

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case IPR2019-00913
Patent 9,651,533 B2

Before GRACE KARAFFA OBERMANN, JOHN F. HORVATH, and
SHARON FENICK, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

A. Background

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 5, 7–10, 13, and 15–17 (“the challenged claims”) of U.S. Patent No. 9,651,533 B2 (Ex. 1001, “the ’533 patent”). Paper 1 (“Pet.”), 4. Omni MedSci Inc. (“Patent Owner”), filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have authority under 35 U.S.C. § 314. Upon consideration of the Petition and Preliminary Response we are persuaded that Petitioner has failed to demonstrate a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’533 patent. Accordingly, we deny institution of *inter partes* review.

B. Related Matters

Petitioner and Patent Owner identify the following as matters that can affect or be affected by this proceeding: pending U.S. Patent Application Nos. 10/188,299, 10/172,523, 15/594,053, 16/015,737, and 16/241,628; *Apple Inc. v. Omni MedSci Inc.*, IPR2019-00916 (PTAB); and *Omni MedSci Inc. v. Apple Inc.*, 2-18-cv-00134-RWD (E.D.Tex).¹ See Pet. xi; Paper 5, 1–2.

¹ This case has been transferred to the Northern District of California, however, has yet to be assigned a case number by that Court. See Paper 9, 1; Paper 11, 1; Ex. 1058, 9.

C. Evidence Relied Upon²

Reference		Publication Date	Exhibit
Valencell 093 ³	U.S. 2012/0197093 A1	Aug. 2, 2012	1005
Valencell 099 ⁴	U.S. 2010/0217099 A1	Aug. 26, 2010	1006
Mannheimer	U.S. 5,746,206	May 5, 1998	1008
Carlson	U.S. 2005/0049468 A1	Mar. 3, 2005	1009

D. Asserted Grounds of Unpatentability⁵

Claims Challenged	Basis	References
5, 7–10, 13, and 15–17	§ 103(a)	Valencell 093 and Valencell 099
5, 7–10, 13, and 15–17	§ 103(a)	Valencell 093, Valencell 099, and Carlson
8, 9, 16, and 17	§ 103(a)	Valencell 093, Valencell 099, and Mannheimer

² Petitioner also relies upon the Declaration of Brian Anthony, Ph.D., (Ex. 1003).

³ Valencell is not listed as an inventor on the '093 patent application publication. Nonetheless, we follow Petitioner's convention and name the reference "Valencell 093."

⁴ Valencell is not listed as an inventor on the '099 patent application publication. Nonetheless, we follow Petitioner's convention and name the reference "Valencell 099."

⁵ Petitioner identifies the third ground as obviousness of claims 8, 9, 16, and 17 over Valencell 093 and Valencell 099 in view of Mannheimer, with or without Carlson. *See* Pet. 4. We treat this as two separate grounds: (1) obviousness over Valencell 093, Valencell 099, and Mannheimer; and (2) obviousness over Valencell 093, Valencell 099, Carlson, and Mannheimer.

Claims Challenged	Basis	References
8, 9, 16, and 17	§ 103(a)	Valencell 093, Valencell 099, Carlson, and Mannheimer

II. ANALYSIS

A. The '533 Patent

The '533 patent is directed toward a physiological measurement system. The system is depicted in Figure 24 of the '533 patent, which is reproduced below.

