

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., FOSSIL GROUP, INC., FOSSIL STORES I, INC., FOSSIL
PARTNERS, L.P., OURA HEALTH OY, AND ONEPLUS TECHNOLOGY
(SHENZHEN) CO., LTD.,

Petitioners,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Patent No. 12,268,475

Case No. PGR2025-00063

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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LISTING OF EXHIBITS

Exhibit No.	Description
2001	Complaint, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Dec. 20, 2024)
2002	Samsung, Fossil, and Oura's Supplemental Invalidity Contentions Cover Document and Charts for the '475 Patent, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (July 18, 2025)
2003	OnePlus's Invalidity Contentions Cover Document and Charts for the '475 Patent, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Sept. 30, 2025)
2004	Omni MedSci's Infringement Contentions Cover Document, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Mar. 12, 2025)
2005	Samsung, Fossil, and Oura's Motion to Stay, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Aug. 27, 2025)
2006	Order Denying Motion to Stay, <i>Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.</i> , 2:24-cv-01070-JRG-RSP (E.D. Tex.) (Aug. 29, 2025)
2007	Docket Navigator Statistics for District Judge James Rodney Gilstrap
2008	Lex Machina Statistics for District Judge James Rodney Gilstrap

Exhibit No.	Description
2009	Model Order Focusing Patent Claims and Prior Art to Reduce Costs (E.D. Tex.)
2010	<i>Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC</i> , IPR2025-00482, Paper 13 (PTAB May 28, 2025)
2011	Patent Assignment Record for U.S. Patent No. 8,108,036
2012-2015	Reserved
2016	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00912, Paper 1 (PTAB Apr. 10, 2019)
2017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00913, Paper 1 (PTAB Apr. 10, 2019)
2018	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00914, Paper 1 (PTAB Apr. 10, 2019)
2019	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00915, Paper 1 (PTAB Apr. 10, 2019)
2020	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00029, Paper 1 (PTAB Oct. 17, 2019)
2021	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00175, Paper 1 (PTAB Dec. 11, 2019)
2022	Defendant's Invalidity Contentions, <i>Omni MedSci, Inc. vs. Apple Inc.</i> , Case No. 2: 18-cv-00134 (E.D. Tex.) (Aug. 28, 2018)

Exhibit No.	Description
2023	Defendant's Invalidity Contentions - Exhibit A, <i>Omni MedSci, Inc. V. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2024	Defendant's Invalidity Contentions - Exhibit N, <i>Omni MedSci, Inc. V. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2025	Defendant's Invalidity Contentions - Exhibit P, <i>Omni MedSci, Inc. V. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2026-2027	Reserved
2028	U.S. Patent Pub. No. 2012/0197093 ("Valencell-093")
2029	File History of U.S. Patent App. No. 16/669,794, issued as U.S. Patent No. 10,874,304
2030	File History of U.S. Patent App. No. 17/078,771, issued as U.S. Patent No. 11,160,455

Pursuant to the March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management” (“Memo”), Patent Owner Omni MedSci, Inc. (“Patent Owner”) respectfully requests that the Director exercise his discretion and deny institution of the Petition (Paper 1) challenging claims 1, 5-8, and 11-13 of U.S. Patent No. 12,268,475 (“the ’475 Patent”).

I. INTRODUCTION

The parties are engaged in litigation involving the ’475 Patent in *Omni MedSci, Inc. v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-01070-JRG-RSP, in the Eastern District of Texas (“the Texas Case”). The factors in the Board’s precedential *Fintiv* decision weigh in favor of denying institution in view of the advanced stage of the Texas Case. The district court already denied Petitioners’ motion to stay. By the time the Board decides whether to institute a PGR, the parties will have completed claim construction briefing and the *Markman* hearing will be just days away. Most importantly, a jury trial in the Texas Case is scheduled nearly 6 months before the Board’s deadline to issue a final written decision (“FWD”).

