Filed June 21, 2024

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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 SMART OPTICS, INC.,
Patent Owner.

Case IPR2024-01072
Patent 10,598,960

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,598,960

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LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,598,960 to Blum et al. ("'960 patent")
1002	File History of U.S. Patent No. 10,598,960
1003	Declaration of John Feland
1004	Curriculum Vitae of John Feland
1005	U.S. Patent App. Publ. No. 2012/0105740 to Jannard et al. ("Jannard-740")
1006	U.S. Patent App. Publ. No. 2011/0214082 to Osterhout et al. ("Osterhout")
1007	U.S. Patent App. Publ. No. 2009/0006846 to Rosenblatt ("Rosenblatt")
1008	U.S. Patent App. Publ. No. 2010/0238034 to Gunaratne ("Gunaratne")
1009	U.S. Patent No. 6,665,842 to Nielsen ("Nielsen")
1010	U.S. Patent No. 7,306,332 to Chen et al. ("Chen")
1011	Excerpts from Microsoft Computer Dictionary, Fifth Edition, 2002
1012	U.S. Patent No. 6,185,537 to Oh et al. ("Oh")
1013	U.S. Patent No. 6,325,507 to Jannard et al. ("Jannard-507")
1014	Graf, Modern Dictionary of Electronics, 7th Edition, 1999
1015	U.S. Patent No. 6,929,365 to Swab et al. ("Swab")
1016	U.S. Patent App. Publ. No. 2011/0014932 to Estevez ("Estevez")
1017	U.S. Patent App. Publ. No. 2006/0132382 to Jannard et al. ("Jannard-382")

Exhibit No.	Description
1018	e-Vision Preliminary Infringement Claim Chart for ’960 Patent
1019	Int’l Patent App. Publ. No. 01/95625 to Calderone et al. (“Calderone”)
1020	Int’l Patent App. Publ. No. 99/53612 to Blum et al. (“Blum”)
1021	YouTube Siri Demo Screenshots
1022	Texas Instruments OMAP White Paper
1023	Federal Court Management Statistics (excerpt), *available at* https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf

ANNOTATED INDEPENDENT CLAIMS

Claim 1

1[pre]	Eyewear comprising:
1[a]	an eyewear frame having a first temple and a second temple;
1[b]	a speaker supported by the eyewear frame;
1[c]	an application module mechanically coupled to the eyewear frame and operably coupled to the speaker, the application module comprising:
1[d]	a microphone and a wireless chip
1[e]	to receive a verbal query from a wearer of the eyewear, wirelessly transmit the verbal query to an external device, receive a response to the verbal query, and provide the response to the wearer via the speaker.

Claim 11

11[pre]	Eyewear comprising:
11[a]	an eyewear frame having a first temple and a second temple; and
11[b]	an application module mechanically coupled to the eyewear frame,
11[c]	the application module including a wireless chip to communicate with a wireless enabled device,
11[d]	wherein the wireless enabled device is configured to recognize a presence of a wearer of the eyewear based at least in part on communication with the wireless chip.

Claim 22

22[pre] Eyewear comprising:

22[a] an eyewear frame having a first temple and a second temple;

22[b] an application module mechanically coupled to the eyewear

22[c] the application module comprising a transmitter and a wireless chip

22[d] to wirelessly transmit a password from the application module from a wearer of the eyewear to a computer to access the computer.

Petitioner Luxottica of America Inc. requests *inter partes* review ("IPR") of claims 1-26 of U.S. Patent No. 10,598,960 ("the '960 patent," Ex.1001), which is purportedly owned by e-Vision Smart Optics, Inc. ("Patent Owner" or "PO").

I. INTRODUCTION

Luxottica and its subsidiaries have led innovation in electronically enabled eyewear. Over twenty years ago, Luxottica filed Jannard-507, which disclosed eyewear equipped with electronics ranging from receivers and transmitters to storage devices to heads-up display circuitry. Building on this foundation, in August 2011, Luxottica filed Jannard-740, detailing eyewear with detachable application modules that support voice commands, wireless communication, and much more. Jannard-740 further incorporated eyewear embodiments that enable wearers to use eyewear to request and listen to content, such as an email, from another device without manually operating that device.

Nearly seven years later, PO filed the application that led to the '960 patent. Claiming priority only from 2012, this patent focuses on eyewear functioning as a "docking station" for removable application modules. But PO tried to distance the claims from this focus by avoiding the term "docking." Using more generic electronics terminology, PO sought to cover eyewear with an application module that supports voice commands and wireless communication. For example, several claims encompass eyewear with an application module that receives and wirelessly

transmits a verbal query, receives a response, and provides the response via the eyewear's speaker. With such generic language, the '960 patent claims what Luxottica disclosed much earlier.

The '960 patent's other claims are likewise unpatentable. In January 2009, Rosenblatt disclosed wearable accessories with an electronic module called a "key." This key module alerted other devices to the wearer's physical proximity by wirelessly communicating with the other devices. When the other devices received the communications, they knew the wearer was nearby and initiated operations. For example, the key might reside in a headset. When a user wearing the headset approached their car, the car's air-conditioning could automatically activate to the wearer's preferred settings. Similarly, when the user approached their computer, the key could wirelessly communicate and transmit a password, enabling access to the computer.

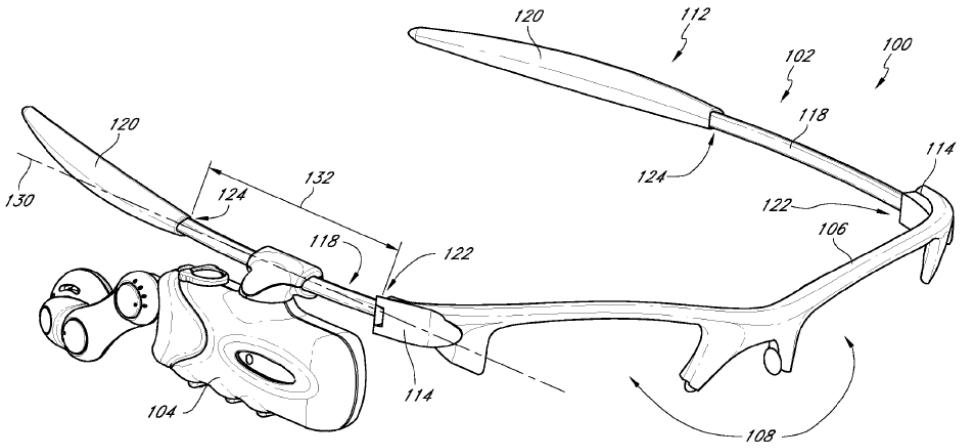
Years after Rosenblatt, PO obtained claims in the '960 patent covering eyewear with an application module that enables another device to recognize a wearer's presence or that wirelessly transmits a password. Those claims are nothing more than an obvious application of Rosenblatt's technology to an application module like Jannard-740's.

Since none of the '960 patent's claims recites anything inventive, the Board should cancel all claims.

II. OVERVIEW OF PRIOR ART

A. Jannard-740

Filed in 2011, Jannard-740 discloses eyewear with electronic modules. Ex.1005, Abstract. For example, Figure 3 shows a module 104 supported by the temple of an eyewear frame. *Id*., [0083]-[0084].



Id., Fig.3.

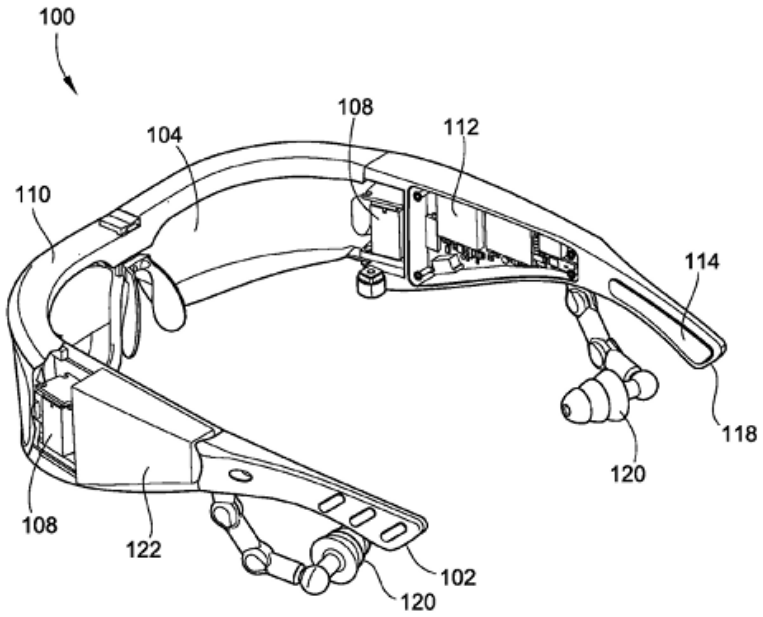
Jannard-740 discloses several types of modules, including "a communication module, a music module, an audio-video module, and/or another electronics module." *Id*., [0086]. In one example, a module includes "a speaker, a microphone, a power supply and a Bluetooth or other radio frequency transceiver for wirelessly communicating with a remote device such as a cellular telephone." *Id*.

Jannard-740 discloses that a wearer of the module may use voice commands to select between input sources. *Id*., [0161], [0220]. These input sources can store and provide content like audio files, news, and music. *Id*., [0236]. Furthermore,

Jannard-740 discloses that a wearer may speak into a wearable device's microphone to send a voice command to a cellular phone, which communicates with a remote network. *Id*., [0195], [0198]. Jannard-740 also incorporates eyewear embodiments that enable a wearer to request and listen to content, including an email, from another device without manually operating that device. *Id*., [0188], [0192]; Ex.1017, [0295]-[0299].

B. Osterhout

Also filed in 2011, Osterhout discloses eyewear with electronic components. Ex.1006, [0125]-[0126], [0135]-[0136].

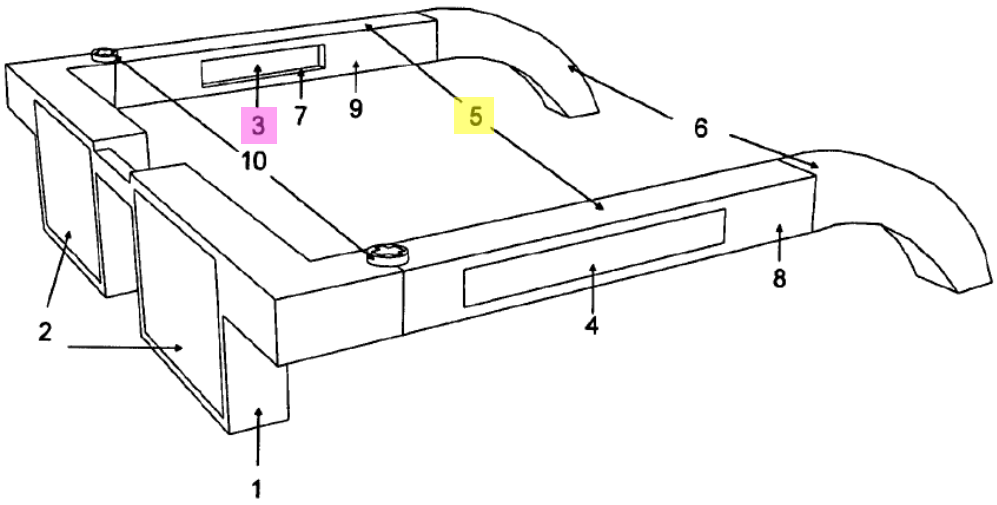


Id., Fig.1. Electronic components like open multimedia applications processor (OMAP) 112 in Figure 1 above enable the eyewear to perform functions including

processing voice commands, communicating wirelessly with remote devices, and retrieving information. *Id*., [0267], [0299], [0309]-[0311].

C. Chen

Published in 2007, Chen discloses eyewear that uses removable cartridges to add to and change an eyewear's functionality. Ex.1010, 2:43-46. A compartment in the eyewear's temple accommodates one or more removable cartridges containing electronic or non-electric components. *Id*., 2:55-63. In Figure 1, a cartridge 3 (pink) is shown positioned within a temple 5 (yellow).



Id., Fig.1 (annotated). By installing different cartridges, the user can augment or change the capabilities of their eyewear. Ex.1010, 4:22-24.

D. Rosenblatt

Published in 2009, Rosenblatt discloses a "system that includes a key for remotely causing a host device to perform an operation." Ex.1007, [0005].

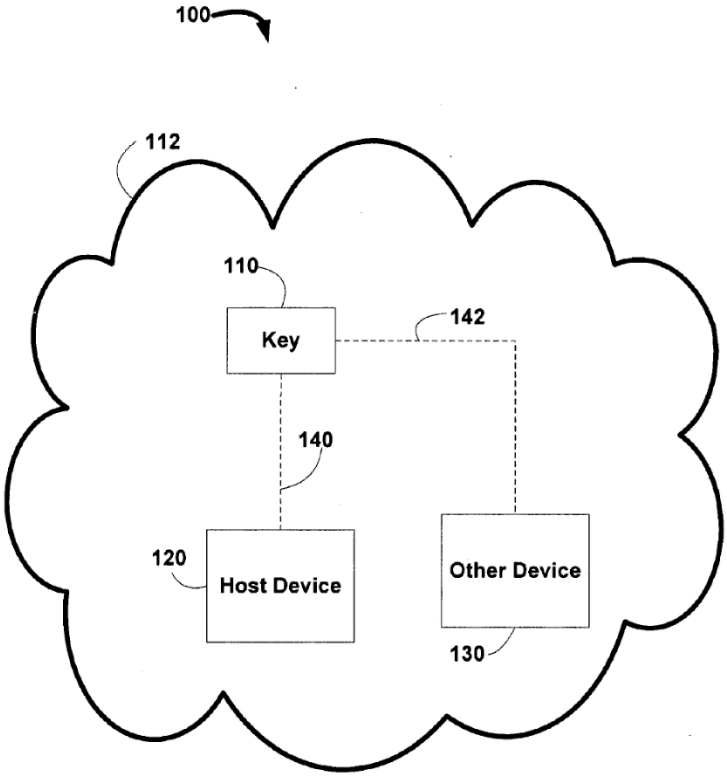
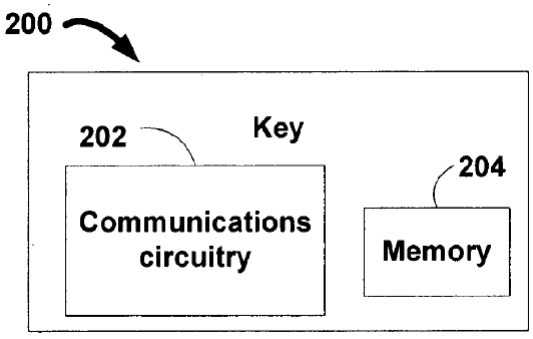


FIG. 1

Id., Fig.1. Rosenblatt's "key" is a module that includes communications circuitry and memory:

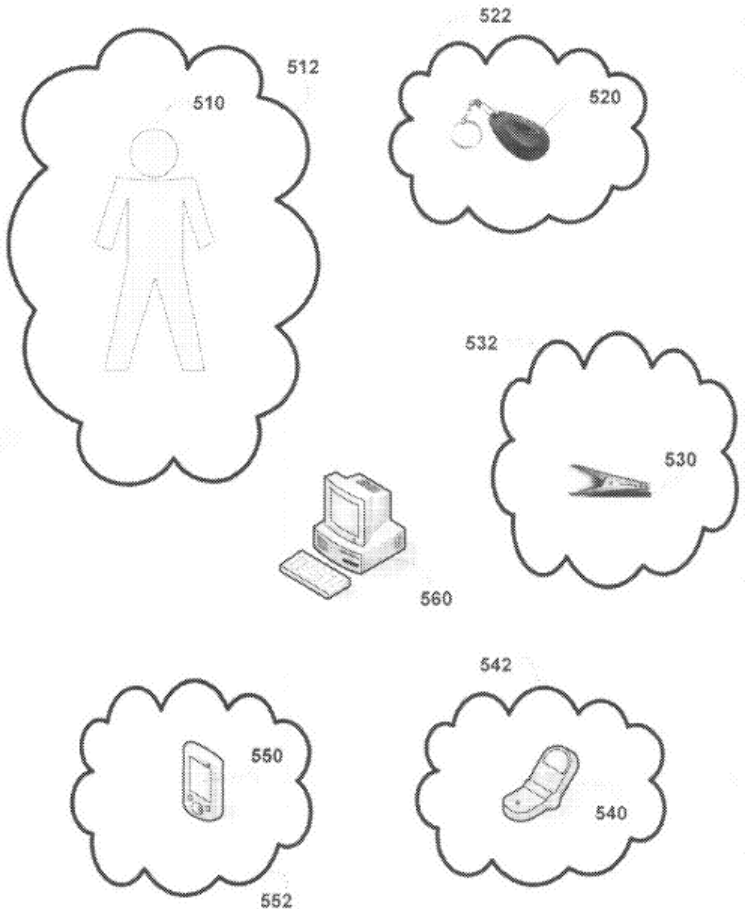


Id., Fig.2. The key uses this circuitry to "create a relatively short-range personal area network" over which it wirelessly communicates with the host device. *Id.*,

[0006], [0028]-[0030]. Rosenblatt discloses several options for this wireless communication, including WiFi and Bluetooth. *Id.*

The key "may be incorporated in an electronic device" such as "a cellular telephone, a mobile communications device, a pocket-sized personal computer (e.g., an iPAQ or a Palm Pilot) a personal media device (e.g., an iPod), … or any other suitable electronic device." *Id.*, [0007], [0044]. Or the key can be "clipped or attached to a user's wallet, cellular telephone, personal media device (e.g., an iPod), wired headset, wireless headset, … or any other suitable object." *Id.*, [0043].

Figure 5 shows several examples of keys creating networks over which they communicate with a host device. A person 510, a fob 520, clip 530, mobile phone 540, or personal media device 550 has the key, which creates personal area network 512/522/532/542/552. *Id.*, [0057]. Over this network, the key communicates with host device 560, which in this case is a computer. *Id.*



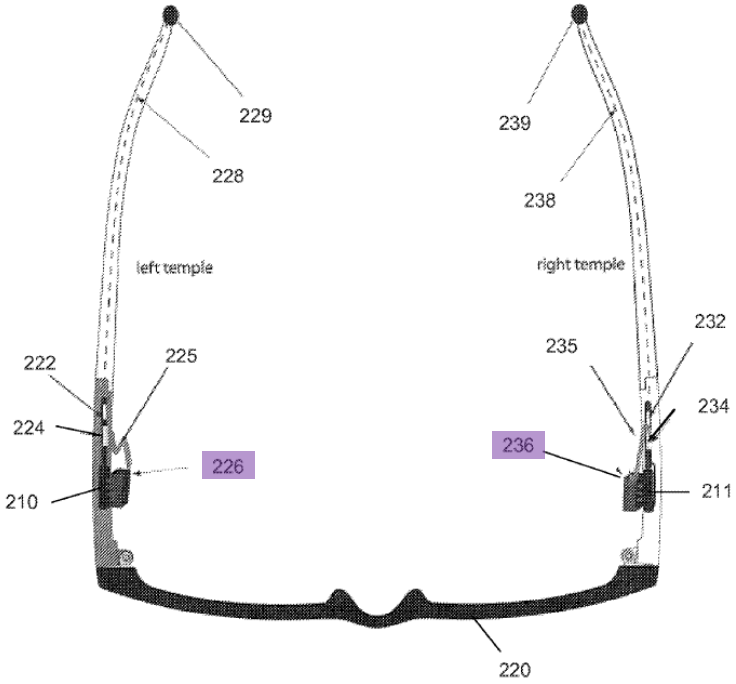
Id., Fig.5.

The host device "perform[s] any suitable operation when the key is placed in proximity of the host device such that the personal area network of the key encloses the host device." *Id*., [0060]. Host devices may be a "computer 610, laptop 612, television system 620, multimedia system 630, automobile 640, door 650, lamp 660, heating and/or air conditioning system 670, elevator 680, and motor 690." *Id*., [0061]. In some implementations, "the user may provide login data [e.g., a password] to the key for transmission to computer," for the host device to perform an operation. *Id*.

III. THE '960 PATENT

A. Overview

The '960 patent discloses electronic eyewear that join with application modules. Ex.1001, 1:66-2:4, 14:19-21. An application module may be "sized to fit within a recess in an eyewear frame [or] attached external to the eyewear frame." *Id*., 9:28-31. Figure 3 illustrates application modules 226, 236 (purple) that are connected to an eyewear's left and right temples:



Id., Fig.3 (annotated).

The application modules provide eyewear with a variety of interchangeable electronic applications. *Id*., 2:7-9.

B. Prosecution History

The Examiner allowed the claims without issuing any rejections. *See* Ex.1002, 31-39. The Examiner did not consider Jannard-740 (Ex.1005), Osterhout (Ex.1006), Rosenblatt (Ex.1007), Chen (Ex.1010), Gunaratne (Ex.1008), or Nielsen (Ex.1009).

IV. LEVEL OF ORDINARY SKILL

The '960 patent relates to electronic eyewear. Ex.1001, 1:66-2:4. Based on the relevant factors, *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995), a hypothetical person of ordinary skill in the art ("POSITA") 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. Ex.1003, ¶¶1-48. A POSITA would have also had at least 2 years of experience designing eyewear and/or consumer electronics. *Id*., ¶28. Work experience could substitute for formal education and additional formal education could substitute for work experience. *Id*.

This Petition does not turn on this specific definition of the level of ordinary skill. The claims would have been obvious from the perspective of a POSITA under any reasonable definition. *Id*.

V. CLAIM CONSTRUCTION

In October 2023, Patent Owner sued Petitioner for infringement of the '960 patent in *e-Vision Optics, LLC et al. v. Luxottica Group S.p.A. et al.*, No. 8:23-cv-02013 (C.D. Cal.) ("the Litigation"). Although the parties may propose constructions for certain terms in the Litigation for purposes of determining infringement, no claim terms require construction to resolve the obviousness challenges here. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Nonetheless, the ordinary meaning of a term is assessed from the perspective of a POSITA, who is "deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). Accordingly, in its arguments below, Petitioner identifies passages from the specification demonstrating that the prior art discloses claim terms in the manner the '960 patent uses them.

VI. STATEMENT OF RELIEF REQUESTED

A. Grounds

Petitioner requests IPR for the following grounds of unpatentability:

Ground	Reference(s)	Basis	Challenged Claims
1	Jannard-740	§103	1-3, 6-10
2	Osterhout	§103	1-8, 10
3	Jannard-740 and Osterhout	§103	1-10
4	Jannard-740 and Rosenblatt	§103	11-18, 20-24, 26
5	Jannard-740, Rosenblatt, and Gunaratne	§103	19
6	Jannard-740, Rosenblatt, and Nielsen	§103	25
7	Chen and Rosenblatt	§103	11-18, 20-24, 26
8	Chen, Rosenblatt, and Gunaratne	§103	19
9	Chen, Rosenblatt, and Nielsen	§103	25

In support of the Petition, Petitioner submits the expert declaration of John Feland, Ph.D. Ex.1003.

B. Asserted References

The '960 patent's earliest priority date is January 6, 2012. Petitioner does not concede the claims are entitled to that priority date, and reserves its right to show they are not so entitled. Nevertheless, the references herein are prior art under pre-AIA 35 U.S.C. §102 for the following reasons:

Ex.	Reference	Date	Art Type
1005	Jannard-740	Filed: August 2, 2011	§102(e)
1006	Osterhout	Filed: February 28, 2011 Published: September 1, 2011	§102(e) §102(a)
1007	Rosenblatt	Published: January 1, 2009	§102(b)
1008	Gunaratne	Published: September 23, 2010	§102(b)
1009	Nielsen	Issued: December 16, 2003	§102(b)
1010	Chen	Published: December 11, 2007	§102(b)

The references are analogous art because they are from the same field as the '960 patent, e.g., eyewear and/or consumer electronics. Ex.1003, ¶¶31-39, 49-60; Ex.1001, 1:66-2:4; *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1000 (Fed. Cir. 2016). They are also pertinent to a problem the inventor was focused on, e.g., eyewear with various electronic capabilities. *Id*.

VII. GROUND 1: CLAIMS 1-3 AND 6-10 ARE OBVIOUS OVER JANNARD-740

A. Claim 1

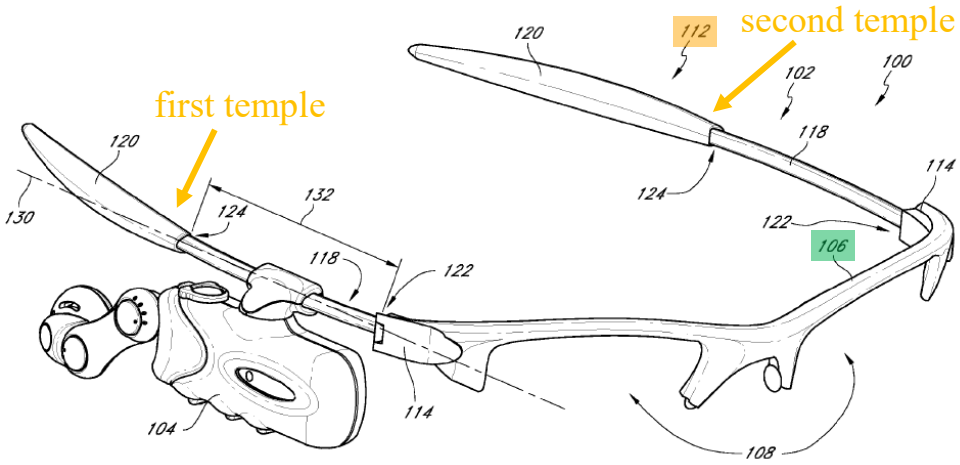
1. Preamble

The preamble recites "[e]yewear." Jannard-740 discloses "eyewear with [a] detachable adjustable electronics module." Ex.1005, Title, Abstract, [0080], [0154], [0167], [0215], [0237]; Ex.1003, ¶62.

2. Limitation 1[a]

This limitation recites "an eyewear frame having a first temple and a second temple."

Jannard-740 discloses this limitation. Ex.1003, ¶63. As shown in Figure 3, Jannard-740's eyewear includes a frame 106 (green) having first and second temples 112 (orange). Ex.1005, [0082]-[0083]; *see also id*., [0010], [0160], [0189]-[0191].

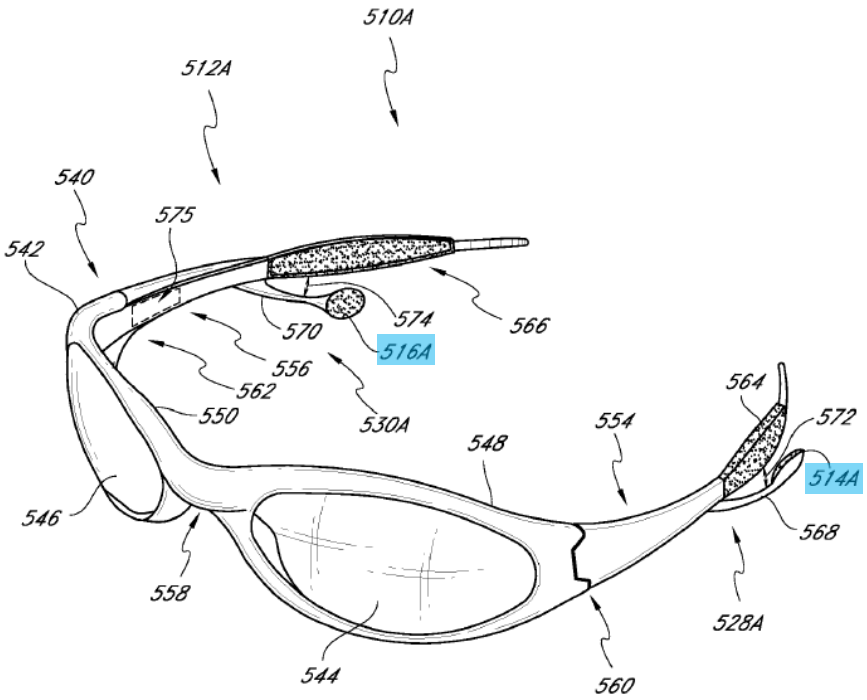


Id., Fig.3 (annotated); Ex.1003, ¶63. Frame 106 secures lenses through which the wearer sees. Ex.1005, [0082]. Jannard-740 thus discloses what the '960 patent describes as an "eyewear frame." Ex.1003, ¶63; Ex.1001, 8:17-24.

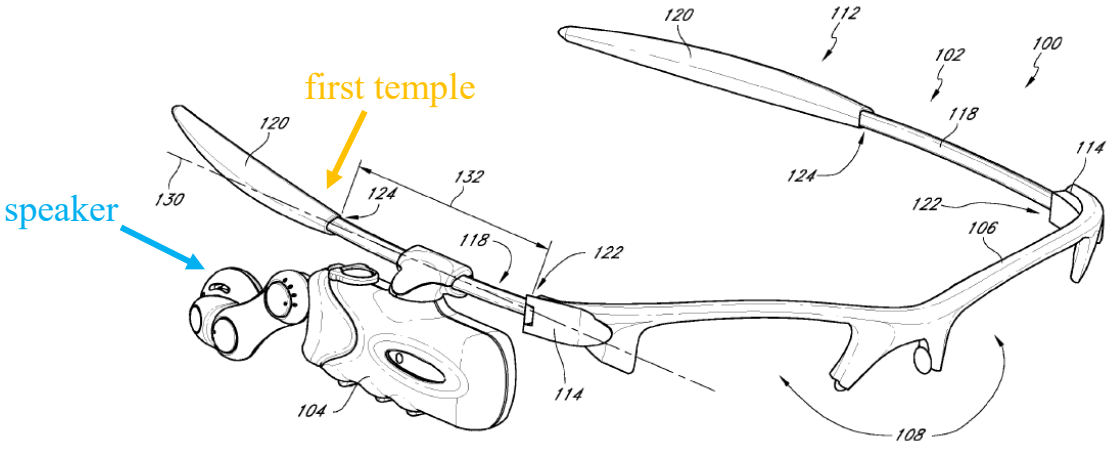
3. Limitation 1[b]

This limitation recites "a speaker supported by the eyewear frame."

Jannard-740 discloses this limitation. For example, Jannard-740 discloses: "A first speaker is supported by the right earstem, and a second speaker is supported by the left earstem." Ex.1005, [0010]; *see also id*., Claim 1. Figure 49 shows an embodiment in which dual speakers (blue) are attached to and supported by the eyewear frame. *Id*., [0191]; *see also id*., Fig.43, [0160].



