

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.; and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

OURARING, INC.,
Patent Owner.

IPR2024-00928
Patent 9,582,034 B2

Before NEIL T. POWELL, ELIZABETH M. ROESEL, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. BACKGROUND

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–5, 11–13, and 16–18 of U.S. Patent No. 9,582,034 B2 (Ex. 1001, “the ’034 Patent”). Paper 3 (“Pet.”). Ouraring, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2024). To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one challenged claim. We institute an *inter partes* review of claims 1–5, 11–13, and 16–18 based on the grounds set forth in the Petition.

B. RELATED PROCEEDINGS

Patent Owner notes that the ’034 Patent “is not currently asserted in any judicial or administrative matters.” Paper 6, 1. Patent Owner notes, however, that the ’034 Patent “belongs to the same family as U.S. Patent Nos. 11,549,147, 11,868,178, and 11,868,179” and identifies the following proceedings involving those related patents:

Certain Smart Wearable Devices, Systems, and Components Thereof,
Inv. No. 337-TA-1398 (ITC March 13, 2024);

Ōura Health Oy et al. v. Ultrahuman Healthcare Pvt., Ltd. et al.,
No. 2:23-cv-00396 (E.D. Tex. September 1, 2023); and

Samsung Electronics Co., Ltd., et al v. Ōura Health Oy et al.,
No. 3:24-cv-03245 (N.D. Cal. May 30, 2024).

Id.

Petitioner notes that it has sought *inter partes* review of related U.S. Patent Nos. 11,868,178, 11,868,179, 11,599,147, and 10,893,833. Pet. 1. Specifically, Petitioner has petitioned for *inter partes* review of those patents in the following matters:

Samsung Electronics Co., Ltd., et al v. Ouraring, Inc.,
PGR2024-00030 (PTAB May 31, 2024), involving U.S. Patent
No. 11,868,178;

Samsung Electronics Co., Ltd., et al v. Ouraring, Inc.,
PGR2024-00031 (PTAB May 31, 2024), involving U.S. Patent
No. 11,868,179;

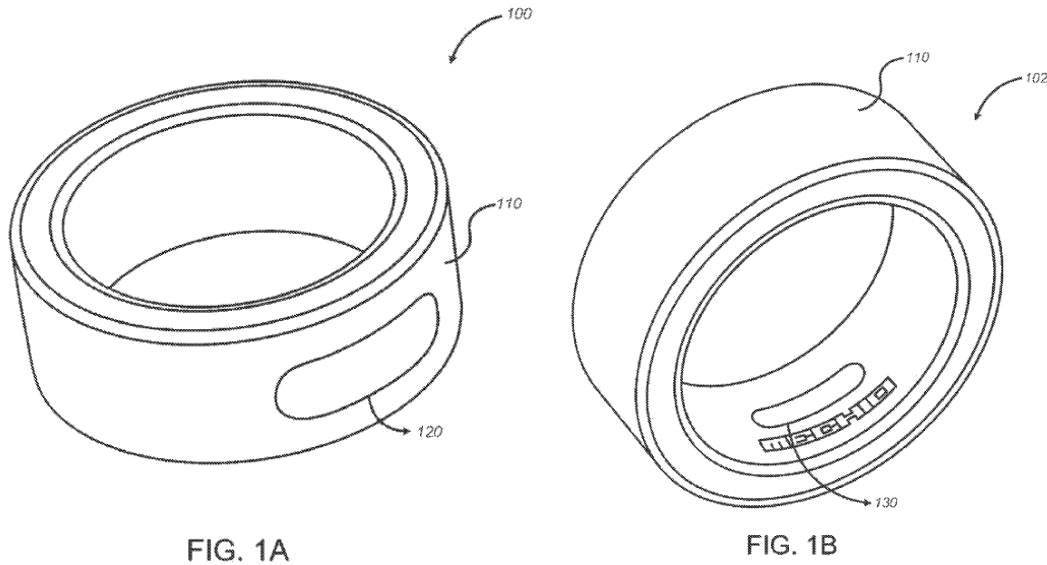
Samsung Electronics Co., Ltd., et al v. Ouraring, Inc.,
IPR2024-00930 (PTAB May 31, 2024), involving U.S. Patent
No. 11,599,147; and

Samsung Electronics Co., Ltd., et al v. Ōura Health Oy,
IPR2024-00929 (PTAB May 31, 2024), involving U.S. Patent
No. 10,893,833.

