

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHOOP, INC.,
Petitioner

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case No. PGR2026-00003

U.S. Patent No. 12,193,790

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

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PETITIONERS' EXHIBIT LIST

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1001	U.S. Patent No. 12,193,790
1002	File History, U.S. Patent No. 12,193,790
1003	Declaration of Patrick Mercier, PhD
1004	U.S. Patent No. 9,651,533
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	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 10, (P.T.A.B. Oct. 18, 2019) (Patent Owner's Preliminary Response, '533 IPR)
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)

Exhibit No.	Description
1018	RESERVED
1019	RESERVED
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	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 10 (P.T.A.B. Nov. 12, 2021) (Patent Owner Response, '484 IPR)
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	U.S. Patent No. 6,304,767 ("Soller")
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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)
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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	RESERVED
1045	Webster, J. G. (1997) Design of Pulse Oximeters, IOP Publishing
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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> , PGR2025-00063, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (475 PGR Petition)

*Opposition to Patent Owner's
Discretionary Denial Brief*

Exhibit No.	Description
1057	U.S. Patent No. 10,874,304
1058	U.S. Patent No. 11,160,455
1059	RESERVED
1060	U.S. Patent No. 12,268,475
1061	<i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 25-1646, Dkt. 17 (Fed. Cir. Sept. 11, 2025) (Omni's Corrected Opening Brief)
1062	U.S. Patent App. Pub. No. 2011/0237911 ("Lamego")
1063	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , PGR2025-00064-1021, Ex. 1021 (P.T.A.B. Aug. 5, 2025) (Ex. 1021 to Samsung's '790 PGR Petition)
1064	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , PGR2025-00064-6 (P.T.A.B. Aug. 5, 2025) (Samsung's Petition Ranking and Explanation of Parallel Petitions)
1065	Wu, et al., <i>A new generation of sensors for non-invasive blood glucose monitoring</i> , Am. J. of Translational Research 2023;15(6):3825-3827 (Jun. 30, 2023)
1066	<i>WHOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01583, Paper No. 1 (P.T.A.B. Sept. 26, 2025) (WHOOP '533 IPR Petition)
1067	<i>WHOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01584, Paper No. 1 (P.T.A.B. Sept. 26, 2025) (WHOOP '304 IPR Petition)
1068	<i>WHOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01585, Paper No. 1 (P.T.A.B. Sept. 26, 2026) (WHOOP '455 IPR Petition)
1069	<i>WHOOP, Inc. v. Omni MedSci, Inc.</i> , 1:25-cv-140-WCB, D.I. 11-12 (D. Del. May 5, 2025) (Ex. 12 to Delaware action Amended Complaint)
1070	U.S. Pat. Provisional App. No. 61/747,472 (Dec. 31, 2012)
1071	U.S. Pat. Provisional App. No. 61/747,477 (Dec. 31, 2012)
1072	U.S. Pat. Provisional App. No. 61/747,487 (Dec. 31, 2012)
1073	U.S. Pat. Provisional App. No. 61/747,553 (Dec. 31, 2012)
1074	U.S. Pat. Provisional App. No. 61/754,698 (Dec. 31, 2012)
1075	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)

*Opposition to Patent Owner's
Discretionary Denial Brief*

Exhibit No.	Description
1076	Scheduling Order, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 43) (Nov. 10, 2025)
1077	Stipulation re Invalidity for the '790 Patent, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 71) (Jan. 22, 2026)
1078	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , PGR2025-00064, Paper No. 13 (P.T.A.B. Nov. 12, 2025) (Omni's POPR to Samsung's 790 PGR Petition)

I. INTRODUCTION

The Director should decline to discretionarily deny WHOOP's PGR Petition challenging claim 7 of the '790 Patent. *Fintiv*, *General Plastic*, and Section 325(d) each support institution. **All but one** of the claim limitations at issue in the Petition are subject to collateral estoppel from prior IPRs, so Board review would be more efficient than litigating invalidity in the district court. Furthermore, if instituted, the Board's Final Written Decision ("FWD") will issue before trial in the pending district court litigation against WHOOP (which is in its early stages). Additionally, PGR estoppel eliminates any potential overlap between this IPR and the district court proceedings. PGRs are also favored over IPRs due to lack of settled expectations.

