

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' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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I. INTRODUCTION

Patent Owner's request for discretionary denial omits key facts, including that Petitioners' request to participate in an *understudy role* in the related Samsung PGR2024-00030 will neither expand the issues under consideration nor modify the existing schedule, and that the issues raised in the Petition minimally overlap with the validity issues at the ITC. Patent Owner's request should be denied for at least three reasons.

First, while Patent Owner argues the Petition is weak on the merits, that argument is belied by the fact that the Board has already instituted the Samsung PGR on *the same grounds* requested here. It follows that the instant Petition raises the same question of patentability the Board deemed worthy of review only a few months ago. Patent Owner also glosses over the fact that Petitioners are not seeking to start an IPR *ab initio*, but instead is seeking to *join* Samsung's in-progress PGR as understudy counsel. The instant Petition in no way expands the scope of that PGR, nor does it impact the schedule in any way. And absent an extension at the ITC, the Final Written Decision in that PGR is due less than two months after the completion of the Presidential Review Period at the ITC.

Second, the ALJ's Initial Determination ("ID") is a non-binding, non-final ITC decision. Contrary to Patent Owner's assertions, it has no estoppel or preclusive effect. *See Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 851 F.2d 342, 344

(Fed. Cir. 1988). Further, it was limited to only five claims (whereas there are seventeen claims at issue here), addressed only one of the ten invalidity grounds at issue here, and did not address two of the four prior art references at issue here. Thus, beyond lacking preclusive effect, the ID fails to address almost the entirety of the issues raised by the Petition, making the PTAB best-positioned to conduct a fulsome and definitive review of these claims.

Third, Patent Owner mischaracterizes and gives short service to the “additional factors” from the PTAB’s March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management. By focusing almost exclusively on the two factors that duplicate the *Fintiv* analysis, Patent Owner completely ignores the two truly additional factors—that the claims have been in force for only 17 months, and the compelling economic and public health implications—both of which compel not exercising discretionary denial. Left with no argument on the merits, Patent Owner resorts to irrelevancies and mudslinging, claiming that Petitioners waited to see “how its arguments played out” at the ITC before filing. (Br. at Section III.A.6.)¹ Patent Owner’s timeline, however, does not track. This Petition was filed on January 6, 2025—before the statutory deadline for filing IPRs and joinder motions—and

¹ Petitioners cite to the relevant sections of Patent Owner’s Brief in Support of its Request for Discretionary Denial because the brief fails to include page numbers.

before the ID issued. There has been no gamesmanship here, and Patent Owner's criticism of Petitioners' exercise of statutory rights is not well taken.

The Board should deny Patent Owner's request and grant Petitioners' motion to join the Samsung PGR.

II. ARGUMENT

The lack of overlap between the issues raised by the Petition and those addressed by the ID strongly favors rejecting Patent Owner's request for discretionary denial. So too does the fact that the merits of the Petition are strong, given that the same grounds were instituted in the Samsung PGR that this Petition seeks to join. The remaining factors are either neutral or slightly favor discretionary denial, but are insufficient to surmount the weight of the lack of overlap and strength of merits factors.

A. *Fintiv* Factors 4 And 6 Strongly Favor Institution And Joinder.

1. Factor 4: There Is Minimal Overlap With The ITC Investigation Because The Petition Challenges Different Claims, Presents Different Grounds, And Relies On Additional References.

The Board commonly institutes IPRs where, as here, there is minimal overlap between the IPR and a parallel ITC case. The ID from the parallel ITC case addressed only 5 claims whereas the Petition asks the Board to consider the *validity*

*of all 17 claims.*² The ITC litigation could not address any dispute as to the vast majority (12 out of 17) of the challenged claims that remain. Thus, the concern of “multiple tribunals” deciding “challenge[s] involving the same patent claims” simply is not present here. (Ex. 2009 at 2.)