C. THE '034 PATENT

The '034 Patent is titled “Wearable Computing Device” and was issued February 28, 2017, based on an application filed November 28, 2014, that asserts the benefit of two provisional applications, the earlier of which was filed November 29, 2013. Ex. 1001, codes (22), (45), (54), (60). The '034 Patent discloses “a wearable computing device (WCD) in the form of a ring that can be worn on the finger of a human user.” *Id.* at code (57).

Figures 1A and 1B of the '034 Patent are reproduced below.



Figures 1A and 1B are perspective views of WCD 110. Ex. 1001, 9:7–10. “[T]he WCD 110 can include the exterior window 120 on its exterior wall for input/output data transmission and reception, battery recharge, or status indication. The WCD 110 can also include the interior window 130 on its interior wall for various monitoring or sensing activities.” *Id.* at 9:40–45.

Figure 4 of the '034 Patent is reproduced below.

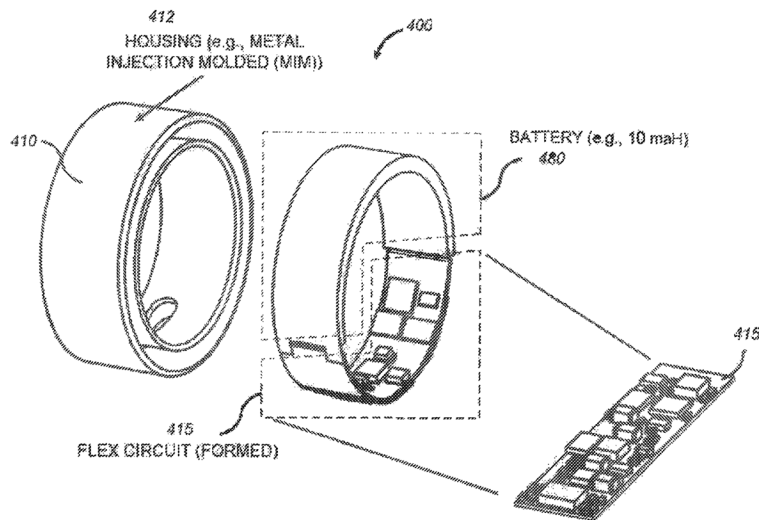


FIG. 4

Figure 4 is an exploded view of WCD 410 illustrating battery 480 and flexible PCB 415, which are configured to fit inside ring housing 412 of WCD 410. Ex. 1001, 5:7–9, 15:46–49.

Figures 7 and 8 of the '034 Patent are reproduced below.

