

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.

Patent No. 11,487,138
IPR2025-00216

PATENT OWNER'S PRELIMINARY RESPONSE

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E-Vision Smart Optics, LLC (“Patent Owner”) submits this Preliminary Response to the Petition of Luxottica of America Inc. (“Petitioner”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 11,487,138 (“the ’138 patent”). Patent Owner respectfully requests that the Board exercise its discretion to decline to institute the present petition for the reasons set forth herein.

I. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(D)

Petitioner asserts that discretionary denial under 35 U.S.C. § 325(d) is not appropriate. *See* Pet. 88-89. Five of the petition’s eight Grounds are based on the Jannard-740 reference. *See* Pet., 24. The Petition argues that during prosecution, the “Examiner rejected claims over Jannard-382, from which Jannard-740 is a continuation-in-part” and states that “the Examiner never considered Jannard-740, which includes additional disclosure relative to Jannard-382.” Pet., 88. Petitioner then specifically contends that “[t]he additional disclosure in Jannard-740 discloses and suggests the limitations of the independent claims that the Examiner found Jannard-382 failed to teach or suggest.” Pet., 88. In so arguing, Petitioner misrepresents the nature of the Examiner’s consideration of Jannard-382 and of its own contentions in this proceeding.

During prosecution, the Examiner rejected the claims over Jannard-382 (Ex.

1017) and Tran (Ex. 1030).¹ The Examiner contended that Jannard-382 taught all elements of the then-pending independent claims except “a verbal query . . . wherein the verbal query causes the Bluetooth-enabled external device to obtain the response to the verbal query via the Internet.” (Ex. 1002, 77, 71, 32-33). During prosecution, Patent Owner presented arguments against the rejections, amended independent claim 1 to further recite “by searching the Internet for the response to the verbal query,” and similarly amended the other independent claims. (*Id.*, 59-62, 64-65). The Examiner then allowed the claims. (*Id.*, 27-34).

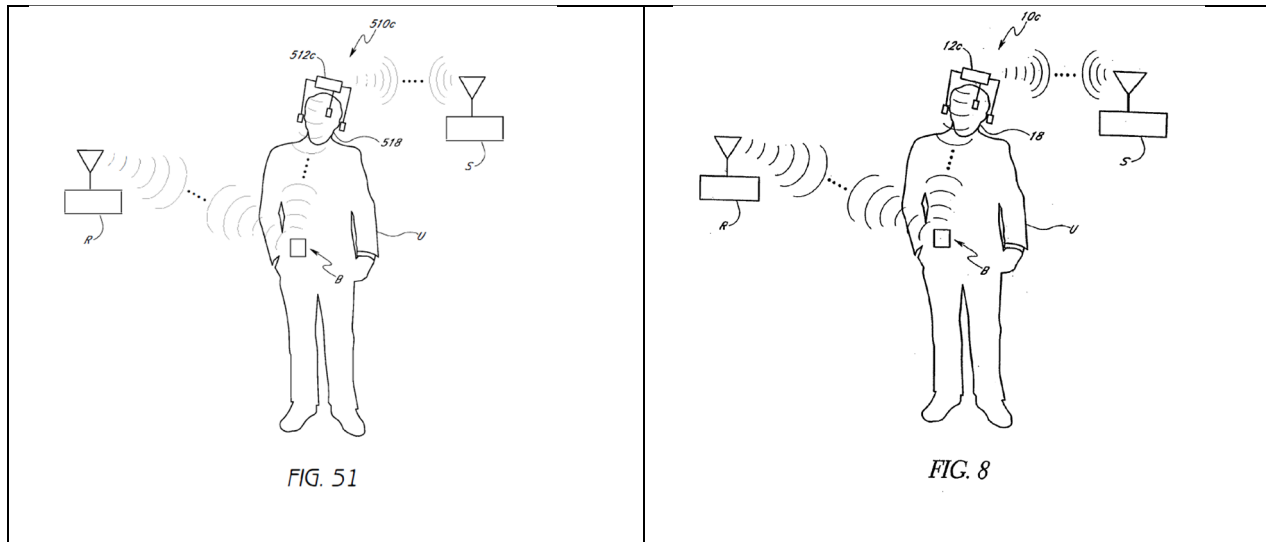
Petitioner now contends that Jannard-740 alone renders obvious all elements of the independent claims. *See* Pet., 24. However, Petitioner relies on portions of Jannard-740 to teach the claimed verbal query and response that are ***substantively the same*** as disclosures in Jannard-382.² For example, Petitioner contends that “Jannard-740 describes an example where a module communicates with an external device, which in turn communicates with a remote network, such as an internet

¹ There was an additional rejection of application claim 7 over U.S. Application No. 2011/0065428 (“Schroeter”). (*Id.*, 85-86). The subject matter of application claim 7 was eventually incorporated into issued claim 1.

