

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., FOSSIL GROUP, INC., FOSSIL STORES I, INC., FOSSIL
PARTNERS, L.P., OURA HEALTH OY, AND ONEPLUS TECHNOLOGY
(SHENZHEN) CO., LTD.,

Petitioners,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Patent No. 9,651,533

Case No. IPR2025-01250

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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LISTING OF EXHIBITS

Exhibit No.	Description
2001	Complaint, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Dec. 20, 2024)
2002	Samsung, Fossil, and Oura's Invalidity Contentions Cover Document and Charts for the '533 Patent, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (June 3, 2025)
2003	OnePlus's Invalidity Contentions Cover Document and Charts for the '533 Patent, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Sept. 30, 2025)
2004	Omni MedSci's Infringement Contentions Cover Document, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Mar. 12, 2025)
2005	Samsung, Fossil, and Oura's Motion to Stay, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Aug. 27, 2025)
2006	Order Denying Motion to Stay, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Aug. 29, 2025)
2007	Docket Navigator Statistics for District Judge James Rodney Gilstrap
2008	Lex Machina Statistics for District Judge James Rodney Gilstrap

2009	Model Order Focusing Patent Claims and Prior Art to Reduce Costs (E.D. Tex.)
2010	U.S. Patent No. 12,013,725
2011	Information Disclosure Statement for U.S. Patent No. 12,013,725 (Mar. 5, 2024)
2012	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00913, Paper 14 (PTAB Oct. 16, 2019)
2013	<i>Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC</i> , IPR2025-00482, Paper 13 (PTAB May 28, 2025)
2014	Complaint, <i>Omni MedSci, Inc. v. Apple Inc.</i> , 2:18-cv-00134 (E.D. Tex.) (Apr. 6, 2018)

Pursuant to the March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management” (“Director Memo”), Patent Owner Omni MedSci, Inc. (“Patent Owner”) respectfully requests that the Director exercise his discretion and deny institution of the Petition (Paper 1) challenging claims 6, 11-2, 14, and 18 of U.S. Patent No. 9,651,533 (“the ’533 Patent”).

I. INTRODUCTION

The parties are engaged in litigation involving the ’533 Patent in *Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-01070-JRG-RSP, in the Eastern District of Texas (“the Texas Case”). Each of the factors in the Board’s precedential *Fintiv* decision weigh in favor of denying institution in view of the advanced stage of the Texas Case. Judge Payne already denied Petitioners’ motion to stay. By the time the Board decides whether to institute an IPR, the parties will have completed claim construction briefing and the *Markman* hearing will be just days away. Most importantly, a jury trial in the Texas Case is scheduled nearly 6 months before the Board’s deadline to issue a final written decision (“FWD”).

Recognizing that these facts weigh strongly in favor of denying institution, Petitioners offer a *Sotera* stipulation, but this will not simplify the issues in the Texas Case because their invalidity contentions are more expansive than the Petition and rely on extensive alleged product prior art. Petitioners also argue (incorrectly) that the merits of the Petition are strong based on collateral estoppel from a prior IPR

concerning the '533 Patent, but this does not outweigh the other *Fintiv* factors. Petitioners' invalidity arguments can, and in fact will, be addressed in the Texas Case well before the Board would issue a FWD.

The Texas Case also concerns six additional patents. As set forth below, this Petition is one of eight filed by Petitioners that challenge the asserted patents:

Case No.	Patent No.	Institution Deadline
IPR2025-01249	9,055,868	February 9, 2026
<i>IPR2025-01250</i>	<i>9,651,533</i>	<i>February 9, 2026</i>
IPR2025-01251	10,874,304	February 12, 2026
IPR2025-01252	11,160,455	February 12, 2026
IPR2025-01253	12,193,790	February 12, 2026
IPR2025-01254	12,268,475	February 12, 2026
PGR2025-00063	12,268,475	February 12, 2026
PGR2025-00064	12,193,790	February 12, 2026

Petitioners challenge 59 claims across these patents even though only 32 of those claims are asserted in the Texas Case. The Director should exercise his discretion to deny these petitions (including this one) because it would be far more efficient to conduct one proceeding—the Texas Case—to resolve the parties' disputes, rather than eight additional proceedings in the Office.

