

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., AND
OURA HEALTH OY, AND
ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.**

Petitioners,

v.

OMNI MEDSCI, INC.,

Patent Owner.

Case IPR2025-01251
Patent No. 10,874,304

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	DISCRETIONARY DENIAL IS NOT WARRANTED.....	2
A.	Efficiency and Consistency Weigh Strongly Against Discretionary Denial.....	2
B.	Examiner’s Material Errors Support Institution.....	6
C.	There Are No Settled Expectations in the ’304’s Validity	13
D.	The <i>Fintiv</i> Factors Weigh Against Discretionary Denial.....	13
1.	Factor 1 (Stay) Is Neutral At Best	13
2.	Factor 2 (Trial Date) Does Not Support Discretionary Denial	15
3.	Factor 3 (Parallel Proceeding) Supports Institution.....	16
4.	Factor 4 (Issue Overlap) Weighs Strongly In Favor of Institution	18
5.	Factor 5 (Same Party) Is Neutral	19
6.	Factor 6 (Other Considerations) Weighs Strongly In Favor of Institution	19
III.	CONCLUSION.....	20

TABLE OF AUTHORITIES

	<u>Page(s)</u>
<u>Cases</u>	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	<i>passim</i>
<i>Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC</i> , IPR2020-00994, Paper 19 (PTAB Nov. 19, 2020).....	18
<i>Berkshire Hathaway Energy Co. v. MES, Inc.</i> , IPR2025-00274, Paper 23 (Director July 2, 2025)	13
<i>BOE Tech. Grp. Co. v. Optronix Scis. LLC</i> , IPR2024-01130, Paper 16 (PTAB Jan. 27, 2025)	16
<i>Broadphone LLC v. Samsung Elecs. Co.</i> , No. 2:23-CV-00001, 2024 WL 3524022 (E.D. Tex. July 24, 2024).....	14
<i>ClearCorrect Operating, LLC v. Align Technology, Inc.</i> , IPR2025-00814, Paper 14 (Director Aug. 29, 2025).....	11
<i>CyWee Grp. Ltd. v. Samsung Elecs. Co.</i> , No. 2:17-CV-00140, 2019 WL 11023976 (E.D. Tex. Feb. 14, 2019)	14
<i>Dr. Reddy's Laboratories S.A. v. Eye Therapies, LLC</i> , IPR2024-00467, Paper 14 (PTAB Aug. 13, 2024).....	12
<i>e-Watch Inc. v. Apple, Inc.</i> , No. 2:13-cv-1061, 2015 WL 12915668 (E.D. Tex. Mar. 25, 2015)	14
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (Director May 19, 2025)	7, 11, 12
<i>Embodiment, Inc. v. LifeNet Health</i> , IPR2025-00248, Paper 13 (Director June 26, 2025)	2, 4
<i>FreightCar America Inc. v. National Steel Car Limited</i> , IPR2025-01046, Paper 20 (Director Oct. 10, 2025).....	4
<i>Google LLC v. Hammond Dev. Int'l, Inc.</i> , 54 F.4th 1377 (Fed. Cir. 2022)	19, 20

<i>Home Depot U.S.A., Inc. v. H2 Intellect LLC</i> , IPR2025-00480, Paper 11 (Director Sept. 4, 2025)	16
<i>HP Inc. v. Slingshot Printing LLC</i> , IPR2020-01084, Paper 13 (PTAB Jan. 14, 2021)	19
<i>Ingenico Inc. v. IOENGINE, LLC</i> , 136 F.4th 1354 (Fed. Cir. 2025)	5
<i>Ironsource Ltd. v. Digital Turbine Inc.</i> , PGR2022-00053, Paper 58 (PTAB Mar. 12, 2024)	20
<i>Keysight Techs., Inc. v. Centripetal Networks, Inc.</i> , IPR2022-01421, Paper 14 (Director Aug. 24, 2023).....	11
<i>Keysight Techs., Inc. v. Centripetal Networks, Inc.</i> , IPR2023-00446, Paper 30 (PTAB Aug. 5, 2024).....	19
<i>Motorola Sols. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (Director Mar. 28, 2025).....	6
<i>Padagis US LLC v. Neurelis, Inc.</i> , IPR2025-00464, Paper 12 (Director July 16, 2025).....	11, 16
<i>Palo Alto Networks, Inc. v. Centripetal Networks, Inc.</i> IPR2021-01155, Paper 12 (PTAB Jan. 20, 2022)	12
<i>ParkerVision, Inc. v. Qualcomm Inc.</i> , 116 F.4th 1345 (Fed. Cir. 2024)	3
<i>POSCO Co., Ltd. v. ArcelorMittal</i> , IPR2025-00370, Paper 10 (Director June 25, 2025)	3, 4, 20
<i>Samsung Display Co. v. Pictiva Displays Int'l Ltd.</i> , IPR2024-01222, Paper 12 (PTAB Mar. 6, 2025)	16
<i>Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC</i> , IPR2025-00482, Paper 15 (Director July 24, 2025).....	6
<i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , IPR2025-00002, Paper 17 (PTAB May 15, 2025)	3, 20

<i>Samsung Elecs. Co., Ltd., v. Sionyx, LLC,</i> IPR2025-00064, Paper 16 (PTAB Jun. 6, 2025)	6
<i>Shenzhen Tuozhu Technology Co., Ltd. v. Stratasy, Inc.,</i> IPR2025-00438, Paper 10 (Director July 17, 2025)	6
<i>Stingray Music USA, Inc. v. Music Choice,</i> No. 16-cv-00586, 2017 WL 9885167 (E.D. Tex. Dec. 12, 2017)	15
<i>Tesla, Inc. v. Intellectual Ventures II LLC,</i> IPR2025-00217, Paper 9 (Director June 13, 2025)	4
<i>Vivint, Inc. v. Sb Ip Holdings LLC,</i> IPR2022-01352, Paper 20 (PTAB Mar. 19, 2024)	20
<i>Volkswagen Grp. of Am., Inc. v. Longhorn Automotive Grp. LLC,</i> IPR2025-01064, Paper 9 (Director Oct. 10, 2025)	16
<u>Statutes</u>	
35 U.S.C. § 311(b)	5

EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 10,874,304 (“304”)
1002	File History of U.S. Application No. 16/669,794 (“304FH”)
1003	Declaration of Brian Anthony in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,874,304 (“Anthony”)
1004	Declaration of Brian Anthony in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,651,533 submitted in IPR2019-00916, Ex. 1003 (“533-Anthony”)
1005	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 1 (P.T.A.B. Apr. 10, 2019) (“533-Pet.”)
1006	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 23 (P.T.A.B. Jan. 31, 2020) (“533-POR”)
1007	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 16 (P.T.A.B. Oct. 18, 2019) (“533-Inst.”)
1008	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 39 (P.T.A.B. Oct. 14, 2020) (“533-FWD”)
1009	<i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 2021-1229, 2022 WL 2062168 (Fed. Cir. June 8, 2022)
1010	Declaration of Brian Anthony in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,517,484 submitted in IPR2021-00453, Ex. 1003 (“484-Anthony”)
1011	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 1 (P.T.A.B. Jan. 22, 2021) (“484-Pet.”)
1012	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 10 (P.T.A.B. Nov. 12, 2021) (“484-POR”)
1013	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 7 (P.T.A.B. Aug. 6, 2021) (“484-Inst.”)

Exhibit No.	DESCRIPTION
1014	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 11 (P.T.A.B. Feb. 4, 2022) (“’484-Pet.-Reply”)
1015	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 22 (P.T.A.B. Aug. 3, 2022) (“’484-FWD”)
1016	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 26 (P.T.A.B. Feb. 14, 2025) (“’484-RFWD”)
1017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , No. 2023-1034, 2024 WL 3084509 (Fed. Cir. June 21, 2024), ECF No. 44
1018	<i>Omni MedSci, Inc. v. Apple Inc.</i> , 2:18-cv-00134-RWS, Dkt. No. 211 (E.D. Tex. June 24, 2019) (“CC Order”)
1019	<i>Omni MedSci, Inc. v. Apple Inc.</i> , 2:18-cv-00429-RWS, Dkt. No. 152 (E.D. Tex. Aug. 14, 2019)
1020	Second Amended Docket Control Order, June 16, 2025. <i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP (E.D. Tex.)
1021-22	<i>Reserved</i>
1023	Defendants’ Supplemental Invalidity and Subject Matter Eligibility Contentions, July 18, 2025. <i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP (E.D. Tex.).
1024	<i>Reserved</i>
1025	U.S. Patent No. 9,241,676 (“Lisogurski”)
1026	U.S. Patent Pub. No. 2010/0217102 (“LeBoeuf”)
1027	U.S. Patent No. 8,108,036 (“Tran”)
1028	U.S. Patent Pub. No. 2005/0049468 (“Carlson”)

Exhibit No.	DESCRIPTION
1029	U.S. Patent Pub. No. 7,139,076 (“Marbach”)
1030	<i>Reserved</i>
1031	U.S. Patent No. 8,050,730 (“Zhang”)
1032	U.S. Patent No. 8,821,397 (“Al-Ali”)
1033	U.S. Patent Pub. No. 2011/0237911 (“Lamego”)
1034	U.S. Patent No. 5,942,749 (“Takeuchi”)
1035	U.S. Patent No. 5,822,473 (“Magel”)
1036	US Patent 5,592,124 (“Mullins”)
1037	E.F. Schubert, Light-Emitting Diodes (Cambridge Univ. Press, 2nd ed. reprinted 2014)
1038	Joseph D. Bronzino, “The Biomedical Engineering Handbook,” (1995)
1039	U.S. Patent No. 8,079,735 (“Vakil”)
1040	<i>Reserved</i>
1041	U.S. Patent Pub. No. 2012/0197093 (“Valencell-093”)
1042	U.S. Patent No. 8,862,196 (“Lynn”)
1043	U.S. Patent No. 8,412,655 (“Colman”)
1044	U.S. Patent No. 5,511,553 (“Segalowitz”)
1045	U.S. Patent No. 6,801,799 (“Mendelson”)
1046	U.S. Patent No. 6,662,033 (“Casciani”)

Exhibit No.	DESCRIPTION
1047	<i>Reserved</i>
1048	U.S. Pat. No. 9,239,951 (“Hoffberg”)
1049	U.S. Pat. Pub. 2007/0194939 (“Alvarez”)
1050	<i>Reserved</i>
1051	U.S. Patent No. 6,931,269 (“Terry”)
1052-58	<i>Reserved</i>
1059	U.S. Patent No. 5,497,769 (“Gratton”)
1060	U.S. Patent No. 5,827,182 (“Raley”)
1061	U.S. Patent No. 7,764,982 (“Dalke”)
1062	U.S. Patent No. 6,343,223 (“Chin”)
1063	W.O. Patent Pub. No. 2000/013003 (“Colvin”)
1064	U.S. Patent No. 5,554,273 (“Demmin”)
1065	U.S. Patent No. 5,953,713 (“Behbehani”)
1066	U.S. Patent No. 6,587,704 (“Fine”)
1067	U.S. Patent No. 6,397,092 (“Norris”)
1068	U.S. Patent No. 5,360,004 (“Purdy”)
1069-76	<i>Reserved</i>
1077	U.S. Patent Publication No. 2006/0184040 (“Keller”)

Exhibit No.	DESCRIPTION
1081	US. Patent No. 9,651,533 (“533”)
1082	U.S. Patent No. 10,517,484 (“484”)
1083	Declaration of Brian Anthony in Support of Petition for Inter Partes Review of U.S. Patent No. 9,861,286 submitted in IPR2019-00914, Ex. 1003
1084	Declaration of Jonathan Bradford in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,874,304
1085	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 10 (P.T.A.B. July. 22, 2019) (“533-POPR”)
1086	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01253 Paper 6 (P.T.A.B. Aug. 5, 2025)
1087	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01254 Paper 6 (P.T.A.B. Aug. 5, 2025)
1088-1090	<i>Reserved</i>
1091	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 27 (P.T.A.B. Apr. 11, 2025)
1092	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01249 Paper 1 (P.T.A.B. Aug. 5, 2025) (“868 Pet.”)
1093	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01250 Paper 1 (P.T.A.B. Aug. 5, 2025) (“533 Pet.”)
1094	<i>Reserved</i>
1095	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01252 Paper 1 (P.T.A.B. Aug. 5, 2025) (“455 Pet.”)
1096	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01254 Paper 1 (P.T.A.B. Aug. 5, 2025) (“475 Pet.”)