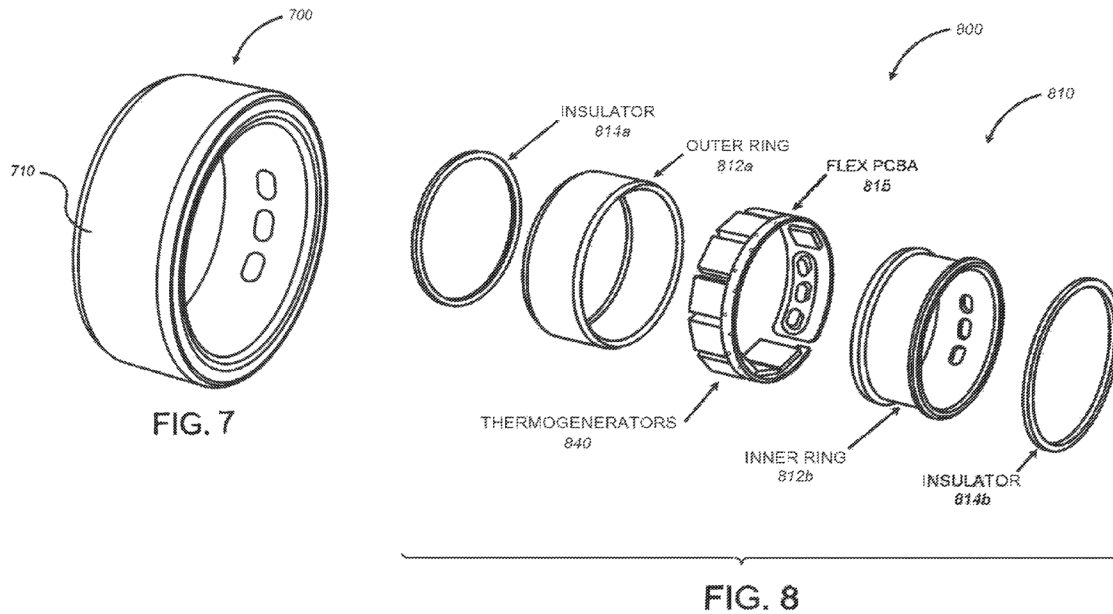


Figure 7 is a perspective view of a WCD, and Figure 8 is an exploded view of the WCD of Figure 7. Ex. 1001, 5:16–20, 14:47–49. Figures 7 and 8 illustrate a design of the housing for the WCD, where the ring includes outer ring 812a, inner ring 812b, and insulators 814a and 814b. *Id.* at 14:49–54.

D. ILLUSTRATIVE CLAIM

Of the challenged claims, claims 1, 11, and 16 are independent. Each of claims 2–5, 12, 13, 17, and 18 depends, directly or indirectly, from one of independent claims 1, 11, and 16. Claim 1 is illustrative for our analysis herein and is reproduced below with certain reformatting:¹

1. [1[pre]] A wearable computing device, comprising:

¹ We have added the same labels that Petitioner uses to identify portions of claim 1. *See, e.g.*, Pet. 39–45.

- [1[A]] an interior wall defining a first enclosing structure;
- [1[B]] an exterior wall defining a second enclosing structure;
- [1[C]] a flexible printed circuit board disposed between the interior wall and the exterior wall;
- [1[D]] at least one component disposed on the flexible printed circuit board; and
- [1[E]] wherein at least one of the interior wall and the exterior wall defines a window that facilitates at least one of data acquisition, data transmission, and battery recharge.

Ex. 1001, 35:38–48.

E. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts that claims 1–5, 11–13, and 16–18 would have been unpatentable on the following grounds (Pet. 4):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 11, 12, 16–18	103	Schröder ²
1–5, 11–13, 16–18	103	Schröder, Yuen ³
1, 2, 11, 12, 16–18	103	LeBoeuf ⁴
4, 5	103	LeBoeuf, Wissmar ⁵

In support of its challenges, Petitioner also relies on the Declaration of Dr. Brian W. Anthony, Ph.D. Ex. 1002.

² U.S. Patent No. 10,303,867 B2, issued May 28, 2019 (Ex. 1007, “Schröder”).

³ U.S. Patent No. 8,954,135 B2, issued Feb. 10, 2015 (Ex. 1006, “Yuen”).

⁴ U.S. Patent No. 8,700,111 B2, issued Apr. 15, 2014 (Ex. 1012, “LeBoeuf”).

⁵ U.S. Patent Application Publication No. 2012/0218184 A1, published Aug. 30, 2012 (Ex. 1013, “Wissmar”).

