IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

OMNI MEDSCI, INC., *Plaintiff*, v. WHOOP, INC., *Defendant.*	C.A. No. 25-140-WCB

PLAINTIFF'S ANSWERING BRIEF IN OPPOSITION TO DEFENDANT'S MOTION TO STAY PENDING *INTER PARTES* AND POST GRANT REVIEW

Dated: November 5, 2025

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2	*Omni MedSci, Inc. v. Samsung*, No. 2:24-cv-1070-JRG-RSP, D.I. 86 (E.D. Tex. Aug. 29, 2025).
3	*RetailMeNot, Inc. v. Honey Sci., LLC*, No. 1:18-cv-937, D.I. 250 (D. Del. May 27, 2020).
4	*RetailMeNot, Inc. v. Honey Sci., LLC*, No. 1:18-cv-937, D.I. 238 (D. Del. Mar. 10, 2020).
5	*Princeton Digital Image Corp. v. Konami Dig. Entm't Inc.*, No. 1:12-cv-1461-LPS-CJB, D.I. 71 (D. Del. May 9, 2014).
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9	Interim Processes for PTAB Workload Management dated March 26, 2025, https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2025_q1_roundup_.pdf (last visited Nov. 5, 2025).
10	PTAB Trial Statistics FY25 Q1 Outcome Roundup IPR, PGR.
11	Cook, Adam, Johnson, Matthew, Sloan, Daniel, *Discretionary Denial Statistics*, https://www.jdsupra.com/legalnews/discretionary-denial-statistics-3371879/ (last visited Nov. 5, 2025).
12	*MSN Pharms., Inc. v. Breckenridge Pharm., Inc.*, IPR2025-01107, Paper 11 (P.T.A.B. Oct. 17, 2025).
13	*Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025).
14	Squires, John A., *An Open Letter From America's Innovation Agency*, https://www.uspto.gov/sites/default/files/documents/open-letter-and-memo_20251017.pdf (dated October 17, 2025, last visited Nov. 5, 2025).
15	Notice of Decisions on Institution, IPR2025-01014 et al., Paper 4 (P.T.A.B. Oct. 31, 2025).

I. Introduction and Summary of Argument

Plaintiff Omni MedSci, Inc. ("Plaintiff") submits this brief answering Defendant Whoop Inc.'s ("Defendant" or "Whoop") Motion to Stay Pending *Inter Partes* and Post Grant Review (D.I. 36) and corresponding brief ("Motion" or "Mot.," D.I. 37).

Rather than engage with the well-established factors governing whether a stay is appropriate pending a final written decision from the Patent Trial and Appeal Board ("PTAB") in post-grant proceedings, Whoop asks this Court to entertain the merits of its petitions and stay this case based on the speculative nature of their success. That is not the test. Instead, the stay inquiry focuses on factors stemming from those Congress expressed should control when determining if a stay should be granted. On each factor, Whoop's Motion fails.

Whoop's Motion also seeks a stay based, in part, on a petition that does not yet exist. Courts do not stay cases based on hypothetical filings that may or may not materialize, on grounds that may or may not be presented, and within a months-long window, only capped by a statutory bar. For at least these reasons, Whoop's Motion should be denied, or at least, denied without prejudice to refiling after any actual institution decisions.

II. Statement of Facts and Stage of the Proceedings

A. This Litigation

Omni filed its initial Complaint ("Original Complaint," D.I. 1), which asserted infringement of U.S. Patent Nos. 9,055,868 ("'868 Patent"), 9,651,533 ("'533 Patent"), U.S. Patent No. 10,517,484 ("'484 Patent"), 10,874,304 ("'304 Patent"), 11,160,455 ("'455 Patent"), 12,193,790 ("'790 Patent"). Whoop did not file a motion to dismiss the Original Complaint. Plaintiff subsequently filed the First Amended Complaint ("FAC," D.I. 11), which now asserts infringement of the '868 Patent, '533 Patent, '304 Patent, '455 Patent, '790 Patent and also U.S.

Patent No. 12,268,475 ("'475 Patent" and collectively, "Asserted Patents").[1] Whoop filed a motion to dismiss (D.I. 15) seeking dismissal of the FAC's willful and induced infringement claims against the '533 Family and certain contributory infringement claims, which this Court granted-in-part and denied-in-part on September 4, 2025 (D.I. 30, 33). The FAC (D.I. 11) remains the operative complaint, subject to this Court's rulings, and Whoop answered the FAC on September 29, 2025 (D.I. 34).