Exhibit No.	DESCRIPTION
1097	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01253 Paper 1 (P.T.A.B. Aug. 5, 2025) (“790 Pet.”)
1098	Email correspondence between counsel for Fossil to counsel for Omni
1099	U.S. Patent No. 9,055,868 (“868”)
1100	<i>Reserved</i>
1101	U.S. Patent No. 11,160,455 (“455”)
1102	U.S. Patent No. 12,193,790 (“790”)
1103	U.S. Patent No. 12,268,475 (“475”)
1104	<i>Apple Inc. v. Omni MedSci, Inc.</i> , No. IPR2020-00175, Paper 26 (P.T.A.B. June 14, 2021)
1105	<i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 2021-2213, 2022 WL 2062167 (Fed. Cir. June 8, 2022), ECF No. 47
1106	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2020-00029, Paper 7 (P.T.A.B. Apr. 22, 2020)
1107	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00914, Paper 13 (P.T.A.B. Nov. 6, 2019)
1108	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00917, Paper 14 (P.T.A.B. Oct. 17, 2019)
1109	<i>Reserved</i>
1110	United States District Courts – National Judicial Caseload Profile
1111	EDTX Trials 2026-08-17

Exhibit No.	DESCRIPTION
1112	Joint Mot for Preferential Trial Setting, <i>Multimedia Techs. Ltd. v LG Elecs.</i> , 2:22-cv-00494-JRG-RSP, Dkt. No. 273 (E.D. Tex. Mar. 18, 2025)
1113	Omni’s First Set of Common Interrogatories to Defendants (2025-05-12)
1114	<i>Reserved</i>
1115	OnePlus Waiver of Service, <i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP, Dkt. No. 70 (E.D. Tex. June 27, 2025)
1116	<i>Omni MedSci, Inc. v. Apple Inc.</i> , 4:20-cv-00563, Dkt. No. 52 (N.D. Cal. Dec. 06, 2021)
1117	Declaration of James Nowell in Support of Petitioners’ Opposition to Patent Owner’s Discretionary Denial Brief
1118	Defendants’ Preliminary Constructions and Extrinsic Evidence – Exhibit A, <i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP (E.D. Tex. Oct. 31, 2025)
1119	Local Patent Rules for the United States District Court for the Eastern District of Texas
1120	Email correspondence between counsel for Samsung and counsel for Omni

TABLE OF ABBREVIATIONS

Exhibit No.	DESCRIPTION
Challenged Claims	Claims 1-6, 11-16, 19-22, 26-27 of the '304
IPR	<i>Inter Partes</i> Review
Petitioners	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.
PO	Patent Owner
Pet.	<i>Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.</i> , No. IPR2025-01251, Paper 1 (PTAB Aug. 5, 2025)
DD Br.	<i>Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.</i> , No. IPR2025-01251, Paper 11 (PTAB Oct. 14, 2025)
FWD	Final Written Decision
Texas Case	<i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP (E.D. Tex.)
'533-FWD	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 39 (PTAB Oct. 14, 2020)
'484-FWD	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 22 (PTAB Aug. 3, 2022)
Prior IPRs	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916 (PTAB) and <i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453 (PTAB)
'868	U.S. Patent No. 9,055,868
'533	U.S. Patent No. 9,651,533

Exhibit No.	DESCRIPTION
'484	U.S. Patent No. 10,517,484
'304	U.S. Patent No. 10,874,304
'455	U.S. Patent No. 11,160,455
'790	U.S. Patent No. 12,193,790
'475	U.S. Patent No. 12,268,475
'868 Pet	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01249, Paper 1 (P.T.A.B. Aug. 5, 2025)
'533 Pet.	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01250, Paper 1 (P.T.A.B. Aug. 5, 2025)
'455 Pet.	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01252, Paper 1 (P.T.A.B. Aug. 5, 2025)
'790 Pet.	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01253, Paper 1 (P.T.A.B. Aug. 5, 2025)
'475 Pet.	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01254, Paper 1 (P.T.A.B. Aug. 5, 2025)
'533-FWD	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 39 (P.T.A.B. Oct. 14, 2020)
'484-FWD	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 22 (P.T.A.B. Aug. 3, 2022)
Lisogurski	U.S. Patent No. 9,241,676
Carlson	U.S. Patent Pub. No. 2005/0049468
Tran	U.S. Patent No. US 8,108,036
LeBoeuf	U.S. Patent Pub. No. 2010/0217102
Marbach	U.S. Patent No. 7,139,076

I. INTRODUCTION

Discretionary denial is not warranted. This is one of six IPRs challenging six patents¹ asserted against Petitioners in the parallel Texas Case.² The vast majority of the limitations in the challenged claims, including those at issue in this IPR, are identical or substantially similar to those already found unpatentable in prior IPRs challenging related patents—collateral estoppel thus eliminates substantive review of over 70% of all challenged claims, or over 80% for this IPR.³ Efficiency and

¹ U.S. Patent Nos. 9,055,868 (“’868”), 9,651,533 (“’533”), 10,874,304 (“’304”), 11,160,455 (“’455”), 12,193,790 (“’790”), 12,268,475 (“’475”).

² Petitioners have filed IPR2025-01249 through -01254 challenging six patents asserted against them in district court. PGR2025-00063 and -00064 are alternative and substantively identical to IPR2025-01254 and -01253, respectively. Thus, Petitioners seek to institute only six 6 proceedings. Exs. 1086-87. Collectively, the six IPRs (and the two alternative PGRs) are referred to as “the IPRs.”