Id., Fig.49 (annotated); Ex.1003, ¶64. Jannard-740 also discloses embodiments with a single speaker, including in Figure 3 where one speaker (blue) is shown supported by the eyewear frame (specifically, the first temple (orange)). Ex.1005, [0093]-[0094].



Id., Fig.3 (annotated), [0089]; Ex.1003, ¶65.

Thus, Jannard-740 discloses a speaker supported by the eyewear frame. Ex.1003, ¶¶64-66.

4. Limitation 1[c]

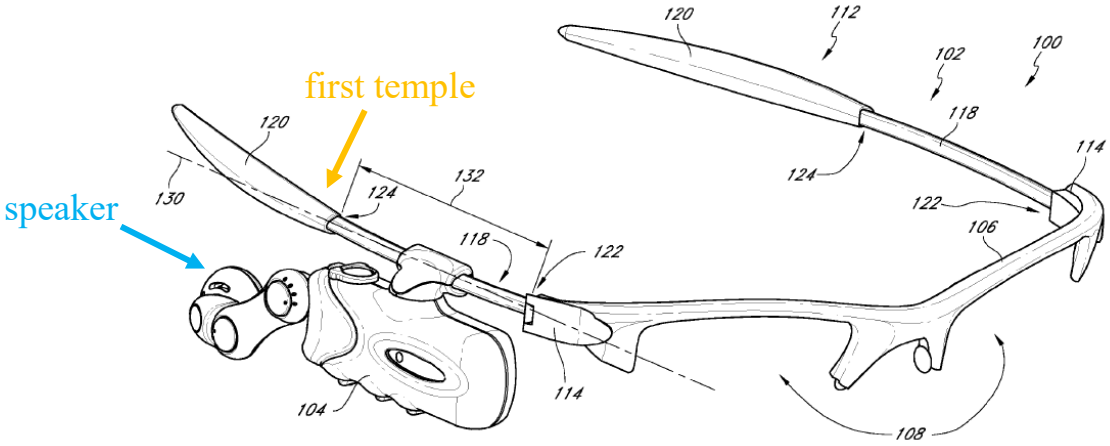
This limitation recites "an application module mechanically coupled to the eyewear frame and operably coupled to the speaker."

Jannard-740 discloses this limitation. "An electronics module is supported by the eyeglass and in electrical communication with each of the first and second speakers." Ex.1005, [0010]; *supra* §VII.A.3. "The electronics module 172 includes electronics for receiving signals from an external source and providing audio signals to the wearer through the speaker 144…." *Id*., [0104]. Furthermore, Jannard-740 discloses:

> [C]ommunication from [a] cellular telephone is received by the first detachable module 304 and audio signals are provided to a user's first ear by a speaker coupled to the first detachable module 304 and audio signals from the cellular telephone are provided to the wearer's second ear via a speaker coupled to the second detachable module 306 that is in communication with the first detachable module 304.

Id., [0160]. Jannard-740 thus discloses an "application module." Ex.1003, ¶67; Ex.1001, 21:59-62.

As another example, in Figure 3, Jannard-740's module 104 is mechanically coupled to the first temple 112 and operably coupled to the speaker. Ex.1005, [0084].



Id., Fig.3 (annotated), [0089]; Ex.1003, ¶68. Jannard-740's eyewear has "coupled" components according to the broad usage of the term in the '960 patent. Ex.1003, ¶68; Ex.1001, 7:47-65.

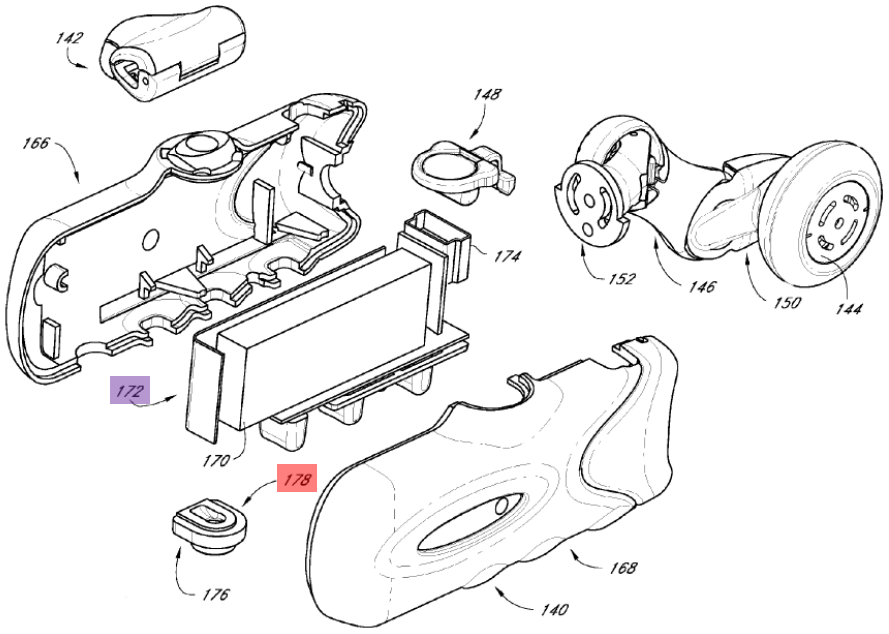
Thus, Jannard-740 discloses an application module that is mechanically coupled to the eyewear frame and operably coupled to the speaker. Ex.1003, ¶¶67-69.

5. Limitation 1[d]

This limitation recites "the application module comprising: a microphone and a wireless chip."

Jannard-740 discloses this limitation. For example, Jannard-740 discloses that "…[a]t least partially inside of [the module 104's] housing 140 are a power

module 170, an electronics module 172, a data port 174 and a holder 176 that supports a microphone 178." Ex.1005, [0102]. The microphone 178 (red) and electronics module 172 (purple) are shown in Figure 12.



Id., Fig.12 (annotated); Ex.1003, ¶70. In one embodiment, "… [the] electronics module 172 includes a Bluetooth transceiver" that facilitates "… wirelessly communicating with a remote device such as a cellular telephone." Ex.1005, [0104], [0086]. Jannard-740 provides that such a transceiver may be implemented as a RF transceiver chip (*id*., [0235]), which is a wireless chip. Ex.1003, ¶70. Jannard-740 also discloses other embodiments which similarly include microphones and transceivers. Ex.1005, [0194]-[0196], [0205]-[0206]; Ex.1003, ¶70.

Thus, Jannard-740 discloses the application module comprising a microphone and a wireless chip. Ex.1003, ¶¶70-71.

6. Limitation 1[e]

This limitation recites the microphone and the wireless chip "to receive a verbal query from a wearer of the eyewear, wirelessly transmit the verbal query to an external device, receive a response to the verbal query, and provide the response to the wearer via the speaker."

Jannard-740 discloses this limitation. For example, Jannard-740 discloses that its eyewear "… can include software that provides the wearer with oral and/or visual popdown-type menus for navigating through the multitude of commands that may be available." Ex.1005, [0161]. "[B]y providing voice control over system functionality, the user need not manipulate mechanical buttons, switches or controls on the support assembly 300 in order to select different support assembly communication, audio, video functions." *Id*., [0161]. According to Jannard-740, such voice control may enable the wearer to "… control[] selection between primary and secondary sources 602, 604 based upon verbal commands provided by the wearer." *Id*., [0220]; *see also id*., [0185], [0202], [0206]. These sources store content accessible to the wearer and comprise "… any of a variety of information sources, including but not limited to, audio files, entertainment, news, media, music, photos, videos, advertising, etc." *Id*., [0193]-[0194], [0236], [0211]; Ex.1003, ¶73; *see also* Ex.1005, [0196].

Jannard-740 also teaches:

> The electronics module 172 includes electronics for receiving signals from an external source and providing audio signals to the wearer through the speaker 144, such as for receiving audio, audio-video or video only signals.… In addition, the electronics module 172 may also allow signals received by the electronics module 172 through the microphone 178 to be transmitted to an external receiver. For example, in one embodiment, electronics module 172 includes a Bluetooth transceiver.

Ex.1005, [0104].

Furthermore, Jannard-740 discloses a module 510C that communicates with an external device B (e.g., a cellular phone), where the external device B communicates with a remote network R (e.g., wireless internet service provider). *Id*., [0193]-[0195], Fig.51; Ex.1003, ¶74. "Optionally, the user U can send voice signals or commands to the cellular phone by speaking into a microphone on the audio device 510C…." Ex.1005, [0195]. "The headset may nonetheless communicate with a remote source R, by relaying the signal through the off board electronics B with or without modification." *Id*., [0198].

Accordingly, Jannard-740 discloses that its microphone and Bluetooth transceiver chip (wireless chip) receive a verbal query through the microphone,

transmit the query to an external device, receive a response (e.g., specific audio file or news) to the query, and provide that response via the speaker. Ex.1003, ¶¶72-75. Thus, Jannard-740 discloses every limitation of claim 1. *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991) ("[S]ince anticipation is the ultimate of obviousness, the subject matter of these claims is necessarily obvious…."); *Realtime Data v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019) ("[A]nticipation is the epitome of obviousness.").

To the extent there is any difference between Jannard-740 and claim 1, the claim would have been obvious. Jannard-740 provides its eyewear systems include "… interface electronics for interacting with a wireless network and/or providing content to a user." Ex.1005, [0003]; *see also id*., [0240]; Ex.1017, [0187], [0290], [0296]. To facilitate requesting and providing content (e.g., specific emails, audio files, or news), a POSITA would have been motivated to use Jannard-740's application module, which includes a microphone and wireless chip (e.g., transceiver chip), to (i) receive a verbal query through the microphone, (ii) wirelessly transmit that query to an external source device, (iii) receive a response to that query from the external source device, and (iv) provide the response to the wearer via a speaker. Ex.1003, ¶76; *see also* Ex.1005, [0236], [0210], [0205].

For example, Jannard-740 incorporates by reference Jannard-382 (Ex.1017) (Ex.1005, [0188], [0192]), which is directed to electronic eyewear and expressly

discloses limitation 1[e]. Jannard-382 discloses eyewear having a microphone through which a user can issue voice commands to control an external source device like a cellular phone. Ex.1017, [0297]; *see also id*., [0073]-[0074], [0296]. Jannard-382 discloses the eyewear communicates with the source device and can provide responses from the source device via the eyewear's speakers: "The user can send a signal to the source device so as to open [an] email. The text-to-speech engine can be configured to read the email to the user. Thus, a user can 'listen' to email through the audio device [e.g., eyewear], without manually operating the source device." *Id*., [0295]; Ex.1003, ¶77; *see also* Ex.1017, [0073]-[0074], [0296]-[0299].

A POSITA would have been motivated to combine this feature in Jannard-382 with Jannard-740's embodiments to provide known benefits, including [i] enabling the wireless chip (e.g., transceiver chip) to use voice commands to query an external source device and then provide content received from the source device to the eyewear's speaker and [ii] enabling access to external source device content through the application module when the wearer wears the eyewear (particularly, e.g., where the wearer has disability/mobility issues or when accessing the external source device would be inconvenient or dangerous), instead of requiring the wearer to manually manipulate the source device, as set forth in Jannard-382. Ex.1003, ¶77. A POSITA would have reasonably expected success in using a transceiver chip in

Jannard-740's application module to receive and transmit such a verbal query and receive and provide a response. *Id*.

Furthermore, the '960 patent does not bother to describe how to implement limitation 1[e]'s voice-control operations. *Id*., ¶78. The '960 patent merely mentions a query could relate to the weather. Ex.1001, 20:2-21. The '960 patent omits implementation details because limitation 1[e] would have been obvious to a POSITA. Ex.1003, ¶78.

Accordingly, Jannard-740 also suggests the microphone and the wireless chip to receive a verbal query from a wearer of the eyewear, wirelessly transmit the verbal query to an external device, receive a response to the verbal query, and provide the response to the wearer via the speaker. *Id*., ¶¶76-79.

Thus, claim 1 is obvious over Jannard-740. *Id*., ¶¶61-79.

B. <u>Claim 2</u>

Claim 2 depends from claim 1 and recites "wherein the external device is a smart phone."

As discussed for limitations 1[d]-1[e], Jannard-740 discloses its transceiver chip (wireless chip) can communicate with "… a telephone, a cellular telephone, a personal digital assistant (PDA), a BLACKBERRY®, or a pager." Ex.1005, [0205]; *supra* §§VII.A.5-6; *see also id*., [0236].

Thus, claim 2 is obvious over Jannard-740. Ex.1003, ¶¶80-82.

C. Claim 3

Claim 3 depends from claim 1 and recites "wherein the external device is a computer."

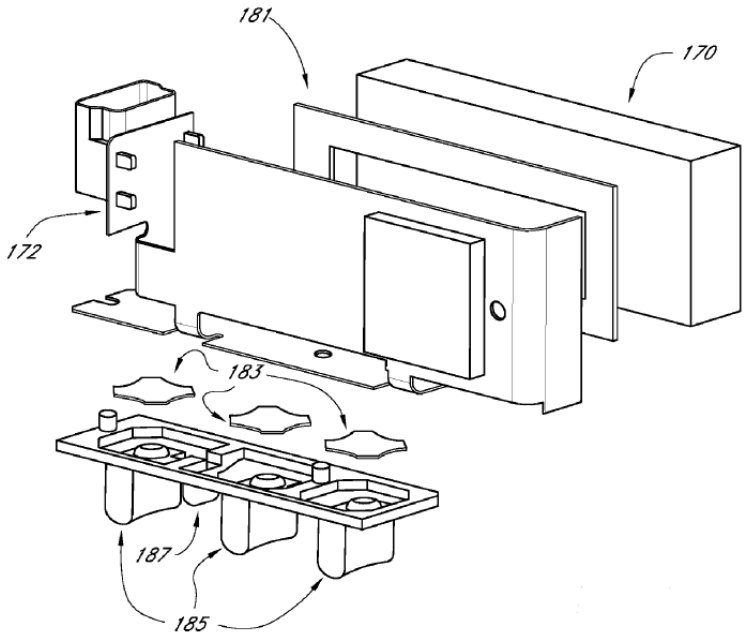
Jannard-740 discloses its module's transceiver chip (wireless chip) communicates with sources including a computer. Ex.1005, [0236]; *see also id*., [0196], [0194]; Ex.1003, ¶84.

Thus, claim 3 is obvious over Jannard-740. Ex.1003, ¶¶83-85.

D. Claim 6

Claim 6 depends from claim 1 and recites "wherein the application module further includes at least one electronic device."

Jannard-740 discloses that "[a]t least partially inside of [the module 104's] housing 140 are a power module 170, an electronics module 172, a data port 174 and a holder 176 that supports a microphone 178." Ex.1005, [0102]. Figure 16 illustrates the module 104's internal assembly and identifies additional module components, including LED 187. *Id*., [0045].



Id., Fig.16. Jannard-740 also discloses that its module "… can include noise cancellation hardware and/or software to reduce or eliminate noise provided to the wearer of the support assembly 300 during use and communication." *Id*., [0162]; *see also* Ex.1017 (incorporated by reference in Ex.1005), [0165] ("noise cancellation electronics"), [0265] ("ASIC-based noise-canceling technology"), [0326] ("static and/or noise correction, and/or active or passive noise cancellation"). Each of Jannard-740's power module 170, electronics module 172, LED 187, and noise cancellation hardware is an electronic device. Ex.1003, ¶87.

Thus, claim 6 is obvious over Jannard-740. *Id*., ¶¶86-88.

