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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 No. IPR2024-01072

Patent No. 10,598,960

**PETITIONER'S REPLY IN SUPPORT OF 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”)
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”)

Exhibit No.	Description
1021	YouTube Siri Demo Screenshots
1022	Texas Instruments OMAP White Paper
1023	Federal Court Management Statistics (excerpt), <i>available at</i> https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf
1024	Case No. 8:23-cv-02013 (C.D. Cal.), Dkt. 115, Stipulated Interim Order Regarding Case Schedule
1025	U.S. Patent App. Publ. No. 2006/0023158 to Howell et al. (“Howell-158”)
1026	Transcript of June 17, 2025 Deposition of Dr. James Oliver in IPR2024-01072

I. INTRODUCTION

The claims of the '960 patent are unpatentable, as set forth in the Petition.

e-Vision Smart Optics, Inc. (“PO”) has not presented any arguments in support of the patentability of claims 1-10 and has therefore waived any such arguments for these claims.

With respect to claims 11-26, PO’s arguments fail to rebut the Petition’s clear showing that each of these claims is unpatentable. The only independent claims in dispute are claims 11 and 22. But PO’s arguments lack merit, fail to address the Petition’s analysis, and conflict with the prior art.

For the dependent claims addressed in the Patent Owner Response (claims 19, 24, and 25), PO’s arguments are similarly meritless and do not rebut the Petition’s obviousness showing. PO’s arguments contradict the prior art and rely on the flawed legal reasoning that prior art references must be analogous to each other. PO also chose not to depose Petitioner’s expert, Dr. Feland, whose opinions stand unrebutted.

Accordingly, the Board should reject PO’s arguments and find all claims unpatentable.

II. CLAIM CONSTRUCTION

In district court, PO argued that the term “application module” should be construed to mean “[o]ne or more electronic devices configured to perform a

function.” Ex. 2013, 9. Luxottica of America Inc. (“Luxottica” or “Petitioner”), by contrast, argued that the term should be construed as “a replaceable device that can be docked to the eyewear to support an application.” *Id.* These differing constructions, however, do not affect the patentability analysis in the Petition. The claims of the ’960 patent are unpatentable under either construction. Accordingly, Petitioner did not propose any claim construction for “application module” in the Petition. Pet., 11 (noting “no claim terms require construction to resolve the obviousness challenges here”).

In an IPR proceeding, the Board only construes claim terms when necessary to resolve a dispute. *See, e.g., Unified Pats. LLC v. Velos Media, LLC*, IPR2020-00352, Paper 39 at 9-10 (P.T.A.B. June 28, 2021) (declining to construe claim terms where construction was unnecessary to resolving the parties’ dispute); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (affirming the Board’s decision not to construe a claim term “where the construction is not material to the obviousness dispute” (brackets omitted)).

Here, the parties’ claim constructions are immaterial because both Jannard-740 and Chen disclose an “application module” under either proposed construction.

See Pet., 14-20, 49-51, 57-59, 68-70, 72-73; Ex. 2013, 9-12 (proposed constructions).

The Patent Owner Response (Paper 24, “POR”) does not dispute this point.¹

Therefore, there is no inconsistency.

III. UNREBUTTED GROUNDS: INDEPENDENT CLAIM 1 AND DEPENDENT CLAIMS 2-10 ARE UNPATENTABLE

The POR does not address any of Grounds 1-3 related to claims 1-10. PO has thus waived any argument in opposition to these grounds and claims. *In re NuVasive, Inc.*, 842 F.3d 1376, 1380-1381 (Fed. Cir. 2016) (holding PO waived arguments on issues not raised in its response after institution). Accordingly, the unpatentability of claims 1-10 stands unrebutted.