A myriad of cases support not exercising discretionary denial for this reason alone. For example, in *Apple, Inc. v. Alivector, Inc.*, the Board instituted, stressing that “the Petition includes materially different grounds, arguments, and/or evidence than the ITC Investigation.” IPR2021-00970, Paper 10 at 18, 48 (P.T.A.B. Dec. 8, 2021). As another example, the Board has instituted where “only four of the nine challenged claims in [the IPR] are also at issue in the ITC proceeding.” *Volkswagen Grp. of Am., Inc. v. Arigna Tech. Ltd.*, IPR2021-01321, Paper 10 at 8, 32 (P.T.A.B. Feb. 15, 2022) (declining to exercise discretion to deny institution finding that “the additional claims at issue here, but not in the ITC proceeding, weigh against exercising our discretion to deny institution”); *see also 3Shape A/S v. Align Tech., Inc.*, IPR2020-00223, Paper 12 at 34-35 (P.T.A.B. May 26, 2020) (instituting *inter partes* review where a parallel “ITC investigation will not address the validity of” 6 claims “and, for those claims that are addressed, the ITC will apply a more stringent standard”). These cases warrant the same result here.

² Claim 11 was disclaimed under 37 C.F.R. 1.321(a).

On top of that, “the ITC does not have the authority to invalidate a patent, and thus ITC decisions do not preempt issues addressed in an *inter partes* review proceeding.” *Samsung Elecs. Co., Ltd. v. BiTMICRO LLC*, IPR2018-01545, Paper 14 at 24 (P.T.A.B. Mar. 7, 2019) (“Samsung”); *see also Wirtgen Am., Inc. v. Caterpillar Paving Prods. Inc.*, IPR2018-01201, Paper 13 at 12 (P.T.A.B. Jan. 8, 2019).

The art and combinations are also divergent. The Petition raises ten grounds for invalidity, but only one of those grounds was addressed at the ITC hearing and by the ID:

Ground	Summary	ITC Status
1	Claims 1-3 and 17-18 are obvious over Schröder (Ex-1007).	Not asserted at hearing or addressed in ID
2	Claims 1-3 and 13-16 are obvious over Schröder in view of Niwa (Ex-1005, 1007).	Not asserted at hearing or addressed in ID
3	Claims 3 and 12 are obvious over Schröder in view of Mestas (Ex-1007,1010).	Not asserted at hearing or addressed in ID
4	Claims 1, 4-10 and 13-16 are obvious over Schröder in view of Yuen (Ex-1006, 1007).	Not asserted at hearing or addressed in ID
5	Claims 1-3 and 13-18 are obvious over Niwa (Ex-1005).	Not asserted at hearing or addressed in ID
6	Claims 1-3 and 13-18 are obvious over Niwa in view of Schröder (Ex-1005, 1007).	Asserted at hearing only as to claims 1-2 and 12-14
7	Claim 12 is obvious over Niwa in view of Mestas (Ex-1005, 1010).	Not asserted at hearing or addressed in ID
8	Claim 12 is obvious over Niwa-Schröder in view of Mestas (Ex-1005, 1007, 1010).	Not asserted at hearing or addressed in ID
9	Claims 4-10 are obvious over Niwa in view of Yuen (Ex-1005, 1006).	Not asserted at hearing or addressed in ID

10	Claims 4-10 are obvious over Niwa-Schröder in view of Yuen (Ex-1005, 1006, 1007).	Not asserted at hearing or addressed in ID
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Patent Owner’s argument that the ITC hearing has already occurred proves too much. It is the *overlap* of issues that matters, not the precise timing of parallel proceedings. Indeed, the Board has rejected a request for discretionary denial made after a trial at the ITC concluded, where the ITC’s target date was “six months before the [PTAB’s] statutory deadline for a final written decision,” and “6 of the 11 claims of the challenged patent” were not addressed at the ITC. *Klein Tools, Inc. v. Milwaukee Elec. Tool Corp.*, IPR2024-01400, Paper 17 at 15-19 (P.T.A.B. Apr. 8, 2025). Here, the target date in the parallel ITC case is closer to the final written decision here and more claims were not addressed at the ITC (12 of 17) than in *Klein Tools. Id.* Institution is warranted here for the same reasons it was warranted in that case.

