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

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<i>Rembrandt Diagnostics, LP v. Alere, Inc.</i> , 76 F.4th 1376 (Fed. Cir. 2023)	6, 7

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

e-Vision Smart Optics, Inc. (“PO”) moves to strike Howell-158 (Ex. 1025) and portions of Petitioner’s Reply (“Reply”) referencing it. Paper 30 (“Motion”), 1. PO claims the Reply introduces new grounds or alters Petition grounds (*id.*, 2–4, 6–8), but this mischaracterizes the Reply. PO also fails to apply proper standards for submitting additional evidence on reply, as set forth in the P.T.A.B. Consolidated Trial Practice Guide¹ and by the Federal Circuit. Instead, PO incorrectly asserts that Petitioner could not submit or rely on Howell-158 in its Reply. *Id.*, 2–3, 6.

PO argues Howell-158 “gap-fill[s]” the Petition’s *prima facie* invalidity case. *Id.*, 4. In reality, Howell-158 is rebuttal evidence responding to PO’s arguments. The Petition already contains ample evidence demonstrating a reasonable expectation of success (Pet., 46–48); PO argued otherwise in its Response (“POR”), asserting “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” (POR, 21–22). The Reply’s Howell-158 discussion—four sentences plus figures—rebutts this. Reply, 9–11 (referencing POR, 21–22).

¹ Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019 (“Consolidated TPG”)

The Reply cites Howell-158 to reinforce Dr. Feland’s explanation regarding the state of the art: before the effective date, it was within the skill of the art to successfully incorporate Rosenblatt’s key or its functionality in the application module in Jannard-740. *Id.*, 9 (referencing Ex. 1003, ¶158). Howell-158 supports Petitioner’s responsive arguments that PO’s expert’s opinion on reasonable expectation of success—and, by extension, PO’s broader expectation-of-success arguments—rests on a flawed understanding of the state of the art. *Id.*, 10–11. The Reply does not use Howell-158 as invalidating prior art.

PO’s Motion likewise fails to apply the correct legal standards governing rebuttal evidence. Motion, 2–3, 6. Petitioner was permitted to introduce new evidence in reply when responding to arguments raised by PO, and Howell-158 was properly submitted as rebuttal evidence supporting Petitioner’s rebuttal arguments.

Accordingly, the Board should deny PO’s motion to strike.

II. E-VISION MISCHARACTERIZES THE REPLY ARGUMENTS REGARDING HOWELL-158

PO’s Motion repeatedly mischaracterizes the Reply’s discussion of Howell-158. PO incorrectly asserts that the Reply somehow alters the Petition’s grounds or arguments. Motion, 2–4, 6–8. For example, the Motion contends that:

- The Reply presents Howell-158 as part of “Petitioner’s apparent new justification for modifying Janard-740 [sic].” *Id.*, 4.

- The Reply discusses Howell-158 “to apparently address deficiencies in Rosenblatt’s disclosure of power-hungry, heavy, and large electronics unsuited for eyewear.” *Id.*, 6.
- “The proper place for a hypothetical combination of Jannard-740, Rosenblatt, and Howell-158 would have been in the petition.” *Id.*, 7.

These assertions are unfounded. Howell-158 does not alter the Petition’s grounds or arguments, and nothing in the Reply suggests otherwise. Rather, Howell-158 is cited to rebut PO’s contention that a POSITA would not have had a reasonable expectation of success in making the Petition’s combination. Reply, 9–11.

The Reply’s arguments regarding Howell-158 appear exclusively under a section titled “A POSITA Would Have Had A Reasonable Expectation Of Success.” *Id.*, 9. That section begins by explaining that “PO and Dr. Oliver further contend that a POSITA would not have had a reasonable expectation of success in making the Petition’s combination.” *Id.* It further provides that “[PO’s] argument is also founded on the false assumption that the combination is ‘inoperable’,” and “[a]s 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.” *Id.* The section’s first paragraph concludes by stating that “[m]ultiple prior art references, in addition to Rosenblatt, support Dr. Feland’s conclusion.” *Id.*

When the section turns to Howell-158, it introduces the reference as “another example,” making clear that Howell-158 is yet another example of the state of the art relevant to a reasonable expectation of success. Howell-158 is mentioned merely to support Dr. Feland’s statement that a POSITA would have reasonably expected success in making the combination. *Id.*, 10. The Reply briefly describes Howell-158’s features with just four sentences and accompanying figures for context.

Howell-158 directly rebuts PO’s assertion that the Petition’s combination would have been inoperable—an argument grounded on Dr. Oliver’s opinions. Howell-158’s advanced network functionalities in glasses undermine Dr. Oliver’s assertion that “only the second category of devices [larger, non-glasses 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.*, 5 (citing Ex. 2014, ¶49). Also, by demonstrating that Howell-158’s prior art eyewear has processors, memory, storage, wireless transceivers, and necessary power circuitry, the Reply refutes Dr. Oliver’s view that Rosenblatt’s keys integrated into purported “tiny devices,” such as eyewear, would have been “incapable of encompassing processor, memory, storage,

wireless transceivers, and the battery and power circuitry needed to power them.”

Id., 8 (discussing and citing Ex. 2014, ¶50).

III. E-VISION APPLIES INCORRECT RULES GOVERNING REBUTTAL EVIDENCE

PO’s arguments conflict with U.S. Patent Office rules and controlling Federal Circuit precedent, each of which expressly permits rebuttal evidence on reply.

