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Paper 28
Date: May 14, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

IPR2025-01253
Patent 12,193,790 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER
Vacating Notice Granting Institution and
Denying Institution of *Inter Partes* Review

On May 6, 2026, I issued an Order initiating *sua sponte* Director Review of the Notice granting institution of an *inter partes* review ("IPR") in the above-referenced proceeding. Paper 27. In the Order, I determined that Director Review was appropriate to address whether U.S. Patent No. 12,193,790 (the "'790 patent") is eligible for IPR in view of the Notice instituting a post-grant review ("PGR") against the '790 patent in PGR2026-00003. *Id.* at 2. As I noted in the Order, the petitioners here (collectively, "Samsung") filed this IPR and a parallel PGR petition that each challenged claim 7 of the '790 patent. *Id.* (citing Paper 1; PGR2025-00064, Paper 1). In filing the parallel petitions, Samsung: (1) did "not contest" Omni MedSci, Inc.'s ("Patent Owner") representation in co-pending litigation that the '790 patent is not an America Invents Act ("AIA") patent, and (2) requested institution of this IPR and to moot its PGR. Paper 6, 4. Given Samsung's ranking, which Patent Owner did not contest, I previously instituted this IPR and denied Samsung's PGR.

On May 6, 2026, I also issued a Decision granting institution of post-grant review in PGR2026-00003—a PGR filed by another party challenging claim 7 of the '790 patent. PGR2026-00003, Paper 14 ("PGR Decision"). In that decision, I explained that, contrary to Patent Owner's arguments, I did not determine in this IPR that the '790 patent is a pre-AIA patent ineligible for PGR, because the parties in this IPR did not place the eligibility issue into dispute. *Id.* at 2–3. I further determined that the petitioner in PGR2026-00003 "persuasively shows, on the current record, that the '790 patent is an AIA patent" and, therefore, is PGR eligible and not IPR eligible. *Id.* at 3–4.

Given my determination in PGR2026-00003 as to the '790 patent's PGR eligibility, and because a patent cannot be both PGR eligible and IPR eligible at the same time, it is appropriate to vacate institution of this IPR. *See, e.g.*, *Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-01188, Paper 12 at 10–12 (PTAB Jan. 13, 2021); Paper 6, 3 n.2 (Samsung acknowledging that the '790 patent is not eligible for simultaneous IPR and PGR).

Accordingly, it is:

ORDERED that the Notice granting institution of *inter partes* review (Paper 19) is vacated; and

FURTHER ORDERED that the Petition is denied, and no trial is instituted.

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