³ Apple Inc. previously challenged claims 5, 7-10, 13, 15-17 of the ’533 in IPR2019-00916 and all claims (1-23) of the ’484 in IPR2021-00453 (collectively, “Prior IPRs”). The Board’s unpatentability decision as to all challenged claims of the ’533 (Ex. 1008, “’533-FWD”) was affirmed on appeal (Ex. 1009), and PO did not appeal the Board’s unpatentability decision on claims 1, 2, 7, and 15-23 of the ’484 (Ex.

consistency are thus best served by the Board’s review of the IPRs together.

Indeed, the ’533-FWD issued before the ’304—the Examiner’s allowance of the Challenged Claims with no substantive prosecution, despite having access to the art used in the Prior ’533 IPR and materials applying that art, confirms material error.

The median time-to-trial also places trial after the final written decision (“FWD”). With no settled expectations given the ’304’s recent issuance in 2020 as well as the extensive IPR history of related patents including the ’533-FWD; Petitioners’ broad *Sotera*-plus stipulation eliminating any potential overlap between the IPRs and district court proceedings; and the *Fintiv* factors further weighing against discretionary denial; PO’s request for discretionary denial should be denied.

II. DISCRETIONARY DENIAL IS NOT WARRANTED

A. Efficiency and Consistency Weigh Strongly Against Discretionary Denial

The Director has repeatedly declined discretionary denial in similar situations to promote the “efficient use of Board resources” and “consistency” in related proceedings. *See Embody, Inc. v. LifeNet Health*, IPR2025-00248, Pap. 13 at 2-3

1015, “’484-FWD”). Upon remand from the Federal Circuit, the Board also found the remaining claims of the ’484 unpatentable. Ex. 1016 at 2-3. PO appealed again, and the parallel district court case is stayed pending that appeal. Exs. 1091 & 1116.

(Director June 26, 2025); *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Pap. 10 at 3 (Director June 25, 2025). That rationale applies even more strongly here.

First, collateral estoppel significantly narrows the scope of substantive review for the Board. Specifically, 139 of 194 total limitations (>70%) challenged across the 6 IPRs, or 47 of 58 limitations in this IPR, are identical or substantially similar to those held unpatentable in the Prior IPRs based on the same grounds here. IPR2025-01251, Pap. 1 (“Pet.”), 16-18; IPR2025-01250, Pap. 1 (“’533 Pet.”), 19; IPR2025-01252, Pap. 1 (“’455 Pet.”), 18-20; IPR2025-01253, Pap. 1 (“’790 Pet.”), 18-21; IPR2025-01254, Pap. 1 (“’475 Pet.”), 19-21. PO does not dispute this. Thus, collateral estoppel precludes PO from relitigating these limitations before the Board. *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Pap. 17 at 17-24 (PTAB May 15, 2025) (applying collateral estoppel to find “substantially similar” limitations in related patents obvious). Collateral estoppel, however, does not apply in district court based on prior Board unpatentability decisions rendered under a different standard. *See ParkerVision, Inc. v. Qualcomm Inc.*, 116 F.4th 1345, 1361-62 (Fed. Cir. 2024).

While PO also argues that the Eastern District of Texas’s model order requires narrowing the asserted claims to a maximum of 16, PO has refused to agree to limit its asserted claims. Paper 11 (“DD Br.”), 13-14; Ex. 1098 (Petitioners’ request to narrow claims and prior art, which remains unanswered). Even if it did, and

assuming it asserts one independent claim per patent and a claim for the '533 (much less than 16 claims), the district court would still have close to 80 limitations⁴ to address, as opposed to fewer than 60 limitations at issue across the six IPRs.

Second, instituting these IPRs will promote “efficient use of Board resources” and “consistency and predictability to the public” because five out of the six challenged patents ('533, '304, '455, '475, '790) are related to the '533 and '484 successfully challenged in the Prior IPRs. *See Embody*, IPR2025-00248, Pap. 13 at 2-3; *FreightCar America Inc. v. National Steel Car Limited*, IPR2025-01046, Pap. 20 at 3 (Director Oct. 10, 2025) (same); *POSCO*, IPR2025-00370, Pap. 10 at 3 (emphasizing “consistency and predictability to the public”).

Contrary to PO’s argument, *Tesla, Inc. v. Intellectual Ventures II LLC*, is on point. DD Br. 19-20. There, the “diverse range of subject matter” was just a factor for declining to exercise discretion. IPR2025-00217, Pap. 9 at 2-3 (Director June 13, 2025). And, as here, challenged claims “similar” to those in an “ancestor patent” that Board found unpatentable “counse[led] against discretionary denial.” *Id.*

Third, Petitioners’ broad stipulation eliminates any overlap with the Texas

⁴ *E.g.*, '868 claim 7 (7 limitations); '533 claim 11 (8 limitations, including independent claim 5); '304 claim 11 (16 limitations); '455 claim 1 (14 limitations); '790 claim 17 (14 limitations); '475 claim 1 (15 limitations).

Case, alleviating any concerns about inefficiency or inconsistency. As stated in all six IPRs, Petitioners' stipulation includes two parts: (1) a standard "*Sotera* stipulation," and (2) an additional stipulation precluding combining any asserted IPR reference with "any other type of prior art" including system art. Specifically, Petitioners' broad stipulations recite:

Petitioners hereby stipulate that, if the PTAB institutes this IPR, Petitioners will not pursue in the Texas Case (1) the specific grounds asserted in this IPR or any ground that was raised or could have been raised in an IPR against the Challenged Claims; or (2) combinations of the prior art asserted in this IPR with any other type of prior art against the Challenged Claims.

Pet. 12; '868 Pet. 15; '533 Pet. 13; '455 Pet. 13; '790 Pet. 13; '475 Pet. 14.

There will thus be no overlap between the IPRs and the Texas Case. DD Br. 8-9. That the alleged assignees of the **Lisogurski** and **Tran** references coincide with potential prior art product manufacturers (DD Br. 7-8) also does not establish actual overlap. And, a prior art publication and its corresponding prior art system form "different grounds." *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366-67 (Fed. Cir. 2025) (no preclusion from relying on a prior art system even though publications evidencing the system art in an IPR could have been raised). Sections 101 and 112 would not cause duplicative efforts or inconsistent rulings (DD Br. 8) either, as those are beyond the Board's statutory jurisdiction. 35 U.S.C. §311(b).