In short, “[t]he record also does not support that the ITC will *ever* adjudicate the invalidity grounds raised here.” *Samsung Elecs. Co., Ltd. v. Sionyx, LLC*, IPR2024-01431, Paper 21 at 15-16 (P.T.A.B. Apr. 10, 2025) (“Sionyx”); *see also Volkswagen*, IPR2021-01321, Paper 10 at 8. Even Ground 6—the sole ground that *was* addressed by the ID—was only *partially* addressed because claims 3, 15-18 were not at issue in the ITC. There are also additional prior art references—Yuen and Mestas—raised in the Petition that were not raised at the ITC hearing or addressed by the ID. Regardless, the PTAB and the ITC apply different standards of

proof to the invalidity analysis. *3Shape*, IPR2020-00223, Paper 12 at 34; *see also Wirtgen*, IPR2018-01201, Paper 13 at 12. That too underscores the appropriateness of institution here.

Patent Owner does not argue that by finding claim 1 not invalid, the ID determined all invalidity issues as to the remainder of the dependent claims here. That argument is therefore waived. *See Ex Parte David Recchia, Timothy Gotsick, & Ryan Vest*, 2021 WL 2286993, at *5 (P.T.A.B. June 3, 2021) (“Arguments which [] could have made but did not make . . . are deemed to be waived.”) At any rate, that argument fails on the merits because only two invalidity grounds as to claim 1 were decided by the ID: anticipation by Niwa and obvious by Niwa in view of Schröder. Grounds 4 and 5 of the instant Petition—Schröder in view of Yuen and single reference obviousness as to Niwa,³ respectively—present invalidity arguments as to claim 1 that were not raised at the evidentiary hearing or addressed

³ Single reference obviousness, unlike obviousness based on combining one or more references, does not require a motivation to combine. Instead, the patent challenger must show that “it would have been obvious to modify that reference to arrive at the patented invention,” an entirely different analysis. *See Game & Tech. Co. v. Activision Blizzard Inc.*, 926 F.3d 1370, 1381 (Fed. Cir. 2019). Indeed, lack of motivation to combine Niwa and Schröder formed the foundation of the ID’s determination that combining those references did not render claim 1 obvious.

by the ID. *Sionyx*, IPR2024-01431, Paper 21 at 15-16; *see also Volkswagen*, IPR2021-01321, Paper 10 at 8.

Nor could the ID's determination as to claim 1 decide invalidity as to the dependent claims at issue here because those claims were not at issue in the ITC and necessarily present limitations that were never tested at the ITC. 35 U.S.C. § 112(d) (stating that dependent claims shall "specify a further limitation of the subject matter claimed" in the independent claim). Dependent claim 5, for example, is directed to "a charging component" for wireless charging. And dependent claim 7 is directed to collecting heart rate data and "selectively adjust[ing] a measurement periodicity . . . to acquire the heart rate data." (Ex-1001 at 45:48-49.) These claims, as just two examples, present invalidity issues far beyond the scope of claim 1. Thus, as in *Sionyx*, the record does not support that the ITC "will ever address the dependent claims at issue here." *Sionyx*, IPR2024-01431, Paper 21 at 15-16; *3Shape*, IPR2020-00223, Paper 12 at 34-35 (denying request for discretionary denial in part because dependent claims would not be addressed by ITC).

The ITC Investigation and this proceeding also have unique expert records with two different experts who have each opined separately on invalidity. That, coupled with the lack of overlap of claims, the unique grounds raised in the Petition, and the non-overlapping prior art at issue here all present a situation where the ID

did not “resolve key issues in the petition.” *Apple Inc. v. Fintiv, Inc.*, IPR2022-00019, Paper 11 at 13 (P.T.A.B. Mar. 20, 2020) (precedential).

