

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OURA HEALTH OY
Patent Owner.

Case IPR2024-01080
U.S. Patent No. 10,842,429

**PATENT OWNER'S PRELIMINARY
RESPONSE PURSUANT TO 37 C.F.R. § 42.107**

TABLE OF CONTENTS

REMARKS 1

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> , 880 F.3d 1345 (Fed. Cir. 2018).....	6
<i>Bestway (USA), Inc. v. Intex Mktg, Ltd.</i> , PGR2024-00036, Paper 9 (P.T.A.B. Oct. 28, 2024).....	6
<i>Cisco Sys., Inc. v. SecurityProfiling, LLC</i> , IPR2021-01428, Paper 13 (PTAB Mar. 14, 2021)	6
<i>CommScope Techs., LLC v. Belden Inc.</i> , IPR2023-01058, Paper 8 (PTAB, Nov. 30, 2023)	7
<i>Crescendo Bioscience, Inc. v. L. Douglas Graham</i> , PGR2017-00020, Paper 8 (PTAB Oct. 17, 2017).....	7
<i>Gen. Elec. Co. v. United Techs. Corps.</i> , IPR2017-00491, Paper 9 (PTAB July 6, 2017)	5
<i>Microsoft Corp. v. Litl, LLC</i> , IPR2021-01011, Paper 11 (PTAB Apr. 5, 2022).....	6
<i>Pfizer, Inc. v. UniQure Biopharma B.V.</i> , IPR2020-00388, 2021 WL 1158151 (PTAB Mar. 25, 2021)	6
<i>Raytheon Tech. Corp. v. Gen. Elec. Co.</i> , 993 F.3d 1374 (Fed. Cir. 2021).....	5
<i>Takeda Vaccines, Inc. v. Valneva Austria Gmbh</i> , IPR2023-00354, Paper 7 (PTAB June 9, 2023).....	7
Statutes	
35 U.S.C. § 253(a)	5, 6

TABLE OF EXHIBITS

Exhibit No.	Description
EX-2001	Statutory Disclaimer of claims of U.S. Patent No. 10,842,429

Patent Owner Oura Health Oy (“Oura”) submits this Preliminary Patent Owner Response (“POPR”) to the Petition filed by Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (Samsung or “Petitioner”) requesting *inter partes* review of claims 1–6 of U.S. Patent No. 10,842,429 (“the ’429 patent”).

REMARKS

Oura disagrees with the merits of Samsung’s unpatentability contentions, but institution should be denied based on a threshold procedural ground alone—Patent Owner has disclaimed claims 1–6 of the ’429 patent that are challenged by this Petition. EX. 2001; *Gen. Elec. Co. v. United Techs. Corps.*, IPR2017-00491, Paper 9 at 2-3 (PTAB July 6, 2017) (precedential) (“Because all claims challenged by GE have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted in this proceeding.”) (citing 37 C.F.R. § 42.107(e)).

The statutory disclaimer is not an admission or concession regarding any of Samsung’s contentions in this petition. *Raytheon Tech. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1379 n.4 (Fed. Cir. 2021) (citation omitted) (a “disclaimer does not legally constitute ‘an admission that the subject of the disclaimer appears in the prior art.’”). Nor should the disclaimer be interpreted as Patent Owner’s request for adverse judgment against itself. Indeed, while the Federal Circuit has interpreted the PTAB rules as allowing a pre-institution disclaimer as a request for adverse

judgment,¹ the Board has treated pre-institution “disclaimed claims . . . as if they never existed.” *Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, 2021 WL 1158151, at *2 (PTAB Mar. 25, 2021) (contrasting pre- and post-institution disclaimers). “If the claims never existed, we cannot have exercised jurisdiction over the disclaimed claims and therefore cannot enter adverse judgment against them.” *Id.* (citing *Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Lab., Inc.*, 933 F.3d 1367, 1374-75 (Fed. Cir. 2019)).

