

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 SUR-REPLY TO PETITIONER'S REPLY

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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"

I. INTRODUCTION

Petitioner has not met its burden to prove, by a preponderance of the evidence, that claims 11-26 of the '960 patent are unpatentable.

Petitioner's reply contains multiple inaccuracies and misrepresentations of Patent Owner's arguments, neglecting to address Patent Owner's pivotal contentions regarding the prior art's lack of disclosure and the absence of any motivation to combine its teachings. For example, Petitioner mischaracterizes Patent Owner's arguments concerning three different prior art references as supposed "non-enablement arguments." (Paper 28, "Reply," 9, 18, 22.) But this is inaccurate. Patent Owner has not alleged (implicitly or otherwise) that the prior art is not enabled. Petitioner also asserts, incorrectly, that Patent Owner misunderstands the law regarding analogous art. (*Id.* at 17, 21.) But this is also inaccurate. Patent Owner does not rest its non-combinability arguments on the relevance of the challenged patents to one another.

Petitioner's reply does little to challenge the central problem of the Rosenblatt combinations: that the relevant Rosenblatt "key" would be employed in a "computer too large, heavy, and power-hungry for eyewear." (Paper 24, "POR," 1.) Rosenblatt describes various implementations of a "key"; some small (like those "surgically inserted under a user's skin"), some large (like "a cellular telephone"). A POSITA would have understood that while larger key embodiments could house a wireless

transceiver (or other components like a display and user interface), smaller key embodiments would include more rudimentary components, such as “radio-frequency identification (RFID) transponder tags.” (EX-2014 at ¶49.) Petitioner does not challenge the physical reality of “very small device” keys necessarily having less physical space for components (and thus functionality) compared to relatively larger devices, such as cell phones. A POSITA would have understood that the only Rosenblatt “keys” capable of the functionality recited in claim 11 were housed in electronic devices too large for adaptation to eyewear.

Petitioner apparently recognizes the shortcomings of Rosenblatt’s “keys,” adding a new prior art reference (U.S. Patent App. Publ. No. 2006/0023158 to Howell et al. (“Howell-158”)) in a belated attempt to bolster its original invalidity grounds. (Reply, 9.) But Petitioner may not use a reply to rehabilitate its petition grounds or chart a new course in search of a *prima facie* obviousness case. (*E.g.*, 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.33(b); Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019 at pp. 73-74; *see, also, generally* Paper 30). And even if the Board were to consider this new reference, Howell-158’s passing mention of “Bluetooth” and “the Internet” is not directed to the removable electronic device shown in FIGS. 8F-8H. (*Compare* Reply, 10-11 with Howell-158, ¶¶ 78-90, 112.)

With respect to tertiary references Gunaratne and Nielsen, Patent Owner has shown that neither reference includes “any teaching regarding their interaction with eyewear.” (POR, 2.) A POSITA would not be motivated to combine Gunaratne or Nielsen because each is non-analogous art **to the claimed invention**. Neither Gunaratne nor Nielsen can be fairly classified as being (i) from the same field or endeavor or (ii) reasonably pertinent to the claims at issue. Petitioner fails both prongs of the analogous standard, and so the combination must fail on this basis alone.

Finally, Petitioner wrongly describes its expert's opinions as “unrebutted” (Reply, 1), despite Dr. Oliver thoroughly refuting those opinions at length in his own detailed declaration. (*See generally* EX-2014.) “[A] tribunal is not required to accept expert testimony simply because...the declarant was not deposed.” *Belden Inc. v. Berk-Tek LLC*, No. 2014-1676, 2014-1677, slip op. at *12 (Fed. Cir. Apr. 17, 2015) (*citing Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 147 F.3d 1374, 1379 (Fed. Cir. 1998). (affirming a PTAB's rejection of expert testimony as “conclusory” and “not supported,” even without cross-examination).

Petitioner's grounds rely on counter-intuitive combinations of prior art teachings which could only have been driven by impermissible hindsight. These grounds are fundamentally flawed because they fail to provide any persuasive rationale that would motivate a POSITA to pursue inoperable combinations.

