

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 REPLY IN SUPPORT OF MOTION TO STRIKE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office P.O.
Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

	Page(s)
EXHIBIT LIST	iii
I. INTRODUCTION	1
II. PETITIONER’S REPLY ARGUMENTS ATTEMPT TO REHABILTE GROUND 4 WITH NEW EVIDENCE: HOWELL-158	1
III. PETITIONER DOES NOT OFFER HOWELL-158 AS REBUTTAL EVIDENCE	3
IV. PATENT OWNER CANNOT FULLY ADDRESS HOWELL-158’S NUMEROUS DEFICIENCIES	4
V. CONCLUSION.....	5

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Eli Lilly & Co. v. Teva Pharmaceuticals Int’l GmbH</i> , IPR2018-01710, Paper 69 (PTAB Mar. 31, 2020)	3
<i>Eli Lilly & Co. v. Teva Pharmaceuticals Int’l GmbH</i> 8 F.4th 1331 (Fed. Cir. 2021)	3
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	3

Statutes

35 U.S.C. § 312(a)(3)	3
-----------------------------	---

Other References

Fed. R. Evid. 702(a)	5
Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019)	5

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, Limited</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's reply introduced new evidence in an improper attempt to rehabilitate its faulty ground 4: EX-1025 (U.S. Patent App. Publ. No. 2006/0023158 to Howell et al. ("Howell-158")). (*See* Paper 28, "Reply," 9-11.) Patent Owner moved to strike Howell-158 and related arguments in Petitioner's reply. (Paper 30, "Motion," 4-8.)

In response, Petitioner attempts to shoehorn Howell-158 into the framework of a "rebuttal." (Paper 31, "Response," 2-7.) But Petitioner's use of Howell-158 is not a rebuttal because Petitioner relies on Howell-158 only to buttress its original petition arguments concerning a purported "reasonably expected success." (*Compare* Petition, 48-49 *with* Reply, 9-11.) Petitioner's use of Howell-158 is thus not specifically directed to Patent Owner's arguments. Moreover, Petitioner has unfairly prevented Patent Owner from fully addressing Howell-158's failure to disclose or suggest critical communication circuitry in its eyewear. The Board should grant Patent Owner's motion to strike.

II. PETITIONER'S REPLY ARGUMENTS ATTEMPT TO REHABILITE GROUND 4 WITH NEW EVIDENCE: HOWELL-158

Petitioner alleges that Patent Owner mischaracterizes Petitioner's reply. (Response, 2.) According to Petitioner, "Howell-158 is cited to rebut PO's contention that a POSITA would not have had a reasonable expectation of success." (*Id.*) Instead, Petitioner uses Howell-158 to buttress its threadbare motivation to combine.

The notion that a POSITA would have a reasonable expectation of success to incorporate large, cumbersome, and power-hungry communication circuitry into eyewear originated with Petitioner, in the petition and in Dr. Feland's accompany declaration. (*See* Petition, 48-49 (*citing* EX-1007, ¶¶7, 43; EX-1003, ¶158) (emphasis added).) Neither Petitioner nor Dr. Feland originally cited Howell-158 as evidence that a POSITA allegedly would have “reasonably expected success.” (*See generally* Petition; EX-1003.) Nevertheless, Petitioner's reply asserts that “Dr. Feland's testimony, *supported by the record*, confirms that a POSITA would have had a reasonable expectation of success.” (Reply, 11 (emphasis added).)

But Jannard-740 was the only reference in the record cited by Dr. Feland to support an alleged reasonable expectation of success. (Petition, 48-49; EX-1003, ¶158.) As such, Petitioner's reply statement that “[*m*]ultiple prior art references, in addition to Rosenblatt, support Dr. Feland's conclusion” is an implicit admission that Petitioner and Dr. Feland failed to adequately support or otherwise formulate ground 4 because they did not include these “multiple references” in the original filing. (*See* Reply, 9 (emphasis added).) It is only with the belated introduction of Howell-158 that Petitioner can purport to support Dr. Feland's testimony with “multiple references.” (*See id.*, 10-11.)

In short, Patent Owner did not mischaracterize Petitioner’s reply because neither the petition nor Dr. Feland’s testimony cited supposed “multiple references” in support of Petitioner’s alleged expectation of success. (*See* Reply, 9-11.)

III. PETITIONER DOES NOT OFFER HOWELL-158 AS REBUTTAL EVIDENCE

Petitioner’s analysis of the admissibility of “rebuttal evidence” is misplaced and ignores the basic requirement that “the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (*citing* 35 U.S.C. § 312(a)(3).) Although Petitioner’s reply states that “multiple references” support Dr. Feland’s position, Petitioner did not identify these multiple references (e.g., Howell-158) in its initial petition, in violation of 35 U.S.C. § 312(a)(3).

