

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHOOP, INC.,
Petitioner

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case No. IPR2025-01583

U.S. Patent No. 9,651,533

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

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PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 9,651,533
1002	File History, U.S. Patent No. 9,651,533
1003	Declaration of Patrick Mercier, PhD
1004	RESERVED
1005	U.S. Patent No. 10,517,484
1006	Docket Sheet, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.)
1007	Docket Sheet, <i>Omni MedSci, Inc. v. Samsung Elecs., et al.</i> , No. 2:24-cv-01070 (E.D. Tex.)
1008	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 39 (P.T.A.B. Oct. 14, 2020) (Final Written Decision, '533 IPR)
1009	<i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 21-1229, 2022 WL 2062168 (Fed. Cir. Jun. 8, 2022) (summary affirmance, '533 IPR)
1010	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Patent Owner's Notice of Appeal (P.T.A.B. Apr. 11, 2025)
1011	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 22 (P.T.A.B. Aug. 3, 2022) (First Final Written Decision, '484 IPR)
1012	<i>Apple Inc. v. Omni MedSci, Inc.</i> , No. 23-1034, 2024 WL 3084509 (Fed. Cir. Jun. 21, 2024) (First Federal Circuit Decision, '484 IPR)
1013	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 26 (P.T.A.B. Feb. 14, 2025) (Second Final Written Decision, '484 IPR)
1014	Docket Sheet, <i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 25-1646 (Fed. Cir.) (Docket Sheet, Second Federal Circuit Appeal, '484 IPR)
1015	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 1 (P.T.A.B. Apr. 10, 2019) (Petition, '533 IPR)
1016	RESERVED
1017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 16, (P.T.A.B. Oct. 18, 2019) (Institution Decision, '533 IPR)
1018	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 23 (P.T.A.B. Jan. 31, 2020) (Patent Owner Response)

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Exhibit No.	Description
1019	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 27 (P.T.A.B. Apr. 30, 2020) (Petitioner Reply, '533 IPR)
1020	RESERVED
1021	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 1, (P.T.A.B. Jan. 22, 2021) (Petition, '484 IPR)
1022	RESERVED
1023	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 7 (P.T.A.B. Aug. 6, 2021) (Institution Decision, '484 IPR)
1024	RESERVED
1025	RESERVED
1026	RESERVED
1027	U.S. Patent No. 9,241,676 (Lisogurski)
1028	U.S. Patent App. Pub. No. 2005/0049468 ("Carlson")
1029	RESERVED
1030	RESERVED
1031	RESERVED
1032	U.S. Patent Appl. Pub. No. 2012/0197093 ("Valencell-093")
1033	"The Biomedical Engineering Handbook," by Joseph D. Bronzino (1995)
1034	Patel, et al., A review of wearable sensors and systems with application rehabilitation, <i>Journal of Neuroengineering & Rehabilitation</i> (2012)
1035	A. Omre, Bluetooth Low Energy: Wireless Connectivity for Medical Monitoring, <i>Journal of Diabetes Science & Technology</i> (Mar. 2010)
1036	P. Baum, et al., Strategic Intelligence Monitor on Personal Health Systems, Phase 2: Market Developments - Remote Patient Monitoring and Treatment, Telecare, Fitness/Wellness and mHealth, JRC <i>Scientific and Policy Reports of European Commission</i> (2013)
1037	M. Kranz, et al., The mobile fitness coach: Towards individualized skill assessment using personalized mobile devices, <i>Pervasive and Mobile Computing</i> (June 2012)
1038	M. Swan, Senior Mania! The Internet of Things, Wearable Computing, Objective Metrics, and the Quantified Self 2.0, <i>Journal of Sensor and Actuator Networks</i> (2012)