Recognizing that these facts weigh strongly in favor of denying institution, Petitioners offer a *Sotera* stipulation, but this will not simplify the issues in the Texas Case because their invalidity contentions are more expansive than the Petition and rely on extensive alleged product prior art. Petitioners also argue (incorrectly) that the merits of the Petition are strong based on collateral estoppel from prior IPR

decisions concerning related patents, but this does not outweigh the other *Fintiv* factors. Petitioners' invalidity arguments can, and in fact will, be addressed in the Texas Case well before the Board would issue a FWD.

The Texas Case also concerns six additional patents. As set forth below, this Petition is one of eight filed by Petitioners that challenge the asserted patents:

Case No.	Patent No.	Institution Deadline
IPR2025-01249	9,055,868	February 9, 2026
IPR2025-01250	9,651,533	February 9, 2026
IPR2025-01251	10,874,304	February 12, 2026
IPR2025-01252	11,160,455	February 12, 2026
IPR2025-01253	12,193,790	February 12, 2026
IPR2025-01254	12,268,475	February 12, 2026
<i>PGR2025-00063</i>	<i>12,268,475</i>	<i>February 12, 2026</i>
PGR2025-00064	12,193,790	February 12, 2026

Petitioners challenge 59 claims across these patents even though only 32 of those claims are asserted in the Texas Case. Another petitioner (Whoop, Inc.) recently filed additional petitions challenging some of these patents:

Case No.	Patent No.	Institution Deadline
IPR2025-01583	9,651,533	April 3, 2026
IPR2025-01584	10,874,304	April 3, 2026
IPR2025-01585	11,160,455	April 3, 2026
PGR2026-00003	12,193,790	N/A

The Director should exercise his discretion to deny these petitions (including this one) because it would be far more efficient to conduct one proceeding—the Texas

Case—to resolve the parties' disputes, rather than conducting potentially up to ten additional proceedings in the Office.

Additionally, the Director should deny institution pursuant to § 325(d) because Petitioners assert the same art that was already presented and considered during prosecution of the '475 Patent, with no showing of any material error by the Office. Indeed, the same or similar art had been asserted against related patents in multiple IPRs and district court litigation prior to prosecution of the '475 Patent. Those references and the prior unpatentability arguments were cited and considered by the Examiner during prosecution of the '475 Patent.

II. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

The Board considers six factors to determine whether to deny institution based on one or more parallel proceedings:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for 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 parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). “[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6. Each of these factors weigh in favor of denying institution in view of the Texas Case.

A. Factor 1 Weighs Against Institution

The first *Fintiv* factor weighs against institution because the district court has not granted a stay, nor is there evidence that one may be granted. *Fintiv*, Paper 11 at 7-8. On August 27, 2025, Petitioners moved to stay the Texas Case based on their IPRs. EX2005. On August 29, 2025, before Patent Owner filed its opposition, the district court *sua sponte* denied the motion as “premature.” EX2006.

It is unlikely that the Texas Case will be stayed even if the Board institutes a PGR. EX2007 (showing 21% grant rate for stay requests). By the time the Board issues an institution decision in February 2026, the parties will have already completed claim construction briefing, will be just days away from the *Markman* hearing (scheduled for February 13, 2026), and will be just weeks away from the close of fact discovery (March 30, 2026). *Infra*, §II.C. Any FWD would not be due until nearly 6 months after the jury trial. *Infra*, §II.B. On these facts, a post-institution stay is exceedingly unlikely in the Texas Case, and this factor strongly weighs against institution.

B. Factor 2 Weighs Against Institution

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this [second] factor in favor of exercising authority to deny institution.” *Fintiv*, Paper 11 at 9. The projected statutory deadline for issuing a FWD for this PGR, if instituted, is February 12, 2027. Jury selection for the Texas Case is scheduled to begin nearly six months prior on August 17, 2026. EX1020.

The scheduled trial date is in line with the median time-to-trial statistics in the Eastern District of Texas: over the last ten years, the median time to trial for Judge Gilstrap’s patent cases is 637 days. EX2008. The current August 17, 2026 trial date is 606 days from the Complaint’s filing date, December 20, 2024. Using the median time to trial, the projected trial date would be September 18, 2026, which would still be nearly five months before the projected FWD deadline. Thus, this factor strongly weighs against institution.

