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 NOTICE OF APPEAL TO THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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Notice is given, pursuant to 35 U.S.C. §§ 141 and 319 and 37 C.F.R. § 90.2(a), that Omni MedSci, Inc. ("Omni") appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision ("FWD") entered on October 14, 2020 (Paper 39, attached) and from all underlying orders, decisions, rulings and opinions that are adverse to Patent Owner, including, without limitation, those within the Decision on Institution of *Inter Partes* Review, entered October 18, 2019 (Paper 16). In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Omni further indicates that the issues on appeal include, without limitation, the following issues.

First, the Board erred when it rewrote the challenged claims from a "light source configured to increase signal to noise ratio . . . by increasing a pulse rate" to "one of the light emitting diodes is capable of having its pulse rate increased to increase a signal-to-noise ratio" as the Board held. (Paper No. 39 at 10.) The claims and specification confirm that the "light source" is "configured to" perform the claimed function, not merely that the "light emitting diodes" are "capable of" doing so. The Board's rewrite and broadening of the claims is improper under Federal Circuit law. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012); *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011).

Second, the Board erred when it invalidated the challenged claims based on an argument Petitioner did not make, and that Omni had no opportunity to respond

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to. For the first time in the FWD, the Board asserted that a passage of the Lisogurski reference disclosed the "light source configured to increase signal to noise ratio . . . by increasing a pulse rate" limitation. Petitioner had neither cited that passage nor made the Board's new argument because the Board's new argument is unfounded. The Board erred when it created this new argument, and reached its conclusion *sua sponte*, without giving Omni an opportunity to respond. 5 U.S.C. §554(b)(3); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380-81 (Fed. Cir. 2016); *In re NuVasive, Inc.*, 841 F.3d 966, 971-72 (Fed. Cir. 2016).

Third, the Board erred when it combined the prior art Lisogurski reference with Carlson's teaching of modulation at 1000 Hz to minimize ambient noise. Lisogurski already discloses modulating the light source at 1000 Hz to minimize ambient noise. Carlson thus adds nothing and there is no reason to combine the references. Neither reference, taken alone or in combination, teaches or suggests the claimed "light source configured to increase signal to noise ratio . . . by increasing a pulse rate."

Fourth, the Board lacked constitutional authority to render its FWD and revoke Omni's patent rights. In *Arthrex Inc. v. Smith & Nephew Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), the Federal Circuit held that APJs are principal officers who must be, but were not, appointed by the President with the advice and consent of the Senate, rendering IPRs under the America Invents Act ("AIA") a violation of U.S.

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Const. art. II, § 2, cl. 2. The Federal Circuit's alleged remedy, severing the tenure protections afforded to APJs, left APJs vulnerable to termination for policy disagreements, political reasons, or no reason at all. As stated in Arthrex, Inc.'s June 30, 2020 Petition for Writ of Certiorari (Supreme Court Docket No. 19-1458), the Federal Circuit's attempt to resolve the unconstitutional aspects of AIA was both improper and insufficient.

Pursuant to 37 C.F.R. § 90.2(a)(1) and (a)(2), and as reflected in the attached Certificate of Service, this Notice of Appeal is being electronically filed with the Patent Trial and Appeal Board through the PRPS System and the United States Court of Appeals for the Federal Circuit through the CM/ECF System along with the requisite filing fee. A copy is also being mailed to the Office of the General Counsel at the U.S. Patent and Trademark Office.

Respectfully submitted,

Dated: November 12, 2020

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CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that on November 12, 2020 a complete and entire copy of **PATENT OWNER'S NOTICE OF APPEAL** was served by correspondence email address to IPRnotices@sidley.com, which delivers to the following lead and back-up counsel:

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I also certify that in addition to being filed electronically with the Board through its PRPS System, the original of the foregoing Notice of Appeal is being sent, pursuant to 37 C.F.R. § 104.2, via first-class mail on November 12, 2020 to the United States Patent and Trademark Office at the following address:

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