

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LUXOTTICA OF AMERICA INC.,  
Petitioner,

v.

E-VISION OPTICS, LLC,<sup>1</sup>  
Patent Owner.

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IPR2024-01070  
Patent 8,801,174 B2

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

O'HANLON, *Administrative Patent Judge*.

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

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<sup>1</sup> The Notice of Filing Date Accorded lists in its case style an additional party as a petitioner that Petitioner does not identify as being a petitioner. Thus, we have corrected the case style here, and the parties should use the corrected case style going forward. If the parties have concerns regarding these corrections to the style, they should promptly request a conference with the Board.

## I. INTRODUCTION

### A. Background

Luxottica of America Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–19 (“the challenged claims”) of U.S. Patent No. 8,801,174 B2 (Ex. 1001, “the ’174 patent”). Paper 2 (“Pet.”), 1. E-Vision Optics, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 9, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 11, “Prelim. Sur-reply”).

Institution of an *inter partes* review is authorized by statute only when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). A decision to institute may not institute on fewer than all claims challenged in the petition. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1354, 1359–60 (2018). If the Board institutes a trial, the Board will institute on all challenges raised in the petition. *See* 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons set forth below, upon considering the parties’ briefs and evidence of record, we conclude that the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one of the challenged

claims. Thus, we institute *inter partes* review of all challenged claims based on all asserted grounds.

#### B. Real Parties in Interest

Petitioner identifies itself and Luxottica Group S.p.A. as real parties in interest. Pet. 91. Petitioner asserts that EssilorLuxottica S.A. is the parent company of each of these entities. *Id.*

Patent Owner identifies itself as the sole real party in interest.  
Paper 4, 1.<sup>2</sup>

The parties are reminded of their continuing obligation to update their mandatory notice information “within 21 days of a change of the information.” 37 C.F.R. § 42.8(a)(3).

#### C. Related Matters

The parties indicate that the ’174 patent is the subject of the following district court proceedings:

*e-Vision Optics, LLC v. Luxottica Group SpA*, No. 8-23-cv-02013 (C.D. Cal. filed October 26, 2023) (“the Related Litigation”), and

*e-Vision, LLC v. Lenovo Group Ltd.*, No. No. 8-23-cv-01860 (C.D. Cal. filed October 3, 2023).

Pet. 91; Paper 4, 1.

#### D. The Challenged Patent

The ’174 patent discloses eyeglass frames “having one or more conductors that may be utilized to form a part of a conductive path from the

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<sup>2</sup> Patent Owner filed a duplicate copy of its mandatory notices as Paper 7.

temple to the lens housing of the frames.” Ex. 1001, 1:39–42. Figure 2 illustrates an example of such eyeglasses and is reproduced below.

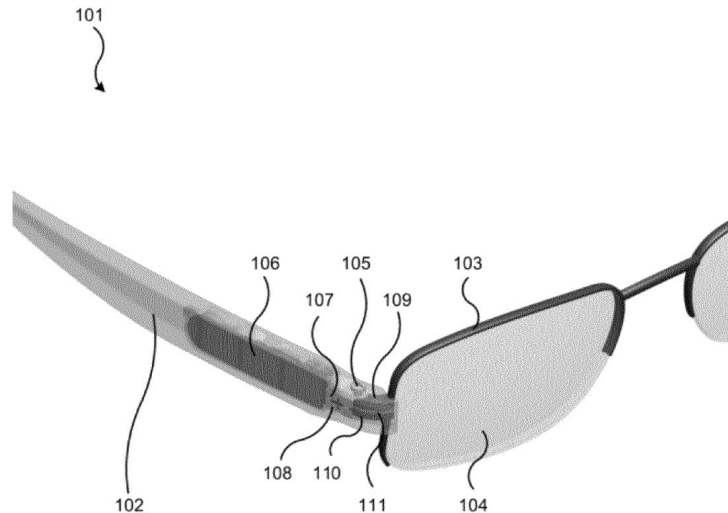


Figure 2 shows eyewear 101 having temple 102, lens housing 103 supporting lens 104, and fastener 105. *Id.* at 15:23–26. The lens “may be an electronic lens, such as a dynamic lens or an electro-chromic lens, and may utilize power and/or control signals received from an electronic component(s) disposed on, or within, the temple 102 or the lens housing 103.” *Id.* at 15:30–33. The eyewear includes electronics module 106, “which may comprise a plurality of electronic components such as a power source (e.g. a battery), a controller, and/or a sensor.” *Id.* at 15:42–45. The electronics module may utilize a capacitive touch switch as a “back bone” on which the electronic components are disposed. *Id.* at 21:39–46. The electronics module is coupled to temple 102 in part by first electrical conductor 107 and second electrical conductor 108. *Id.* at 15:45–48. The fastener is adapted to compress or hold the first and second electrical conductors in electrical contact with first conductive path 109 and second conductive path 110, respectively. *Id.* at 15:51–55.

