UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

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Case IPR2019-00916
Patent 9,651,533 B2

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

PER CURIAM

Opinion Concurring filed by *Administrative Patent Judge* HORVATH

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(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."), 3. Omni MedSci Inc. ("Patent Owner"), filed a Preliminary Response. Paper 10 ("Prelim. Resp."). Upon consideration of the Petition and Preliminary Response, we instituted *inter partes* review of all challenged claims on all grounds raised. Paper 16 ("Dec. Inst.").

Patent Owner filed a Response to the Petition (Paper 23, "PO Resp."), Petitioner filed a Reply (Paper 28, "Pet. Reply"), and Patent Owner filed a Sur-Reply (Paper 32, "PO Sur-Reply"). An oral hearing was held on July 16, 2020, and the hearing transcript is included in the record. *See* Paper 37 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). This is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we find Petitioner has shown by a preponderance of evidence that claims 5, 7–10, 13, and 15–17 of the '533 patent are unpatentable.

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.*, IPR2019-00913 (PTAB); and *Omni MedSci*

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Inc. v. Apple Inc., 2-18-cv-00134-RWD (E.D. Tex.).[1] *See* Pet. x; Paper 7, 1–2.

C. Evidence Relied Upon[2]

Reference		Date	Exhibit
Mannheimer	U.S. 5,746,206	May 5, 1998	1008
Carlson	U.S. 2005/0049468 A1	Mar. 3, 2005	1009
Lisogurski	U.S. 9,241,676 B2	May 31, 2012[3]	1011

D. Instituted Grounds of Unpatentability

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

II. ANALYSIS

A. The '533 Patent

The '533 patent was filed on October 6, 2015, and claims priority to a utility application filed on December 17, 2013, and a provisional application filed on December 31, 2012. Ex. 1001, codes (22), (60), (63), 1:10–14. The '533 patent is directed toward a wearable physiological measurement

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[1] This case was transferred to the Northern District of California. *See* Paper 11, 1; Paper 13, 1; Ex. 1058, 9.

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

[3] Petitioner relies on the filing date of Lisogurski to establish its status as prior art. *See* Pet. 21.

system. *Id.* code (57). The system is depicted in Figure 24 of the '533
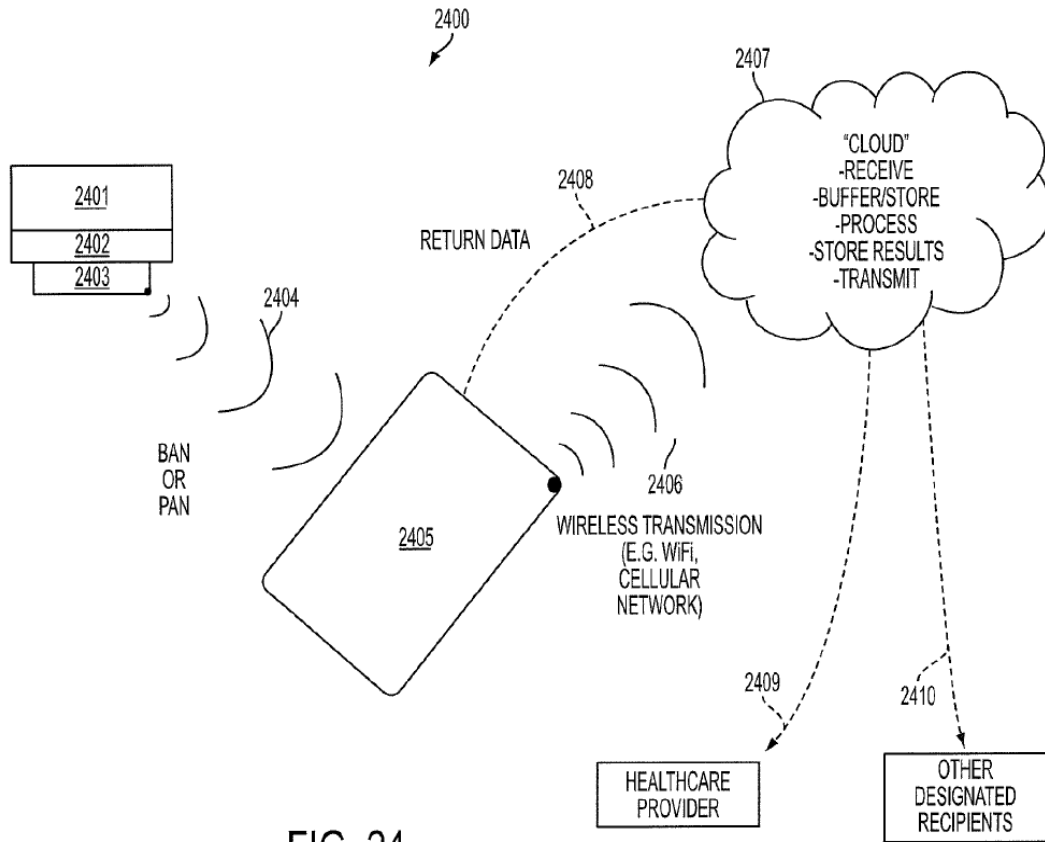patent, which is reproduced below.

