

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 SUR-REPLY TO
PETITIONER'S PRELIMINARY REPLY**

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Nothing in Petitioner's Reply alters the conclusion that the Board should deny institution under 35 U.S.C. § 325(d) and *Advanced Bionics*.¹

Discretionary denial is warranted because Sikonowiz is cumulative. Petitioner misrepresents the examiner's reasons for allowance, which do not concern the conformal layer and are "set forth in the *first and third paragraphs of page 7* of Applicant's Remarks filed 04/27/18" and "the *first paragraph of page 6* of Applicant's Supplemental Remarks, filed 08/14/18." (EX-1003, 1108 (emphases added).) Rather, the examiner suggested including limitations relating to a capacitive touch switch to distinguish over the prior art:

Applicant is amending claim 1 to recite "a *capacitive touch switch* coupled to at least one electronic component in the electronics assembly." The proposed combination of Cochran and Howell lacks such a *capacitive touch switch*. Therefore, the eyewear system of claim 1 is patentably distinct from the proposed combination of Cochran and Howell.

(*Id.*, 765 (emphases added).)

Applicant understands that claims 1, 4, 10, 11, and 20-28 are allowable and that new independent claim 29 would be allowable if amended to recite "*a capacitive touch switch*" and to address potential

¹Petitioner does not dispute that Blum-130, Howell-158, and Vogt were previously reviewed by the Office and Thomas is duplicative of Vogt and Cochran. (Paper 9.)

indefiniteness issues. Applicant is amending the claims in line with Examiner O'Neill's suggestions.

(*Id.*, 1095 (emphases added).) Indeed, the examiner rejected Applicant's arguments that Cochran and Howell-596 did not disclose a conformal layer (*id.*, 627-30)—i.e., the very same arguments Petitioner makes in asserting that Sikonowiz is “new.” (*Compare* Paper 9, 1-2, with EX-1003, 612-14.²) It is not.

Lastly, prior art need not have been “applied” by the examiner, as Petitioner urges. *See Biocon Pharma Ltd. v. Novartis Pharms. Corp.*, IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021) (“Examiner considered [the reference] because it is listed on the IDS and the Examiner signed the IDS”). As to the second prong of *Advanced Bionics*, Petitioner fails to carry its burden. (Paper 9, 4 (shifting the burden). Nonetheless, the examiner explained that additional limitations, like a capacitive touch switch, would narrow the claims. (EX-1003, 629-630, 752.)

² Petitioner's purpose-based argument regarding Archambeau's conformal layer is misplaced. (*See* EX-1003, 636-37 (declaring “it would have been obvious to use the p[r]otection application as taught by Archambeau” with the eyewear system taught by Cochran and Howell-596 “for the purpose of providing a complete hermetic seal while controlling component amounts” or “optimizing operating voltages.”).)

Date: December 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY** was served by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS) on December 12, 2024 and a courtesy copy was also served via electronic mail, in its entirety on the following:

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