Patent Owner relies on *BioRad* to support its argument that discretionary denial is appropriate in view of the parallel ITC case. (Br. at Section IV.A.) But that case is readily distinguishable because the overlap between the ITC case and the IPR in that case was substantial. *BioRad Lab ’ys., Inc. v. 10X Genomics, Inc.*, IPR2019-00568, Paper 22 at 24-25 (P.T.A.B. Aug. 8, 2019). Further, unlike here, the expert between proceedings was the same in *BioRad*. *Id.* And unlike *BioRad* where “none of the additional references listed by Petitioner are a part of any ground of unpatentability in the Petition,” the Yuen and Mestas references are part of the grounds in the Petition and were not “considered by the ALJ.” *Id.* at 23.

It would also be wholly unfair to deny institution in view of such minimal overlap given that Patent Owner is currently asserting *all* claims against Petitioners in the stayed district court case. Any risk of overlap with that case is minimal because there is no scheduling order in that case yet, none will issue until the stay is lifted after the completion of the ITC proceedings, and a final written decision will issue far before a trial date in EDTX. Institution would thus meet “an objective of the AIA” and “provide an effective and efficient alternative to district court litigation.” *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19

at 16-17 (P.T.A.B. Sept. 6, 2017).⁴ Regardless, Patent Owner created the multi-track environment that it now complains of by suing Petitioners in multiple fora (EDTX and the ITC). It is in no position to profit from such a decision and granting Patent Owner's request would be tantamount to allowing it to choose where and how the validity of its claims is tested.

Patent Owner's final argument as to Factor 4 is a bait and switch. Patent Owner effectively argues that by telling the ALJ that Samsung's PGR was *instituted*, Petitioners somehow conceded that the invalidity arguments in the ITC are the same as those at issue in the Samsung PGR (and thus here). (Br. at Section IV.E.) Patent Owner's argument proves too much, and it seeks to transform Petitioners' efforts to inform the ITC of a relevant development about the sole asserted patent into a concession. Petitioners know of no case—and Patent Owner cites none—where estoppel attaches to a notice of supplemental authority. Further, that the sole asserted patent might be invalidated because of grounds raised in a third party's petition makes no statement about the scope of invalidity before the ITC.

⁴ There will be no efficiency gains realized from granting the request for discretionary denial because this is a joinder petition and Petitioners will be taking an understudy role.

2. Factor 6: The Merits Of The Petition Are Unquestionably Strong As They Have Already Been Instituted By The Board.

There can be no question that the Petition is strong on the merits. The grounds presented are the same as those in the Samsung PGR, which the Board instituted. *Samsung Elecs. Co. v. Ouraring, Inc.*, PGR2024-00030, Paper 9 (P.T.A.B. Dec. 6, 2024) (“Ouraring”). To be sure, the Board would not have instituted if the merits were weak as PGR’s are instituted if “it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a).⁵ Historically, institution means all challenged claims are found invalid 70% of the time.⁶ And that this Petition adds no new issues, arguments, or deadlines and instead seeks to join the already-instituted Samsung PGR warrants institution and joinder here. *See Enzymotec Ltd. v. Neptune Techs. & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 5-7 (P.T.A.B. July 9, 2014).

Patent Owner makes only a single argument that the merits are not strong and that is with respect to Schröder. (Br. at Section IV.B.) But this lone argument ignores

⁵ The standard for institution of an IPR is similar: petitions are instituted if there is 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).

⁶ Ex-1068 (<https://ipwatchdog.com/2025/01/12/ptab-70-claims-invalidation-rate-continues-source-concern/id=184956/>)

the fact that the Board already instituted on grounds involving Schröder. *Ouraring*, PGR2024-00030, Paper 9 at 17-27. Setting Schröder aside, three grounds in the Petition do not include Schröder. And even stronger than *Sionyx*, where “very little argument, on the merits” was made by patent owner, Patent Owner here makes *no argument* as to those other grounds and has thus waived with respect to them. *Sionyx*, IPR2024-01431, Paper 21 at 17. And while of course Patent Owner is singing the praises of the ID, not only does the ID have no preclusive effect, the Commission has not yet weighed in on the decision.⁷ *Samsung*, IPR2018-01545, Paper 14 at 24.