Because each challenged claim has been disclaimed under 35 U.S.C. § 253(a), Patent Owner requests that the Board deny institution without entry of an adverse judgment. *Cisco Sys., Inc. v. SecurityProfiling, LLC*, IPR2021-01428, Paper 13 at 7 (PTAB Mar. 14, 2021) (“The statutory disclaimer was filed before institution. In view of this disclaimer . . . we determine a denial of institution is sufficient to dispose of this case.”); *Bestway (USA), Inc. v. Intex Mktg, Ltd.*, PGR2024-00036, Paper 9 at 8 (P.T.A.B. Oct. 28, 2024) (“the efficient administration of the Office weighs against entering adverse judgment because such an action would have the effect of discouraging other similarly situated patent owners from filing disclaimers prior to institution in appropriate cases and also encourage patent owners to continue to litigate every AIA trial proceeding through Final Written Decision in such cases”); *Microsoft Corp. v. Litl, LLC*, IPR2021-01011, Paper 11 at 3 (PTAB Apr. 5, 2022)

¹ *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1349-50 (Fed. Cir. 2018).

(“we determine that denying institution without entering adverse judgment is the appropriate means for disposing of this case.”); *Crescendo Bioscience, Inc. v. L. Douglas Graham*, PGR2017-00020, Paper 8 at 2 (PTAB Oct. 17, 2017) (“As prior panels have held, and we agree, a statutory disclaimer filed prior to institution of trial in a case should not be construed as a request for adverse judgment.”); *Takeda Vaccines, Inc. v. Valneva Austria GmbH*, IPR2023-00354, Paper 7 at 4 (PTAB June 9, 2023); *CommScope Techs., LLC v. Belden Inc.*, IPR2023-01058, Paper 8 (PTAB, Nov. 30, 2023).

Thus, Patent Owner respectfully requests denial of the institution of this Petition.

Dated: October 31, 2024

Respectfully submitted,

/s/ Jasjit S. Vidwan

Jasjit S. Vidwan, Reg. No. 72,080
ARENTFOX SCHIFF LLP
1717 K Street, NW
Washington, DC 20006-5344
Tel.: 202.857.6000
jasjit.vidwan@afslaw.com

Attorney for Patent Owner

CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(d)

I hereby certify that the foregoing Patent Owner's Preliminary Response contains 576 words as measured by the word-processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24(d).

Dated: October 31, 2024

/s/ Jasjit S. Vidwan

Jasjit S. Vidwan, Reg. No. 72,080
ARENTFOX SCHIFF LLP
1717 K Street, NW
Washington, DC 20006-5344
Tel.: 202.857.6000
jasjit.vidwan@afslaw.com

CERTIFICATE OF SERVICE

I hereby certify that, on October 31, 2024, I caused a true and correct copy of Patent Owner's Preliminary Response Pursuant to 37 C.F.R. §42.107 to be served via email to the following counsel for Petitioner:

William M. Fink, Reg. No. 72,332
tfink@omm.com
O'Melveny & Myers LLP
1625 Eye Street, NW
Washington, DC 20006

Benjamin Haber, Reg No. 67,129
bhaber@omm.com
O'Melveny & Myers LLP
400 South Hope Street, 18th Floor
Los Angeles, CA 90071

John Kappos, Reg. No. 37, 861
jkappos@omm.com
O'Melveny & Myers LLP
2801 North Harwood Street,
Suite 1600
Dallas, TX 75201

Marc Pensabene, Reg. No. 37, 416
mpensabene@omm.com
O'Melveny & Myers LLP
Times Square Tower
7 Times Square
New York, NY 10036

Mark Liang, Reg. No. 81,045
mlaing@omm.com
Sorin G, Zaharia
szaharia@omm.com
O'Melveny & Myers LLP
Two Embarcadero Center, 28th Floor
San Francisco, CA 94111

omm-samsung-oura@omm.com

Dated: October 31, 2024

/s/ Jasjit S. Vidwan

Jasjit Vidwan, Reg. No. 72,080
ARENTFOX SCHIFF LLP
1717 K Street, NW
Washington, DC 20006-5344
Tel.: 202.857.6000
jasjit.vidwan@afslaw.com

Attorney for Patent Owner