During the Rule 16 Scheduling Conference held on October 24, 2025, this Court set this case for trial on May 10, 2027. *See* October 31, 2025 Minute Entry for proceedings held on October 24, 2025. The parties are in agreement that Omni will serve its infringement contentions on December 5, 2025 and Whoop will serve its invalidity contentions on January 21, 2026.

B. Post-Grant Proceedings

On September 26, 2025, Whoop filed petitions for *inter partes* review of claims 6, 11–12, 14, and 18 of the '533 Patent, and all claims for the '304 and '455 Patents. *See* D.I. 38-1 at 1, 76, 184. On October 13, 2025, Whoop also filed a petition for post-grant review of the '790 Patent. *See id.* at 289. Omni's deadlines to file briefing on whether the PTAB should discretionally deny these petitions are December 3 and 22, 2025, respectively. The PTAB is expected to issue a decision on the parties' discretional denial briefing on February 5, 2026 for the '533, '304, and '455 Patents, and February 23, 2026 for the '790 Patent. If not discretionally denied, the PTAB's institution deadline is April 5, 2026 for the '533, '304, and '455 Patents, and Aprill 2026 for the '790 Patent.

To date, Whoop has not filed any petition for a post-grant proceeding challenging the '475

[1] Count III of the FAC, which asserted infringement of U.S. Patent No. 10,517,484 ("'484 Patent"), was dismissed from this case. (*See* D.I. 20.) The Motion's arguments regarding the '484 Patent are thus moot and not addressed in this opposition brief.

Patent and has not offered a date certain when it intends to do so or identified any of the challenges to be raised by the supposed forthcoming petition. The only guidance Whoop offered was that filing such a petition may—or may not—occur sometime before its statutorily barred from doing so on February 7, 2026.

C. Status of Proceedings Before the PTAB

On March 26, 2025, the interim Director of the U.S. Patent and Trademark Office ("USPTO") (hereinafter, "Director") announced a bifurcated process for determining whether an IPR petition warrants institution. Under the bifurcated process, the Director will first determine whether discretionary denial of institution is appropriate, and, if the Director determines that discretionary denial is appropriate, the Director will issue a decision denying institution prior to a review of the merits of the petition. Only if the Director determines that discretionary denial is inappropriate, will the Director refer the petition to the standard three-member panel of the PTAB administrative patent judges ("APJs") to conduct a merits-based review of whether the IPR or PGR petitions warrant institution.

In evaluating whether discretionary denial is appropriate, the Director considers the PTAB's long-standing *Fintiv* factors[2] and several new factors including, for example, (1) the settled expectations of the parties, such as the length of time the claims have been in force; (2) the PTAB's workload; and (3) the strength of the unpatentability challenge.

[2] The *Fintiv* factors include (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) the proximity of the district court's trial date to the PTAB's projected statutory deadline for issuing a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the district court proceeding; (5) whether the petition and the defendant in the parallel proceeding are the same party; and (6) other circumstances that may impact the Board's exercise of discretion. Ex. 1 at 6.

III. Legal Standard

A court has the inherent power to control its own docket, including the power to stay proceedings before it. *See Clinton v. Jones*, 520 U.S. 681, 706 (1997). When considering a motion to stay, this Court should evaluate: (1) whether a stay will simplify the issues in question and trial of the case; (2) whether the stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party; and (3) whether discovery is complete and whether a trial date has been set.[3] *Murata Mach. USA v. Daifuku Co., Ltd.*, 830 F.3d 1357, 1361 (Fed. Cir. 2016); *see also Dental Monitoring v. Get-Grin Inc.*, No. 22-647-WCB, 2024 WL 1603403, at *2 (D. Del. Apr. 9, 2024); *see also id.* at *2, n.1.

IV. Argument

Consistent with this Court's practice, Whoop's Motion should be denied at least until after institution of any post-grant challenges. Whether or not petitions have been instituted provides substantial clarity on the scope of the case. *See TwinStrand Biosciences, Inc. v. Guardant Health, Inc.*, No. 21-1126-GBW-SRF, 2023 WL 2563179, at *3 (D. Del. Mar. 17, 2023) ("[S]tays are not ordinarily granted before the PTAB has instituted proceedings. . . ."); *Brit. Telecom. v. IAC/InterActiveCorp*, No. 18-366-WCB, 2019 WL 4740156, at *5 (D. Del. Sept. 27, 2019) ("[C]ourts almost invariably deny requests for stays pending IPR proceedings when the stay requests are filed before the IPR is instituted."). As Whoop concedes, the asserted claims are not presently subject to any post-grant challenges, and the effect of a stay is entirely speculative at this point. *See* Mot. at 1–2. As this Court has previously stated, "courts *almost invariably deny*