The ID simply did not make the broad pronouncements about Schröder that Patent Owner implies. (Ex. 2015 at 81-107; Br. at Section IV.B.) Each of the three grounds at issue in the ID centered on Niwa: whether the claims were anticipated by Niwa, rendered obvious by Niwa and Schröder, and rendered obvious by Niwa and

⁷ Further undermining Patent Owner’s merits argument, the ID’s invalidity analysis found minimal issues with Petitioners’ invalidity case. For example, with respect to whether Niwa anticipates (a ground not at issue here), the ID found no anticipation based *solely* on the fact that Niwa did not disclose a dual housing structure. Patent Owner’s argument that the claims are clearly valid is not the slam dunk it suggests.

multiple battery references.⁸ (Ex. 2015 at 81-107.) Patent Owner's resort to merits-based arguments about the prior art thus miss the mark.

Patent Owner's arguments about Niwa illustrate why review is needed here. The ID determined that Niwa does not anticipate because "Niwa discloses a unitary housing 40 and does not disclose separate external and internal housing components." (*Id.* at 86.) Suffice it to say, Petitioners disagree. This determination was based on an erroneous and brand new claim construction that: (i) issued after the evidentiary hearing, (ii) construed terms that were previously construed during *Markman*, (iii) neither party asked for, and (iv) was based on a rebuttable presumption that Respondents never had the opportunity to brief, let alone rebut. (*Id.* at 85-86.) That new claim construction erroneously added a negative limitation (that the claims do not cover unitary housing structures) and read out express embodiments in the specification (Figures 4 and 16). (*Id.* at 85.) Nothing in the claim language requires two separate structures to satisfy the "[internal/external] housing component" limitations and numerous embodiments in the specification directed to unitary housings. (Ex-1001, Figs. 4, 6, 16A, 16B.) Indeed, Figures 4 and 16 show that the internal and external housing components (identified as inner and outer walls in Figure 16) can be subparts of the same "U-shaped" housing. (Ex-1001 at 20:67-

⁸ None of these battery references is at issue here.

21:1 (“the inner and outer walls 1612, 1614 are directly connected by floor 1618”).)

But rather than jump the gun on deciding this merits issue now, the proper course of action is to address it during a thorough and fulsome review—one that is going forward regardless in view of the Samsung PGR which Petitioners seek to join in an understudy role.

Finally, discretionary denial here would set a bad precedent that punishes petitioners who rightfully utilize the full statutory period of one year before filing a Petition. 35 U.S.C. § 315(b). There should be no detrimental impact for a timely-filed petition. On top of that, discretionary denial would also lead to inconsistent decisions between this Petition and the Samsung PGR. This Petition should be instituted and joined with the Samsung PGR for all the same reasons that PGR was instituted.

B. *Fintiv* Factors 1-3 And 5 Are Either Neutral Or Slightly Favor Discretionary Denial.

The remaining *Fintiv* factors do not override that discretionary denial is not warranted here for the reasons stated above with respect to Factors 4 and 6. With regard to these remaining Factors, Patent Owner fails to appreciate that the Petition is to join an ongoing PGR and its arguments miss the mark at any rate.

1. Factor 1 Highlights The Importance Of Factor 4.

As Patent Owner acknowledges, its case in EDTX against Petitioners is stayed pending completion of the ITC Investigation and thus the “weight of the lack of a

stay [] in the ITC Investigation itself depends, in part, on factor four.” *Sionyx*, IPR2024-01431, Paper 21 at 13. As in *Sionyx*, this factor “bears little weight” in the analysis and instead “elevates the importance of factor four.” *Id.*; see also *Klein Tools*, IPR2024-01400, Paper 17 at 14-15. Thus, this factor is neutral.

