

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case IPR2019-00910 (Patent 9,757,040 B2)
Case IPR2019-00911 (Patent 9,861,286 B1)
Case IPR2019-00913 (Patent 9,651,533 B2)
Case IPR2019-00914 (Patent 9,861,286 B1)
Case IPR2019-00916 (Patent 9,651,533 B2)
Case IPR2019-00917 (Patent 9,757,040 B2)¹

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

HORVATH, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5(a)

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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Case IPR2019-00917 (Patent 9,757,040 B2)

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 5, 7–10, 13, and 15–17 of U.S. Patent No. 9,651,533 B2 (“the ’533 patent”). IPR2019-00916, Paper 1 (“Pet”).² Omni MedSci Inc. (“Patent Owner”), filed a Preliminary Response. IPR2019-00916, Paper 10 (“Prelim. Resp.”). Petitioner and Patent Owner identify the following District Court proceeding, *Omni MedSci Inc. v. Apple Inc.*, 2-18-cv-00134-RWS (EDTX), as related.³ See IPR2019-00916, Paper 1, x; Paper 7, 1–2.

In its Preliminary Response, Patent Owner contends that the Board should exercise its discretion and deny the Petition on procedural grounds. Prelim. Resp. 3 (citing *Trial Practice Guide Update*, 83 Fed. Reg. 39989 (Aug. 13, 2018)). Specifically, Patent Owner contends that the Board should deny the Petition because the challenges it raises rely on the same references Petitioner has identified in its District Court invalidity contentions, and any

² We cite to the Papers filed in IPR2019-00916 for convenience. Similar papers, in some cases challenging different claims of different patents, were filed in each of the cases identified in the caption. This Order applies to each of the cases identified in the caption.

³ In IPR2019-00914 and IPR2019-00911, Petitioner and Patent Owner also identify *Omni MedSci, Inc. v. Apple Inc.*, 2-18-cv-00429-RWS (EDTX) as a related matter. See *e.g.* IPR2019-00914, Paper 1, xi; Paper 8, 2. However, in those cases, Patent Owner does not provide information regarding the status of that litigation, or base its § 314(a) arguments, described *infra*, on the progress of that litigation. See *e.g.* IPR2019-00914, Paper 7, 2–6. Thus, in this Order, our reference to District Court litigation refers solely to the proceedings in *Omni MedSci Inc. v. Apple Inc.*, 2-18-cv-00134-RWS (EDTX).

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Final Written Decision entered in this proceeding (if instituted) would not be due until October 22, 2020, more than eight months after commencement of a jury trial in the District Court. *Id.* at 5 (citing Pet. 3; Ex. 2101, 3; Ex. 2102, 2, Ex. 2110). Therefore, Patent Owner argues, “[t]he Board should exercise its discretion to deny the Petition under § 314(a) because the facts here are similar to those in *NHK*.” *Id.* at 4 (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, slip op. at 20 (PTAB Sept. 12, 2018) (Paper 8) (Precedential)).

The Board seeks additional input from the parties on the facts and factors the Board should consider when deciding whether to exercise its discretion to deny institution under 35 U.S.C. § 314(a). Therefore, the Board authorizes Petitioner to file a Reply to Patent Owner’s Preliminary Response limited to discussing those issues, and Patent Owner to file a Sur-Reply limited to discussing the same issues. Petitioner’s Reply shall be no longer than seven (7) pages and due no later than September 30, 2019. Patent Owner’s Sur-Reply shall be no longer than seven (7) pages and due no later than October 4, 2019.

To assist the parties, the Board identifies the following findings of fact relevant to IPR2019-00916, and notes that similar facts are presented in the other cases identified in the caption:

1. Petitioner was served with a complaint asserting infringement of the ’533 patent on April 10, 2018 (Ex. 1004, 2).

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2. The District Court issued a Scheduling Order on June 19, 2018, scheduling a jury trial to commence on February 18, 2020, and setting a Dispositive Motion Deadline on July 9, 2019 (Ex. 2102, 1–2).
3. The Board issued *NHK* as a non-precedential decision on September 12, 2018 (*See NHK*, slip op. at 1).
4. Petitioner served Patent Owner with Proposed Claim Constructions for the '533 patent on November 1, 2018 (Ex. 1040, 5).
5. Petitioner and Patent Owner filed in the District Court an Amended Joint Claim Construction and Prehearing Statement for the '533 patent on January 11, 2019 (Ex. 1043, 4).
6. Petitioner filed the Petition in IPR2019-00916 on April 10, 2019, challenging the patentability of claims 5, 7–10, 13, and 15–17 over Lisogurski and Carlton, and claims 8, 9, 16, and 17 over Lisogurski, Carlton, and Mannheimer (Pet. 3).
7. The Board designated *NHK* as a precedential decision on May 7, 2019 (*See NHK*, slip op. at 1).
8. Patent Owner served Petitioner with an Amended Final Election of Asserted Claims on May 7, 2019, asserting claims 5, 9, 13, and 15–17 of the '533 patent (Ex. 2111, 1, 3);
9. Petitioner served Patent Owner with a Final Election of Asserted Prior Art on May 22, 2019, challenging the asserted

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claims on the basis of, *inter alia*, Lisogurski + Carlson +
Mannheimer (Ex. 2101, 2, 6).

10. The District Court issued a Claim Construction Memorandum Opinion and Order on June 24, 2019 (Ex. 2107, 1).
11. Patent Owner filed and served its Preliminary Response on Petitioner on July 22, 2019 (Prelim. Resp. 32).

The parties are invited to address the extent to which these, and any other relevant facts or factors, weigh in favor of or against denying the Petition under 35 U.S.C. § 314(a). In particular, the parties are invited to address whether, and to what extent, the Board should consider and weigh the following factors when deciding whether to institute or deny institution of the Petition under 35 U.S.C. § 314(a): (a) the merits of Petitioner's challenge; (b) the amount of time between the District Court's expected findings on validity and any expected Board findings on patentability; (c) any differences between the claims challenged in the District Court and the Petition; (d) any differences between the grounds raised in the District Court and the Petition, where a ground challenges the validity/patentability of an identified claim over identified prior art; and (e) any delay between the filing of Petitioner's invalidity contentions in the District Court and the filing of the Petition.

The parties are further invited to address (a) whether, and to what extent, Petitioner had sufficient notice that the Petition could be denied under 35 U.S.C. § 314(a), (b) whether, and to what extent, Petitioner's

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