II. CLAIM 11 IS PATENTABLE

A. Ground 4: Jannard-740 And Rosenblatt Do Not Render Claim 11 Obvious

The combination of Jannard-740 and Rosenblatt would be inoperable because Rosenblatt's "keys" that were capable of communicating wirelessly with wireless-enabled devices were too large, heavy, and power-hungry to be integrated with the eyewear of Jannard-740. (POR, 18-22.) As such, a POSITA would not have had a reasonable expectation of success and would have never attempted the combination.

Patent Owner's position is consistent with both Rosenblatt's description of multiple types of devices and a POSITA's understanding of available technology. Patent Owner and its expert, Dr. Oliver, addressed Rosenblatt's various "keys" and explained what components a POSITA would understand to be included in each.

1. Rosenblatt Does Not Contradict Patent Owner's Arguments

Petitioner's Rosenblatt-based combination depends on the mistaken assumption that a POSITA would have understood all of Rosenblatt's "keys" to be the same. But Rosenblatt does not disclose or suggest that all "keys" include the same components or perform the same function. To the contrary, Rosenblatt teaches that various embodiments of its "keys" may have more or fewer components. (*E.g., id.*, ¶ 30 ("the short range communications circuitry . . . in other embodiments, may be included in an accessory device that is docked or connected to device 110").) And a POSITA would

have known that components such as a wireless transceiver, display, user interface, processor, and database would not have fit inside a surgical insert. (*See* EX-2014, ¶¶ 49-52.)

Petitioner ignores differences among Rosenblatt's "keys." For example, Petitioner cites Rosenblatt ¶ 7 for the proposition that the "key may be incorporated or integrated in any suitable device." (Reply, 5 (*citing* EX-1007, ¶ 7).) But Rosenblatt discloses the flexibility to incorporate or integrate the "key" into a variety of devices only to the extent that the device is "suitable." (EX-1007, ¶¶ 6-9, 43-44.) A POSITA would understand that different devices would be suitable for different arrangements and component inclusions based on the suitability of a device to accommodate such components. (EX-2014, ¶¶ 49-52, 54-56.)

Petitioner's reliance on Rosenblatt ¶ 43 is also misplaced. Rosenblatt ¶ 43 does not require the "key" to be a "very small" device. While some of Rosenblatt's "keys" indeed may be very small, they also may be very large. (EX-1007, ¶ 7.) Rosenblatt's disclosure of small keys is not inconsistent with its disclosure of other "keys" with different components and functionalities based on physical design constraints. (EX-2014, ¶ 50.)

Petitioner also wrongly asserts that "[n]owhere does Rosenblatt indicate that key functionality depends on the size of the device into which it is incorporated."

(Reply, 5.) To the contrary, Rosenblatt discloses that not all “keys” include the same functionality and components:

In one embodiment, *the short range communications circuitry* may be integrated within the packaging of key 110 (e.g., integrated into a printed circuit board of the device), or *in other embodiments, may be included in an accessory device that is docked or connected to device 110*. The accessory device may be, for example, a relatively unobtrusive device that provides device 110 with short-range communicating functionality. Examples of *key 110* may include, for example, a media player such as an iPod available by Apple Computer Inc., of Cupertino, Calif., a key fob, *a cellular telephone, pocket-sized personal computers such as an iPAQ Pocket PC available by Hewlett Packard Inc., of Palo Alto, Calif., personal digital assistants (PDAs), a desktop computer, a laptop computer*, and any other device capable of communicating wirelessly (with or without the aid of a wireless enabling accessory system). In some embodiments, key 110 may be *incorporated in an article of clothing*, a wallet, a briefcase, a bag, a shoe, or any other item that a user may typically carry or wear. In some embodiments, key 110 may be *inserted inside a user's body* (e.g., surgically inserted under a user's skin).

(EX-1007, ¶ 30 (emphases added).)

Thus, a POSITA would understand that as a device shrinks in size, the size and number of components in the device shrink as well. (EX-2014, ¶¶ 48-49.)

