

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 IPR2025-01252
Patent No. 11,160,455

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

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EXHIBIT LIST

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1001	U.S. Patent No. 11,160,455 (“455”)
1002	File History of U.S. Application No. 17/078,771 (“455FH”)
1003	Declaration of Brian Anthony in Support of Petition for Inter Partes Review of U.S. Patent No. 11,160,455, (“Anthony”)
1004	Declaration of Brian Anthony in Support of Petition for Inter Partes 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. 21-01229, ECF 69 (Fed. Cir. June 8, 2022)
1010	Declaration of Brian Anthony in Support of Petition for Inter Partes 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.”)

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1013	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2021-00453, Paper 7 (P.T.A.B. Aug. 6, 2021) (“484-Inst.”)
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. 23-01034, ECF 44 (Fed. Cir. June 21, 2024)
1018	<i>Omni MedSci, Inc. v. Apple Inc.</i> , 2:18-cv-00134-RWS, Dkt. No. 211 (E.D. Tex. June 24, 2019)
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	Reserved
1022	<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.)

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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. 2005/0049468A1 (“Carlson”)
1029	<i>Reserved</i>
1030	U.S. Patent No. 7,029,628 (“Tam”)
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”)

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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”)
1047	U.S. Patent No. 5,028,787 (“Rosenthal”)
1048	U.S. Pat. No. 9,239,951 (“Hoffberg”)
1049	U.S. Pat. Pub. 2007/0194939 (“Alvarez”)
1050	U.S. Patent No. 8,364,226 (“Diab”)
1051	U.S. Patent No. 6,931,269 (“Terry”)
1052-1058	<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”)
1062-63	<i>Reserved</i>
1064	U.S. Patent No. 5,554,273 (“Demmin”)
1065	U.S. Patent No. 5,953,713 (“Behbehani”)
1066-76	<i>Reserved</i>
1077	U.S. Patent Publication No. 2006/0184040 (“Keller”)

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1078-1080	<i>Reserved</i>
1081	US. Patent No. 9,651,533 (“533”)
1082	U.S. Patent No. 10,517,484 (“484”)
1083	<i>Reserved</i>
1084	Declaration of Jonathan Bradford
1085	<i>Apple Inc. v. Omni Medsci, Inc.</i> , No. IPR2019-00916, Paper 10 (P.T.A.B. Jul. 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>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01251, Paper 1 (P.T.A.B. Aug. 5, 2025) (“304 Pet.”)
1095	<i>Reserved</i>
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	U.S. Patent No. 10,874,304 (“304”)
1101	<i>Reserved</i>
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
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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 to counsel for Omni

TABLE OF ABBREVIATIONS

Exhibit No.	DESCRIPTION
Challenged Claims	Claims 1-20 of the '455 patent
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. IPR2025-01252, Pap. 1 (PTAB Aug. 5, 2025)
DD Br.	<i>Samsung Electronics Co., Ltd. et al. v. Omni MedSci, Inc.</i> , No. IPR2025-01252, Pap. 11 (PTAB Oct. 14, 2025)
Texas Case	<i>Omni MedSci, Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:24-cv-01070-JRG-RSP (E.D. Tex.)
FWD	Final Written Decision
'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 FWDs	'533-FWD and '484-FWD
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)
'304 Pet.	<i>Samsung Electronics Co., Ltd. et al v. Omni MedSci, Inc.</i> , No. IPR2025-01251, 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)
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

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 challenged in the IPRs, including those here, are identical or substantially similar to those already found unpatentable in prior IPRs challenging related patents.³ Efficiency and consistency are thus best served by the Board's

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 filed IPR2025-01249 through -01254 challenging six patents asserted in district court, as well as PGR2025-00063 and -00064, which are alternative and substantively identical to IPR2025-01254 and -01253 (collectively, “the IPRs”). Thus, Petitioners seek to institute only 6 proceedings. Exs. 1086-1087.

³ Apple Inc. challenged claims 5, 7-10, 13, 15-17 of the ’533 in IPR2019-00916 and all claims of the ’484 in IPR2021-00453 (“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. Though PO did not appeal the Board’s unpatentability decision on claims 1, 2, 7, and 15-23 of the ’484 (Ex. 1015, “’484-FWD”), Apple appealed the remaining claims (Ex. 1017), which were ultimately found unpatentable by the Board after remand from the Federal Circuit based on claim

review of the IPRs together.