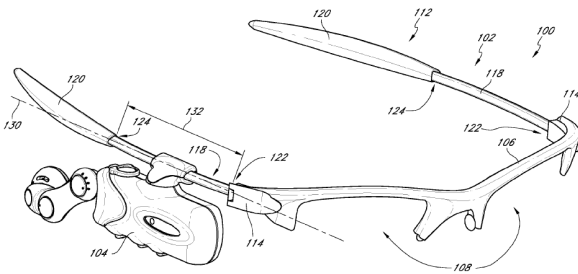
IV. INDEPENDENT CLAIM 11 IS UNPATENTABLE

A. Jannard-740 And Rosenblatt Render Claim 11 Obvious (Ground 4)

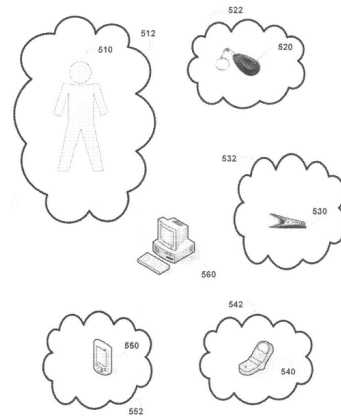
PO does not dispute that Jannard-740 discloses the claimed eyewear and application module, nor does PO dispute that Rosenblatt describes a device that recognizes the presence of a user of another device (referred to as a key) via wireless

¹ The POR argues that Chen does not disclose the “claimed application module.” POR, 27-28. But this argument does not dispute that Chen discloses an “application module.” Instead, it disputes whether Chen discloses an “application module including a wireless chip to communicate with a wireless enabled device.” *Id.*

communication between the devices. *See* POR, 18-23; Pet., 14-20, 49-51. These aspects of Jannard-740 and Rosenblatt are illustrated by the following figures:



Jannard-740 Fig. 3



Rosenblatt Fig. 5

Ex. 1005, Fig. 3; Ex. 1007, Fig. 5.

Instead, PO argues that a person of ordinary skill in the art (“POSITA”) would not have been motivated to implement Rosenblatt’s key or its functionality into Jannard-740’s application module, asserting that it would have been “inoperable.” POR, 18. But this argument is inconsistent with Rosenblatt’s disclosure, fails to meet PO’s burden to demonstrate that Rosenblatt’s disclosure is not enabled, and is contradicted by evidence showing that a POSITA would have been both motivated and able to combine the prior art as explained in the Petition.

1. PO’s Arguments Contradict Rosenblatt’s Disclosure

PO contends that “[a] POSITA would have understood that Rosenblatt describes several distinct types of ‘keys,’” only some of which could implement the

claimed functionality. POR, 18-20. PO's expert, Dr. Oliver, posits that Rosenblatt discloses "two general categories" of keys: (1) those integrated into "very small devices" (e.g., "credit card, a surgical implant, a garment clip"), and (2) those integrated into "cell phones, personal digital assistants, and laptop computer[s]." Ex. 2014, ¶¶37-38, 48.

Based on this characterization, Dr. Oliver then asserts that only the second category of devices would have been capable of creating personal area networks, as they alone could incorporate "more advanced wireless transceiver ... chips (for instance chips designed to use WiFi standards)." *Id.*, ¶49. He contrasts this with the first category, which he claims would have been limited to RFID tags "and basic radio or infrared" protocols—technologies he deems insufficient for creating a personal area network. *Id.*

PO's argument directly contradicts Rosenblatt's disclosure. For example, Rosenblatt explains that the "key may be incorporated or integrated in *any* suitable device," citing examples such as "a coin-sized object." Ex. 1007, [0007] (emphasis added). Rosenblatt further notes that "[b]ecause key 200 may require so few elements, and these elements may be very small in size, key 200 may be a very small device." *Id.*, [0043]. Nowhere does Rosenblatt indicate that key functionality depends on the size of the device into which it is incorporated. PO likewise identifies no such limitation.

Further, PO’s argument that only “more advanced wireless transceiver ... chips” could create Rosenblatt’s “personal area networks” is inconsistent with Rosenblatt’s teachings. *See* POR, 19-20 (citing Ex. 2014, ¶¶49-53). Rosenblatt states that the key’s communications circuitry “may use *any* suitable communications protocol *to create the personal area network* including ... Bluetooth ... infrared, and other relatively localized wireless communications protocols.” Ex. 1007, [0006] (emphasis added); *see also id.*, [0034]-[0035]. Accordingly, PO’s arguments are not only contradictory to the express teachings of Rosenblatt—which states that the key may be integrated into any suitable device—but also lack foundation.

