

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 No. IPR2024-01072

Patent No. 10,598,960

CORRECTED PATENT OWNER'S RESPONSE TO PETITION

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KSR v Teleflex,
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Metalcraft of Mayville, Inc. v. The Toro Co.,
848 F.3d 1358 (Fed. Cir. 2017).....

Statutes:

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EXHIBIT LIST

Exhibit	Description
EX-2001	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Denying Defendants' Motion to Stay, Dkt. 75 (Aug. 21, 2024 C.D. Cal.)
EX-2002	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Re Civil Jury/Court Trial, Dkt. 54 (April 4, 2024 C.D. Cal.)
EX-2003	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Order Scheduling Additional Dates and Correcting Scheduling Order, Dkt. 58 (April 18, 2024 C.D. Cal.)
EX-2004	<i>Ltd., et al.</i> , Case No. 8:23-cv-01860 AB (SHK) Defendants' Preliminary Invalidity Contentions (July 19, 2024 C.D. Cal.) (excerpted)
EX-2005	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) Defendants' Invalidity Contentions (July 12, 2024 C.D. Cal.)
EX-2006	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, Order re Civil Jury/Court Trial, Dkt. 54 (April 3, 2024 C.D. Cal.)
EX-2007	Lex Machina – Federal Court – Federal District Court Cases in C.D. Cal, Pending Between 2019-09-01 and 2024-09-19
EX-2008	Vacancies in the Federal Judiciary 118th Congress, last updated on 9/23/2024, https://www.uscourts.gov/judges-judgeships/judicial-vacancies/current-judicial-vacancies
EX-2009	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, Order Granting Joint Stipulation to Schedule Additional Dates, Dkt. 56 (April 18, 2024 C.D. Cal.)
EX-2010	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK) (IN CHAMBERS) Order Continuing Claim Construction Hearing, Dkt. 97 (Oct. 7, 2024 C.D. Cal.)

Corrected Patent Owner's Response to
Petition for Inter Partes Review
Patent No. 10,598,960

Exhibit	Description
EX-2011	<i>eVision Optics, LLC and e-Vision Smart Optics, Inc. v. Lenovo Group, Ltd. et al.</i> , Case No. 8:23-cv-01860-AB-SHK, (IN CHAMBERS) Order Continuing Claim Construction Hearing, Dkt. 74 (Oct. 7, 2024 C.D. Cal.)
EX-2012	<i>E-Vision Optics LLC v. Lenovo</i> , 8:23-cv-01860, Dkt. 78, Order Granting Joint Stipulation to Modify Order re: Civil Jury/Court Trial (Dkt. No. 54) and Order Granting Joint Stipulation to Schedule Additional Dates (Dkt. No. 56)
EX-2013	<i>eVision Optics, LLC and Vision Smart Optics, Inc. v. Luxottica Group S.P.A. and Luxottica of America Inc.</i> , Case No. 8:23-cv-02013 AB (SHK), Luxottica's Opening Claim-Construction Brief
EX-2014	Expert Declaration of James Oliver, Ph.D.
EX-2015	James Oliver Curriculum Vitae
EX-2016	https://www.ti.com/design-resources/design-tools-simulation/models-simulators/pcb-thermal-calculator.html
EX-2017	A Figure of Merit for Smart Phone Thermal Management
EX-2018	https://www.gsmarena.com/samsung_i9300_galaxy_s_iii-4238.php
EX-2019	https://www.gsmarena.com/apple_iphone_4-3275.php
EX-2020	https://gizmodo.com/the-most-important-laptops-of-2012-5967988
EX-2021	https://dl.dell.com/manuals/all-products/esuprt_laptop/esuprt_xps_laptop/xps-12-1221x_reference%20guide_en-us.pdf
EX-2022	https://opticstown.com/what-is-a-good-weight-for-glasses/
EX-2023	Khalil, Elias, "Application of Phase Change Materials in Textiles: A Review"
EX-2024	https://spinoфф.nasa.gov/spinoфф1997/ch6.html
EX-2025	Walsh, Glyn, "The weight of spectacle frames and the area of their nose pads"

E-Vision Smart Optics, Inc. (“Patent Owner”) submits this Patent Owner’s Response to the petition of Luxottica of America Inc. (“Petitioner”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 10,598,960 (“the ’960 Patent”).

I. INTRODUCTION

Claims 11-26 of the ’960 Patent are directed to eyewear comprising innovative embedded electronics application modules that enable the eyewear to perform various functions by wirelessly communicating with external devices. The Board should reject Petitioner’s challenges to those claims and instead find them patentable.

First, Petitioner’s proffered prior art combinations disregard constraints (e.g., size, weight, power, and heat dissipation) that a person of ordinary skill in the art (“POSITA”) would have considered when designing eyewear-embedded electronics. Rosenblatt’s disclosure of wireless communications between a “key” and a host device—on which all of Petitioner’s grounds 4-9 challenging claims 11-26 rely—is irrelevant because the “key” would be embodied in a computer too large, heavy, and power-hungry for eyewear. And neither Rosenblatt nor any other art cited by Petitioner provides any teachings on how to alter the “keys” in Rosenblatt’s wireless communications techniques to make them suitable for embedding in eyewear. As a result, a POSITA would not have been motivated to combine

Rosenblatt's teachings with those of prior art directed to eyewear, because a POSITA would not have had a reasonable expectation of success.

Second, Petitioner's addition of tertiary references Gunaratne and Nielsen to challenge claims 19 and 25, respectively, compounds a POSITA's lack of motivation to combine and expectation of success, because the additional references lack any teaching regarding their interaction with eyewear or the wireless communication techniques of Rosenblatt. Gunaratne relates to analysis of facial recognition data to detect drowsiness, but requires capturing images of the user (such as with a camera), managing a large database of images of drowsy faces, and running a matching algorithm to evaluate whether the captured images are similar to the drowsy faces, all of which lack any relation to eyewear or any teaching or suggestion of how to interface them with Rosenblatt's wireless communications techniques. Nielsen is directed to adjusting a webpage's font size based on user preferences stored in a database, and has no relation to eyewear or to Rosenblatt's wireless communication techniques. A POSITA would not have been motivated to implement these teachings within eyewear or in the context of wireless communication techniques such as those of Rosenblatt, nor would a POSITA have had any reasonable chance of success in doing so.

II. The '960 Patent

A. Inadequacy of the Prior Art

Before the '960 Patent, “commercial eyewear comprising electronics [were] limited to one application in addition to the conventional eyeglass lenses housed within said eyewear.” (EX-1001, 1:24-26.) The electronics placed within eyewear would focus on a single function, such as “commercially available electronic focusing eyeglasses, commercially available eyeglasses with a built in MP3 player, [or] commercially available eyeglasses with video for occupation purposes.” (*Id.*, 1:26-32.) At the time of the invention, eyeglasses with a built-in camera were “expected” to be commercially available “soon.” (*Id.*) Although eyewear featuring such single-application electronic devices became more diversified, it failed to enable the user to enjoy a plurality of electronic functions without discomfort or inelegance. Thus, at the time of the inventions claimed in the '960 Patent, there was “a need for a single pair of fashionable eyewear capable of [...] utilizing one or more of a multitude of different application devices while the wearer is wearing the eyewear. (*Id.*, 1:59-62.)