The *General Plastic* factors also favor discretionary denial. This is the ***third*** petition challenging the '533 Patent and uses the same prior art combinations and expert as a prior petition filed by Apple that the Board already considered. Petitioners offer no justification for why they waited over ***7 months*** after the

Complaint to file their follow-on petition. The Board should decline to use its limited resources for yet another IPR of the '533 Patent.

Finally, settled expectations favor discretionary denial. The '533 Patent issued nearly 9 years ago. Petitioner Samsung has known about the '533 Patent for more than 8 years, and Petitioner Oura has known about the '533 Patent for at least 17 months.

II. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

The Board considers six factors to determine whether to deny institution based on one or more parallel proceedings:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). “[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or

instituting review.” *Id.* at 6. Each of these factors weigh in favor of denying institution in view of the Texas Case.

A. Factor 1 Weighs Against Institution

The first *Fintiv* factor weighs against institution because the district court has not granted a stay, nor is there evidence that one may be granted. *Fintiv*, Paper 11 at 7-8. On August 27, 2025, Petitioners moved to stay the Texas Case based on their IPRs. EX2005. On August 29, 2025, before Patent Owner filed its opposition, the district court *sua sponte* denied the motion as “premature.” EX2006.

It is unlikely that the Texas Case will be stayed even if the Board institutes an IPR. EX2007 (showing 21% grant rate for stay requests). By the time the Board issues an institution decision in February 2026, the parties will have already completed claim construction briefing, will be just days away from the *Markman* hearing (scheduled for February 13, 2026), and will be just weeks away from the close of fact discovery (March 30, 2026). *Infra*, §II.C. Any FWD would not be due until nearly 6 months after the jury trial. *Infra*, §II.B. On these facts, a post-institution stay is exceedingly unlikely in the Texas Case, and this factor strongly weighs against institution.

B. Factor 2 Weighs Against Institution

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this [second] factor in favor of exercising authority to

deny institution.” *Fintiv*, Paper 11 at 9. The projected statutory deadline for issuing a FWD for this IPR, if instituted, is February 8, 2027. Jury selection for the Texas Case is scheduled to begin nearly six months prior on August 17, 2026. EX1020.

The scheduled trial date is in line with the median time-to-trial statistics in the Eastern District of Texas: over the last ten years, the median time to trial for Judge Gilstrap's patent cases is 637 days. EX2008. The current August 17, 2026 trial date is 606 days from the Complaint's filing date, December 20, 2024. Using the median time to trial, the projected trial date would be September 18, 2026, which would still be nearly five months before the projected FWD deadline. Thus, this factor strongly weighs against institution.

C. Factor 3 Weighs Against Institution

The third factor concerns “the amount and type of work already completed in the parallel litigation by the court and the parties and the time of the institution decision.” *Fintiv*, Paper 11 at 9. Here, both the district court and the parties have invested substantial time and resources in the Texas Case and will continue to do so before any institution decision. As of the filing of this brief, the parties have negotiated a Docket Control Order regarding scheduling, engaged in motion practice, and have commenced fact discovery, including serving and responding to dozens of interrogatories and hundreds of requests for production. EX1020. The

parties have also already exchanged thousands of pages of infringement contentions and invalidity contentions. *See* EX2004; EX2002; EX2003.

By the time the Board decides whether to institute an IPR in February 2026, even more work will have been completed: the parties will have substantially completed their document productions and completed *Markman* briefing in January 2026, and a *Markman* hearing is scheduled on February 13, 2026. EX1020. The Texas Case will be at a very advanced stage by the time the Board issues an institution decision.

The timing of the Petition is also considered under the third *Fintiv* factor: if “the petitioner did not file the petition expeditiously ... or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.” *Fintiv*, Paper 11 at 11-12. Here, Samsung waited more than **8 years** to challenge the '533 Patent after it was notified of its existence. *Infra*, §V; EX2001, ¶¶110-25. Oura Health Oy was also aware of the '533 Patent given that its affiliate, Ouraring Inc., cited the '533 Patent in an IDS on March 5, 2024 during prosecution of its own patent. *Infra*, §V; EX2001, ¶124; EX2011, 1.