2. Factor 2 At Worst Only Slightly Favors Discretionary Denial.

Patent Owner argues that this factor favors discretionary denial because the ID issued “over a year before the Board would issue a Final Written Decision” in this Petition. (Br. at Section III.A.2.) Patent Owner’s argument misses the mark because it overlooks the fact that Petitioners’ request is to *join* the Samsung PGR—without changing any deadlines or in any way modifying the schedule—which is set for a Final Written Decision on December 6, 2025. Absent any extension of the target date by the Commission, the Final Written Decision if this Petition is joined with Samsung’s PGR would issue less than two months after the conclusion of the ITC’s 60-day Presidential Review Period and well-before any trial date in EDTX.⁹

⁹ The Commission often extends its Target Dates. In three recent examples, the Commission added 2-2.5 months to each Target Date. *Certain Mobile Phones, Components Thereof, and Prods. Containing Same.*, Inv. No. 337-TA-1375, EDIS Doc. ID 843768 (Feb. 18, 2025) (extending target date); *Certain Photovoltaic Connectors and Components Thereof*, Inv. No. 337-TA-1365, EDIS Doc. ID 837177 (Nov. 13, 2024) (same); *Certain Integrated Circuits, Components Thereof, and*

But that alone does not warrant discretionary denial. *See 3Shape*, IPR2020-00223, Paper 12 at 34 (instituting even where “the ITC Investigation will likely end before we issue a final written decision”); *see also Klein Tools*, IPR2024-01400, Paper 17 at 15. At worst, this factor only slightly favors discretionary denial. *Sionyx*, IPR2024-01431, Paper 21 at 13-14.

And while Patent Owner tries to downplay the stay of the district court case, the current median time-to-trial continues to increase in EDTX, now reaching 21.9 to 23.0 months. *Solus Advanced Materials Co., Ltd. v. Sk Nexilis Co., Ltd.*, IPR2024-01463, Paper 14 at 14 (P.T.A.B. Apr. 25, 2025). In that regard, even if the stay in the EDTX case is lifted immediately after the Presidential Review period at the ITC, it will likely not go to trial until the end of 2027. That is two years after the Final Written Decision date in the Samsung PGR and a full year after the Final Written Decision would issue for this IPR under Patent Owner’s flawed rubric that ignores Petitioners’ joinder request.

Prods. Containing the Same, Inv. No. 337-TA-1350, EDIS Doc. ID 816219 (Mar. 15, 2024) (same). A similar extension in the related ITC Investigation here would come perilously close to the Final Written Decision date. The ITC recently extended the Target Date in an investigation about wearable devices by nearly one year. *Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276, EDIS Doc. ID 806724 (Oct. 23, 2023).

3. Factor 3 Favors Institution And Joinder Because The Work Completed In The ITC Is Largely Irrelevant Here.

In analyzing Factor 3, Patent Owner overlooks that it is not sufficient to simply consider the *amount* of work completed in the parallel proceeding; the Board's holding in *Fintiv* also requires an analysis of the *type* of work completed. *Fintiv*, IPR2020-00019, Paper 11 at 9. And while Patent Owner spends nearly three pages listing every item of work done in the ITC Investigation, it makes no attempt to tie any of that work to the issues raised in the Petition. Much of the work relied on by Patent Owner is the general work performed in any litigation, such as “joint report on mediation” and “monthly case management conferences.” (Br. at Section III.A.3.) And the remaining items are largely irrelevant because of the lack of overlap between the ITC Investigation and the Petition as described in the analysis of Factor 4 above. (*See* Section II.A.1, *supra*.) This factor thus weighs against discretionary denial.

4. Factor 5 Favors Discretionary Denial.

Petitioners agree that there is a complete overlap of parties and thus this factor favors discretionary denial. However, this is the only factor that clearly favors discretionary denial and that is insufficient to outweigh the strong case for rejecting Patent Owner's request.