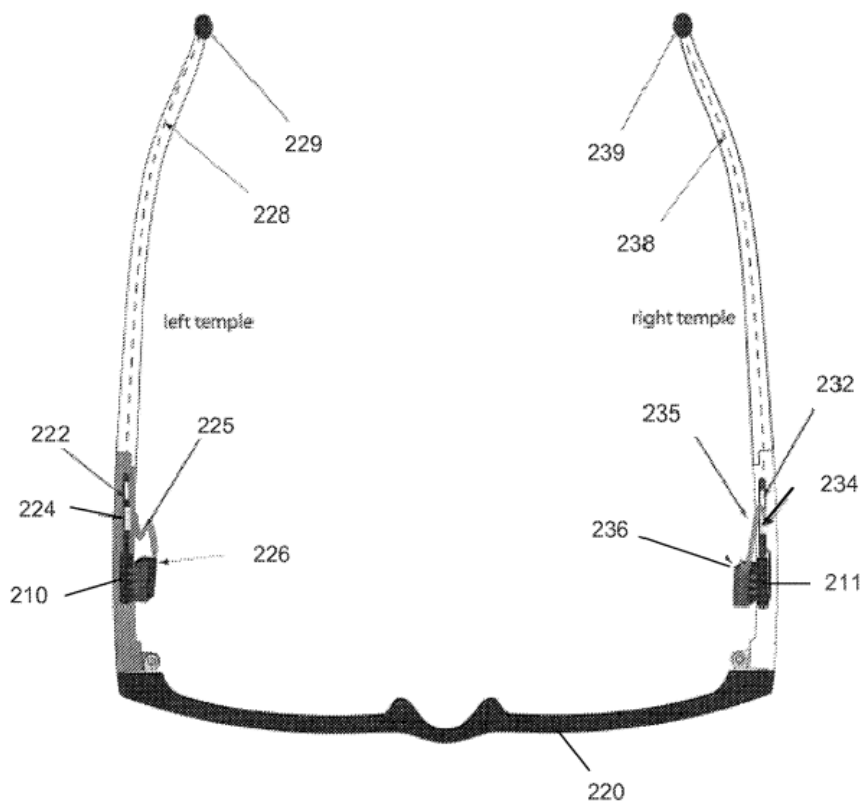
B. Innovations of the '960 Patent

The '960 Patent provides innovative electronic modules and docking stations for eyewear. For example, the patent claims eyewear featuring “application

modules” that “can each fit together with the docking station and may be utilized one or more at a time while the eyewear is being worn by a wearer.” (*Id.*, 1:5-7.) This modularity of the embedded electronics brings significant new benefits for the design of electronically enhanced eyewear: for instance, an “application module may include one or more of an electronic device configured to perform a function; an attachment mechanism configured to secure the application module to the docking station in a substantially fixed position; and/or a plurality of preconfigured application connection points.” (EX-1001, 2:21-26.) An application module can thereby package discrete, individual functions of the eyewear such as “audio playback, audio recording, acoustic amplification, acoustic canceling, hearing aid, video playback, video recording, photography, fall detection, alertness monitoring, pedometer, geo-location, pulse detector, wireless communication, virtual reality, augmented reality, gaming, eye tracking, pupil monitoring, lens control, automated reminder, lighting, lasing, and alarm.” (*Id.*, 3:54-60.)

Two or more application modules can be joined to enhance eyewear with several functions. (*Id.*, 4:47-50.) The use of multiple application modules in the eyewear may, for instance, enable some application modules to handle user commands and provide controls while others provide other functions, such as augmented reality, gaming, or sending sound to external audio systems. (*Id.*, 13:9-

37.) The use of application modules, such as exemplary embodiments 226 and 236 in each temple of the eyewear shown in Figure 3, below, allows such advanced functions while keeping the eyewear both fashionable and comfortable due to the application modules' weight distribution. (*Id.*, 2:12-18.)



C. Claim Construction

Petitioner takes conflicting claim construction positions in two proceedings. Here, Petitioner contends the Board need not construe any claim terms. (Petition, 11.) But in co-pending district court litigation Petitioner has proposed construing the

claim term “application module.” (EX-2013, 9-12.) Notwithstanding Petitioner’s inconsistent positions, however, for purposes of the IPR, Patent Owner agrees that no terms require construction and construes all terms consistent with their plain and ordinary meaning.

D. Level of Ordinary Skill in the Art

A person of ordinary skill in the art would have a bachelor’s degree in mechanical engineering, electrical engineering, computer engineering, or equivalent degree and, in addition, approximately two years of work experience with embedded electronic devices (EX-2014, ¶28.) More advanced degrees or training in a related discipline or both can compensate for shorter work experience. (EX-2014, ¶¶27-31.) Patent Owner’s expert, Dr. James Oliver, is qualified to offer opinions under this standard. (*Id.*)

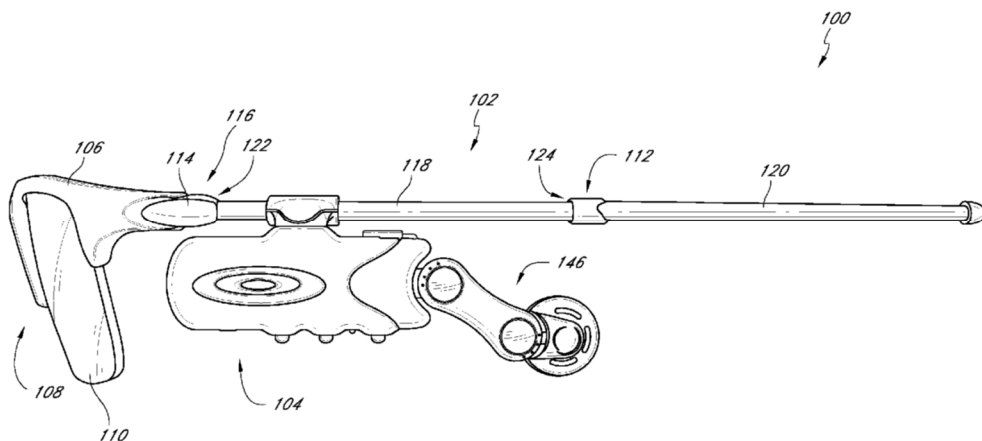
III. Prior Art Overview

A. Jannard-740

Jannard-740 is “directed to wearable audio devices, and in particular, devices that humans can wear on their heads and that include electronics such as, for example, speakers, microphones, processors, transmitters, receivers, video display technology, and/or interface electronics for interacting with a wireless network and/or providing content to a user.” (EX-1005, [0003].) Jannard-740 acknowledges

that head-mounted devices may comprise electronics that “can be used for portable entertainment, personal communications, and the like” and “in conjunction with” distinctly larger electronics devices such as “cellular telephones, cordless telephones, radios, tape players, MP3 players, portable video systems, hand-held computers and laptop computers.” (*Id.*, [0005].)

Jannard-740 discloses “a dual speaker eyewear system” with an “electronics module [that] is supported by the eyeglass and in electrical communication with each of the first and second speakers” dedicated to the eyewear’s audio speaker functionality, which “may include an MP3 format memory, a radio frequency receiver, a radio frequency transmitter, a cellular telephone, Video display technology, or other electronic devices.” (*Id.*, [0010]-[0011].)



(EX-21005, FIG. 1.)

B. Chen

Chen is directed to “an eyewear temple assembly that provides the flexibility to add thermal regulation to eyewear in an integrated and concealed manner.” (EX-1010, Abstract.) Chen states that “the present invention relates to prior works of art that provide thermal regulation of the head.” (*Id.*, 1:20-22.) According to Chen, the function of its invention addresses the needs of:

“eyewear users, like athletes or construction workers, [who] live and work in harsh thermal conditions, such as summers and winters in the Southwest. For example, heat exhaustion, which includes important symptoms such as dizziness, nausea, and headaches, often occurs above an internal body temperature of 40° C. (104°F.) [...] consequently, regulating head temperature is important. An elegant solution would be to have protective eyewear with additional thermal regulation capabilities.”

(*Id.*, 2:16-30.)

To do so, Chen discloses the use of removable heating or cooling cartridges that can be placed in eyewear temples to deliver the desired thermal regulation (“[s]pecifically, the invention being presented is an eyewear temple assembly comprised of exchangeable cartridges, which can provide thermal regulation of a

user's head"). (*Id.*, 2:49-52.) An example cartridge 4 and its compartment 7 is shown in Figure 1, below:

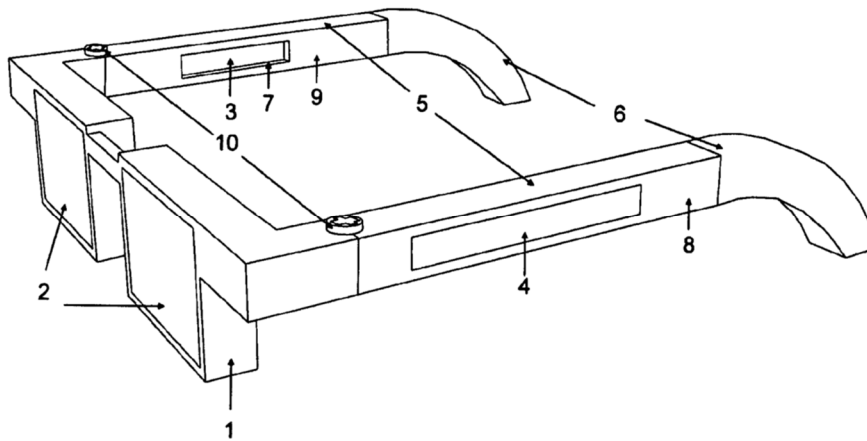


FIG. 1

(EX_1010, FIG. 1.)

