

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. 10,874,304

Case No. IPR2025-01251

**PATENT OWNER'S ADDITIONAL BRIEF REGARDING THE IMPACT
OF THE *REVVO* AND *TESLA* DECISIONS**

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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 '304 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 '304 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	<i>Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC</i> , IPR2025-00482, Paper 13 (PTAB May 28, 2025)
2011	Patent Assignment Record for U.S. Patent No. 8,108,036
2012	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 27 (PTAB Apr. 11, 2025)
2013	R. Marbach, T. Koschinsky, F. Gries, and H. Heise, "Noninvasive Blood Glucose Assay by Near-Infrared Diffuse Reflectance Spectroscopy of the Human Inner Lip," <i>Appl. Spectrosc.</i> 47, 875-881 (1993)
2014	Roggo, Y., et al., "A review of near infrared spectroscopy and chemometrics in pharmaceutical technologies," <i>Journal of Pharmaceutical and Biomedical Analysis</i> , 44, 683–700 (2007)

Exhibit No.	Description
2015	Buttussi, F., et al., MOPET: A context-aware and user-adaptive wearable system for fitness training, <i>Artificial Intelligence in Medicine</i> (2008) 42, 153-163
2016	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00912, Paper 1 (PTAB Apr. 10, 2019)
2017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00913, Paper 1 (PTAB Apr. 10, 2019)
2018	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00914, Paper 1 (PTAB Apr. 10, 2019)
2019	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00915, Paper 1 (PTAB Apr. 10, 2019)
2020	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00029, Paper 1 (PTAB Oct. 17, 2019)
2021	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00175, Paper 1 (PTAB Dec. 11, 2019)
2022	Defendant's Invalidity Contentions, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2: 18-cv-00134 (E.D. Tex.) (Aug. 28, 2018)
2023	Defendant's Invalidity Contentions - Exhibit A, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2024	Defendant's Invalidity Contentions - Exhibit N, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2025	Defendant's Invalidity Contentions - Exhibit P, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2026	Reserved
2027	Reserved
2028	Reserved
2029	Reserved
2030	Reserved
2031	Declaration of Prof. Igor Efimov, Ph.D
2032	<i>Curriculum vitae</i> of Prof. Igor Efimov, Ph.D
2033	Omni MedSci Inc.'s P.R. 4-2 Disclosure of Preliminary Claim Constructions and Extrinsic Evidence
2034	Samsung Electronics, Co. Ltd., Samsung Electronics America, Inc., Fossil Group, Inc., Fossil Stores I, Inc., and Fossil Partners, L.P., and Oura Health Oy's P.R. 4-2 Disclosure of Preliminary Claim Constructions and Extrinsic Evidence

Exhibit No.	Description
2035	König, V., et al., “Reflectance Pulse Oximetry – Principles and Obstetric Application in the Zurich System,” Journal of Clinical Monitoring, Vol. 14, pp. 403-412 (1998)
2036	Reserved
2037	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00914, Paper 13 (PTAB Nov. 6, 2019)
2038	Statutory Disclaimer dated November 11, 2025
2039	<i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 25-1646, Corrected Opening Brief of Appellant Omni MedSci, Inc. (Fed. Cir. Sept. 11, 2025)
2040	Email exchange between Petitioners and Patent Owner concerning indefiniteness contentions.

I. INTRODUCTION

As set forth in Patent Owner's Preliminary Response (Paper 12, "POPR"), the Director should deny institution, among other reasons, because Petitioners failed to justify their inconsistent claim construction positions relative to the parallel Texas Case. Paper 12, 12-16; *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3-4 (PTAB Nov. 3, 2025) (precedential) (requiring petitioners provide a sufficient explanation when it "takes alternative positions before the Board and a district court" to "ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums"). Petitioners' claim construction positions are inconsistent and warrant denial because Petitioners asserted indefiniteness for certain terms in the Texas Case and have not fully withdrawn those assertions. *See* Paper 12, 12-16.

