

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LUXOTTICA OF AMERICA INC.,  
Petitioner,

v.

E-VISION SMART OPTICS, INC.,  
Patent Owner.

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IPR2025-00216  
Patent 11,487,138 B2

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Before RICHARD H. MARSCHALL, JOHN D. HAMANN, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Luxottica of America Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 11,487,138 B2 (Ex. 1001, “the ’138 patent”). Paper 2 (“Pet.”). E-Vision Smart Optics, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2023); *see* 37 C.F.R. § 42.108 (2024). Upon consideration of the papers, we conclude that the information presented shows that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’138 patent.

### A. Real Parties in Interest

Petitioner states that “Luxottica of America Inc. and Luxottica Group S.p.A. are the real parties in interest for Petitioner,” and that “[t]he parent company of each . . . is EssilorLuxottica S.A.” Pet. 89. Patent Owner states that it is the real party in interest. Paper 5, 1.

### B. Related Matters

Petitioner identifies *e-Vision Optics, LLC v. Luxottica Group S.p.A.*, No. 8:23-cv-02013 (C.D. Cal.) and *e-Vision, LLC v. Lenovo Group Ltd.*, No. 8:23-cv-01860 (C.D. Cal.), in which Patent Owner asserts related U.S. Patent No. 10,598,960 B2, as matters that may affect, or be affected by, a decision in this proceeding. Pet. 89–90.

*C. The Challenged Patent*

The '138 patent “is directed to electronic eyewear modules and systems to be worn by a wearer, whereby an electronic eyewear system with a docking station can be easily joined with a plurality of electronic application modules.” Ex. 1001, 1:66–2:4. Figure 3, shown below, illustrates an embodiment of the '138 patent.

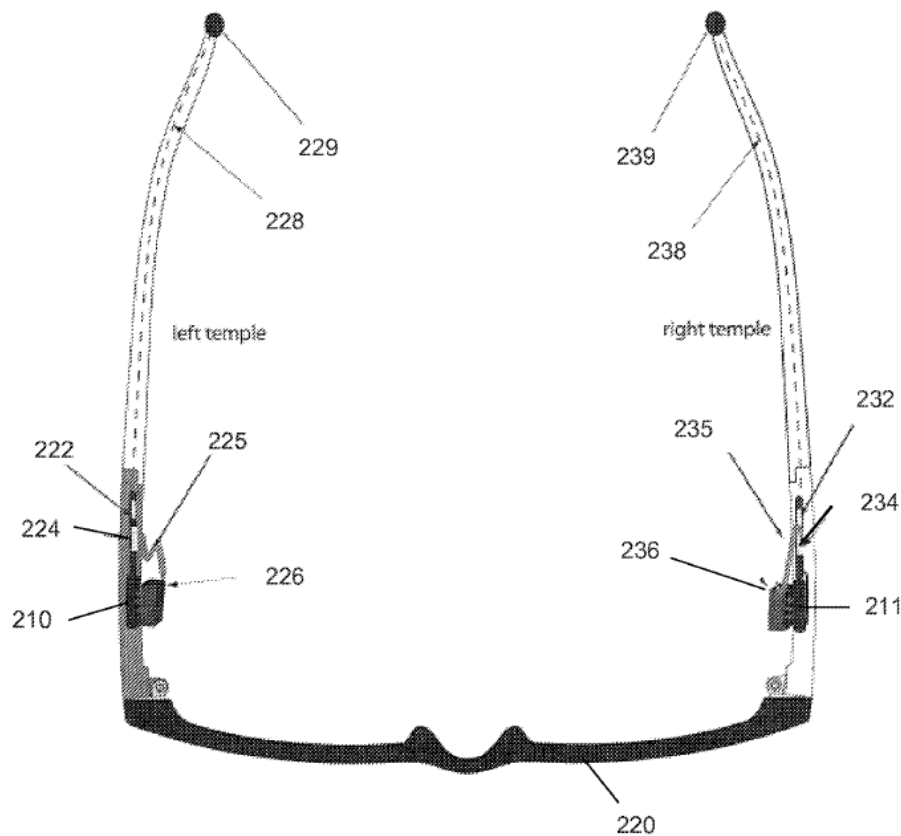


**FIG. 3**

Figure 3 “is a top-down view of an exemplary frame including earbuds and docked application modules connected to connection points of the frame in accordance with” the '138 patent. *Id.* at 6:1–4. As illustrated, “an eyewear frame includ[es] lens holder 220, and left and right temple portions.” *Id.* at 12:17–19. “Each of the left and right temple portions include a docking station 210, 211, and a docked application module 226, 236, respectively,