Insulator material 111 is disposed between and electrically isolates the first and second conductive paths. *Id.* at 15:61–64. The conductive paths electrically connect to one or more electrical contacts of the electro-active lens or electronic devices disposed in the lens housing or on the other temple of eyewear. *Id.* at 15:67–16:6.

#### E. The Challenged Claims

Petitioner challenges claims 1–19 of the '174 patent. Claims 1 and 15 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below.

1. A first device, comprising:
  - a lens housing adapted to support a first lens and a second lens;
  - a first temple movably coupled to the lens housing;
  - a second temple movably coupled to the lens housing;
  - an electronics module disposed at least partially within the first temple;
  - a first electrical conductor coupled to the first temple,wherein a first conductive path is provided from the first temple to the lens housing at least in part by the first electrical conductor; and
  - a second electrical conductor coupled to the first temple,wherein a second conductive path is provided from the first temple to the lens housing at least in part by the second electrical conductor;
- wherein the first and second electrical conductors are configured to couple the electronics module to the first temple to constrain the electronics module.

Ex. 1001, 32:13–30.

F. Asserted Grounds of Unpatentability

The Petition relies on the following prior art references:

| Name          | Reference                                                                                                                                    | Exhibit |
|---------------|----------------------------------------------------------------------------------------------------------------------------------------------|---------|
| Brunton       | US 2,915,598, issued December 1, 1959                                                                                                        | 1003    |
| Kokonaski-999 | WO 2010/080999 A1, published July 15, 2010                                                                                                   | 1004    |
| Hattori-913   | JP S58-113913, published July 7, 1983                                                                                                        | 1006    |
| Delorenzo     | US 3,883,701, issued May 13, 1975                                                                                                            | 1007    |
| Carling       | GB 799,294, published August 6, 1958                                                                                                         | 1008    |
| Eichelberger  | US 4,290,052, issued September 15, 1981                                                                                                      | 1010    |
| Kokonaski-579 | Certified copy of U.S. Provisional Patent Application No. 61/157,579, dated January 23, 2010, available under PCT/US2010/020498 <sup>3</sup> | 1012    |
| Howell-596    | US 2005/0230596 A1, published October 20, 2005                                                                                               | 1015    |
| Sikonowiz     | Sikonowiz, Walter, <i>Designing and Creating Printed Circuits</i> , Hayden Book Company, Inc., published 1981                                | 1016    |

Petitioner asserts the following grounds of unpatentability:

| Claim(s) Challenged  | 35 U.S.C. §         | Reference(s)/Basis     |
|----------------------|---------------------|------------------------|
| 1, 2, 4, 9, 12       | 102(b) <sup>4</sup> | Brunton                |
| 1–4, 9, 12           | 103(a)              | Brunton                |
| 7, 8, 13             | 103(a)              | Brunton, Carling       |
| 1, 2, 4–6, 9, 12, 14 | 103(a)              | Kokonaski-999, Brunton |

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<sup>3</sup> Petitioner asserts that the publication date of Kokonaski-579 is July 15, 2010. Pet. 11.

<sup>4</sup> The application resulting in the '174 patent was filed prior to the date when the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284 (2011), took effect. Thus, we refer to the pre-AIA version of sections 102 and 103.

| Claim(s) Challenged | 35 U.S.C. § | Reference(s)/Basis                     |
|---------------------|-------------|----------------------------------------|
| 1, 2, 5, 6, 12, 13  | 103(a)      | Hattori                                |
| 1, 2, 4, 9, 12, 13  | 102(b)      | Delorenzo                              |
| 1–4, 9–13           | 103(a)      | Delorenzo                              |
| 15–19               | 103(a)      | Kokonaski-999, Kokonaski-579           |
| 15, 16, 18          | 103(a)      | Howell-596, Eichelberger,<br>Sikonowiz |

Pet. 12. Petitioner submits a declaration of John M. Feland, III, Ph.D. (Ex. 1003, “Feland Declaration”) in support of its contentions. Patent Owner does not submit any witness testimony with its Preliminary Response.

