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On behalf of **Luxottica of America Inc.**

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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.

Case No. IPR2024-01071
Patent 8,905,541

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Patent Owner asks for discretionary denial under *Fintiv* and § 325(d). The Board should not deny on either basis and should instead institute review.

I. THE *SOTERA* STIPULATION PRECLUDES A *FINTIV* DENIAL

Petitioner has provided a *Sotera* stipulation. Petition 80–81. The Director’s June 2022 Memorandum (“Director’s Memo”) is “binding agency guidance” that prohibits a *Fintiv* denial where the petitioner submits a *Sotera* stipulation. Memo at 3, *available at* <https://tinyurl.com/usptoDirMemo>; *see also Hilti AG v. Specified Techs. Inc.*, IPR2024-00193, Paper 17 at 10 (PTAB May 14, 2024) (“The [Director’s Memo] binds this panel.”). The Director’s Memo unambiguously states three times that the Board “will not” discretionarily deny institution due to parallel litigation when the petitioner files a *Sotera* stipulation. Memo at 3, 7, 9. “Because Petitioner has provided a *Sotera* stipulation, the Director Memo is controlling and the *Fintiv* factors are not a basis for denying institution.” *Meta Platforms, Inc. v. Immersion Corp.*, IPR2023-00946, Paper 13 at 16 (PTAB Dec. 8, 2023).

Patent Owner nevertheless argues the Board should create an exception to the Director’s Memo and accord Petitioner’s stipulation “no weight” for two reasons. POPR 13. First, Patent Owner argues, by the time the Board decides whether to institute, the parties will supposedly have “expended the resources to litigate the same prior art through the completion of validity expert reports.” *Id.* This first argument fails because the factual premise is false: the district court vacated the 2024

deadlines for expert reports and will not reset them until after it construes the claims. Ex. 1017. Moreover, the Director’s Memo acknowledges that considering the parties’ investment in parallel litigation is part of *Fintiv* factor 3, yet the Memo makes no exception to its rule that a *Sotera* stipulation precludes a *Fintiv* denial.

Second, Patent Owner argues “the stipulation does not bar Lenovo from litigating the very same invalidity challenges before the district court.” POPR 13. That argument is unavailing because Petitioner and Lenovo are independent and Petitioner is not a party to the suit Patent Owner freely chose to bring against Lenovo. In similar circumstances, the Board has rejected arguments seeking an exception to the Director’s Memo. In *Structural Wrap, LLC v. System Stormseal Pty Ltd.*, the patent owner argued a *Sotera* stipulation was insufficient because it did not bind the petitioner’s indemnitee. IPR2024-00084, Paper 13 at 12–13 (PTAB May 9, 2024). But the petitioner was not a party to the suit against its indemnitee. *Id.* at 14–15. Noting it could not “effectively ignore the Director Memo under these circumstances,” the Board rejected the patent owner’s argument. *Id.* at 13.

Similarly, in *Box, Inc. v. Topia Technology, Inc.*, the patent owner argued the petition failed to name a third party as a real party in interest. IPR2023-00427, Paper 17 at 9, 19 (PTAB Aug. 4, 2023). This third party was a defendant in a parallel lawsuit that the petitioners’ *Sotera* stipulation did not cover. *See id.* The third party was therefore “free to raise Petitioners’ same (and more) invalidity contentions.” *Id.*

at 19 (quoting patent owner). Nonetheless, the Board was unpersuaded that the stipulation fell outside the scope of the Director’s Memo. *Id.*

The Board has also rejected other proposed exceptions to the Director’s precept that a *Sotera* stipulation precludes a *Fintiv* denial. *See, e.g., Hilti*, Paper 17 at 11 (rejecting proposed “exception for parallel litigation where duplicative ‘product’ prior art is asserted”); *Meta*, Paper 13 at 15 (rejecting proposed exception “based on the advanced state of the district court case and the duplication of invalidity grounds asserted in this proceeding”).

Here, the Board should likewise decline to create an exception to the binding Director’s Memo. Petitioner and Lenovo are independent parties sued in separate suits. Petitioner’s *Sotera* stipulation precludes a *Fintiv* denial.