C. Rosenblatt

Rosenblatt is “directed to a system for remotely directing a host device to perform an operation using a key.” (EX-1007, Abstract.) For instance, it describes host devices as including, on the one hand, “light or light Switch, curtains or shades, an elevator, a conveyer belt, a motorized device, or any other device or system that may be moved from at least a first to a second position or state.” (*Id.*, [0033].) On the other hand, host devices can be embodied in personal computers to allow a user to “access personalized settings or information.” (*Id.*, [0032] (“host device 120 or other device 130 may include a computer, a workstation, a cellular telephone, a

mobile communications device, a personal media device, a set-top box, a television system, or any other suitable electronic device”).)

Contrary to Petitioner's depiction, Rosenblatt's "keys" are not all the same—they differ in their abilities, their size, and the complexity of their electronics circuits. In smaller, less complex embodiments, Rosenblatt discloses incorporating keys into devices such as a credit card, a surgical implant, a garment clip, a "coin-sized object," or car keys. (*Id.*, [0007], [0043].) Other embodiments, however, require the "key" to be a cell phone or a laptop computer: "In some embodiments, 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].) Figure 5, for example, depicts Rosenblatt's host device as computer 560 for which "a key may be integrated in any of key fob 520, object with clip 530 (e.g., a clip configured to be attached to an article of clothing or accessory), mobile telephone 540, and personal media device 550 using any suitable approach." (*Id.*, [0059].)

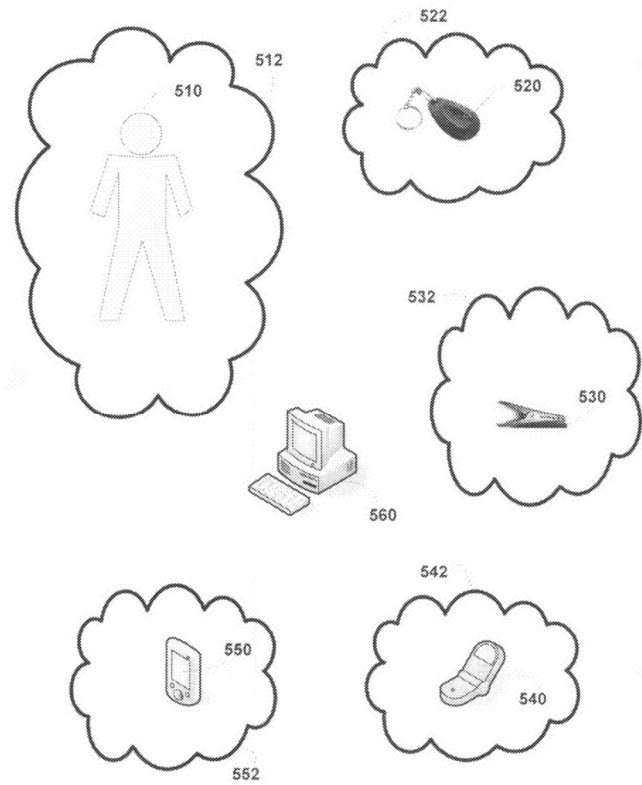


FIG. 5

(EX-1007, FIG. 5.)

Rosenblatt distinguishes keys embodied in computers and cell phones by calling out their advanced computing and networking capabilities. For instance, Rosenblatt discloses that in some embodiments, “key 200 may include a power supply, a user interface and a display. Key 200 may also include a processor distinct from communications circuitry 202.” (*Id.*, [0041].) Additionally, the key may comprise “memory [which] may be configured to store data by communication circuitry” within the key. (*Id.*, [0037].) Key memory may serve to “host a database of the host devices to which key 200 was paired” and “store instructions that key

200 can transmit to cause each host device to perform one or more operations.” (*Id.*, [0038]; *see also, id.*, FIG. 2.)

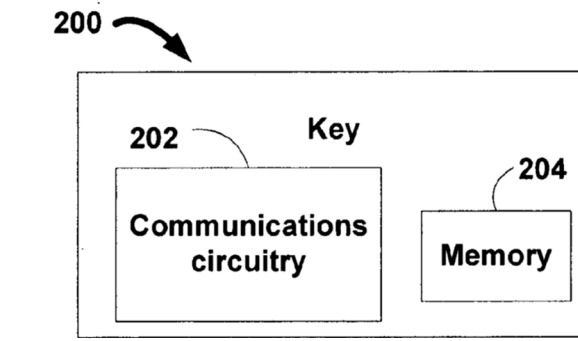


FIG. 2

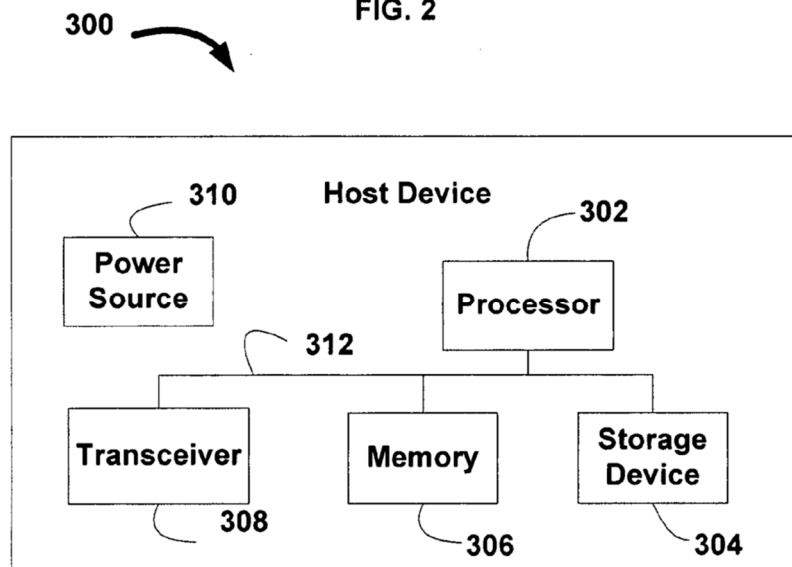


FIG. 3

(EX-1007, FIG. 2.)

D. Gunaratne

Gunaratne “relates to a system for detecting drowsiness in a machine operator, and in particular, to a system having a facial action database with a plurality of stored high priority sleepiness facial actions that are used for rapidly detecting drowsiness

in a machine operator.” (EX-1008, [0001].) Gunaratne discloses a “system and a process for detecting drowsiness in an individual operating a machine. The system includes an image acquisition module that can electronically capture a plurality of facial images of the individual.” (*Id.*, [0004].) To detect machine-operator drowsiness, Gunaratne’s system implements a software “face localization module” which analyzes captured images of operators’ faces using to generate “face mesh grids” and identify the boundaries of facial features such as the eyes and mouth. (*Id.*, [0004], [0019].) The orientation of the analyzed facial features is then compared with the images stored in a “facial action database” to determine a probability that the face shows signs of sleepiness. (*Id.*, [0022]-[0031].)