[3] When considering a motion to staying pending IPRs and PGRs, courts sometimes consider a fourth factor articulated by Congress for deciding whether to stay a case pending CBM proceedings: "whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court." *Brit. Telecom.*, 2019 WL 4740156 at *2. This "fourth" factor does not favor a stay as addressed with the other three factors.

requests for stays pending [post-grant] proceedings when the stay requests are filed before[institution], and a pre-institution request therefore would have been futile." *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB, 2019 WL 3943058, at *6 (D. Del. Aug. 21, 2019).

A. Granting a stay will not simplify the issues in this case.

The Motion rests entirely on predictions about what the PTAB might do months from now across a set of disparate proceedings. That is not enough. Until the PTAB institutes, there are no assurances that any challenged claim in this case will be taken up, much less held unpatentable. *See HIP, Inc. v. Hormel Foods Corp. Services, LLC*, No. 18-615-CFC, 2019 WL 7667104, at *1 (D. Del. May 16, 2019) ("Generally, the 'simplification' issue does not cut in favor of granting a stay prior to the time the PTAB decides whether to grant the petition. . . .") (quoting *Copy Protection LLC v. Netflix, Inc.*, No. 14-365-LPS, 2015 WL 3799363, at *1 (D. Del. June 17, 2015)).

There are currently no institution decisions for any Asserted Patent, and Whoop has not filed any petitions challenging the '475 Patent. Despite having notice of Omni's claims since February, Whoop's IPRs and PGR were recently filed and institution decisions are not expected until April 2026, and final written decisions—if any petitions are instituted—would not be expected until 2027. This Court should not forecast outcomes or predicate a stay on proceedings that are in their infancy. This Court, while sitting by designation in the Eastern District of Texas, has denied a similar request to stay proceedings when a defendant waited—like Whoop—to file petitions challenging the patents-in-suit. *See Freeny v. Apple Inc.*, No. 2:13-cv-00361-WCB, 2014 WL 3611948, at *2–3 (E.D. Tex. July 22, 2014). Other courts in this District have likewise denied motions to stay where the PTAB has not yet entered a decision on whether to institute a petition for post-grant proceedings or where a defendant had not challenged all patents-in-suit. *See e.g.*, *Pratt Retail Specialties, LLC v. ProAmpac LLC*, No. 1:24-cv-1073, Oral Order (D. Del. Aug. 14, 2025); *Earin AB v. Skullcandy Inc.*, No. 1:24-cv-275, Oral Order (D. Del. May 2, 2024) (denying

a motion to stay without prejudice to renewal after an institution decision is filed).

Whoop also oversells petitions filed by third parties and its estoppel arguments. Third-party post-grant proceedings may sometimes support a stay after institution, but there is no reason to stay a case—or consider the effects of estoppel—based on petitions filed by non-parties in a separate litigation that have also not been instituted. Notably, the district court presiding over those non-parties has already denied their pre-institution motion to stay. *See* Ex. 2. Even if third-party post-grant proceedings on the Asserted Patents had been instituted, Whoop has made no such promise to be bound by any of the petitions filed by third-parties.

Whoop's reliance on *RetailMeNot, Inc. v. Honey Sci., LLC* in support that a stay will simplify this case is misplaced and instead supports denying its Motion. As an initial matter, Whoop relies on a Report and Recommendation ("R&R") that was never entered as an order of the Court. *See, generally*, No. 1:18-cv-937, 2020 WL 373341 (D. Del. Jan. 23, 2020). Tellingly, Whoop omits that this R&R expired and the underlying motion to stay was denied as moot because—after this R&R was entered—the PTAB denied the patent challengers' petitions, despite the "unique" facts Whoop contends are present here. *See* Ex. 3; *see also* Ex. 4 (supporting exhibits omitted).

This case is also distinguishable from *Black Hills Media, LLC v. Pioneer Elecs. (USA) Inc.*, No. 1:-14-cv-00471-SJO, 2014 WL 4638170 (C.D. Cal. May 8, 2014). As the Court noted, the defendant/patent challenger had "already succeeded in obtaining review on all four of its petitions to be considered by the PTO." *Id.* at *6, n.4. Whoop has had no such success in this case. Instead, when the *Black Hills* case was similarly situated—*i.e.*, when no petitions filed by the defendant had been instituted—the court "continued further briefing and hearing on the Motion until the [PTO] made a decision on [defendant's] IPR Petitions." *Id.* at *3.