## II. DISCRETIONARY DENIAL

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 314(a) to deny institution in light of the Related Litigation. Prelim. Resp. 2–18. For the reasons set forth below, we decline to do so.

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution. In determining whether to exercise that discretion on behalf of the Director, we are guided by the Board’s precedential decision in *NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential).

In *NHK*, the Board found that the “advanced state of the district court proceeding” was a “factor that weighs in favor of denying” the petition under § 314(a). *NHK*, Paper 8 at 20. The Board determined that “[i]nstitution of an *inter partes* review under these circumstances would not be consistent with ‘an objective of the AIA . . . to provide an effective and

efficient alternative to district court litigation.” *Id.* (citing *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (precedential in relevant part)).

“[T]he Board’s cases addressing earlier trial dates as a basis for denial under *NHK* have sought to balance considerations such as system efficiency, fairness, and patent quality.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (precedential). *Fintiv* sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.* We are also guided by the Director’s Memorandum, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*, issued June 21, 2022 (“Guidance Memo”),<sup>5</sup> which provides several clarifications concerning the application of the *Fintiv* factors. One such clarification instructs that “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Guidance Memo 3; *see also id.* at 7–8. Thus, we will not exercise our delegated discretion to deny institution if a petitioner makes a stipulation similar to that provided in *Sotera Wireless, Inc. v. Masimo Corp.*,

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<sup>5</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential in relevant part).

Petitioner stipulates that, upon institution of *inter partes* review in this proceeding, it will not pursue in the Related Litigation “invalidity of the ’174 patent based on any ground Petitioner raised or reasonably could have raised in this petition.” Pet. 89.

Patent Owner acknowledges that Petitioner provided a stipulation, but argues that “the stipulation is meaningless[] because the parties will have already expended the resources to litigate validity of the challenged patent through expert reports.” Prelim. Resp. 10. Patent Owner argues that, because “Lenovo has filed no such stipulation[,] . . . even if the Board were to institute this proceeding, the parallel district court case against Lenovo will move forward to determine the validity of the challenged patent on the very same prior art at issue in the petition.” *Id.* at 13; *see also* Prelim. Sur-reply 1–2 (presenting similar arguments).

As correctly noted by Petitioner (*see* Prelim. Reply 1), the Guidance Memo is “binding agency guidance.” Guidance Memo at 3. “[T]he PTAB will not discretionarily deny institution of an IPR . . . in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” *Id.* at 7. The Guidance Memo makes no exception for parallel litigation in which expert reports have been exchanged or litigation with a third party involving the challenged patent. Nor has Patent Owner identified any instance in which the Board has determined there to be such exceptions to the Director’s guidance. Indeed, Patent Owner admits that it “is unaware of any post-

[Guidance] Memo decision discretionarily denying institution in these circumstances.” Prelim. Sur-reply 1.

Accordingly, pursuant to the Guidance Memo, we decline to exercise discretion under 35 U.S.C. § 314(a) to deny institution.

### III. PATENTABILITY ANALYSIS

#### A. Principles of Law

##### *1. Anticipation*

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

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

## 2. Obviousness

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) when in evidence, any objective evidence of nonobviousness.<sup>6</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

### B. Level of Ordinary Skill in the Art

The level of ordinary skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). The person of ordinary skill in the art is a hypothetical person presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). In determining the level of ordinary skill in the art, we may consider certain factors, including: “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Best*

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<sup>6</sup> At this stage of the proceeding, the parties have not directed us to any such objective evidence.

*Med. Int'l, Inc. v. Elekta Inc.*, 46 F.4th 1346, 1353 (Fed. Cir. 2022) (quoting *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007)).

“The patent’s purpose can also be informative.” *Id.*

Petitioner contends that a person having ordinary skill in the art at the time of the invention “would have had at least a bachelor’s degree in mechanical or manufacturing engineering; mechatronics; electrical engineering plus coursework in mechanical engineering, manufacturing engineering, or mechatronics; or a similar technical degree.” Pet. 9 (citing Ex. 1002 ¶¶ 28–31). Petitioner contends that “[w]ork experience could substitute for formal education and additional formal education could substitute for work experience.” *Id.* at 9–10 (citing Ex. 1002 ¶¶ 28–31).