2. PO Has Not Met Its Burden To Demonstrate That Rosenblatt’s Disclosure Is Not Enabled

PO next argues that “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.” POR, 18; *see also id.*, 19-23; Ex. 2014, ¶¶49-51 (“in order to meet the limitations of the ’960 Patent’s claims, [] advanced components [] infeasible in eyewear given the space and power constraints.”). This argument fails for multiple independent reasons.

First, this “inoperability” argument is based on the same flawed premise that only large, “advanced components” can implement Rosenblatt’s functionality. Because this assumption is incorrect (*see supra* §IV.A.1), so too is the conclusion

that Rosenblatt’s key would have demanded excessive size and power. Indeed, Rosenblatt states that its key “may be a very small device” and its “elements may be very small in size.” Ex. 1007, [0043]. Therefore, the Board should reject PO’s argument concerning size and power on this basis alone.

PO’s “inoperability” argument also fails because PO fails to carry its burden to show that Rosenblatt’s disclosure is not enabled. Rosenblatt discloses a key capable of creating personal area networks integrated into a “very small device” (*id.*), and this disclosure is presumed enabled. *Apple Inc. v. Corephotonics, Ltd.*, 861 F. App’x 443, 449 (Fed. Cir. 2021) (“It is well established that prior art patents and printed publications ... are presumed enabling.” (citing *Impax Labs., Inc. v. Aventis Pharms., Inc.*, 545 F.3d 1312, 1316 (Fed. Cir. 2008))). The burden of overcoming the presumption lies with PO, and that burden is significant. *Impax*, 545 F.3d at 1316 (holding that the patentee can only overcome this presumption with “*persuasive evidence* showing that the prior art does not enable the claimed invention”). Dr. Oliver provides only unsupported conjecture, which is insufficient to meet this burden. *See, e.g., Ericsson Inc. v. Intell. Ventures I LLC*, 890 F.3d 1336, 1346 (Fed. Cir. 2018) (“To contradict a reference, an unsupported opinion is not substantial evidence.”); 37 C.F.R. §42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Dr. Oliver concludes that “a POSITA would have recognized that car key fobs and garment clips *were not capable* of housing and powering wireless transceivers capable of creating personal area networks....” Ex. 2014, ¶49 (emphasis added); *see also id.*, ¶¶48, 50-56 (making “estimates” and assertions regarding various component requirements). But this conclusion does nothing more than disagree with Rosenblatt’s disclosure. The only articulated bases for Dr. Oliver’s conclusion are “estimates” concerning characteristics such as weight and power requirements that are not supported by underlying facts or data. *See id.*, ¶¶48, 50-51, 55. Therefore, his unsupported conclusion is entitled to no weight. *Ericsson*, 890 F.3d at 1346; 37 C.F.R. §42.65(a).

Dr. Oliver also opines that “a POSITA would view [Rosenblatt’s] keys [integrated into ‘tiny devices’] as limited to very simple circuitry and incapable of encompassing processor, memory, storage, wireless transceivers, and the battery and power circuitry needed to power them.” Ex. 2014, ¶50. Yet again, Dr. Oliver provides no facts or data to support this conclusion.

Dr. Oliver further references laptops and cell phones to analogize component weight and size but concedes that these devices contain sizable and weighty components not required by Rosenblatt’s key. Ex. 2014, ¶55. This comparison is therefore inapposite to the issue of whether Rosenblatt’s disclosure enables smaller devices.

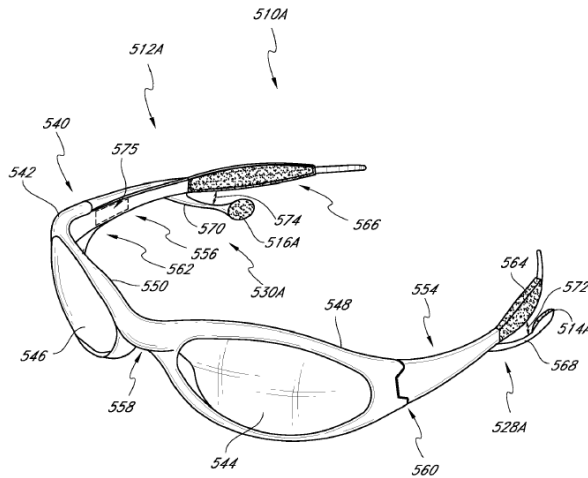
PO's non-enablement arguments lack foundation, are speculative, and fall well short of the "persuasive evidence" required to rebut the presumption that Rosenblatt is enabled. *See Impax*, 545 F.3d at 1316.

