

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

U.S. Patent No. 9,651,533

IPR Case No.: IPR2019-00913

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY
PURSUANT TO BOARD'S SEPTEMBER 24, 2019 ORDER**

Updated List of Exhibits

No.	Description
2001	Apple Inc.'s Final Election of Asserted Prior Art, filed in Omni MedSci, Inc. v. Apple Inc., Case No. 2:18-cv-134-RWS (E.D. Tex), May 24, 2019
2002	Scheduling Order, filed in Omni MedSci, Inc. v. Apple Inc., Case No. 2:18-cv-134-RWS (E.D. Tex), June 19, 2018
2003	Reserved
2004	Reserved
2005	Reserved
2006	US Patent App. Pub. No. 2013/0327966 A1 to Fidler et al.
2007	Claim Construction Memorandum Opinion and Order, filed in Omni MedSci, Inc. v. Apple Inc., Case No. 2:18-cv-134-RWS (E.D. Tex), June 24, 2019
2008	Reserved
2009	Reserved
2010	District Court Scheduling Notice, issued in Omni MedSci, Inc. v. Apple Inc., Case No. 2:18-cv-134-RWS (E.D. Tex), July 12, 2019
2011	Reserved
2012	Reserved
2013	District Court Docket Sheet, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex), October 3, 2019
2014	Amend Docket Control Order, issued in Omni MedSci, Inc. v. Apple Inc., Case No. 2:18-cv-134-RWS, Dkt. 142 (E.D. Tex), March 29, 2019
2015	Petition challenging U.S. 8,888,701 to LeBoeuf et al., <i>Apple Inc. v. Valencell, Inc.</i> , IPR2017-01704, Paper 2 (PTAB) June 30, 2017
2016	Order, <i>Apple Inc. and ZTE (USA) Inc., v. INVT SPE LLC</i> , IPR2018-01478, Paper 8 (PTAB) January 30, 2019
2017	Civil Minutes, issued in Windy City Innovations, LLC v. Facebook, Inc., Case No. 16-cv-01730-YGR, Dkt. 148 (N.D. Cal) January 28, 2019

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Atty. Dkt. No.: OMSC0110IPR1

No.	Description
2018	Case Management and Pretrial Order, issued in Intri-Plex Technologies, Inc., v. NHK Intl. Corp., Case No. 17-cv-01097-EMC, Dkt. 114 (N.D. Cal) May 23, 2019

Congress designed the IPR as an efficient alternative to challenging patent validity. Proceeding with these IPRs would be *inefficient* due solely to Petitioner's delays. Petitioner waited *an entire year* to file parallel sets IPR petitions against the patents asserted in the lawsuit. At least eight months earlier, Petitioner knew about and identified the prior art asserted in the IPRs. The same invalidity issues (and more) raised in the IPRs will most certainly be tried in the Northern District of California before the October 2020 deadline for a Final Written Decision ("FWD") in these IPRs. The lawsuit is *more advanced than in NHK*—the parties are in the summary judgment phase. The Board should deny the Petition under 35 U.S.C. § 314(a).

I. The Board's Finding of Facts

In addition to the facts identified by the Board, and the facts identified by Petitioner in the Reply, the following facts are also relevant.

1. All discovery ended on July 5, 2019. (Ex. 2014 at 3; Ex. 2013 at 25.)
2. The parties filed summary judgment motions. (Ex. 2013, 27-28; Ex. 2014, 3.)
3. In August 2019, the Eastern District of Texas transferred the lawsuit to the Northern District of California, which completed transfer on October 2, 2019. (Ex. 2013 at 33.)
4. The lawsuit is no longer stayed—the stay was lifted upon completion of the transfer. (Ex. 1057 at 1.)

II. Analysis of the Factors Identified by the Board

A. The merits of Petitioner's challenge

As detailed in the Patent Owner's Preliminary Response ("POPR"), Petitioner fails to meet its burden on both procedural and substantive grounds. This factor favors denying institution.

B. Any differences between the claims challenged in the District Court and the Petition

Petitioner admits that "[e]very claim asserted in the litigation has been challenged in the petition." (Reply at 3.) This factor weighs in favor of denying institution because, as discussed below, the district court will most likely resolve all invalidity issues for all asserted claims before an FWD in these IPRs.

C. The time between the District Court's expected findings on validity and any expected Board findings on patentability

The lawsuit is in the summary judgment phase and a jury decision on validity most likely will issue several months before an FWD.

The lawsuit is pending before Judge Gonzalez Rogers. The parties have filed opening summary judgment briefs. Judge Gonzalez Rogers has not yet set a schedule for the remaining briefs or a trial date, but, on January 28, 2019, in another patent case pending before Judge Gonzalez Rogers, she scheduled summary judgment motions and trial deadlines. She set trial 3.5 months after the deadline for summary judgment response briefs. (Ex. 2017.) In the present case, it is likely that trial will be completed in

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