Patent Owner does not contest Petitioner’s proposed definition or proffer a definition of its own. *See generally* Prelim. Resp.

We find Petitioner’s definition to be consistent with the problems and solutions disclosed in the ’174 patent and prior art of record, and adopt it as our own for purposes of this Decision. *See, e.g., GPAC*, 57 F.3d at 1579 (approving the determination of the level of ordinary skill in the art by appeal to the references of record).

### C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). “[T]he ordinary and

customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention” and “after reading the entire patent.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1321 (Fed. Cir. 2005) (en banc). In addition to the specification and prosecution history, we also consider use of the terms in other claims and extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Id.* at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (alteration in original) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner contends that “no claim terms require an express construction to resolve the challenges here.” Pet. 10. Petitioner notes that “the ’174 patent describes a number of claim terms, many in quotation marks, by what the terms refer to or may refer to” and asserts that “[t]hese descriptions in the specification are consistent with the plain and ordinary meaning of these claim terms.” Pet. 10–11 (citing Ex. 1002 ¶¶ 50–51).

Patent Owner does not oppose Petitioner’s contentions or proffer any constructions of its own. *See generally* Prelim. Resp.

At this time, we determine that no express construction of any term is necessary. We note that this determination does not preclude the parties from arguing their proposed constructions of the claims during trial. Indeed,

the parties are hereby given notice that claim construction, in general, is an issue to be addressed at trial. A final determination as to claim construction will be made at the close of the proceeding, after any hearing, based on all the evidence of record. The parties are expected to assert all of their claim construction arguments and evidence during the trial, as permitted by our rules.

#### D. Asserted Anticipation by Brunton

Petitioner argues that claims 1, 2, 4, 9, and 12 are anticipated by Brunton. Pet. 13–23. In support of its showing, Petitioner relies upon the Feland Declaration. *Id.* (citing Ex. 1002). Patent Owner does not contest Petitioner’s assertions. *See generally* Prelim. Resp. We have reviewed Petitioner’s assertions and supporting evidence. For the reasons discussed below, and based on the record before us, we determine that Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one challenged claim is anticipated by Brunton.

##### *1. Summary of Brunton*

Brunton discloses hearing aids removably mounted in a pair of spectacles. Ex. 1003, 1:15–23. Elements of the hearing aid are “installed in a unit, such as a cartridge, and the unit [is] adapted to be inserted in a cavity in one of the temples of [the] pair of spectacles.” *Id.* at 2:34–39. Figure 1 illustrates Brunton’s spectacles and is reproduced below.

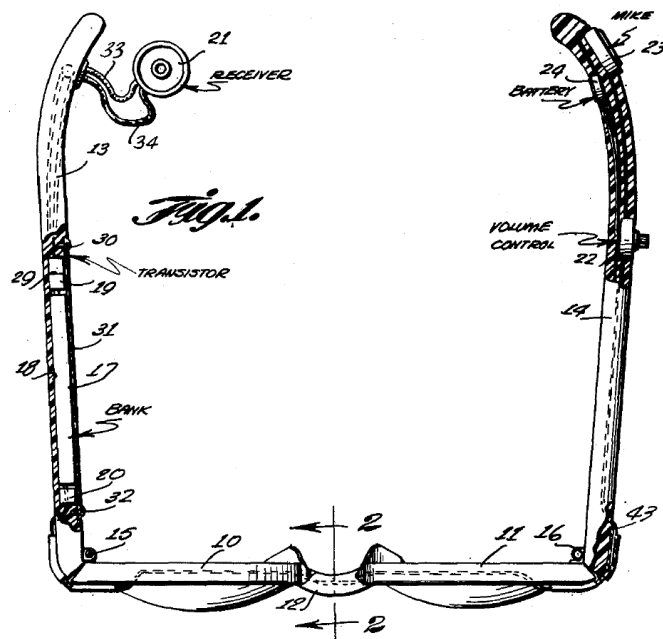


Figure 1 shows spectacles including a lens frame having sections 10 and 11 connected by bridge 12, temples 13 and 14 connected to the ends of the lens frame, hinges 15 and 16, and hearing aid unit 17 positioned in cavity 18 of temple 13. *Id.* at 3:34–40. The hearing aid unit is adapted to be snapped into sockets 19 and 20 and is “connected by suitable conductors to a receiver 21 at the end of the temple 13 and to a volume control 22, a microphone 23 and a battery 24 in the temple 14.” *Id.* at 3:41–44. The hearing aid unit “contains the elements of a hearing aid, such as resistors, transistors, and capacitors.” *Id.* at 3:51–52.

