

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

20/20 VISION CENTER, LLC,
Petitioner,

v.

DIGITALOPTOMETRICS LLC,
Patent Owner.

Case 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*.

DECISION

Granting Institution of Post Grant Review

35 U.S.C. § 324(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 (“The patent owner *may* file a preliminary response to the petition.”) (emphasis added).²

Institution of post grant review is authorized by statute only when “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324; *see* 37 C.F.R. § 42.4. Petitioner challenges the patentability of the ’644 patent under 35 U.S.C. §§ 101, 112(a), 112(b), 102, and 103. After considering the Petition, as well as all supporting evidence, we conclude that Petitioner has satisfied its burden under 35 U.S.C. § 324 to show that it is more likely than not that at least 1 of the claims challenged in the Petition is 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.

¹ Petitioner identifies 20/20 Vision Center, LLC as the real party in interest. Pet. 1.

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

C. THE '644 PATENT (EX. 1001)

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

[i]nstead, 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 “[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. *See id.* at 25:20–23, 48:46–49.

The ’644 patent discloses that “in some embodiments, the eyecare doctor, the remote technician and the local technicians are in different locations.” *Id.* 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).

D. ILLUSTRATIVE CLAIMS

Petitioner challenges claims 1–20 of the ’644 patent. Claims 1 and 12 are independent claims. Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A method comprising:

assigning a patient to a local eyecare technician, wherein the patient and the local eyecare technician are located at a local diagnostic center;

assigning, by the local eyecare technician, the patient to a remote eyecare technician, wherein the remote eyecare technician is located at a remote diagnostic center;

collecting, by the local eyecare technician, medical history for the patient;

administering, by the local eyecare technician, pre-refraction tests on the patient to produce pre-refraction results for the patient;

transmitting the medical history for the patient and the pre-refraction results for the patient to the remote eyecare technician;

administering, by the remote eyecare technician, refraction tests on the patient to produce refraction results for the patient; and

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.