

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

**PATENT OWNER'S MOTION TO STRIKE
UNDER 37 C.F.R. § 42.23(b)**

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EXHIBIT LIST

Exhibit	Description
EX-2001	<i>eVision Optics, LLC and EVision 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 LLC and E-Vision Smart Optics, Inc. v. Luxottica Group S.P.A., Luxottica U.S. Holdings Corp., 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>e-Vision LLC and E-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>e-Vision, LLC and E-Vision Smart Optics, Inc. v. Lenovo Group, 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>e-Vision Optics, LLC and E-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>e-Vision 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>e-Vision 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>e-Vision Optics, LLC et al. v. Luxottica Group S.P.A. et al.</i> , Case No. 8:23-cv-02013 AB (SHK) (IN CHAMBERS) Order Continuing Claim Construction Hearing, Dkt. 97 (Oct. 7, 2024 C.D. Cal.)

Exhibit	Description
EX-2011	<i>e-Vision LLC et al. 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 and e-Vision Smart Optics, Inc. v. Lenovo (United States), Inc. and Lenovo PC HK, Limied</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>e-Vision 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://spinoff.nasa.gov/spinoff1997/ch6.html
EX-2025	Walsh, Glyn, “The weight of spectacle frames and the area of their nose pads”

Pursuant to Board’s emails dated July 9, 2025 and July 16, 2025 (EX-3002), Patent Owner e-Vision Smart Optics, Inc. moves to strike new arguments and evidence improperly included in Petitioner’s reply (Paper 28) (“Reply”) in violation of 37 C.F.R. § 42.23(b), 35 U.S.C. § 312(a)(3), and applicable portions of the Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019 (“Consolidated TPG”).

Patent Owner respectfully requests that the Board strike (i) EX-1025 and (ii) related arguments in Petitioner’s reply (Reply at 9-11 (Section IV.3)), as set forth herein.

I. INTRODUCTION

Petitioner improperly relies on new evidence in its reply in an attempt to patch its deficient obviousness grounds. But a reply is not the appropriate vehicle for Petitioner to rehabilitate its petition arguments.

Petitioner, apparently recognizing the weakness of its ground 4 combination of Jannard-740 and Rosenblatt, asserts that “[m]ultiple prior art references, in addition to Rosenblatt, support Dr. Feland’s [Petitioner’s expert] conclusion.” Reply at 9. Even if that were true—which it is not—these purported “multiple prior art references” do not exist in the record, despite Petitioner’s suggestion otherwise. *See* Reply at 11. To the contrary, the only such alleged evidence was not part of the record before Petitioner

submitted it along with its reply. *See* EX-1025 (U.S. Patent App. Publ. No. 2006/0023158 to Howell et al. (“Howell-158”)).

Patent Owner is unfairly prejudiced by Petitioner’s belated submission of new evidence and arguments. Patent Owner and its expert, Dr. Oliver, did not address Howell-158 in either Patent Owner’s preliminary response or Patent Owner’s response because Petitioner did not mention Howell-158 in the petition. Petitioner’s untimely submission should not be permitted at this late stage. Patent Owner requests that the Board strike Howell-158 and related arguments in Petitioner’s reply.

II. LEGAL STANDARD

A petitioner must supply all prior art evidence that supports its invalidity grounds when it files its petition. 35 U.S.C. § 312(a)(3). Raising new evidence or theories months later, and after a patent owner responds to the petition, contradicts the “expedited nature” of an IPR proceeding. *See, e.g., Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (acknowledging that “[u]nlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute”) (emphasis added). The Federal Circuit, *citing* 35 U.S.C. § 312(a)(3), noted that “[i]t is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with

particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”

Id.

A deficient petition cannot be rectified with new evidence and arguments in a reply. “A reply may only **respond** to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” 37 C.F.R. § 42.33(b) (emphasis added). As clarified in the Consolidated TPG, “‘Respond,’ in the context of 37 C.F.R. § 42.23(b), does not mean proceed with a new approach as compared to the positions taken in a prior filing.” Consolidated TPG at p. 73. In fact, “Petitioner may not submit new evidence or argument in reply **that it could have presented earlier**, e.g. to make out a prima facie case of unpatentability.” *Id.* at p. 73. Any reply that “that raises a new issue or belatedly presents evidence may not be considered.” *Id.* at p. 74.

Providing new prior art references to “gap-fill” indicates a new issue raised in a reply or otherwise an improper attempt to “make out” a case of unpatentability of challenged claims. *See, e.g., id.* (“[e]xamples of indications that a new issue has been raised in a reply include new evidence necessary to make out a prima facie case for the patentability or unpatentability of an original or proposed substitute claim”; “[i]t is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art

references intended to “gap-fill” by teaching a claim element that was not present in the prior art presented with the petition.”). *Id.* at pp. 74-75.

III. THE BOARD SHOULD STRIKE EX-1025 AND RELATED ARGUMENTS IN PETITIONER’S REPLY

A. Petitioner Did Not Support Its Petition Grounds With Howell-158.

In its reply, Petitioner asserts that “[m]ultiple prior art references” support Dr. Feland’s conclusion of implementing Rosenblatt’s functionality into Janard-740, but oddly, Petitioner does not support this assertion with any additional references found in its petition or Dr. Feland’s declaration. Instead, Petitioner impermissibly introduces Howell-158 in an attempt to “gap fill” a critical shortcoming of its ground 4 combination: Rosenblatt’s key functionality is too large, heavy, and power-hungry for Janard-740’s glasses.