II. PETITIONERS DID NOT AND HAVE NOT WITHDRAWN THEIR INDEFINITENESS CONTENTIONS IN THE TEXAS CASE

The Petition acknowledges that "[i]n the Texas Case, Defendants identified certain limitations [of the '304 Patent] as indefinite" (Pet., 14 n.3 (citing EX1023, 236-238)) yet purports to apply the plain and ordinary meaning for these terms (*id.*, 13-15). The Director has confirmed that denial is warranted in this situation absent a sufficient explanation because "[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent

indefiniteness arguments in district court fails to further, but instead detracts from, the Office's goal of 'providing greater predictability and certainty in the patent system.'" *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 4 (PTAB Nov. 5, 2025) (informative) (quoting *Revvo Techs.*, IPR2025-00632, Paper 20 at 4-5).

Attempting to justify the inconsistency, Petitioners' additional brief merely repeats their conclusory assertions in the Petition that "the prior art discloses and renders obvious the indisputable scope of these limitations." Pet., 14 n.3 (citing EX1003, ¶¶66-67, 118-120, 141-142, 181, 200, 235, 242, 258-59, 281, 285, 289, 298, 304, 309, 313, 342-43, 359-360, 364, 400-401); Paper 16, 1-3. Petitioners do not explain what that "indisputable scope" is or what the "outer bounds" of the limitations are. Pet., 18-77; Paper 16, 1-3.¹ Petitioners' conclusory assertion that the prior art meets the claims even if they are indefinite does not explain the inconsistency any more than simply saying that indefiniteness cannot be raised in an

¹ Petitioners' expert fares no better than the Petition, and regardless, Petitioners' explanation was required in the Petition. EX1003, ¶¶66-67, 118-120, 141-142, 181, 200, 235, 242, 258-59, 281, 285, 289, 298, 304, 309, 313, 342-43, 359-360, 364, 400-401; *see* 37 C.F.R. §§ 42.22(a)(2), 42.6(a)(3).

IPR. *Tesla*, IPR2025-00340, Paper 18 at 4.

Petitioners also argue there is no inconsistency because they “withdrew all indefiniteness positions in the Texas Case.” Paper 16, 1. Petitioners’ purported “withdrawal” is insufficient for two reasons. First, Petitioners have only stipulated that they “will not raise any indefiniteness arguments in the Texas Case as to any claims *subject to an instituted IPR* in this proceeding.” Paper 16, 4 (emphasis added). This expressly allows Petitioners to raise indefiniteness in the Texas Case unless the Director institutes an IPR. Indeed, Petitioners have not amended or withdrawn their invalidity contentions asserting indefiniteness. EX1023, 234-238; EX2003, 234-238.

Second, Petitioners’ assertion that they “withdrew” indefiniteness for the ’304 Patent when they did not expressly raise it in their claim construction disclosures is incorrect. Paper 16, 2-4. Courts in the Eastern District of Texas have allowed defendants to assert indefiniteness after claim construction. *See, e.g., Erfindergemeinschaft UroPep GbR v. Eli Lilly & Co.*, 240 F. Supp. 3d 605, 624-26 (E.D. Tex. 2017) (considering indefiniteness theory during summary judgment even though the parties were directed to argue indefiniteness at claim construction stage); *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. 2:13-CV-00103-JRG-RSP, 2017 WL 275386, at

*5-6 (E.D. Tex. Jan. 9, 2017).

Petitioners' reliance on *Stratasys, Inc. v. Shenzhen Tuozhu Tech. Co.* is misplaced because it shows that a defendant can raise indefiniteness after dropping it in its initial claim construction disclosures upon a showing of good cause. No. 2:24-CV-00644, 2025 WL 3164626, at *1-2 (E.D. Tex. Nov. 12, 2025). Again, Petitioners could have eliminated this possibility by stipulating that they would not raise indefiniteness in the Texas Case without hedging but refused to do so. EX2040, 2. The uncertainty caused by Petitioners' limited stipulation is contrary to the Office's goal of "providing greater predictability and certainty." *Revvo Techs.*, IPR2025-00632, Paper 20 at 4-5.

III. CONCLUSION

For the reasons set forth herein and in Patent Owner's Preliminary Response, Patent Owner respectfully submits that the Petition should be denied as to all requested grounds.

Respectfully submitted,

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The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Additional Brief Regarding the Impact of the *Revvo* and *Tesla* Decisions** was served on December 17, 2025, by email:

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