Figure 10 shows a flowchart of Gunaratne’s software process for acquiring and analyzing facial imagery to assess a probability of sleepiness as well as the severity of the sleepiness evidenced by the facial data:

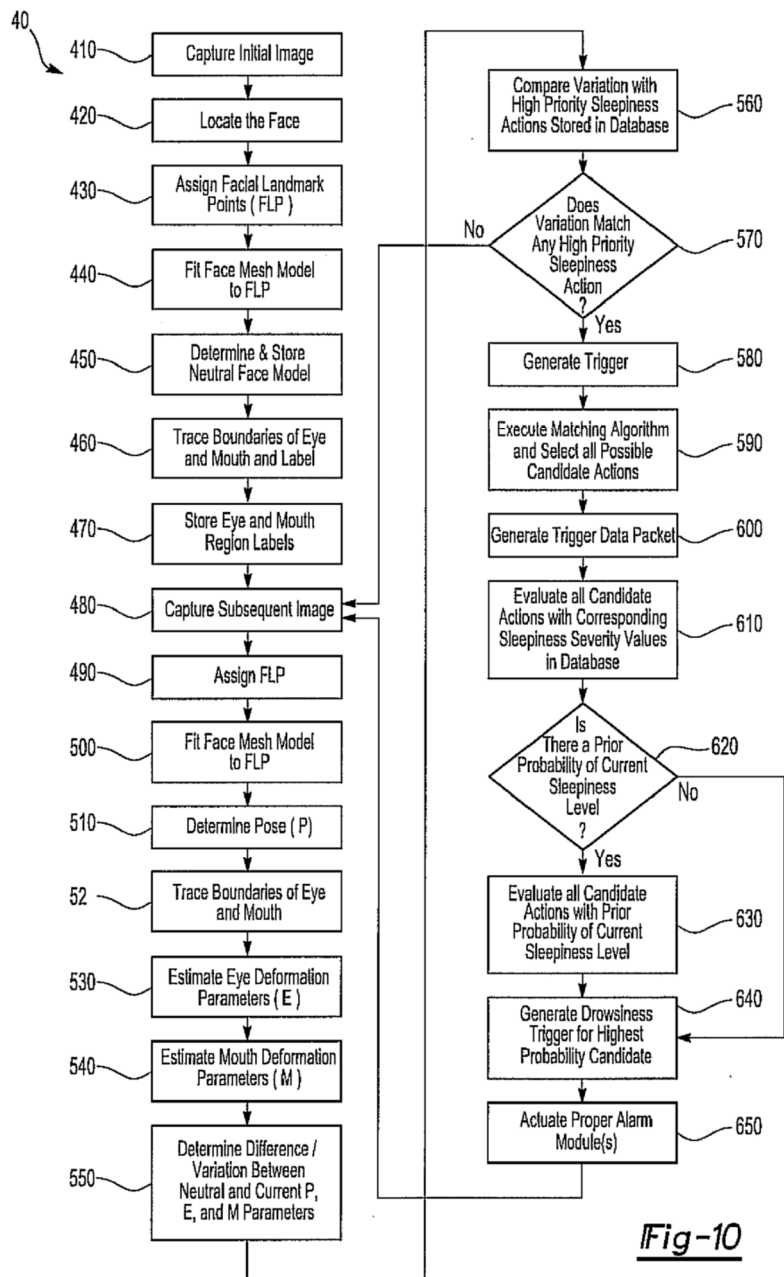


Fig-10

(EX-1008, FIG. 10.)

E. Nielsen

Nielsen “relates to information retrieval, and more particularly to adaptively changing the font size with which information retrieved over a network is displayed”

(EX-1009, 1:9-12.) Nielsen discloses “apparatus, systems, methods and computer program products which allow for an adaptive User Interface within a network browser that will utilize information gathered over time to display retrieved pages with font sizes that are desired by the user, even if that user has not visited a particular page before.” (*Id.*, 1:66-2:4.)

Nielsen teaches that network browsers, such as web browsers, can be configured to “to record font size changes in a database and after a certain number of changes to the same font size for a particular page are recorded, the user is asked if this is the preferred font size” or “to infer from previous font size preference settings made by the user, the appropriate font size to use when accessing a related [web] page for the first time.” (*Id.*, 2:7-20.) Figure 3A provides an example of Nielsen's tracking changes to the font size on several websites, and Figure 4 is a flowchart of Nielsen's database of font size preferences for a set of webpages and its use to apply the preferred font size when browsing the web page:

302 URL	303 FONT SIZE	304 DATE & TIME CHANGED
www.nasa.gov	12	4/10/97
www.nasa.gov	10	4/11/97
www.gmu.edu/catalog/page 1	11	5/10/97
-	-	-
-	-	-

FIG. 3A

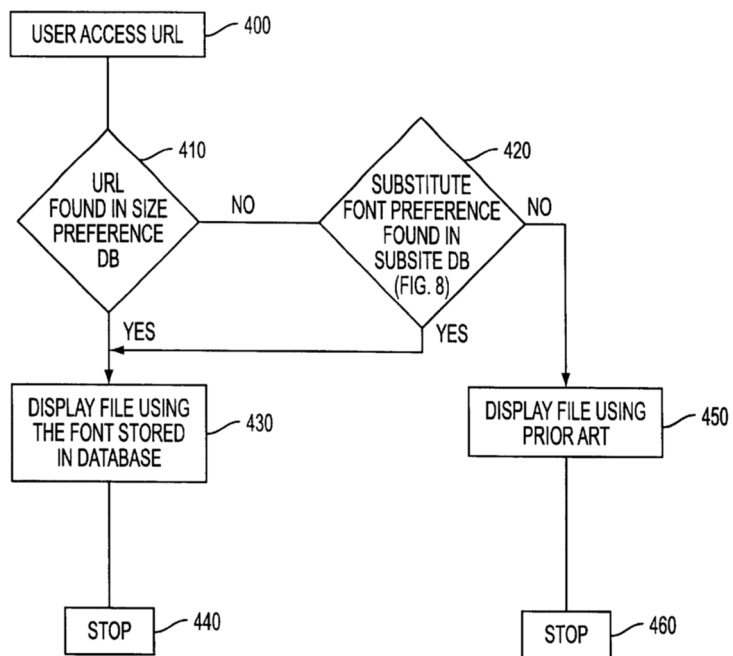


FIG. 4

(EX-1009, FIGs. 3A, 4.)

IV. Claims 11-18, 20-24, and 26 Are Patentable

Petitioner challenges claims 11-18, 20-24, and 26 under only two grounds—Jannard-740 and Rosenblatt (ground 4) and Chen and Rosenblatt (ground 7.) Both of these grounds rely on Rosenblatt, but a POSITA would not have been motivated to implement Rosenblatt's teachings in combination with those of either Jannard-740 or Chen. Thus, Petitioner's ground 4 and 7 obviousness combinations fail, and claims 11-18, 20-24, and 26 are patentable.

As further evidence that Petitioner's ground 7 fails, Chen's and Rosenblatt's teachings—even if combined as Petitioner proposes—fail to render obvious all limitations of claims 11-18, 20-24 and 26. And as further evidence that Petitioner's ground 4 fails, Jannard-740's and Rosenblatt's teachings—even if combined—fail to render obvious all limitations of claim 24.

A. Independent Claim 11 Is Patentable

Claim 11 recites:

Eyewear comprising:

an eyewear frame having a first temple and a second temple; and
an application module mechanically coupled to the eyewear
frame, the application module including a wireless chip to
communicate with a wireless enabled device,

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.

Petitioner asserts that a POSITA would have been motivated to implement Rosenblatt's disclosure of a "key"—which allegedly embodies key limitations of claim 11—in the eyewear of either Jannard-740 (ground 4) or Chen (ground 7. (Petition, 46-51, 64-70.) But a POSITA would not have been motivated to combine Rosenblatt with either primary reference. And in the case of ground 7, even if a POSITA were to combine the references' teachings as suggested, the resulting combination still does not render obvious all limitations of claim 11.

1. A POSITA would not have been motivated to implement the teachings of Rosenblatt in Jannard-740.

A POSITA would not have been motivated to combine the eyewear teachings of Jannard-740 with Rosenblatt's "key" of to achieve eyewear "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," as required by claim 11. The excessive size and power requirements needed to implement Rosenblatt's key within the confines of the eyewear of Jannard-740 would render the combination inoperable. (EX-2014, ¶47.)