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1039	RESERVED
1040	“The Usage of Tablets in the HealthCare Industry,” by Rauf Adil, available through the Internet Archive at https://web.archive.org/web/20121014002306/https://www.healthcareitnews.com/blog/usage-tablets-healthcare-industry (last accessed Sept. 4, 2025)
1041	RESERVED
1042	Curriculum Vitae of Patrick Mercier, PhD
1043	Docket Sheet, <i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 4:19-cv-05924 (N.D. Cal.)
1044	U.S. Patent No. 6,144,867 (“Walker”)
1045	Webster, J. G. (1997) <i>Design of Pulse Oximeters</i> , IOP Publishing.
1046	U.S. Patent No. 7,029,628 (“Tam”)
1047	U.S. Pat. Pub. No. 2013/0327966 (“Fidler”)
1048	U.S. Patent Pub. No. 2011/0267688 (“Kleppe”)
1049	U.S. Patent Pub. No. 2005/0133691 (“Doppke”)
1050	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01250, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (533 IPR Petition)
1051	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01251, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (304 IPR Petition)
1052	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01252, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (455 IPR Petition)
1053	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01253, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (790 IPR Petition)
1054	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , PGR2025-00064, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (790 PGR Petition)
1055	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01254, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (475 IPR Petition)
1056	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-00063, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (475 PGR Petition)
1057	U.S. Patent No. 10,874,304
1058	U.S. Patent No. 11,160,455

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Exhibit No.	Description
1059	U.S. Patent No. 12,193,790
1060	U.S. Patent No. 12,268,475
1061	RESERVED
1062	Order Denying WHOOP's Mot. to Stay Without Prejudice, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 61) (Dec. 23, 2025)
1063	Scheduling Order, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 43) (Nov. 10, 2025)
1064	Stipulation re Invalidity for the '533 Patent, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 62) (Jan. 5, 2026)
1065	RESERVED
1066	RESERVED
1067	Order Granting-in-Part WHOOP's Mot. to Dismiss, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 33) (Sept. 24, 2025)
1068	RESERVED
1069	RESERVED

I. INTRODUCTION

The Director should deny Omni's request to exercise his discretion to deny institution of WHOOP's Petition challenging claims 6, 11–12, 14, and 18 of the '533 Patent (collectively, the "Challenged Claims"). *Fintiv* and *General Plastic* both support institution.

If instituted, the Board's Final Written Decision ("FWD") in this IPR is projected to issue one month before trial in the pending district court litigation against WHOOP. Board review would be more efficient than litigating invalidity in the district court. Collateral estoppel precludes Omni from contesting the unpatentability of at least one of the five claims challenged WHOOP's Petition before the PTO, but does not bind Omni in the district court. The Board is also already familiar with the '533 Patent, including with the independent claims from which the Challenged Claims depend, because the it found claims 5, 7–10, 13, and 15–17 unpatentable in a prior IPR.¹ Additionally, WHOOP's *Sotera* stipulation

¹ Apple Inc. previously successfully challenged the '533 Patent and a related patent, the '484 Patent (collectively, the "Apple IPRs"). All claims held unpatentable in the '533 Patent have been affirmed on appeal. EX1008 (the "'533 Apple IPR"); EX1009. All but one limitation held unpatentable in the '484 Patent has been affirmed. EX1013 (the "'484 Apple IPR"); EX1014.

eliminates any potential overlap between this IPR and the district court proceedings.

This is WHOOP's first petition challenging the '533 Patent, and it presents a prior art ground not included in the Samsung petition.² WHOOP filed its Petition well before any substantive briefing by Omni in the Samsung IPR, alleviating any roadmapping concerns.

Finally, Omni cannot claim settled expectations in the '533 Patent, since no claim has thus far survived a patentability challenge.

Accordingly, for the reasons discussed below, WHOOP respectfully requests that the Director deny Omni's request for discretionary denial.

II. ARGUMENT

A. Each *Fintiv* Factor Favors Institution or Is Neutral

The *Fintiv* factors support institution. Most importantly, independent claims 5 and 13, from which the Challenged Claims depend, were already found unpatentable in the '533 Apple IPR. EX1008. Collateral estoppel further prevents Omni from challenging the unpatentability of at least one Challenged Claim (claim

² Samsung Electronics Co., Ltd., among other entities, filed a petition challenging certain claims of the '533 Patent about seven weeks before WHOOP filed this Petition. IPR2025-01251, Paper 1 (Aug. 5, 2025) ("Samsung petition").