PO's cited cases are also inapposite. DD Br. 9, 12-13. *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Pap. 19 at 3-4 (Director Mar. 28, 2025) and *Samsung Elecs. Co., Ltd., v. Sionyx, LLC*, IPR2025-00064, Pap. 16 at 13-16 (PTAB Jun. 6, 2025) involved a “*Sotera* stipulation,” much narrower than Petitioners’ broad stipulations here. In *Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC*, IPR2025-00482, Pap. 15 at 2 (Director July 24, 2025), the Director did not address the sufficiency of the stipulation at all. Indeed, a “broad stipulation” similar to Petitioners’ precluding combination with system art was found to weigh against discretionary denial. See *Shenzhen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Pap. 10 at 3 (Director July 17, 2025).

B. Examiner’s Material Errors Support Institution⁵

PO’s §325(d) arguments only highlight the Examiner’s material error. The ’533-FWD issued before the ’304 issued and invalidated challenged claims based on **Lisogurski** (optionally in view of **Carlson**), the same art asserted in this Petition that the Examiner considered during prosecution. In fact, the Board has already held claims from six patents in the same family unpatentable or at least reasonably likely

⁵ Petitioners identified **Lisogurski**, **Tran**, and **Carlson** via the ’533-/’484-FWDs, **LeBoeuf** via an IDS submitted during prosecution (’304FH, 171), and **Marbach** via targeted search.

to be unpatentable, including based on the same **Lisogurski** and **Carlson** references. Exs. 1008, 1015, 1104-1108. Examiner materially erred in allowing the claims *without any rejection*. '304FH, 153, 168, 171, 192, 211, 354, 370, 373, 400, 426.

Indeed, for an IDS listing the '533-FWD, the Examiner issued a Notice of Non-Complaint IDS stating that it “*has not been considered.*” '304FH, 425-427, 431. Applicant never rectified this issue and the '304 issued without the Examiner ever having considered the '533-FWD. Due to the material error, discretionary denial under §325(d) is not warranted. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Pap. 13 at 7 (Director May 19, 2025) (precedential) (Applicant’s failure to “identify references to ‘which the examiner should [pay] particular attention,’” or “respond to that request... may demonstrate that discretionary denial under § 325(d) is not warranted”).

Comparing '304 cl. 1 and '533 cl. 5, which the Board invalidated based on **Lisogurski** and **Carlson** asserted in this IPR, illustrates the Examiner’s error:

'304 claim 1 ⁶	'533, claim 5
[1.pre] A measurement system comprising:	A measurement system comprising:

⁶ Identical language is highlighted in **green**, and substantially similar language with minimal linguistic differences is highlighted in **purple**.

[1.a] a light source comprising a plurality of semiconductor sources that are configured to generate an output optical beam with one or more optical wavelengths, the light source configured to increase signal-to-noise ratio by increasing a light intensity relative to an initial light intensity from at least one of the plurality of semiconductor sources;	a light source comprising a plurality of semiconductor sources that are light emitting diodes, the light emitting diodes configured to generate an output optical beam with one or more optical wavelengths, wherein at least a portion of the one or more optical wavelengths is a near-infrared wavelength between 700 nanometers and 2500 nanometers, the light source configured to increase signal-to-noise ratio by increasing a light intensity from at least one of the plurality of semiconductor sources and by increasing a pulse rate of at least one of the plurality of semiconductor sources;
[1.b] a measurement device configured to:	an apparatus comprising
[1.c] receive a portion of the output optical beam, and deliver an analysis output beam to a sample;	a plurality of lenses configured to receive a portion of the output optical beam and to deliver an analysis output beam to a sample
[1.d] a receiver configured to:	a receiver configured to
[1.e] receive and process at least a portion of the analysis output beam reflected or transmitted from the sample,	receive and process at least a portion of the analysis output beam

	reflected or transmitted from the sample and
[1.f] generate an output signal representing at least in part a non-invasive measurement on blood contained within the sample,	to generate an output signal,
[1.g] synchronize to the light source,	wherein the receiver is configured to be synchronized to the light source;
[1.h] capture light while the semiconductor sources are off and convert the captured light into a first signal, [1.i] capture light while at least one of the semiconductor sources is on and convert the captured light into a second signal, the captured light including at least a part of the at least a portion of the analysis output beam reflected or transmitted from the sample, and [1.j] the measurement system further configured to improve the signal-to-noise ratio by differencing the first signal and the second signal;	
[1.k] a smart phone or tablet comprising a wireless receiver, a wireless transmitter, a display, a	a personal device comprising a wireless receiver, a wireless transmitter, a display, a microphone, a

microphone, a speaker, one or more buttons or knobs, a microprocessor and a touch screen, the smart phone or tablet configured to: receive and process at least a portion of the output signal, store and display the processed output signal, and transmit at least a portion of the processed output signal over a wireless transmission link; and	speaker, one or more buttons or knobs, a microprocessor and a touch screen, the personal device configured to receive and process at least a portion of the output signal, wherein the personal device is configured to store and display the processed output signal, and wherein at least a portion of the processed output signal is configured to be transmitted over a wireless transmission link; and
[1.l] a cloud configured to:	a remote device configured to
[1.m] receive, over the wireless transmission link, an output status comprising the at least a portion of the processed output signal,	receive over the wireless transmission link an output status comprising the at least a portion of the processed output signal,
[1.n] process the received output status to generate processed data, and store the processed data.	to process the received output status to generate processed data and to store the processed data.