A POSITA would have understood that Rosenblatt describes several distinct types of “keys” when disclosing that a key can 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].) A POSITA would have known that garment clips and car keys, for instance, cannot host the same electrical components as laptop computers and are, accordingly, much more limited in terms of size, functionality, and power-requirements. (EX-2014, ¶¶48-49.)

Rosenblatt describes embodiments of the disclosed key that include “a power supply, a user interface and a display.” (EX-1007, [0041].) Such keys may “include a processor distinct from communications circuitry 202.” (*Id.*, [0041].) To a POSITA, this disclosure would have indicated that such keys are embodied in a device the size of a small computer or a cell phone, at the very least. (EX-2014, ¶¶49-52.) Similarly, Rosenblatt’s disclosure of key memory that can “host a database of the host devices to which key 200 was paired” and “store instructions that key 200 can transmit to cause each host device to perform one or more operations” would have indicated to a POSITA that the keys incorporate operating and program

software to host such databases, functionality that could not have been done at the time of the invention in a device as rudimentary as car keys or a garment clip. (*Id.*, [0038]; EX-2014, ¶53.) Thus, based on Rosenblatt's teachings, wireless communication between a "key" and a wireless-enabled device, on which Petitioner relies as allegedly rendering obvious the limitations of claim 11, would have required at the time of the invention of the '960 Patent that the key be embodied in computers (including laptops and pocket-sized computers) or cell phones with similarly complex functionality.

Rosenblatt's "key" would therefore have comprised integrated circuits including processor, memory, storage, and wireless communications chips. (EX-2014, ¶¶53-54.) For example, Petitioner relies on Rosenblatt's disclosure of a key creating its own personal area network. (Petition, 50; EX-1003, ¶163; EX-1007, [0058] ("By virtue of the presence of a key, a personal area network may exist about person."), [0010] ("When 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.")). But a POSITA would have understood that, to create its own personal area network based on Rosenblatt's teachings, the "key" would need to be a computer comprising processor, memory, storage and wireless networking components. (EX-2014, ¶49.)

A POSITA would have known that the typical dimensions of such components and of the printed circuit boards and enclosures that house them would, at the time, range from a few cubic inches to over half a cubic foot. (EX-2014, ¶¶55; EX-2018; EX-2019; EX-2020; EX-2021) Moreover, a POSITA would have been aware of design constraints for supplying power to such components and dissipating the heat they generate: batteries, heatsinks and power supplies for those components, at the time of the invention, would have significantly increased the size of the device and added considerable weight (EX-2014, ¶¶50-56; EX-2022; EX-2025.) A POSITA would have brought that knowledge to bear when considering the design of eyewear with embedded electronics and assessed the limited space, weight, and power that eyewear could hold without being too cumbersome, dangerous, or uncomfortable.

As such, a POSITA would have been aware that the only computer “keys” in Rosenblatt that would be expected to communicate wirelessly with wireless-enabled devices “configured to recognize a presence of a wearer of the eyewear based at least in part on communication with the wireless chip” could not be adequately shrunk to fit inside the eyewear of Jannard-740 and still worn comfortably. Such computers would have dwarfed the size, weight, and power limitations of Jannard-740’s eyewear. (EX-2014, ¶¶51-56.) Petitioner’s combinations would therefore have been

inoperable, and a POSITA would not have had a reasonable expectation of success in making such a combination. Accordingly, a POSITA would not have been motivated to combine prior art teachings as Petitioner suggests.

Petitioner's arguments for alleged motivation to combine are conclusory and unsupported.

First, Petitioner alleges that eyewear such as those in Jannard-740 are a "suitable device in which to incorporate Rosenblatt's key or its functionality," in line with Rosenblatt's disclosure of placing a "key" in a "headset," which would purportedly motivate a POSITA to obtain the "benefit" of that combination (Petition, 47-48; EX-1003, ¶156; EX-1007, [0043].) Rosenblatt's disclosure of keys ranges from car keys and garment clips to cell phones and laptops, as discussed above. A POSITA would have understood that those are different devices with different capabilities and components, yet Petitioner never assesses what those differences would be and under what conditions a given "key" would be suitable for embedding in eyewear. Contrary to Petitioner's argument, the excessive size, weight and power of computer components would have rendered eyewear unsuitable for the type of Rosenblatt "keys" the petition seeks to invoke (as discussed above.)

Second, Petitioner's allegation that the combination would "represent nothing more than the simple addition" of "known elements" and the "use of a known

technique” to “improve a similar device” yielding “predictable results” (Petition, 47-48; EX-1003, ¶156) is a conclusory statement that fails to establish reasonable expectation of success as required to demonstrate motivation to combine. *KSR v Teleflex*, 550 U.S. 398, 418 (2007.) As discussed above, the need for embedding computer hardware and software to achieve the requisite “key” disclosed in Rosenblatt, the incompatible constraints of eyewear such as those disclosed in Jannard-740, and the absence of any teachings or suggestions in those references as to how to achieve a working combination leaves a POSITA without a reasonable chance of success. (EX-2014, ¶¶55-56.)

2. A POSITA would not have been motivated to implement the teachings of Rosenblatt in Chen.

Ground 7 is predicated on a combination wherein Rosenblatt's disclosure of a “key” in wireless communication with a host device is inserted into the temple of an eyewear frame, disclosed in Chen. It differs from ground 4 in that Chen replaces Jannard-740 as the reference for the eyewear. As set out above in section IV.A.1, a POSITA would not have been motivated to insert the key in Rosenblatt in the temple of *any* eyewear frame to achieve the invention in claim 11 of the '960 Patent because the only keys disclosed in Rosenblatt that could do so would be embodied in small computers (or “smart” cell phones with equivalent functionality) whose size, weight and power requirements would be too large to fit in an eyewear temple. This makes

the insertion of a Rosenblatt key in eyewear inoperable whether the eyewear is as described in Jannard-740 or in Chen, therefore ground 7 fails for at least the same reasons as ground 4. (EX-2014, ¶61.) Ground 7's reliance on Chen also fails for the additional reasons discussed in this Section.

In the case of Ground 7, the lack of motivation to combine Rosenblatt with Chen to achieve the invention of claim 11 is further demonstrated by the difference in subject matter between Chen, directed to eyewear containing thermally regulating removable cartridges, and the '960 Patent, directed to eyewear with electronic application modules capable of wireless interaction with other devices. (EX-2014, ¶62.)

The '960 Patent pertains to the field of wearable embedded electronics, namely "commercial eyewear comprising electronics" (EX-1001, 1:24-25.) More specifically, the '960 Patent is directed to "electronic eyewear modules and systems to be worn by a wearer." (*Id.*, 1:66-67.) The disclosure and claims of the '960 Patent focus on the function and design of electronic modules that fit in eyewear, notably the invention of "application modules" whose embodiments "may include one or more of an electronic device configured to perform a function." (*Id.*, 2:22-23.) Additionally, "sub-function connections [are] used to support the function of the electronic device" (*Id.*, 2:28-29.)

Chen, in contrast offers no meaningful discussion pertaining to the field of electronics embedded in eyewear. It “present[s] an eyewear temple assembly that provides the flexibility to add thermal regulation to eyewear in an integrated and concealed manner” (EX-1010, Abstract) by placing in the eyewear temples “exchangeable cartridges, which can provide thermal regulation of a user’s head.” (*Id.*, 2:49-52.) Chen’s description of its “field of the invention” further states that “the present invention relates to prior works of art that provide thermal regulation of the head.” (*Id.*, 1:20-22.) A POSITA would have understood Chen’s field of endeavor to be thermally regulated clothing (i.e., cooling or heating garments), such as cooling hats and headbands, which typically use materials with heating or cooling attributes (such as phase-changing materials; *see*, e.g., EX-2023, EX-2024) rather than electronics to achieve the desired effect. (EX-2014, ¶62.)

Petitioner mischaracterizes Chen as featuring teachings on embedded electronics by misquoting, by omitting Chen’s reference to thermal regulation as the only stated function of Chen’s cartridge, an isolated mention that “[t]he removable cartridge comprises of [sic] materials and components, including electronic or non-electronic or any combination thereof, *which will provide functions such as thermal regulation*” in Chen. (EX-1010, 2:60-63 (emphasis added); *see* Petition, 5, 66, 67, 69; EX-1003, ¶¶59, 227, 230, 234.) Contrary to Petitioner’s suggestion, Chen never

explains what electronic components would be featured in the eyewear it describes and fails to disclose any specific design of embedded electronics in its claims or in the description of its embodiments. (*See* EX-1010, 2:60-63, 5:61-64.)

