

Filed: December 4, 2024

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

By: Ali S. Razai (Reg. No. 60,771)
Joseph F. Jennings (Reg. No. 40,664)
Vladislav Teplitskiy (Reg. No. 68,069)
Jacob L. Peterson (Reg. No. 65,096)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
Email: luxotticaIPR-960@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUXOTTICA OF AMERICA INC.,
Petitioner,

v.

E-VISION SMART OPTICS, LLC,
Patent Owner.

Case No. IPR2024-01072
Patent 10,598,960

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

Patent Owner asks for discretionary denial under *Fintiv*. The Board should not deny on this basis and should instead institute review.

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

Petitioner has provided a *Sotera* stipulation. Petition 77. The Director’s June 2022 Memorandum (“Director’s Memo”) is “binding agency guidance” that prohibits a *Fintiv* denial where the petitioner submits a *Sotera* stipulation. Memo at 3, *available at* <https://tinyurl.com/usptoDirMemo>; *see also* *Hilti AG v. Specified Techs. Inc.*, IPR2024-00193, Paper 17 at 10 (PTAB May 14, 2024) (“The [Director’s Memo] binds this panel.”). The Director’s Memo unambiguously states three times that the Board “will not” discretionarily deny institution due to parallel litigation when the petitioner files a *Sotera* stipulation. Memo at 3, 7, 9. “Because Petitioner has provided a *Sotera* stipulation, the Director Memo is controlling and the *Fintiv* factors are not a basis for denying institution.” *Meta Platforms, Inc. v. Immersion Corp.*, IPR2023-00946, Paper 13 at 16 (PTAB Dec. 8, 2023).

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

deadlines for expert reports and will not reset them until after it construes the claims. Ex. 1024. Moreover, the Director’s Memo acknowledges that considering the parties’ investment in parallel litigation is part of *Fintiv* factor 3, yet the Memo makes no exception to its rule that a *Sotera* stipulation precludes a *Fintiv* denial.

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

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

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

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

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

Dated: December 4, 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 a copy of
PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE
is being served by email on Patent Owner as follows:

Brian Eutermoser (Reg. No. 64,058)
Email: beutermoser@kslaw.com
Mikaela Stone (Reg. No. 70,404)
Email: mikaela.stone@kslaw.com
KING & SPALDING LLP
1401 Lawrence Street, Suite 1900
Denver, CO 80202

Christopher C. Campbell (Reg. No. 37,291)
ccampbell@kslaw.com
KING & SPALDING LLP
1700 Pennsylvania Avenue, NW
Suite 200
Washington, DC 20006-4707

Dated: December 4, 2024

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