II. PATENT OWNER’S § 325(D) ARGUMENT FAILS

A. Patent Owner fails the first prong of *Advanced Bionics*.

1. Howell-596 was not before the examiner and is not cumulative.

Grounds 1–4 rely on Howell-596, which was not before the examiner. Patent Owner does not dispute that. Rather, Patent Owner argues Howell-596 is cumulative of Howell-158, which appeared in an IDS. POPR 19, 21–22. To argue cumulativeness, Patent Owner makes three points, none of which is persuasive.

First, Patent Owner asserts “Howell-158 cites priority to Howell-596’s application (U.S. Application No. 11/078,857).” POPR 21. That is incorrect.

Howell-158 merely states it is “related to” application 11/078,857, the application that led to Howell-596. Ex. 1006 ¶ 3. Howell-158 does not claim priority to the application, and a priority claim does not establish cumulativeness anyway.

Second, Patent Owner argues Howell-158 purports to incorporate application 11/078,857 by reference in paragraph 3. POPR 21. But application 11/078,857 is just one of 10 applications Howell-158 lists in paragraph 3. Ex. 1006 ¶ 3. That paragraph lists only application serial numbers. *Id.* It lists no publication numbers. *Id.* Applications must publish to qualify as prior art that an examiner would consider. 35 U.S.C. §§ 102(a), (b), (e) (2006). Under these circumstances, the reference to serial number 11/078,857 in paragraph 3 is insufficient to establish that, by signing an IDS listing Howell-158, the examiner considered the contents of the Howell-596 publication, much less *meaningfully* considered them. *See JUUL Labs, Inc. v. NJOY, LLC*, IPR2024-00160, Paper 10 at 11–13 (PTAB May 24, 2024) (finding first prong of *Advanced Bionics* unmet where patent owner cited no evidence that the examiner substantively considered disclosed references); *Samsung Elecs. Co. v. Maxell, Ltd.*, IPR2024-00867, Paper 9 at 17, 20 (PTAB Nov. 7, 2024) (same).

Third, Patent Owner argues that Howell-596 is cumulative of Howell-158 because they both disclose eyeglass frames with two lenses and a cavity for an electronic device. POPR 22. This argument fails because it rests on the false premise that this is the only disclosure in Howell-596 that Petitioner relies on. To the

contrary, Petitioner relies on figures 15A and figures 17A and 17B of Howell-596, which show (1) an electronics module inside (2) a housing module, where the electronics module comprises (3) a power source, a controller, and a sensing mechanism. Petition 18–21. Howell-596’s figures 15A, 17A, and 17B do not appear in Howell-158, and Patent Owner cites no equivalent disclosure in Howell-158.

Since the examiner also never evaluated Howell-158 in an office action or considered arguments about Howell-158, *Becton, Dickinson* factors (a), (b), and (d) all point to the conclusion that Howell-596 was not previously presented to the Office for purposes of § 325(d). *JUUL Labs*, Paper 10 at 11–13.

**2. Denial under § 325(d) is unwarranted at least because
Grounds 1–4 rely on Howell-596 to challenge all claims.**

Grounds 1–4 each rely on Howell-596 as a primary reference, and together they challenge every claim. Petition 13. Therefore, regardless of Grounds 5 and 6, Grounds 1–4 make discretionary denial under § 325(d) inappropriate. *E.g.*, *Shenzhen Chic Elecs. v. Pilot, Inc.*, IPR2023-00810, Paper 12 at 21 n.11 (PTAB Nov. 8, 2023) (§ 325(d) denial inappropriate where challenges based on new art “address all challenged claims,” regardless of whether other challenges relied on previously considered art); *TP-Link Corp. Ltd. v. Netgear, Inc.*, IPR2023-01469, Paper 10 at 9–10 (PTAB Apr. 2, 2024) (same). Because Patent Owner fails the first prong of *Advanced Bionics*, the Board need not consider the second prong and should decline to deny under § 325(d).

3. Hattori-913 is new, and the examiner did not meaningfully address Howell-158, which further shows that Patent Owner fails the first prong of *Advanced Bionics*.