It is more efficient for the Board to resolve the overlapping validity questions of the six patents-at-issue. **First**, collateral estoppel eliminates substantive review of over 70% of all challenged limitations across the IPRs (almost 75% here), and can only be applied by the Board. **Second**, efficiency and consistency will be best promoted by the Board's review of the IPRs together, as five ('533, '304, '455, '790, '475) of the six challenged patents include limitations identical/substantially similar to those deemed unpatentable in Prior IPRs. **Third**, Petitioners' *Sotera*-plus stipulation eliminates any potential overlap with the Texas Case.

Importantly, despite having access to the same art and grounds—including the IPR petitions and expert declarations—that rendered identical/substantially similar claims of the related '484 and '533 unpatentable in the Prior IPRs, the Examiner nevertheless allowed the Challenged Claims without a single rejection. This constitutes material error, and discretionary denial under §325(d) is not warranted.

The median time-to-trial also places trial after the final written decision ("FWD"). In light of the *Fintiv* factors further weighing against exercising discretionary denial, no settled expectations even alleged by the PO, and extensive

construction (Ex. 1016, 2-3). PO appealed again. Ex. 1091. PO's litigation against Apple involving the '484 patent is currently stayed pending that appeal. Ex. 1116.

IPR history successfully challenging related patents in the same family, 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 to exercise discretionary denial in similar situations to promote “efficien[cy]” and “consistency” in related IPRs. *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Pap. 13 at 2-3 (Director June 26, 2025) (“it is an efficient use of Board resources to address the related patent”); *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Pap. 10 at 3 (Director June 25, 2025) (“It is an appropriate use of Office resources to provide consistency and predictability to the public[.]”). That rationale applies even more strongly here.

First, collateral estoppel significantly narrows the scope of substantive review for the Board. PO does not dispute that 139 of 194 total limitations (over 70%) challenged across the 6 IPRs—or 46 of 62 limitations here (almost 75%)—are identical or substantially similar to those held unpatentable in prior related IPRs based on the same grounds presented here. IPR2025-01252, Pap. 1 (“Pet.”), 18-20; IPR2025-01250, Pap. 1 (“’533 Pet.”), 19; IPR2025-01251, Pap. 1 (“’304 Pet.”), 16-18; IPR2025-01253, Pap. 1 (“’790 Pet.”), 18-21; IPR2025-01254, Pap. 1 (“’475 Pet.”), 19-21. Thus, “collateral estoppel” precludes PO from relitigating these “substantially similar” limitations before the Board. *Samsung Elecs. Co., Ltd. v.*

Netlist, Inc., IPR2025-00002, Pap. 17 at 17-24 (PTAB May 15, 2025). In contrast, the district court cannot apply collateral estoppel based on prior Board unpatentability decisions rendered under a different standard of proof. See *ParkerVision, Inc. v. Qualcomm Inc.*, 116 F.4th 1345, 1361-62 (Fed. Cir. 2024); *Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1379-81 (Fed. Cir. 2025).

While PO also argues that the Eastern District of Texas’s model order requires the narrowing of asserted claims to a maximum of 16, PO has refused to limit its asserted claims. Pap. 11 (“DD Br.”), 18; Ex. 1098 (Petitioners’ request to narrow claims and prior art, which remains unanswered). And even if it did, assuming it asserted one independent claim per patent and a claim for the ’533 (fewer than 16), the district court would still have close to 80 limitations⁴ to address, rather than fewer than 60 limitations across six IPRs before the Board due to collateral estoppel.

Second, these IPRs will promote “efficient use of Board resources” and “consistency and predictability to the public” because five (’533, ’304, ’455, ’475, ’790) of the six challenged patents are related to the ’533 and ’484 successfully challenged in Prior IPRs. *Embody*, IPR2025-00248, Pap. 13 at 2-3; *FreightCar*

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).

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.

Contrary to PO's argument (DD Br. 18), *Tesla, Inc. v. Intellectual Ventures II LLC* is on point. As the Director noted, challenged claims "similar" to those in an "ancestor patent" that the Board previously found unpatentable, just as here, "counsel[ed] against discretionary denial." IPR2025-00217, Pap. 9 at 2 (Director June 13, 2025). Thus, the "diverse range of subject matter" was merely a factor, and not the sole reason, for declining discretionary denial. *Id.* at 2-3.