Petitioner's reliance on the Rosenblatt's description of communication circuitry that “may use any suitable communication protocol” is similarly misplaced. (Reply, 6.) A POSITA would understand that communication protocol/circuitry and

corresponding device must be “suitable” for one another. (*See* EX-2014, ¶¶ 49-51.) For example, wireless transceivers, displays, user interfaces, and processors might be “suitable” for a cell phone, but not for a surgical insert or garment clip. (*Id.*)

2. Rosenblatt's Heavy And Large “Keys” Would Be Expected To Communicate Wirelessly With Wireless-Enabled Devices

In its reply, Petitioner argues that Patent Owner “fails to carry its burden to show that Rosenblatt's disclosure is not enabled.” (Reply, 7.) But Patent Owner never makes a non-enablement argument (implicitly or explicitly). Rather, Patent Owner and Dr. Oliver simply explain the types of components a POSITA would have expected to be in each “key” that would permit them to function in the manner described in Rosenblatt. (EX-2014, ¶¶ 48-53.) As described by Dr. Oliver, small-device “keys” may include components such as “radio-frequency identification (RFID) transponder tags and basic radio or infrared wireless remote controls.” (*See id.*, ¶49.) Correspondingly, large-device “keys” may include components such as “more advanced circuits, such as processors and memory needed to run programs, storage for data and programs (which can include memory, such as non-volatile memory, solid-state drives, etc.) and more advanced wireless transceiver (transmitter-receiver) chips.” (*See id.*) Patent Owner carries no burden to show that Rosenblatt's disclosure is not enabled because that is not Patent Owner's argument.

In creating a strawman “non-enablement” argument, Petitioner misses the central point of Dr. Oliver’s testimony: different devices necessarily have different components and functionalities based on engineering design constraints. (EX-1014, ¶¶ 48-52.) Petitioner does not dispute, for example, that surgical inserts cannot include the same combination or arrangement of components as a cell phone. A POSITA would have understood Rosenblatt to teach that a wide range of “suitable” devices could be matched with a similarly wide range of “suitable” communication functionality. (*Id.*)

Further, Petitioner dismisses practical weight requirements by attacking the “underlying facts or data” of Dr. Oliver’s conclusion. (Reply, 8.) Dr. Oliver’s declaration documents the weight and size of a cell phone as a relevant touchstone for Rosenblatt’s large keys because Rosenblatt itself repeatedly discusses implementing an embodiment of its disclosed functionality in cell phones. (EX-2014, ¶¶ 55-56.) Further, Dr. Oliver provides specific facts and data, supported by additional evidence, concerning the size and weight of two leading cell phones in 2012: the Samsung Galaxy S II and the Apple iPhone 4. (*Id.*; *see, also*, EX-2018; EX-2019.) Petitioner does not dispute that the two leading cell phones of 2012 weighed almost 140 grams, or that a 140-gram device could not have been incorporated into Jannard-740’s eyewear.

Dr. Oliver explained that even taking a “barebones’ approach” and omitting certain cell phone features not required for Rosenblatt’s wireless key functionality (e.g., the input digitizer, cell network radio, speakers and microphones), the resulting cell phone would still weigh close to 100 grams. (EX-2014, ¶ 55.) And even a 100-gram device could not have been incorporated into Jannard-740’s eyewear. (*Id.*, ¶¶ 55-56.)

In sum, Dr. Oliver summarizes the functionality and components of Rosenblatt’s keys and provides a roadmap for understanding which circuitry is “suitable” in which device. Petitioner mischaracterizes this exercise as a non-enablement argument instead of, for example, addressing whether, in practical engineering terms, a surgical insert could perform the same functions as a laptop.

3. A POSITA Would Not Have Had A Reasonable Expectation Of Success

By relying on a newly introduced reference (Howell-158), Petitioner implicitly acknowledges Rosenblatt’s deficiencies; in particular, that its relevant “keys” were too large, heavy, and power-hungry for implementation in Jannard-740’s eyewear. Instead, Petitioner searches for “[m]ultiple references . . . to support Dr. Feland’s conclusion” that did not exist in his declaration or elsewhere in the record. (Reply, 9.)