Notably, the Board also found that limitations substantially similar to '304 limitations [1.h]-[1.j] were disclosed in **Lisogurski**. *See* Pet. 30-33 (citing '484-FWD). And, as detailed in the Petition, **Lisogurski** discloses even the allegedly unique limitations (DD Br. 10-11) in the '304 that the Examiner added to issue the allowance. '304FH, 266, 273, 275-76, 287 (adding "increasing a light intensity

relative to an initial light intensity” and “generate an output signal representing at least in part a non-invasive measurement on blood contained within the sample”); Pet. 25, 28 (addressing these limitations). That **Lisogurski** meets the limitations is not mere disagreement with the Examiner (*contra* DD Br. 17-18)—the Examiner failed to reject even the limitations identical/substantially similar to those already found unpatentable in the ’533-FWD based on Lisogurski. *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2022-01421, Pap. 14, 6–8 (Director Aug. 24, 2023) (Examiner misapprehended or overlooked the Board’s earlier FWD involving the same prior art and overlapping subject matter, despite “some differences between the [claim] language”).

The Examiner’s failure to issue a single rejection alone amounts to a material error. *Ecto World*, IPR2024-01280, Pap. 13 at 5 (part two of *Advanced Bionics* may be satisfied where “the asserted prior art was not a basis for rejection during examination” or, “even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination”); *see also ClearCorrect Operating, LLC v. Align Technology, Inc.*, IPR2025-00814, Pap. 14 at 3 (Director Aug. 29, 2025) (“Petitioner persuasively demonstrates that the Office erred by allowing the claims after the Board determined that substantially similar claims are unpatentable.”); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Pap. 12 at 2 (Director July 16, 2025) (allowance of a related patent “directly contradicts the

Board's determination and raises concerns of material error such that review of the challenged patents is an appropriate use of Office resources").

The Examiner's initialing on various IDS submissions throughout prosecution (DD Br. 14-16) is not a "meaningful evaluation and appreciation of the prior art." *Dr. Reddy's Laboratories S.A. v. Eye Therapies, LLC*, IPR2024-00467, Pap. 14 at 19 (PTAB Aug. 13, 2024). Indeed, Applicant submitted about 700 references via IDS during prosecution, rendering any claim of careful consideration questionable. '304FH, 137-155, 159-163, 167-177, 182-206, 211-213, 248-251, 425-427. *Ecto World*, IPR2024-01280, Pap. 13 at 6-7 (finding IDS containing over 1,000 references as "over 40 times the size of a typical IDS," and "may demonstrate that discretionary denial under § 325(d) is not warranted").

PO's reliance on *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.* to ignore the '533-FWD is likewise misplaced (DD Br. 18). No material error was found in *Palo Alto* because it involved materially different claims from those found unpatentable in an ancestor patent. IPR2021-01155, Pap. 12 at 9-10, 17-18 (PTAB Jan. 20, 2022). That is not the case here where the vast majority of the Challenged Claims are identical or substantially similar to those invalidated in the '533-FWD.

In sum, the Examiner's failure to meaningfully consider **Lisogurski** and **Carlson**, the same art in the '533-FWD invalidating identical/substantially similar claims, amounts to a material error. With the Applicant's failure to appropriately

present the '533-FWD to the Examiner, discretionary denial is not warranted.

C. There Are No Settled Expectations in the '304's Validity

Having issued in very late 2020, PO cannot have developed settled expectations in the '304. *See, e.g., Berkshire Hathaway Energy Co. v. MES, Inc.*, IPR2025-00274, Pap. 23 at 3 (Director July 2, 2025) (finding no strong settled expectations for patents issued in 2019 and 2020). Indeed, given the Prior IPRs finding unpatentable claims identical or substantially similar to those challenged here, any expectation developed would be that of invalidity.

Likewise, Samsung Electronics Co., Ltd.'s ("Samsung") purported prior knowledge is based solely on allegations in its own complaint directed to a non-petitioner subsidiary of Samsung. DD Br. 14-15. Even if PO's allegations are true, any such settled expectation cannot undermine the strong interest in efficiency and consistency outweighing any minimal expectation PO may have. *See* §II.A.

D. The *Fintiv* Factors Weigh Against Discretionary Denial

The rest of the *Fintiv* factors collectively weigh against discretionary denial.

1. Factor 1 (Stay) Is Neutral At Best

Fintiv factor 1 favors institution where, in denying an earlier motion to stay, the district court "indicated to the parties that it will consider a renewed motion...to stay if a PTAB trial is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Pap. 11 at 6-7 (PTAB Mar. 20, 2020) ("*Fintiv*"). Here, Petitioners' pre-institution motion

was denied without prejudice as “premature.” Ex. 2006. Petitioners will renew their motion to stay if the Board institutes the IPRs, and it is likely to be granted.⁷ *See e-Watch Inc. v. Apple, Inc.*, No. 2:13-cv-1061, 2015 WL 12915668, at *3 (E.D. Tex. Mar. 25, 2015) (the timing of the defendant’s earlier motion to stay weighs in favor of granting “promptly renewed” post-institution motion to stay).

As detailed below (§II.D.3), a significant amount of work remains in the Texas Case, including most of claim construction, fact/expert discovery, and dispositive motions—the early phase of the litigation increases the likelihood of a stay. *Fintiv*, IPR2020-00019, Pap. 11 at 9-10. *Markman* is also set for February 13, 2026, after the Board’s institution deadline. This district court, and Judge Gilstrap in particular, frequently stays proceedings post-institution and before a *Markman* hearing. *See, e.g., Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-CV-00001, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (granting stay prior to *Markman*); *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, No. 2:17-CV-00140, 2019 WL 11023976, at *6-7 (E.D. Tex. Feb. 14, 2019) (granting stay three months prior to

⁷ PO’s statement that Judge Gilstrap has only a 21% grant rate for post-institution motions to stay is misleading, as the cited document indicates a grant rate of 33% for the last two years. DD Br. 4 (citing Ex. 2007). Regardless, PO’s statistics do not specify at what stage of the case these decisions were made. Ex. 2007.

scheduled trial date).

The district court has granted stays in cases that have advanced far beyond the instant case. *See, e.g., Stingray Music USA, Inc. v. Music Choice*, No. 16-cv-00586, 2017 WL 9885167, at *2 (E.D. Tex. Dec. 12, 2017) (granting stay after expert report exchange because “a stay might still obviate the need to prepare for trial [on] some or all ... claims, thus reducing the burden ... on the parties and the Court”).