This is WHOOP's first petition challenging the '790 Patent. The Petition includes two references and two § 112 grounds not included in Samsung's petitions.¹ WHOOP's petition is also properly a PGR (unlike Samsung's surviving petition). Specifically, the '790 patent is a PGR patent because the applicant certified that it had at least one post-AIA claim during prosecution. At a minimum, the Director should decline to exercise discretionary denial so the Director and Board can

¹ Samsung Electronics Co., Ltd. and others filed an IPR and a PGR challenging claim 7 of the '790 Patent. EX1053 ("Samsung IPR"); EX1054 ("Samsung PGR"). The Samsung PGR was discretionarily denied. EX2045, 1.

consider on the merits the important question of whether—to avoid PGR—an applicant can contradict its statements about the patent's priority date made during prosecution. WHOOP also filed this Petition well before any substantive briefing by Omni in the Samsung IPR and PGR, alleviating any road-mapping concerns.

Although certain references and materials from prior IPRs² were included in IDS forms submitted during prosecution, they were not discussed by the Examiner, suggesting material error. Indeed, as mentioned, the Board has since found that every element of claim 7 is met by the same prior art included in WHOOP's Petition, and only one remaining element is not subject to collateral estoppel. Finally, Omni has no settled expectations in the '790 Patent, which issued in January 2025.

II. ARGUMENT

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

The *Fintiv* factors support institution. Most importantly, collateral estoppel based on the Apple IPRs renders *all but one* of the challenged limitations

² Apple successfully challenged two parent patents (the '533 and '484 Patents) to the '790 Patent ("Apple IPRs"). All challenged claims of the '533 Patent were held unpatentable, affirmed on appeal. EX1008; EX1009. All challenged claims of the '484 Patent were held unpatentable; certain claims having one particular limitation are pending appeal. EX1011, EX1012, n.2; EX1013; EX1014.

unpatentable. Since FWDs do not carry preclusive effect in the district court, the Board is best situated to review WHOOP's patentability challenge. Moreover, the FWD in this PGR would be due before trial in the district court litigation, which is still in the earliest stages. PGR estoppel ensures any grounds that could have been raised in this Petition will be litigated only in this forum. The other factors (likelihood of a stay and identity of parties) are neutral. *Fintiv* thus favors 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. EX1075. 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 (PTAB. Mar. 20, 2020) (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." EX1075, 1. The 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. EX1076 at 8. If instituted, a FWD for this Petition is projected for April 22, 2027—about a month before trial. Omni argues that the parties will complete discovery and case dispositive motions by the FWD (Paper 6, 10,³ “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 ’790 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 date for this Petition (April 22, 2026), the litigation will still be in early stages. Opening claim construction briefs will only just have been filed (April 13, 2026). EX1076, 6. Fact discovery close will be nearly 6 months away, and initial expert reports are not due until October 2026. *Id.* at 3–4.

³ DD Br. at 10 has an apparent typo, putting April 2026 (not 2027) as the FWD date.

Omni's argument that early case disclosures, such as infringement and invalidity contentions, amount to "substantial time and resources" (D.D. Br. 11) 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 '790 Patent in the district court (except WHOOP's motion to dismiss, granted in part) further weighs against denial. *Fintiv*, IPR2020-00019, Paper 11 at 10.

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 did not delay (*infra*, § II.B.2), and PGR estoppel precludes WHOOP from challenging validity in district court, ensuring invalidity will be decided only once. 35 U.S.C. § 325(e)(2).

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

4. Lack of overlap favors institution

If the Petition is instituted, PGR estoppel precludes WHOOP from challenging in district court that claim 7 of the '790 patent "is invalid on any ground" that was "raised or reasonably could have [been] raised" during post-grant review, so a *Sotera* stipulation is unnecessary. 35 U.S.C. § 325(e)(2). Although unnecessary given PGR estoppel, WHOOP filed a *Sotera* stipulation for the '790 Patent.