At this late stage, Petitioner may not change the prior art references used to formulate ground 4. (*E.g.*, 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.33(b); Patent Trial

and Appeal Board Consolidated Trial Practice Guide, November 2019 (“TPG”), pp. 73-74.) Notwithstanding, Dr. Feland’s “conclusion” cited at page 9 of the reply does not help Petitioner. In fact, each and every device Dr. Feland references is a large-scale device that has a size and form factor inappropriate for integration into the eyewear of Jannard-740: “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).’” (EX-1003, ¶ 158.) Dr. Feland’s testimony supports the point that Rosenblatt’s keys having the requisite functionality could be implemented only in Rosenblatt’s larger categories of keys. And as noted by Dr. Oliver, those larger keys would simply be too bulky for eyewear. (*E.g.*, EX-2014, ¶¶ 55-56.)

Petitioner’s turn to Howell-158 does not make up for Rosenblatt’s flaws. (*See* § II.A.1-2, *supra*.) As a threshold issue, Petitioner’s untimeliness materially prejudices Patent Owner at least because Patent Owner is prevented under the Consolidated TPG from fully rebutting this new evidence. (*See* Consolidated TPG, pp. 73-74; *see, also* Paper 30.)

But even a cursory examination of Howell-158 shows that it does not disclose what Petitioner implies. (Reply, 11.) Howell-158 fails to explicitly describe the depicted electrical removable device of FIGS. 8F, 8G, and 8H as having a “Bluetooth

network” or the “Internet.” (Howell-158, ¶¶ 78-90, 112.) It is almost thirty (30) paragraphs later in Howell-158 where wireless functionalities of the glasses are mentioned. (*Id.*, ¶ 112.) The discussion in Howell-158 ¶ 112 not germane to the removable electronic devices of FIGS. 8F-H, and the immediately following paragraphs (*id.*, ¶¶ 112-118) describe eyewear with wireless capabilities with reference to FIGS. 11A and 11B. And there, Howell-158 discloses that at least some of the components required for wireless transmission are “external to the glasses.” (*Id.*, ¶¶ 116, 118.)

* * *

In sum, a POSITA would not have been motivated to implement Rosenblatt's teachings in Jannard-740's eyewear, and Petitioner's late reliance on Howell-158 does not change this result. The Board should therefore find challenged claims 11-18, 20-24, and 26 patentable over ground 4.

B. Ground 7: Chen And Rosenblatt Do Not Render Claim 11 Obvious

Petitioner's ground 7 combination of Chen and Rosenblatt fails for the same reasons as set forth above with respect to ground 4.

This combination fails for the additional reasons that Chen is non-analogous art and, in any event, fails to disclose or suggest the claimed “application module.”

1. Chen Is Non-Analogous Art

Petitioner argues in its reply that Chen is “analogous art.” (Reply, 12.) However, Chen fails both prongs of the analogous art test. Chen is neither from the same field of endeavor as the claimed invention nor “reasonably pertinent to the particular problem with which the inventor is involved.” *Sanofi-Aventis Deutschland GmbH v. Mylan Pharm. Inc.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023) (*citing In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) with approval).

Petitioner attempts to draw together the concepts of “wearable embedded electronics” (of the '960 patent) and “thermally regulated clothing” (of Chen). (*See* Reply, 12-13.) But even to the extent these concepts overlap, a POSITA would not find the field of wearable embedded electronics to be the same field as thermally regulated clothing, because of the distinct focus of each pursuit.

For example, a POSITA would understand the '960 patent to concern wearable embedded electronics because the background, claims, figures, and detailed description concern exactly that: electronics, embedded, in a wearable. For example, each claim of the '960 patent recites, *inter alia*, an “application module.” Each figure of the '960 depicts an application module and/or its wearable implementation or functionality, while the detailed description describes it. Even the background of the '960 patent recognizes the need for “different application devices while the wearer is wearing the eyewear.” (EX-1001, 1:61-62.)