3. A POSITA Would Have Had A Reasonable Expectation Of Success

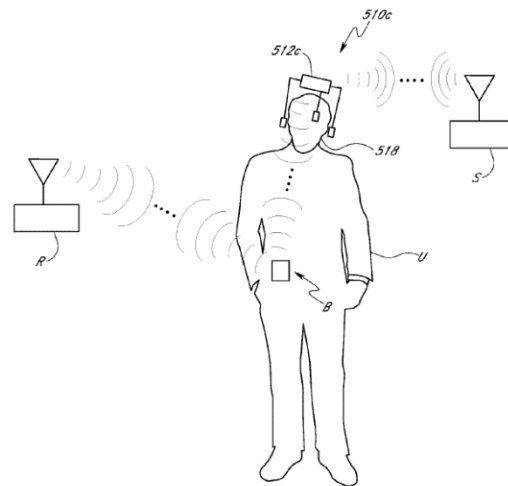
PO and Dr. Oliver further contend that a POSITA would not have had a reasonable expectation of success in making the Petition's combination. POR, 21-22; Ex. 2014, ¶56. But this argument is also founded on the false assumption that the combination is "inoperable." As Dr. Feland explains, "A POSITA would have reasonably expected success in incorporating Rosenblatt's key or its functionality in the application module in Jannard-740 based on Rosenblatt's recommendation to incorporate 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. 1003, ¶158. Multiple prior art references, in addition to Rosenblatt, support Dr. Feland's conclusion.

For example, Jannard-740 discloses a compact, detachable module 104, which includes components enabling wireless communication. Ex. 1005, [0079], [0086]. The detachable module 104 is expressly described as connectable to an eyeglass frame. *Id.*, [0079]. Jannard-740 further describes head-wearable audio devices 510,

shown below, capable of “one or two-way wireless communication with a source device.” *Id.*, [0193], [0188].



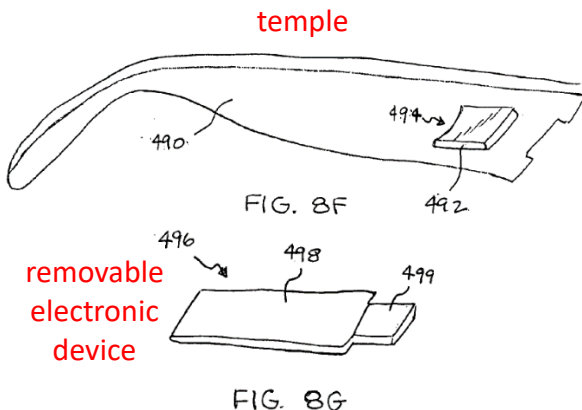
Jannard-740, Fig. 49



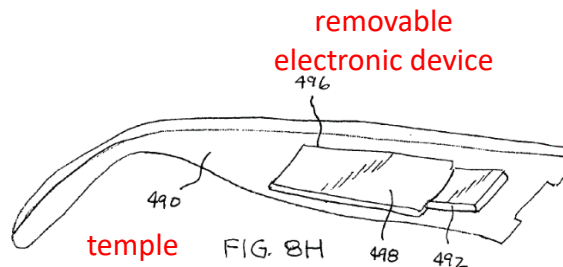
Jannard-740, Fig. 51

Id., Figs. 49, 51. Neither PO nor Dr. Oliver disputes these disclosures.

As another example, Howell-158 (Ex. 1025) discloses an eyewear frame with a connector that serves as a “docking station.” Ex. 1025, [0086]. “[A] variety of different removable electronic devices can be interconnected with the eyeglass frame, as desired,” providing functions of a mobile telephone, a data storage device, or an MP3 player. *Id.* This configuration is illustrated below, with the removable electronic device shown disconnected from the eyewear’s temple (left) and connected (right):



Howell-158, Figs. 8F-8G



Howell-158, Fig. 8H

Id., Figs. 8F-8H. According to Howell-158, its eyewear’s “wireless coupling capabilities can be used to couple to a **Bluetooth network, the Internet, a WiFi network, a WiMax network, a cell-phone network or other types of networks.**” *Id.*, [0112] (emphasis added); *see also id.*, [0123].

