

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ULTRAHUMAN HEALTHCARE PVT. LTD, ULTRAHUMAN HEALTHCARE
SP LLC, and ULTRAHUMAN HEALTHCARE LTD.,
Petitioners

v.

OURARING, INC.,
Patent Owner

Case No. IPR2025-00411
U.S. Patent No. 11,868,178

**PETITIONERS' MOTION TO JOIN OR CONSOLIDATE
PURSUANT TO 37 C.F.R. § 42.222 AND 35 U.S.C. §§ 315(d), 325(d)**

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I. STATEMENT OF RELIEF REQUESTED

Under 37 C.F.R. § 42.222 and 35 U.S.C §§ 315(d), 325(d), Ultrahuman Healthcare Pvt. Ltd., Ultrahuman Healthcare SP LLC, and Ultrahuman Healthcare Ltd. (collectively, “Ultrahuman” or “Petitioners”) respectfully request to join or in the alternative consolidate the concurrently filed Petition for *Inter Partes* Review of U.S. Patent No. 11,868,178 (“the ’178 Patent”) (“Ultrahuman’s Petition”) with pending post-grant review *Samsung Electronics Co., Ltd. et al. v. Ouraring, Inc.*, PGR2024-00030 (“the Samsung PGR”), filed on May 31, 2024. Ultrahuman has conferred with Samsung, which has no objection to the relief requested in this Motion.

Ultrahuman’s Petition for *inter partes* review was filed less than one year after the date on which Petitioners were served with Patent Owner’s complaint alleging infringement of the ’178 Patent and is thus timely filed under 35 U.S.C. § 315(b). Likewise, Ultrahuman is filing this motion to join or consolidate within the one month period set by 37 C.F.R. §42.222(b) to request joinder.

Ultrahuman’s Petition mirrors and is substantively identical to the petition filed in the Samsung PGR (“Samsung’s Petition”) with respect to invalidity over the prior art. Namely, Ultrahuman challenges the same claims of the ’178 Patent on the same grounds set forth in Grounds 1-10 of Samsung’s Petition, relying on the same

prior art references, same arguments, and same evidence to do so.¹ Accordingly, Ultrahuman's Petition should be instituted for the same reasons the Board granted institution of Samsung's PGR. *See generally Samsung Elecs. Co. v. Ouraring, Inc.*, PGR2024-00030, Paper 9 (P.T.A.B. Dec. 6, 2024).

Indeed, the only differences between Ultrahuman's Petition and Samsung's Petition include the following: (1) removing all challenges made in Samsung's Petition to claim 11, which Patent Owner has since disclaimed from the '178 Patent; (2) consistent with 35 U.S.C. § 311(b), maintaining only the challenges made pursuant to 35 U.S.C. § 103 in Samsung's Petition; (3) updating the relevant mandatory notices to reflect Ultrahuman as the petitioner, including the notices relating to Real Parties-In-Interest, Related Matters, and designated Counsel; (4) updating the sections related to *Advanced Bionics* and other Discretionary Denial considerations (*Fintiv*) in view of recent developments; and (5) streamlining certain other sections, including the background section regarding the '178 Patent, the overview of the prior art, and certain other arguments throughout to comply with the shorter, 14,000 word count requirement set forth in 37 C.F.R. § 42.24(a)(1)(i) for

¹ Because § 112 challenges cannot be brought in an IPR, Ultrahuman does not include Ground 11 from the Samsung Petition. Further, Ultrahuman's Petition does not include a challenge to claim 11, which the Patent Owner has disclaimed.

IPRs. Petitioners represent that they have made no substantive changes to the arguments set forth in Grounds 1-10 of Samsung's Petition; thus, the relevant arguments in Ultrahuman's Petition and Samsung's Petition are substantively identical.

The fact that Samsung's PGR is already pending on the same patent is not sufficient to warrant discretionary denial of Ultrahuman's Petition here, as Samsung and Ultrahuman are different parties that do not possess a "significant relationship" with each other. *See Videndum Prod. Sols., Inc. v. Rotolight Ltd.*, No. IPR2023-01218, Paper 12 at 5-7 (P.T.A.B. Apr. 19, 2024) (determining that "where, as here, the first and second petitioners are neither the same party, nor possess a significant relationship" it is inappropriate for the Board to exercise its discretion to deny a petition because a prior petition challenging the same patent has already been filed). Instead, the identity of Ultrahuman's Petition and Samsung's Petition favors institution of Ultrahuman's Petition and joinder with the recently instituted Samsung PGR, not discretionary denial. Indeed, doing so will avoid duplicative proceedings and conserve resources for both the Board and the parties.