Howell-158 is not rebuttal evidence because it is not specifically directed to Patent Owner’s arguments. Petitioner relies on Howell-158 to make up for the lack of “multiple references” in the petition. (*See* § II, *supra*.) Nor can Petitioner rely on Howell-158 to rebut a non-existent non-enablement theory (Response, 6), as Patent Owner never argued—explicitly or implicitly—that Rosenblatt is not enabling, (Paper 32, “Sur-Reply,” 7). The fact that Petitioner purports to introduce Howell-158 for purposes of countering a non-existent non-enablement theory demonstrates that Howell-158 is not rebuttal evidence.

Petitioner’s reliance on the Board’s decision in *Eli Lilly & Co. v. Teva Pharmaceuticals Int’l GmbH* is misplaced. (IPR2018-01710, Paper 69 (Final Written Decision), 161–63 (PTAB. Mar. 31, 2020), *aff’d*, 8 F.4th 1331 (Fed. Cir. 2021).) Unlike the current proceeding, in which Petitioner uses Howell-158 to patch up the lack of “multiple references” in its petition, the petitioner in *Eli Lilly* apparently relied on a new reference to respond to a specific “blood pressure” argument first raised by Patent Owner. (*See id.*; IPR2018-01710, Paper 32 (Petitioner’s Reply), 6.) Thus, *Eli Lilly* is inapposite.

Petitioner’s assertion that it could not have anticipated that Patent Owner would “argue that the Petition’s combination lacks a reasonable expectation of success” defies credibility. (Response, 7.) Petitioner argued in its petition that a POSITA would expect success in combining communication components into eyewear. (Petition, 48–49.) Petitioner therefore knew (or at least should have known) that Patent Owner would like respond to that argument. Petitioner could have relied on Howell-158 in the petition, but chose not to.

IV. PATENT OWNER CANNOT FULLY ADDRESS HOWELL-158’S NUMEROUS DEFICIENCIES

Petitioner suggests there is no prejudice because expert testimony is not “necessary to address Petitioner’s attorney argument about Howell-158.” (Response, 8.) But though Petitioner’s argument is indeed unsupported by expert testimony, Patent

Owner was still entitled to an opportunity to present whatever rebuttal evidence it chose. (*See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) (“TPG”), 34 (*citing* Fed. R. Evid. 702(a)).) For example, Dr. Oliver could have submitted testimony explaining that Howell-158 does not teach what Petitioner says it does. (*Compare* Reply, 10-11 with Howell-158, FIGS. 8F-8H, ¶112.) In particular, Petitioner wrongly implied that Howell-158 discloses the use of Bluetooth in connection with “removable electronic device.” (*See id.*) Moreover, Petitioner introduced new evidence—Howell-158—not just attorney argument in its reply. (Reply, 9-11.) And at this late stage, Patent Owner cannot submit expert testimony, for example, to “testify about the teachings of the prior art” that Petitioner seeks to insert into the current proceeding. (*See* TPG, 35.)

While Patent Owner’s sur-reply did address such deficiencies in Howell-158 and Petitioner’s new argument based on it (Sur-Reply, 9-11), Patent Owner was barred from introducing new expert testimony on Howell-158’s disclosures, under the TPG. (TPG, 73-74.) As such, should Howell-158 be considered in this proceeding, Patent Owner would be materially prejudiced by its inability to fully address Howell-158.

V. CONCLUSION

The Board should strike (i) EX-1025 and (ii) related arguments in Petitioner’s reply (Reply, 9-11 (Section IV.3)). Petitioner provides no basis to do otherwise.

Respectfully submitted,

KING & SPALDING LLP

By: /Brian Eutermoser/
Brian Eutermoser (Reg. No. 64,058)

Attorney for Patent Owner
e-Vision Smart Optics, Inc.

Date: August 13, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REPLY IN SUPPORT OF MOTION TO STRIKE** 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 13, 2025, in their entirety on the following:

Ali S. Razai (Reg. No. 60,771)
ali.razai@morganlewis.com
Benjamin B. Anger (Reg. No. 62,207)
ben.anger@morganlewis.com
Zachary B. Messick (Reg. No. 77,839)
zachary.messick@morganlewis.com
MLB-Luxottica-IPR-
960@morganlewis.com
Morgan, Lewis & Bockius LLP
600 Anton Boulevard, Suite 1800
Costa Mesa, CA 92626-7653
Phone: (714) 830-0600
Fax: (714) 830-0700

*Counsel for Petitioner
Luxottica of America Inc.*

Alexander B. Stein (Reg. No. 71,397)
alexander.stein@morganlewis.com
Jacob L. Peterson (Reg. No. 65,096)
jacob.peterson@morganlewis.com
Morgan, Lewis & Bockius LLP
1301 Second Avenue, Suite 3000
Seattle, WA 98101
Phone: (206) 274- 6400
Fax: (206) 274-6401

KING & SPALDING LLP

By: /Brian Eutermoser/
Brian Eutermoser (Reg. No. 64,058)

*Attorney for Patent Owner
e-Vision Smart Optics, Inc.*

Date: August 13, 2025