

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

20/20 VISION CENTER, LLC,
Petitioner,

v.

DIGITALOPTOMETRICS LLC,
Patent Owner.

PGR2018-00100
Patent 9,980,644 B2

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

MEYERS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 328(a)

I. INTRODUCTION

A. OVERVIEW

20/20 Vision Center, LLC (“Petitioner”) filed a Petition requesting a post-grant review of claims 1–20 of U.S. Patent No. 9,980,644 B2 (Ex. 1001, “the ’644 patent”).¹ Paper 2 (“Pet.”). DigitalOptometrics LLC (“Patent Owner”) filed its Mandatory Notices in response to the Petition (Paper 5), but did not file an optional Preliminary Response. *See* 37 C.F.R. § 42.207 (2018) (“The patent owner *may* file a preliminary response to the petition.”) (emphasis added).²

On April 17, 2019, we issued a Decision ordering that “pursuant to 35 U.S.C. § 324, a post grant review of the ’644 patent is instituted as to claims 1–20 based on the unpatentability grounds set forth in the Petition.” Paper 7 (“Dec.”), 48. After institution, Patent Owner filed a Patent Owner’s Response (Paper 15; “PO Resp.”) and a statutory disclaimer of claims 1–11³

¹ Petitioner identifies itself as the real party in interest. Pet. 1.

² Patent Owner identifies itself as the real party in interest. Paper 5, 2.

³ The July 2019 Trial Practice Guide Update notes that “a patent owner may file a statutory disclaimer of one or more challenged claims to streamline the proceedings. Where no challenged claims remain, the Board would terminate the proceeding. Where one or more challenged claims remain, the Board’s decision on institution would be based solely on the remaining claims. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1315 (Fed. Cir. 2016); *Sony Computer Entm’t Am. Inc. v. Dudas*, 2006 WL 1472462 (E.D. Va. May 22, 2006).” Trial Practice Guide Update 21 (July 2019) (“July 2019 Trial Practice Guide Update”), <https://www.uspto.gov/TrialPracticeGuide3>; *see also* Office Patent Trial Practice Guide, July 2019 Update, 84 Fed. Reg. 33,925 (July 16, 2019); Patent Trial and Appeal Board Consolidated Trial Practice Guide 52 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

(Ex. 2005). Petitioner filed a Petitioner’s Reply to Patent Owner’s Response (Paper 20; “Pet. Reply”), and Patent Owner filed a Patent Owner’s Sur-Reply (Paper 21; “PO Sur-Reply.”). An oral hearing was held on January 23, 2020. Paper 25 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R § 42.73. After reviewing all relevant evidence and assertions, we determine that Petitioner has proven, by a preponderance of the evidence, that claims 12–20 of the ’644 patent are unpatentable.

B. RELATED PROCEEDINGS

Petitioner and Patent Owner represent that the ’644 patent is not involved in any other matters. Pet. 1; Paper 5, 2.

C. THE ’644 PATENT (EX. 1001)

The ’644 patent is titled “REMOTE COMPREHENSIVE EYE EXAMINATION SYSTEM.” Ex. 1001, code (54). The ’644 patent relates to a remote-based eye testing system that does not require an optometrist or ophthalmologist, i.e., a doctor, to be on-site when a patient receives a comprehensive eye examination. *Id.* at 1:64–66. Instead of an optometrist or ophthalmologist, the ’644 patent discloses that

an ophthalmic technician is present with the patient in the exam room to operate eye examination equipment and transmit patient information to [a] remote location. At that remote location, a skilled technician is present to provide the necessary optical and/or medical care, and may operate the phoropter from the remote location if he/she desires. Using video and/or teleconferencing equipment and a phoropter located in the patient examination room along with management software, the

system works to determine the final optical prescription for the patient. That information, coupled with findings from other devices which are integrated with the management software, and that the patient uses locally, are reviewed by a remote based optometrist or ophthalmologist.

While the patient is being evaluated for eyeglasses or contacts, the optometrist or ophthalmologist may also operate the phoropter located in the patient examination room from the remote location if he/she desires and evaluate the patient for other ocular-related medical issues. Once the findings are finalized by the optometrist or ophthalmologist remotely, the final prescription for eyeglasses and/or contact lenses, along with any additional comments or findings, will print locally at the examination location and be delivered to the patient.

Id. at 1:67–2:23.

The '644 patent describes that its system comprises “exam site 1100, central server (exam site and remote technician connection) 1200, remote technician 1300, remote doctor 1400, and central server (remote doctor connection) 1500.” *Id.* at 8:22–26. In this regard, the '644 patent describes that the patient, the local technician, and the phoropter are located at the exam site or local diagnostic center. *Id.* at 9:28–45, 14:41–44, 17:38–40. The '644 patent discloses that “[t]he local technician in the system is always physically located at the exam site. The local technician takes care of registering the patient, collecting patient history, and walking the patient through the entire exam process.” *Id.* at 19:63–66. The '644 patent further discloses that “[t]he local technician also performs the initial pre-refraction tests prior to the actual refraction by a remote technician and the final review by a remote doctor.” *Id.* at 19:66–20:2.

The '644 patent also discloses that “[t]he remote technicians in the system are responsible for performing the subjective refraction part of the

eye exam prior to the patient being transferred to the remote doctor.” *Id.* at 25:17–19. The ’644 patent discloses that “[t]he remote doctors in the system are responsible for evaluating the results of all tests performed during the eye examination process and they may optionally verify or refine the subjective refraction performed by the remote technician.” *Id.* at 28:42–46. The ’644 patent describes that both the remote technician and the remote doctor may control the phoropter equipment located at the exam site from their respective remote locations. *Id.* at 25:20–23, 48:46–49.

In some embodiments, the ’644 patent discloses that “the eyecare doctor, the remote technician and the local technicians are in different locations.” *Id.* at 17:48–50. However, the ’644 patent also discloses that while the patient and the local technician are located together at a local diagnostic center, the remote technician and the remote doctor may be located at the same remote location, i.e.,

[t]he patient is then assigned to a remote eyecare technician (possibly by the local technician), where the remote eyecare technician is located at *a first remote diagnostic center*. The patient is finally assigned (possibly by the local technician) to a eyecare doctor, where the eyecare doctor is located at *a second remote diagnostic center*, which may or may not be *the same remote diagnostic center as the first remote diagnostic center*.

Id. at 17:38–50 (emphases added).

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