adapted to be mounted to the docking station.” *Id.* at 12:19–22. In addition, “each of the left and right temple portions also includes an electronic connector 225, 235, respectively, including a first set of preconfigured application connection points and associated conductive paths, configured to connect application connection points of the modules to the eyewear.” *Id.* at 12:22–28. As illustrated, “electronic connectors 225, 235 can be connected at one end to . . . application modules [226, 236], and at the other end to electronics modules 224, 234 of the eyewear frame.” *Id.* at 12:41–44. In addition, “power sources 222, 232 in each of the temple portions” “may be connected to application modules 226, 236 to provide operating and/or rechargeable power.” *Id.* at 13:42–45.

“Preferably, more robust processing may be included in electronics modules of the frame, thereby reducing the size and/or data or power requirements of the docked application module.” *Id.* at 12:53–56. “Electronics modules 224, 234, or other functional devices included in the eyewear, such as electronic lenses, cameras, displays, microphones, speakers, etc., may be referred to as functional member(s) of the eyewear.” *Id.* at 12:56–60. “The application modules 226, 236 and/or electronics modules 224, 234 may include[, *inter alia*,] one or more of still photo camera, video camera, digital audio player, display, . . . hearing aid, cell phone, audio system, communication system, [and] video system.” *Id.* at 12:61–13:5. Also as illustrated, “the eyewear frame may include a speaker, such as earbuds 229, 239, and one or more of the modules may be configured to provide an audio signal to the speaker(s) via audio connectors 228, 238.” *Id.* at 13:22–25.

In addition, the ’138 patent explains that “[t]he application module which is docked within the docking station can comprise a wireless chip . . .

to enable wireless communication between the docked application device module (application module) and a remotely located device, such as” a smart phone or computer. *Id.* at 19:4–11. “Various wireless means are well known and understood in the communication art, [such as] Bluetooth.” *Id.* at 19:14–16. Moreover, the application module can provide “desired functionality for the wearer by way of the application device module which is docked within the docking station.” *Id.* at 19:65–20:2. For example, “an application module being that of a wireless enabled personal assistant module docked within the docking station of the inventive eyewear (upon a verbal question raised orally by the wearer of the inventive eyewear about the weather) by way of a miniature microphone, voice recognition chip contained within the personal assistant device module and also a wireless chip or circuit also contained within the personal assistant device module could communicate to the wearer’s wireless enabled computer or smart phone to address any number of questions of the wearer” (e.g., “to look up the weather on the internet wirelessly and then answer the question about the weather thru the speakers or ear buds located within the inventive eyewear”). *Id.* at 20:2–16.

#### *D. The Challenged Claims*

Petitioner challenges claims 1–20 in this proceeding. Claims 1, 6, and 12 are independent claims. Claim 1 is illustrative of the challenged claims and is reproduced below:

1. Eyewear comprising:  
an eyewear frame having a first temple and a second temple;  
a speaker coupled to the eyewear frame; and  
an application module mechanically coupled to the eyewear frame and operably coupled to the speaker, the application module comprising:

a microphone to receive a verbal query from a wearer of the eyewear; and

a Bluetooth chip, operably coupled to the microphone and the speaker, to connect to a Bluetooth-enabled external device, to transmit the verbal query to the Bluetooth-enabled external device, to receive a response to the verbal query from the Bluetooth-enabled external device, and to provide the response to the wearer via the speaker,

wherein the verbal query causes the Bluetooth-enabled external device to obtain the response to the verbal query via the Internet by searching the Internet for the response to the verbal query.