## 2. Independent Claim 1

### a. The Preamble

Claim 1 recites “[a] first device.” Ex. 1001, 32:13. Petitioner maps Brunton’s spectacles to the recited first device. Pet. 13 (citing Ex. 1003, 3:36–39, Fig. 1; Ex. 1002 ¶¶ 54–55).

Brunton discloses hearing aids removably mounted in a pair of spectacles. Ex. 1003, 1:15–23. The spectacles include a lens frame into which the hearing aid unit is mounted. *Id.* at 3:34–40.

Accordingly, for the foregoing reasons and on this preliminary record, to the extent the preamble is limiting, Brunton supports Petitioner’s contentions.

#### b. The Lens Housing Recitation

Claim 1 recites “a lens housing adapted to support a first lens and a second lens.” Ex. 1001, 32:14–15. Petitioner maps Brunton’s frame sections 10, 11 to the recited lens housing and lenses to the recited first and second lenses. Pet. 13 (citing Ex. 1003, 3:36–39, Fig. 1; Ex. 1002 ¶¶ 54–55).

Brunton discloses that its lens housing supports two lenses. Ex. 1003, Fig. 1; *see also id.* at 1:50–55 (disclosing that “the hearing aid elements are independent of the lenses”).

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner’s contentions.

#### c. The Temple Recitations

Claim 1 recites “a first temple movably coupled to the lens housing” and “a second temple movably coupled to the lens housing.” Ex. 1001, 32:16–17. Petitioner maps Brunton’s temples 13, 14 to the recited temples. Pet. 13 (citing Ex. 1003, 3:36–39, Fig. 1; Ex. 1002 ¶¶ 54–55).

Brunton discloses that its spectacles include temples 13, 14 connected via hinges 15, 16 to the ends of the lens frame. Ex. 1003, 3:34–40, Fig. 1.

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner's contentions.

d. The Electronics Module Recitation

Claim 1 recites "an electronics module disposed at least partially within the first temple." Ex. 1001, 32:18–19. Petitioner maps Brunton's hearing aid unit 17 to the recited electronics module and argues that it is installed as a unit in a cavity within a temple of the spectacles. Pet. 14 (citing Ex. 1003, 2:55–63, 3:32–33, 3:39–40, 3:51–56, Figs. 1–2, 6). Petitioner argues that the hearing aid unit is an electronics module because it includes electronic elements. *Id.*

Brunton discloses that its hearing aid unit "contains the elements of a hearing aid, such as resistors, transistors, and capacitors." Ex. 1003, 3:51–52. The hearing aid unit is positioned and retained within cavity 18 of temple 13 by snapping into sockets 19, 20. *Id.* at 3:34–44.

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner's contentions.

e. The Electrical Conductor Recitations

Claim 1 recites "a first electrical conductor coupled to the first temple" and "a second electrical conductor coupled to the first temple." Ex. 1001, 32:20, 32:24. Petitioner argues that "[t]he '174 patent uses 'electrical conductor' to encompass 'any material that can be used to conduct electrical signals or power.'" Pet. 15 (citing Ex. 1001, 11:15–20). Petitioner argues that Brunton's sockets 19, 20 include electrical contacts or terminals that make an electrical connection with pins on the hearing aid

unit. *Id.* at 16–17 (citing Ex. 1003, 3:57–65, 4:2–4, Figs. 1, 6; Ex. 1002 ¶¶ 57–59).

Brunton discloses that its sockets 19, 20 include tubular contacts 27, 28 that receive pins 25, 26 on the hearing aid unit. Ex. 1003, 3:57–61, Fig. 6. The sockets “may be embedded in the material of the temple.” *Id.* at 3:70–74.

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner’s contentions.

#### f. The Conductive Path Recitations

Claim 1 recites “wherein a first conductive path is provided from the first temple to the lens housing at least in part by the first electrical conductor” and “wherein a second conductive path is provided from the first temple to the lens housing at least in part by the second electrical conductor.” Ex. 1001, 32:21–23, 32:25–27. Petitioner argues that Brunton’s spectacles include conducting wires that create conductive paths from socket 20, through temple 13, around hinge 15, and through the lens frame. Pet. 17–19 (citing Ex. 1003, 3:36–44, 4:6–7, 4:10–21; Figs. 1, 2, 7). Petitioner argues that “the sockets with electrical conductors/terminals in the cavity are connected to the wires in the temple that extend across the hinge to the lens frame.” *Id.* at 19 (citing Ex. 1003, 4:2–9, Figs. 1–2).