EX1077. Further, because, unlike IPRs, PGRs permit invalidity challenges under 35 U.S.C. §§ 101 and 112, Omni is wrong that the “invalidity issues to be litigated in the Delaware Case will likely be more expansive than the grounds in the Petition.” DD Br. 13–14. There will be no overlap, and this factor favors 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 PGR 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. Collateral estoppel weighs strongly in favor of institution

The merits strongly weigh in favor of institution due to collateral estoppel. Collateral estoppel applies 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.” *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 at 18–19 (PTAB May 15, 2025). 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 (Fed. Cir. 2022); *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d

1333, 1342 (Fed. Cir. 2013) (estoppel not limited to “claims that are identical”). The significant overlap between claim 7 of the ’790 Patent and the claims previously invalidated in the Apple IPRs is shown in the Petition. Paper No. 1 (“Pet.”), 27–29.

Omni does not (and could not) contest that the elements of collateral estoppel are satisfied for nearly all claim elements. DD Br. 14–17. Indeed, Omni appears to concede that 13 of 14 limitations in the ’790 Patent are not patentably distinct from those found unpatentable in the Apple IPRs. DD Br. 15 (identifying *one* limitation to which collateral estoppel does not apply). Omni’s sole argument is that the *one* claim limitation (“identify an object”) is not subject to collateral estoppel because the finding of unpatentability for that limitation is pending appeal.

But the fact collateral estoppel might not apply to a challenged limitation does not negate the effects of estoppel as to other limitations. *Keysight Techs., Inc. et al. v. Centripetal Nets., LLC*, IPR2023-00446, Paper 30 at 20–21 (PTAB Aug. 5, 2024) (applying estoppel to “limitations [1a] through [1d]” and considering limitation [1e] on its merits). Furthermore, although it is precluded from relitigating validity 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[s] require[] a lower burden of proof” than district court). Board review of the challenged claims would thus be significantly more efficient, since only one limitation in the sole challenged claim requires review.

Recent decisions recognize estoppel can “tip[] the balance against discretionary denial,” since 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 Jun. 25, 2025); *Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 at 2–3 (Director Aug. 6, 2025). So too here. The Board held nearly identical claims from this patent family unpatentable based on the same core prior art. Review of the ’790 Patent would thus promote consistency and avoid unnecessary litigation.

Omni suggests the merits do not favor institution because WHOOP “has not shown that the ’790 Patent is PGR eligible.” DD Br. 16–17. Tellingly, Omni does not address WHOOP’s arguments (Pet. 9–14) that Omni conceded during prosecution that the ’790 Patent is subject to the AIA, and therefore, PGR eligible. Nor does Omni dispute that for “transition applications” like the ’790 Patent, which was filed after the AIA but purports to claim a pre-AIA priority date, PGR eligibility turns on whether the application “contained at any time” at least one post-AIA claim. America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) §3(n)(1); *MicroSurgical Tech. v. Regents of Univ. of Col.*, PGR2021-00026, 2021 WL 2460802, at *5 (PTAB Jun. 16, 2021) (“[F]or a patent issuing from a transition application, eligibility 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.”); MPEP §§ 2159.02, 2159.04.

Here, Omni certified during prosecution that the application resulting in the ’790 Patent “contains, or contained at any time, a claim...that has an effective filing date on or after March 16, 2013” and acknowledged that “[b]y providing this statement under 37 CFR 1.55 or 1.78,” the application would be “examined under the first inventor to file provisions of the AIA.” EX1002, 246; *see also* EX1002, 271 (“AIA (First Inventor to File Status)” marked “Yes”), 305 (AIA status “Yes”), 306 (“The present application...is being examined under the first inventor to file provisions of the AIA.”). Because Omni certified the ’790 patent had at least one post-AIA claim and it was examined under the AIA, the ’790 patent is PGR eligible.⁴

Again, Omni does not dispute these facts, and instead argues that by denying the Samsung PGR, the Director “has already implicitly found that the ’790 Patent is pre-AIA.” DD Br. 16–17. But the Director denied the Samsung PGR on *discretionary* grounds (*i.e.*, not on the merits due to lack of PGR standing) *after*

⁴ Omni disagrees that certain exemplary limitations WHOOP included in its Petition lack support in the pre-AIA provisionals to which the ’790 Patent claims priority. DD Br. 16–17. Notably, Omni’s purported “support” for these claim limitations does not match the claim language. *Id.* Regardless, Omni cannot escape its own representations that the ’790 patent contain(s/ed) at least one post-AIA claim.