C. Factor 3 Weighs Against Institution

The third factor concerns “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. Here, both the district court and the parties have invested substantial time and resources in the Texas Case and will continue to do so before any institution decision. As of the filing of this brief, the Court has entered a Docket Control Order (scheduling), and the parties have engaged in motion practice,

exchanged proposed terms for construction, and have commenced fact discovery, including serving and responding to dozens of interrogatories and hundreds of requests for production. EX1020. The parties have also already exchanged thousands of pages of infringement contentions and invalidity contentions. *See* EX2004; EX2002; EX2003.

By the time the Board decides whether to institute a PGR in February 2026, even more work will have been completed: the parties will have substantially completed their document productions and completed *Markman* briefing in January 2026, and a *Markman* hearing is scheduled on February 13, 2026. EX1020. The Texas Case will be at a very advanced stage by the time the Board issues an institution decision.

The timing of the Petition is also considered under the third *Fintiv* factor: if “the petitioner did not file the petition expeditiously ... or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.” *Fintiv*, Paper 11 at 11-12. Here, Petitioners waited more than ***seven months*** after the filing of the Complaint to seek review. EX2001. Petitioners’ delay is especially unwarranted because the Petition used prior IPR petitions (and the same expert from the prior IPR petitions) challenging patents related to the ’475 Patent and associated FWDs as a roadmap for portions of this Petition. EX1005; EX1011; EX1004, 5-9; EX1010, 6-10; EX1003, 7-17. Petitioners knew that the jury trial in the Texas Case

would occur before a FWD when they filed this Petition. Patent Owner submits that Petitioners delayed filing to use this PGR to gain another bite at the apple for validity should Patent Owner obtain a favorable jury verdict in the Texas Case.

D. Factor 4 Weighs Against Institution

Under factor 4, “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where a petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 13. That is precisely the case here. Petitioners’ invalidity contentions in the Texas Case also rely on Lisogurski, LeBoeuf, Tran, and Carlson as prior art. EX2002, 40-41; EX2003, 41; Pet., 8. Lisogurski claims “pulse oximetry monitoring system[s]” and is assigned to “Covidien.” EX1025, (73), 45:50-48:30. Petitioners’ invalidity contentions also rely on “[p]ulse oximeters or similar products publicly disclosed, used, sold, or offered for sale by Covidien.” EX2002, 41; EX2003, 42. Similarly, Tran claims a heart monitoring system, refers to pulse oximetry at least 14 times, and is assigned to “Philips.” EX1027, 97:38-98:64; EX2011, 1. Petitioners’ invalidity contentions also rely on “[p]ulse oximeters or similar products publicly disclosed, used, sold, or offered for sale by Philips” EX2002, 42; EX2003, 42. Thus, the Petition includes substantially the same claims, grounds, evidence, and arguments as the Texas Case.

Petitioners' invalidity contentions in the Texas Case are more expansive than the Petition. They assert invalidity based on *thirty* alleged prior art systems and *fourteen* patents and printed publications (including Lisogurski, LeBoeuf, Tran, and Carlson). EX2002, 40-42; EX2003, 41-43. Petitioners state that each Asserted Claim "is rendered obvious by combination with one or more other prior art references identified," yielding an untold number of possible combinations. EX2002, 69; EX2003, 69. Petitioners' invalidity contentions also assert lack of written description and enablement, indefiniteness, and subject matter ineligibility. EX2002, 245-48; EX2003, 244-48.

The Board has denied institution of petitions accompanied by a *Sotera* stipulation where, as here, the "Petitioner's invalidity arguments in the district court are more expansive" than the petition. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (vacating institution decision despite *Sotera* stipulation). In fact, the Director has previously denied institution for a petition accompanied by a substantively identical stipulation as the one offered by Petitioners. *Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC*, IPR2025-00482, Paper 15 at 2 (PTAB July 24, 2025); *compare* Pet., 14-15 (Petitioners' stipulation) *with* EX2010, 11 (substantively identical stipulation).

E. Factor 5 Weighs Against Institution

This factor weighs against institution because Petitioners are the defendants in the Texas Case. EX2001; *Fintiv*, Paper 11 at 13-14.