* * *

In view of the lack of overlap with the ITC case—the importance of which is emphasized by Factor 4—and the unquestionable strength of the merits here, the Board should reject Patent Owner’s request for discretionary denial.

C. Additional Factors Set Forth In The PTAB’s Workload Management Memorandum Support Denying Patent Owner’s Request.

Patent Owner’s brief includes a laundry list of grievances under the guise of “additional factors” that the Board should consider. But Patent Owner primarily reiterates arguments that are duplicative of those already covered in the *Fintiv* analysis while ignoring the most relevant considerations from the Acting Director’s March 26, 2025 Memorandum. (Br. at Section IV.)

1. Two Additional Factors That Do Not Overlap With The *Fintiv* Factors Require Denial Of Patent Owner’s Request.

The Board’s “Interim Processes for PTAB Workload Management” identified additional “relevant considerations” that the “parties are permitted to address” when requesting discretionary denial. (Ex-1069.) Patent Owner’s “additional” arguments—that the ITC has already adjudicated the claims as valid and that the unpatentability challenge is weak—fail for all the reasons described above with respect to Factors 4 and 6. In addition to the reasons described above pursuant to

these *Fintiv* factors, two additional considerations from the Memorandum that were completely ignored by Patent Owner also weigh against discretionary denial.¹⁰

First, the “settled expectations of the parties” factor does not support discretionary denial. The claims subject to the Petition have been in force for only about 17 months. Patent Owner, therefore, cannot have “some settled expectation of validity” and nor has Patent Owner presented any “evidence that the claims have been in force for so long without challenge” that it has any such expectation. *Green Revolution Cooling, Inc., v. Midas Green Techs., LLC*, IPR2025-00196, Paper 7 at 17-18 (P.T.A.B. May 23, 2025). Patent Owner has thus waived on this issue, and could not succeed on the issue anyway. *See Ex Parte David Recchia*, 2021 WL 2286993 at *5. To be sure, the ’178 Patent’s 17-month lifespan is dwarfed by the more than 5 year lifespan of the patent in the *Green Revolution Cooling* IPR. Further, the ’178 Patent was expedited through prosecution—it issued only 7 months after it was filed and was not subject to a single rejection on the merits. Patent Owner’s

¹⁰ Certain of the “relevant considerations” overlap with the *Fintiv* factors, including “strength of the unpatentability challenge” and whether “another forum has already adjudicated the validity or patentability of the challenged patent claims.” For the reasons described *supra*, those factors also do not support discretionary denial.

disclaimer of all claims of U.S. Patent No. 11,868,179 (filed and issued on the same day as the '178 Patent, with the same priority chain), all claims of U.S. Patent No. 11,874,701 (to which the '178 Patent is a continuation), and all but one dependent claim of U.S. Patent No. 11,599,147 (to which the '701 Patent is a continuation), also highlights that the validity of the '178 Patent and its family is far from “settled.” (Ex-1062; Ex-1063; Ex-1064.) All four patents recite the same basic ring structure. (See Ex-1001 at Cl. 1; Ex-1065 at Cl. 1; Ex-1066 at Cl. 1; Ex-1067 at Cl. 1.) And the PTAB has instituted review of U.S. Patent No. 9,582,034—the earliest patent to which the '178 Patent claims priority—in IPR2024-00928. The '178 Patent is thus hardly battle-tested and there can be no expectation of validity such that discretionary denial is warranted.

Second, “compelling economic [and] public health” considerations also militate in favor of denying the request for discretionary denial. The smart ring market is a quickly expanding one that provides many important health and wellness functions. It is still, however, very much in a nascent stage. There are compelling economic and public health implications if the Board does not give these claims close scrutiny before conferring Patent Owner an overly broad and undeserved monopoly. This is a particular concern here given the breadth of the claims (as argued by Patent Owner in the ITC proceeding) and the public health considerations raised by wearable rings that track a user’s biometric data. In fact, “modern wearable

devices are no longer only focused on simple fitness tracking measurements . . . they also monitor important physiological considerations, such as Heart Rate Variability.” (Ex-1038 at 2.) As to economic considerations, Patent Owner has sued or threatened nearly every one of its competitors and major smart ring manufacturers, and the public should not be subjected to such widespread assertion without fulsome review of Patent Owner’s claims by the PTAB. (Ex-1070.) Thus, granting Patent Owner a continued monopoly should be given careful consideration and discretionary denial is not warranted for this reason as well.