Petitioner's baseless attempt to rope in all wearable products into an amorphous field of endeavor does not change the fact that Chen concerns thermally regulated clothing. Taking a holistic, reality-of-the-circumstances view, each section of Chen would guide a POSITA to the field of thermal regulation. For example, Chen's claim 1 requires "at least one removable modular cartridge *for thermal regulation.*" (EX-1010, cl. 1 (emphasis added).) Further, Chen's field of invention states that its invention relates to "thermal regulation of the head." (*Id.*, 1:20-22.) And each Chen figure (and accompanying description) shows thermal regulating cartridges and/or structures that facilitate their use. (*Id.*, FIGS. 1-6.) By any objective measure, Chen concerns the field of thermally regulated clothing. This is a different field than embedded electronics, and so Petitioner's argument fails.

Chen is also not reasonably pertinent to the problem faced by the inventor. Here, Petitioner relies on a single sentence in Chen noting that its cartridge 3 "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." (Reply, 14 (*citing* EX-1010, 5:61-6:4).) However, a POSITA would read this statement in the context of Chen's thermal regulation teachings. Presented in context, Chen contemplates that while in some instances, "cartridge 3 . . . regulate[s] his/her head temperature in a convenient and

unobtrusive manner,” presumably in other cases, other thermal functions could potentially be performed, such as those that do not require active “regulating.” (EX-1010, 5:64-67.) And regardless, Chen never discloses what such “other function(s)” may entail, so a POSITA would have no basis for understanding Chen to perform electronic communication functions based on this singular passage. Petitioner reads far more into Chen than what the reference describes.

Chen would not have logically commanded itself to the attention of a POSITA because the inventor addressed the problem of wearable embedded electronics. A POSITA would have understood that the types of cartridges (e.g., those housing phase-change materials; *see, e.g.*, EX-2023; EX-2024) and structures for regulating thermal flow therefrom, would not be relevant to wearable embedded electronics. The fact that Chen includes a single sentence describing its thermal regulating cartridges as “electric” does not change this result. (*See*, EX-1010, 5:61-6:4.) The mere presence of a potential electric circuit in Chen’s thermal regulating cartridge does not render moot the entire problem to be solved by Chen—thermal regulation. Rather, a holistic reading of Chen demands that “*how*” Chen implements a thermally regulated cartridge does not change “*why*” Chen discloses a thermally regulated cartridge at all. Chen of course discloses a thermally regulated cartridge for the purpose of thermal regulation, and as

such, Chen would not have been at the logical command of the inventor who attacked a wholly different problem.

In sum, Chen is non-analogous art because it is not in the same field of endeavor as the '960 patent, nor is it reasonably pertinent to the problem faced by the inventor, as demonstrated herein.

2. Chen Does Not Teach Or Suggest The Claimed “Application Module”

Petitioner asserts that Chen's background description of a *prior art* document discussing use of Bluetooth in an eyeglass temple discloses that *Chen's thermal cartridges* communicate wirelessly. (See, Reply, 15-16 (*citing* EX-1010, 1:63-2:2).) But the relevant question is whether a POSITA would have understood Chen to disclose or suggest incorporating Bluetooth or other wireless functionality into its thermally regulated cartridges. It does not.

In its reply, Petitioner cites the testimony of its expert, Dr. Feland, who opined that POSITA would have been motivated to include a Bluetooth component in Chen's glasses based on the following passage of Chen: “incorporate detachable parts and concealable compartments, which can store or hold additional functional components.” (See, Reply, 16 (*citing* EX-1010, 1:32-34; EX-1003, ¶234).) But the ability to store and conceal additional functional components does not teach or suggest incorporating Bluetooth in Chen's thermally regulated cartridges. To the contrary, a

POSITA would have understood “additional functional components” to refer to the types of functions afforded by the various embodiments of thermally regulated cartridges described throughout Chen. (*See* EX-2014, ¶¶ 62-63.) Moreover, Chen provides no disclosure or teaching for incorporating Bluetooth or other wireless technology into its “concealable compartments.” And neither Petitioner nor its expert explain how it would even be possible to incorporate the Bluetooth of U.S. Pat. No. 5,455,638 (referenced in Chen’s background) with Chen’s concealed compartments, or whether either would be operable together in such combination.