FIG. 24

Figure 24 is a schematic illustration of a physiological measurement system
that includes wearable measurement device 2401, personal device 2405, and
cloud based server 2407. *Id.* at 7:7–10, 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 device is shown in Figure 18 of the '533 patent, which is reproduced
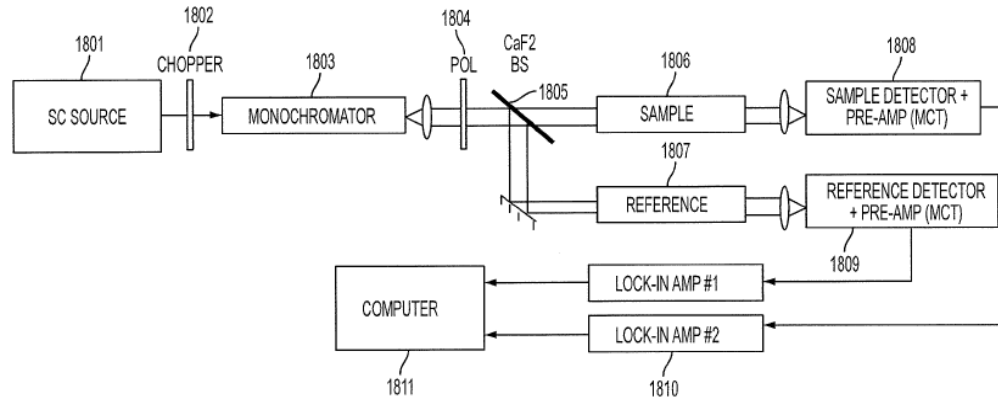below.

FIG. 18

Figure 18 is a schematic diagram of a wearable physiological measurement device to "subtract out (or at least minimize the adverse effects of) light source fluctuations." *Id.* at 18:43–46. The device includes light source 1801 made from a plurality of light emitting diodes that output an optical beam at one or more wavelengths, including at least one wavelength between 700 and 2500 nanometers. *Id.* at 5:37–43, 18:46–48. The device 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, 18:46–55. The device includes a receiver that receives at least a portion of the analysis beam that has been reflected from or transmitted through the sample, and processes that signal to generate an output signal. *Id.* at 5:51– 54, 18:55–59.

Light source 1801 "is configured to increase signal-to-noise ratio by increasing a light intensity from at least one of the plurality of semi-conductor sources [e.g., LEDs] and by increasing a pulse rate of at least one of the plurality of semiconductor sources." *Id.* at 5:43–47. For example, light source 1801 can be "an active illuminator" that allows "higher signal-

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