12) because it is not patentably distinct from the limitations found unpatentable in the '533 Apple IPR.

The Board is also best situated to review WHOOP's patentability challenge because it is already familiar with the '533 Patent, its unpatentable independent claims, and the core prior art references (Lisogurski and Carlson) cited in WHOOP's Petition. Moreover, the FWD in this IPR would be due before trial in the district court litigation, which is still in the earliest stages. WHOOP's *Sotera* stipulation ensures any grounds that could have been raised in this Petition will be litigated only in this forum. The other factors (the likelihood of a stay and the identities of the parties) are neutral. The *Fintiv* factors therefore favor institution.

1. The likelihood of a stay is neutral

WHOOP moved for a stay of the district court litigation promptly after filing its Petitions. The district court denied WHOOP's motion as premature and without prejudice on December 23, 2025. EX1062.

Where the district court indicates "that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted," this factor "usually weigh[s] against" discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6–7 (noting that investment in the district court litigation is also relevant to the weight of this factor where no stay has yet been ordered). The district court here stated in its Order that it was "postpon[ing] ruling on [the stay] motion . . . pending

the [institution] decisions by the PTO.” EX1062 at 1. The district court’s Order further acknowledged the “general rule” that “stays may be granted . . . once PTO review of some or all of the asserted claims is granted,” and expressly permitted WHOOP to “renew its request . . . after the PTO issues its institution decision” for the pending petitions. *Id.* at 4, 6. As discussed for Factors 2 and 3, *infra*, the district court case against WHOOP is still in its early stages, with the vast majority of resource-intensive work still ahead.

This factor is therefore neutral, or weighs slightly in favor of institution.

2. The trial date favors institution

Trial in the district court is scheduled to begin on May 10, 2027. EX1063 at 8. If instituted, a FWD for this Petition is projected for April 6, 2027—a month before the trial date. Omni argues that the parties will complete discovery and case dispositive motions by the FWD (Paper 6 at 10, “DD Br.”), ignoring that institution is likely to stay the district court litigation, as discussed in Factor 1, *supra*. Even if the litigation is not stayed, this IPR stands to eliminate the need to try the ’533 Patent in the district court entirely, saving considerable resources for the parties and the court.

This factor weighs in favor of institution, particularly in view of the early stage of the district court litigation discussed in Factor 3, *infra*.

3. Minimal investment in the litigation favors institution

At the projected institution decision for this Petition (April 6, 2026), the litigation will be in the earliest stages. Opening claim construction briefs are not due until the following week, on April 13, 2026. EX1063 at 6. Completion of fact discovery will be months away, and opening expert reports not due until October 2026. *Id.* at 3–4.

Omni's argument that early case disclosures, such as infringement and invalidity contentions, amount to “substantial time and resources” would weigh against nearly every petition. *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9–11 (PTAB Apr. 13, 2022) (with contentions served and claim construction briefing complete, *Fintiv* factor 3 weighed against denial). The absence of substantive orders related to the '533 Patent in the district court (except WHOOP's motion to dismiss, granted in part) further weighs against denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (PTAB Mar. 20, 2020).

Omni erroneously claims, without evidence, that WHOOP “delayed” filing its petition to “gain another bite at the apple” should Omni prove “infringement and validity” in the district court. DD Br. 12. WHOOP's *Sotera* stipulation ensures no overlap in the invalidity grounds between this IPR and the district court.

Because the litigation is still in its early stages, this factor favors institution.

4. Lack of overlap favors institution

This Petition challenges claims 6, 11–12, 14, and 18 of the '533 Patent, whereas Omni currently asserts only claims 11 and 12 in the district court. The validity of most claims is therefore not presently within the scope of the district court litigation.