Ex. 1001, 24:54–25:6.

*E. Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims of the '138 patent are unpatentable based on the following eight grounds:

| Claim(s) Challenged | 35 U.S.C. § <sup>1</sup> | Reference(s)/Basis                      |
|---------------------|--------------------------|-----------------------------------------|
| 1–20                | 103(a)                   | Thiel, <sup>2</sup> Gruber <sup>3</sup> |
| 5                   | 103(a)                   | Thiel, Gruber, Maddern <sup>4</sup>     |
| 8                   | 103(a)                   | Thiel, Gruber, Lu <sup>5</sup>          |
| 1, 5, 6, 8, 11–16   | 103(a)                   | Jannard <sup>6</sup>                    |
| 5                   | 103(a)                   | Jannard, Maddern                        |
| 7, 17, 18           | 103(a)                   | Jannard, Osterhout <sup>7</sup>         |

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. Because the '138 patent issued from an application claiming an effective filing date before March 16, 2013, we apply the pre-AIA version of the statutory basis for unpatentability.

<sup>2</sup> US 2010/0272304 A1, published Oct. 28, 2010 (Ex. 1028, “Thiel”).

<sup>3</sup> US 2012/0016678 A1, published Jan. 19, 2012 (Ex. 1024, “Gruber”).

<sup>4</sup> US 2010/0330908 A1, published Dec. 30, 2010 (Ex. 1029, “Maddern”).

<sup>5</sup> US 2019/0081937 A1, published Mar. 14, 2019 (Ex. 1031, “Lu”).

<sup>6</sup> US 2012/0105740 A1, published May 3, 2012 (Ex. 1005, “Jannard”).

<sup>7</sup> US 2011/0214082 A1, published Sept. 1, 2011 (Ex. 1006, “Osterhout”).

| Claim(s) Challenged | 35 U.S.C. § <sup>1</sup> | Reference(s)/Basis       |
|---------------------|--------------------------|--------------------------|
| 1–20                | 103(a)                   | Jannard, Gruber          |
| 5                   | 103(a)                   | Jannard, Gruber, Maddern |

Pet. 24, 27–87. Petitioner submits in support of its arguments the Declaration of John Feland, Ph.D. (Ex. 1003).

In addition, Petitioner argues that although “[t]he ’138 patent’s earliest claimed priority date is January 6, 2012,” “the priority provisional application filed on that day does not support the claim limitation ‘by searching the Internet for the response to the verbal query,’ as recited in independent claim 1, nor does it support similar limitations in the other independent claims.” Pet. 24–25 (citing Ex. 1003 ¶ 60). Rather, “the ’138 patent’s claims are entitled to a priority date of no earlier than April 10, 2012,” according to Petitioner. *Id.* at 25. Petitioner, however, does not explain why this alleged date difference matters, if at all, to any of its arguments.

In addition, Petitioner argues that the ’138 patent “is not entitled to pre-AIA status” “because claim 8’s effective filing date is in 2020.” *Id.* More specifically, Petitioner argues that “[c]laim 8 recites ‘pairing the Bluetooth wireless chip with the external device before transmitting the verbal query to the external device,’” for which “none of the priority applications of the ’138 patent provide sufficient written description support.” *Id.* (citing Ex. 1003 ¶ 61). “Therefore, claim 8’s effective filing date is the ’138 patent’s actual filing date, March 16, 2020,” according to Petitioner. *Id.* Petitioner, however, does not explain which of its arguments, if any, depend on what version (pre-AIA or AIA) of the statutory basis we apply. Regardless, at this stage, we find that Petitioner sufficiently shows that the claims are unpatentable under either version of the statutory basis.

Lastly, at this stage, we do not turn to what is the effective filing date of claim 8 for prior art purposes, which impacts the Thiel, Gruber, and Lu ground (i.e., whether Lu is prior art). Because we find that Petitioner makes a sufficient showing for at least one challenged claim on other grounds, we institute on all grounds and all claims raised in the Petition. 37 C.F.R. § 42.108(a). Thus, in our view, this issue is best left for trial after full development of the record.