Third, Petitioners' broad stipulation eliminates any overlap with the Texas 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. 13; '868 Pet. 15; '533 Pet. 13; '304 Pet. 12; '790 Pet. 13; '475 Pet. 14. Thus, there will be no overlap with Texas Case (*contra* 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) 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) (petitioners were not precluded from relying on a prior art system even though publications evidencing the prior art system in an IPR could have been raised). Sections 101 and 112 also would not cause duplicative efforts or inconsistent rulings (DD Br. 8), as those are beyond the Board’s statutory jurisdiction. 35 U.S.C. §311(b).

PO’s cited cases are inapposite. DD Br. 9, 11. *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 June 6, 2025) involved a standard “*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’s decision granting discretionary denial did not address the sufficiency of the stipulation at all. Indeed, “broad stipulation” similar to Petitioners’ precluding combination with system art

was found to weigh against discretionary denial. *See Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Pap. 10 at 3 (Director July 17, 2025).

B. The Examiner’s Material Errors Support Institution⁵

PO’s §325(d) arguments (DD Br. 12-15) only highlight the Examiner’s material error. **Lisogurski** and **Carlson**, relied upon in the instant IPR, were before the Examiner during prosecution, and are the same references that the Board relied on in the prior related ’484-/’533-FWDs (“Prior FWDs”) to hold claims identical/substantially similar to the Challenged Claims unpatentable. Pet. 18-20. A comparison of claim 1 of the ’455 with claim 1 of the ’484 illustrates the Examiner’s error in allowing the ’455 based on the same art. *See* Pet. §IX.A; *supra* §II.A.

’455 claim 1 ⁶	’484 claim 1
[1.pre] A system for measuring one or more physiological parameters and for use with a smart phone or tablet, the system comprising:	[1.pre] A system for measuring one or more physiological parameters and for use with a smart phone or tablet, the system comprising:

⁵ Petitioners identified Lisogurski, Tran, and Carlson via the Prior FWDs, and LeBoeuf via an IDS submitted during prosecution.

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

[1.a] a wearable device adapted to be placed on teeth, a wrist, or an ear of a user, and	[1.a] a wearable device adapted to be placed on a wrist or an ear of a user,
[1.b] including a light source comprising a driver and a plurality of semiconductor sources, the plurality of semiconductor sources configured to generate an output optical light having a plurality of optical wavelengths	[1.b] including a light source comprising a plurality of semiconductor sources that are light emitting diodes, each of the light emitting diodes configured to generate an output optical light having one or more optical wavelengths;
[1.c] the wearable device comprising one or more lenses configured to receive at least a portion of the output optical light and to deliver a lens output light to tissue;	[1.c] the wearable device comprising one or more lenses configured to receive a portion of at least one of the output optical lights and to direct a lens output light to tissue;
[1.d] the wearable device further comprising a detection system configured to receive at least a portion of the lens output light reflected from the tissue and to generate an output signal having a signal-to-noise ratio,	[1.d] the wearable device further comprising a detection system configured to receive at least a portion of the lens output light reflected from the tissue and to generate an output signal having a signal-to-noise ratio,
[1.e] wherein the detection system is configured to be synchronized to the light source;	[1.e] wherein the detection system is configured to be synchronized to the light source;
[1.f] wherein the detection system comprises a plurality of detectors that are	[1.f] wherein the detection system comprises a plurality of spatially

spatially separated from each other, and wherein at least one analog to digital converter is coupled to at least one of the spatially separated detectors;”	separated detectors, and wherein at least one analog to digital converter is coupled to at least one of the spatially separated detectors; ...
[1.g] the smart phone or tablet comprising a wireless receiver, a wireless transmitter, a display, a speaker, a voice input module, a microprocessor and a touch screen, the smart phone or tablet configured to receive and process at least a portion of the output signal, wherein the smart phone or tablet 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;	[1.h] the smart phone or tablet comprising a wireless receiver, a wireless transmitter, a display, a speaker, a voice input module, 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, wherein the smart phone or tablet 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;
[1.h] wherein the output signal is indicative of one or more of the physiological parameters;	[1.g] wherein the output signal is indicative of one or more of the physiological parameters,...
[1.i] the wearable device configured to increase the signal-to-noise ratio by increasing light intensity of at least one	[1.j] the wearable device configured to increase the signal-to-noise ratio by increasing light intensity of at least one of the plurality of semiconductor