F. Factor 6 is Neutral

Petitioners argue that Factor 6 weighs in favor of institution in light of prior IPRs finding some claims in related patents unpatentable. Pet., 15-16. Specifically, Petitioners argue that Patent Owner is collaterally estopped from relitigating the unpatentability determinations of certain limitations in the '475 Patent. *Id.*, 15-16, 20-22. However, Factor 6 does not outweigh the other *Fintiv* factors for two reasons.

First, the merits do not favor institution because Petitioners have not met their burden to demonstrate that the '475 Patent is PGR eligible. *Inguran, LLC v. Premium Genetics (UK) Ltd.*, PGR2015-00017, Paper 8 at 8 (PTAB Dec. 22, 2015) (petitioners “bear[] the burden of setting forth grounds for standing for post-grant review”); 37 C.F.R. § 42.204(a). “[E]ligibility for post-grant review depends on whether the patent contains or contained at any time a claim that lacks written description and enabling support in a priority application filed before March 16, 2013.” *MicroSurgical Tech., Inc. v. Regents of the Univ. of Colorado*, PGR2021-00026, Paper 12 at 15 (PTAB June 16, 2021). In this case, “Petitioners do not contest Patent Owner’s assertion of the '475 patent’s December 31, 2012 priority date.” Paper 6, 2. Thus, Petitioners have not (and cannot have) certified PGR-eligibility

Second, Petitioners have not asserted collateral estoppel as to all limitations of any challenged claims. For example, Petitioners do not assert collateral estoppel as to limitations [1.a], [1.c], [1.n], and [8.d] of the independent claims, acknowledging that there are differences between the claims of the '475 Patent and the claims at issue in the prior IPRs. Pet., 20. "Collateral estoppel does not apply [where] there are differences between the claim limitation at issue ... and the adjudicated claim limitations at issue in the prior IPRs." *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01153, Paper 10 at 18 (PTAB Jan. 24, 2022); *see also MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1377-78 (Fed. Cir. 2018) (noting that whether collateral estoppel applies to unadjudicated claims turns on whether they "present materially different issues that alter the question of patentability"); *Dr. Reddy's Lab'ys., Ltd. v. Monosol RX, LLC*, IPR2016-01111, Paper 14 at 16-17 (PTAB Dec. 5, 2016) (concluding collateral estoppel was inapplicable where a prior decision did not resolve whether the same prior art disclosed a different limitation from the challenged patent).

Claim 1 of the '475 Patent recites: "the one or more physiological parameters comprises a pulse rate monitoring and a blood flow measurement." EX1001, 85:16-18 (limitation [1.c]). The related patents in the prior IPRs did not recite this limitation and thus this limitation was not addressed in the prior FWDs. EX1008; EX1081; EX1015; EX1016; EX1082. Indeed, Petitioners do not cite any prior FWDs for this

limitation in the Petition. Pet., 32-34. Similarly, claim 8 of the '475 Patent recites: “generate a third output signal using at least a portion of the first output signal and at least a portion of the second output signal, the third output signal having a third signal-to-noise ratio that is greater than the first signal-to-noise ratio and greater than the second signal-to-noise ratio, the third output signal being associated with a physiological parameter of the user.” EX1001, 86:36-43 (limitation [8.f]). This limitation was not recited in the related patents in the prior IPRs. EX1008; EX1081; EX1015; EX1016; EX1082. While Petitioners cite to findings in the '484-FWD concerning the “increase the signal-to-noise ratio by comparing the first signal and the second signal” limitation in the related '484 Patent (EX1082, 37:38-39), that discussion does not address the additional requirements in claim 8 of the '475 Patent. Pet., 54-55. Thus, Petitioners have not shown that collateral estoppel applies to at least these limitations in the independent claims.