37 C.F.R. § 42.222(b) provides a procedural mechanism for joining an IPR to a pending post-grant review. Petitioners' request for joinder to the Samsung PGR under this mechanism is timely, as it is made "no later than one month after the institution date." 37 C.F.R. § 42.222(b). Joinder would also be an appropriate and

efficient exercise of the Board’s discretion because (i) Ultrahuman’s Petition is substantively identical to the petition in the Samsung PGR as it pertains to the grounds challenging the validity of the ’178 Patent under 35 U.S.C. § 103, and (ii) Ultrahuman agrees to serve in an “understudy role” and relies upon the same expert declaration as relied upon in the Samsung PGR, simplifying briefing and discovery. Joinder will thus provide for a just, speedy, and inexpensive determination of related proceedings.

Alternatively, 35 U.S. Code § 315(d) provides that “during the pendency of an inter partes review,” like Ultrahuman’s IPR, “if another proceeding or matter involving the patent is before the Office,” like Samsung’s PGR, “the Director may determine the manner in which the [IPR] or other proceeding or matter may proceed, including providing for . . . consolidation . . . of any such matter or proceeding.” 35 U.S.C. § 315(d); *accord* 35 U.S.C. § 325(d) (indicating the same “during the pendency of any post-grant review”). Similarly, 37 C.F.R. § 42.222(a) expressly contemplates such situations where there are “[m]ultiple proceedings” involving the same patent, stating, “[w]here another matter involving the patent is before the Office, the Board may during the pendency of [a] post-grant review”—like Samsung’s PGR—“enter any appropriate order regarding the additional matter,” such as Ultrahuman’s IPR, “including providing for the . . . consolidation . . . of any such matter.” 37 C.F.R. § 42.222(a); *accord* 35 U.S.C. § 325(d).

Accordingly, each of 35 U.S.C. §§ 315(d), 325(d), and 37 C.F.R. § 42.222(a) allow the Board to join or consolidate Ultrahuman’s IPR with Samsung’s PGR because both are “proceedings” or “matters” before the Office involving the same patent. Thus, Petitioners’ request for joinder is procedurally and substantively proper and, at minimum, consolidation of the “matters” involving the same ’178 Patent—Ultrahuman’s IPR and Samsung’s PGR—would be an appropriate use of the Board’s discretion.

For these reasons, Ultrahuman respectfully requests that the Board grant this motion, and either join or consolidate IPR2025-00411 with PGR2024-00030.

II. STATEMENT OF MATERIAL FACTS

1. The owner of the ’178 Patent, Ouraring, Inc. (“Patent Owner”), sued Ultrahuman alleging infringement of the ’178 Patent in the Eastern District of Texas, Marshall Division, on March 14, 2024. *See* First Am. Compl. ¶ 2, *Oura Health Oy v. Ultrahuman Healthcare Pvt. Ltd.*, No. 23-cv-00396 (Mar. 14, 2024), ECF No. 9 (Gilstrap, J.).

2. On May 31, 2024, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) timely filed a petition for post-grant review challenging claims 1-18 of the ’178 Patent. *Samsung Elecs. Co., Ltd. v. Ouraring, Inc.*, PGR2024-00030, Paper 3 (P.T.A.B. May 31, 2024).

3. On September 10, 2024, Patent Owner filed a disclaimer under 37 C.F.R. 1.321(a) for claim 11 of the '178 Patent. *Samsung Elecs. Co. v. Ouraring, Inc.*, PGR2024-00030, Patent Owner Oura Ex. 2015 at 0005 (P.T.A.B. Sept. 10, 2024).

4. On December 6, 2024, Samsung's PGR was instituted: (1) on claims 1-10 and 12-18, excluding the disclaimed claim 11; and (2) on all asserted grounds, including the § 103 challenges asserted in Grounds 1-10. *Samsung Elecs. Co. v. Ouraring, Inc.*, PGR2024-00030, Paper 9 at 2, 6-7, n.2 (P.T.A.B. Dec. 6, 2024).

