From:	Daniel Kim
To:	Hayes, Jennifer; Christopher, Angelo; James Davis; Stringfield, Daniel; Maloney, Timothy; Holt, Benjamin; Georgiev, Dan
Cc:	CT-SamsungOmniMedsci; Frances Zhang; JVidwan@mayerbrown.com; RPluta@mayerbrown.com; jasmith@fr.com; rbonilla@fr.com; jshaw@cjsjlaw.com
Subject:	RE: IPR2025-01249 – 01254 & PGR2025-00063 – 00064: Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.
Date:	Tuesday, November 25, 2025 1:03:38 PM
Attachments:	image004.png image001.png

Counsel,

Petitioners disagree. We will insert Patent Owner's position in yellow highlight below in the email to the Director shortly.

Best,
Daniel

Daniel Kim
+1 212-653-8708 | direct
HyKim@sheppardmullin.com | Bio

From: Hayes, Jennifer <jenhayes@nixonpeabody.com>
Sent: Monday, November 24, 2025 7:14 PM
To: Daniel Kim <HyKim@sheppardmullin.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; James Davis <JDavis@sheppardmullin.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Maloney, Timothy <tmaloney@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Georgiev, Dan <dgeorgiev@nixonpeabody.com>
Cc: CT-SamsungOmniMedsci <CT-SamsungOmniMedsci@sheppardmullin.com>; Frances Zhang <FZhang@sheppardmullin.com>; JVidwan@mayerbrown.com; RPluta@mayerbrown.com; jasmith@fr.com; rbonilla@fr.com; jshaw@cjsjlaw.com
Subject: RE: IPR2025-01249 – 01254 & PGR2025-00063 – 00064: Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.

Counsel,

We disagree with your characterization of the facts and law. Petitioners' invalidity contentions in the Texas Case continue to include indefiniteness contentions. While you indicate no indefiniteness dispute remains in your email dated November 11, 2020, that email appears to be related only to withdrawal of indefiniteness as to the Joint Claim Construction Statement. Your email below seemingly confirms that you are limiting your stipulation to the claim construction stage and only to claims subject to an instituted IPR or PGR proceeding ("Petitioners will not raise any indefiniteness arguments in the parallel district court proceeding as to any claims subject to an instituted IPR or PGR in these proceedings" (emphasis added)). Petitioners can still potentially raise indefiniteness in the

Texas case notwithstanding the Local Patent Rules, especially in view of your proposed limited stipulation. *See, e.g.*, *Erfindergemeinschaft UroPep GbR v. Eli Lilly & Co.*, 240 F. Supp. 3d 605, 624-26 (E.D. Tex. 2017); *Nanology Alpha LLC v. WITec Wissenschaftliche Instrumente und Technologie GmbH*, No. 6:16-CV-00445-RWS, 2018 WL 4289342, at *7 (E.D. Tex. July 11, 2018); *Cioffi v. Google, Inc.*, No. 213CV00103JRGRSP, 2017 WL 275386, at *5-6 (E.D. Tex. Jan. 9, 2017), *report and recommendation adopted*, No. 213CV00103JRGRSP, 2017 WL 235011 (E.D. Tex. Jan. 19, 2017). The draft stipulation included in your email below (i.e., "that Petitioners will not raise any indefiniteness arguments in the parallel district court proceeding as to any claims subject to an instituted IPR or PGR in these proceedings") contemplates Petitioners later raising indefiniteness in the Texas case for any claim for which an IPR/PGR is not instituted. Please confirm that Petitioners will not raise indefiniteness in the Texas case for any challenged claim.

If you confirm agreement, Patent Owner proposes the following revised email to the Board.

To the Honorable Director,
Petitioners seek leave to submit an updated mandatory notice in these proceedings indicating that "no indefiniteness dispute remains or will be raised" in the parallel district court case ("Texas case"). Petitioners have indicated in exchanges between the parties that no indefiniteness issue remains in the claim construction stage of the Texas Case (see Ex. 1120, IPR2025-01251 – 01254 & PGR2025-00063 – 00064). Further, the parties have conferred, and per Patent Owner's request, Petitioners stipulate that Petitioners will not raise any indefiniteness arguments in any stage of the Texas case as to any claims challenged in the IPR and PGR petitions in these proceedings. With this stipulation, Patent Owner does not oppose the submission of this updated mandatory notice.
The parties are available for a call if preferred.

