

10 UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

IPR2020-00175
Patent US 10,188,299 B2

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

FENICK, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a); 37 C.F.R. § 42.4

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 7 and 10–14 (“the challenged claims”) of U.S. Patent No. 10,188,299 B2 (Ex. 1001, “the ’299 patent”). Paper 1 (“Pet.”), 3. Omni MedSci Inc. (“Patent Owner”), filed a Preliminary Response. Paper 6

(“Prelim. Resp.”). After we issued an order (Paper 7) that granted authorization for additional briefing addressing discretionary denial under 35 U.S.C. § 325(d), Petitioner filed a Reply to the Preliminary Response (Paper 8 (“Pet. Reply”)) and Patent Owner filed a Sur-Reply to the Reply (Paper 9 (“PO Sur-Reply”)). We have authority under 35 U.S.C. §§ 6, 314.

Upon consideration of the Petition, Preliminary Response, and additional briefing we decline to exercise discretion to deny institution under 35 U.S.C. §§ 325(d) or 314(a), and we are persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim of the ’299 patent. Accordingly, we institute *inter partes* review of all challenged claims on all grounds raised.

II. BACKGROUND

A. Related Matters

Petitioner and Patent Owner identify the following as matters that would affect or be affected by a decision in this proceeding:

Issued patents: U.S. Patent No. 9,651,533 (“the ’533 patent”) and U.S. Patent No. 9,164,032.

Litigation: *Omni MedSci, Inc. v. Apple Inc.*, Action No. 2-19-cv-05673-YGR (N.D. Cal.); *Omni MedSci, Inc. v. Apple Inc.*, Action No. 2-19-cv-05924 (N.D. Cal.); *Omni MedSci, Inc. v. Apple Inc.*, Action No. 2-18-cv-00429-RWS (E.D. Tex.) (terminated); and *Omni MedSci, Inc. v. Apple Inc.*, Action No. 2-18-cv-00134-RWS (E.D. Tex.) (terminated).

Inter partes review proceedings: IPR2019-00913 (terminated), and IPR2019-00916 (instituted).

See Pet. xii–xiii; Paper 4, 1–2.

B. Evidence Relied Upon

Reference		Date	Exhibit
Mannheimer	US 5,746,206	May 5, 1998	1008
Lisogurski et al.	US 9,241,676 B2	May 31, 2012	1011
Park et al.	US 9,596,990 B2	Nov. 6, 2013	1010
Carlson et al.	US 2005/0049468 A1	Mar. 3, 2005	1009

Petitioner also relies upon the Declaration of Brian Anthony, Ph.D. (Ex. 1003). Patent Owner relies upon the Declaration of Duncan L. MacFarlane, Ph.D., P.E. (Ex. 2122).

C. Asserted Grounds of Unpatentability

Claims Challenged	35 U.S.C. §	References
7, 11–13	103	Lisogurski, Carlson
12, 13	103	Lisogurski, Carlson, Mannheimer
10, 14	103	Lisogurski, Carlson, Park
14	103	Lisogurski, Carlson, Park, Mannheimer

D. Overview of the '299 Patent

The '299 patent was filed on May 12, 2017, 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), 1:7–13. The '299 patent is directed to a system for measuring physiological parameters. *Id.* at code (54).

The system, in one embodiment, includes a wearable measurement device for measuring physiological parameters. *Id.* 6:48–50. This measurement device includes a light source including multiple

semiconductor sources configured to generate an output optical beam in which a portion of the wavelengths of the output optical beam are of a near-infrared wavelength between 700 and 2500 nanometers. *Id.* 6:50–55. A portion of this output optical beam is delivered to a sample and some portion of the beam reflected or transmitted from the sample is received and processed. *Id.* 6:55–63.

A system including a wearable device is depicted in Figure 24 of the '299 patent, which is reproduced below.