## II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(D)

The parties present arguments concerning the Board's potential exercise of discretion under 35 U.S.C. § 325(d). Pet. 88–89; Prelim. Resp. 3–8. In evaluating these arguments, we use a two-part framework, with the first part being whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (addressing in a two part framework the factors presented in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III(C)(5), first paragraph)). As we discuss below, we are not persuaded that the first part of the framework is met.

Here, Patent Owner argues that Jannard is substantially the same as Jannard382,<sup>8</sup> which was before the Office. Prelim. Resp. 3–8. Notably, Patent Owner does not argue that Thiel, Gruber, Maddern, Lu, or Osterhout previously were presented to the Office—Petitioner argues that they were

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<sup>8</sup> US 2006/0132382 A1, published June 22, 2006 (Ex. 1017, “Jannard382”). Jannard is a continuation-in-part of Jannard382.

not (Pet. 88). Nor does Patent Owner argue that any of these five additional references are cumulative of previously presented art. *See* Prelim. Resp. Rather, Patent Owner remains silent as to these five references. In addition, Patent Owner does not address whether the same or substantially the same arguments previously were presented to the Office. *Id.*

In light of the above, we find that the first part of the *Advanced Bionics* framework is not met for at least seven of the eight asserted grounds. More specifically, there is no dispute that three grounds, which collectively challenge all claims of the '138 patent, do not include Jannard. Nor do we find persuasive Patent Owner's argument that "[f]ive of the [P]etition's eight [g]rounds are based on the Jannard[] reference." Prelim. Resp. 3 (citing Pet. 24). Four of those five grounds include additional references, for which there is no allegation that they were previously presented to the Office. And these four grounds also collectively challenge all of the claims of the '138 patent. Moreover, the Jannard ground challenges only ten of the twenty challenged claims. Pet. 24.

Under the circumstances present here, including that the remaining seven grounds<sup>9</sup> collectively cover all of the challenged claims, we determine that the statutory purpose of § 325(d) is not sufficiently implicated so as to be undermined by instituting on all challenges. *See* Consolidated Trial Practice Guide (November 2019)<sup>10</sup> 62 ("Whether to deny institution of trial on the basis of 35 U.S.C. § 325(d) is a fact-dependent decision, in which the Board balances the petitioner's desire to be heard against the interest of the

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<sup>9</sup> In fact, the (i) Thiel and Gruber and (ii) Jannard and Gruber grounds each challenged all of the claims (i.e., 1–20) of the '138 patent. Pet. 24.

<sup>10</sup> *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

patent owner in avoiding duplicative challenges to its patent,” and “takes into account the ‘efficient administration of the Office’”).

In sum, in light of the above, we decline to exercise discretion to deny institution under § 325(d).

### III. LEVEL OF ORDINARY SKILL IN THE ART

To determine whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). In assessing the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citing *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962–63 (Fed. Cir. 1986)). “[O]ne or more factors may predominate.” *Id.*

Petitioner argues that one of ordinary skill in the art “would have had at least a bachelor’s degree in mechanical or manufacturing engineering; mechatronics; electrical engineering plus coursework in mechanical engineering, manufacturing engineering, or mechatronics; or a similar technical degree,” and “at least 2 years of experience designing eyewear and/or consumer electronics.” Pet. 22–23 (citing Ex. 1003 ¶ 28). Petitioner adds that “[w]ork experience could substitute for formal education and additional formal education could substitute for work experience.” *Id.* at 23.

Patent Owner does not identify a level of skill in the art that one would have had at the time of the invention of the ’138 patent or identify any shortcoming in Petitioner’s formulation. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner’s definition of the level of skill for one of ordinary skill in the art. Pet. 22–23. We view this definition for the level of ordinary skill as consistent with the ’138 patent and the asserted prior art, and we apply it in our analysis below.