If you do not agree to the revised email to the Board, Patent Owner's position for inclusion in the email is as follows:

Patent Owner's Position:

Petitioners mischaracterize the facts and the law. Petitioners did not and have not withdrawn their indefiniteness invalidity contentions in the Eastern District of Texas. Petitioners also mischaracterize the impact of their withdrawal of indefiniteness contentions in claim construction but not from the invalidity contentions. Contrary to Patent Owner's representations to the Board, Petitioners may still raise indefiniteness in the Texas case in certain circumstances.

Nevertheless, Patent Owner does not oppose Petitioner's request to submitted an updated mandatory notice. However, Patent Owner notes that Petitioner is limiting its stipulation to only claims that are instituted and therefore has no bearing on the pending Discretionary Denial briefs.

Jennifer Hayes
Partner
jenhayes@nixonpeabody.com
T/ +1 213.629.6179 M/ +1 650.575.2400 F/ +1 866.781.9391

Nixon Peabody LLP
300 South Grand Avenue, Suite 4100, Los Angeles, CA 90071-3151
LinkedIn | Subscribe

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From: Daniel Kim <HyKim@sheppardmullin.com>
Sent: Monday, November 24, 2025 11:11 AM
To: Christopher, Angelo <achristopher@nixonpeabody.com>; James Davis <JDavis@sheppardmullin.com>; Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Maloney, Timothy <tmaloney@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Georgiev, Dan <dgeorgiev@nixonpeabody.com>; Leggett, Corey <cleggett@nixonpeabody.com>
Cc: CT-SamsungOmniMedsci <CT-SamsungOmniMedsci@sheppardmullin.com>; Frances Zhang <FZhang@sheppardmullin.com>; JVidwan@mayerbrown.com; RPluta@mayerbrown.com; jasmith@fr.com; rbonilla@fr.com; jshaw@cjsjlaw.com
Subject: RE: IPR2025-01249 – 01254 & PGR2025-00063 – 00064: Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.

Counsel,
Local Patent Rule 4-1 of the Eastern District of Texas explicitly requires that “each party shall simultaneously exchange a list of claim terms, phrases, or clauses which that party contends should be construed or found indefinite by the Court.” Likewise, Local Patent Rule 4-3 also requires the Joint Claim Construction and Prehearing Statement to include “[e]ach party’s proposed claim construction or indefiniteness position.” Rather than the invalidity contentions, the claim construction proceedings thus govern indefiniteness disputes at the current stage of the Texas Case. Petitioners did not raise any indefiniteness dispute for the Challenged Patents in their Local Patent Rule 4-1 exchange, except for a term in the ’475 patent that was also withdrawn on November 11, 2025—prior to the POPR for that patent. Thus, Petitioners had already withdrawn all their indefiniteness positions before the POPRs were due for the corresponding patents.
Nevertheless, we can agree to send the following. Please confirm Patent Owner’s position.

Best,
Daniel

To the Honorable Director,
Petitioners seek leave to submit an updated mandatory notice in these proceedings indicating that “no indefiniteness dispute remains” between the parties as already

indicated in the district court claim construction exchanges between the parties prior to the relevant POPRs (see Ex. 1120, IPR2025-01251 – 01254 & PGR2025-00063 – 00064). These exchanges are required to include any indefiniteness positions pursuant to EDTX Local Rule 4-1. While a single indefiniteness issue was raised as to one challenged claim (dependent claim of the '475 patent) in Petitioners' Oct. 31, 2025 claim construction exchange (Ex. 2034 at 18), that indefiniteness position was withdrawn prior to the submission of the POPR for that patent (Ex. 1120, IPR2025-01254).
The parties have conferred. Per Patent Owner's request, Petitioners are willing to stipulate that Petitioners will not raise any indefiniteness arguments in the parallel district court proceeding as to any claims subject to an instituted IPR or PGR in these proceedings. With this stipulation, Patent Owner does not oppose the submission of the updated mandatory notice.
The parties are available for a call if preferred.