Additionally, WHOOP has filed a *Sotera* stipulation, agreeing “not to pursue” in the district court any “ground that was raised or could have been reasonably raised in an IPR.” EX1064. WHOOP’s stipulation fully disclaims the grounds upon which WHOOP is permitted to bring an IPR (including the grounds actually brought), so there will be no overlap between an instituted IPR and the district court litigation. 35 U.S.C. §§ 311, 315(e); *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–67 (Fed. Cir. 2025). WHOOP’s *Sotera* stipulation mitigates the “concerns of inefficiency and the possibility of conflicting decisions.” *Fintiv* at 12.

Omni’s argument that potential subject matter ineligibility, enablement, and written description arguments weigh against institution is misplaced. DD Br. 13. Arguments under Sections 101 and 112 are outside of the Board’s jurisdiction in IPR proceedings. 35 U.S.C. § 311(b). Such arguments present no risk of duplicated efforts or inconsistent rulings.

Accordingly, this factor weighs in favor of institution.

5. The identity of the parties is neutral

WHOOOP is the defendant in the district court litigation. This factor is therefore neutral, as institution is routinely granted where the same entities are parties to the IPR and the litigation. *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (PTAB Jan. 14, 2021); *Savant Techs. LLC v. Feit Elec. Co.*, IPR2025-00260, Paper 16 at 2–3 (PTAB June 12, 2025).

6. The merits weigh strongly in favor of institution

To date, nine claims from the '533 Patent have been found unpatentable by the Board. EX1008, *aff'd*, EX1009. The claims challenged in WHOOOP's Petition depend from claims previously found unpatentable in the '533 Apple IPR. EX1001. The additional limitations in these dependent claims are not patentably significant. Indeed, at least claim 12 consists of limitations that are materially similar to those previously found unpatentable. Collateral estoppel therefore precludes Omni from challenging the patentability of claim 12 before the Board. *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 at 17–24 (PTAB May 17, 2025) (granting institution in part because petitioner preliminarily showed that “patent owner is collaterally estopped” as to the challenged claims).

Collateral estoppel applies to IPR proceedings where “(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the

identical issue; and (4) the prior action featured full representation of the estopped party.” *Netlist*, Paper 17 at 18–19. Estoppel applies even “if the patent claims use slightly different language to describe substantially the same invention.” *Google LLC v. Hammond Dev. Int’l*, 54 F.4th 1377, 1381–82 (2022); *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (estoppel not limited “to patent claims that are identical”).

Omni does not (and could not) contest that elements 2–4 are met here. DD Br. 13–15. Instead, Omni argues that the Board’s findings in the ’533 Apple IPR did not encompass the limitations recited in claim 12. DD Br. 14–16. Omni misreads the Board’s FWD in the ’533 Apple IPR.

Claim 12 recites, “[t]he system of claim 5,” which was invalidated in the ’533 Apple IPR, “wherein the output optical beam comprises a **plurality of optical wavelengths**, and the *output signal is generated in part by comparing signals at different optical wavelengths*.” EX1001 (emphases added). Omni erroneously claims that the Board’s FWD in the ’533 Apple IPR was limited to a finding that Lisogurski teaches a system capable of emitting light at “one optical wavelength.” DD Br. 15. To the contrary, the Board found that Lisogurski teaches “a light sensor [that] emits **one or more wavelengths** [of light]” including “**red and infrared (IR) wavelengths** of light.” EX1008 at 13 (internal quotations omitted) (emphasis added); *see also, id.* at 14 (finding that Lisogurski’s “[s]ensor 312 includes one or

more light sources 316 for emitting light at one or more wavelengths”), 25–26 (similar). In other words, the Board expressly found that Lisogurski teaches a sensor that can emit at least two wavelengths of light (red and infrared). Omni also mistakenly argues that the Board’s prior FWD “did not address the comparison” recited in claim 12. DD Br. 15. In fact, the Board previously found that Lisogurski “teaches separately *detecting red light (first signal) and IR light (second signal)* . . . and further *teaches comparing the intensities of two wavelengths* . . . to estimate the blood oxygen saturation” in arterial blood. EX1008 at 46 (internal quotations omitted) (emphasis added). The Board concluded that Lisogurski teaches “determin[ing] blood oxygen saturation using two wavelengths of light and a ratio-of-ratios calculation.” *Id.* In sum, claim 12 consists of limitations that are materially similar to those found unpatentable in the ’533 Apple IPR, and Omni is therefore collaterally estopped from relitigating the patentability of claim 12 before the Board.