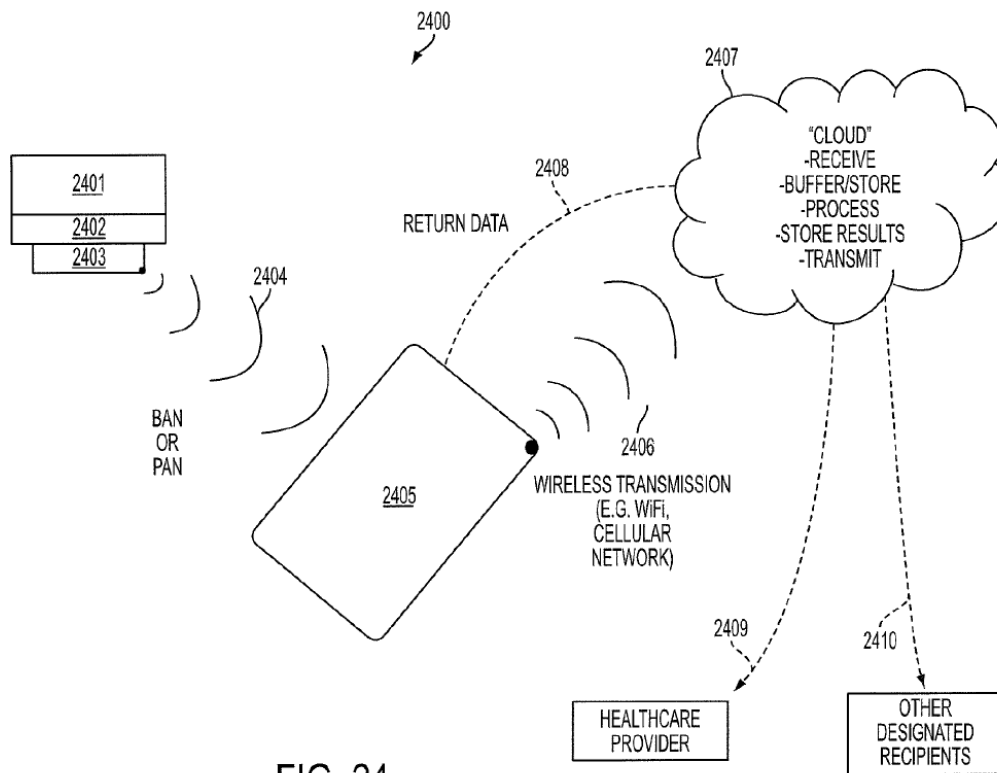


Figure 24 is a schematic illustration of a physiological measurement system. Ex. 1001, 7:7–10. The system includes wearable measurement device 2401, personal device 2405, and cloud based server 2407. *Id.* at 26:49–27:20.

The “wearable measurement device [is] for measuring one or more physiological parameters.” *Id.* at 5:35–37. A schematic illustration of such

a measurement device is shown in Figure 18 of the '533 patent, which is reproduced below.

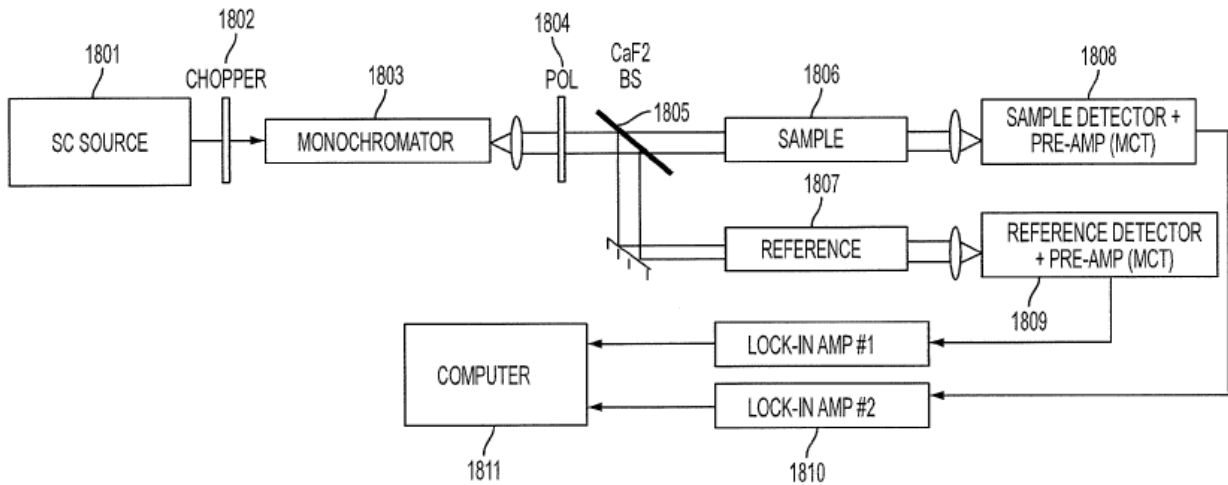


FIG. 18

Figure 18 is a schematic diagram of a device for measuring physiological parameters that may be used to “subtract out (or at least minimize the adverse effects of) light source fluctuations.” *Id.* at 18:43–46.

Wearable measurement device 2401 includes light source 1801 made from a plurality of light emitting diodes that generate an output optical beam at one or more optical wavelengths, wherein at least one of the optical wavelengths is between 700 and 2500 nanometers. *Id.* at 5:37–43, 18:46–48. The light source can increase a signal-to-noise ratio by increasing either the LED intensity or pulse rate. *Id.* at 5:43–47. Wearable measurement device 2401 also includes a plurality of lenses that receive a portion of the output optical beam from the light source and deliver an analysis beam to a sample. *Id.* at 5:47–50. Lastly, wearable measurement device 2401 includes a receiver that receives at least a portion of the analysis beam that has been

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