of the semiconductor sources from an initial light intensity;	sources from an initial light intensity...;
[1.j] the detection system further configured to: generate a first signal responsive to light received while the semiconductor sources are off,	[1.k] the detection system further configured to: generate a first signal responsive to light received while the light emitting diodes are off,
[1.k] generate a second signal responsive to light received while at least one of the semiconductor sources is on; and	[1.l] generate a second signal responsive to light received while at least one of the light emitting diodes is on, and
[1.l] increase the signal-to-noise ratio by comparing the first signal and the second signal; and	[1.m] increase the signal-to-noise ratio by comparing the first signal and the second signal.
[1.m] wherein the plurality of optical wavelengths comprises three optical wavelengths for measuring at least a portion of the one or more of the physiological parameters, wherein the optical wavelengths comprise near infrared or visible wavelengths.	No corresponding limitation.

As shown above, '455 claim 1 is strikingly similar to '484 claim 1. Prosecution of the '455 further confirms this, as the Applicant filed a terminal disclaimer to the '484 patent to secure allowance of the claims. '455FH, 378-385, 396. Though PO argues that [1.m], [8.m], [15.m], and [15.o] of the '455 are different

from those previously considered in the Prior FWDs (DD Br. 10), PO does not dispute that **Lisogurski** also discloses these limitations. *See* Pet. 45-51, 57-58.

Despite having access to the same art and grounds relied upon in the Prior FWDs (e.g., **Lisogurski, Carlson**)—including Apple’s ’484 and ’533 IPR petitions, declarations from the expert, and other supporting materials explaining how the art rendered unpatentable claims that were identical/substantially similar to the Challenged Claims here, and the ’533 FWD adopting those grounds—the Examiner still allowed the Challenged Claims *without a single rejection*. ’455FH, 278-289, 294-313, 316-321, 324-347, 350-352, 355-359, 364-367, 370-376, 403-404, 407-429, 433-434, 441-457, 461-464, 467-469, 496-497, 500-522, 526-527, 534-550, 554-563. This was material error. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Pap. 13 at 5 (Director May 19, 2025) (precedential) (*Advanced Bionics* part two may be satisfied if “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”).

Padagis is on point. There, the Director declined discretionary denial because, as here, the examiner allowed challenged claims with “significant overlap in claimed subject matter” with claims in a related patent that were held unpatentable by the Board in a prior IPR. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Pap. 12 at 2-3 (Director July 16, 2025). The Examiner’s allowance (including for

one challenged patent issuing before the prior related FWD) thus “***directly contradict[ed] the Board’s determination***” in the prior IPR and “raise[d] concerns of ***material error***.” *Id.* Such concerns were, and are here, sufficient to outweigh the trial date scheduled before the expected FWD date (*see* §II.C.2). *Id.*, Pap. 12 at 3.

Here, as in *Padagis*, the Examiner had access to the ’533 FWD invalidating claims with identical/substantially similar limitations as the ’455 (Pet. 18-20; ’455FH, 365, 567), confirming the Examiner’s failure to properly examine the Challenged Claims. *See ClearCorrect Operating, LLC v. Align Technology, Inc.*, IPR2025-00814, Pap. 14 at 3 (Director Aug. 29, 2025) (“the Office erred by allowing the claims after the Board determined that substantially similar claims are unpatentable”); *Ecto World*, IPR2024-01280, Pap. 13 at 5.

That **Lisogurski** meets these limitations is not mere disagreement with the Examiner (*contra* DD Br. 16-17), especially given the Examiner’s failure to reject even the limitations identical/substantially similar to those found unpatentable in the Prior IPRs based on the same art. *Keysight Techs., Inc. v. Centripetal Networks, Inc.*, IPR2022-01421, Pap. 14, 6-8 (Director Aug. 24, 2023) (despite “some differences” in “[claim] language,” Examiner erred by “misapprehend[ing] or overlook[ing]” the Board’s earlier FWD involving the same prior art and overlapping subject matter). In fact, the Board has already held claims from six patents in the same family unpatentable or at least reasonably likely to be