* * *

In sum, a POSITA would not have been motivated to combine Rosenblatt’s teachings with Chen’s because the resulting system would be inoperable. Moreover, Chen is not relevant to the problem addressed by the challenge claims, and thus a POSITA would lack the requisite motivation to combine Chen with Rosenblatt. The Board should therefore find challenged claims 11-18, 20-24, and 26 patentable over ground 7.

III. CLAIM 19 IS PATENTABLE (GROUNDS 5 AND 8)

Dependent claim 19 is patentable over grounds 5 and 8 for at least the reasons set forth herein in relation to independent claim 11. Claim 19 is additionally patentable over grounds 5 and 8 because each combination relies on non-analogous art Gunaratne, results in an inoperable combination, and ultimately relies on hindsight bias.

First, Petitioner argues that Patent Owner “misunderstands the law.” (Reply, 17.) However, Gunaratne fails both prongs of the analogous art test because Gunaratne is neither from the same field of endeavor as the claimed invention nor “reasonably pertinent to the particular problem with which the inventor is involved.” *See, Sanofi-Aventis*, 66 F.4th at 1377. Gunaratne does not concern wearable embedded electronics nor commercial eyewear comprising electronics. (*See generally* EX-1008.) Not only does Gunaratne fail to describe eyewear, it also relies on different technology inapposite of eyewear: capturing an image of a user's face. (*Id.*, ¶¶ 31-32, FIGS. 1-2.) This alone precludes Gunaratne from being in a field directed to eyewear and/or wearables, because logically, the image of a person's face captured in Gunaratne FIG. 2 could not be captured from a wearable resting on the same person's face.

Further, Gunaratne is not reasonably pertinent to the problem faced by the inventor. Gunaratne would not have logically commanded itself to the inventor faced with the problem addressed by claim 19 of the '960 patent. The '960 patent sought to address problems of using a wireless enabled device to control things external to the device. (*See* EX-1001, 19:32-63.) Merely because one such thing was an automobile does not mean that Gunaratne would have been at the inventor's logical command. To the contrary, engaged in the pursuit of causing a wearable device to control things, the inventor would have dismissed Gunaratne as inapplicable at least because Gunaratne's

system could not have been implemented with a wearable, such as eyeglasses. (*See* EX-2014, ¶¶ 71-73.)

Second, Petitioner incorrectly alleges that Patent Owner “advances a non-enablement theory with respect to Gunaratne.” (Reply, 18.) But rather than advance a “non-enablement theory,” Patent Owner demonstrated in its response that Gunaratne’s techniques (even if enabled) would be inoperable in a hypothetical combination with eyewear, such as the eyewear described in Jannard-740. (POR, 37-42.) Gunaratne discloses multiple features incompatible with eyewear, and therefore Petitioner’s attempt to combine such features with eyewear results in an inoperable system.

For example, Gunaratne’s complex data analysis process with “image acquisition” would be incompatible with eyewear. (EX-1008, ¶¶ 31-32, FIGS. 1-2.) Gunaratne relies on complex data analysis steps to perform detection techniques. (*Id.*, ¶¶ 40-44, FIG. 10.) Petitioner fails to explain how this complex data analysis would be performed in conjunction with eyewear, particularly when Gunaratne does not discuss eyewear, and would have been incompatible with eyewear (because of its image acquisition requirements). As an illustration, without capturing an image of the driver, Gunaratne cannot complete its facial landmark analysis. (*See id.*) But eyewear or other wearables would not be suitable to create a straight-on image of a face wearing said eyewear, e.g., of a hypothetical drowsy driver. So, if Gunaratne were combined

with Jannard-740 and/or Chen as Petitioner proposes, the result would be an inoperable system.