Samsung ranked the IPR petition as the preferred parallel petition and neither party challenged pre-AIA status. See EX2045, 1; EX1064, 4; EX1078, 15–16. There is thus no indication that the Director “recognized” the ’790 patent as a pre-AIA patent, but, rather, that the Director understandably accepted the parties’ representations and rankings for purposes of determining which petition should be considered on the merits. Omni cannot escape collateral estoppel or its statements during prosecution that the ’790 patent is a PGR patent, and the merits therefore favor institution.

B. *General Plastic* Does Not Support Discretionary Denial

Discretionary denial under *General Plastic* is not justified here. WHOOP’s Petition is materially different from the Samsung petitions, asserting two additional prior art references and two grounds under § 112. Moreover, 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. Sols., 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 ’790 Patent, and Omni does not (and cannot) allege that WHOOP has a “significant relationship” under *Valve* with the Samsung petitioners. DD Br. 6; *see Valve Corp. v. Elec. Scripting Products, Inc.*, IPR2019-00062, Paper 11, at 10 (PTAB Apr. 2, 2019) (precedential). To the extent the remaining *General Plastic* factors are considered, each is either neutral or weighs against 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*, IPR2023-01218, 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” absent extenuating circumstances); *Jeisys Med. Inc. v. Serendia, LLC*, IPR2024-00463, Paper 20 at 8 (PTAB Aug. 20, 2024) (similar). This principle applies 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); *American Honda Motor Co., Inc. v. Neo Wireless LLC*, IPR2023-00797, Paper 16 at 3 (PTAB Dec. 8, 2023); *id.*, Paper 27 at 2–3 (Director Mar. 22, 2024) (no significant relationship despite roadmapping allegations).

A “significant relationship” must connect the petitioners “with respect to [the] assertion” of the challenged patent. *Valve*, IPR2019-00062, Paper 11 at 10. Absent a contractual relationship or informal cooperation implementing the accused 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*, IPR2023-01339, Paper 12 at 19–20; *American Honda*, IPR2023-

00797, Paper 27 at 2–3. WHOOP does not have a “significant relationship” with the Samsung petitioners, and Omni does not assert one exists. DD Br. 5–6.

Nevertheless, Omni argues that WHOOP’s Petition is a “follow-on” petition that uses the Samsung IPR as a roadmap, so that—despite the lack of a “significant relationship” between the Samsung petitioners and WHOOP—the *General Plastics* factors favor denying institution. *Id.* Omni’s cited authorities are distinguishable or rely 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. *See, infra*, § II.B.2 (strategic staggering 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); *NetApp Inc. v. Realtime Data*

LLC, IPR2017-01196, Paper 10 at 11 (PTAB Oct. 13, 2017) (petition filed “well after” POR). 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 (PTAB Mar. 17, 2020) (finding Factor 1 weighed against institution despite no significant relationship), with *Prime Time Toys*, IPR2023-01339, Paper 12 at 18–21 (finding discretionary denial not justified absent significant relationship). *Ericsson* is also inapposite, as the petitioner studied the prior petitions “to determine grounds” for its own petition. IPR2019-01550, Paper 8 at 11.

Here, by contrast, Samsung and WHOOP’s petitions rely on different grounds and different combinations of references. Indeed, WHOOP relies on two additional references and two § 112 grounds that Omni ignores. DD Br. 3. Omni accuses WHOOP of “reus[ing]” references and “adopt[ing]” arguments from the Apple IPRs (*Id.* at 3, 5), but ignores that WHOOP does not use these arguments as a “follow-on,” but rather to argue collateral estoppel. The Board has endorsed such petitions as “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*, IPR2025-00370, Paper 10 at 3; *Arm*, IPR2025-00207, Paper 14 at 2–3.

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 [WHOO] 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/PGR of the ’790 Patent. *Elm 3DS Innovations*, IPR2017-01305, Paper 11 at 19–20. Omni does not explain how this factor supports denial. DD Br. 5–8. Moreover, WHOOP must rely on Apple’s same art for estoppel.