The Board is best situated to assess the patentability of the Challenged Claims. Although it is precluded from relitigating patentability before the Board, prior FWDs do not bind Omni in the district court. *Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1379–80 (Fed. Cir. 2025) (no collateral estoppel because “IPR proceeding requires a lower burden of proof” than district court). Board review of the Challenged Claims would therefore be significantly more efficient, particularly since the Board is already familiar with the independent claims of the ’533 Patent

and the core prior art references (Lisogurski and Carlson) cited in WHOOP's Petition.

Recent decisions recognize that estoppel can “tip[] the balance against discretionary denial,” because it is “an appropriate use of Office resources to . . . ensure that a [patent owner] does not take action inconsistent with the judgment in a prior Office proceeding.” *POSCO v. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (Director June 25, 2025); *Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 at 2–3 (Director Aug. 6, 2025) (similar). So too here. Review of the Challenged Claims would promote consistency and avoid unnecessary litigation.

B. *General Plastic* Does Not Support Discretionary Denial

Discretionary denial under *General Plastic* is not justified here. Where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one **necessarily** outweighs the other *General Plastic* factors.” *Videndum Prod. Solutions, Inc. v. Rotolight Ltd.*, IPR2023-01218, Paper 12 at 5–6 (Director Apr. 19, 2024) (emphasis added). WHOOP has not filed any prior petitions for the '533 Patent, and Omni does not allege that WHOOP has a “significant relationship” under *Valve* with the petitioners of the Samsung petition or the prior Apple IPR (nor can it). Dd Br. at 5 ; *see Valve Corp. v. Elec. Scripting Products, Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential).

To the extent the remaining *General Plastic* factors are considered, each is either neutral or weighs against discretionary denial.

1. Factor 1, petitioner identity, outweighs the rest

“Under USPTO policy and precedent, *General Plastic* has not been extended to any cases in which the first and second petitioners do not have a significant relationship” under *Valve*. *Videndum*, Paper 12 at 6; *Micron Tech., Inc. v. Sonrai Memory Ltd.*, IPR2023-00909, Paper 7 at 8–9 (PTAB Nov. 28, 2023) (“factors 1–5 weigh against denying institution” where the petitioner has not previously filed a petition and the Patent Owner “does not assert extenuating circumstances,” such as a special relationship); *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00463, Paper 20 at 8 (PTAB Aug. 20, 2024) (citing *Videndum* and holding “we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a significant relationship”). This principle holds true even where the prior petitions asserted “some of the same art at issue” in the current proceedings. *Prime Time Toys LLC et al. vs. Spin Master, Inc.*, IPR2023-01339, Paper 12 at 18–21 (Director July 9, 2024); see *American Honda Motor Co., Inc. v. Neo Wireless LLC*, IPR2023-00797, Papers 16 and 27 (Director finding no significant relationship despite roadmapping allegation).

A “significant relationship” under *Valve* must connect the petitioners “with respect to [the] assertion” of the challenged patent. *Valve*, Paper 11 at 10. Absent a

contractual relationship or informal cooperation in the implementation of the allegedly infringing technology, different entities with unrelated accused products do not have a significant relationship that “justifies the application of a *General Plastic* analysis.” *Prime Time Toys*, Paper 12 at 19–20; *American Honda*, Paper 27 at 2–3, (Mar. 22, 2024) (similar). WHOOP does not have a “significant relationship” with the Samsung petitioners or the Apple IPR petitioners, and Omni does not assert one exists. DD Br. 5–6.