To the extent Samsung and Oura argue that they were justified in waiting to challenge the '533 Patent until they were sued for infringement, Petitioners still waited more than **seven months** after the filing of the Complaint. EX2001. Petitioners' delay is especially unwarranted because the Petition used a prior IPR

petition challenging the '533 Patent and associated FWD as a roadmap for this Petition. EX1005, 3; EX1003, 119-121; EX1004, 5-9. The only “new” reference (Tam) in this Petition is, according to Petitioner, no different than prior art that was considered during prosecution. Pet., 11-12. There is no justification for the seven months taken by Petitioners to prepare their follow-on Petition. Petitioners knew that the jury trial in the Texas Case would occur well before a FWD when they filed this Petition. Patent Owner submits that Petitioners delayed filing to use this IPR to gain another bite at the apple for validity should Patent Owner obtain a verdict of infringement and validity in the Texas Case.

D. Factor 4 Weighs Against Institution

Under factor 4, “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where a petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 13. That is precisely the case here. Petitioners’ invalidity contentions in the Texas Case challenge claims 11 and 12. EX2002, 2-3; EX2003, 3. The Petition challenges claims 11 and 12¹ as well. Pet., 7. Petitioners’ invalidity contentions in the Texas Case also cite “Lisogurski” and

¹ Patent Owner served its infringement contentions identifying asserted claims from the '533 Patent before Petitioners filed the Petition. EX2004.

“Carlson” as prior art against the '533 Patent, just like the Petition. EX2002, 14; EX2003, 14; Pet., 7. Notably, Lisogurski claims “pulse oximetry monitoring system[s]” and is assigned to “Covidien.” EX1025, 1, 55-56. Petitioners’ invalidity contentions also rely on “[p]ulse oximeters or similar products publicly disclosed, used, sold, or offered for sale by Covidien.” EX2002, 15; EX2003, 15. Thus, the Petition includes substantially the same claims, grounds, evidence, and arguments as the Texas Case.

Petitioners’ invalidity contentions in the Texas Case are more expansive than the Petition. They assert invalidity based on *thirty* alleged prior art systems and *eight* patents and printed publications (including Lisogurski and Carlson). EX2002, 14-16; EX2003, 14-16. Petitioners state that each Asserted Claim “is rendered obvious by combination with one or more other prior art references identified,” yielding billions of possible combinations. EX2002, 49; EX2003, 55. Petitioners’ invalidity contentions also assert invalidity based on lack of written description, lack of enablement, indefiniteness, and subject matter ineligibility. EX2002, 195-198; EX2003, 228-231.

Contrary to their suggestion, Petitioners’ *Sotera* stipulation does not ensure that there will be no overlapping issues between an instituted IPR and the Texas Case. Pet., 13. Petitioners’ stipulation is limited to patents and printed publications and does not prevent Petitioners from using product/system prior art in the Texas

Case if an IPR is instituted. Pet., 13. There are **30** alleged prior art products/systems identified in Petitioners' invalidity contentions in the Texas Case. EX2002, 14-16; EX2003, 14-16. As noted above, there is a substantial risk of overlapping issues because Petitioners rely on alleged product prior art from Covidien, which corresponds to the primary Lisogurski reference in the Petition.

The Board has denied institution of petitions accompanied by a *Sotera* stipulation where, as here, the "Petitioner's invalidity arguments in the district court are more expansive" than the petition. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (vacating institution decision despite *Sotera* stipulation). In fact, the Director has previously denied institution for a petition accompanied by a substantively identical stipulation as the one offered by Petitioners. *Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC*, IPR2025-00482, Paper 15 at 2 (PTAB July 24, 2025); *compare* Pet., 13 (Petitioners' stipulation) *with* EX2013, 11 (substantively identical stipulation).

E. Factor 5 Weighs Against Institution

This factor weighs against institution because Petitioners are the defendants in the Texas Case. EX2001; *Fintiv*, Paper 11 at 13-14.

F. Factor 6 Weighs Against Institution or is Neutral

Petitioners argue that Factor 6 weighs in favor of institution in light of the prior IPR finding some of the claims of the '533 Patent unpatentable. Pet., 14.

Specifically, Petitioner argues that the Petition is strong because Patent Owner is “collaterally estopped from relitigating the patentability of those cancelled independent claims upon which the Challenged Claims depend.” *Id.*, 15. This factor does not compel institution for at least two reasons.