Petitioners' cited cases are distinguishable. In *Google LLC v. Hammond Dev. Int'l, Inc.*, collateral estoppel applied because “[t]he only difference between the claims [in the two patents] is the language describing the number of application servers.” 54 F.4th 1377, 1381 (Fed. Cir. 2022). In this case, as noted above, the challenged claims contain additional limitations that were not previously addressed. In *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 (PTAB May 17, 2025), the Board preliminarily found at the institution stage that the patentee was

collaterally estopped from contesting the grounds in the petition because the challenged claims were not patentably distinct from claims in a related patent were found unpatentable. *Id.* at 20-23. This case is distinguishable because collateral estoppel is not case dispositive for the '475 Patent. Pet., 20. Finally, in *Posco Co., Ltd. v. Arcelormittal*, IPR2025-00370, Paper 10 (PTAB Jun. 25, 2025), *Fintiv* did not apply, in part, because the petitioner was not a party to the parallel litigation, whereas here every Petitioner is a party to the Texas Case. *Id.* at 2-3.

Third, even if Petitioners were correct that *Fintiv* Factor 6 weighed in favor of institution (which it does not), this does not outweigh the other *Fintiv* factors discussed above. The Board takes a “holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6. In *Samsung Elecs. Co., Ltd., v. Sionyx, LLC*, the Board discretionarily denied institution despite “the strong merits of the Petition” and a *Sotera* stipulation because of “the proximity of the trial date as well as the investment and overlapping issues and parties in the district court case.” IPR2025-00064, Paper 16 at 21 (PTAB June 6, 2025). Similarly, the fact that the jury trial in the Texas Case will occur several months before a FWD heavily weighs in favor of discretionary denial.

III. THE DIRECTOR SHOULD DENY INSTITUTION UNDER § 325(D)

The Director may deny institution when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

The Board applies a two-part test to determine whether § 325(d) denial is warranted:

(1) whether the same or substantially the same art or arguments were previously presented to the Office; and (2) if part one satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential in relevant part).

The Petition should be denied under § 325(d) because all of the references asserted in the Petition were previously presented to the Office and Petitioners fail to demonstrate a material error by the Office.

A. Petitioners' References Were Previously Considered or Are Cumulative

Grounds 1-8 rely on Lisogurski with various combinations of LeBoeuf, Tran, and Carlson. Pet., 7-8. Petitioners claim that “[t]he Examiner did not consider the references relied upon in this Petition,” yet admit that “Lisogurski, LeBoeuf, Tran, and Carlson were cited in an IDS during prosecution.” Pet., 12; *see* EX1002, 1184, 1139, 1159, 1136. This citation in an IDS is “sufficient to satisfy the first part of the *Advanced Bionics* framework” even if the Examiner did not rely on the references as a basis for rejection. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (PTAB May 19, 2025) (precedential); Pet., 12-13.

Materials from ten IPRs applying Lisogurski, Tran, and/or Carlson against related patents, including petitions, associated expert declarations (also from Petitioners' expert), a deposition transcript, and FWDS were cited and considered during prosecution of the '475 Patent, including from IPR2021-00453 (combining Lisogurski, Tran, and Carlson) and IPR2019-00914, -00915, -00916, and IPR2020-00175 (combining Lisogurski and Carlson). EX1002, 1119-20, 1155, 1160-61, 1165-66; *see, e.g.*, EX1011, 7; EX2018, 3; EX2019, 3; EX1008 ('533-FWD), 3; EX2021, 3.¹ The Examiner also considered district court invalidity contentions asserting Lisogurski and Carlson individually and in combination against related patents. EX1002, 1132, 1124-25; EX2022, 4; EX2023, 2-3, 5; EX2024; EX2025; *see also* EX1002, 1122.

Some of the cited IPR materials also applied "Valencell-093" (EX2028), which is cumulative of LeBoeuf asserted in this Petition. EX1011, 7 (combining Valencell-093 with Lisogurski, Tran, and Carlson); EX2016, 4-5; EX2017, 4; EX2020, 3-4; EX1002, 404, 415, 433-34. Petitioners rely on LeBoeuf for its alleged teaching of an "arc arrangement[]" of emitters and detectors, but in this regard, LeBoeuf is cumulative because Valencell-093 similarly teaches an arc arrangement. Pet., 68-73; *compare* EX1026, FIG. 8B, ¶123 with EX2028, Figs. 7, 9A, 10, ¶¶120,

¹ Citations herein to PTAB papers refer to native page numbers.