E. Claim 7

Claim 7 depends from claim 6 and recites "wherein the application module is further configured to control at least one function of the at least one electronic device." Jannard-740 discloses this for multiple reasons.

First, Jannard-740 discloses its module 104's "LED 187 provides status indication to the wearer." Ex.1005, [0119]. The LED's activation and deactivation are functions of the LED that the module controls. Ex.1003, ¶90.

Second, Jannard-740 discloses its module's noise cancellation hardware reduces or eliminates noise during use and communication, as discussed for claim 6. *Supra* §VII.D; *see also* Ex.1017 (incorporated by reference in Ex.1005), [0165], [0265], [0326]. Jannard-740's module controls the processing of data through the noise cancellation hardware. Ex.1003, ¶91. Thus, the noise-cancelled audio output of the noise cancellation hardware is a function of the noise cancellation hardware that the module controls. *Id*., ¶91.

Thus, claim 7 is obvious over Jannard-740. *Id*., ¶¶89-91.

F. Claims 8-9

Claim 8 depends from claim 7 and recites "wherein the at least one function includes providing audio power to the at least one external device." Claim 9 depends on claim 7 and recites "wherein the at least one function includes providing electrical

power to the at least one external device." Both claims refer to "the at least one ***external*** device," which finds antecedent basis in "an ***external*** device" of claim 1.

1. Claim 8

The '960 patent uses the phrase "audio power" only in claim 8, while employing the phrases "audio out" and "power supply" within the specification. *See e.g.*, Ex.1001, 10:3-14. Petitioner interprets "audio power" to mean "audio out" consistent with the '960 patent's specification. Ex.1003, ¶94.

As discussed for claim 7, Jannard-740 discloses its module controls the noise cancellation hardware to reduce or eliminate noise during use and communication. *Supra* §VII.E. That function of the noise cancellation hardware (at least one electronic device) allows the noise cancellation hardware to send audio power to the cellular phone (at least one external device) in the form of microphone audio output from which noise has been reduced or eliminated. Ex.1003, ¶95.

Thus, claim 8 is obvious over Jannard-740. *Id*., ¶¶92-95.

Moreover, PO has taken the position in the Litigation that the application module of claim 8 may simply be one which controls audio output with voice control and wirelessly provides audio output to a smart phone. Ex.1018, 12-14. However, the application module of claim 1 already includes a microphone and wireless chip. Under PO's interpretation of claim 8, PO identifies no other electronic device that enables the functionality of claim 8 and which the application module "further

includes" as required by claim 6. Although Petitioner disagrees with PO's interpretation, claim 8 would be obvious under PO's interpretation for an additional independent reason. Ex.1003, ¶¶96-97. For example, as discussed for limitation 1[e], Jannard-740 discloses providing voice control and commands through the application module to the external device, i.e., the cellular phone. *Supra* §VII.A.6.

2. Claim 9

Jannard-740 discloses its module can "… transmit and receive data signals to and from the source device B…," such as a cellular phone. Ex.1005, [0194]. Jannard-740 also discloses its module can communicate via "… a physical connection, such as a wire, cable, fiberoptic cable, or trace on a PC board," with a source device like a cellular phone. *Id*., [0212], [0200], [0205]. A wired connection like a cable includes conductors for electrically communicating data. Ex.1011, 8 (USB meaning "universal serial bus"), 3-4 (bus being "[a] set of hardware lines (conductors) used for data transfer among the components of a computer system"); Ex.1003, ¶98. As part of transferring the data, such conductors provide electrical power from the module to the cellular phone via the conductors. Ex.1003, ¶98.

Thus, claim 9 is obvious over Jannard-740. *Id*., ¶¶92-93, 98-99.

G. Claim 10

Claim 10 depends from claim 1 and recites "wherein the application module further comprises a voice recognition chip."

Jannard-740 incorporates by reference Jannard-382 (Ex.1005, [0188], [0192]), which discloses this dependent claim limitation. Ex.1003, ¶101. Jannard-382 discloses electronic eyewear that "… include ASIC-based noise-canceling technology, such as is available in chips from Andrea Electronics Corporation (AEC), to enable voice recognition in ambient noise up to about 130 Db or more." Ex.1017, [0265]. It would have been obvious to incorporate a voice recognition chip in Jannard-740's module in view of Jannard-382 to enable the voice functions disclosed in Jannard-740 and/or Jannard-382. Ex.1003, ¶101; *see also* Ex.1019, 1:9-13. A POSITA would have been motivated to incorporate such a chip in Jannard-740's embodiments with a reasonable expectation of success because the chip is an off-the-shelf solution for providing voice recognition. Ex.1003, ¶101; *see also* Ex.1019, 1:9-13; Ex.1020, 19:28-20:1 (prior art disclosure in 1999 by '960 patent inventor Ronald Blum regarding use of "voice recognition chip"); Ex.1012, 3:52-64.

Thus, claim 10 is obvious over Jannard-740. Ex.1003, ¶¶100-102.

VIII. GROUND 2: CLAIMS 1-8 AND 10 ARE OBVIOUS OVER OSTERHOUT

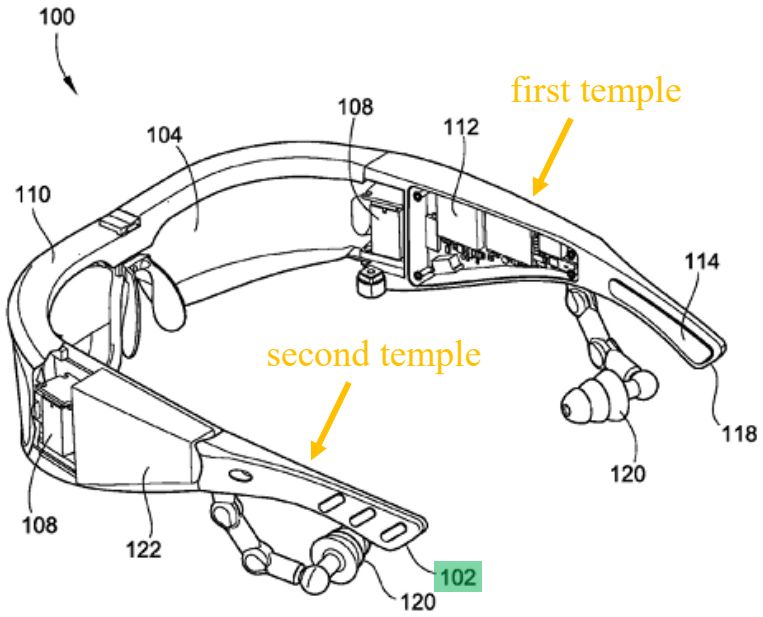
A. Claim 1

1. Preamble

Osterhout discloses "eyewear," specifically an "interactive head-mounted eyepiece." Ex.1006, Abstract, Fig.1, [0406]; Ex.1003, ¶104.

2. Limitation 1[a]

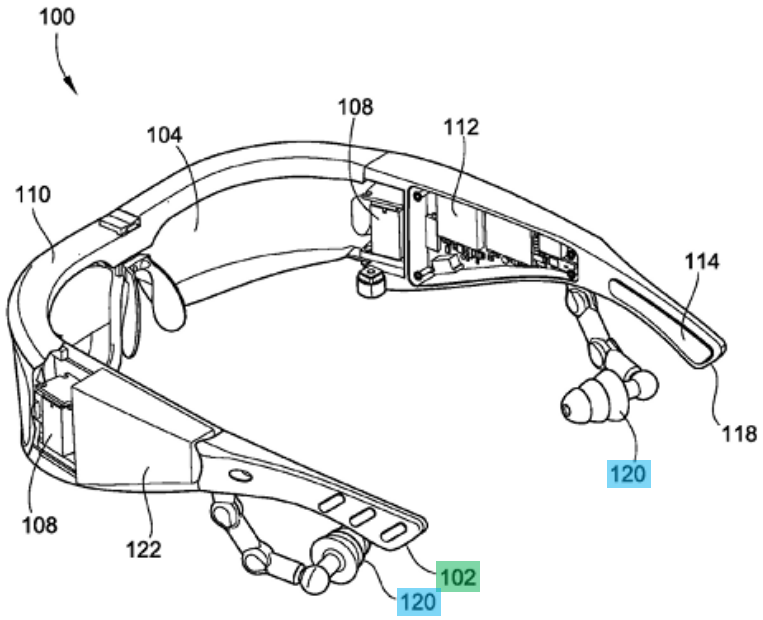
Figure 1 illustrates a frame 102 (green) with a first and second temple (orange):



Ex.1006, Fig.1 (annotated); Ex.1003, ¶105; *see also* Ex.1006, [0125], [0135]. Osterhout thus discloses what the '960 patent describes as an "eyewear frame." Ex.1003, ¶105; Ex.1001, 8:17-24.

3. Limitation 1[b]

Figure 1 illustrates speakers 120 (blue) supported by the frame 102 (green):



Ex.1006, Fig.1 (annotated); Ex.1003, ¶106; *see also* Ex.1006, [0126], [0135]; Ex.1001, 13:22-25.

4. Limitation 1[c]

Osterhout discloses its eyewear includes electronics, such as an open multimedia applications processor (OMAP) and a communications system on a chip (SOC), that can be disposed within a cavity of the eyewear's temple (e.g., temple housing 2116 in Figs. 21-22). Ex.1006, [0126], [0136], [0267], Figs. 1, 20-21. Osterhout's electronics are operably coupled to the ear buds so that the electronics cause the ear buds to "… deliver[] sounds to ears of the user." *Id*., [0138]; Ex.1003, ¶107. Osterhout's electronics are disposed in a cavity within the eyewear frame. For the reasons discussed below in Section IX.A, it would have been obvious to dispose Osterhout's electronics into a module to mechanically couple to an eyewear

because a POSITA would have been motivated to make the electronics modular and would have expected success in doing so. *Supra* §IX.A. Accordingly, this limitation would have been obvious in light of Osterhout. Ex.1003, ¶¶107-108.

In the Litigation, PO has alleged that an "electronics assembly" disposed within a temple of eyewear is a module. Ex.1018, 4-6. Petitioner disagrees. Such disposing of an "electronics assembly" directly within the temple is not encompassed by the plain and ordinary meaning of "module" because it has no modularity. Should PO maintain in this proceeding that a "module mechanically coupled to the eyewear" includes disposing electronics within the temple of eyewear, then Osterhout discloses this limitation. Ex.1003, ¶109.

5. Limitation 1[d]

Osterhout's electronics include a microphone that can be disposed within the eyewear's temple. Ex.1006, [0378], Figs. 39; *see also id*., [0135]. The microphone performs "[a]udio data capture." *Id*., [0026], [0361]. To the extent Osterhout does not expressly disclose the microphone is located within the same cavity and housing as the OMAP and communications SOC (e.g., temple housing 2116), it would have been obvious to position the microphone in the same cavity and housing. Ex.1003, ¶111. Such positioning would have provided known benefits including (i) space optimization, (ii) reduced manufacturing complexity, (iii) improved performance, (iv) enhanced durability and protection, and (v) better aesthetics. *Id*. Such

positioning represents nothing more than the simple addition of one known element (microphone in temple) to another known element (Osterhout's electronics in temple housing) to obtain predictable results (a module with both microphone and Osterhout's electronics in temple housing). *Id.*; *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Osterhout's electronics also include the communications SOC, as discussed for limitation 1[c]. *Supra* §VIII.A.4. The communications SOC supports "one or more communications capabilities, including a wide local area network (WLAN), BlueTooth™ communications," which include wireless communication protocols. Ex.1006, [0136], [0150]; *see also id.*, [0191]. The communications SOC is a wireless chip. Ex.1003, ¶110.

Thus, Osterhout discloses and renders obvious this limitation. *Id.*, ¶¶110-112.

6. Limitation 1[e]

Osterhout discloses that the voice commands "may be detected though a microphone on the eyepiece." Ex.1006, [0267]; *see also id.*, [0309], [0299]. The eyewear's communications SOC wirelessly transmits the voice commands to access information "located remotely, such as a database accessible over the Internet." *Id.*, [0309]-[0310]; Ex.1003, ¶113; *see also* Ex.1006, [0226] ("…querying a database…"). "Using voice commands, [the wearer] may then access the database and search within the database for particular information, such as manuals or other

repair and maintenance documents." Ex.1006, [0310]. In turn, the eyewear's communications SOC enables accessed information from the remotely located external device to be "viewed and heard" (e.g., via the ear buds) and provided "promptly" and "on-the-spot" to the wearer. *Id*., [0309]-[0310]; Ex.1003, ¶113; *see also* Ex.1006, [0215], [0364]. Therefore, Osterhout discloses a microphone and a wireless chip to receive a verbal query from a wearer of the eyewear, wirelessly transmit the verbal query to an external device, receive a response to the verbal query, and provide the response to the wearer via the speaker. Ex.1003, ¶113.

Thus, claim 1 is obvious over Osterhout. *Id*., ¶¶103-114.

B. Claims 2-3

Osterhout discloses its eyewear can wirelessly communicate through another device. For example, Osterhout provides that "the wearer may have to … tether [the eyewear] to their mobile communications facility in order to establish a wireless connection." Ex.1006, [0213], [0268]. Such tethering involves the eyewear communicating through a wearer's mobile communications facility (i.e., smart phone) so that the eyewear transmits the verbal query to the smart phone and receives the response to the verbal query through and from the smart phone. Ex.1003, ¶115; *see also* Ex.1006, [0213] ("…a mobile communications facility (e.g. mobile phone)"), [0364] ("…cellular telephone (smart phone)…"). A smart phone is a computer. Ex.1003, ¶115.

Thus, claims 2-3 are obvious over Osterhout. *Id*., ¶¶115-116.

C. Claims 4-5

Claim 4 depends from claim 1 and recites "wherein the verbal query includes a query about the weather." Claim 5 depends from claim 4 and recites "wherein a response to the query includes information about the weather."

Osterhout discloses these dependent claim limitations. For example, Osterhout discloses "[i]nformation and content related to … weather … may be accessed by the eyepiece and projected on to the lens of the eyepiece for the user to view and interact with." Ex.1006, [0302]. Osterhout also provides that with its eyewear "content may then be searched relating to … local weather…." *Id*. A POSITA would have been motivated to enable a verbal query received by Osterhout's electronics to include a query about the weather and also for a response to the query to include information about the weather. Ex.1003, ¶118. Such a combination represents the use of a known technique (requesting weather information using eyewear) to improve a known device and method (application module for processing voice commands and communicating with other devices) that is ready for improvement and yields predictable results (constructing application module to process verbal request for weather information and then receive requested weather information). *Id*.; *KSR*, 550 U.S. 398, 417 (2007).

Thus, claims 4-5 are obvious over Osterhout. Ex.1003, ¶¶117-118.

D. Claim 6

Osterhout discloses its electronics include the OMAP, as discussed for limitation 1[c]. *Supra* §VIII.A.4. The OMAP is an electronic device. Ex.1006, [0136]; Ex.1003, ¶120.

Thus, claim 6 is obvious over Osterhout. Ex.1003, ¶¶119-120.

E. Claim 7

Osterhout's OMAP may be a OMAP 4 (i.e., fourth generation OMAP), which provides audio playback for the eyewear. Ex.1006, [0188]; Ex.1016, [0028] ("As known in the art, [OMAP 4] applications processors are capable of … implementing … audio and video streaming…."); Ex.1003, ¶122. Osterhout's electronics control audio playback by the OMAP. Ex.1003, ¶122. Accordingly, the audio playback is a function of the OMAP that Osterhout's electronics control. *Id*.; *see also* Ex.1016, [0028].