II. ANALYSIS

A. LEVEL OF ORDINARY SKILL

At this stage of the proceeding, there is no dispute about the level of ordinary skill in the art. Based on the testimony of Dr. Anthony, we determine that a person of ordinary skill in the art (“POSITA”) would have had a four-year degree in electrical engineering, mechanical engineering, biomedical engineering, optical engineering, or related field of study, and two years of experience in academia or industry studying or developing physiological monitoring devices such as non-invasive biosensors. A POSITA would have been familiar with sensor system design and signal processing. A higher level of education or skill can substitute for less experience, and vice versa. Ex. 1002 ¶ 29.

We find that the level of ordinary skill in the art, as articulated above, is consistent with the level of technical understanding and competence reflected in the ’034 Patent Specification and the asserted prior art references.

B. CLAIM CONSTRUCTION

In an *inter partes* review, we apply the same claim construction standard as would be used by a district court to construe a claim in a civil action involving the validity or infringement of a patent. 37 C.F.R. § 42.100(b). Under that standard, claim terms are given their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention, in light of the language of the claims, the specification, and the prosecution history of record. *Id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–19 (Fed. Cir. 2005) (en banc); *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). “The Board is required to construe ‘only those terms . . . that are in

controversy, and only to the extent necessary to resolve the controversy.”
Realtime Data, LLC v. Iancu, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (quoting
Vivid Techs., Inc. v. Am. Sci. Eng’g, Inc., 200 F.3d 795, 803 (Fed.
Cir. 1999)).

We agree with the parties that it is not necessary for us to provide an
express construction for any claim term for purposes of determining whether
to institute an *inter partes* review. Pet. 8; Prelim. Resp. 16.

C. ALLEGED OBVIOUSNESS OVER LEBOEUF

1. *Overview of LeBoeuf*

LeBoeuf is titled “Light-Guiding Devices and Monitoring Devices
Incorporating Same.” Ex. 1012, code (54). According to LeBoeuf, “[t]here
is growing market demand for personal health and environmental monitors.”
Id. at 1:23–24. LeBoeuf discloses directing light to a person’s body part and
then collecting light at a detector “for detecting and/or measuring, among
other things, body temperature, skin temperature, blood gas levels, muscle
tension, heart rate, blood flow, cardiopulmonary functions, etc.”
Id. at 2:46–52. LeBoeuf discloses embodiments in which “a monitoring
device includes a circular band capable of encircling a finger of a subject”
with provisions for sending light to a subject’s finger, gathering light from
the finger, and sending the gathered light to an optical detector.
Id. at 5:44–53. LeBoeuf discloses such an embodiment in Figures 22A and
22B, which are reproduced below. *Id.* at 8:13–17, 27:61–64.