5. On January 6, 2025, Ultrahuman filed its Petition for *Inter Partes* Review of the '178 Patent, as well as the present Motion, a date which is “no later than one month after the institution date” of the Samsung PGR. *See* 37 C.F.R. § 42.222(b).

III. LEGAL STANDARDS

A. Request for Joinder—37 C.F.R. § 42.222(b)

37 C.F.R. § 42.222(b) specifically states:

(b) *Request for joinder.* Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant review for which joinder is requested.

The Board has previously found that motions for joinder should “(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of

unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4 (PTAB July 29, 2013); *see also Samsung Elecs. Co., Ltd. v. Wepay Glob. Payments LLC*, PGR2022-00045, Paper 9 at 11-13 (P.T.A.B. Dec. 20, 2022).²

B. Multiple Proceedings—35 U.S.C. §§ 315(d), 325(d); 37 C.F.R. § 42.222(a)

35 U.S.C. § 315(d) provides:

Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

35 U.S.C. § 315(d); *see also* 35 U.S.C. § 325(d) (reciting substantially the same except replacing “inter partes review” with “post-grant review”).

Relatedly, 37 C.F.R. § 42.222(a) states:

² The rules regarding joinder of IPRs, 37 C.F.R. § 42.122(b), and PGRs, 37 C.F.R. § 42.222(b), are functionally the same such that decisions regarding IPR joinder are equally applicable to PGR joinder.

(a) *Multiple proceedings.* Where another matter involving the patent is before the Office, the Board may during the pendency of the post-grant review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.

IV. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Ultrahuman’s motion is timely.

Joinder. A Motion for Joinder under 37 C.F.R. § 42.222(b) is timely if the moving party files within one month of institution of the post-grant review for which joinder is requested. Because Ultrahuman files this motion less than one month after a decision on the institution of the Samsung PGR, this motion is timely. *See Samsung Electronics Co., Ltd. v. Ouraring, Inc.*, PGR2024-00030, Paper 9 (PTAB December 6, 2024).

Consolidation. Section 315(d) merely states that “consolidation” with “another proceeding or matter involving the patent [that] is before the Office” is permitted “during the pendency of an inter partes review.” 35 U.S.C. § 325(d) and 37 C.F.R. § 42.222(a) similarly state that “consolidation” of another matter involving the same patent is permitted “during the pendency of the post-grant review,” and are likewise silent as to any additional timing requirements for consolidation. As Samsung’s PGR is still pending, consolidation with Ultrahuman’s IPR, timely filed today, is also appropriate.

B. Joinder or consolidation is warranted.

Joinder is appropriate because Ultrahuman's Petition does not raise any new grounds of unpatentability and does "not present issues that might complicate or delay" the Samsung PGR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). As discussed, Ultrahuman's Petition is substantially identical to the petition in the Samsung PGR, challenging the same claims of the '178 Patent on substantially the same grounds and relying on the same expert declaration. The only differences between the two account for the fact that Ultrahuman is filing a petition for *inter partes* review, as opposed to a petition for post-grant review; no substantive changes have been made to any of the parallel arguments. Indeed, Ultrahuman has re-filed the same declaration of Dr. Brian W. Anthony. Joinder would therefore have little, if any, impact on the Samsung PGR because no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on the Patent Owner.

In fact, given the identity of the issues, joinder would eliminate the possibility of duplicative efforts and ensure a just, speedy, and inexpensive resolution of these proceedings. Accordingly, to the extent Petitioners' request for joinder is denied, for the same reasons discussed herein, consolidation of Ultrahuman's IPR and Samsung's PGR would still be appropriate. For example,

Ultrahuman's IPR should be instituted for the same reasons as Samsung's PGR, and the fact that Samsung's PGR is pending does not alone warrant basis for discretionary denial. Therefore, consolidation would avoid a briefing schedule in which due dates in the instant proceeding are delayed by six months as compared to the instituted Samsung PGR. Furthermore, since the instant petition and the instituted Samsung PGR recite substantially the same grounds and involve the same art, consolidation would also avoid the need for Patent Owner to file papers with the Board which presumably are substantially the same in both proceedings, mitigating unnecessary wastefulness for both the Board and Patent Owner.

1. There are no new grounds of unpatentability in the Petition.

Ultrahuman's Petition does not assert any new grounds of unpatentability. As stated herein, it challenges the same claims (1-10 and 12-18) of the '178 Patent, with the exception of disclaimed claim 11, based on substantially the same arguments, evidence, and grounds of unpatentability as the Samsung PGR, particularly the grounds also permitted under 35 U.S.C. § 311(b).