In sum, Dr. Feland’s testimony, supported by the record, confirms that a POSITA would have had a reasonable expectation of success when incorporating Rosenblatt’s key or its functionality into Jannard-740’s application module. Dr. Oliver’s contrary opinion is inconsistent with the record and should be rejected. *Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1378 (Fed. Cir. 2017) (The court “must disregard the testimony of an expert that is plainly inconsistent with the record.”).

B. Chen And Rosenblatt Render Claim 11 Obvious (Ground 7)

PO first argues “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.” POR, 23. PO's argument mirrors its “inoperability” argument raised under Ground 4 and should be rejected for the same reasons discussed above. *Supra* §IV.A.

PO next argues there would have been no motivation to combine Chen and Rosenblatt due to purported differences in subject matter between Chen and the '960 patent. POR, 24-25. Accordingly, PO's argument is grounded in its contention that Chen is not analogous art to the '960 patent. As set forth in the Petition, Chen is analogous art to the '960 patent. Pet., 13.

To establish that a reference is analogous, the Petition need only show that the reference is either (1) in the same field of endeavor or (2) reasonably pertinent to a problem addressed by the challenged patent. *Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023). The Petition satisfies both prongs. It establishes that Chen is “analogous art because [it is] from the same field as the '960 patent, e.g., eyewear and/or consumer electronics,” and that it is “also pertinent to a problem the inventor was focused on, e.g., eyewear with various electronic capabilities.” Pet., 13; *see also* Ex. 1026, 12:20-13:7 (Patent Owner's

expert describing the '960 patent as “focused on making fashionable eyewear with one or more application devices that are accessible to the user.”).

Chen’s title, “Eyewear Temple Assembly,” and its field of invention, which “relate[s] to eyewear with temple components that provide additional functions,” reinforce this conclusion. Ex. 1010, Title, 1:18-20. The background of the '960 patent itself acknowledges a known desire for such features, admitting “a need for a single pair of fashionable eyewear capable of a [sic] utilizing one or more of a multitude of different application devices while the wearer is wearing the eyewear.” Ex. 1001, 1:59-62; *see also Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1380 (Fed Cir. 2019) (explaining the field of endeavor may be determined based on an express disclosure in the Background section (citing *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)).

Chen also addresses a problem identified in the '960 patent: replaceability of components in electronic eyewear. Chen discloses a modular solution where “rather than replacing an entire temple, a user can just remove the old cartridge and install a new one.” Ex. 1010, 3:58-60. This mirrors the '960 patent’s disclosure that “[i]n the event that electronic application modules break, they can also be easily replaced without replacing the entire system.” Ex. 1001, 2:9-11.

PO’s analogous art argument thus fails.

Next, PO claims that the Petition “mischaracterizes Chen as featuring teachings on embedded electronics by misquoting, by omitting [sic] Chen’s reference to thermal regulation as the only stated function of Chen’s cartridge.” POR, 25; Ex. 1026, 24:22-25:6 (Patent Owner’s expert asserting that “[t]here’s no discussion or embodiment [in Chen] that describes electronics embedded in the eyewear”). But Chen broadly discloses modular solutions and electronics:

Cartridge 3 is comprised of materials and components, including *electronic* or non-electronic or any combination thereof, which will provide useful functions. For instance, cartridge 3 can be a simple, miniature, thermal regulating cartridge that an eyewear user utilizes to regulate his/her head temperature in a convenient and unobtrusive manner. ***However, a cartridge is not limited to just this functionality*** but can also include any other function(s) that are only restricted by the component(s) & material(s) in the cartridge as well as the physical dimensions of the compartment & the cartridge.

Ex. 1010, 5:61-6:4 (emphasis added).

PO then argues that a POSITA would not have had a reasonable expectation of success. Specifically, through Dr. Oliver, PO argues that “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.” Ex. 2014, ¶63;

see also POR, 26-27. But PO’s conclusory statements are contrary to the evidence.