122. Indeed, LeBoeuf's inventors overlap with the inventors of Valencell-093. EX1026, (76) (identifying inventors LeBoeuf, Tucker, Aumer); EX2028, (76) (identifying inventors LeBoeuf, Tucker, Aumer, Romesburg, Morris).

Moreover, the same art and related IPR and litigation materials applying that art were also previously cited in and considered during prosecution of related patents examined by the same Examiner as the '475 Patent, such as U.S. Patent Nos. 10,874,304 and 11,160,455. *See* EX1002, 1199 (Examiner Rahman); EX2029, 453 (Rahman), 400, 373, 370, 353-54, 381-82, 296-97, 366, 358-59, 356 (IDS citations to Lisogurski, LeBoeuf, Carlson, and related materials); EX2030, 604 (Rahman), 457, 465, 403, 462, 404, 415-16, 433-34, 437-38, 474, 428, 420-21, 418 (IDS citations to Lisogurski, LeBoeuf, Tran, Carlson, and related materials).

Petitioners argue that § 325(d) is inapplicable because the Petition's asserted references were never "considered in combination" or used "for a rejection" during prosecution, including arguing that "§325(d) discretion is improper where 'Examiner did not consider the specific combination of references asserted.'" Pet., 12-13 (quoting *Sony v. MZ Audio Scis., LLC*, IPR2022-01544, Paper 12 at 7 (PTAB Apr. 21, 2023)). But § 325(d) and the Board's precedent do not require that the same **combination** of art be **applied** during prosecution; they only require that the same or substantially similar **art** be previously **presented** to the Office. 35 U.S.C. § 325(d); *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8; *Weatherford U.S., L.P. V.*

Enventures Global Tech., Inc., IPR2020-01661, Paper 19 at 28-30 (PTAB Apr. 15, 2021) (rejecting argument that the examiner erred by not combining two references that were considered separately).

Petitioners mischaracterize the Board's findings in *Sony* in suggesting that it stands for the proposition that "§325(d) discretion is improper where 'Examiner did not consider the specific combination of references asserted.'" Pet., 12-13 (quoting *Sony*, Paper 12 at 7). In that case, the Board found that §325(d) did not apply because the secondary and tertiary references in the proposed combination were not cited or considered by the Examiner. *Sony*, Paper 12 at 6-8. By contrast, each of the references in Petitioners' combinations were cited in an IDS or is cumulative of cited references, which satisfies the first part of the *Advanced Bionics* test. *Ecto World*, IPR2024-01280, Paper 13 at 4. Further, as discussed above, the Examiner *did* consider combinations of Lisogurski, Tran, and Carlson (and Valencell-093, which is cumulative of LeBoeuf) when considering the prior IPR materials.

B. Petitioners Fail to Show Any Material Error

Because part one the *Advanced Bionics* test is satisfied, Petitioners "must demonstrate that, for example, the previously presented art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise." *Ecto World*, IPR2024-01280, Paper 13 at 5-6.

Petitioners first argue that it is “difficult, if not impossible to explain ‘why the Examiner allowed the claims’” over Lisogurski, LeBoeuf, Tran, and Carlson because they were allegedly not “‘expressly consider[ed].’” Pet., 13 (quoting *Bowtech, Inc. v. MCP IP, LLC*, IPR2019-00379, Paper 14 at 20 (PTAB July 3, 2019)). Petitioners’ reliance on *Bowtech* is misplaced because that decision issued before the precedential *Ecto World* decision clarifying that “a petitioner must provide an analysis [for part two of *Advanced Bionics*] even when the asserted prior art is on an IDS, but the Examiner did not apply the reference.” IPR2024-01280, Paper 13 at 5; *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01155, Paper 12 at 13, 16-19 (PTAB Jan. 20, 2022) (rejecting similar argument based on *Bowtech* and requiring demonstration of material error). This case is also distinguishable from *Bowtech* in that the Examiner considered multiple prior IPRs applying Lisogurski, Tran, and Carlson against related patents. *Supra*, §III.A.