Howell-158 does not make up for the deficiencies of ground 4. *See* Paper 24, “POR” at 18-23. Regardless, Petitioner’s attempt to repair ground 4 with a new prior art reference comes too late. Accepting Howell-158 and Petitioner’s apparent new justification for modifying Janard-740 would violate Petitioner’s requirement under 35 U.S.C. § 312(a)(3) to identify “*with particularity*” for each ground “*evidence that supports the grounds for the challenge.*” Petitioner’s failure to particularly identify Howell-158 in either its Petition or Dr. Feland’s declaration does not justify

introduction of new evidence now, nor has Petitioner offered any explanation for its untimely submission.

Petitioner cannot, for example, claim that it only discovered Howell-158 after Patent Owner responded to the petition. Rather, on the same day Petitioner filed the petition in this proceeding—June 21, 2024—Petitioner also filed a petition against E-Vision Optics, LLC in another proceeding, IPR2024-01069, which, like this proceeding, relates to eyewear incorporating electronics (the “-01069 IPR”). More specifically, in the -01069 IPR, Petitioner relies on Howell-158 to challenge U.S. Patent No. 10,613,335 (the “’355 patent”). Petitioner was not only aware of Howell-158, but it had even formulated an IPR petition based on it, yet Petitioner failed to cite Howell-158 in the current proceeding until its reply.

As such, Howell-158 should not be considered.

B. Petitioner’s Argument In Its Reply Is Not A “Response” To The Patent Owner Response.

Petitioner’s reply purports to respond to Patent Owner’s argument that “a POSITA would not have had a reasonable expectation of success in *making the Petitioner’s combination.*” Reply at 9-11 (*citing* POR at 21-22) (emphasis added). And indeed, pages 21-22 of the POR demonstrate that Petitioner’s combination—*Jannard-740 and Rosenblatt*—would have been inoperable, and thus a POSITA “would not have had a reasonable expectation of success in making such

combination.” POR at 21-22. In particular, adding Rosenblatt’s computer “keys” to communicate wirelessly with wireless-enabled device “would have dwarfed the size, weight, and power limitations of Jannard-740’s eye wear.” *Id.* (citing EX-2014, ¶¶51-56). Patent Owner did not address Howell-158 in the POR because Petitioner did not include Howell-158 as part of its obviousness “combination,” nor cite it for any other purpose.

A fundamental difference between a response to Patent Owner’s POR and raising new argument is where new evidence is employed to “gap-fill” or rehabilitate a *prima facie* case of obviousness, as opposed to merely showing the general state of the art. Consolidated TPG at pp. 74-75; *see also*, *Genzyme Therapeutic Prods. Ltd. v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1365–69 (Fed. Cir. 2016). A proper “response” might have included a discussion of the *prima facie* case of obviousness using the two references Petitioner used to challenge claim 11 on ground 4, Jannard-740 and Rosenblatt. Petitioner’s reliance on brand new evidence in the form of Howell-158 to show additional, never-before-seen in this proceeding, “temple” and “removable electronic device” components is not a proper response. Reply at 10-11.

Not only does Petitioner introduce new evidence in violation of the Consolidated TPG’s prohibition against doing so, but Petitioner also introduces new evidence to apparently address deficiencies in Rosenblatt’s disclosure of power-hungry, heavy, and large electronics unsuited for eyewear. If Rosenblatt alone is

insufficient to establish Petitioner’s proposed modification of Jannard-740, Petitioner cannot in the reply introduce a new *prima facie* case of obviousness based on alleged “[m]ultiple prior art references,” such as Howell-158, which Patent Owner had no opportunity to rebut in its initial responses.

The proper place for a hypothetical combination of Jannard-740, Rosenblatt, and Howell-158 would have been in the petition. Raising new references in the reply constitutes a “new approach” that is not responsive to Patent Owner’s arguments, which responded in good faith to arguments based on the two “particular” references Petitioner enumerated in ground 4: Jannard-740 and Rosenblatt. Accordingly, Patent Owner respectfully requests the Board strike Petitioner’s reply at Section IV.3 and Howell-158.

C. Petitioner’s Untimeliness Unfairly Prejudices Patent Owner.

The Board’s rules do not permit Patent Owner, in its forthcoming sur-reply, to introduce new evidence to rebut Petitioner’s new combination of Jannard-740, Rosenblatt, and Howell-158. *See, e.g.*, Consolidated TPG at pp. 73-74 (“[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness”). This leaves Patent Owner with limited opportunity to meaningfully address Howell-158 and the flaws in Petitioner’s purported modification of Jannard-740 using Howel-158.

Had Petitioner included Howell-158 in its petition, Patent Owner's expert could have (and would have) opined on Howell-158 and its flaws. But since Petitioner did not do so, Patent Owner has not (and cannot) fully address this new combination of references. Leaving Howell-158 and Petitioner's reply (Section IV.3) in the record would thus prejudice Patent Owner's position, and so Patent Owner respectfully requests the Board strike both.

IV. CONCLUSION

For the foregoing reasons, the Board should strike (i) EX-1025 and (ii) related arguments in Petitioner's reply (Reply at 9-11 (Section IV.3)).

Respectfully submitted,

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Date: July 23, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S MOTION TO STRIKE UNDER 37 C.F.R. § 42.23(b)** were served by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as by delivering a copy via electronic mail on July 23, 2025, in their entirety on the following:

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