Brunton discloses that the ends of its hearing aid unit are provided with contact pins 25, 26 that are adapted to be inserted into tubular contacts 27, 28 in sockets 19, 20. Ex. 1003, 3:57–61, Fig. 6. Once snapped into sockets 19, 20, the hearing aid unit is “connected by suitable conductors to a receiver 21 at the end of the temple 13 and to a volume control 22, a

microphone 23 and a battery 24 in the temple 14.” *Id.* at 3:41–44. The connection to the receiver is made by wires 33, 34, and the connections to the other components are made by wires 35, 36. *Id.* at 4:2–9, Figs. 2, 6.

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner’s contentions.

g. The Constrain Recitation

Claim 1 recites “wherein the first and second electrical conductors are configured to couple the electronics module to the first temple to constrain the electronics module.” Ex. 1001, 32:28–30. Petitioner argues that “[t]he ’174 patent describes the term ‘constrain’ as including ‘provid[ing] support (i.e. a restraining force)’ and ‘retain[ing] the module in a fixed position within the temple.” Pet. 20 (alterations in original) (citing Ex. 1001, 11:52–55). Petitioner argues that “the contact pins on the hearing aid unit are ‘frictionally retained’ by the sockets in the temple cavity” and that, “[b]y frictionally retaining the pins of the hearing aid unit in the cavity, the socket contacts are coupling the hearing aid unit to the temple and constraining the hearing aid unit.” *Id.* at 20–21 (citing Ex. 1003, 3:61–65, 4:56–63; Ex. 1002 ¶ 64).

Brunton discloses that “the [hearing aid] units may be provided with any suitable number of contact pins and the sockets provided with a corresponding number of tubular contacts that are positioned to receive the pins and in which the pins are frictionally retained.” Ex. 1003, 3:61–65.

Petitioner’s witness, Dr. Feland, testifies,

Frictionally retaining the hearing aid unit’s pins in the cavity means that the socket contacts couple the hearing aid unit to the temple and constrain the hearing aid unit. Brunton’s socket

contacts (corresponding to the claimed first and second electrical conductors) accordingly are configured to couple the hearing aid unit (corresponding to the claimed electronics module) to the temple to constrain the hearing aid unit.

Ex. 1002 ¶ 64.

Accordingly, for the foregoing reasons and on this preliminary record, Brunton supports Petitioner's contentions.

#### h. Conclusion

Accordingly, at this stage of the proceeding, we determine that Petitioner has established a reasonable likelihood of prevailing on its assertion that claim 1 is anticipated by Brunton.

#### E. Asserted Unpatentability based on Delorenzo

Petitioner argues that claims 1, 2, 4, 9, 12, and 13 are anticipated by Delorenzo and that claims 1–4 and 9–13 would have been obvious in view of Delorenzo. Pet. 54–69. In support of its showing, Petitioner relies upon the Feland Declaration. *Id.* (citing Ex. 1002). Patent Owner does not contest Petitioner's assertions. *See generally* Prelim. Resp. We have reviewed Petitioner's assertions and supporting evidence. For the reasons discussed below, and based on the record before us, we question whether Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one challenged claim is anticipated by or would have been obvious in view of Brunton.

##### *1. Summary of Delorenzo*

Delorenzo discloses eyeglasses with a built-in hearing aid. Ex. 1007, 1:3–4. Figure 1 illustrates Delorenzo's eyeglasses and is reproduced below.

