

## Warby Parker Gets PTAB To Nix Obvious Eye Care Patent

By **Dani Kass**

*Law360 (September 17, 2019, 2:04 PM EDT)* -- The Patent Trial and Appeal Board has invalidated the bulk of a Visibly Inc. patent tied to figuring out a patient's vision prescription, saying eyewear company Warby Parker proved the invention was obvious.

The board issued its final written decision Monday, invalidating all but two claims in Visibly's patent. It also refused to let the eye health technology company substitute new claims to restrengthen the patent.

The patent covers a way of using a computer to determine a person's refractive error, and therefore provide him or her with the right prescription. Jand Inc., which does business as Warby Parker, challenged it in March 2018, hoping to cancel the vast majority of its claims.

Visibly, then known as Opternative Inc., had not sued the eyewear retailer for infringement, according to the petition.

PTAB agreed with Warby Parker that the patent claims were not eligible for patent protection based on a few combinations of prior art. Visibly then tried to replace the entire patent with new claims, but PTAB said those don't hold up either, as they are both indefinite and rendered obvious by the same prior art.

When saying the substitute claims were indefinite, PTAB said the proposed language "creates ambiguity," mainly as it relates to the term "distance."

The substitute claim talks about the patient's distance from the computer, a key element to correctly determining refractive error. It includes language about "guiding the person to a desired distance" and "caus[ing] the person to move towards the desired distance," but then doesn't say that the person ever reached that desired distance. The board said that creates ambiguity as to what the distance is in another part of the claim.

Administrative Patent Judges Kalyan K. Deshpande, Garth D. Baer and Kara L. Szpondowski sat on the panel for the Patent Trial and Appeal Board.

The patent-in-suit is U.S. Patent No. 9,504,378.

Warby Parker is represented by Peter P. Chen, David A. Garr and Richard L. Rainey of Covington & Burling LLP.

Visibly is represented by Barry F. Irwin and Reid P. Huefner of Irwin IP LLC.

The case is Jand, Inc. v. Opternative, Inc., case number IPR2018-00802, before the Patent Trial and Appeal Board.

--Editing by Stephen Berg.

---

All Content © 2003-2019, Portfolio Media, Inc.