Petitioner further mischaracterizes Chen as a reference that “discloses eyewear with wireless communication circuitry.” (Petition, 64; EX-1003, ¶224.) The petition cites a single survey of unrelated patents in Chen’s “background” section stating that “[e]yewear with integrated electronic components have also been described recently” in one unrelated patent pertaining to “a Bluetooth component being integrally embedded into the temple” and in another unrelated patent about a “power and control system for battery-powered, electro-chromic eyewear.” (EX-1010, 1:63-2:5; *see* petition, 67-70, EX-1003, ¶¶159-167.) But a POSITA would have understood that Chen’s background only made a passing reference to a patent in a different field, as Chen lacks any example or description of electronic components in the specification, claims, or drawings—all of which pertain, instead, to eyewear cartridges providing thermal regulation generally. Chen’s lack of disclosure of any specific design for electronic modules in eyewear would have left a POSITA without any guidance as to how to configure Chen’s eyewear in combination with Rosenblatt’s wireless communication techniques. A POSITA

would therefore have lacked any reasonable chance of succeeding in that combination. (EX-2014, ¶63.)

3. Ground 7 also fails because Petitioner's combination of Chen and Rosenblatt does not disclose or suggest the claimed application module.

Even if a POSITA were to combine the references' teachings as Petitioner argues under ground 7, the resulting combination still does not render obvious all limitations of claim 11. In addition to lacking a motivation to combine references as explained above, the combination of Chen and Rosenblatt fails to disclose the following limitations of claim 11: "an application module mechanically coupled to the eyewear frame, the application module including a wireless chip to communicate with a wireless enabled device."

Petitioner incorrectly concludes that Chen's "cartridge is an application module, and Chen thus discloses an "application module" because Chen mentions that its thermally regulating cartridge can be "electronic or non-electronic or any combination thereof" (EX-1007, 2:60-63) and permits "installment of cartridge(s) comprised of different, unique capabilities." (*Id.*, 4:22-24.) But Chen does not disclose or suggest that the cartridge includes—or even could include—"a wireless chip to communicate with a wireless enabled device." (EX-2014, ¶64.) Petitioner's

combination of Chen with Rosenblatt under ground 7 fails to render claim 11 obvious for this additional reason.

B. Independent Claim 22 Is Patentable

Claim 22 recites:

Eyewear comprising:

an eyewear frame having a first temple and a second temple;
an application module mechanically coupled to the eyewear the application module comprising 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.

The petition relies on Rosenblatt's "key" to allegedly embody the limitation "to wirelessly transmit a password from the application module from a wearer of the eyewear to a computer to access the computer." (Petition, 59.) For the same reasons previously discussed in connection with independent claim 11 (*see* Section IV(A)(1), *supra*), Petitioner's assertion that a POSITA would have implemented Rosenblatt's "key" as an "application module" within Jannard-740's or Chen's eyewear fails.

In particular, a POSITA would have understood that Rosenblatt's disclosure of a key that provides "authentication information" and enables a user to "provide login data to the key for transmission to [the] computer" (EX-1007, [0061], [0095]),

implies that the key comprises a computer system equipped with at least a processor, memory, and wireless communications chip. The resulting computer system would not, at the time of the invention, be viewed by a POSITA as suitable for embedding in eyewear due to its excessive size, weight and power requirements. (EX-2014, ¶60; *see* Section IV(A)(1), *supra.*) As a result, a POSITA would not have been motivated to combine Rosenblatt with Jannard-740 or Chen, nor would he or she have had a reasonable expectation of success in doing so. (*See* Section IV(A)(1), *supra.*)

Furthermore, for the same reasons discussed above in connection with claim 11, the combination of Chen and Rosenblatt is also deficient regarding claim 22, because Chen fails to disclose the limitations of “an application module mechanically coupled to the eyewear the application module comprising 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.” (*See* Section IV(A)(2), *supra.*)

C. As grounds 4 and 7 fail to render independent claims 11 and 22 obvious, they also fail to render obvious dependent claims 12-18, 20-21, 23-24 and 26

As discussed above in Sections IV.A and IV. B, grounds 4 and 7 do not render independent claims 11 and 22 obvious. As a result they also do not render obvious claims 12-18, 20-24, and 26 for the same reasons. Because Petitioner's arguments

regarding those dependent claims are itemized in the petition and because they are deficient for additional reasons, Patent Owner also addresses them individually below.

1. Dependent Claim 12 Is Patentable

Claim 12 recites the “eyewear of claim 11, wherein in response to recognizing the presence of the wearer, the wireless enabled device is configured to control light in the wearer's environment based at least in part on the wearer's preferences.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

Petitioner relies on Rosenblatt for the limitations of claim 12, however, a POSITA would not have been motivated to combine the computer networking and communication disclosures of Rosenblatt with the eyewear of Jannard-740 or Chen in this regard. As discussed regarding independent claim 11, a POSITA would have understood that Rosenblatt's “keys” would only be capable of advanced wireless networking and computing functionality if, indeed, they comprised a fully functioning computer that would not fit in the eyewear of Jannard-740 or Chen. (EX-2014, ¶¶41-68.)

In particular, Rosenblatt's discussion of how to configure a key to control light via a host device shows that a qualifying “key” must be a computer with: the capability of creating its own network (“as long as lamp 660 is within the network

created by the key, lamp 660 may be turned on” (EX-1007, [0065] (emphasis added)); memory; and software for “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.” (*Id.*, [0037].) At the time of the invention, such computers would largely exceed the typical size, weight and power constraints of electronics embedded in eyewear and a POSITA would therefore not consider such a combination as reasonably operable. (EX-2014, ¶¶41-68.)

2. Dependent Claim 13 Is Patentable

Claim 13 recites: the “eyewear of claim 11, wherein in response to recognizing the presence of the wearer, the wireless enabled device is configured to control temperature in the wearer’s environment based at least in part on the wearer’s preferences.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As with independent claim 11 and dependent claim 12, discussed above, a POSITA would have known that the “keys” disclosed in Rosenblatt regarding the control of temperature of a heating or air-conditioning system (EX-1007, [0037], [0066]) required embedding a full computer that exceeded typical constraints on size, power and weight for eyewear at the time. (EX-2014, ¶¶41-68.)

3. Dependent Claim 14 Is Patentable

Claim 14 recites: the “eyewear of claim 11, wherein in response to recognizing the presence of the wearer, the wireless enabled device is configured to control an external audio device based at least in part on an instruction from the wearer.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed with respect to independent claim 11, a POSITA would not have been motivated to combine Rosenblatt's “key” with the eyewear of Jannard-740 or Chen to convey a wearer's instructions to a wireless-enabled device and thereby control an external audio device. Only computers (such as a laptop, handheld computer or smartphone) exceeding typical size, weight and power constraints of eyewear would be expected by a POSITA to qualify as such keys. (EX-2014, ¶¶41-68.)

4. Dependent Claim 15 Is Patentable

Claim 15 recites: the “eyewear of claim 11, wherein in response to recognizing the presence of the wearer, the wireless enabled device is configured to control an external video device based at least in part on an instruction from the wearer.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

Similarly to claim 14, a POSITA would not have been motivated to combine Rosenblatt's “key” with the eyewear of Jannard-740 or Chen as only computers of

excessive typical size, weight and power demands of the eyewear would qualify as such keys. (EX-2014, ¶¶41-68 .)

5. Dependent Claim 16 Is Patentable

Claim 16 recites: “the eyewear of claim 11, wherein the wireless enabled device is located in an automobile.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed above regarding claim 11, a POSITA would not have been motivated to combine Rosenblatt's “key” with the eyewear of Jannard-740 or Chen due to the fact that the “key” would embody a computer whose size, weight and power would make it unsuitable for embedding in eyewear. (EX-2014, ¶¶41-68.) Claim 16's limitations envisage that an application module (which the petition maps to Rosenblatt's key) would be in wireless communication with a wireless enabled device inside an automobile. As a result, a POSITA would have understood that Rosenblatt's key would be unsuitable for embedding in eyewear when communicating with a wireless-enabled device in an automobile, rendering the petition's combination inoperative.