unpatentable, including based on at least **Lisogurski**. Exs. 1008, 1015-1016, 1104-1108. Though the IPR materials were cited in IDSs listing more than 700 other references, the Examiner’s initialing of them does not establish any “meaningful evaluation and appreciation of the prior art.” ’455FH, 278-289, 294-313, 316-321, 324-347, 350-352, 355-359, 364-367, 370-373, 137-155, 159-163, 167-177, 182-206, 211-213, 248-251, 425-427. *Dr. Reddy's Laboratories S.A. v. Eye Therapies, LLC*, IPR2024-00467, Pap. 14 at 19 (PTAB Aug. 13, 2024); *Ecto World*, IPR2024-01280, Pap. 13 at 6-7 (IDS containing over 1,000 references “may demonstrate that discretionary denial under §325(d) is not warranted”).

The Examiner’s failure to meaningfully consider **Lisogurski** and **Carlson**—the same art that rendered identical/substantially similar claims unpatentable in the Prior FWDs—constitutes material error. Discretionary denial is not warranted.

C. 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 weighs against discretionary denial where there is no stay but “the district court has denied a motion for stay without prejudice and 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).

As detailed below (§II.C.3), there is still significant work to do in the Texas Case, including most of fact discovery and claim construction, expert discovery, and dispositive motions—increasing the likelihood of a stay. *Fintiv*, IPR2020-00019, Pap. 11 at 9-10. *Markman* is scheduled for February 13, 2026, after the Board’s institution deadline on February 12, 2026. This district court, and Judge Gilstrap in particular, frequently stays proceedings post-institution when the court has not yet conducted a *Markman*. *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).

Indeed, the district court has granted stays in cases at more advanced stages. *See SSL Servs., LLC v. Cisco Sys., Inc.*, No. 2:15-cv-433, 2016 WL 3523871, at *2 (E.D. Tex. June 28, 2016) (granting stay after claim construction and trial less than 3 months away); *Stingray Music USA, Inc. v. Music Choice*, No. 2:16-cv-00586,

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.

2017 WL 9885167, at *2 (E.D. Tex. Dec. 12, 2017) (granting stay after fact discovery and expert reports because “a stay might still obviate the need to prepare for trial”); *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, No. 2:17-cv-140, 2019 WL 11023976, at *6-7 (E.D. Tex. Feb. 14, 2019) (granting stay 3 months before trial).

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

If this IPR is instituted, the FWD would issue by February 12, 2027. While trial is tentatively scheduled for August 17, 2026, even PO acknowledges that this is unlikely given the longer “median time to trial” (DD Br. 5). Between 3/2024 and 3/2025, the median time to trial in the Eastern District of Texas was 26 months, which would push the expected trial date to February 20, 2027 (complaint filed December 20, 2024), *after* the FWD deadline. Ex. 1110 at 35. 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).

Indeed, delay is likely in the Texas Case. Twelve other active cases have the same trial date as the Texas Case, which routinely delays trial dates. Ex. 1111; Ex. 1112 (“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 jury trials on the same day). The trial date is likely to be even further delayed given the likelihood the district court will grant Petitioners’ renewed motion to stay if the Board grants institution. *See supra* §II.C.1. Thus, factor 2 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 the scheduled trial date preceded the 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 that favor 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) (projected FWD due date post-dated scheduled trial date by 7 months); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Pap. 12 (Director July 16, 2025) (same); *Samsung Display Co. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Pap. 12 at 6, 9 (PTAB Mar. 6, 2025) (post-recission) (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. This factor strongly weighs against discretionary denial. *Fintiv*, IPR2020-00019, Pap. 11 at 10 (no “orders

related to the patent at issue in the petition” weighs against discretionary denial).

Contrary to PO’s misleading suggestion (DD Br. 6), the parties have invested little into the Texas Case. Fact and expert discovery do not close for almost 5 and 7 months, respectively, no fact or expert deposition has been taken or scheduled, and no case-dispositive motions have been filed (deadline not until May 11, 2026). Ex. 1020. PO has served only four interrogatories, provided no substantive responses to any of Petitioners’ interrogatories, and produced only around a hundred documents. Ex. 1113. No case-dispositive motions have been filed (deadline not until May 11, 2026). Claim construction is also in its early phases—claim construction discovery is not complete, and no briefing has been filed.⁸ As scheduled, *Markman* is set for February 13, 2026—after the Board’s institution deadline. Indeed, the Board has granted institution in cases more advanced than here. *See Samsung Display*, IPR2024-01222, Pap. 12 at 7 (factor 3 weighs against denial, even after *Markman* was held because “much remains to be done, including expert discovery”); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01432, Pap. 14 at 8-9 (PTAB Apr. 7, 2025) (factor 3 favors institution after *Markman* briefing was complete).