Petitioner obfuscates the issue by alleging that Patent Owner's expert, Dr. Oliver, did not identify any disclosure in the '960 patent of "how the waking feature would be implemented." (Reply, 19 (*citing* EX-1026, 36:1-38:12).) But this is irrelevant to whether Gunaratne would be implemented with eyewear. A POSITA would not have been motivated to incorporate Gunaratne's system into eyewear, as proposed by Petitioner, because a POSITA would have understood that doing so would have not resulted in an operable system. (*See* EX-2014, ¶¶ 70-73.)

Third, Petitioner cites Rosenblatt's discussion of an "automobile" as support for Petitioner's assertion that its ground 5 combination does not rely on hindsight bias. (Reply, 20.) But implementation of Rosenblatt's "keys" in an automobile does not provide a basis for combining drowsiness detection techniques with eyewear. Absent an express disclosure of "eyewear" in Gunaratne, Petitioner appears to rely exclusively on hindsight to stitch together unrelated elements of the prior art in a misguided attempt to reconstruct the invention addressed by the '960 patent, claim 19. (Reply, 20.)

Other than the specification of the '960 patent, which is unavailable as prior art, Petitioner identifies no other prior art that shows the recited "awake" function in

combination with a wearable, “wireless enabled device.” Nor can Petitioner provide a motivation for integrating these features together beyond Dr. Feland’s conclusory testimony that Gunaratne “has utility as a safety feature for a machine.” (EX-1003, ¶ 216 (*citing* EX-1008, ¶ 17).) In fact, this teaching exists only in the specification of the ’960 patent, not the cited art, and thus Petitioner “fall[s] victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Petitioner’s hindsight-based rationale for combining Gunaratne with either Jannard-740 or Chen fails.

* * *

In sum, Patent Owner respectfully request that the Board find claim 19 patentable over grounds 5 and 8.

IV. CLAIM 24 IS PATENTABLE (GROUNDS 4 AND 7)

Dependent claim 24 is patentable over grounds 4 and 7 for at least the reasons set forth herein in relation to independent claim 11. Claim 24 is additionally patentable over grounds 4 and 7 because each combination fails to teach or suggest: “wherein the *wireless enabled device is configured to* adjust a brightness and/or a volume of the computer.” (EX-1001, cl. 24 (emphasis added).)

In the reply, Petitioner doubles down on its use of Rosenblatt's mere mention of a display—"may include a display"—as evidence that it would have been obvious to adjust brightness using a wireless enabled device. (Reply, 20-21.) But mere mention of a display does not disclose or suggest brightness control, much less doing so with a wireless enabled device. For example, Petitioner's reply points to an unrelated portion of Dr. Oliver's testimony in which Dr. Oliver describes turning on virtual or augmented reality functions "within the lens display." (Reply, 20-21 (*citing* EX-1026, 34:22-35:20).) Not only is Dr. Oliver's comment not directed to Rosenblatt's "display," but it also does not address a brightness "adjustment," as recited in claim 24. Accordingly, Petitioner's reliance of Dr. Oliver's testimony is insufficient to remedy Rosenblatt's shortcomings.

As such, dependent claim 24 is also patentable because neither Jannard-740 nor Rosenblatt disclose or suggest adjusting brightness.

V. CLAIM 25 IS PATENTABLE (GROUNDS 6 AND 9)

Dependent claim 25 is patentable over grounds 6 and 9 for at least the reasons set forth herein in relation to independent claim 11. Claim 25 is additionally patentable over grounds 6 and 9 because each combination relies on non-analogous art Nielsen, results in an inoperable combination, and ultimately relies on hindsight bias.