The remaining cases Whoop relies on to support a pre-institution stay also fail at being persuasive for this case. For example, not all petitions at issue in *Princeton Digital Image Corp. v. Konami Dig. Entm't Inc.*, No. 12-1461-LPS-CJB, 2014 WL 3819458 (D. Del. July 2, 2013) were instituted. *See* Ex. 5 (supporting exhibit omitted); *see also* Ex. 6 (supporting exhibit omitted).

Likewise, the defendant/patent challenger in *Miics & Partners Am. Inc. v. Toshiba Corp.*, No. 1:14-cv-803-RGA, might have secured a complete stay pre-institution, but it was not successful in maintaining that stay after failing to have all its petitions instituted. *See* Ex. 7; *see also* Ex. 8 (Order lifting the stay and putting a schedule in place).

Self-evident from Whoop's own case law, staying this case—at least pre-institution—will not lead to a simplification of the issues for this Court to decide and the Motion should be denied.

B. Omni will be prejudiced or disadvantaged if a stay is granted.

Omni will suffer undue prejudice and will be disadvantaged if this case were stayed. Courts assessing undue prejudice may consider: "(1) the timing of the request for review; (2) the timing of the request for a stay; (3) the status of the review proceedings; and (4) the relationship of the parties." *IOENGINE*, 2019 WL 3943058, at *5. The mere potential for delay is not enough to establish undue prejudice, but "staying a case pending PTO review risks prolonging the final resolution of the dispute and thereby may result in some inherent prejudice to the plaintiff." *Neste Oil Oyj v. Dynamic Fuels*, *LLC*, No. 12-1744-GMS, 2013 WL 3353984, at *2 (D. Del. July 2, 2013).

Whoop waited eight months to file post-grant proceedings on some—but not all—of the Asserted Patents. Though Whoop's Motion followed shortly after, courts express reluctance to grant a stay where the timing the request for PTO review suggests a dilatory intent on the movant's part. *See Neste Oil*, 2013 WL 3353984, at *2; *see also Belden Techs. Inc. v. Superior Essex Commc'ns LP*, No. 08-63-SLR, 2010 WL 3522327, at *2 (D. Del. Sept. 2, 2010) (finding that post-

grant proceedings and a motion to stay filed well after the onset of the litigation may lead to an inference that the moving party is seeking "an inappropriate tactical advantage").

The status of the post-grant proceedings has been discussed at length above, but it is worth noting again that none of Whoop's petitions have been instituted yet and an institution decision is months away. This Motion, filed more than six months before the PTAB's institution decision, is premature and suggests dilatory intent just as this case is set to get underway.

Courts have recognized that "delay inherently harms a non-moving party by prolonging resolution of the dispute, even if the party is not a direct competitor." *Cao Lighting, Inc. v. Gen. Elec. Co.*, No. 20-681-GBW, 2022 WL 17752270, at *3 (D. Del. Dec. 19, 2022) (citing *Rideshare Displays, Inc. v. Lyft, Inc.*, N. 20-1629-RGA-JLH, 2021 WL 7286931, at *2 (D. Del. Dec. 17, 2021)). Though Omni is not a direct competitor with Whoop, both companies exist within the same industry and Omni is actively protecting and seeking to monetize the Asserted Patents. A stay of this case would directly prejudice Omni by harming its existing business prospects and prolonging resolution of the parties' disputes and every unnecessary delay diminishes the value of Omni's Assert Patents.

C. Whoop's assurance that the post-grant proceedings will be instituted is misplaced.

Whoop represents to the Court that institution of its post-grant petitions is "highly likely" (Mot. at 10) and asks this Court to affirm the likelihood of institution based on Whoop's merit-based arguments that the petitions are likely to invalidate the challenged Asserted Patents. *See, e.g.*, *id.* at 3–7. This Court's role with respect to Whoop's Motion is not to consider the merits of Whoop's petitions (which Omni highly contests and disagrees with the merits of); instead, this Court is asked to determine whether the petitions "will simplify the issues and trial of the case." *SITO Mobile R&D IP, LLC v. World Wrestling Entm't, Inc.*, C.A. No. 21-721-CFC, 2021 WL

7628181, at *1 (D. Del. Dec. 20, 2021). Given the recent shakeup at the USPTO with respect to post-grant proceedings, which is explained below, it is more likely that Whoop's petitions will not be instituted, thereby rendering a stay inappropriate.