Thus, claim 7 is obvious over Osterhout. Ex.1003, ¶¶121-122.

F. Claim 8

A POSITA would have been motivated to construct Osterhout's electronics so that the electronics provide audio output (i.e., audio power) to external devices selected for connection by a user. Ex.1003, ¶124. For example, Osterhout discloses that "[t]he eyepiece may provide additional electronic elements or features, including … audio output…." Ex.1006, [0187]; *see also id*., [0364]. One such

external device that the user would select for connection and providing audio power is the external device (e.g., a smart phone) to which Osterhout's electronics transmits the verbal query, which is discussed for limitation 1[e] and claims 2-3. Ex.1003, ¶124; *supra* §§VIII.A.6, VIII.B.

Moreover, the '960 patent attributes no significance to providing audio power to the external device as opposed to any other device. *See* Ex.1001, 2:35-40, 3:43-48, 10:3-39. Nor should it: choosing to provide audio power to the external device, rather than to another device, is not inventive. Ex.1003, ¶125.

Thus, claim 8 is obvious over Osterhout. Ex.1003, ¶¶123-126.

G. Claim 10

Osterhout discloses that its eyewear performs voice recognition. Ex.1006, [0267]; Ex.1003, ¶128; *see also* Ex.1006, [0244]-[0245], [0365]-[0368]. According to Osterhout, machines including "chips" are used for implementing disclosed elements and functions like voice recognition. Ex.1006, [0406]; Ex.1003, ¶128.

Thus, claim 10 is obvious over Osterhout. Ex.1003, ¶¶127-128.

IX. GROUND 3: CLAIMS 1-10 ARE OBVIOUS OVER JANNARD-740 AND OSTERHOUT

A. Combination of Jannard-740 and Osterhout

As discussed in Ground 1, Jannard-740 discloses or suggests eyewear comprising every limitation of claim 1. *Supra* §VII.A. To the extent that Jannard-740 does not disclose its microphone and wireless chip (transceiver chip) receive a

verbal query, wirelessly transmit that verbal query to an external device, receive a response to the verbal query, and provide the response via the speaker, Osterhaut certainly does. *Supra* §VIII.A.6. It would have been obvious to combine Jannard-740 and Osterhout to render these claim limitations obvious. Ex.1006, [0309]-[0310]; Ex.1003, ¶¶129-130; *see also id*., [0226].

A POSITA would have been motivated for multiple reasons to incorporate Osterhout's functionality, such as the verbal content search functionality, in Jannard-740's application module, such as in the module's electronics. Ex.1003, ¶131.

First, Jannard-740 and Osterhout suggest doing so. Jannard-740 discloses "… interface electronics for interacting with a wireless network and/or providing content to a user." Ex.1005, [0003]. Jannard-740's wearable device is usable to verbally select an external content source (e.g., database) from which to receive and provide content. *Id*., [0236], [0214]; Ex.1003, ¶132. Osterhout discloses that its eyewear is usable to verbally search an external content source like a database for "… particular information, such as manuals or other repair and maintenance documents." Ex.1006, [0309]-[0310]; Ex.1003, ¶132. A POSITA would have been motivated to incorporate Osterhout's functionality, including the verbal content search functionality, in Jannard-740's application module to enable the application module to search for content verbally requested by a wearer, such as particular content in a database or another collection of content (e.g., audio file from set of audio files).

Ex.1003, ¶132; *see also* Ex.1005, [0236]. This incorporation would allow a wearer to verbally request both a source of content and particular content from the source, consistent with Jannard-740's recommendation that "… by providing voice control over system functionality, the user need not manipulate mechanical buttons, switches or controls…." Ex.1005, [0161]; Ex.1003, ¶132. This incorporation would have provided known benefits including [i] enhancing user convenience through enabling a wearer to verbally select and audibly receive content from the external source device handsfree and [ii] facilitating quicker access to content from the external source device via the application module when the wearer wears the eyewear (e.g., where the wearer has disability/mobility issues or when accessing the external source device would be inconvenient or dangerous). Ex.1003, ¶132.

Second, such a modification represents nothing more than the simple addition of one known element (eyewear that processes verbal query for particular content from external source device) to another known element (eyewear application module that processes voice commands) to obtain predictable results (eyewear application module that processes verbal query for particular content from external source device). *Id*., ¶133; *KSR*, 550 U.S. at 417.

Third, the combination represents the use of a known technique (verbally querying particular content using eyewear) to improve a similar device and method

(Jannard-740's application module with wireless communications for diverse functions) in the same way. Ex.1003, ¶134; *KSR*, 550 U.S. at 417.

Fourth, the combination represents the use of a known technique (verbally querying particular content using eyewear) to improve a known device and method (Jannard-740's application module for processing voice commands) that is ready for improvement and yields predictable results (constructing Jannard-740's application module to incorporate verbal content search functionality). Ex.1003, ¶135; *KSR*, 550 U.S. at 417.

A POSITA would have reasonably expected success in incorporating Osterhout's functionality, including the verbal content search functionality, in Jannard-740's application module because such incorporation would have been trivial for a POSITA. Ex.1003, ¶136. At most this would have involved limited software and/or hardware updates that were well within a POSITA's abilities. *Id*.

As discussed in Ground 2, Osterhout discloses or suggests eyewear comprising every limitation of claim 1. *Supra* §VIII.A. To the extent Osterhout does not disclose an application module as recited by claim 1, this would have been obvious in view of Jannard-740. Jannard-740 discloses a self-enclosed, independent electronics module unit that meets the application module recited by claim 1. *Supra* §VII.A. A POSITA would have been motivated to implement Osterhout's

electronics in a self-enclosed, independent unit like Jannard-740's, Ex.1005, [0081], [0086], for several reasons. Ex.1003, ¶137.

First, Jannard-740 suggests doing so. Jannard-740 discloses that "[t]he housing 140 is formed by attaching the first body portion 166 to the second body portion 168 along a part line, to provide a protective outer wall which defines at least one interior cavity for housing electronics." Ex.1005, [0102]. This allows the housing 140 to be "… formed entirely or partially by insert molding or co-molding processes to produce embedded electronics in a unitary or monolithic module." *Id*. Such a design would have provided known benefits including (i) space optimization, (ii) reduced manufacturing complexity, (iii) improved performance, (iv) enhanced durability and protection, and (v) better aesthetics. Ex.1003, ¶138.

Second, the combination represents the use of a known technique (including electronics for eyewear in self-enclosed, independent unit) to improve a known device and method (Osterhout's eyewear electronics) that is ready for improvement and yields predictable results (eyewear electronics incorporated in self-enclosed, independent unit for known benefits). *Id*., ¶139; *KSR*, 550 U.S. at 417.

Third, the construction represents nothing more than the simple addition of one known element (module with electronics for eyewear) to another known element (Osterhout's electronics in temple housing) to obtain predictable results (module

incorporating electronics for coupling to temple to realize known benefits). Ex.1003, ¶140; *KSR*, 550 at 417.

A POSITA would have reasonably expected success in incorporating Jannard-740's teaching of a self-enclosed, independent unit in Osterhout's eyewear because such incorporation would have been trivial for a POSITA. Ex.1003, ¶141. At most this would have involved limited structural and/or hardware updates that were well within a POSITA's abilities. *Id*.

B. Claim 1

1. Preamble and Limitations 1[a]-1[b]

Jannard-740 and Osterhout disclose the preamble and limitations 1[a]-1[b] for the reasons discussed for the preamble of claim 1 and limitations 1[a]-1[b] in Grounds 1-2. *Supra* §§VII.A.1-3, VIII.A.1-3.

2. Limitations 1[c]-[d]

Jannard-740 discloses these limitations for the reasons discussed for limitations 1[c]-1[d] in Ground 1. *Supra* §§VII.A.4-5. Osterhout discloses and renders obvious these limitations for the reasons discussed for limitations 1[c]-1[d] in Ground 2. *Supra* §§VIII.A.4-5.

A POSITA would have been motivated to incorporate Jannard-740's teaching of a self-enclosed, independent module unit in Osterhout's eyewear and reasonably

expected success in doing so as discussed above for the combination of Osterhout with Jannard-740. *Supra* §IX.A.

3. Limitation 1[e]

Jannard-740 renders obvious this limitation for the reasons discussed for limitation 1[e] in Ground 1. *Supra* §VII.A.6. Osterhout discloses this limitation for the reasons discussed for limitation 1[e] in Ground 2. *Supra* §VIII.A.6.

A POSITA would have been motivated to incorporate Osterhout's verbal content search functionality in Jannard-740's application module, such as in the module's electronics, and reasonably expected success in doing so as discussed above for the combination of Jannard-740 with Osterhout. *Supra* §IX.A.

Thus, claim 1 is obvious over Jannard-740 and Osterhout. Ex.1003, ¶¶142-147.

C. Claims 2-3

Jannard-740 and Osterhout render obvious claims 2-3 for the reasons discussed for claims 2-3 in Grounds 1-2. *Supra* §§VII.B-C, VIII.B.

Thus, claims 2-3 are obvious over Jannard-740 and Osterhout. Ex.1003, ¶¶148-149.

D. Claims 4-5

Osterhout renders obvious claims 4-5 for the reasons discussed for claims 4-5 in Ground 2. *Supra* §VIII.C.

A POSITA would have been motivated in view of Osterhout to enable a verbal query received by Jannard-740's application module to include a query about the weather and also for a response to the query to include information about the weather. Ex.1003, ¶151. Such a combination represents the use of a known technique (requesting weather information using eyewear) to improve a known device and method (Jannard-740's application module for processing voice commands and communicating with other devices) that is ready for improvement and yields predictable results (constructing Jannard-740's application module to process verbal request for weather information and then receive requested weather information). *Id*.; *KSR*, 550 U.S. at 417. Furthermore, Jannard-740 discloses its selectable sources (e.g., communications-enabled device or Internet) store content, such as "… a variety of information sources, including but not limited to, … news, … etc.," that is accessible to a wearable device. Ex.1005, [0236]. Weather information is a subset of news information, which is a type of content that Jannard-740 expressly contemplates receiving from an external source device. Ex.1003, ¶151.

Thus, claims 4-5 are obvious over Jannard-740 and Osterhout. *Id*., ¶¶150-152.

E. Claims 6-10

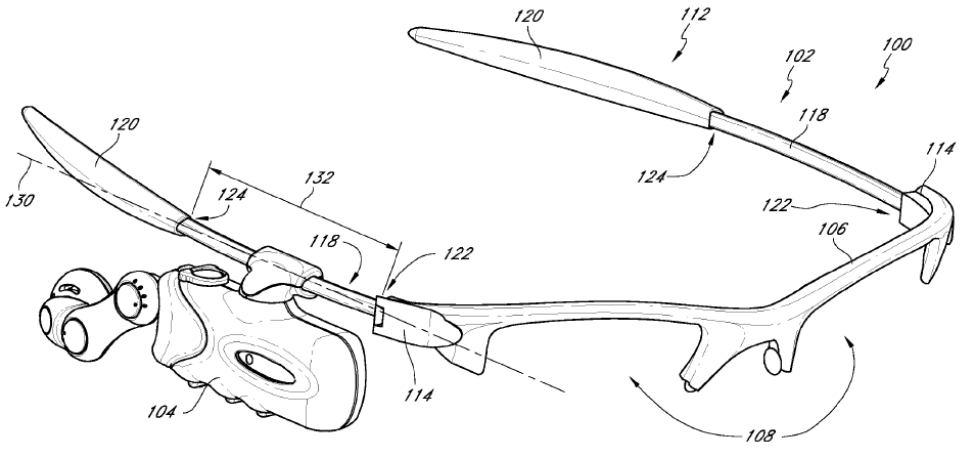
Jannard-740 renders obvious claims 6-10 for the reasons discussed for claims 6-10 in Ground 1. *Supra* §§VII.D-G. Osterhout renders obvious claims 6-8 and 10 for the reasons discussed for claims 6-8 and 10 in Ground 2. *Supra* §§VIII.D-G.

Thus, claims 6-10 are obvious over Jannard-740 and Osterhout. Ex.1003, ¶¶153-154.

X. GROUND 4: CLAIMS 11-18, 20-24, AND 26 ARE OBVIOUS OVER JANNARD-740 AND ROSENBLATT

A. Combination of Jannard-740 and Rosenblatt

Jannard-740 discloses eyewear comprising an eyewear frame and an application module mechanically coupled to the eyewear frame as discussed for claim 1 in Ground 1. *Supra* §§VII.A.1-2, VII.A.4.



Ex.1005, Fig.3. Jannard-740 also discloses its application module includes a wireless chip and a transmitter. *Supra* §VII.A.5; Ex.1005, [0011], Claim 10. Jannard-740, thus, discloses every limitation of claims 11 and 22 except perhaps that

[i] another device recognizes a presence of a wearer based at least partly on communication with the wireless chip (claim 11) and [ii] the application module transmits a password to access a computer (claim 22). But it was well known, as disclosed in Rosenblatt, to use a wireless chip and transmitter for such functions. Ex.1007, [0058]-[0061], [0095]; Ex.1003, ¶155.

Rosenblatt discloses "the key or its functionality may be incorporated in an electronic device, for example in a cellular telephone, a mobile communications device, a pocket-sized personal computer (e.g., an iPAQ or a Palm Pilot) a personal media device (e.g., an iPod), a camera, a video recorder, a computer (e.g., a laptop computer), a key (e.g., car keys), a remote controller, or any other suitable electronic device." Ex.1007, [0007]. Jannard-740's application module for eyewear is one such suitable device in which to incorporate Rosenblatt's key or its functionality. Ex.1003, ¶156. Indeed, Rosenblatt recommends attaching its key to a wired or wireless headset (Ex.1007, [0043]), which is similar to Jannard-740's eyewear system. Ex.1003, ¶156. A POSITA would have been motivated to incorporate Rosenblatt's key or its functionality in Jannard-740's application module to achieve the benefits disclosed in Rosenblatt with Jannard-740's application module, including controlling host devices responsive to wireless communication with Jannard-740's application module. *Id*. This implementation of Jannard-740's

application module desirably "provid[es] functional fashion having device operation capabilities," as Rosenblatt recommends. *Id*.; *see also* Ex.1007, [0058].

Such a modification of Jannard-740's application module represents nothing more than the simple addition of one known element (key or its functionality) to another known element (application module) to obtain predictable results (application module incorporating key or its functionality). Ex.1003, ¶157; *KSR*, 550 at 417. In addition, the combination of Jannard-740 and Rosenblatt represents the use of a known technique (incorporating key or its functionality into electronic device) to improve a similar device and method (Jannard-740's application module with wireless communications for diverse functions) in the same way. Ex.1003, ¶157; *KSR*, 550 U.S. at 417. The combination also represents the use of a known technique (incorporating key or its functionality into electronic device) to improve a known device and method (Jannard-740's application module for eyewear) that is ready for improvement and yields predictable results (enhancing Jannard-740's application module by incorporating key or its functionality). Ex.1003, ¶157; *KSR*, 550 U.S. at 417.

A POSITA would have reasonably expected success in incorporating Rosenblatt's key or its functionality in Jannard-740's application module in view of Rosenblatt's recommendation to include the key or its functionality "… in a cellular telephone, a mobile communications device, a pocket-sized personal computer (e.g.,

an iPAQ or a Palm Pilot) a personal media device (e.g., an iPod) …" or to attach the key to a wired or wireless headset. Ex.1007, [0007], [0043]; Ex.1003, ¶158.