Moreover, Omni provides no authority to support its argument that the prior ’533 Apple IPR supports discretionary denial under *General Plastic*. DD Br. 5–7. The ’533 Apple IPR successfully challenged nine claims, including independent claims 5 and 13, from which the Challenged Claims depend. EX1008, *aff’d*, EX1009. Omni faults WHOOP for relying on the Board’s FWD holding those independent claims unpatentable. DD Br. 5–6. But Omni does not cite any decision in which a Board’s prior holding of *unpatentability* of related claims weighed in favor of discretionary denial. *See id.* To the contrary, relying on the Board’s “prior determinations with respect to previously cancelled independent claims,” including by use of the “same prior art,” has been found to “efficiently streamline[]” the unpatentability analysis for the Board and weigh in favor of institution. *Bayerische Motoren Werke Aktiengesellschaft et al. v. Paice LLC et al.*, IPR2020-00994, Paper 19 at 19 (PTAB Nov. 19, 2020) (“BMW”).

The authority Omni does cite is distinguishable or relies on logic rejected by the more recent decisions WHOOP cites above. *Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, the only recent case, did not expressly apply the *General Plastic* framework, although the Acting Director determined that “concerns of roadmapping” weighed in favor of discretionary denial (among other factors). IPR2025-00884, Paper 9 at 2 (Director Sept. 3, 2025) (“AWS”). In *AWS*, however, the petitioner admitted its petition addressed “the precise deficiency identified” in two previous merits-based institution denials. *Id.* No such roadmapping exists here because WHOOP’s petition was filed well before any substantive briefing by Omni or decisions by the Board in the Samsung IPR. *See, infra*, Section II.B.3 (explaining strategic staggering of petitions is the core of *General Plastic* roadmapping concerns).

The other cases Omni cites similarly addressed concerns about staggering petitions in a prejudicial manner. *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*. IPR2017-01305, Paper 11 at 8, 12 (PTAB Oct. 17, 2017) (petition filed seven months after two merits-based institution denials); *see also NetApp, Inc. v. Realtime Data*, IPR2017-0196, Paper 10 at 11 (PTAB Oct. 13, 2017) (petition filed “well after” patent owner response). The reasoning Omni cites in *Ericsson* was rejected in the later *Prime Time Toys* decision. *Compare Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 12 (finding Factor 1 weighed against institution without

a significant relationship between the petitioners), *with Prime Time Toys*, Paper 12 at 18–20 (finding discretionary denial not justified absent significant relationship). *Ericsson* is further distinguishable because the petitioner there studied “the prior petitions . . . to determine grounds” to advance in its own petition. *Ericsson*, Paper 8 at 11. As discussed for Factor 3, *infra*, most of the overlap between Samsung and WHOOP’s petitions is due to common arguments about the collateral estoppel effects of the Apple IPRs. DD Br. 3. Lisogurski and Carlson, two of the references that overlap between WHOOP and Samsung’s petitions, were relied on by the Board to invalidate the independent claims of the ’533 Patent in the Apple IPR. *Id.* Indeed, Omni’s allegation of “roadmapping” ignores that WHOOP’s Petition advances an additional ground not included in Samsung’s Petition. DD Br. 3.

In sum, as this is WHOOP’s first petition for the ’533 Patent and no significant relationship exists with the prior petitioners, denial under *General Plastic* “is not justified.” *Videndum*, Paper 12 at 6–7.

2. Factors 2 through 5 do not support denial

Where the petitioner has not previously filed a petition and no extenuating circumstances, such as a significant relationship, exist, “factors 1–5 weigh against denying institution.” *Micron Technology*, IPR2023-00909, Paper 7 at 8–9; *Cellco P’ship v. Gen. Access Sols., Ltd.*, IPR2023-00978, Paper 20 at 19 (PTAB Dec. 14,

2023) (“factors 2–5 bear little relevance,” absent extenuating circumstances, where “Petitioner had not previously filed a petition against the same patent”).