Daniel Kim
+1 212-653-8708 | direct
HyKim@sheppardmullin.com | Bio

From: Christopher, Angelo <achristopher@nixonpeabody.com>
Sent: Friday, November 21, 2025 2:39 PM
To: Daniel Kim <HyKim@sheppardmullin.com>; James Davis <JDavis@sheppardmullin.com>; Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Maloney, Timothy <tmaloney@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Georgiev, Dan <dgeorgiev@nixonpeabody.com>; Leggett, Corey <cleggett@nixonpeabody.com>
Cc: CT-SamsungOmniMedsci <CT-SamsungOmniMedsci@sheppardmullin.com>; Frances Zhang <FZhang@sheppardmullin.com>; JVidwan@mayerbrown.com; RPluta@mayerbrown.com; jasmith@fr.com; rbonilla@fr.com; jshaw@cjsjlaw.com
Subject: RE: IPR2025-01249 – 01254 & PGR2025-00063 – 00064: Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.

Counsel,

Please see Patent Owner's position statement below and please include in your email to the Board. Should Petitioners modify their proposed email/position, please send so that we may update our position if appropriate.

Patent Owner's Position

Petitioners' assertion that "Petitioners withdrew all indefiniteness positions in the corresponding district court litigation before Patent Owner filed its Preliminary Responses" in each of these proceedings is not accurate, and their operative invalidity contentions assert indefiniteness. Nevertheless, Patent Owner does not oppose Petitioners' request to file updated mandatory notices stipulating that they will not raise indefiniteness for any of

the patents subject to these proceedings in district court.

Patent Owner opposes Petitioners request for a preliminary reply. Good cause does not exist because Petitioners could have withdrawn their indefiniteness positions prior to filing the petitions. Should the Board grant a preliminary reply, Patent Owner requests a preliminary sur-reply of equal length to address these issues.

Best regards,

- Angelo

Angelo J. Christopher
Counsel
achristopher@nixonpeabody.com
T/ +1 312.977.4391 M/ +1 312.366.4745 F/ +1 844.450.2568
Nixon Peabody LLP
70 West Madison, Suite 5200, Chicago, IL 60602-4378

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From: Daniel Kim <HyKim@sheppardmullin.com>
Sent: Thursday, November 20, 2025 2:30 PM
To: James Davis <JDavis@sheppardmullin.com>; Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; Maloney, Timothy <tmaloney@nixonpeabody.com>; Holt, Benjamin <bholt@nixonpeabody.com>; Georgiev, Dan <dgeorgiev@nixonpeabody.com>; Leggett, Corey <cleggett@nixonpeabody.com>
Cc: CT-SamsungOmniMedsci <CT-SamsungOmniMedsci@sheppardmullin.com>; Frances Zhang <FZhang@sheppardmullin.com>; JVidwan@mayerbrown.com; RPluta@mayerbrown.com; jasmith@fr.com; rbonilla@fr.com; jshaw@cjsjlaw.com
Subject: IPR2025-01249 – 01254 & PGR2025-00063 – 00064: Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.

[EXTERNAL E-MAIL]
Be Aware of Links and Attachments

Counsel,

In light of the arguments made in Patent Owner's Preliminary Replies, Petitioners intend to send the following email to Trials. Can you please provide Patent Owner's position? Petitioners are available to meet and confer as well.

Best,
Daniel

//DRAFT

To the Honorable Director,

Petitioners seek leave to submit an updated mandatory notice indicating that it has withdrawn any indefiniteness positions in district court or a preliminary reply concerning Patent Owner's allegations of inconsistent claim construction positions between the district court and IPR proceedings. In particular, Petitioners withdrew all indefiniteness positions in the corresponding district court litigation before Patent Owner filed its Preliminary Responses for the corresponding patents as indicated by Exhibits 2034 and 1120 in these proceedings.

The parties have conferred and Patent Owner [does/does not] object to this submission.

The parties are available for a call if preferred.

Daniel Kim
+1 212-653-8708 | direct
HyKim@sheppardmullin.com | Bio

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