B. Claim 11

1. Preamble

The preamble of claim 11 recites "[e]yewear." Jannard-740 discloses the preamble as discussed for the preamble of claim 1 in Ground 1. *Supra* §VII.A.1.

2. Limitation 11[a]

Jannard-740 discloses this limitation as discussed for limitation 1[a] in Ground 1. *Supra* §VII.A.2.

3. Limitation 11[b]

Jannard-740 discloses this limitation as discussed for limitation 1[c] in Ground 1. *Supra* §VII.A.4.

4. Limitation 11[c]

Jannard-740 discloses this limitation as discussed for limitation 1[d] in Ground 1. *Supra* §VII.A.5.

Rosenblatt also discloses, or at least suggests, this limitation. For example, Rosenblatt discloses a key includes communications circuitry and "… create[s] a relatively short-range personal area network," using protocol such as "… Wi-Fi communications (e.g., one of the 802.11 standards), Bluetooth, … and other relatively localized wireless communication protocols." Ex.1007, [0006].

Rosenblatt provides its "… communications circuitry may be integrated within the packaging of key 110 (e.g., integrated into a printed circuit board of the device) …," confirming the key may include a wireless chip. *Id*., [0030]; Ex.1003, ¶163. According to Rosenblatt, "[w]hen a key is brought in proximity of a host device such that the host device is within the personal area network created by the key, the communications circuitry of the key and the transceiver of the host device may communicate data." Ex.1007, [0010]. Rosenblatt's key is an application module, and Rosenblatt's host device is a wireless enabled device. Ex.1003, ¶163.

A POSITA would have been motivated to incorporate Rosenblatt's key or its functionality in Jannard-740's application module, such as in the module's electronics or housing, and reasonably expected success in doing so for the reasons discussed above. *Supra* §X.A.

Accordingly, Jannard-740 and Rosenblatt render obvious that the application module includes a wireless chip to communicate with a wireless enabled device. Ex.1003, ¶¶162-165.

5. Limitation 11[d]

Rosenblatt discloses this limitation. For example, Rosenblatt discloses "[a] system that includes a key for remotely causing a host device to perform an operation." Ex.1007, [0005]. Rosenblatt provides that "[b]y virtue of the presence of a key, a personal area network may exist about person 510." *Id*., [0058].

According to Rosenblatt, a host device "… perform[s] any suitable operation when the key is placed in proximity of the host device such that the personal area network of the key encloses the host device." *Id*., [0060]. Rosenblatt confirms that the host device performs the operation "… in response to receiving a signal from the key." *Id*. Rosenblatt also provides that "the user may be required to enter private information in addition to having the key present to perform an operation (e.g., a password for a more secure login to the computer)." *Id*., [0061]. For example, "… the user may provide login data to the key for transmission to computer 110 or 112." *Id*.

Accordingly, Jannard-740 and Rosenblatt render obvious that the wireless enabled device is configured to recognize a presence of a wearer of the eyewear based at least in part on communication with the wireless chip. Ex.1003, ¶¶166-167.

Thus, claim 11 is obvious. *Id*., ¶¶159-167.

C. Claim 12

Rosenblatt discloses its host device can be a smart lamp. Ex.1007, [0061]. Rosenblatt provides "[l]amp 660 may be configured to be turned on or off when a key is brought in proximity of the lamp." *Id*., [0065]. "[A]s long as lamp 660 is within the network created by the key, lamp 660 may be turned on." *Id*. In addition, Rosenblatt discloses a host device, such as a lamp, controls light in the wearer's environment based at least in part on the wearer's preferences. *Id*., [0035], [0037],

[0065]; Ex.1003, ¶169. Rosenblatt provides a user may "… select the operation or operations that key 200 will direct a particular host device to perform…." Ex.1007, [0039]. In turn, the key's memory may store "… an instruction to perform an operation with a host device, an identifier for a user profile or for user preferences, or user profile or user preference data …" for transmitting to the host device. *Id*., [0037]. In one example, Rosenblatt discloses the user "… select[s] with the key whether to turn lamp 660 on or off, or select[s] the intensity for the lamp, and direct[s] the key to transmit the selection to lamp 660." *Id*., [0065].

Accordingly, claim 12 is obvious. Ex.1003, ¶¶168-170.

D. Claim 13

Rosenblatt discloses its host device can be a smart heating and/or air conditioning system. Ex.1007, [0061]. Rosenblatt provides "[h]eating and/or air conditioning system 670 may be configured to discharge air at a particular temperature when the key is brought in proximity of heating and/or air conditioning system 670." *Id*., [0066]. Rosenblatt also discloses a host device, such as the heating and/or air conditioning system, controls temperature in the wearer's environment based at least in part on the wearer's preferences. *Id*., [0035], [0037], [0066]; Ex.1003, ¶172. According to Rosenblatt, a user may "… select the operation or operations that key 200 will direct a particular host device to perform…." Ex.1007, [0039]. In turn, the key's memory may store "… an instruction to perform an

operation with a host device, an identifier for a user profile or for user preferences, or user profile or user preference data …" for transmitting to the host device. *Id*., [0037]. In one example, Rosenblatt discloses the user "… select[s] with the key a temperature, fan speed, or other setting, and direct[s] the key to transmit the selection to system 670." *Id*., [0066].

Accordingly, claim 13 is obvious. Ex.1003, ¶¶171-173.

E. Claim 14

Rosenblatt discloses this claim's dependent claim limitations for two reasons.

First, Rosenblatt discloses "[a]utomobile 640 may be configured to perform any of a number of operations when a key is brought in proximity of the automobile." Ex.1007, [0063]. For example, Rosenblatt provides "automobile 640 may automatically activate a navigation system (e.g., a GPS system) or a media system." *Id*. Such a media system comprises an external audio device that is external to Rosenblatt's key. Ex.1003, ¶175. Rosenblatt also discloses "… the user may select with the key one or more particular operations for automobile 640 to perform, and direct the key to transmit the user's selections to the automobile." Ex.1007, [0063].

Second, Rosenblatt discloses that when a key is placed in proximity of multimedia system 630, "media system 630 may be configured to automatically load the user profile or preferences of the user associated with the key, or login the user associated with the key (e.g., load the user's music preferences or load the user's

playlists)." Ex.1007, [0061]-[0062]. Such a media system includes a speaker, which is external to Rosenblatt's key and enables the user to listen to the music. *Id*., [0062]; Ex.1003, ¶176. Rosenblatt also provides a user may "… select the operation or operations that key 200 will direct a particular host device to perform." Ex.1007, [0039].

Accordingly, claim 14 is obvious. Ex.1003, ¶¶174-177.

F. Claim 15

Rosenblatt discloses this claim's dependent claim limitations for two reasons.

First, Rosenblatt discloses "[a]utomobile 640 may be configured to perform any of a number of operations when a key is brought in proximity of the automobile." Ex.1007, [0063]. For example, Rosenblatt provides "automobile 640 may automatically activate a navigation system (e.g., a GPS system) or a media system." *Id*. Such a navigation system includes an external video device for visually assisting a user in navigating. Ex.1003, ¶179. The external video device is external to Rosenblatt's key. *Id*. Rosenblatt also discloses "… the user may select with the key one or more particular operations for automobile 640 to perform, and direct the key to transmit the user's selections to the automobile." Ex.1007, [0063].

Second, Rosenblatt discloses "[t]elevision system 620 may be configured to automatically load a user's profile or preferences when a key associated with the user is brought in proximity of system 620." Ex.1007, [0062]. Such a television

system includes a screen, which is external to Rosenblatt's key and enables the user to watch content. *Id*.; Ex.1003, ¶180. Rosenblatt also provides a user may "… select the operation or operations that key 200 will direct a particular host device to perform." Ex.1007, [0039].

Accordingly, claim 15 is obvious. Ex.1003, ¶¶178-181.

G. Claim 16

Rosenblatt discloses "[a]utomobile 640 may be configured to perform any of a number of operations when a key is brought in proximity of the automobile." Ex.1007, [0063]. For example, "automobile 640 may automatically turn on the heating or air conditioning system of the automobile" when the key is brought in proximity to the automobile. *Id*. Such a heating or air conditioning system is a wireless enabled device located in an automobile. Ex.1003, ¶183.

Thus, claim 16 is obvious. *Id*., ¶¶182-184.

H. Claim 17

As discussed for claim 16, Rosenblatt discloses an automobile automatically turns on its heating or air conditioning system when the key is brought in proximity of the automobile. *Supra* §X.G. Turning on the heating or air conditioning system controls an air management function of the automobile. Ex.1003, ¶186.

Thus, claim 17 is obvious. *Id*., ¶¶185-187.

I. Claim 18

As discussed for claim 16, Rosenblatt discloses an automobile automatically turns on its heating or air conditioning system when the key is brought in proximity of the automobile. *Supra* §X.G. This heating or air conditioning system controls a temperature of the automobile. Ex.1003, ¶189.

Thus, claim 18 is obvious. *Id*., ¶¶188-190.

J. Claim 20

Jannard-740 discloses "the wireless chip is a Bluetooth chip" as discussed for limitation 1[d] in Ground 1. *Supra* §VII.A.5. Rosenblatt additionally discloses "the wireless chip is a Bluetooth chip" as discussed for limitation 11[c] this ground. *Supra* §X.B.4.

Thus, claim 20 is obvious. Ex.1003, ¶¶191-192.

K. Claim 21

Rosenblatt discloses its host device may be a computer or laptop. Ex.1007, [0061]. When a key is placed in proximity of the computer or laptop, "computer 610 and laptop 612 may be configured to automatically log the user associated with the key into the computer system" or "… load a user's profile or preferences." *Id*.

Thus, claim 21 is obvious. Ex.1003, ¶¶193-195.

L. Claim 22

1. Preamble

Jannard-740 discloses the preamble as discussed for the preamble of claim 1 in Ground 1. *Supra* §VII.A.1.

2. Limitation 22[a]

Jannard-740 discloses this limitation as discussed for limitation 1[a] in Ground 1. *Supra* §VII.A.2.

3. Limitation 22[b]

Jannard-740 discloses this limitation as discussed for limitation 1[c] in Ground 1. *Supra* §VII.A.4.

4. Limitation 22[c]

Jannard-740 discloses this limitation. For example, Jannard-740 discloses the application module may include "… a radio frequency transmitter…." Ex.1005, [0011], Claim 12 ("electronics module comprises a transmitter"); Ex.1003, ¶199. In addition, as discussed for limitation 1[d] in Ground 1, Jannard-740 discloses that its application module comprises a wireless chip. *Supra* §VII.A.5.

5. Limitation 22[d]

Rosenblatt discloses this limitation. For example, as discussed for limitations 11[c]-11[d], Rosenblatt discloses a system that includes a key with a wireless chip which remotely causes a host device, such as a computer, to perform an operation

when the key is placed in proximity to the host device. *Supra* §§X.B.4-5. Further, Rosenblatt discloses "[t]he key may include a communications circuitry for transmitting data," confirming the communications circuitry includes a transmitter for facilitating the data transmission. Ex.1007, Abstract; Ex.1014, 3 (definition of transmitter); *see also* Ex.1007, [0037]. Rosenblatt also provides that a host device like a computer "… authenticates the key." Ex.1007, [0095]. The computer's processor "… may receive authentication information from the key that processor 302 can compare to data stored for the key in storage device 304 or memory 306." *Id*. "Authentication information may include, for example, a username and password combination…." *Id*. Rosenblatt confirms that "… the user may provide login data to the key for transmission to [the] computer…." *Id*., [0061]. In addition, Rosenblatt discloses that, once a host device determines that the key is authenticated, "the host device identifies one or more operations to perform in response to the key's proximity…." *Id*., [0097]-[0098]. Such operations may include "automatically log[ging] the user associated with the key into the computer system." *Id*., [0061]; *see also id*., [0053].

A POSITA would have been motivated to incorporate Rosenblatt's key or its functionality in Jannard-740's application module, such as in the module's electronics or housing, and reasonably expected success in doing so for the reasons as discussed above. *Supra* §X.A.

Accordingly, Jannard-740 and Rosenblatt render obvious a transmitter and a wireless chip to wirelessly transmit a password from the application module from a wearer of the eyewear to a computer to access the computer. Ex.1003, ¶¶200-202.

Thus, claim 22 is obvious. *Id*., ¶¶196-203.

M. Claim 23

Rosenblatt discloses receiving the password at the computer enables access to the computer, as discussed for limitation 22[d]. *Supra* §X.L.5.

Thus, claim 23 is obvious. Ex.1003, ¶¶204-206.

N. Claim 24

The phrase "wireless enabled device" lacks an antecedent basis, making the meaning of this claim unclear. As best as Petitioner understands, PO intended to recite "computer" in place of "wireless enabled device." Petitioner applies this interpretation to claim 24.

Rosenblatt discloses this claim's dependent claim limitations. For example, Rosenblatt discloses a host device, such as a computer, "may include a display…." Ex.1007, [0051]-[0053]. Such a display varies its brightness to visually present information to a user. Ex.1011, 5; Ex.1003, ¶208. Thus, claim 24 is obvious. Ex.1003, ¶¶207-209.

O. Claim 26

Petitioner interprets "wireless enabled device" to mean "computer" as discussed for claim 24. *Supra* §X.N.

Rosenblatt discloses a host device, such as a computer, performs operations including "… opening a program (e.g., opening a user's e-mail software)…." Ex.1007, [0009], [0055]; *see also* Ex.1005, [0210]. Such an e-mail software accesses a user's email with the computer. Ex.1003, ¶211.

Thus, claim 26 is obvious. *Id*., ¶¶210-212.

XI. GROUND 5: CLAIM 19 IS OBVIOUS OVER JANNARD-740, ROSENBLATT, AND GUNARATNE

This ground addresses claim 19, which claims controlling an automobile's functionality to wake a wearer of eyewear. Gunaratne discloses such controlling. Ex.1003, ¶215.

Rosenblatt discloses its host device (wireless enabled device) can be an automobile. Ex.1007, [0061]. A common issue with automobiles known to a POSITA is drowsiness while driving. Ex.1008, [0002]; Ex.1003, ¶214. Gunaratne discloses a system that addresses this known issue by "rapidly detect[ing] the drowsiness of an individual operating a machine," such as a motor vehicle. Ex.1008, [0018]. An actuator can "… alert the individual that he or she is becoming drowsy and may fall asleep unless proper action is taken." *Id*., [0026]. The actuator "can be an audio actuator such as … a radio in a motor vehicle…." *Id.*

A POSITA would have been motivated to add Gunaratne's drowsiness-alert functionality to the automobile in the combination of Jannard-740 and Rosenblatt because Gunaratne suggests doing so. Ex.1003, ¶216. For example, Gunaratne discloses its drowsiness-alert functionality "… has utility as a safety feature for a machine." Ex.1008, [0017]. Rapidly detecting driver drowsiness "… improve[s] the performance and/or safety of the individual, other individuals in the vicinity of the machine and the like." *Id*., [0018]. Adding the functionality would enable Jannard-740-Rosenblatt's automobile to realize the benefits disclosed in Gunaratne. Ex.1003, ¶216. Furthermore, the combination represents the use of a known technique (alerting drivers determined to be drowsy) to improve a known device and method (Jannard-740-Rosenblatt's automobile having electronic systems) that is ready for improvement and yields predictable results (alerting drowsy drivers in automobile to increase safety). *Id*.; *KSR*, 550 U.S. at 417. Incorporating the functionality would have been trivial in view of Gunaratne's disclosure. Ex.1003, ¶216; *see also* Ex.1007, [0063].