#### IV. CLAIM CONSTRUCTION

Because the Petition was filed after November 13, 2018, we apply the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), following the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b); 83 Fed. Reg. 51,340, 51,340–41, 51,343 (Oct. 11, 2018). In applying such standard, claim terms generally are given their ordinary and customary meaning, as would be understood by a person of ordinary skill in the art, at the time of the invention and in the context of the entire patent disclosure. *Phillips*, 415 F.3d at 1312–13. “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Here, neither party sets forth any term for claim construction. Pet. 23–24; *see* Prelim. Resp. Thus, for purposes of this Decision, we afford the claim terms their plain and ordinary meaning. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’”).

## V. PRINCIPLES OF LAW

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time of the invention to a person having ordinary skill in the art. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness, if present.<sup>11</sup> *See Graham*, 383 U.S. at 17–18. When evaluating a claim for obviousness, we also must “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## VI. ALLEGED OBVIOUSNESS OF CLAIM 1 OVER THIEL AND GRUBER

### A. *Summary of Thiel*

Thiel “relates to a flexible eyewear retention device with an integrated audio device.” Ex. 1028 ¶ 2. More specifically, Thiel provides “[a]n eyewear retention device having integrated electronics to transmit sound to the ear or ear surfaces.” *Id.* ¶ 10. Thiel teaches that “the eyewear retention device may employ Bluetooth technology and/or wireless technology and be capable of transmitting one or more audio signals received from a sound transmission device, such as a cellular telephone, . . . mobile communications device or other audio transmission device.” *Id.* Moreover,

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<sup>11</sup> Patent Owner does not present arguments or evidence of such objective evidence of non-obviousness. *See Prelim. Resp.*

Thiel teaches that its eyewear retention device may include an audio transceiver which comprises a microphone to receive voice signals from a user for communication to a remote device via a Bluetooth wireless link to connect to a mobile phone. *Id.* ¶ 43.

*B. Summary of Gruber*

Gruber “relates to intelligent systems, and more specifically for classes of applications for intelligent automated assistants.” Ex. 1024 ¶ 4. More specifically, Gruber teaches that “an intelligent automated assistant is implemented on an electronic device, to facilitate user interaction with a device, and to help the user more effectively engage with local and/or remote services.” *Id.* ¶ 8. “In various embodiments, the intelligent automated assistant engages with the user in an integrated, conversational manner using natural language dialog, and invokes external services when appropriate to obtain information or perform various actions.” *Id.*

*C. Challenged Claim 1*

Petitioner argues that the combination of Thiel and Gruber renders claim 1 obvious. Pet. 27–39. Petitioner supports its arguments with citations to Thiel and Gruber’s specific teachings and the testimony of Dr. Feland. *Id.* Patent Owner does not address Petitioner’s arguments at this stage. *See* Prelim. Resp.

After reviewing Petitioner’s arguments and cited evidence, at this stage, we are persuaded that Petitioner sufficiently demonstrates that the limitations of claim 1 are taught by the combination of Thiel and Gruber. We also find, at this stage, that Petitioner has provided sufficiently articulated reasoning with rational underpinning to support combining Thiel and Gruber’s teachings in the manner Petitioner proposes.

In sum, at this stage, we determine that Petitioner shows a reasonable likelihood that it would prevail in showing that claim 1 would have been obvious to one of ordinary skill in the art in view of Thiel and Gruber.

#### VII. ANALYSIS OF OTHER CLAIMS AND GROUNDS

Because Petitioner demonstrates a reasonable likelihood of success in proving that at least one claim of the '138 patent is unpatentable, we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner, especially, as in this case, when Patent Owner does not address the merits of Petitioner's arguments for any claim for any ground. Those challenges, in our view, are best left for trial after full development of the record.

#### VIII. CONCLUSION

For the foregoing reasons, we determine that Petitioner has shown a reasonable likelihood that it would prevail in proving the unpatentability of at least one of the challenged claims of the '138 patent. We thus institute an *inter partes* review of all of the challenged claims on all grounds asserted in the Petition.

Any findings or conclusions in this Decision are made only for the purposes of institution and are not dispositive of any issue. We have not made a final determination with respect to the patentability of any challenged claim. Our final determination will be based on the record as fully developed during trial, including any evidence or argument timely presented by the parties under our Rules.

IX. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the '138 patent is instituted on all of the challenged claims and all grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this Decision.

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