² Petitioner also relies ***directly*** on Jannard-382 (Ex. 1017) throughout the relevant section of the petition. *See* Pet. 65-69.

service provider.” (Pet., 66-67)(citing Ex. 1005, [0193]-[0195], Fig. 51)(see also Pet. 68-69)(relying on same). A side-by-side comparison of Jannard-740, paragraphs [0193]-[0195], and Figure 51 and the equivalent disclosures in Jannard-328 is provided below:

<i>Compare</i> Jannard-740 (Ex. 1005)	<i>with</i> Jannard-382 (Ex. 1017)
[0193] As illustrated in FIG. 51, an audio device 510C can be worn on the head 518 of a user U. Preferably, the audio device 510C is configured to provide one or two-way wireless communication with a source device, or the source device can be incorporated into the audio device 510C. The source device can be carried by the user U, mounted to a moveable object, stationary, or part of a local area or personal area network.	[0174] As illustrated in FIG. 8, the audio device 10C can be worn on the head 18 of a user U. Preferably, the audio device 10C is configured to provide one or two-way wireless communication with a source device, or the source device can be incorporated into the audio device 10C. The source device can be carried by the user U, mounted to a moveable object, stationary, or part of a local area or personal area network.
[0194] The user U can carry a “body borne” source device B such as, for example, but without limitation, a cellular phone, an MP3 player, a “two-way” radio, a palmtop computer, or a laptop computer. As such, the user U can use the audio device 510C to receive and listen to audio signals from the source device B, and/or transmit audio signals to the source device B. Optionally, the audio device 510C can also be configured to transmit and receive data signals to and from the source device B, described in greater detail below.	[0175] The user U can carry a “body borne” source device B such as, for example, but without limitation, a cellular phone, an MP3 player, a “two-way” radio, a palmtop computer, or a laptop computer. As such, the user U can use the audio device 10C to receive and listen to audio signals from the source device B, and/or transmit audio signals to the source device B. Optionally, the audio device 10C can also be configured to transmit and receive data signals to and from the source device B, described in greater detail below.
[0195] Optionally, the device B can also be configured to communicate, via long or short range wireless networking protocols, with a remote source R. The remote source R can be, for example, but without limitation, a cellular phone service provider, a satellite radio provider, or a wireless internet service provider. For example, but without limitation, the source device B can be configured to communicate with other wireless data networks such as via, for example, but without limitation, long-range packet-switched network protocols including PCS, GSM, and GPRS. As such, the audio device 510C can be used as an audio interface for the source device B. For example, but without limitation, where the source device B is a cellular phone, the user U can listen to the audio output of the cellular phone, such as the voice of a caller, through sound transducers in the audio device 510C. Optionally, the user U can send voice signals or commands to the cellular phone by speaking into a microphone on the audio device 510C, described in greater detail below. Thus, the audio device 510C may advantageously be a receiver and/or a transmitter for telecommunications.	[0176] Optionally, the device B can also be configured to communicate, via long or short range wireless networking protocols, with a remote source R. The remote source R can be, for example, but without limitation, a cellular phone service provider, a satellite radio provider, or a wireless internet service provider. For example, but without limitation, the source device B can be configured to communicate with other wireless data networks such as via, for example, but without limitation, long-range packet-switched network protocols including PCS, GSM, and GPRS. As such, the audio device 10C can be used as an audio interface for the source device B. For example, but without limitation, where the source device B is a cellular phone, the user U can listen to the audio output of the cellular phone, such as the voice of a caller, through sound transducers in the audio device 10C. Optionally, the user U can send voice signals or commands to the cellular phone by speaking into a microphone on the audio device 10C, described in greater detail below. Thus, the audio device 10C may advantageously be a receiver and/or a transmitter for telecommunications.



As can be seen from the above, the disclosures are substantively identical—the only differences are in the reference numbers. The table below provides a correspondence between Jannard-740 paragraphs relied upon the relevant section of the Petition and the corresponding portion of Jannard-382 with the same substantive content:

<i>Compare</i> Jannard-740 (Ex. 1005) (See Pet. 65-69)	<i>with</i> Jannard-382 (Ex. 1017)
[0185]	[0009]
[0188]-[0189]	[0082]-[0083]
[0192]	[0136]
[0193]-[0195]	[0174]-[0176]

[0196]	[0177]
[0198]	[0179]
[0202]	[0191]
[0208]	[0202]
[0211]	[0205]
[0220]	[0214]
[0236]	[0301]
[0240]	[0318]
Fig. 49	Fig. 3A
Fig. 51	Fig. 8

Petitioner thus now relies on effectively the same disclosures in Jannard-740 that were before the Examiner in Jannard-382. Because of this, Petitioner’s suggestion that Jannard-740 has key additional disclosures relevant to its alleged teaching of the claimed verbal query that were not before the Examiner is inaccurate. *See* Pet., 88.

Despite the fact that Petitioner now relies on disclosures that were before the Examiner, and thus the petition relies on “substantially the same prior art” as was before the Examiner, Petitioner makes no attempt to explain how the Office erred in the consideration of Jannard-382. Petitioner has thus not carried its burden to

demonstrate material error by the Office. *See Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 9-11 (PTAB Feb. 13, 2020) (precedential). For this reason, the Office should exercise its discretion under 325(d) to deny institution. *See, e.g., ABS Glob., Inc. v. Cytonome/ST LLC*, IPR2021-00306, Paper 13 at 13-16 (PTAB June 7, 2021).

II. CONCLUSION

Patent Owner respectfully request that the Board deny institution of the present petition.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Patent Owner's Preliminary Response, together with all exhibits and other documents filed therewith, was served by filing the documents through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via electronic mail, using the following addresses:

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the foregoing Patent Owner Preliminary Response review contains 718 words according to the word processing program used to prepare it.

Date: March 19, 2025

/Elizabeth A. Laughton/ (RN 70,484)