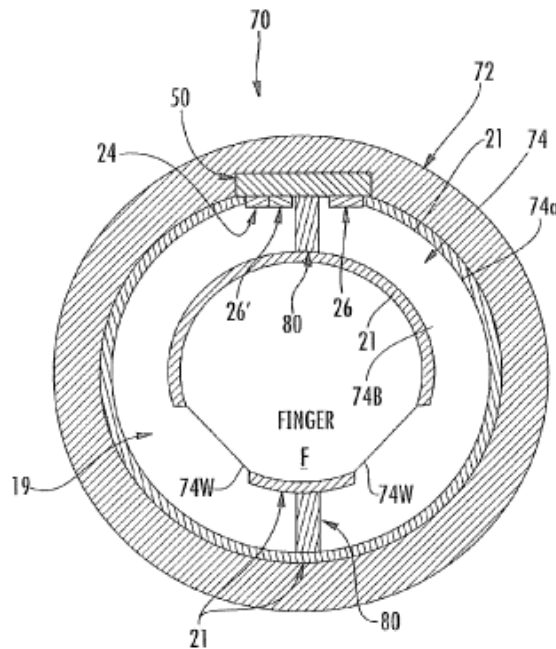


FIG. 22B

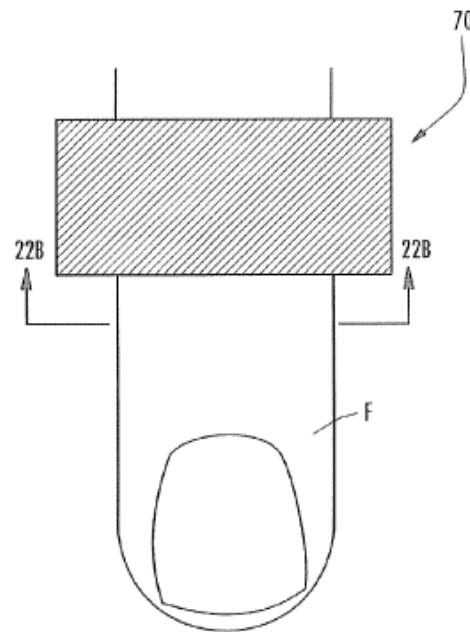


FIG. 22A

Figure 22A shows monitoring device 70 in top plan view.

Ex. 1012, 8:13–15. Figure 22B shows a cross-section of monitoring device 70 along Figure 22A’s lines 22B-22B. *Id.* at 8:16–17.

Monitoring device 70 includes structure that encircles finger F. Ex. 1012, 27:61–28:1. Specifically, monitoring device 70 “includes a generally circular band capable of encircling a finger F of a subject, with a cylindrical outer body portion 72 and a generally cylindrical inner body portion 74 secured together in concentric relationship.” *Id.* at 27:64–28:1.

Monitoring device 70 may also include other elements. For example, “outer body portion 72 may include a flex circuit containing various electronic components, such as a microprocessor, D/A converter, power source, power regulator, and the like.” Ex. 1012, 28:4–6. “A base 50 is secured to the inner and outer body portions 72, 74,” with base 50 holding

“an optical emitter 24, an optical detector 26, and an optical noise detector 26’.” *Id.* at 28:11–17.

Inner body portion 74 may route light from optical emitter 24 to finger F and back from finger F to optical detectors 26, 26’.

Ex. 1012, 28:30–34. Inner body portion 74 has light transmissive material, such as “a soft, resilient material” like silicone. *Id.* at 28:18–22. Inner body portion 74 has cladding material 21 applied to its outer and inner surfaces 74a and 74b, such that inner body portion 74 guides light to and from finger F. *Id.* at 28:26–34. “[W]indows 74w are formed in the cladding material 21 and serve as light-guiding interfaces to the finger F.” *Id.* at 28:40–42.

2. Discussion

In support of its position that claims 1, 2, 11, 12, and 16–18 are unpatentable as obvious over LeBoeuf, Petitioner cites LeBoeuf’s finger ring shown in Figures 22A and 22B. Pet. 39–50. According to Petitioner and Dr. Anthony, LeBoeuf teaches each limitation of claims 1, 2, 11, 12, and 16–18. *Id.*; Ex. 1002 ¶¶ 212–224.

Patent Owner counters that LeBoeuf does “not disclose or suggest the claimed invention.” Prelim. Resp. 2. In Patent Owner’s view, LeBoeuf does not teach claim elements 1[C] and 1[E]. *Id.* at 30–33. According to Patent Owner, LeBoeuf also fails to disclose or suggest certain features recited in independent claims 11 and 16. *Id.* at 33–34. Additionally, Patent Owner suggests that there may be objective evidence of nonobviousness, arguing that its commercial product is coextensive with and embodies the ’034 Patent based on LeBoeuf. *Id.* at 2.

In view of all of the parties’ arguments and evidence currently on record, Petitioner demonstrates a reasonable likelihood of prevailing on its

challenge of claim 1 as unpatentable over LeBoeuf. Below, we discuss the issues raised by Patent Owner's arguments affecting Petitioner's challenge of claim 1 of the '034 Patent based on LeBoeuf.

a) Claim Element 1[C]

Claim element 1[C] requires “a flexible printed circuit board disposed between the interior wall and the exterior wall,” referring to claim element 1[A]’s “interior wall defining a first enclosing structure” and claim element 1[B]’s “exterior wall defining a second enclosing structure.”