Factor 2: Knowledge of the prior art. As Omni’s own authority confirms, “whether [WHOOOP] knew about the asserted references at the time the prior petitions were filed has little, if any, probative value,” because WHOOP was not a petitioner in any previous IPR of the ’533 Patent. *Elm 3DS Innovations*, Paper 11 at 19–20. Omni does not explain how this factor supports denial, particularly since WHOOP filed its Petition only seven weeks after Samsung. *See* DD Br. 5–7. Likewise, WHOOP’s reliance on the prior art that “formed the basis for cancellation of [the] independent claims” in the ’533 Apple IPR does not favor discretionary denial under Factor 2. *BMW*, Paper 19 at 16–17.

Factor 3: Substantive proceedings in the prior IPR. The roadmapping concerns underlying *General Plastic* and its progeny refer to “Petitioner’s potential benefit from receiving and having the opportunity to study” patent owner responses and merit-based denials by the Board to strategically file multiple petitions “until a ground [that results in review] is found.” *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential in relevant part). These concerns do not exist here. WHOOP filed its Petition well before any substantive response by Omni or decision by the Board in the Samsung IPR. Additionally, and contrary to Omni’s claims, WHOOP’s petition

does not simply “repackage[]” the Samsung petition. DD Br. 7. WHOOP advances an additional ground and prior art reference (Walker) not covered by Samsung’s petition. DD Br. 3, 7. Most of the overlap between WHOOP’s and Samsung’s petitions stems from common arguments about the collateral estoppel effects of the Apple IPRs, which necessarily requires the two petitions to rely on the same references asserted by Apple for estoppel to apply.

As discussed for Factor 1, *supra*, Omni argues that WHOOP’s reliance on the Board’s FWD in the ’533 Apple IPR is evidence of roadmapping favoring discretionary denial. DD Br. 5–6. But Omni cites no authority to support its claim that relying on the Board’s prior decision *holding unpatentable* related claims in order to invoke collateral estoppel is a form of prejudicial roadmapping. *Id.* To the contrary, evidence of previous unpatentability determinations of related claims weighs in favor of institution. *BMW*, IPR2020-00994, Paper 19 at 19; *see also, supra*, Section II.A.6.

Factors 4 and 5: Timing of the second petition. Factors 4 and 5 consider the timing of the second petition to assess “whether a petitioner should have or could have raised [its] challenges earlier.” *General Plastic*, Paper 19 at 18. Omni suggests that WHOOP unreasonably delayed filing its petition, but contrary to Omni’s assertions, there is no evidence that WHOOP delayed requesting IPR for seven months. DD Br. 7. Indeed, Omni’s cited authority confirms that Factors 4 and 5

have little probative value, and actually weigh against discretionary denial, where the second petitioner was not involved in the prior petition and where the timing of the second petition is a function of the patent owner's litigation activity. *Elm 3DS Innovations*, Paper 11 at 22–23. WHOOP worked diligently to file its Petition after Omni first accused it of infringing the '533 Patent in February 2025. EX1006. That Samsung filed its petition slightly before WHOOP is not surprising, since Omni accused Samsung of infringing the '533 Patent about one and a half months before WHOOP. EX1007. Additionally, Omni's claim that a suit by a different entity asserting a different, unrelated patent (the '868 Patent) "put Petitioner on notice" of its entire "patent portfolio" is unsupported by evidence or authority and was rejected in the parallel district court litigation. EX1067 (Judge Bryson holding "that the '868 patent (not a member of the '533 patent family) had previously been asserted against Whoop does not plausibly suggest that Whoop was aware of the '533 patent family.").

Nor does the time elapsed between WHOOP's Petition and the FWD in the '533 Apple IPR favor discretionary denial. Although the FWD in the '533 Apple IPR issued in October 2020, Omni did not accuse WHOOP of infringing the '533 Patent until February 2025. EX1006. Any purported "delay" between the '533 Apple IPR and WHOOP's Petition is therefore due to the '533 patent owner's own

piecemeal litigation. *BMW*, IPR2020-00994, Paper 19 at 20 (Factor 5 weighs in favor of institution where delay between petitions is due to litigation timing).