First, Petitioner argues that Patent Owner's "argument is based on a misapprehension of the law." (Reply, 21.) However, Nielsen fails both prongs of the

analogous art test because Nielsen is neither from the same field of endeavor as the claimed invention nor “reasonably pertinent to the particular problem with which the inventor is involved.” *See, Sanofi-Aventis*, 66 F.4th at 1377. Nielsen is not from the same field of endeavor because “wearable embedded electronics,” namely, “commercial eyewear comprising electronics” is not the same field as “information retrieval, and more particularly to adaptively changing the font size with which information retrieved over a network is displayed,” as described in Nielsen. (EX-1009, 1:9-10.) Petitioner has not demonstrated how these fields overlap or could even be remotely related to one another, particularly as Nielsen never discusses eyewear.

Further, Nielsen is not reasonably pertinent to the problem faced by the inventor. The '960 patent addresses problems of using a wireless enabled device to control things external to the device. (*See*, EX-1001, 19:32-63.) Nielsen would not have been at the logical command of the inventor because the Nielsen disclosure does not provide any relevant teaching to this problem. For example, the inventor would have found Nielsen's reliance on detecting input from a user's hands as the user surfs the web (and registers font size preferences) inapplicable to the problems addressed in the context of hands-free eyewear. Accordingly, Nielsen is non-analogous art because it is not in the same field of endeavor as the '960 patent, nor is it reasonably pertinent to the problem faced by the inventor.

Second, Petitioner incorrectly alleges that Patent Owner “effectively advances an implicit non-enablement theory with respect to Nielsen.” (Reply, 22.) Rather than advance a “non-enablement theory,” as mischaracterized by Petitioner in the reply, Patent Owner merely demonstrates that Nielsen’s techniques would be inoperable in a hypothetical combination with eyewear, such as the eyewear described in Jannard-740. (POR, 42-44.) For example, Nielsen discloses detecting or registering user font-size preferences as the user surfs the web. (See EX-1009, 4:52-65, FIG. 3A.) FIG. 1A of Nielsen shows available technology contemplated for detecting or registering said preferences. Any attempt to incorporate Nielsen’s teachings into those of Petitioner’s eyewear references would have resulted in an inoperable system at least because there would be no basis for the preference detection techniques to occur. (EX-2014, 76-79.) Thus, a POSITA would not have been motivated to substitute the Nielsen database analysis system into eyewear.

Third, in the reply, Petitioner merely refers to conclusory statements in its petition that, e.g., “[a] POSITA would have been motivated to add Nielsen’s adaptive font functionality to the computer,” without ever establishing why a POSITA would divorce the prior art teachings from the contexts within which they are disclosed. (Reply, 23-24.) Absent an express disclosure of “eyewear” in Nielsen, Petitioner appears to rely exclusively on hindsight to stitch together unrelated elements of the

prior art in a misguided attempted to reconstruct the invention recited in claim 25 of the '960 patent. (Reply, 23-24.) Petitioner must put forward some “explanation as to how or why the references would be combined to arrive at the claimed invention...[otherwise] hindsight bias [becomes] the thread that stitches together prior art patches into something that is the claimed invention.” *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) (citation omitted).

A POSITA would not engage in such pursuit, and thus Petitioner's hindsight-based rationale to combine the teachings of Nielsen with those of either Jannard-740 or Chen fails.

* * *

In sum, Patent Owner respectfully requests that the Board find claim 25 patentable over grounds 6 and 9.

VI. CLAIMS 12-18, 20-23, AND 26 ARE PATENTABLE

With respect to independent claim 22, Petitioner relies on its arguments for claim 11. (Pet., 57-59.) Because Petitioner's arguments for claim 11 fail, its arguments for independent claim 22 fail for the same reasons. (*See* § II.A, *supra*.)

With respect to dependent claims 12-18, 20-21, 23, and 26, these claims are patentable for at least due to their dependence on a respective patentable independent claim.

VII. CONCLUSION

For the above reasons, the Board should issue a Final Written Decision finding the challenged claims patentable over the grounds in the petition.

Respectfully submitted,

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Date: August 4, 2025

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY** specified in 37 C.F.R. § 42.24 have 5,306 words, in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word 365 v.2022.

Date: August 4, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY** 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 August 4, 2025, in their entirety on the following:

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