As Dr. Feland explains:

A POSITA would have reasonably expected success in incorporating Rosenblatt’s key or its components or functionality in the application module in Chen based on Chen’s disclosure that “[t]he removable cartridge comprises of materials and components, including electronic or non-electronic or any combination thereof,” and Rosenblatt’s recommendation to incorporate 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. 1003, ¶227 (internal citations omitted). Multiple prior art references support Dr. Feland’s conclusion, as discussed for Ground 4. *Supra* §IV.A.3. Dr. Oliver’s contrary opinion should be disregarded as inconsistent with the record. *Homeland Housewares*, 865 F.3d at 1378.

PO also argues that the Petition’s combination fails to disclose or suggest the claimed application module because “Chen does not disclose or suggest that [its] cartridge includes—or even could include—‘a wireless chip to communicate with a wireless enabled device.’” POR, 27-28. But PO ignores Chen’s disclosure about embedding a Bluetooth component in the temple of eyewear. Ex. 1010, 1:63-2:2.

Indeed, PO fails to address the Petition’s clear showing that Chen suggests using application modules with a wireless chip, including, for example:

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.

Pet., 69. Similarly, PO does not rebut that “Rosenblatt suggests incorporating a wireless chip in a device like Chen’s cartridge” and “[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.” *Id.*, 69-70.

V. INDEPENDENT CLAIM 22 IS UNPATENTABLE

PO repeats its arguments from Ground 4 and 7 concerning claim 11, now in relation to claim 22. POR, 28-29. Specifically, PO argues the combinations would have been “inoperable” due to excessive size, weight, and power requirements. *Id.* PO also challenges the combination of Chen and Rosenblatt, asserting it fails to disclose or suggest the claimed application module. POR, 29. These arguments fail for the reasons above discussed with respect to claim 11. *Supra* §IV.

VI. DEPENDENT CLAIMS 12-18, 20-21, 23, AND 26 ARE UNPATENTABLE

PO provides no additional arguments regarding claims 12-18, 20-21, 23, and 26 beyond those presented for independent claims 11 and 22. *See* POR, 29-37. For the reasons discussed in Sections IV-V, these arguments are unpersuasive, and these dependent claims are also unpatentable.

VII. DEPENDENT CLAIM 19 IS UNPATENTABLE

For claim 19 under Grounds 5 and 8, PO first repeats its arguments from Ground 4 and 7 for independent claim 11, contending that the combinations are “inoperable” due to excessive size, weight, and power requirements. POR, 37-38. These arguments fail for the reasons discussed for claim 11. *Supra* §IV.

PO next argues that a POSITA would not have been motivated to combine Gunaratne’s drowsiness detection system with the combination set forth in Ground 4 or 7 because Gunaratne is purportedly directed to different subject matter from Jannard-740, Chen, and Rosenblatt. POR, 38-40. PO misunderstands the law. “When more than one prior art reference is used as the basis of an obviousness rejection, it is not required that the references be analogous art to each other.” *Sanofi-Aventis*, 66 F.4th at 1380. Instead, the references must be analogous to the claimed invention. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). The Petition demonstrates that Gunaratne is “from the same field as the ’960 patent, *e.g.*, eyewear and/or consumer electronics” (Pet., 13) and addresses “drowsiness while driving”

(Pet., 60), which is pertinent to a problem addressed in the '960 patent. Specifically, the '960 patent addresses the problem of awaking a driver who has fallen asleep, disclosing that “the remote wireless enabled devices located within the automobile can ... awake wearer should wearer fall asleep.” Ex. 1001, 19:44-50. Thus, each of the references in Grounds 5 and 8 is analogous art.

PO then contends that a POSITA would have lacked a reasonable expectation of success based on Dr. Oliver’s assertion that “a POSITA would have no guidance from any of the references towards implementing Gunaratne’s complex database system, data analysis program and facial recognition software in conjunction with Jannard-740’s or Chen’s eyewear or Rosenblatt’s wireless communication techniques.” Ex. 2014, ¶¶72-73; *see also* POR, 40-41. This argument effectively advances a non-enablement theory with respect to Gunaratne. But Gunaratne expressly discloses “a system and a process for detecting drowsiness in an individual operating a machine” (Ex. 1008, [0004]) and that an actuator can “alert the individual that he or she is becoming drowsy and may fall asleep unless proper action is taken” (*id.*, [0026]), which demonstrate that the dependent claim limitations of claim 19 are both disclosed and enabled. PO has not shown otherwise. The burden to prove non-enablement lies with PO and is substantial. *See Impax*, 545 F.3d at 1316. Dr. Oliver’s opinion is speculative and unsupported (Ex. 2014, ¶72), and thus fails to satisfy this burden. *Ericsson*, 890 F.3d at 1346; 37 C.F.R. §42.65(a).