Petitioners do not allege that collateral estoppel applies to the challenged dependent claims (claims 6, 11-12, 14 and 18). *Id.* The Board has held that “[c]ollateral estoppel does not apply [where] there are differences between the claim limitation at issue ... and the adjudicated claim limitations at issue in the prior IPRs.” *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01153, Paper 10 at 18 (PTAB Jan. 24, 2022); *see also MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1377-78 (Fed. Cir. 2018) (noting that whether collateral estoppel applies to dependent claims turns on whether they “present materially different issues that alter the question of patentability”); *Dr. Reddy's Lab'ys., Ltd. v. Monosol RX, LLC*, IPR2016-01111, Paper 14 at 16-17 (PTAB Dec. 5, 2016) (concluding collateral estoppel was inapplicable where a prior decision did not resolve whether the same prior art disclosed a different limitation from the challenged patent).

Petitioners' reliance on *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 (PTAB May 17, 2025) is misplaced. In *Netlist*, the Board preliminarily found at the institution stage that the patent owner was collaterally estopped from contesting the grounds in the petition because the challenged claims

were not patentably distinct from claims that were found unpatentable in a related patent. *Id.* at 20. This case is distinguishable from *Netlist* because even if Petitioners' contentions regarding collateral estoppel were correct (they are not), collateral estoppel is not case dispositive for the '533 Patent. *Id.* at 23 (finding that patentee was "collaterally estopped as to the challenges involved in the Petition"); Pet., 19-21 (only arguing that Patent Owner is estopped as to the independent claims from which the challenged claims depend).

Further, in *Netlist*, the petitioner mapped the limitations in the challenged claims to limitations in the invalidated claims and cited the FWDs addressing those limitations. *Id.* Petitioners have not offered such claim limitation mapping and analysis in their Petition. For example, Petitioners do not cite the previous FWD (EX1008) for:

- claim 6 and claim 14's "emits light with a bandwidth between 20 nanometers to 40 nanometers" element (Pet., 41-42, 57, 62-63; Pet., 45, 57, 65);
- claim 11 and claim 18's "one or more filters ... to select a fraction of the one or more optical wavelengths" element (Pet., 58-61; Pet., 58-61); or
- claim 12's "generated in part by comparing signals at different optical wavelengths" element (Pet., 43-44, 57).

Petitioners have not shown that the Challenged Claims present identical issues of patentability as the previously invalidated claims. Accordingly, Patent Owner is not

estopped from litigating the patentability of challenged dependent claims 6, 11-12, 14, and 18.

Petitioners also argue that Patent Owner “did not contest” the Examiner’s statement during prosecution that the prior art teaches the “emits light with a bandwidth between 20 nanometers to 40 nanometers” limitation in dependent claims 6 and 14. Pet., 10, 64. But Patent Owner distinguished that prior art reference based on a different element in the independent claims. EX1002, 756, 766. Patent Owner made clear that it “[did] not necessarily agree or acquiesce to ... the disclosure or teaching of any of the references as set forth in the rejection” and that it “amended [the] independent claims ... in light of the indication of other allowable subject matter.” *Id.* at 766.

Second, even if Petitioners were correct that *Fintiv* Factor 6 weighed in favor of institution (which it does not), this does not outweigh the other *Fintiv* factors discussed above. The Board takes a “holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6. In *Samsung Elecs. Co., Ltd., v. Sionyx, LLC*, the Board discretionarily denied institution despite “the strong merits of the Petition” and a *Sotera* stipulation because of “the proximity of the trial date as well as the investment and overlapping issues and parties in the district court case.” IPR2025-00064, Paper 16 at 21 (PTAB

June 6, 2025). Similarly, the fact that the jury trial in the Texas Case will occur several months before a FWD heavily weighs in favor of discretionary denial.

Petitioners' other cited cases for *Fintiv* factor 6 are distinguishable. *Embody, Inc. and Zimmer Biomet Holdings, Inc. v. Lifenet Health* involved a recently issued patent (2022) and, unlike this case, the *Fintiv* factors did not apply. IPR2025-00248, Paper 13 at 2-3 (PTAB June 26, 2025). In *Posco Co., Ltd. v. Arcelormittal*, *Fintiv* did not apply, in part, because the petitioner was not a party to the parallel ITC investigation. IPR2025-00370, Paper 10 at 2-3 (PTAB Jun. 25, 2025). Here, the '533 Patent issued in 2017, the *Fintiv* factors apply and favor discretionary denial, and every Petitioner is a party to the Texas Case.

III. THE TEXAS CASE WILL MOST EFFICIENTLY RESOLVE THE PARTIES' ENTIRE DISPUTE

As noted above, this Petition is one of eight IPR challenges to six utility patents that are asserted in the Texas Case. If each of the eight petitions is instituted, the Board would need to issue eight final written decisions, which will only resolve the parties' disputes for these patents if the Board finds that *every* asserted claim in the Texas Case is unpatentable.

