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. IPR2024-01070
Patent No. 8,801,174

PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S PRELIMINARY REPLY

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Patent Trial and Appeal Board
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I. DENIAL UNDER SECTION 314(a) IS APPROPRIATE

Petitioner's schedule update is applicable only to Petitioner's parallel case, in which claim construction is complete and the parties await a *Markman* order. But in the parallel Lenovo case, expert reports are due Feb-March 2025; trial is set for July 2025. (EX-2015 1.) Given both cases' schedule, discretionary denial is appropriate.

Patent Owner is unaware of any post-Memo decision discretionarily denying institution in these circumstances, but *Fintiv*'s goal of avoiding duplicative litigation and wasted resources is best served by an exception on these facts. *See* Memo, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022). IPRs were meant to "limit unnecessary and counterproductive litigation costs," *id.*, 1, and require "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2020).

The Board has recognized duplicative-proceeding potential in multi-defendant litigation. In *Cisco Systems, Inc. v. Estech Systems, Inc.*, decided pre-Memo, the Board found, despite the petitioner's *and* the RPIs' *Sotera* stipulations, ongoing invalidity litigation by others favored discretionary denial. IPR2021-00329, Paper 13 at 11-15 (July 6, 2021). Here, because of parallel Lenovo litigation, Petitioner's stipulation does not address "concerns of duplicative efforts" or "potentially conflicting decisions." *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19

(Dec. 1, 2020). If the Board institutes here, the Board and the district court will labor to decide the same issues, and even if the Board finishes first, the race will "increase … litigation costs," create "potential conflict between the … (PTAB) and district court proceedings," and increase the "potential for inefficiency and gamesmanship." Memo at 1.

Not one of Petitioner's cited cases share the same facts here. In *Hilti AG v. Specified Techs. Inc.*, there was no unbound third party in parallel litigation, no overlap in written prior art, and no dispute of the stipulation until patent owner's surreply. IPR2024-00193, Paper 17 at 10 (May 14, 2024). In *Meta Platforms, Inc. v. Immersion Corp.*, there was no unbound third party in parallel litigation, and the stipulation removed all post-institution overlap. IPR2023-00946, Paper 13 at 15 (Dec. 8, 2023). In *Box, Inc. v. Topia Technology, Inc.*, patent owner did not demonstrate actual overlap with parallel litigation; moreover, the Board would not have discretionarily denied "even absent the stipulation." IPR2023-00427, Paper 17 at 8, 19 (Aug. 4, 2023). In *Structural Wrap, LLC v. System Stormseal Pty Ltd.*, patent owner did not apply *Fintiv* factors to third-party litigation, so the Board could not assess the need for denial. IPR2024-00084, Paper 13, at 13-15 (May 9, 2024).

Here, Lenovo raises identical invalidity grounds; Patent Owner has addressed the *Fintiv* factors based on both parallel litigations; and, despite the stipulation, parallel litigation will proceed to trial on the same grounds. (Paper 9, 1-3.)

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** and **UPDATED EXHIBIT LIST, EXHIBIT 2015** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on December 12, 2024 and courtesy copies were also served via electronic mail, in their entireties on the following:

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