PO's contention also lacks merit because the '960 patent itself treats the disclosed driver-waking feature as conventional, merely providing one sentence of description that "the remote wireless enabled devices located within the automobile can ... awake wearer should wearer fall asleep." Ex. 1001, 19:44-50; Ex. 1026, 36:1-38:12 (Patent Owner's expert unable to identify any disclosure in the '960 patent of how the waking feature would be implemented); *see also Abbott Labs. v. Andrx Pharms., Inc.*, 452 F.3d 1331, 1341 (Fed. Cir. 2006) (explaining that the patent demonstrates that alleged invention was within scope of the ordinary skill in the art, "and it does so not by what [the patent] discloses but by what it *does not* disclose."); *In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994); *Smith & Nephew, Inc. v. Rea*, 721 F.3d 1371, 1381 (Fed. Cir. 2013). The '960 patent does not purport to solve any problems relating to driver-waking structures or processes, confirming that they were already within the skill of the art. *Abbott Labs.*, 452 F.3d at 1341; *Epstein*, 32 F.3d at 1568; *Smith & Nephew*, 721 F.3d at 1381. PO cannot complain about detailed disclosures from Gunaratne to demonstrate knowledge when the '960 patent itself lacks any such teaching and relies solely on the knowledge of a POSITA. *Epstein*, 32 F.3d at 1568 ("[T]he Board's observation that appellant did not provide the type of detail in his specification that he now argues is necessary in prior art references supports the Board's finding that one skilled in the art would have known

how to implement the features of the references and would have concluded that the reference disclosures would have been enabling.”).

PO also argues that the Petition’s motivation analysis relies on hindsight. POR, 41-42. This is incorrect. The Petition explains that “Rosenblatt discloses its host device (wireless enabled device) can be an automobile,” “[a] common issue with automobiles known to a POSITA is drowsiness while driving,” and “Gunaratne discloses a system that addresses this known issue.” Pet., 60. The Petition further establishes, as supported by Dr. Feland’s testimony, that “[a] POSITA would have been motivated to add Gunaratne’s drowsiness-alert functionality to the automobile” in the combinations. *Id.*, 61; *see also id.*, 73-74.

VIII. DEPENDENT CLAIM 24 IS UNPATENTABLE

PO’s sole argument for claim 24, beyond its arguments for independent claim 22, is that the Petition fails to demonstrate that Rosenblatt discloses “brightness or volume control in a computer.” POR, 36-37. But the Petition establishes that Rosenblatt describes a host device with a display and that “[s]uch a display varies its brightness to visually present information to a user.” Pet., 59; *see also* Ex. 1026, 34:22-35:20 (Patent Owner’s expert agreeing that turning on a display would activate visual elements and “generally require[] some level of illumination to render the visual elements visible to the user”). This shows that the combination renders obvious that the computer’s display is configured to adjust its brightness.

Accordingly, claim 24 is unpatentable for the reasons set forth in Grounds 4 and 7 (*supra* §V) and as detailed in the Petition (Pet., 59, 73).

IX. DEPENDENT CLAIM 25 IS UNPATENTABLE

For claim 25 under Grounds 6 and 9, PO first repeats its arguments from Grounds 4 and 7 for independent claim 22, contending that the combinations are “inoperable” due to excessive size, weight, and power requirements. POR, 42-44. These arguments fail for the reasons discussed for claim 22. *Supra* §V.

PO next argues that a POSITA would not have been motivated to combine Nielsen’s adjusting of an application’s font size in a computer with the combination set forth in Ground 4 or 7 because Nielsen is directed to different subject matter from Jannard-740, Chen, and Rosenblatt. POR, 42-43. Again, PO’s argument is based on a misapprehension of the law. There is no requirement that the references be analogous to one another. *Sanofi-Aventis*, 66 F.4th at 1380. Rather, the references must be analogous to the claimed invention. *Bigio*, 381 F.3d at 1325. The Petition demonstrates that Nielsen is “from the same field as the ’960 patent, e.g., eyewear and/or consumer electronics” (Pet., 13) and addresses “adaptively changing the font size” (Pet., 62), which is pertinent to a problem addressed in the ’960 patent. Specifically, the ’960 patent addresses the problem of automatically changing font size responsive to user and device presence, disclosing that “the remote wireless enabled devices located within the computer can ... adjust the brightness, volume,

font size, access email.” Ex. 1001, 19:50-55. Thus, each of the references in Grounds 6 and 9 is analogous art.