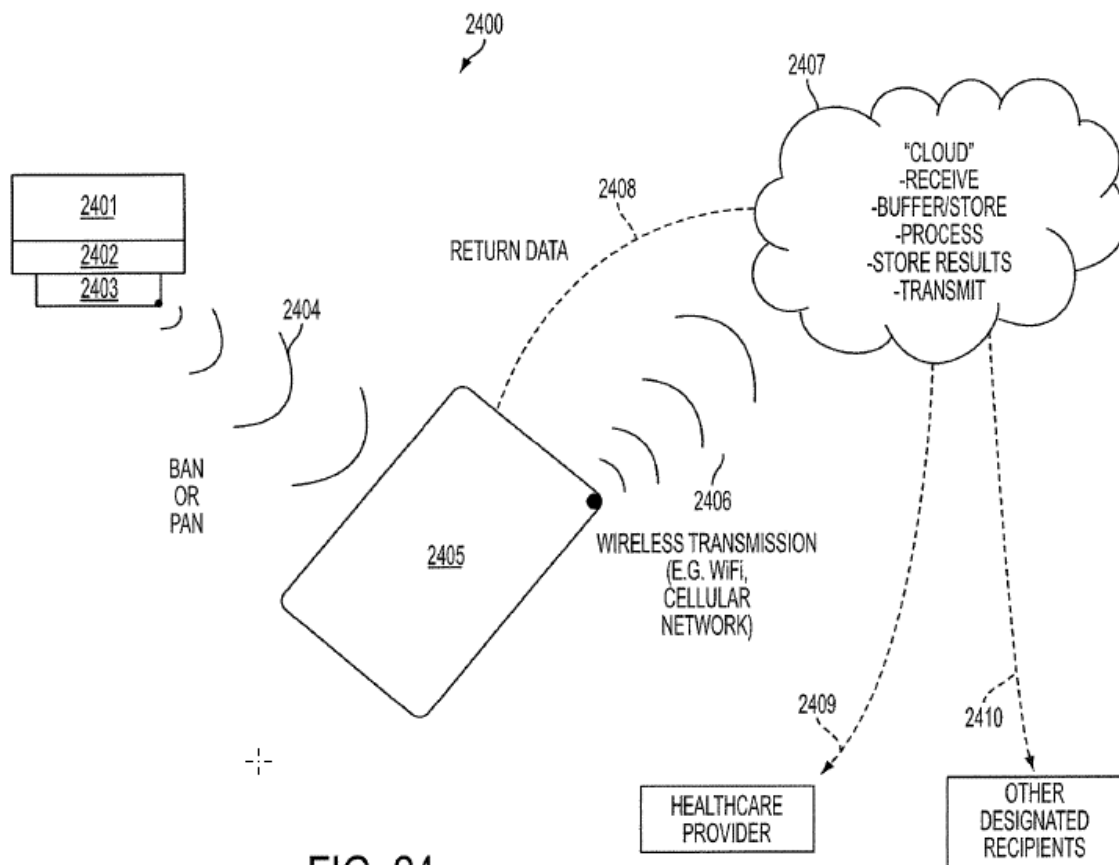


Figure 24 is a schematic illustration of a medical measurement device that is part of a personal or body area network. *Id.* at 8:25–30. Wearable measurement device 2401 is a physiological measurement or blood

constituent measurement device which includes processor 2402 and transmitter 2403. *Id.* 30:16–19. Communication link 2404 allows communication between measurement device 2401 and personal device 2405. *Id.* at 30:16–22. Personal device 2405, which may be a smart phone, optionally has a receiver, a transmitter, a display, a voice control, a speaker, one or more buttons or knobs, and/or a touch screen. *Id.* at 30:39–43. Personal device 2405 stores, processes, displays, and transmits at least a portion of the output signal generated by wearable measurement device 2401. *Id.* at 30:37–39. Personal device 2405 also transmits some of the data or the processed output signal over a wireless transmission link to internet or “cloud” 2407. *Id.* at 30:46–49. Internet or cloud 2407 may provide services including storage, processing, and retransmission of data to the originator or to another designated recipient such as a health care provider or doctor. *Id.* at 30:55–67.

The light source of the measurement device can increase a signal-to-noise ratio by increasing either the LED intensity or pulse rate. *Id.* at code (57), 3:11–16. Additionally, “change detection schemes may be used, where the detection system captures the signal with the light source on and with the light source off. . . . Then, the signal with and without the light source is differenced. This may enable the sun light changes to be subtracted out.” *Id.* at 29:13–18.

E. Challenged Claims

Claim 7 of the ’299 patent is a representative claim, the sole independent claim of the challenged claims, and is reproduced below, with one limitation (the “pulse rate limitation”) italicized for emphasis.

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