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.: IPR2019-00916

PATENT OWNER'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.108

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Other Authorities

I. Introduction

Patent Owner, Omni MedSci, Inc., ("Omni MedSci") requests rehearing of the Board's decision (Paper 16) instituting *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"). Omni MedSci submits that the Board's decision represents an unreasonable judgement in weighing the relevant factors with regard to the Board's discretion to deny institution under 35 U.S.C. § 314(a). Specifically, Omni MedSci submits that the Board did not address, and therefore does not appear to have considered, a critical factor relevant to its discretion, namely whether, and to what extent, Petitioner's district court invalidity contentions are the same as or substantially similar to the unpatentability grounds raised in the Petition. (Paper 12 at 5-6.) Properly weighed, this factor would militate against the Board granting institution of the Petition. As explained below, granting institution will result in significant overlap with the district court invalidity arguments resulting in a substantial and unnecessary duplication of effort. Further, contrary to Apple's promise to *stay* the litigation upon institution, Apple recently filed a substantive motion showing its intention to *proceed* with the district court litigation – resulting in further duplication of effort and wasted resources in parallel proceedings.

Omni MedSci further requests that this rehearing be heard by the Precedential Opinion Panel ("POP"), because the Board's decision deals with the following "issue[] of exceptional importance": When the obviousness combinations asserted in the district court substantially overlap the combinations asserted in the IPR, and estoppel would not apply to the district court combinations, should the Board exercise its discretion to deny institution to avoid duplicative analysis and promote efficiency? *See* PTAB Standard Operating Procedure 2, Rev. 10 at Section II(A).

II. Background

Omni MedSci filed suit against Petitioner ("Apple") in April 2018 in the Eastern District of Texas. Apple filed its IPR Petition exactly one year after being served with the complaint. After Apple filed its Petition, but before the Board's institution decision, the E.D. Tex. court transferred the lawsuit to the Northern District of California. By that time, the parties had completed all fact and expert discovery and were in the process of briefing summary judgment motions.

In the lawsuit, Apple asserted obviousness based on prior art that included patents, printed publications, and alleged public use/knowledge of preexisting systems and devices. (Ex. 2101, p. 2; Paper 13 at 4.)

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