Petitioners next argue that the Examiner materially erred by failing “to reject the Claims over references or combinations of references teaching each of the limitations that the Examiner found not disclosed in the prior art (§V.B).” Pet., 13 (citing §§IX.B-E). Petitioners, however, do not explain what limitations the Examiner supposedly overlooked and simply refer the Director to 50+ pages of analysis in the Petition. *Id.* The Board has noted that this practice “improperly shifts Petitioner[s’] burden to demonstrate material error onto the Board” to “cobble

together an argument under the second part of *Advanced Bionics*.” *Ecto World*, IPR2024-01280, Paper 13 at 6 n.2. Similarly, “generalized statements as to the strength of [the] Petition fail to identify sufficiently a material error.” *Id.*

Finally, Petitioners argue that the Examiner materially erred because “the Board in the ’484-IPR and ’533-IPR already found unpatentable limitations identical or substantially identical to those in the Claims.” Pet., 13-14. However, as discussed above, (1) the prior IPR petitions were considered by the Examiner and (2) the claims of the ’475 Patent are different than the claims at issue in the prior IPRs. *Supra*, §§II.F, III.A. Petitioners’ disagreement with the Examiner’s treatment of the art and the prior IPRs does not demonstrate any material error. *Advanced Bionics*, Paper 6 at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office [materially] erred”).

IV. THE TEXAS CASE WILL MOST EFFICIENTLY RESOLVE THE PARTIES’ ENTIRE DISPUTE

As noted above, this Petition is one of eight IPR or PGR challenges filed by Petitioners for the six patents that are asserted in the Texas Case, and four additional petitions were recently filed by another petitioner. If instituted, the Board would need to issue up to ten final written decisions, which will only resolve the parties’ disputes for these patents if the Board finds that *every* asserted claim in the Texas Case is unpatentable.

By contrast, the Texas Case will resolve not only the dispute regarding the

'475 Patent but ***all*** of the parties' disputes for all six patents in one proceeding. Congress designed PGRs "to provide an effective and efficient ***alternative*** to district court litigation." *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential) (emphasis added). In this case, instituting a PGR would merely result in the creation of an ***additional*** proceeding.

It would be far more efficient to conduct one proceeding (the Texas Case) to resolve the parties' disputes rather than to strain the Office's limited resources in conducting potentially ten additional proceedings that may not resolve all of the parties' disputes. Notably, Patent Owner is required to narrow the number of asserted claims in the Texas Case prior to trial. EX2009. By the time the parties reach trial, Patent Owner will be limited to "no more than a total of 16 claims." *Id.* at 2. Nevertheless, Petitioners would have the Board address the patentability of more than four times that number across the various petitions it has filed. The Board should decline to devote resources to considering claims that will no longer be part of the parties' disputes by the time of a FWD.

In arguing that the Petition presents "compelling unpatentability arguments," Petitioners cite *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (PTAB June 13, 2025). Pet., 15-16. In that case, the Director declined to discretionarily deny a series of petitions for "eleven patents spanning nine different

families that involve a diverse range of subject matter” because “the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla*, Paper 9 at 2-3. Here, the asserted patents in the Texas Case concern similar subject matter, with five out of the six patents being from the same family. It would be more efficient for these patents to be litigated in the Texas Case. *See also Samsung Elecs. Co., Ltd. et al. v. iCashe, Inc.*, IPR2025-00639, Paper 11 at 2-3 (PTAB Aug. 14, 2025) (discretionary denial for two-year-old patent and three-year-old patent due to efficiency where “the district court will be considering the validity of” patents “in force for over nine, eight, twelve, nine, and nine years”).

Patent Owner submits that the Office should decline Petitioners’ request to initiate such piecemeal and duplicitous litigation. It would be less burdensome for the parties to litigate all of their disputes in one proceeding.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise his discretion and deny institution.

Patent No. 12,268,475
PGR2025-00063

Patent Owner's Discretionary Denial Brief

Respectfully submitted,

Dated: October 14, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's**

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