Grounds 2 and 4 rely on Hattori-913, which Patent Owner concedes is a “New reference.” POPR 20. Moreover, Grounds 1, 2, 5, and 6 all rely on Howell-158 and collectively challenge all claims. While the examiner signed an IDS listing Howell-158, the examiner never discussed or applied Howell-158, and Patent Owner cites no evidence the examiner meaningfully considered the reference.

Consistent with the April 2024 Notice of Proposed Rule Making, 89 FR 28693, 28702, 28705, the Board has found that mere disclosure of a reference in an IDS does not establish the reference was previously presented to the Office for purposes of the first prong of *Advanced Bionics*. In *JUUL Labs*, the petitioner did not dispute that all asserted references were disclosed during examination. *JUUL Labs*, Paper 10 at 11. But the patent owner failed to cite anything else showing the examiner substantively or otherwise materially considered the references. *Id.* at 12. The first prong of *Advanced Bionics* was therefore unmet, and the Board declined to deny under § 325(d). *Id.* at 12–13.

Similarly, in *Samsung*, a reference appeared in an IDS with approximately 50 other references. *Samsung*, Paper 9 at 17. The patent owner failed to cite any evidence “indicating that the Office meaningfully addressed this reference during prosecution of the [challenged patent], other than a blanket statement printed on the

bottom of the IDS that ‘all references considered except where lined through.’” *Id.* That statement did not allow the Board to evaluate the extent to which the examiner substantively considered the reference. *Id.* Because the record lacked any evidence that this reference and others “were ever meaningfully addressed by the Office during prosecution or reexamination,” the Board found the first prong of *Advanced Bionics* unsatisfied and accordingly declined to deny under § 325(d). *Id.* at 20.

Because the examiner did not meaningfully address Hattori-913 or Howell-158, Patent Owner fails the first prong of *Advanced Bionics*, regardless of Howell-596. *Shenzen*, Paper 12 at 21 n.11; *TP-Link*, Paper 10 at 9–10.

B. Patent Owner also fails the second prong of *Advanced Bionics*.

Patent Owner represents: “Petitioner Makes No Claim that the Examiner Erred During Prosecution.” POPR 28. But Petitioner expressly argued: “as shown in Grounds 1–4, the examiner erred in concluding the claims were patentable.” Petition 84. The error arose in part because the examiner allowed claims based on the applicant’s argument that the prior art failed to disclose the claimed insulating layer. *See id.* at 82, 84–85 (citing file history). Petitioner has shown that Howell-158 discloses, and Howell-596 renders obvious, that limitation. *Id.* at 22–24, 47–49.

Because the examiner at most signed an IDS listing Howell-158 and never “substantively remarked upon or applied [Howell-596 or Howell-158] in a rejection of the claims,” Petitioner “may show material error by showing that the Office failed

to reject the claims over the asserted art.” *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10 at 13–14 (PTAB Oct. 10, 2023). Patent Owner mischaracterizes Petitioner’s reliance on *Quasar*, incorrectly attributing to Petitioner an assertion that merely citing a reference in an IDS is evidence of material error. POPR 29. Patent Owner ignores that, under *Quasar*, Petitioner’s showing on the merits in Grounds 1–6 suffices to demonstrate material error. *Quasar*, Paper 10 at 14. Indeed, Grounds 1–6 show “the Office overlooked the prior art’s teachings of the limitations that were the basis for allowing the challenged claims.” *Id.* at 15.

Disputing the examiner erred, Patent Owner contends applying Howell-158’s insulative tape to Howell-596, Kokanaski-166, or Kokanaski-999 “would have nullified stated benefits of those references.” POPR 30. Patent Owner offers only unsupported attorney argument about wrapping an entire circuit board in double-sided tape. *Id.* at 30–31. These arguments are unavailing because in claim 1 it suffices for the insulating layer to be disposed between the frame and a single electronic *component* within the module. Moreover, Patent Owner’s arguments do not apply to Ground 3, which does not rely on Howell-158.

Because the examiner materially erred with respect to each ground, Patent Owner fails the second prong of *Advanced Bionics*. For this reason as well, the Board should decline Patent Owner’s § 325(d) request and instead institute review.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of
PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE
is being served by email on Patent Owner as follows:

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