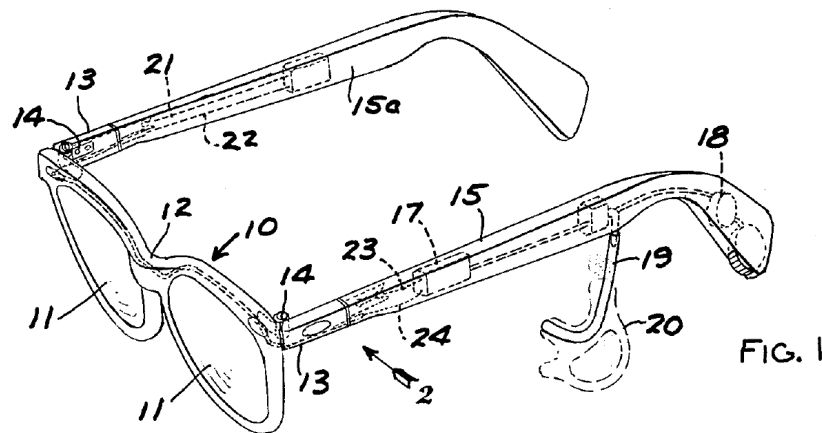


Figure 1 shows eyeglasses having frame front 10 for receiving lenses 11, nosepiece 12, and temples 15 and 15a. *Id.* at 2:3–8. Temple 15a has a microphone and temple 15 has amplifier element 17 “removably embedded therein.” *Id.* at 2:9–11. The amplifier element is “connected electrically . . . with conventional circuitry” to battery 18 and earpiece 20. *Id.* at 2:13–16.

## 2. Independent Claim 1

Claim 1 recites, in relevant part, “a first temple movably coupled to the lens housing” and “a second temple movably coupled to the lens housing.” Ex. 1001, 32:16–17. Petitioner maps Delorenzo’s temples 15 to the recited temples. Pet. 55 (citing Ex. 1007, Figs. 1, 4).

Claim 1 recites “an electronics module disposed at least partially within the first temple.” Ex. 1001, 32:18–19. Petitioner argues that amplifier element 17 is removably embedded within the back portion of temple 15, which can be mechanically and electrically connected and disconnected from the front portion of temple 15 (that is, temple tip 13). Pet. 56–57 (citing Ex. 1007, 1:41–51, 2:9–11, 2:44–54, Figs. 1–3, code (57)). Thus, Petitioner argues, “temple 15 is an electronics module

disposed at least partially within the fully assembled temple of the eyewear (temple tip 13 plus temple 15).” *Id.* at 57.

As noted above, Petitioner maps Delorenzo’s temple 15 to both the recited temple and the recited electronics module. It is not clear to us how the electronics module (that is, *temple 15* per Petitioner’s mapping) is disposed at least partially within the first temple (that is, *temple 15* per Petitioner’s mapping). In other words, Petitioner’s mapping appears to require temple 15 to be embedded within itself. It is not clear to us how this requirement is met.

To the extent Petitioner maps Delorenzo’s temple tip 13 to the recited temple and temple 15 to the recited electronics module, it is unclear to us how temple 15 is embedded within temple tip 13. Rather, it appears that the temple tip and temple are arranged to abut when connected so as to form a continuous temple arm. *See* Ex. 1007, Figs. 1–2.

### *3. Conclusion*

For at least these reasons, we question whether Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 1 is anticipated by Delorenzo. Petitioner relies on the same arguments in asserting that claim 1 would have been obvious in view of Delorenzo (Pet. 64), so we question whether Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 1 would have been obvious in view of Delorenzo for the same reasons.

#### F. Petitioner's Other Assertions that the Independent Claims are Unpatentable

Petitioner argues that: claims 1–4, 9, and 12 would have been obvious in view of Brunton (Pet. 24–26); claims 7, 8, and 13 would have been obvious in view of Brunton and Carling (*id.* at 26–29); claims 1, 2, 4–6, 9, 12, and 14 would have been obvious in view of Kokonaski-999 and Brunton (*id.* at 30–43); claims 1, 2, 5, 6, 12, and 13 would have been obvious in view of Hattori (*id.* at 43–54); claims 15–19 would have been obvious in view of Kokonaski-999 and Kokonaski-579 (*id.* at 69–81); and claims 15, 16, and 18 would have been obvious in view of Howell-596, Eichelberger, and Sikonowiz (*id.* at 81–86). We have reviewed Petitioner's assertions and supporting evidence and determine that, based on the record before us, Petitioner demonstrates a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in each of these grounds.

#### IV. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of the challenged claims is unpatentable. At this preliminary stage, we have not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner's burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”).

Accordingly, *inter partes* review is instituted as to all challenged claims and all proposed grounds of unpatentability. *See* 37 C.F.R. § 42.108(a).

#### V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–19 of the '174 patent is instituted with respect to all grounds set forth in the Petition; and

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

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Patent 8,801,174 B2

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