2. Patent Owner’s Manufactured “Additional” Factors Are Duplicative And Do Not Support Discretionary Denial At Any Rate.

Patent Owner argues that Petitioners engaged in gamesmanship with the goal of “disrupting the ITC Investigation and the stayed District Court cases.” (Br. at Section IV.C.) The argument for disruption makes no sense: Petitioners have in no way sought to leverage these proceedings in the ITC or in the District Court. Petitioners did not seek a stay on the basis of the Petition in either proceeding—nor could they in EDTX since that case has been stayed pending the ITC Investigation. Nor can there be any gamesmanship when Petitioners filed within the statutory time period to do so: if Congress wanted Petitioners to file for PTAB review more expeditiously, it would have set a shorter timeline. *See* 35 U.S.C. § 315(b). It did not. Petitioners should not be punished for exercising their full statutory rights. And

by seeking to *join* Samsung's PGR, rather than start a new proceeding *ab initio*, the Petition is on its face geared towards efficiency.

Patent Owner's arguments on the lack of a *Sotera* stipulation miss the mark entirely. A *Sotera* stipulation is not warranted where the District Court case is stayed at the earliest until a few weeks before the Final Written Decision issues if this Petition is joined with Samsung's PGR. While not dispositive as the PTAB's latest guidance makes clear, Petitioners have functionally implemented a *Sotera* stipulation between the Petition and the ITC case given the lack of overlap of issues raised in the two proceedings. And while Patent Owner complains of having to prepare invalidity defenses in EDTX, that is the cost of its strategic decision to sue in multiple fora.¹¹ At any rate, it is likely that Petitioners' invalidity contentions would not be due until a month *after* a scheduling conference occurs in that case,¹² with trial likely not occurring for nearly two years after the stay is lifted. Any preparation of invalidity defenses would be in their infancy by the time the Final Written Decision issues.

¹¹ And to the extent the same invalidity issues arise in that case as here, any effort by Patent Owner to defend its claims here would be applicable in EDTX.

¹² E.D. Tex. Pat. R. 3-3, available at <https://www.txed.uscourts.gov/?q=patent-rules>

Finally, Oura tries to create a new “reverse IPR estoppel” whereby any arguments raised at the ITC could not be raised at the PTAB. It cites no authority supporting its novel argument and Petitioners are aware of none. In fact, the Federal Circuit has held the exact opposite: ITC determinations have no collateral estoppel effect. *See Texas Instruments*, 851 F.2d at 344 (“[T]his court has stated that the ITC’s determinations regarding patent issues should be given no res judicata or collateral estoppel effect.”); *see also Samsung*, IPR2018-01545, Paper 14 at 24.

III. CONCLUSION

Institution and joinder here would serve the core policy goals of the America Invents Act: providing an efficient, expert-driven alternative to costly litigation, ensuring that unpatentable claims do not remain enforceable due to forum selection by Patent Owner, and protecting the public from invalid claims leading to monopolies. Discretionary denial would achieve the opposite and allow claims to escape review despite strong merits not yet adjudicated elsewhere.

The Board should deny Patent Owner’s request, institute the Petition, and join it with the Samsung PGR.

Dated: May 28, 2025

Respectfully submitted,

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

I hereby certify that the foregoing Petitioners' Opposition to Patent Owner's Request for Discretionary Denial contains 5,447 words as measured by the word-processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24(d).

Dated: May 28, 2025

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

The undersigned hereby certifies that the above document and Exhibits 1062-1070 were served on May 28, 2025, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering an electronic copy via email upon the following attorneys of record for the Patent Owner:

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