UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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.

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Case IPR2025-01253
Patent No. 12,193,790

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PETITIONERS' RANKING AND EXPLANATION OF PARALLEL PETITIONS

1. Petitioners 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") have filed two petitions for review of claim 7 of U.S. Patent No. Patent No. 12,193,790 (the "'790 patent"): (1) a petition for *inter partes* review (IPR2025-01253, the "IPR Petition") and (2) a petition for post grant review (PGR2025-00064, the "PGR Petition"), and submit this explanation of the differences between the petitions and a ranking of the petitions for the Board's consideration.

2. Because the '790 patent issued on January 14, 2025, less than 9 months ago, whether Petitioners may challenge the patentability of the '790 patent in a post grant review or an *inter partes* review depends on whether the '790 patent is considered an AIA patent or not. *See* 35 U.S.C. §§ 311(c), 321(c).

3. Omni Medsci, Inc. ("Patent Owner") asserts in a co-pending civil action[1] that the '790 patent is at least entitled to a priority date of December 31, 2012. Ex.1021, 21-22. For the purposes of both Petitions, Petitioners do not contest Patent Owner's assertion of the '790 patent's December 31, 2012 priority date. Therefore, by Patent Owner's own admission, the '790 patent is not subject to the

[1] *Omni Medsci, Inc. v. Samsung Electronics. Co., Ltd. et al.*, 2:24-cv-01070-JGR-RSP (E.D. Tex) ("Texas Case").

AIA, and is available for *inter partes* review under 37 C.F.R. § 42.102(a)(2).

4. However, if Patent Owner later argues and/or the Board concludes that the ’790 patent is not subject to the AIA, the ’790 patent is instead available for post grant review. Thus, Petitioners have filed the conditional PGR Petition concurrently with the IPR Petition.

5. Petitioners’ concurrent IPR and PGR Petitions are necessary to ensure that Petitioners’ patentability challenges are heard by the Board in a timely manner regardless of whether the ’790 patent is an AIA patent or not. Because the two petitions challenge the same claim based on the same obviousness grounds, are substantively duplicative, and only one would need to be instituted depending upon the Board’s determination of the ’790 patent’s priority date,[2] they create no “substantial and unnecessary burden on the Board and the patent owner” or “fairness, timing, and efficiency concerns.” *See* Consolidated Trial Practice Guide (Nov. 2019) at 59, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

[2] Because the ’790 patent would not be eligible for simultaneous post-grant review and *inter partes* review proceedings, the Board need not institute review in both proceedings. *See, e.g., Trend Micro Inc., v. Cupp Computing As*, PGR2021-00101, Paper 16 at 6 (PTAB, Jan. 19, 2022) (denying PGR petition that was “substantively duplicative” of IPR petition and filed “out of an abundance of caution” due to questions regarding the challenged patent’s AIA status).

I. Ranking

6. For the purposes of the IPR and PGR Petitions, Petitioners do not contest Patent Owner's representation in the Texas Case that the '790 patent has a priority date of December 31, 2012 and thus is not an AIA patent. Petitioners accordingly request that the Board institute *inter partes* review in IPR2025-01253 and moot post-grant review in PGR2025-00064.

7. Alternatively, if the Board determines that the '790 patent is an AIA patent and thus denies the petition in IPR2025-01253, Petitioners request that the Board institute post-grant review in PGR2025-00064 because the Petitioners are filing the PGR within nine months of the '790 patent's issue date of January 14, 2025.

'790 Patent	**IPR Petition IPR2025-01253**	**PGR Petition PGR2025-00064**
Challenged Claim	7	7
Number of Grounds	2	2
Ranking	#1	#2

II. Differences Between Petitions

8. Both IPR and PGR Petitions advance the same 35 U.S.C. § 103 invalidity grounds against the same challenged claim of the '790 patent and are substantively duplicative.

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9. For these reasons set forth above, Petitioners respectfully request that

the Board institute *inter partes* review in IPR2025-01253. Otherwise, the Board should institute post-grant review in PGR2025-00064.

Dated: August 5, 2025

Respectfully submitted,

By: /*James L. Davis, Jr.*/
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Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) on the Patent Owner by FedEx of a copy of this Petitioners' Ranking and Explanation of Parallel Petitions at the correspondence address of record for the '790 patent:

109543 - Brooks, Kushman P.C./Cheetah Omni MedSci
150 W 2nd St., Suite 400N
Royal Oak, MI 48067
UNITED STATES

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A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel at the following addresses:

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