PO asserts that “Petitioner introduce[s] new evidence in violation of the Consolidated TPG’s prohibition against doing so.” Motion, 6. That is incorrect. The Consolidated TPG expressly provides that “[a] party also may submit rebuttal evidence in support of its reply.” Consolidated TPG, 73 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015)). As discussed above, Petitioner’s Reply relies on Howell-158 to support its rebuttal arguments, making Howell-158 rebuttal evidence. *See supra* § II. Thus, the Reply’s use of Howell-158 complies with the Consolidated TPG.

The Board has previously addressed a very similar situation. In *Eli Lilly & Co. v. Teva Pharmaceuticals Int’l GmbH*, IPR2018-01710, Paper 69 (Final Written Decision), 161–63 (P.T.A.B. Mar. 31, 2020), *aff’d*, 8 F.4th 1331 (Fed. Cir. 2021), a patent owner sought to strike a thesis and portions of a reply brief that relied on the thesis. *Id.* The patent owner argued that the petitioner improperly put forth the thesis for the first time on reply. *Id.*, 162. The Board disagreed, concluding that the petitioner’s reply appropriately relied on the thesis as rebuttal evidence responding

to arguments raised in the patent owner’s response, and therefore constituted proper reply evidence. *Id.*

The Federal Circuit precedent confirms the same principle. The court has held that “there is no blanket prohibition against the introduction of new evidence during an IPR.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023) (citing *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380–82 (Fed. Cir. 2018)). Indeed, the Federal Circuit has explained that “‘the introduction of new evidence in the course of the trial is to be expected in [IPR] trial proceedings’ and permissible ‘as long as the opposing party is given notice of the evidence and an opportunity to respond to it.’” *Id.* (quoting *Genzyme Therapeutic Prods. Ltd. P’ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360, 1366 (Fed. Cir. 2016)). The court has further clarified that a petitioner “may introduce new evidence after the petition stage if ***the evidence is a legitimate reply to evidence introduced by the patent owner.***” *Anacor*, 889 F.3d at 1380–82 (emphasis added).

The Reply’s introduction of Howell-158 is a proper and legitimate evidentiary response to the evidence first raised with the POR. *See* Exs. 2014, 2016–2025. At the time of the Petition’s filing, Petitioner could not have anticipated that PO would introduce evidence asserting that Rosenblatt’s disclosure was not enabled for purported “very small devices” or that Rosenblatt’s contrary statements were

incorrect. Nor could Petitioner have anticipated PO would extend those assertions to argue that the Petition’s combination lacks a reasonable expectation of success.

Because the Petition’s grounds establish unpatentability without relying on Howell-158, Petitioner had no reason to present Howell-158 initially. Howell-158 was introduced only after PO submitted evidence claiming that a POSITA would have lacked a reasonable expectation of success. As discussed above, Howell-158 simply corroborates Dr. Feland’s testimony by providing additional prior-art evidence that the types of processing and communication components described in Rosenblatt had already been applied to eyewear like Jannard-740’s. *See supra* § II.

IV. E-VISION IS NOT PREJUDICED BY THE REPLY ARGUMENTS CONCERNING HOWELL-158

PO’s prejudice arguments rely heavily on the flawed premise that Howell-158 is presented as part of “Petitioner’s new combination.” Motion, 7–8; *see also id.*, (“Petitioner’s purported modification of Jannard-740 using Howel-158 [sic]”). As explained above, this is incorrect. The Reply cites Howell-158 to support its rebuttal arguments, making Howell-158 rebuttal evidence. *See supra* § II.

The Federal Circuit has confirmed that “‘the introduction of new evidence in the course of the trial is to be expected in [IPR] trial proceedings’ and permissible ‘as long as the opposing party is given notice of the evidence and an opportunity to respond to it.’” *Rembrandt*, 76 F.4th at 1384 (quoting *Genzyme*, 825 F.3d at 1366). PO retains the opportunity to file a sur-reply in this proceeding, ensuring the

opportunity to respond to Howell-158. Moreover, Petitioner’s expert, Dr. Feland, presented no testimony regarding Howell-158 in this IPR. It is unclear, therefore, why PO claims prejudice or contends that Dr. Oliver’s testimony is necessary to address Petitioner’s attorney argument about Howell-158.

In *Eli Lilly*, IPR2018-01710, Paper 69 (Final Written Decision), the Board addressed similar issues. *Id.*, 161–63. There, the Board noted that the patent owner had the opportunity to submit a sur-reply. *Id.*, 163. The Board ultimately concluded that “Patent Owner ha[d] failed to meet its burden to show that the arguments and evidence should be stricken.” *Id.*

V. CONCLUSION

PO’s Motion offers no valid basis to strike Howell-158 or the portions of Petitioner’s Reply addressing it. PO’s mischaracterizations of the Reply and failure to apply the correct governing rules do not show that Howell-158 constitutes improper rebuttal evidence or that the Reply’s related arguments are improper.

For these reasons, the Board should deny PO’s motion to strike.

Respectfully submitted,

Dated: August 4, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on the date below, a true and correct copy of **PETITIONER’S RESPONSE TO PATENT OWNER’S MOTION TO STRIKE UNDER 37 C.F.R. § 42.23(b)** 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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