Ex. 1001, 35:39–42. Petitioner contends that “LeBoeuf teaches Element[] 1[C].” Pet. 42. Patent Owner disagrees. Prelim. Resp. 32–33.

At this stage, we find Petitioner’s position that LeBoeuf teaches claim element 1[C] meets the threshold for institution after considering Patent Owner’s rebuttal. In concert with its position that LeBoeuf’s inner body portion 74 and outer body portion 72 teach interior and exterior walls (Pet. 40–41), Petitioner contends that LeBoeuf teaches a flexible printed circuit board between those interior and exterior walls:

[LeBoeuf’s] finger ring may include a flex circuit containing various electronic components, such as a microprocessor, D/A converter, power source, power regulator, and the like. Ex-1012, 28:3–8. For example, base 50 . . . in Figure 22B may be a printed circuit board that provides support for one or more sensors and is “secured to the inner and outer body portions 74, 72.” *Id.*, 28:11–18 (applying base 50 from other embodiments), 14:28–38 (base 50 of the earbud embodiments is a PCB). A POSITA would have understood that LeBoeuf’s “flex circuit” is a flexible printed circuit board disposed between the interior and exterior walls of the device, like base 50, because it has electronic components positioned on it and is arranged inside the finger ring (i.e., by the ring’s outer body portion 72 and interior body portion 74). Ex-1002 ¶216.

Pet. 42–43. For the reasons discussed below, these arguments and evidence are sufficient under the reasonable likelihood standard.

According to Patent Owner, “there is no support” for LeBoeuf’s “base 50 [to be] considered a printed circuit board.” Prelim. Resp. 33. We disagree. Petitioner cites LeBoeuf’s disclosures that (1) in its finger ring, “base 50 . . . may be similar to the base 50 described . . . with respect to [Figures] 3, 4A–4D, 5, 6, 7A–7B, 8A–8D, 9A–9B, and 11A–11B” (Ex. 1012, 28:11–14) and (2) “[t]he base 50 in all of the earbud embodiments ([Figures] 3, 4A–4D, 5, 6, 7A–7B, 8A–8D, 9A–9B, and 11A–11B) . . . may include . . . a *printed circuit board*” (*id.* at 14:28–32 (emphasis added)). Pet. 43. Contrary to Patent Owner’s argument, these disclosures provide support for Petitioner’s position that, in LeBoeuf’s ring, base 50 may be a printed circuit board. Pet. 42–43; Prelim. Resp. 33.

Patent Owner also argues that LeBoeuf “does not disclose or suggest a first and second ‘enclosing structures’ of claim 1 that contain a flexible printed circuit board therebetween (such as inner and outer rings of [Figure] 8 of the ’034 Patent).” Prelim. Resp. 32–33. In support of this, Patent Owner asserts that “LeBoeuf discloses a unitary housing 72 that may contain a flex circuit,” arguing that “LeBoeuf specifically states that a ‘flex circuit’ is separately located in housing 72.” *Id.* at 33 (citing Ex. 1012, 28:3–6). This argument is unavailing because it misstates the disclosure in the cited portion of LeBoeuf. Contrary to Patent Owner’s argument, the cited portion of LeBoeuf discloses that “outer body portion 72 may *include* a flex circuit” (Ex. 1012, 28:3–6 (emphasis added)), not that a flex circuit is “separately located *in* housing 72” (Prelim. Resp. 33 (emphasis added)).

