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Paper 38
Entered: October 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case IPR2019-00916
Patent 9,651,533 B2

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)

I. INTRODUCTION

Apple, Inc. ("Petitioner") filed a Petition challenging certain claims of U.S. Patent No. 9,651,533 B2. Paper 1. In the Petition, Petitioner alleged that Lisogurski[1] teaches increasing the signal-to-noise ratio of a physiological measurement by increasing the pulse rate of an LED used to take the measurement. *See* Paper 1, 35–36.

We instituted *inter partes* review of the challenged claims on October 18, 2019. Paper 16. The deadline for filing a Final Written Decision in this proceeding is October 16, 2020. *See* 35 U.S.C. § 316(a)(11) (requiring the Director to prescribe regulations "requiring that the final determination . . . be issued not later than 1 year after the date on which the Director notices the institution of a review").

Omni MedSci, Inc. ("Patent Owner") filed a Response to the Petition on January 31, 2020, stating in the Response that Lisogurski teaches improving signal-to-noise by "modulating the light signal to correlate with 'physiological pulses' such as a 'cardiac pulse, . . ." Paper 23, 15 ("the correlation statement"). Petitioner filed a Reply on April 30, 2020, arguing the correlation statement was as admission that when Lisogurski increases the LED pulse rate to match an increased cardiac cycle, Lisogurski improves or increases signal-to-noise. *See* Paper 28, 10–11. Patent Owner filed a Sur-Reply on June 11, 2020. *See* Paper 32 ("PO Sur-Reply"). The Sur-Reply provided Patent Owner with a first opportunity to challenge Petitioner's

[1] U.S. Patent No. 9,241,676 B2

characterization of the correlation statement as an admission, but Patent Owner chose not to avail itself of that opportunity. *Id.* at 1–21.

An oral hearing was held on July 16, 2020, and a transcript of the hearing was filed on July 31, 2020. Paper 37 ("Tr."), 1. At the oral hearing, Petitioner repeated its contention that Patent Owner's correlation statement was an admission that Lisogurski increases signal-to-noise by increasing the LED pulse rate to match an increased cardiac cycle rate. *See* Tr. 8:17–9:22. The oral hearing provided Patent Owner with a second opportunity to challenge Petitioner's characterization of the correlation statement as an admission, and Patent Owner did so. *Id.* at 43:5–46:1.

On September 28, 2020, Patent Owner emailed the Board, copying Petitioner, requesting admission of a declaration filed in another proceeding (IPR2020-00175, Ex. 2131) ("the declaration") as evidentiary Exhibit 2125 in this proceeding. *See* Ex. 3001. Patent Owner avers "the two proceedings are related" and the declaration "addresses questions the Board asked during oral argument in this proceeding concerning the Lisogurski reference." *Id.* Patent Owner further avers that "Petitioner opposes this request." *Id.*

II. DISCUSSION

Our rules state that "[u]ncompelled direct testimony may be taken at any time to support a petition, motion, opposition, or reply; otherwise, testimony may only be taken during a testimony period set by the Board." 37 C.F.R. § 42.53(b). The Scheduling Order governing this proceeding provided the parties with several opportunities to exchange testimonial

evidence, but no opportunity to exchange such evidence after the oral hearing. *See* Paper 17, 10.

Moreover, nothing in the Scheduling Order contemplates or permits admitting a declaration that is not tied to a motion, opposition, or reply as evidence in this proceeding. Our rules do permit Patent Owner to request authorization to file a motion seeking relief to consider the declaration as new evidence. *See* 37 C.F.R. § 42.20(b). However, given the late date, any such subsequently filed request would be untimely. *See id.* § 42.25(b) ("A party should seek relief promptly after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.").

As discussed above, Patent Owner has already had two opportunities—Patent Owner's Sur-Reply and the oral hearing—to contest Petitioner's characterization of the correlation statement as an admission. If Patent Owner was not satisfied with its rebuttal of that characterization at the oral hearing, or felt expert testimony was needed to refine or elucidate that rebuttal, it could have timely requested authorization to file a motion to clarify its rebuttal or to consider an elucidating declaration. A timely request is one that would have provided sufficient time for (a) Petitioner to cross-examine the declarant, (b) both parties to brief the significance of the declaration, and (c) the Board to consider the new evidence and argument. *See* 37 C.F.R. §§ 42.23, 42.51(b)(1)(ii).

Patent Owner's current request, made 18 days before the due date for the Final Written Decision, is not a timely request. It fails to give the Board sufficient time to (a) order any discovery on the declaration to which Petitioner is entitled under our rules, (b) order any briefing to explain the significance and relevance of the declaration, (c) consider the declaration

and any briefing explaining its significance and relevance, and (d) write a Final Written Decision by the statutory due date.

III. ORDER

It is ORDERED that Patent Owner's request to file Ex. 2131 from IPR2020-00175 as an exhibit in this proceeding is *denied*.

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