

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

20/20 VISION CENTER, LLC,

Petitioner,

v.

DIGITALOPTOMETRICS, LLC,

Patent Owner.

PGR 2018-00100
Patent 9,980,644 B2

RECORD OF ORAL HEARING
Held: January 23, 2020

Before PATRICK M. BOUCHER, CHRISTOPHER G. PAULRAJ, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

PGR 2018-00100
Patent 9,980,644 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

ALEXANDER WARDEN, ESQUIRE
Bryan Cave Leighton Paissler
1290 Avenue of the Americas
New York, NY 10104

ON BEHALF OF THE PATENT OWNER:

ROBERTO DEVOTO, ESQUIRE
KARL RENNER, ESQUIRE
Fish & Richardson
1425 K Street, N.W.
11th Floor
Washington, D.C. 20005

The above-entitled matter came on for hearing on Thursday, January 23, 2020, commencing at 12:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Chris Hofer, Notary Public.

P R O C E E D I N G S

- - - - -

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

JUDGE PAULRAJ: Good afternoon. We're here for IPR 2018-00100. I'm Judge Paulraj and we have the other two judges participating remotely today. On the left side of the screen here is Judge Patrick Boucher from our Denver office and on the right hand side of the screen is Judge Matthew Meyers from St. Louis. So let's start with appearances, so Petitioner's counsel first and then Patent Owner's counsel.

MR. WALDEN: Good afternoon, Your Honors Alexander Walden of Bryan Cave Leighton Paissner, LLP, on behalf of Petitioner 20/20 Vision Center, LLC.

MR. RICHETTI: Joseph Richetti for 20/20 Vision Center, LLC.

MR. DEVOTO: Thank you, Your Honors. This is Roberto Devoto from Fish & Richardson on behalf of Patent Owner. We also have my colleague, Karl Renner, from Fish & Richardson as well as my other colleague, Ryan Chowdhury, from Fish & Richardson. Karl Renner and I will be doing most of the speaking. Ryan will be providing support today.

JUDGE PAULRAJ: All right, thank you, Mr. Devoto. So as per our Oral Hearing Order, each side will have 40 minutes to present their arguments. We are in receipt of the modified demonstratives that were sent by email today. If you're going to refer to those demonstratives, please make sure to identify the specific slide number as the remote judges won't necessarily be able to see what's being shown on the screen in the room here. I trust the parties have resolved any objections to the demonstratives but if you're going to object any further, I would like you to save those objections

1 until the end of the presentation. I don't want to take up the parties'
2 argument time with resolving objections; is that clear? All right, with that
3 let's start with Petitioner's arguments. How much time would you like to
4 reserve?

5 MR. WALDEN: Fifteen minutes, please.

6 JUDGE PAULRAJ: All right. Thank you. So I have set the
7 count down clock for 25 minutes here and then I think the clock should
8 change colors when you have one minute left. With that, whenever you're
9 ready.

10 MR. WALDEN: Good afternoon, Your Honors. The 644
11 patent which is the subject of this PGR proceeding is generally directed to,
12 and I'm sorry, I'm on slide 1 of the demonstratives, will try and remember to
13 do that. The 644 patent is generally directed to techniques for allowing eye
14 examinations to be performed remotely with three individuals, so one local
15 person and two remote individuals so that's apparent on the slide from the
16 way that the system is described generally. You've got a local on-site
17 technician who's there at the diagnostic center. You've got a remote
18 technician who's located remotely as it sounds, as well as a remote eyecare
19 doctor who's also remote and these three people together perform administer
20 an eye exam.

21 So moving on to slide 2, there's really no dispute about this. On
22 this slide we see in a couple of places how the Patent Owner has
23 characterized the claim system and again it's enabling remote -- you can see
24 in the top box -- enabling remote eye exams in which two remote individuals
25 collaborate to administer a remote eye examination for a patient located at a

1 diagnostic center and below talking specifically about claims 12 through 20
2 which are the ones that remain at issue. They categorize it as a procedure
3 that involves three types of individuals in the administration of the eye
4 exam, one local individual, two remote.

5 So at the beginning of this proceeding, moving on to slide 3 just
6 to kind of set the framework for what's left in this proceeding, at the
7 beginning there were claims 1 through 20 in the 644 patent. There were
8 seven grounds raised in the petition to demonstrate why all of those claims,
9 claims 1 through 20 were unpatentable under various sections of 35 U.S.C.
10 and at this point we move on to slide 4 we can see that Patent Owner has
11 now disclaimed -- in response to the Institution decision -- they've now
12 disclaimed claims 1 through 11 and that was the first claim set. There were
13 really two claim sets. There were two independent claims, claim 1 and
14 claim 12, a little bit different and 2 through 11 depended off 1 and 13
15 through 20 depend off 12. So they disclaimed the first set and the other
16 thing we see in the Patent Owner response as well as the surreply is that
17 there's no separate arguments. Patent Owner hasn't advanced any separate
18 arguments specific to dependent claims 13 through 20. So really what's left
19 and what we're finding about here today is just independent claim 12. So
20 claims 12 through 20 are all going to rise and fall with the patentability of
21 independent claim 12. If we move to slide 7. The parties -- sorry.

22 JUDGE PAULRAJ: On that point counsel, I just want to
23 confirm that given that ground 1 only focused on the disclaimed claims 1
24 through 11, the 101 grounds, that's a moot issue at this point, correct?

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.