PO then contends that a POSITA would have lacked a reasonable expectation of success in making the Petition’s combination based on Dr. Oliver’s assertion that “the vast difference in subject matter and the lack of guidance in any of the reference [sic] would have left a POSITA without any reasonable chance of succeeding in combining the web-browsing system of Nielsen with the eyewear of Jannard-740 or Chen and the wireless communication techniques of Rosenblatt.” Ex. 2014, ¶78; *see also* POR, 43-44. This argument effectively advances an implicit non-enablement theory with respect to Nielsen. However, PO has not shown that Nielsen’s disclosure is not enabled. The burden to prove non-enablement lies with PO and is substantial. *See Impax*, 545 F.3d at 1316. Dr. Oliver’s opinion is speculative and unsupported (Ex. 2014, ¶78), and thus fails to meet this burden. *Ericsson*, 890 F.3d at 1346; 37 C.F.R. §42.65(a).

PO’s contention also lacks merit because the ’960 patent treats the disclosed font-adjusting feature as conventional, merely providing one sentence of description that “the remote wireless enabled devices located within the computer can ... adjust the brightness, volume, font size, access email.” Ex. 1001, 19:50-55; Ex. 1026, 39:6-40:10 (Patent Owner’s expert acknowledging, when asked to identify any disclosure in the ’960 patent explaining how the font-adjusting feature would be implemented,

that “[t]here’s any number of ways to accomplish that, the font adjustment”); *see also Abbott Labs.*, 452 F.3d at 1341 (explaining that the patent demonstrates that alleged invention was within scope of the ordinary skill in the art, “and it does so not by what [the patent] discloses but by what it *does not* disclose.”); *Epstein*, 32 F.3d at 1568; *Smith & Nephew*, 721 F.3d at 1381. The ’960 patent does not purport to solve any problems relating to font-adjusting structures or processes, confirming that they were already within the skill of the art. *Abbott Labs.*, 452 F.3d at 1341; *Epstein*, 32 F.3d at 1568; *Smith & Nephew*, 721 F.3d at 1381. PO cannot complain about detailed disclosures from Nielsen to demonstrate knowledge when the ’960 patent itself lacks any such teaching and relies solely on the knowledge of a POSITA. *Epstein*, 32 F.3d at 1568 (“[T]he Board’s observation that appellant did not provide the type of detail in his specification that he now argues is necessary in prior art references supports the Board’s finding that one skilled in the art would have known how to implement the features of the references and would have concluded that the reference disclosures would have been enabling.”).

PO also argues that the Petition’s motivation analysis relies on hindsight. POR, 44. This is incorrect. The Petition explains that “Rosenblatt discloses its host device (wireless enabled device) can be a computer,” “[a] POSITA would have known that font sizes on computers should be adapted to user preferences,” and “Nielsen discloses a routine method for ‘... adaptively changing the font size.’” Pet.,

62. The Petition further establishes, as supported by Dr. Feland’s testimony, that “[a] POSITA would have been motivated to add Nielsen’s adaptive font functionality to the computer” in the combinations. *Id.*, 61; *see also id.*, 74.

Respectfully submitted,

Dated: June 23, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this **PETITIONER’S REPLY IN SUPPORT OF PETITION FOR INTER PARTES REVIEW** contains 5,007 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 5,600-word type-volume limit specified by 37 C.F.R. § 42.24(c)(1).

Dated: June 23, 2025

By: / Ali S. Razai /

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CERTIFICATE OF SERVICE

I hereby certify that on the date below, a true and correct copy of **PETITIONER’S REPLY IN SUPPORT OF PETITION FOR INTER PARTES REVIEW** is being served via email pursuant to 37 C.F.R. § 42.6(e), to counsel for Patent Owner as addressed below:

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