Patent Owner also argues that LeBoeuf’s “base 50 is not located between interior and exterior walls that define first and second enclosing structures.” Prelim. Resp. 33. On the contrary, Petitioner sufficiently supports its position that LeBoeuf’s inner body portion 74 and outer body portion 72 teach interior and exterior walls defining first and second enclosing structures. Pet. 40–42 (citing Ex. 1002 ¶¶ 213–215; Ex. 1012, 27:61–28:1, 28:18–19, 28:26–34). And the evidence, including LeBoeuf’s Figure 22B, tends to show base 50 is between inner body portion 74 and outer body portion 72. *See, e.g.*, Ex. 1002 ¶ 216. At this stage, Patent Owner does not elaborate on its counterargument that “base 50 is not located between interior and exterior walls that define first and second enclosing structures.” Prelim. Resp. 33. To the extent Patent Owner believes that LeBoeuf does not teach the claim elements because inner body portion 74 and outer body portion 72 do not resemble sufficiently “inner and outer rings of [Figure] 8 of the ’034 patent” (*see* Prelim. Resp. 32–33), Patent Owner does not argue that any specific feature of the ’034 Patent’s Figure 8 is required by claim 1 and missing from LeBoeuf’s finger ring.

b) Claim Element 1[E]

Referring back to claim element 1[A]’s “interior wall defining a first enclosing structure” and claim element 1[B]’s “exterior wall defining a second enclosing structure,” claim element 1[E] requires that “at least one of the interior wall and the exterior wall defines a window that facilitates at least one of data acquisition, data transmission, and battery recharge.” Ex. 1001, 35:45–48. Petitioner contends that “LeBoeuf teaches Element 1[E].” Pet. 44. Patent Owner disagrees. Prelim. Resp. 30–32.

At this stage, we find Petitioner’s position that LeBoeuf teaches claim element 1[E] meets the threshold for institution after considering Patent

Owner’s rebuttal. In concert with its position that LeBoeuf’s inner body portion 74 teaches an interior wall (Pet. 40–41), Petitioner contends that LeBoeuf’s disclosures regarding windows 74_w teach limitation 1[E]:

LeBoeuf’s monitoring device has at least one window that facilitates data acquisition. *Id.* As shown in Figure 22B below, LeBoeuf’s finger ring has “windows 74_w” . . . formed in the cladding material 21 which serve as light-guiding interfaces to the finger from the optical emitter 24 . . . to light detectors 26, 26’ . . . to acquire data. Ex-1012, 28:40–50. The windows may incorporate optical filters to selectively pass one or more optical wavelengths and reflect and/or absorb other optical wavelengths. *Id.*, 28:48–50. Light detectors 26, 26’ measure the light scattered by the window lens to determine the user’s motion or physiological activity. Ex-1012, 28:63–29:11. LeBoeuf’s “windows 74_w” are positioned in the interior wall of the finger ring, through cladding 21 of inner housing portion 74 to acquire data by measuring light. Ex-1002 ¶219.

Pet. 44–45. For the reasons discussed below, these arguments and evidence are sufficient under the reasonable likelihood standard.

In response to Petitioner’s arguments, Patent Owner asserts that “LeBoeuf does not disclose or suggest ‘wherein at least one of the interior wall and the exterior wall [between which the printed circuit board is disposed] defines a window that facilitates at least one of data acquisition, data transmission, and battery recharge’ of claim 1.” Prelim. Resp. 32 (alteration in original). In support of this, Patent Owner argues that “as shown in [Figure] 22B of LeBoeuf, the outer housing 72 includes a ‘flex circuit,’ but a *separate* inner housing 74 is the one that includes windows 74_W.” *Id.* This argument is unavailing for multiple reasons.

First, LeBoeuf’s disclosure does not fully support Patent Owner’s argument. LeBoeuf does not disclose “inner housing 74” or “outer housing 72,” as stated by Patent Owner. Prelim. Resp. 31–32. Rather,

LeBoeuf discloses “inner body portion 74” and “outer body portion 72.” Ex. 1012, 27:66–28:1. Also, although LeBoeuf’s inner body portion 74 and outer body portion 72 are identified as separate parts, LeBoeuf discloses that they are “secured together in concentric relationship.” *Id.* at 27:66–28:1.