⁸ Consistent with the IPRs, Petitioners propose constructions consistent with plain meaning and do not contend that any term is indefinite in the Texas Case. Exs. 1118-1120. *See* §VIII of Pet., ’868 Pet., ’533 Pet., ’475 Pet., ’790 Pet., and ’304 Pet.

PO's assertion that "Samsung waited more than *2 years*" to challenge the '455 (DD Br. 6) is supported solely by unsubstantiated allegations in its Complaint, and PO's allegation that *non-petitioner* Ouraring, Inc. had knowledge of the '455 for 17 months before Petitioners filed this IPR is irrelevant.

Indeed, Petitioners were diligent in preparing and filing the IPRs. PO served its infringement contentions on March 12, 2025, which were amended on May 9, 2025. After filing the Original Complaint against all Petitioners on December 20, 2024, PO twice amended its complaint on March 6 and May 19, 2025 to additionally assert '790 and '475 (challenged in IPR Nos. 2025-01253 and -01254, respectively). Importantly, PO did not effectuate service on Petitioner OnePlus Technology (Shenzhen) Co., Ltd. ("OnePlus") for six months, resulting in OnePlus's return of a timely waiver on June 27, 2025. Ex. 1115. And, without OnePlus's participation, Petitioners could not submit their *Sotera-plus* stipulations across all defendants in the Texas Case. Thus, any purported "delay" in filing the IPRs (DD Br. 6-7) was the "direct result of [PO's] own litigation activity" and a proper and "efficient[]" "exten[sion]" of the Board's analysis in the prior FWDs, not an attempt to gain an unfair advantage by using the Prior FWDs as a roadmap. *Bayerische Motoren Werke Aktiengesellschaft v. Paice LLC*, IPR2020-00994, Pap. 19 at 12, 19, 21-22 (PTAB Nov. 19, 2020); *Samsung Elecs. Am., Inc. v. Uniloc Luxembourg S.A.*, IPR2017-01797, Pap. 8, 33-34 (PTAB Feb. 6, 2018).

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

Petitioners’ *Sotera*-plus stipulation guarantees no overlap with the Texas Case, strongly favoring institution. *See* §II.A. And, challenging additional claims with substantively different limitations⁹ beyond those involved in the district court also favors institution (*contra* DD Br. 17-19), as the district court will not reach these issues. *Fintiv*, IPR2020-00019, Pap. 11 at 10, 13 (challenging claims not “similar[]” to those “in the district court” weighs “against” discretionary denial).

5. Factor 5 (Same Party) Is Neutral

Petitioners are 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

As discussed (§II.A), efficiency and consistency strongly favor institution, and PO alleges no settled expectations supporting denial. Collateral estoppel precludes substantive review of over 70% of all limitations in the IPRs, including

⁹ *E.g.*, “the output signal corresponding to at least one of the optical wavelengths is used to improve measurement...using the output signal corresponding to the other two optical wavelengths” (’455, cls. 4, 11, 16); and “pattern identification or classification,” “regression signal processing” (’455, cls. 12, 18).

this one. PO’s argument that collateral estoppel does not apply to Challenged Claims due to additional limitations (DD Br. 10) is incorrect. “[C]ollateral estoppel requires that the *issues of patentability* be identical,” not the 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 first four limitations of a claim). Indeed, PO identifies only three distinct limitations across four limitations ([1.m], [8.m], [15.m], [15.o]) as new (DD Br. 10), and does not dispute that the other ’455 claim limitations are either identical or substantially similar to the claims already found unpatentable by the Board.¹⁰ Nor does PO dispute that these four allegedly “new” limitations are taught by **Lisogurski**, which was before the Examiner during prosecution—further supporting material error favoring institution. *See* §II.B.

III. CONCLUSION

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

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

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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, 4663 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>.

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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:

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