2. Factor 2 (Trial Date) Does Not Support Discretionary Denial

A FWD would issue here by February 12, 2027. While the Texas Case’s trial is tentatively set for August 17, 2026, this is unlikely even under PO’s “median time to trial” (DD Br. 5). Indeed, between 2024-2025, the median time to trial in the Eastern District of Texas is 26 months, pushing the expected trial date to February 20, 2027 (the complaint was filed December 20, 2024) *after* the expected FWD date. Ex. 1110 at 35. And, PO’s “637” day median time to trial date (DD Br. 5) is based on outdated data spanning a 10 year period that no longer accurately reflects the increased congestion experienced by the district court. Ex. 2008 (based on cases pending between 10/3/2015 and 10/3/2025); DD Br. 5.

Indeed, delay is likely in the Texas Case. Twelve other active cases have the same trial date as the Texas Case, where trial dates are routinely delayed. Ex. 1111; Ex. 1112 at 1 (“This case has been set for trial five times.... The parties have also

been notified that other cases are preferentially set ahead of them for the [other] trial settings.”); *BOE Tech. Grp. Co. v. Optronix Scis. LLC*, IPR2024-01130, Pap. 16 at 10 (PTAB Jan. 27, 2025) (*Fintiv* factor 2 “neutral or weigh[s] slightly in favor of not exercising discretion” where Judge Gilstrap set 10 trials on the same day). The trial date is likely to be further delayed given the likelihood the district court will grant Petitioners’ renewed motion to stay if the Board grants institution. *See supra* §II.D.1. Factor 2 is thus neutral and does not support discretionary denial. *Volkswagen Grp. of Am., Inc. v. Longhorn Automotive Grp. LLC*, IPR2025-01064, Pap. 9 at 2 (Director Oct. 10, 2025) (*Fintiv* factor 2 neutral where scheduled trial date preceded expected FWD date, but the time-to-trial statistics suggested the trial would begin after the FWD date); *BOE Tech.*, IPR2024-01130, Pap. 16 at 10.

Even in the unlikely event that the current trial date is not delayed, when “balanced” against the other factors favoring institution, discretionary denial is still not warranted. *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Pap. 11 (Director Sept. 4, 2025) (declining to exercise discretion, despite the projected FWD due date post-dating the scheduled trial date by 7 months); *Padagis*, IPR2025-00464, Pap. 12 (same); *Samsung Display Co. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Pap. 12 at 6, 9 (PTAB Mar. 6, 2025) (post-rescission) (same).

3. Factor 3 (Parallel Proceeding) Supports Institution

The district court has not made a single substantive ruling regarding any of

the six challenged patents, and PO does not dispute. DD Br. 5-7; *Fintiv*, IPR2020-00019, Pap. 11 at 10 (finding no “orders related to the patent at issue in the petition” weighing against discretionary denial). This factor strongly favors institution.

The Texas Case has made little progress. Fact and expert discovery do not close for almost 5 and 7 months, respectively. Contrary to PO’s allegations (DD Br. 6), PO served only four interrogatories, provided no substantive responses to any of Petitioners’ interrogatories, and produced around a hundred documents. Ex. 1113. No fact nor expert deposition has been scheduled. No case-dispositive motions have been filed (the deadline is May 11, 2026). Claim construction⁸ is also in its early phases—the parties have yet to file any claim construction briefs. As currently scheduled, *Markman* is set for February 13, 2026—shortly after the Board’s institution deadline. These dates are likely to be extended given multiple trials scheduled on the current trial date, further supporting institution. *See supra* §II.D.2.

PO’s assertion that Samsung “waited more than **4 years** to challenge the ’304” (DD Br. 20) is supported only by its own allegations and concerns only a non-

⁸ In the Texas Case, Petitioners propose constructions consistent with the plain and ordinary meaning and do not contend that any term is indefinite. Exs. 1118-1120. Petitioners thus treat claim terms consistently in the Texas Case and in these IPRs. *See* §VIII of Pet., ’868 Pet., ’533 Pet., ’455 Pet., ’790 Pet., and ’475 Pet.

petitioner. *See supra* §II.C. Petitioners were diligent in preparing and filing the IPRs. PO served its infringement contentions on March 12, 2025 and amended them on May 9, 2025. After filing the Original Complaint on December 20, 2024, PO twice amended it on March 6 and May 19, 2025 to additionally assert the '790 and '475 (challenged in IPR2025-01253 and -01254, respectively). Importantly, PO did not send a request for waiver of service to Petitioner OnePlus Technology (Shenzhen) Co., Ltd. ("OnePlus") for six months, until June 20, 2025. Ex. 1115. Without OnePlus's participation, Petitioners could not submit their *Sotera-plus* stipulations across all defendants in the Texas Case. Any purported "delay" in filing the IPRs (DD Br. 6-7) was the "direct result of [PO's] own litigation activity" and Petitioners' reliance on the Prior IPRs is a proper and "efficient[]" "exten[sion]" of the Board's analysis in the '533-/ '484-FWDs, not an attempt to gain an unfair advantage by using the FWDs as a roadmap. *Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC*, IPR2020-00994, Pap. 19 at 12, 19, 21-22 (PTAB Nov. 19, 2020).

4. Factor 4 (Issue Overlap) Weighs Strongly In Favor of Institution

Petitioners' stipulations guarantee no overlap between the instant IPR proceedings and the Texas Case, and strongly favors institution. *See supra* §II.A. And, contrary to PO's assertion (DD Br. 18-19), challenging additional claims with

substantively different limitations beyond those involved in the district court favors institution as the district court will not reach these issues.⁹ *Fintiv*, IPR2020-00019, Pap. 11 at 10, 13 (challenging claims that are not “similar” to “those at issue in the district court” weighs “against exercising discretion to deny institution”).

5. Factor 5 (Same Party) Is Neutral

Petitioners are all defendants in the Texas Case. Factor 5 is “neutral.” *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Pap. 13 at 9 (PTAB Jan. 14, 2021).