By contrast, the Texas Case will resolve not only the parties' dispute regarding the '533 Patent but *all* of the parties' disputes for all six patents in a single proceeding. Congress designed IPRs "to provide an effective and efficient *alternative* to district court litigation." *General Plastic Co., Ltd. v. Canon Kabushiki*

Kaishaat, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential) (emphasis added). In this case, instituting an IPR would merely result in the creation of an ***additional*** proceeding.

It would be far more efficient to conduct one proceeding (the Texas Case) to resolve the parties' disputes rather than to strain the Office's limited resources in conducting eight proceedings that may not resolve all of the parties' disputes. Notably, Patent Owner is required to narrow the number of asserted claims in the Texas Case prior to trial. EX2009. By the time the parties reach trial, Patent Owner will be limited to "no more than a total of 16 claims." *Id.* at 2. Nevertheless, Petitioners would have the Board address the patentability of more than four times that number across the various petitions it has filed. The Board should decline to devote resources to considering claims that will no longer be part of the parties' disputes by the time of a FWD.

In arguing that institution would be an "an efficient use of Board resources," Petitioner cites *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (PTAB June 13, 2025). Pet., 14. In that case, the Director declined to discretionarily deny a series of petitions for "eleven patents spanning nine different families that involve a diverse range of subject matter" because "the Board is better suited to review a large number of patents involving diverse subject matter." *Tesla*, Paper 9 at 2-3. Here, the asserted patents in the Texas Case concern similar subject matter,

with five out of the six patents being from the same family. It would be more efficient for these patents to be litigated in the Texas Case.

Patent Owner submits that the Office should decline Petitioners' request to initiate such piecemeal and duplicitous litigation. It would be less burdensome for the parties to litigate all of their disputes in one proceeding. For these additional reasons, the Director should exercise his discretion to deny institution.

IV. THE *GENERAL PLASTIC* FACTORS STRONGLY FAVOR DISCRETIONARY DENIAL

The Director should also deny the Petition because it is the *third* of now four petitions challenging the '533 Patent:

Proceeding	Filing Date	Claims	Alleged Prior Art	Status
IPR2019-00913 ("913 IPR")	4/10/19	5, 7-10, 13, 15-17	Valencell-093, Valencell-099, Carlson, Mannheimer	Institution Denied
IPR2019-00916 ("916 IPR")	4/10/19	5, 7-10, 13, 15-17	Lisogurski, Carlson, Mannheimer	Final Written Decision
IPR2025-01250	8/5/25	6, 11-12, 14, 18	Lisogurski, Carlson, Tam	Pending
IPR2025-01583	9/26/25	6, 11-12, 14, 18	Lisogurski, Carlson, Tam, Walker	Pending

The Board considers the following factors in exercising its discretion to deny "follow-on" petitions repeatedly challenging the same patent:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew

- of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
 4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
 6. the finite resources of the Board; and
 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 9-10, 18. Where a second petition is filed by a *different* petitioner, the Board considers additional factors:

8. whether there may be potential prejudice to the subsequent petitioner if institution is denied and the pending instituted proceedings involving the first petitioner are terminated; and
9. whether multiple petitions filed against the same patent is a direct result of Patent Owner's litigation activity.

Samsung Electronics Co., Ltd., v. Iron Oak Techs., LLC, IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019). On balance, these factors favor discretionary denial.

While Petitioners do not appear to have a direct business relationship with the prior petitioner (Apple), the Board has extended *General Plastic* to unrelated petitioners. *See, e.g., Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 12 (PTAB Mar. 17, 2020) (finding that while second petitioner was unrelated to the first, “[t]he instant Petitioner’s decision to use the prior petitions as a roadmap for its own petition ties the interests of all the petitioners together”); *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2017-01305, Paper 11 at 19 (PTAB Oct. 17, 2017) (“[T]he high degree of similarity of Samsung’s instant Petition with the prior petitions” and “Petitioner’s use of the same expert ... reduces the weight we accord” *General Plastic* factor 1). As discussed above, Petitioners use the same prior art combination and the same expert as the 916 IPR filed by Apple. Pet., 14. Indeed, the Petition cites the Apple Petition 30 times+ and the prior FWD 80+ times. Petitioners’ expert repeatedly incorporates by reference and refers to his declaration from the prior IPR. EX1003, ¶11 (“I incorporate my opinion regarding the obviousness of independent claims 5 and 13 from my Prior ’533 Declaration by reference”); *see also id.*, ¶¶40, 94, 98, 112-13, 116, 118, 120-21, 123, 125, 127, 131, 135, 139-40, 143, 145-47, 155-56, 158, 165-67, 169, 174-80, 183-84; EX1004.