Thus, claim 19 is obvious. Ex.1003, ¶¶213-217.

XII. GROUND 6: CLAIM 25 IS OBVIOUS OVER JANNARD-740, ROSENBLATT, AND NIELSEN

This ground addresses claim 25, which claims adjusting a font size of an application in a computer. Nielsen discloses such adjusting. Ex.1003, ¶221.

Petitioner interprets "wireless enabled device" to mean "computer" as discussed for claim 24. *Supra* §X.N.

Rosenblatt discloses its host device (wireless enabled device) can be a computer. Ex.1007, [0061]. A POSITA would have known that font sizes on computers should be adapted to user preferences. Ex.1009, 1:14-63; Ex.1003, ¶220. Nielsen discloses a routine method for "… adaptively changing the font size with which information retrieved over a network is displayed." Ex.1009, 1:9-11. A document is "displayed with a size preference found in one of the databases." *Id*., 2:54-56. This display may be presented by a browser application executed in a computer. *Id*., 5:29-35, 4:11-12, 2:7-14; Ex.1003, ¶221.

A POSITA would have been motivated to add Nielsen's adaptive font functionality to the computer in the combination of Jannard-740 and Rosenblatt because Nielsen suggests doing so. Ex.1003, ¶222. For example, Nielsen beneficially "provide[s] a way for adapting font size in a browser or other User Interface based on user font-size preferences for retrieved documents." Ex.1009, 1:55-57. Adapting of font size "accommodate[s] the needs of a variety of network users who have different individual preferences for viewing documents …" and "account[s] for display differences which may cause the same document to appear differently on different displays." *Id*., 1:58-63. Adding the functionality would enable Jannard-740-Rosenblatt's computer to realize the benefits disclosed in

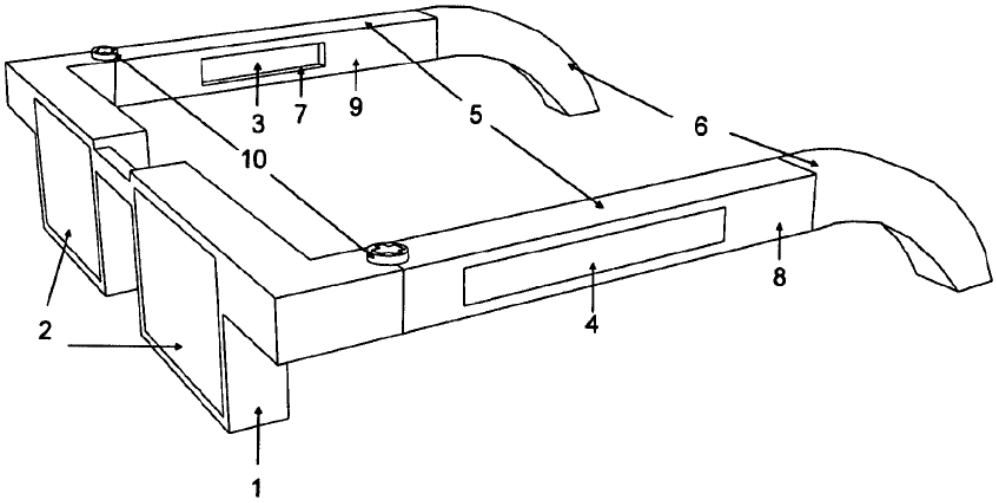
Nielsen. Ex.1003, ¶222; *see also* Ex.1007, [0051]-[0052]. Furthermore, the combination represents the use of a known technique (adapting font size in browser) to improve a known device and method (Jannard-740-Rosenblatt's computer for executing applications) that is ready for improvement and yields predictable results (adapting font size in browser of computer to better respond to user preferences). Ex.1003, ¶222; *KSR*, 550 U.S. at 417. Incorporating the functionality would have been trivial in view of Nielsen's disclosure. Ex.1003, ¶222.

Thus, claim 25 is obvious. *Id*., ¶¶218-223.

XIII. GROUND 7: CLAIMS 11-18, 20-24, AND 26 ARE OBVIOUS OVER CHEN AND ROSENBLATT

A. Combination of Chen and Rosenblatt

Chen discloses eyewear comprising an eyewear frame and an application module (cartridge) mechanically coupled to the eyewear frame. Ex.1010, 2:55-59; Ex.1003, ¶224.



Ex.1010, Fig.1. Chen also discloses eyewear with wireless communication circuitry. *Id*., 1:28-31, 1:63-22; *see also* Ex.1015, 4:19-37. Chen, thus, discloses every limitation of claims 11 and 22 except perhaps using a wireless chip and transmitter so that [i] another device recognizes a presence of a wearer based at least partly on communication with the wireless chip (claim 11) and [ii] the application module transmits a password to access a computer (claim 22). But it was well known, as disclosed in Rosenblatt, to use a wireless chip and transmitter for such functions. Ex.1007, [0058]-[0061], [0095]; Ex.1003, ¶224.

As discussed in Ground 4, Rosenblatt discloses "the key or its functionality may be incorporated in an electronic device, for example in a cellular telephone, a mobile communications device, a pocket-sized personal computer (e.g., an iPAQ or a Palm Pilot) a personal media device (e.g., an iPod), a camera, a video recorder, a computer (e.g., a laptop computer), a key (e.g., car keys), a remote controller, or any other suitable electronic device." Ex.1007, [0007]. Chen's application module for

eyewear is one such suitable device in which to incorporate Rosenblatt's key or its components or functionality. Ex.1003, ¶225. Indeed, Rosenblatt recommends attaching its key to a wired or wireless headset (Ex.1007, [0043]), which is similar to Chen's eyewear system. Ex.1003, ¶225. A POSITA would have been motivated to incorporate Rosenblatt's key or its components or functionality in Chen's application module to achieve the benefits disclosed in Rosenblatt with Chen's application module, including controlling host devices responsive to wireless communication with Chen's application module. *Id*. This implementation of Chen's application module desirably "provid[es] functional fashion having device operation capabilities," as Rosenblatt recommends. *Id*.; *see also* Ex.1007, [0058].

Such a modification of Chen's application module represents nothing more than the simple addition of one known element (key or its components or functionality) to another known element (application module) to obtain predictable results (application module incorporating key or its components or functionality). Ex.1003, ¶226; *KSR*, 550 at 417. In addition, the combination of Chen and Rosenblatt represents the use of a known technique (incorporating key or its components or functionality into electronic device) to improve a similar device and method (Chen's application module with diverse functions) in the same way. Ex.1003, ¶226; *KSR*, 550 U.S. at 417. The combination also represents the use of a known technique (incorporating key or its components or functionality into

electronic device) to improve a known device and method (Chen's application module for eyewear) that is ready for improvement and yields predictable results (enhancing Chen's application module by incorporating key or its components or functionality). Ex.1003, ¶226; *KSR*, 550 U.S. at 417.

A POSITA would have reasonably expected success in incorporating Rosenblatt's key or its components or functionality in Chen's application module in view of Chen's disclosure that "[t]he removable cartridge comprises of materials and components, including electronic or non-electronic or any combination thereof," (Ex.1010, 2:60-63) and Rosenblatt's recommendation to include the key or its components or functionality "… in a cellular telephone, a mobile communications device, a pocket-sized personal computer (e.g., an iPAQ or a Palm Pilot) a personal media device (e.g., an iPod) …" or to attach the key to a wired or wireless headset (Ex.1007, [0007], [0043]). Ex.1003, ¶227.

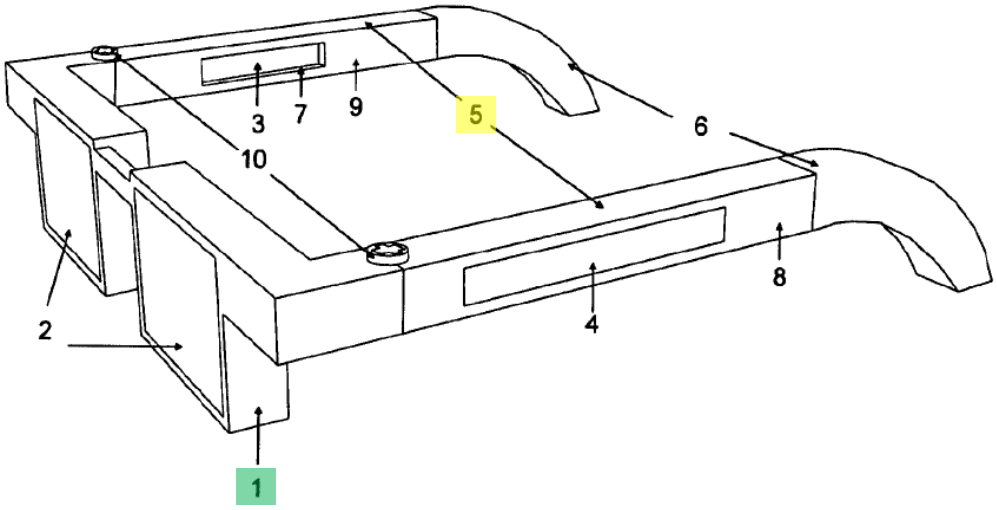
B. Claim 11

1. Preamble

Chen discloses eyewear, including in its title "EYEWEAR TEMPLE ASSEMBLY." Ex.1010, Title, Abstract, Figs. 1, 4; Ex.1003, ¶228.

2. Limitation 11[a]

Chen discloses a frame 1 (green) having temples 5 (yellow), as shown in Figure 1. Ex.1010, 5:25-27, 2:54-55, 8:5-7.

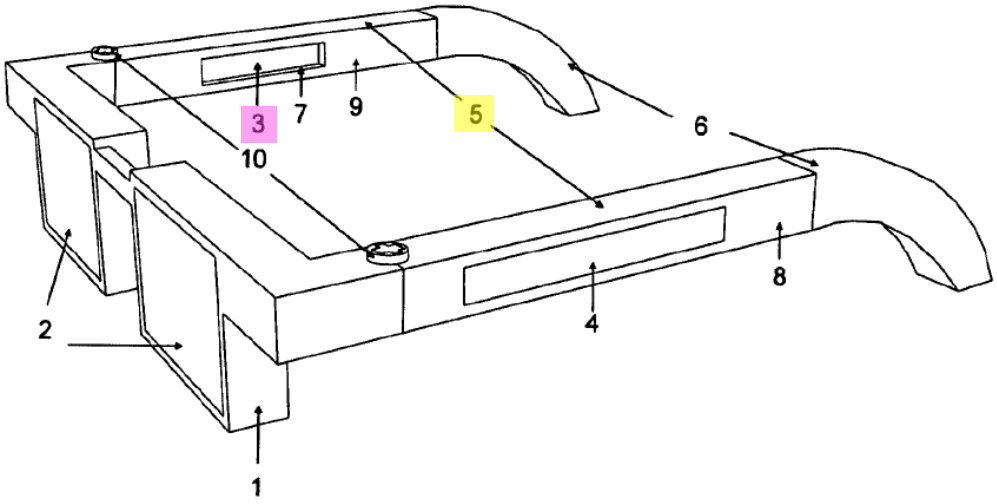


Id., Fig.1 (annotated); Ex.1003, ¶229; *see also* Ex.1010, Fig.4. Chen thus discloses what the '960 patent describes as an "eyewear frame." Ex.1003, ¶229; Ex.1001, 8:17-24.

3. Limitation 11[b]

Chen discloses its "temple assembly invention is comprised of a temple, removable cartridge, cartridge compartment that can accommodate and conceal one or multiple said cartridge(s), and temple tip." Ex.1010, 2:55-59. "The removable cartridge comprises of materials and components, including electronic or non-electronic or any combination thereof…." *Id*., 2:60-63. This design "allows the addition of diverse functions to eyewear through the installment of cartridge(s) comprised of different, unique capabilities." *Id*., 4:22-24. The cartridge is an application module, and Chen thus discloses an "application module." Ex.1003, ¶230; Ex.1001, 21:59-62, 9:32-43.

According to Chen, its "cartridge compartment can be within the temple, within the temple tip, or be comprised of sub-compartments within the temple and temple tip." Ex.1010, 2:63-65. Figure 1 shows a cartridge 3 (pink) is positioned within the temple 5 (yellow).



Id., Fig.1 (annotated); Ex.1003, ¶231; *see also* Ex.1010, Fig.4. Chen's eyewear has "coupled" components according to the broad usage of the term in the '960 patent. Ex.1003, ¶231; Ex.1001, 7:47-65.

Thus, Chen discloses an application module mechanically coupled to the eyewear frame. Ex.1003, ¶¶230-232.

4. Limitation 11[c]

Chen discloses eyewear that "… provide music playing and cell phone capabilities …" and "… functionalities that go beyond the obvious features." Ex.1010, 1:28-31. Chen references disclosure in U.S. Pat. No. 6,929,365 (Ex.1015) about embedding a Bluetooth component in an eyewear's temple. Ex.1010, 1:63-

22. Such a Bluetooth component includes a wireless chip to wirelessly communicate via the Bluetooth® standard with another wireless enabled device. Ex.1003, ¶233; *see e.g.*, Ex.1015, 4:19-37.

To the extent PO argues that Chen does not expressly disclose a cartridge having a wireless chip, a POSITA would have been motivated to incorporate a wireless chip in a cartridge in view of Chen's highlighting of the Bluetooth component and cell phone capabilities and Chen's recommendation to "incorporate detachable parts and concealable compartments, which can store or hold additional functional components." Ex.1010, 1:32-34; Ex.1003, ¶234. Chen encourages such incorporating by contrasting prior designs which "if any electronic component malfunctions, then the user will have to replace a significant portion of the eyewear, such as a whole temple, rather than the individual defective component." *Id*., 2:2-5. A POSITA would have reasonably expected success in such incorporating given Chen's disclosure that "[t]he removable cartridge comprises of materials and components, including electronic or non-electronic or any combination thereof." *Id*., 2:60-63; Ex.1003, ¶234. Thus, Chen suggests that the application module includes a wireless chip to communicate with a wireless enabled device. Ex.1003, ¶234.

To the extent PO argues that Chen does not suggest a cartridge includes a wireless chip, Rosenblatt suggests incorporating a wireless chip in a device like Chen's cartridge. Ex.1007, [0007], [0058]; Ex.1003, ¶235. For example, Rosenblatt

discloses a system that includes a key (application module) with a wireless chip for remotely causing a host device (wireless enabled device) to perform an operation, as discussed for limitation 11[c] in Ground 4. *Supra* §X.B.4. A POSITA would have been motivated to incorporate Rosenblatt's key with its wireless chip or a wireless chip like Rosenblatt's in one of Chen's cartridges and reasonably expected success in doing so for the reasons discussed above. *Supra* §XIII.A.

Thus, Chen and Rosenblatt render obvious that the application module includes a wireless chip to communicate with a wireless enabled device. Ex.1003, ¶¶233-236.

5. Limitation 11[d]

Rosenblatt discloses this limitation as discussed for limitation 11[d] in Ground 4. *Supra* §X.B.5. A POSITA would have been motivated to incorporate Rosenblatt's key or its components or functionality in one of Chen's cartridges and reasonably expected success in doing so as discussed above. *Supra* §XIII.A.

Thus, claim 11 is obvious. Ex.1003, ¶¶228-238.

