14 and dependent claim 18 with respect to the capacitive touch switch limitations.

Perhaps because Howell-719 was previously before the Patent Office and Petitioner wished to avoid a discretionary denial, the petition presents two additional grounds (challenging only three claims) relying on Eichelberger's disclosure of a "capacitive touch switch" as an alternative to Howell-719's disclosure of a capacitive touch switch. *See, e.g.*, Petition at 37-41, 66-68. Petitioner's own assertions that both Howell-719 and Eichelberger disclose a capacitive touch switch undermines Petitioner's claim that Eichelberger presents new, noncumulative prior art. *Id.* at 74. Below is a comparison of Howell-719's disclosure, cited in Ground 1, which was previously before the Patent Office, and Eichelberger's disclosure cited in Grounds 3 and 7.

Ground 1	Grounds 3 & 7
“Howell-719’s glasses include a switch. <i>E.g.</i>, Ex. 1004 ¶28... Howell-719 discloses that its switch can be a <i>capacitive touch switch</i>. <i>Id.</i> ¶69. ‘The switch can be activated depending on electrical forces,’ including where ‘the electrical force depends on capacitive effect.’ Ex. 1004 ¶82. ‘By changing the capacitance,’ such as ‘by placing one’s finger over a metallic pad,’ one turns the switch on and off.” (Petition at 21.)	“Eichelberger discloses a capacitive touch switch that includes a double-sided printed circuit board 16 on which electrodes 18b and 18c are fabricated. Ex. 1010 3:20–23, 3:43–47, 3:54–57.” (Petition at 39 (also including Eichelberger figs. 1a and 1b shown below).) “As discussed in Ground 3, Eichelberger discloses a capacitive touch switch with multiple electronic components disposed thereon.” (Petition at 66.)

As demonstrated by the above comparison, Petitioner relies on disclosure in Eichelberger which is substantially the same as Howell-719—i.e., prior art that was previously before the Patent Office.

* * *

Petitioner asks the Board to reconsider the same or substantially the same prior art previously considered by the examiner. Petitioner's reliance on two allegedly new, duplicative references does not insulate the petition from discretionary denial where the new references do not distinguish Petitioner's grounds from arguments previously considered by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 14-17 (denying institution despite petitioner's combining a previously examined reference with three new references, finding new references duplicative of disclosure and arguments already considered by the Office).

B. Petitioner Failed to Establish that the Office Materially Erred

In part two of the *Advanced Bionics* framework, *Becton Dickinson* factors (c), (e), and (f) are considered to determine whether the petitioner has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10; *see Becton Dickinson*, IPR2017-01586, Paper 8, 17–18 (designated as informative). The petitioner bears the burden of showing that the examiner materially erred. *Fitesa Simpsonville, Inc. v. The Procter & Gamble Co.*, IPR2023-01451, Paper 11, 19 (PTAB Mar. 20, 2024). Here, Petitioner has failed to carry its burden.

Petitioner asserts that the examiner “failed to appreciate the teachings of Howell-719, Howell-158, and Blum-130” (Petition at 75) and cites *Quasar* to

support its assertion that citation of a reference in an IDS alone, and not in a rejection, is itself evidence of a material error. (Petition at 75.) *See also, Quasar Sci. LLC v. Colt Int'l Clothing, Inc.*, IPR2023-00611, Paper 10 at 14 (PTAB Oct. 10, 2023). *Quasar* supports no such conclusion.

The Board in *Quasar* reviewed a petition which cited two references previously presented to the Office as part of an IDS and four new references alleged to be substantially similar to references listed in an IDS or the examiner's search results, none of which were ever substantively discussed. *Quasar*, IPR2023-00611, Paper 10 at 13-14. Within this context, the Board explained that "[i]f the record of the Office's previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive." *Id.* at 14. The Board declined to exercise its discretion in *Quasar* where the petitioner "demonstrate[d] that the Office overlooked the prior art's teachings of the limitations that were the basis for allowing the challenged claims." *Id.* at 15. That is not the case here.

The record here shows that the examiner performed searches using Howell-719 (which Petitioner asserts discloses a capacitive touch switch) (Ex. 1003 at 285 (search history item L345 dated 6/24/2015), 385 (search history item S284 dated 6/24/2015)), along with variations of "capacitive" and "switch." (*Id.* at 1568 (search

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history items L40 and L41 dated 11/13/2019).) The examiner also reviewed and signed all submitted IDSs, and even rechecked and corrected information disclosed in those IDSs:

U.S. PATENT DOCUMENTS					
Examiner Initials ⁴	Cite No. ¹	Document Number Number-Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
/G.W.O/ Change(s) applied to document, /J.K./ 1/9/2019 ↓	1.	D755,281	05-03-2016	BLUM et al.	
	2.	4,873,029	10-10-1989	BLUM	
	3.	5,147,585	09-15-1992	BLUM	
	4.	5,178,800	01-12-1993	BLUM	
	5.	5,219,497	06-15-1993	BLUM	
	6.	5,526,067	06-11-1996	CRONIN et al.	
	7.	5,774,273	06-30-1996	BORNHORST 1998	
	8.	5,861,934	01-19-1999	BLUM et al.	
	9.	6,136,926	12-26-2000	WATANABE	
	10.	6,142,941	11-07-2000	BENHALIMA et al.	
	11.	6,433,913	08-13-2002	BAUER et al.	
	12.	6,491,391	12-10-2002	BLUM et al.	
	13.	6,517,203	02-11-2003	BLUM, et al.	
	14.	6,619,799	09-16-2003	BLUM et al.	
	15.	6,733,130	05-11-2004	BLUM et al.	
	16.	6,778,246	08-17-2004	SUN et al.	
	17.	6,857,741	02-22-2005	BLUM et al.	
	18.	6,918,570 07/2005	~~03-18-2004~~	~~BLUM, et al.~~ Ahn	
	19.	6,927,894	08-09-2005	BLUM et al.	
	20.	7,018,040	03-28-2006	BLUM et al.	
	21.	7,023,594	04-04-2006	BLUM et al.	
	22.	7,077,519	07-18-2006	BLUM et al.	
Examiner Signature: /GARY W O'NEILL/		Date Considered		08/09/2018	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

(Ex. 1003 at 1370.) Moreover, and contrary to Petitioner's assertion, the examiner did not allow the claims based simply "on the recitation of a capacitive touch switch." (Petition at 75.) Rather, the examiner participated in at least three interviews with the applicant and/or applicant's representative regarding this limitation. (Ex. 1003 at 1101.) In one instance, the examiner explained that "the

'touch switch' limitation of claim 29 was broader than the other independent claims 1 and 28, in that those require a capacitive type of touch switch *as arranged according to the entirety of those claims.*" (*Id.*) Petitioner does not address the specified arrangement in relation to the asserted art.

Thus, any suggestion that the examiner's consideration of cited prior art references was not robust or substantive is unfounded and contrary to the well-established principle that Examiners are "presumed to have done their job." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1574 (Fed. Cir. 1992); *see also Advanced Bionics*, IPR2019-01469, Paper 6 at 9 ("If reasonable minds disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.").

The examiner made no error in issuing the '355 patent over Howell-719, Howell-158, Blum-130, and Vogt, and Eichelberger, Thomas, and Sikonowiz provide no new disclosure.

C. Petitioner Offers No Other Facts to Support Institution

Petitioner cites no additional evidence that warrants reconsideration of the references that the Patent Office already considered and rejected. The only purported "additional" evidence that the Petitioner cites is its expert declaration. (Petition at 76; Ex. 1002.) But a "declaration alone is insufficient." *Juniper*

Networks, Inc. v. Mobile Telecomm. Techs., LLC, IPR2017-00642, Paper 31 at 23 (PTAB Mar. 14, 2018). To be relevant, the declaration must set forth additional facts and evidence—here, explaining why the Patent Office was wrong in its prior consideration of the same or cumulative art. Petitioner's expert declaration fails to do so. Instead, Petitioner's expert declaration relies on the same references for the same disclosures cited in the petition, which, as explained above, the Patent Office considered during prosecution. Thus, Petitioner's failure to set forth a basis to reevaluate that which the Patent Office already evaluated supports denial of the petition.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board exercise its discretion to deny institution.

Date: October 11, 2024

Respectfully submitted,

KING & SPALDING LLP

BY: /Brian Eutermoser/
Brian Eutermoser
Registration No. 64,058

Attorney for Patent Owner
e-Vision Optics, LLC

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. § 42.24 have 3770 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 365 v.2022.

Date: October 11, 2024

Respectfully submitted,

KING & SPALDING LLP

BY: /Mikaela Stone/

Mikaela Stone

Registration No. 70,404

*Attorney for Patent Owner
e-Vision Optics, LLC*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and all supporting **EXHIBITS 2001 – 2003** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on October 11, 2024 and courtesy copies were also served via electronic mail, in their entireties on the following:

Ali S. Razai (Reg. No. 60,771)
2AZR@knobbe.com
LuxotticaIPR-483@knobbe.com
Knobbe, Martens, Olson, & Bear LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel: 949-760-0404
Fax: 949-760-9502

Joseph F. Jennings (Reg. No. 40,664)
2JFJ@knobbe.com
Jacob L. Peterson (Reg. No. 65-096)
2JUP@knobbe.com
Nathan D. Reeves (Reg. No. 77,806)
2NDR@knobbe.com
Knobbe, Martens, Olson, & Bear LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel: 949-760-0404
Fax: 949-760-9502

Counsel for Petitioner
Luxottica of America Inc.

Date: October 11, 2024

KING & SPALDING LLP

BY: /Brian Eutermoser/
Brian Eutermoser
Registration No. 64,058

Attorney for Patent Owner
e-Vision Optics LLC.