6. Dependent Claim 17 Is Patentable

Claim 17 recites: “the eyewear of claim 16, wherein in response to recognizing the presence of the wearer, the wireless enabled device is configured to

control at least one function of the automobile.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed above regarding claim 16, a POSITA would have understood that Rosenblatt's key would need to embody a full computer to communicate wirelessly with a wireless enabled device, including when that device is configured to control at least one function of an automobile. A POSITA would therefore not have been motivated to combine Rosenblatt with Jannard-740 or Chen regarding claim 17.

7. Dependent Claim 18 Is Patentable

Claim 18 recites: the “eyewear of claim 16, wherein the wireless enabled device is configured to control a seat, a radio, a temperature, and/or a speed of the automobile.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed above regarding claim 16, a POSITA would have understood that Rosenblatt's key would need to comprise a computer to communicate wirelessly with a wireless enabled device when that device is configured to control an automobile seat, radio, temperature and/or speed. (EX-2014, ¶¶41-68.) A POSITA would therefore not have been motivated to combine Rosenblatt with Jannard-740 or Chen in respect of this claim.

8. Dependent Claim 20 Is Patentable

Claim 20 recites: the “eyewear of claim 11, wherein the wireless chip is a Bluetooth chip.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed above for claim 11, a POSITA lacked a motivation to combine the key in Rosenblatt with the eyewear in Jannard-740 or Chen because the key would need to embody a full computer and thereby exceed feasible size, weight and power for embedding electronics in eyewear. A POSITA would have faced this issue whether or not the wireless chip used in the “key” communicated using the Bluetooth standard. (EX-2014, ¶¶41-68.)

9. Dependent Claim 21 Is Patentable

Claim 21 recites: “the eyewear of claim 11, wherein the wireless enabled device is at least one of a cell phone, a smart phone, a computer, an iPad, and/or a tablet.” Petitioner asserts only grounds 4 and 7 against this dependent claim.

As discussed above for Claim 11, a POSITA would not have been motivated to combine the key in Rosenblatt with the eyewear in Jannard-740 or Chen as it would have to be a computer requiring excessive size, weight and power (EX-2014, ¶41-68), including in the event that the key was in wireless communication with a “computer and laptop.” (EX-1007, [0061].)

10. Dependent Claim 23 Is Patentable

Claim 23 recites: “the eyewear of claim 22, wherein receiving the password at the computer enables access to the computer.” A POSITA would not have been motivated to combine the key in Rosenblatt with the eyewear of Jannard-740 or Chen for the reasons discussed above in respect of claim 22.

11. Dependent Claim 24 Is Patentable

Claim 24 recites: the “eyewear of claim 22, wherein the wireless enabled device is configured to adjust a brightness and/or a volume of the computer.” Petitioner asserts only grounds 4 and 7 against this dependent claim. A POSITA would not have been motivated to combine the key in Rosenblatt with the eyewear of Jannard-740 or Chen for the reasons discussed above in respect of claim 22, including in the event that the key was in communication with a wireless enabled device configured to adjust brightness or volume of the computer.¹

¹ Petitioner asserts that “wireless enabled device” must be construed as “computer” to avoid indefiniteness. The distinction between the two is irrelevant to Patent Owner's arguments in this proceeding, as the prior art also fails to disclose or render obvious a computer.

Furthermore, the resulting combinations of Rosenblatt with Jannard-740 and Rosenblatt with Chen fail to disclose the limitations of claim 24. The petition and its accompanying expert declaration incorrectly cite to Rosenblatt as evidence of “adjusting a brightness or volume of the computer” but Rosenblatt merely indicates that a computer “may include a display” (EX-1007, [0051]-[0053]), without discussion of brightness or volume control in a computer. (*See* petition, 59, 73; EX-1003, ¶¶ 207-209, 253.)

12. Dependent Claim 26 Is Patentable

Claim 26 recites: the “eyewear of claim 22, wherein the wireless enabled device is configured to access an email via the computer.” Petitioner asserts only grounds 4 and 7 against this dependent claim. A POSITA would not have been motivated to combine the key in Rosenblatt with the eyewear of Jannard-740 or Chen for the reasons discussed above in respect of claim 22.

V. Dependent Claim 19 Is Patentable

Claim 19 recites: the “eyewear of claim 16, wherein the wireless enabled device is configured to control a functionality of the automobile to awake the wearer should the wearer fall asleep.” Petitioner asserts grounds 5 and 8 against this dependent claim, which add Gunaratne to the combination of Jannard-740 or Chen (respectively) and Rosenblatt.

As set out above (Section IV.A and IV.C.5) for independent claim 11 and its dependent claim 16, a POSITA would not have been motivated to combine Rosenblatt's applicable "key," i.e. a small computer or cell phone with equivalent functionality to a computer, with the eyewear of Jannard-740 or Chen. The size, power, and weight constraints of such eyewear would have rendered that combination inoperable. EX-2014, ¶70.

A POSITA would also not have been motivated to combine Gunaratne's drowsiness detection system with the eyewear of Jannard-740 or Chen, or with Rosenblatt's system for remotely directing a host device to perform an operation using an electronic key, for multiple reasons.

First, Gunaratne is directed to subject matter that is very different from Jannard-740's (eyewear with embedded audio system), Chen's (eyewear with heating/cooling cartridges) or Rosenblatt's (wireless communications between various electronic keys and a host device.) Instead, Gunaratne's subject matter pertains to database management, data analysis and pattern recognition. Gunaratne discloses the use of software databases comprising digital images of sleepy faces with image acquisition software so that a picture of a machine operator can be compared to those sleepy faces. If the software described in Gunaratne finds a sufficiently similar pattern of drowsiness in the operator's picture, it activates an

alarm. (See EX-1008, Abstract, [0017]-[0031].) An example of a flowchart of Gunaratne's software is provided in Figure 10 and shows the complex data analysis steps required:

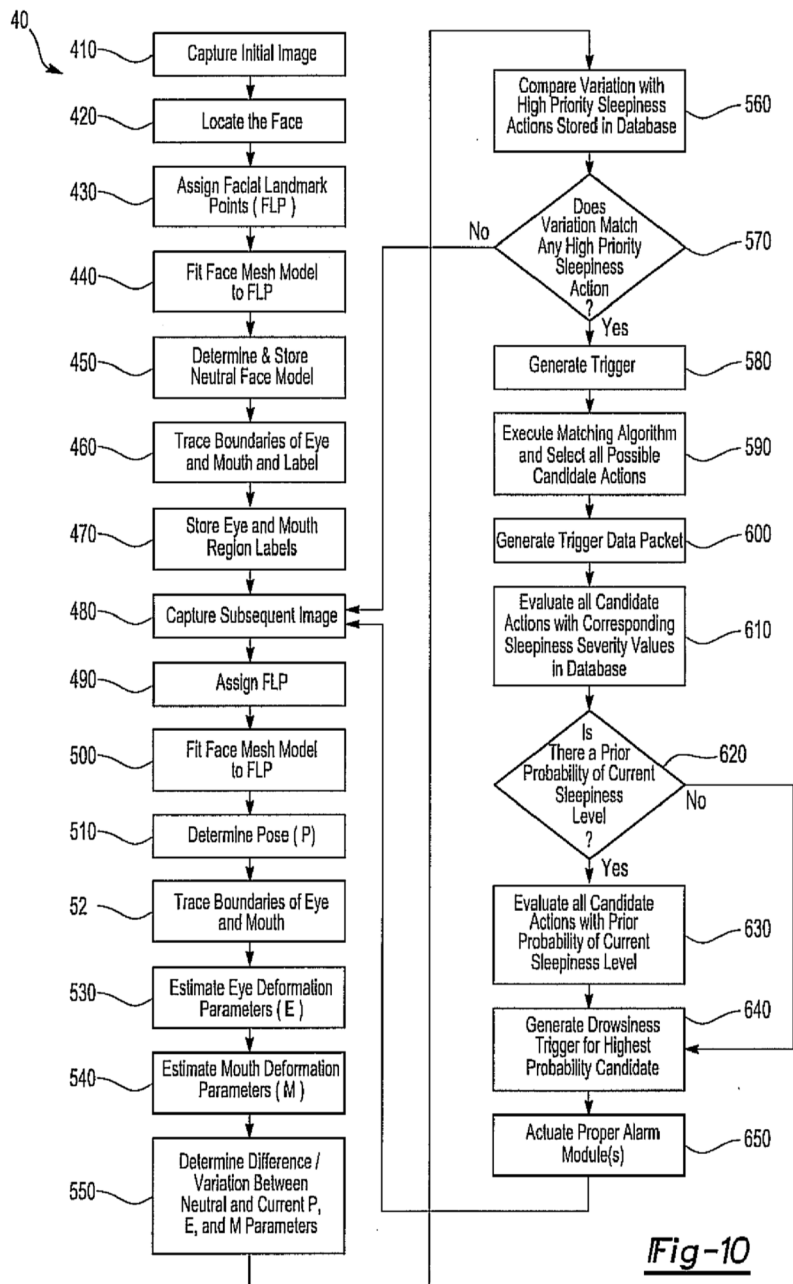


Fig-10

A POSITA would have understood that Gunaratne's subject matter made it relevant to the fields of image recognition, data analysis and database management, not the design of eyewear featuring embedded electronics (as is the case for Jannard-740) or thermally regulating eyewear (for Chen), or even wireless communication techniques (such as those described in Rosenblatt). (EX-2014, ¶71.) This is further confirmed by Gunaratne's lack of any mention of eyewear, computer hardware, embedded electronics, or wireless communications. (*Id.*)

Second, a combination of Gunaratne with the eyewear of Jannard-740 or Chen and the wireless communication techniques of Rosenblatt would have offered a POSITA no reasonable chance of success. (EX-2014, ¶¶72-73.) To implement Gunaratne as part of an automobile wireless enabled device would have required an automobile computer that embodied the complex database structure and ran the image acquisition and recognition software of Gunaratne. Gunaratne, Jannard-740, Chen and Rosenblatt provide no guidance to a POSITA as to how to build such a wireless enabled device at all and, furthermore, fail to provide guidance as to how to install such a device within the constraints of an automobile. (EX-2014, ¶72.) Similarly, the alleged combinations provide no information to a POSITA as to how such a device (assuming the POSITA could build it) would be "configured to recognize a presence of a wearer of the eyewear based at least in part on

communication with the wireless chip” of an eyewear’s electronic application module. (*Id.*)

Third, it is only through impermissible hindsight, guided by the teachings of the '960 Patent, that a POSITA could have been motivated to combine Gunaratne with Jannard-740 or Chen and Rosenblatt as Petitioner asserts. “The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985). An obviousness combination is only legitimate if the petition provides an “explanation as to how or why the references would be combined to arrive at the claimed invention,” failing which “we are left with only hindsight bias that KSR warns against.” *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017). The petition and its accompanying expert declaration fail to provide such an explanation, instead alleging that “Gunaratne suggests doing so” because it mentions rapid detection of driver drowsiness as improving driver, passenger, and bystander safety. (Petition, 61; EX-1003, ¶216.) Such passing mention of the safety benefits of avoiding driver drowsiness offers no information to a POSITA as to why combine the references or how to achieve the combination with a reasonable chance of success. (EX-2014, ¶73.) Petitioner’s and its expert’s conclusion that the

combination is the result of combining known techniques together in a “trivial” manner reveals their reliance on impermissible hindsight.

VI. Dependent Claim 25 is Patentable

Claim 25 recites the: eyewear of claim 22, wherein the wireless enabled device is configured to adjust a font size of an application in the computer. Petitioner asserts grounds 6 and 9 against this dependent claim, which add Nielse to the combination of Jannard-740 or Chen (respectively) and Rosenblatt.

As set out above (Sections IV.B) for independent claim 22, a POSITA would not have been motivated to combine Rosenblatt's “key,” which in this case would require a small computer, with the eyewear of Jannard-740 or Chen. The size, power and weight constraints of such eyewear render that combination inoperable.

A POSITA would also not have been motivated to combine Nielsen's techniques for storing webpage font size preferences in a database and displaying fonts in the preferred size when accessing such webpages with the eyewear of Jannard-740 or Chen, or with Rosenblatt's system for remotely directing a host device to perform an operation using an electronic key, for several reasons.

First, a POSITA would be unlikely to consider Nielsen in the context of designing eyewear with embedded electronics (such as Jannard-740) or equipped with thermally regulating cartridges (such as Chen), let alone motivated to combine

those references. (EX-2014, ¶76.) Nielsen pertains to very different subject matter. Nielsen discloses software relevant to web browsing techniques (adapting a font size on a given web page) and further comprising database management software (e.g., to manage a database recording the user's changes to a font size when browsing web pages). (EX-2014, ¶¶76-77.) Similarly, the subject matter of Nielsen would bear little to no relevance to a POSITA when considering Rosenblatt (wireless communications between various electronic keys and a host device), as Nielsen focuses on enhancements to the web browsing experience and offers no information pertaining to the interactions between an electronic "key" and a host device as described in Rosenblatt. Moreover, Nielsen offers no teachings on how its database systems for web-browser font adjustment would interact with electronically enhanced eyewear, leaving a POSITA without any reason to consider it when designing such eyewear, as well as no reason to consider joining it (somehow) with wireless communication techniques disclosed in Rosenblatt to do so, given that Rosenblatt features no disclosures on interfacing with web browsers at all. (EX-2014, ¶77.)

Second, a combination of Nielsen with the eyewear of Jannard-740 or Chen and the wireless communication techniques of Rosenblatt would have offered a POSITA no reasonable chance of success. (EX-2014, ¶¶78-79.) Nielsen provides no

teachings or suggestions regarding how to implement its database of webpage font changes and preferences in a computer in wireless communication with an electronic key such as disclosed in Rosenblatt, or when such a computer interacts with eyewear embedding an audio electronic system such as Jannard-740. (EX-2014, ¶¶77-79.) As Chen does not even disclose any eyewear embedding electronics capable of wireless communication, it also fails to provide a POSITA with a reasonable chance of success if attempting a combination with Rosenblatt and Nielsen.

Third, there was no motivation to combine except in hindsight driven by the teachings of the '960 Patent. Petitioner's attempt to conjure a motivation to combine the references is unavailing except as impermissible hindsight. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985.) The petition and its accompanying expert declaration simply allege that a POSITA would have been motivated to combine Nielsen because Nielsen "suggests doing so" and adding Nielsen's techniques for adjusting font size on web pages to Rosenblatt would "realize the benefits disclosed in Nielsen." (Petition, 62; EX-1003, ¶222.) Their portrayal of the combination as an assembly of a "known" technique to improve a "known" device that would have been "trivial" to a POSITA is conclusory and amply contradicted by the gap in relevant subject matter and the lack of any teachings that would yield a reasonable chance of success. (EX-2014, ¶¶74-79.)

VII. CONCLUSION

For the foregoing reasons, Petitioner has failed to establish that the challenged claims of the '960 Patent are unpatentable. Patent Owner respectfully requests the Board find the challenged claims patentable over the grounds in the Petition.

Date: April 15, 2025

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. § 42.24 have 7,990 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 365 v.2022.

Date: April 15, 2025

Respectfully submitted,

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CERTIFICATE OF CORRECTION

The undersigned hereby certifies that, with the exception of corrections made to address 1) the patent owner name correction in the **PATENT OWNER RESPONSE** and **EXHIBIT 2014**; and 2) the Patent Owner name correction in the footer of **EXHIBITS 2013-2025** as raised in communications to the Board on April 9, 2025, no other changes have been made to the original submissions.

Date: April 15, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S RESPONSE** and all supporting **EXHIBITS 2013 – 2025** were served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) on April 15, 2025 and courtesy copies were also served via electronic mail, in their entireties on the following:

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