Factors 6 and 7: Board considerations. The Board's resources would be most efficiently utilized through coordination of the WHOOP and Samsung IPRs. Since WHOOP's Petition was filed only seven weeks after Samsung's, the Board may set a common briefing and argument schedule without violating the statutory requirement to issue a final determination within one year of institution. 35 U.S.C. § 316(a)(11). Although WHOOP and Samsung's petitions are not identical and include a non-overlapping prior art reference, the prior Apple IPRs form the core of both. DD Br. 7. Institution of both petitions would not be overly burdensome, as the '533 Apple IPR obviates the need for a merits review of at least one Challenged Claim, as discussed in Section II.A.6, *supra*.

Factors 8 and 9: Prejudice to the Petitioner. Omni cites *Samsung Elecs. Co., Ltd. v. Iron Oak Techs. LLC*, as identifying additional factors in cases where the second petition is filed by a different petitioner. DD Br. 4–5. Applying *Iron Oak*, both factors weigh against denial. IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019).

WHOOP would face undue prejudice if institution is denied and the Samsung IPR is terminated prior to a FWD. Omni argues incorrectly that WHOOP can raise the same challenges in district court. DD Br. 8. Due to the different standards of

proof, the Board's prior unpatentability decisions cannot support collateral estoppel in the district court. *Kroy IP Holdings*, 127 F.4th at 1380. WHOOP's argument that the '533 Apple IPR precludes Omni from litigating the validity of the challenged claims can only be applied by the Board.

The existence of multiple petitions challenging the '533 Patent is also the direct result of Omni's litigation activity. The Director should "decline to wield [the patent owner's] own litigation activities as a shield in [an] *inter partes* review." *Iron Oak Techs.*, Paper 9 at 31; *Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.*, IPR2017-01797, Paper 8 at 33 (PTAB Feb. 6, 2018) (arguments against serial petitions are less persuasive when resulting from patent owner's litigation activity).

Omni argues that the timing of WHOOP's petition "diminishes the weight" of its own litigation activity. DD Br. 8 (citing *Nichia Corp. v. Document Sec. Sys., Inc.*, IPR2019-00398, Paper 10 (PTAB Apr. 15, 2019)). Omni's reliance on *Nichia* is misplaced. That decision was based on concerns that petitioner had improperly benefitted from roadmapping, using the denial of institution in a previous IPR that *it filed* to improve its position in the subsequent petition. *Nichia*, Paper 10 at 5, 9, 17, 23–24. As discussed with respect to Factor 3, *supra*, no such concerns exist here.

Omni also faults WHOOP for not filing a "copycat" of the Samsung Petition and moving for joinder. DD Br. 8. Joinder is permitted only when the issues raised in the petitions are identical. *Facebook, Inc. v. Windy City Innovations, LLC*, 973

F.3d 1321, 1335–37 (Fed. Cir. 2020) (joined party cannot bring “new issues from its new proceeding into the existing proceeding”). As explained with respect to Factors 1 and 3, *supra*, WHOOP’s Petition includes an invalidity ground and a prior art reference not covered by Samsung’s Petition. WHOOP could not join Samsung’s Petition without foregoing this additional ground.

In sum, the concerns of inefficiency and prejudice to the patent owner addressed in *General Plastic* do not exist for WHOOP’s Petition. Accordingly, discretionary denial is not warranted.

C. Omni Has No Settled Expectations in the ’533 Patent

Omni cannot claim settled expectations in the ’533 Patent, when not a single claim has thus far withstood a patentability challenge. *POSCO*, IPR2025-00370, Paper 10 at 2–3 (a patent owner’s settled expectations are undermined where related claims are found unpatentable).

III. CONCLUSION

WHOOP respectfully requests the Director to deny discretionary denial.

Dated: January 5, 2026

Respectfully Submitted,

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