2. There would be no impact on the schedule for the existing PGR proceeding.

Because Ultrahuman's Petition raises no new grounds of unpatentability, and because a Scheduling Order has been established for the Samsung PGR less than one month ago, joinder or consolidation should have no impact on the schedule of the

Samsung PGR. Ultrahuman will adhere to all applicable deadlines set in the Scheduling Order for the Samsung PGR. Additionally, no additional expert discovery will be needed because Ultrahuman's Petition relies upon the same declaration testimony from the same expert as relied upon by the petition in the Samsung PGR.

Further, if joined or otherwise consolidated, Ultrahuman will not file additional briefs outside of the consolidated filings, will not request any additional deposition time, and will not request any additional oral hearing time. In the event that the Samsung PGR is terminated with respect to the petitioner, Ultrahuman intends to "step into the shoes" of the dismissed petitioner and materially participate in the joined or consolidated proceedings.

Thus, for the reasons stated above, joinder or consolidation of Ultrahuman to the Samsung PGR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 326(a)(11) and 37 C.F.R. § 42.200(c).

3. Briefing and discovery will be simplified by joinder or consolidation.

Ultrahuman agrees to an "understudy" role and does not raise any issues that are not already before the Board. In particular, Ultrahuman agrees that, if joined or consolidated, the following conditions will apply so long as Samsung remains an active party, as previously approved by the Board in similar circumstances:

(a) all filings by Ultrahuman in the joined or consolidated proceeding be consolidated with the filings of Samsung, unless a filing solely concerns issues that do not involve Samsung;

(b) Ultrahuman shall not be permitted to raise any new grounds not instituted by the Board in the Samsung PGR, or introduce any argument or discovery not already introduced by Samsung;

(c) Ultrahuman shall be bound by any agreement between the Patent Owner and Samsung concerning discovery and/or depositions; and

(d) Ultrahuman at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for Samsung in this proceeding alone under 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Samsung. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5–6 (P.T.A.B. Apr. 10, 2015) (finding the same proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s assertion that its presence would not require introducing any additional arguments, briefing, or discovery”). Ultrahuman would assume a primary role only if Samsung ceased to participate in the proceeding. Briefing and discovery will be simplified in that there will be no need for redundant depositions, briefing, or hearings.

Joinder or consolidation is therefore a means to conserve Board resources and to protect the Patent Owner from otherwise duplicative proceedings. Joinder or

consolidation also helps achieve the AIA's goals of providing an alternative, cost effective, efficient mechanism for the resolution of validity disputes. By permitting joinder or consolidation, the Petitioners and the Patent Owner, as well as the Board, reap the presumptive cost, time, and overall efficiency benefits of a single proceeding.

4. There is no prejudice to the Patent Owner.

Joinder or consolidation of Petitioners to the Samsung PGR will not create any additional burden on the Patent Owner. The Patent Owner need not expend additional resources above and beyond those required in the Samsung PGR. Moreover, joinder or consolidation eliminates the need for the Patent Owner to participate in parallel proceedings instituted upon identical grounds of unpatentability and therefore protects the Patent Owner from otherwise duplicative proceedings. Accordingly, the rights of the Patent Owner would not be prejudiced by Petitioners' request for joinder of the issues to the original proceeding or for consolidation of Ultrahuman's IPR and Samsung's PGR.

V. CONCLUSION

Joining or consolidating the instant Petition and corresponding IPR proceeding with the instituted PGR proceeding would significantly reduce the burden on the Board and original parties. In particular, (1) the issues involving 35 U.S.C. § 103 set forth in the petitions are identical; (2) duplicative filings and

discovery would be eliminated; (3) discovery would be consolidated with one expert between petitioners; (4) one attorney will conduct cross-examination and redirect of involved witnesses; and (5) the trial schedule will not be impacted.

For these reasons, Ultrahuman respectfully requests that its Petition for *Inter Partes* Review of the '178 Patent be granted and that the proceedings be joined or consolidated with PGR2024-00030.

Dated: January 6, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. §42.6(E)(1))

The undersigned hereby certifies that the above document was served on January 6, 2025, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering an electronic copy via express mail upon the following attorneys of record for the Patent Owner:

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