On March 26, 2025, the Director announced a bifurcated process for determining whether a post-grant petition warrants institution. Under the bifurcated process, the Director will first determine whether discretionary denial of institution is appropriate, and, if the Director determines that discretionary denial is appropriate, the Director will issue a decision denying institution prior to a review of the merits of the petition. Only if the Director determines that discretionary denial is inappropriate, will the Director refer the petition to the standard three-member panel of the PTAB APJs to conduct a merits-based review of whether the petitions warrant institution.

In evaluating whether discretionary denial is appropriate, the Director considers the PTAB's long-standing *Fintiv* factors and several new factors including, for example, (1) the settled expectations of the parties, such as the length of time the claims have been in force; (2) the PTAB's workload; and (3) the strength of the unpatentability challenge. Ultimately, the objective of the bifurcated process is to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings." *See* Ex. 9.

The bifurcated process has significantly impacted the rate at which IPR petitions are instituted. For example, in fiscal year 2024 and prior to the bifurcated process, IPR petitions were instituted 68% of the time. Ex. 10 at 6. In contrast, under the bifurcated process, IPR petitions are discretionarily denied 61% of the time, meaning that only 39% of IPR petitions receive a merits-based review and less than 39% of IPR petitions are instituted. Ex. 11 (measuring the institution rate from the start of the bifurcated process in March, 26, 2025 to October 9, 2025).

Where the Director determined that discretionary denial was appropriate, the Director primarily relied on one or both of the following factors: *Fintiv* and "settled expectations." *Id.* In other words, the Director found that discretionary denial was warranted because: (1) the district court's trial date is scheduled to occur prior to the Board's final written decision and/or (2) the patent that was the subject of the petition was in force for a sufficient length of time (*e.g.*, more than six years), thereby creating settled expectations that the patent is valid. *See, e.g.*, Ex. 12 at 2 (denying institution because "it is unlikely that a final written decision . . . will issue before district court trials occur"); Ex. 13 at 2 (denying institution because "the challenged patent has been in force almost eight years, creating settled expectations"). These considerations are relevant here because: (1) the trial in this case and the trial in the EDTX case are scheduled to occur before the USPTO issues a final written decision, and (2) the PTAB's "settled expectations" analysis applies to several of the Asserted Patents.

On October 17, 2025, the Director issued an open letter (*see* Ex. 14) supported by a memorandum regarding revisions to the IPR institution process. Therein, the Director stated that he is reclaiming the Director's statutory role in determining all aspects of whether to institute trial for IPR proceedings, which lies in stark contrast to the USPTO's procedures both prior to and during the bifurcated process, where a three-member panel of PTAB APJs would consider the merits of the IPR petition. *See id.* This new guidance confirmed that the discretionary denial portion of the bifurcated process will remain largely unaffected; however, the Director noted that, while the bifurcated process was "smart and necessary," it resulted in "extraordinarily high institution rates" for petitions that were not subject to discretionary denial. *See id.* at 2. While there has yet to be a decision issued by the Director with detailed analysis of this latest guidance, given the sentiment expressed in the open letter and supporting memorandum, it is believed that

institution rates under the latest guidance will be even lower than under the bifurcated process, and significantly lower compared to institution rates prior to the bifurcated process. In fact, the Director recently issued a blanket denial of 13 IPR petitions on October 31, 2025. *See* Ex. 15.

The empirical data contradicts Whoop's assertion that its post-grant petitions are "highly likely" to be instituted. Mot. at 10. Indeed, the Board's history under the bifurcated process renders institution of Whoop's IPR petitions unlikely. At best, given the recently issued guidance from the Director, there is substantial uncertainty whether the IPR petitions will be instituted, which affirms that Whoop's Motion should not be granted. This case should not be indefinitely stayed based purely on a highly speculative assertion regarding the outcome of Whoop's IPR petitions, especially where, as is true here, the USPTO's recent precedent does not favor institution and the Director's institution decision is not due for another five months. Accordingly, Whoop's Motion should be denied.

V. Conclusion

For the foregoing reasons, this Court should deny Whoop's Motion to Stay this case, or at least denied without prejudice to refiling after any actual institution decisions.

Dated: November 5, 2025

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