C. Claims 12-18

Rosenblatt discloses the dependent claim limitations of claims 12-18 as discussed for claims 12-18 in Ground 4. *Supra* §§X.C-I. Thus, these claims are obvious. Ex.1003, ¶239.

D. Claim 20

Chen discloses, or at least suggests, that the wireless chip is a Bluetooth chip, as discussed for limitation 11[c] in this ground. *Supra* §XIII.B.4.

Rosenblatt discloses "[t]he key may use any suitable communications protocol to create the personal area network including, for example, … Bluetooth … and other relatively localized wireless communication protocols." Ex.1007, [0006]; *see also id*., [0029], [0034], Title, Claim 3.

Accordingly, claim 20 is obvious. Ex.1003, ¶¶240-242.

E. Claim 21

Rosenblatt discloses the dependent claim limitations of claim 21 as discussed for claim 21 in Ground 4. *Supra* §X.K. Accordingly, this claim is obvious. Ex.1003, ¶243.

F. Claim 22

1. Preamble and Limitations 22[a]-22[b]

Chen discloses the preamble and limitations 22[a]-22[b] for the reasons discussed for the preamble of claim 11 and limitations 11[a]-11[b] in this ground. *Supra* §§XIII.B.1-3.

2. Limitation 22[c]

Chen and Rosenblatt render obvious that the application module includes a wireless chip, as discussed for limitation 11[c] in this ground. Ex.1003, ¶245; *supra* §XIII.B.4.

Chen and Rosenblatt also disclose, or at least suggest, the application module comprising a transmitter.

Chen discloses embedding a Bluetooth component in an eyewear's temple. Ex.1010, 1:63-22. Such a Bluetooth component includes a transmitter for enabling wireless communication by the Bluetooth component. Ex.1014, 3; Ex.1003, ¶247.

To the extent PO argues that Chen does not expressly disclose one of its cartridges includes a transmitter, a POSITA would have been motivated to incorporate Chen's disclosed Bluetooth component in a cartridge as discussed for limitation 11[c] in this ground. *Supra* §XIII.B.4. The Bluetooth component includes a transmitter as discussed in the preceding paragraph.

To the extent PO argues that Chen does not suggest a cartridge having a transmitter, Rosenblatt suggests incorporating a transmitter in a device like Chen's cartridge. Ex.1007, [0007], [0058]; Ex.1003, ¶249. For example, Rosenblatt discloses that "[t]he key may include a communications circuitry for transmitting data." Ex.1007, Abstract; *see also id*., [0037]. Such communications circuitry includes a transmitter for facilitating the data transmission. Ex.1014, 3; Ex.1003,

¶249. For the reasons discussed above, a POSITA would have been motivated to incorporate Rosenblatt's key with its transmitter or a transmitter like Rosenblatt's in one of Chen's cartridges and reasonably expected success in doing so. *Supra* §XIII.A.

Thus, Chen and Rosenblatt render obvious that the application module includes a transmitter and a wireless chip. Ex.1003, ¶¶245-250.

3. Limitation 22[d]

Rosenblatt discloses this limitation as discussed for limitation 22[d] in Ground 4. *Supra* §X.L.5. A POSITA would have been motivated to incorporate Rosenblatt's key or its components or functionality in one of Chen's cartridges and reasonably expected success in doing so as discussed above. *Supra* §XIII.A.

Accordingly, claim 22 is obvious. Ex.1003, ¶¶244-252.

G. Claims 23-24 and 26

Rosenblatt discloses the dependent claim limitations of claims 23-24 and 26 as discussed for claims 23-24 and 26 in Ground 4. *Supra* §§X.M-O. Accordingly, these claims are obvious. Ex.1003, ¶253.

XIV. GROUND 8: CLAIM 19 IS OBVIOUS OVER CHEN, ROSENBLATT, AND GUNARATNE

This ground addresses claim 19, which claims controlling an automobile's functionality. Gunaratne discloses such controlling as discussed in Ground 5. *Supra* §XI.

A POSITA would have been motivated to add Gunaratne's drowsiness alert functionality to the automobile in the combination of Chen and Rosenblatt because, as discussed in Ground 5, Gunaratne suggests doing so and the combination represents the use of a known technique to improve a known device and method that is ready for improvement and yields predictable results. Incorporating the functionality would have been trivial. Ex.1003, ¶255; *supra* §XI.

Thus, claim 19 is obvious. Ex.1003, ¶¶254-256.

XV. GROUND 9: CLAIM 25 IS OBVIOUS OVER CHEN, ROSENBLATT, AND NIELSEN

This ground addresses claim 25, which claims adjusting a font size. Nielsen discloses such adjusting as discussed in Ground 6. *Supra* §XII.

A POSITA would have been motivated to add Nielsen's adaptive font functionality to the computer in the combination of Chen and Rosenblatt because, as discussed in Ground 6, Nielsen suggests doing so and the combination represents the use of a known technique to improve a known device and method that is ready for improvement and yields predictable results. Ex.1003, ¶258; *supra* §XII. Incorporating the functionality would have been trivial. Ex.1003, ¶258.

Thus, claim 25 is obvious. *Id*., ¶¶257-258.

XVI. SECONDARY CONSIDERATIONS

Secondary considerations should be considered but do not control the obviousness conclusion. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed.

Cir. 1988). Where, as here, a strong *prima facie* obviousness showing exists, even relevant secondary considerations supported by substantial evidence may not dislodge the obviousness conclusion. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). Petitioner is aware of no evidence supporting a claim for secondary considerations. Ex.1003, ¶¶259-260.

XVII. DISCRETIONARY DENIAL UNDER §314(A) IS NOT APPROPRIATE

Considering the factors under *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board should decline to exercise its discretion under §314(a).

A. Factor 1: Potential Stay

Petitioner will move to stay the Litigation pending resolution of this IPR. In the Litigation, discovery is in the very early stages, with the parties serving initial sets of discovery requests on June 4, 2024. Claim construction, depositions, expert reports, and summary-judgment motions have not begun. The Central District of California recognizes a "liberal policy" favoring stays pending PTO proceedings. *RJ Tech. LLC v. Apple Inc.*, No. 8:22-cv-01874, 2023 WL 8188475, at *1 (C.D. Cal. Oct. 4, 2023). Courts in that district stay litigation pending IPR where, as here, "there is more work ahead of the parties and the Court than behind"; the stay "will simplify the issues in question and the trial of the case"; and there is no undue prejudice. *Polaris PowerLED Techs., LLC v. LG Elecs., Inc.*, No. SACV-20-00125,

2020 WL 6064964, at *2-3 (C.D. Cal. Aug. 26, 2020). Courts routinely grant pre-institution stays. *E.g.*, *RJ Tech.*, 2023 WL 8188475, at *3; *DataQuill Ltd. v. TCL Commc'n Tech. Holdings Ltd.*, No. 2:19-cv-03394, 2020 WL 3884436, at *1-3 (C.D. Cal. Apr. 24, 2020). Accordingly, this factor favors institution.

B. Factor 2: Proximity of Trial to FWD

The Litigation's trial is currently scheduled for July 21, 2025. A final written decision in this proceeding would be expected within five months of that date—in December 2025. Furthermore, the Litigation is in its early stages, and, as statistics discussed below suggest, the court may well postpone trial, due to a stay or otherwise. The Director's June 2022 memorandum counsels against relying on scheduled trial dates. Memo[1] at 8.

In 2023, over 17,000 new cases were filed in the Central District, resulting in 622 new cases per authorized judgeship, *not accounting for vacancies*. Ex. 1023. In 2023, the median time to trial for civil cases in the Central District was 29.7 months from filing. *Id.* Applying that median time to the Litigation, which was filed at the end of October 2023, would put trial in April 2026—four months *after* the expected final written decision in this case. Accordingly, this factor favors institution or is at worst neutral. *Fusion Orthopedics, LLC v. Extremity Med., LLC*,

[1] https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

IPR2023-00894, Paper 15 at 30 (PTAB Nov. 17, 2023); *Samsung Elecs. Co. v. DoDots Licensing Sols. LLC*, IPR2023-00621, Paper 9 at 11 (PTAB Oct. 11, 2023).

C. Factor 3: Investment in Parallel Proceeding

On June 13, 2024, the Court granted Petitioner's motion to dismiss claims from PO's amended complaint. The parties have invested very little in the Litigation. Fact discovery remains in its infancy. *Supra* §XVII.A. The parties have not proposed claim constructions or submitted claim construction briefs. No expert reports have been served. Accordingly, the "remaining investment" outweighs any investments made and this factor weighs against discretionary denial. *Samsung Elecs. Am. Inc. v. Snik LLC*, IPR2020-01428, Paper 10 at 11 (PTAB Mar. 9, 2021); *Huawei Techs. Co. v. WSOU Invs., LLC*, IPR2021-00226, Paper 10 at 13-14 (PTAB June 10, 2021).

D. Factor 4: Overlapping Issues

Petitioner hereby stipulates that, if the Board institutes review, Petitioner will not pursue in the Litigation invalidity of the '960 patent based on any ground Petitioner raised or reasonably could have raised in this Petition. This stipulation resolves *Fintiv* factor 4 strongly in favor of institution. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (Dec. 1, 2020) (precedential as to §II.A). The Director's June 2022 memorandum states that, when a petitioner so

stipulates, "the PTAB will not discretionarily deny institution" due to parallel litigation. Memo, *supra* n.1, at 7.

E. Factor 5: The Parties

The parties are the same, but due to the likelihood of a stay, the Litigation is unlikely to go to trial before a final written decision. This factor is neutral. *Google LLC v. Jawbone Innovations, LLC*, IPR2022-00630, Paper 10 at 14 (PTAB Sept. 13, 2022) (note: Paper 10 is captioned with Samsung as petitioner).

F. Factor 6: Other Circumstances

Although the Examiner considered two patents from which Jannard-740 is a continuation-in-part, the prior art that the forms the grounds in this Petition have not been considered by the PTO, any court, or any jury. The Petition's merits are particularly strong, which favors institution. *Fintiv*, IPR2020-00019, Paper 11 at 18. Moreover, denying institution would negate Congress's intent in providing a 1-year period to file petitions and would encourage forum shopping as patent owners look to shield their patents from PTAB scrutiny by seeking judges with aggressive trial schedules.

Accordingly, the *Fintiv* analysis favors institution.

XVIII. DISCRETIONARY DENIAL UNDER §325(D) IS NOT APPROPRIATE

The Office has not previously substantively addressed "the same or substantially the same prior art or arguments." 35 U.S.C. §325(d). Here, the PTO has never evaluated the '960 patent against the prior art asserted.

Advanced Bionics Prong 1; Becton, Dickinson Factors (a), (b), and (d). None of the prior art asserted was before the PTO examiner. The examiner issued no rejections during prosecution. Applicant merely disclosed two patents from which Jannard-740 claims priority as a continuation-in-part, but the PTO examiner never relied on those patents or discussed them. "As clarified in the Notice of Proposed Rule Making," the Board has explained, "mere prior citation of prior art in an IDS will not automatically satisfy the first prong of the analytical framework set forth in *Advanced Bionics*." *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)).

The first prong of *Advanced Bionics* is therefore unmet, and the Board "need not address the second part." *JUUL*, Paper 10 at 13; *Quasar Sci. LLC v. Colt Int'l Clothing, Inc.*, IPR2023-00611, Paper 10 at 12 (PTAB Oct. 10, 2023).

Advanced Bionics Prong 2; Becton, Dickinson Factors (c), (e), and (f). The examiner did not consider the prior art asserted. Nor did the examiner have the benefit of this Petition mapping the prior art to PO's claims and Dr. Feland's accompanying expert declaration explaining the POSITA's understanding of the

prior art. Where, as here, references were "not extensively evaluated during examination and [were] not the basis for a rejection," and Petitioner "present[s] a sufficient showing that the Examiner overlooked disclosures" that invalidate the claims, "the Office erred in a manner material" to patentability. *Apple Inc. v. Telefonaktiebolaget LM Ericsson*, IPR2022-00457, Paper 7 at 8 (PTAB Sept. 21, 2022). This Petition presents compelling challenges to patentability.

Thus, the Board should not deny institution under §325(d).

XIX. MANDATORY NOTICES, GROUNDS FOR STANDING, AND FEE PAYMENT

A. Real Parties-In-Interest (37 C.F.R. §42.8(b)(1))

Luxottica of America Inc. and Luxottica Group S.p.A. are the real parties in interest for Petitioner. The parent company of each party identified above is EssilorLuxottica S.A.

B. Related Matters (37 C.F.R. §42.8(b)(2))

The parties are currently engaged in district court litigation in *e-Vision Optics, LLC et al. v. Luxottica Group S.p.A. et al.*, No. 8:23-cv-02013 (C.D. Cal.). The '960 patent is asserted in the Litigation.

Patent Owner also asserted the '960 patent in the following case:

e-Vision, LLC et al. v. Lenovo Group Ltd. et al., No. 8:23-cv-01860 (C.D. Cal.).

C. Lead and Backup Counsel (37 C.F.R. §42.8(b)(3))

Petitioner provides the following designation of counsel, all of whom are included in Customer No. 20,995 identified in Petitioner's Power of Attorney.

Lead Counsel	Back-up Counsel
Ali S. Razai (Reg. No. 60,771) 2AZR@knobbe.com Knobbe, Martens, Olson, & Bear, LLP Postal and Hand-Delivery Address: 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: 949-760-0404 Facsimile: 949-760-9502	Joseph F. Jennings (Reg. No. 40,664) 2JFJ@knobbe.com Vladislav Teplitskiy (Reg. No. 68,069) 2VXT@knobbe.com Jacob L. Peterson (Reg. No. 65,096) 2JUP@knobbe.com Knobbe, Martens, Olson, & Bear, LLP Postal and Hand-Delivery Address: 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: 949-760-0404 Facsimile: 949-760-9502

D. Service Information (37 C.F.R. §42.8(b)(4))

Please direct all correspondence to lead counsel and back-up counsel at the addresses shown above. Petitioner also consents to electronic service by email to luxotticaIPR-960@knobbe.com.

E. Standing

The '960 patent is available for IPR, and no bar or estoppel applies. PO filed the Litigation in October 2023 and served the complaint subsequently.

The Office may charge any fees due to Deposit Account 11-1410.

XX. CONCLUSION

Petitioner respectfully requests that the Board institute IPR and cancel all claims of the '960 patent.

Dated: June 20, 2024

By: /Ali S. Razai/
Ali S. Razai (Reg. No. 60,771)
KNOBBE, MARTENS, OLSON & BEAR, LLP

Attorney for Petitioner Luxottica of America Inc.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that this PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,598,960 contains 13,948 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000-word type-volume limit specified by 37 C.F.R. §42.24(a)(1).

Dated: June 20, 2024 By: /Ali S. Razai /
Ali S. Razai (Reg. No. 60,771)
KNOBBE, MARTENS, OLSON & BEAR, LLP

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below copies of this PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,598,960, PETITIONER'S POWER OF ATTORNEY, and EXHIBITS 1001-1023 are being served by FedEx on the Patent Owner at the correspondence address of record for the subject patent as follows:

Smith Baluch LLP
376 Boylston St. Suite 401
Boston, MA 02116

A courtesy copy is being sent by email on this day to Patent Owner's counsel of record in the Litigation as follows:

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Dated: June 21, 2024 By: /Ali S. Razai/
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KNOBBE, MARTENS, OLSON & BEAR, LLP