Petitioners not only were able to use the Petition in the prior IPR as a starting point but also had the benefit of being able to review Patent Owner’s responsive arguments, the Board’s findings, and the Federal Circuit’s affirmance when

preparing their Petition. Even if Petitioners had no prior knowledge of the '533 Patent (and the prior IPR) before they were sued for infringement, Petitioners offer no justification for why it took *seven months* after the Complaint was filed to prepare a follow-on Petition that uses a prior petition and corresponding FWD as a roadmap to challenge the dependent claims. EX2001. While the Petition challenges dependent claims that were not at issue in the prior IPRs, Petitioners argue that these claims are similar to the previously challenged claims. *Juniper Networks, Inc. v. Orckit Corp.*, IPR2024-00895, Paper 15 at 5-7 (PTAB Dec. 11, 2024) (denying institution under *General Plastic* where second petition challenged different but “substantially similar” claims as first petition)

There is no undue prejudice to Petitioners if institution is denied because the prior IPR decision is final. Petitioners can raise the invalidity arguments in the Texas Case and have them heard by a judge and/or jury before the Board would issue a FWD. Patent Owner submits that the Board should not expend its limited resources reviewing a *third* petition challenging the '533 Patent.

V. SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

“Settled expectations of the parties, such as the length of time the claims have been in force[,]” warrant discretionary denial. Director Memo at 2. The '533 Patent issued nearly 9 years ago. EX1001, 1. Petitioners' argument that Patent Owner cannot have any expectation that the challenged claims are patentable in view of the

prior IPR is misplaced. Pet., 15. The prior petitioner, Apple, chose not to challenge the claims Petitioners now challenge in this IPR. EX1005, 3; EX1008, 51. Apple filed two petitions challenging the '533 Patent (one was instituted, one was denied), so it had ample opportunity and word count to challenge those claims. Further, Apple challenged more claims of the '533 Patent in its IPRs than those that were asserted in the underlying lawsuit. EX2014, ¶36.

The challenged claims also differ from the claims challenged in the 2019 IPR because they recite additional limitations relative to the claims found unpatentable:

- Claim 6 and claim 14 depend directly on claims 5 and 13, respectively, but add the “emits light with a bandwidth between 20 nanometers to 40 nanometers” limitation. EX1001, 49-50.
- Claim 11 and claim 18 depend directly on claims 5 and 13, respectively, but add the “one or more filters in front of one of more detectors to select a fraction of the one or more optical wavelengths” limitation. EX1001, 49-50.
- Claim 12 depends directly on claim 5, but adds the “a plurality of optical wavelengths, and the output signal is generated in part by comparing signals at different optical wavelengths” limitation. EX1001, 49.

None of these limitations were considered in the 2019 IPR. The foregoing has led Patent Owner to have settled and reasonable expectations that the claims not challenged in the 2019 IPR were valid.

At least two Petitioners have known about the '533 Patent for *years* prior to the Petition. Samsung, whose counsel from the Texas Case is Lead Counsel for this proceeding, knew about the '533 Patent for more than *8 years* before seeking to challenge its validity. EX2001, ¶¶110-25. Petitioner Oura Health Oy was also aware of the '533 Patent through its own patent prosecution. *Id.*; *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB Jun. 6, 2025) (petitioner's citation to challenged patent in IDS demonstrated prior knowledge). Specifically, Oura Health Oy's U.S. affiliate Ouraring Inc.'s U.S. Patent No. 12,013,725, which issued on June 18, 2024, lists the '533 Patent on its face after having been listed in an IDS filed on March 5, 2024. EX2010, 3; EX2001, ¶124; EX2011, 1. Samsung and Oura Health Oy's failure to raise any challenge to the '533 Patent despite being aware of it led Patent Owner to have settled and reasonable expectations that it would not face yet another challenge to the validity of the '533 Patent from these entities.

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise his discretion and deny institution.

Patent No. 9,651,533
IPR2025-01250

Patent Owner's Discretionary Denial Brief

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's**

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