6. Factor 6 (Other Considerations) Weighs Strongly In Favor of Institution

Efficiency and consistency strongly favor institution, and no settled expectations support discretionary denial. *See supra* §§II.A-C. Collateral estoppel eliminates the Board’s need to substantively review over 70% of all limitations at issue in the IPRs, and over 80% for this IPR. *See supra* §II.A. “[C]ollateral estoppel requires that the *issues of patentability* be identical,” not claims. *Google LLC v. Hammond Dev. Int’l, Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022); *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2023-00446, Pap. 30 at 20-21 (PTAB Aug. 5, 2024) (applying collateral estoppel to a subset of a claim).

Indeed, PO identifies only two limitations in all independent claims as new

⁹ *E.g.*, “spatially coupling” (’304, cl.3), “threshold function,” “pattern identification or classification,” and “regression signal processing” (’304, cls.12 & 26).

(DD Br. 10-11) without disputing that other '304 independent claim limitations are identical/substantially similar to the claims already invalidated by the Board.¹⁰ Even the “new” limitations are taught by Lisogurski, which was before both the Board in the '533-FWD and the Examiner—this is material error. *See supra* §II.B.

Finally, while arguing that collateral estoppel does not attach based on the '484-RFWD due to pending appeal, PO does not urge the Board to deviate from that decision. DD Br. 12; Pet. 61-65 (applying the '484-RFWD's rationale). It cannot. *Vivint, Inc. v. Sb Ip Holdings LLC*, IPR2022-01352, Pap. 20 at 52-53 n.12 (PTAB Mar. 19, 2024) (“find[ing] no reason...to deviate from the Board's decision” even without collateral estoppel due to pending appeal). And, should the appeal resolve during the pendency of this proceeding, collateral estoppel will apply. *See Ironsource Ltd. v. Digital Turbine Inc.*, PGR2022-00053, Pap. 58 at 13-15 (PTAB Mar. 12, 2024) (applying collateral estoppel based on prior FWD that concluded appeal during pendency of instant IPR).

III. CONCLUSION

For the above reasons, PO's request for discretionary denial should be denied.

¹⁰ Thus, contrary to PO's assertion (DD Br. 11-12), *Hammond*, *Netlist*, and *POSCO* are apposite. *See* §II.A.

Dated: November 12, 2025

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
*Counsel for Petitioners Samsung
Electronics Co. Ltd. and Samsung
Electronics America Inc.*

Jasjit S. Vidwan
Registration No. 72,080
Robert G. Pluta
Registration No. 50,970
Counsel for Petitioner Oura Health Oy

Jared A. Smith
Registration No. 73,749
Ricardo J. Bonilla
Registration No. 65,190
*Counsel for Petitioners Fossil Group,
Inc., Fossil Stores I, Inc. and Fossil
Partners*

Jack Shaw
Registration No. 72,262
*Counsel for Petitioner OnePlus
Technology (Shenzhen) Co., Ltd.*

CERTIFICATE OF COMPLIANCE

Pursuant to §42.24(d), the undersigned certifies that the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Brief contains, as measured by the word-processing system used to prepare this paper, 4555 words and 20 pages. This word count does not include the items excluded by §42.24 as not counting towards the word limit. *Interim Director Discretionary Process*, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

Dated: November 12, 2025

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
*Counsel for Petitioners Samsung
Electronics Co. Ltd. and Samsung
Electronics America Inc.*

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF were served by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as providing a courtesy copy via electronic mail to the following attorneys of record for each party as listed below:

OMNI MEDSCI, INC.	
Lead Counsel	Back-Up Counsel
Jennifer Hayes Registration No. 50,845 Nixon Peabody LLP 300 South Grand Avenue, Suite 4100 Los Angeles, CA 90071-3151 Phone: 213-629-6179 Facsimile: 213-629-6001 jenhayes@nixonpeabody.com	Daniel Stringfield Registration No. 68,677 Phone: 312-977-4130 Facsimile: 833-923-0056 dstringfield@nixonpeabody.com Timothy Maloney Registration No. 38,233 Phone: 312-977-4451 Facsimile: 833-818-8070 tmaloney@nixonpeabody.com Angelo J. Christopher Registration No. 81,594 Phone: 312-977-4391 Facsimile: 312-977-4405 achristopher@nixonpeabody.com Benjamin R. Holt Registration No. 78,605 Phone: 202-585-8048 Facsimile: 833-824-1380 bholt@nixonpeabody.com Daniel Georgiev Registration No. 80,647

	Phone: 312-977-4412 Facsimile: 833-824-7710 dgeorgiev@nixonpeabody.com Corey Leggett Registration No. 70,017 (415) 984-8340 Facsimile: 415-984-8300 cleggett@nixonpeabody.com
FOSSIL GROUP, INC., FOSSIL STORES I, INC., AND FOSSIL PARTNERS, L.P.	
	Back-Up Counsel
	Jared A. Smith Reg. No. 73,749 FISH & RICHARDSON P.C. 12860 El Camino Real, Suite 400 San Diego, CA 92130 Phone: +1 858-678-4702 Fax: +1 858-678-5099 jasmith@fr.com Ricardo J. Bonilla Reg. No. 65,190 FISH & RICHARDSON P.C. 1717 Main Street, Suite 5000 Dallas, TX 75201 Phone: +1 214-760-6150 Fax: +1 214-747-2091 rbonilla@fr.com
OURA HEALTH OY	
	Back-Up Counsel
	Jasjit S. Vidwan Reg. No. 72,080 MAYER BROWN LLP 1999 K Street, NW Washington, DC 20006-1101

	Tel.: 202.263.3065 JVidwan@mayerbrown.com Robert G. Pluta Reg. No. 50,970 MAYER BROWN LLP 71 S. Wacker Drive Chicago, IL 60606 Tel.: 312.701.8641 RPluta@mayerbrown.com
ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.	
	Back-Up Counsel
	Jack Shaw Reg. No. 72,262 CHERRY JOHNSON SIEGMUND JAMES PC 8140 Walnut Hill Lane, Suite 105 Dallas, Texas 75231 Tel: 254-732-2242 Fax: 866-627-3509 jshaw@cjsjlaw.com

Dated: November 12, 2025

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
*Counsel for Petitioners Samsung
Electronics Co. Ltd. and Samsung
Electronics America Inc.*