Second, on this record, Patent Owner’s argument that LeBoeuf’s inner body portion 74 and outer body portion 72 are “separate” (Prelim. Resp. 31–32) does not appear to distinguish the challenged claim from LeBoeuf. Claim 1 recites an “interior wall” and separately recites an “exterior wall.” Ex. 1001, 35:39–40. So, Patent Owner’s argument about separate parts appears to be consistent with Petitioner’s contention that LeBoeuf’s inner body portion 74 and outer body portion 72 teach claim 1’s separately recited “interior wall” and “exterior wall,” respectively. Pet. 40–42; Prelim. Resp. 30–32.

Third, on this record, Patent Owner’s argument that LeBoeuf has its windows 74w on inner body portion 74, rather than outer body portion 72 (Prelim. Resp. 32), also does not appear to distinguish the challenged claim from LeBoeuf. Claim element 1[E] encompasses positioning a window on either or both of the interior wall and the exterior wall, requiring only that “at least one of the interior wall and the exterior wall defines a window.” Ex. 1001, 35:45–46. And, as discussed in Section II.C.2.a above, Petitioner contends that LeBoeuf’s inner body portion 74 and outer body portion 72 teach interior and exterior walls with a printed circuit board between them. Pet. 40–44. For claim element 1[E], Petitioner’s contention that “LeBoeuf’s ‘windows 74w’ are positioned in the interior wall of the finger ring,” is supported by the reference and sufficient for purposes of institution. *Id.* at 44–45.

c) Objective Evidence of Nonobviousness

“Objective evidence of nonobviousness is an important component of the obviousness inquiry because evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012).

“For objective evidence of secondary considerations to be relevant, there must be a nexus between the merits of the claimed invention and the objective evidence.” *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, 81 F.4th 1202, 1210 (Fed. Cir. 2023). “A showing of nexus can be made in two ways: (1) via a presumption of nexus, or (2) via a showing that the evidence is a direct result of the unique characteristics of the claimed invention.” *Id.*

Patent Owner contends that its commercial product—the Oura Ring—is “revolutionary” and a success, with more than more than 2,500,000 sales. Prelim. Resp. 2. According to Patent Owner, the Oura Ring is coextensive with and embodies the ’034 Patent. *Id.*

We determine that Patent Owner’s argument and evidence concerning commercial success and nexus are best evaluated on a fully developed record.

d) Conclusion for Petitioner’s Challenge Based on LeBoeuf

For these reasons, we determine that Petitioner’s challenge to claim 1 based on LeBoeuf meets the threshold for institution of an *inter partes* review.

D. PETITIONER’S OTHER CHALLENGES

In view of our determination that Petitioner’s challenge of claim 1 based on LeBoeuf meets the threshold for institution of an *inter partes* review, it is unnecessary for us to determine whether Petitioner’s remaining prior art challenges meet that threshold. *See SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). We do not reach Petitioner’s other challenges or Patent Owner’s arguments concerning them in this decision (*see* Prelim. Resp. 18–29, 33–34). In our view, those arguments present complex issues that are best evaluated on a fully developed record at trial.

III. ORDER

It is:

ORDERED that *inter partes* review of claims 1–5, 11–13, and 16–18 of the ’034 Patent is instituted on all grounds presented in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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FOR PETITIONER:

William M. Fink
Marc Pensabene
John Kappos
Mark Liang
Benjamin Haber
Sorin G. Zaharia
O'MELVENY & MYERS LLP
tfink@omm.com
mpensabene@omm.com
jkappos@omm.com
mlaing@omm.com
bhaber@omm.com
szaharia@omm.com

FOR PATENT OWNER:

Jasjit S. Vidwan
Christopher S. Schultz
ARENTFOX SCHIFF LLP
jasjit.vidwan@afslaw.com
christopher.schultz@afslaw.com