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/PGR. WHOOP’s petition does not simply “repackage[]” the Samsung petition (DD Br. 7) but asserts two additional prior art references and § 112

grounds not in the Samsung petitions. Pet. 17; EX1051, 8. Any 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.

Omni argues that WHOOP's reliance on the Board's FWDs in the Apple IPRs is evidence of roadmapping favoring discretionary denial. DD Br. 5–8. But Omni cites no authority to support its claim that relying on the Board's prior decisions *holding unpatentable* related claims in order to invoke collateral estoppel is a form of prejudicial roadmapping. *Id.* To the contrary, unpatentability determinations of related claims weighs in favor of institution. *See, supra*, § 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*, IPR2016-01357, Paper 19 at 18. Omni suggests WHOOP unreasonably delayed filing its petition (DD Br. 7), but there is no evidence that WHOOP delayed requesting PGR. Indeed, Omni's cited authority is inapplicable, as it involved the petitioner's third petition, which was filed after the Patent Owner's substantive briefing was submitted for the other two petitions. *Apple Inc. v. Koss Corp.*, IPR2022-00053, Paper 10 at 9–12 (PTAB Apr. 4, 2022). WHOOP worked diligently to file its Petition, which is more comprehensive than Samsung's, after Omni first accused it of infringing the '790

Patent in February 2025. EX1006, 3. Further, the '790 patent issued barely a year ago, and WHOOP filed its Petition within the nine-month PGR window. Indeed, PGRs “are favored because they must be filed no later than nine months from the grant of the patent...are close in time to examination, and occur before expectations in the patent rights are strongly settled.” *Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper No. 10 at 2–3 (Director Jul. 16, 2025) (precedential).

Factors 6 and 7: Board considerations. WHOOP’s Petition was filed only ten weeks after Samsung’s, so 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. § 326(a)(11). Institution of both petitions would not be overly burdensome, as estoppel precludes Omni from litigating the validity of nearly all limitations, *supra* § II.A.6. Omni suggests a parallel PGR and IPR petition on the same patent would be inefficient due to the fact they rest on “inconsistent premises,” (DD Br. 8), but ignores that it conceded during prosecution that the '790 Patent is a PGR patent (*supra* § II.A.6). To the extent the Board must select one Petition, the Board’s resources would be most efficiently utilized through WHOOP’s PGR because PGR estoppel would apply to WHOOP in district court, whereas Samsung would still have additional invalidity challenges available.

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. Both *Iron Oak* factors weigh against denial. IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019).

WHOOOP would face undue prejudice if institution is denied and the Samsung IPR is terminated prior to a FWD. Omni argues incorrectly that WHOOOP 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. WHOOOP's argument that the Apple IPRs preclude Omni from litigating the validity of the challenged claim can only be applied by the Board.

The existence of multiple petitions challenging the '790 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.*, IPR2018-01554, 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 WHOOOP'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)). But *Nichia* 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*, IPR2019-00398, Paper 10 at 5, 9, 17, 23–24. As discussed with respect to Factor 3, *supra*, no such concerns exist here.

Omni also attempts to fault WHOOP for not filing a “copycat” of the Samsung Petition(s) 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 properly filed its challenge as a PGR, and could not join Samsung’s IPR without foregoing its § 112 challenges, which are not permissible in IPR.

In sum, the concerns of inefficiency and prejudice to the patent owner addressed in *General Plastic* do not exist for WHOOP’s petition.

C. Denial Under 35 U.S.C. § 325(d) Is Not Warranted

Although materials from the Apple 533 IPR and the Lisogurski, Carlson, and Lamego references were listed in IDS forms in the ’790 Patent’s prosecution Section 325(d) denial is not warranted. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 6–7 (Director May 19, 2025).

1. The Apple IPR and related prior art were not discussed during prosecution

Materials from the ’533 Apple IPR, invalidity contentions, Lisogurski, Carlson, and Lamego were among over 700 references listed across six IDS forms

in the '790 Patent file history. *See* DD Br. 18 (collecting exhibits). These IDS forms were submitted during prosecution of the prior patents, not during the '790 prosecution, and do not show a “meaningful evaluation and appreciation of the prior art.” *Dr. Reddy's Lab 'ys S.A. v. Eye Therapies, LLC*, IPR2024-00467, Paper 14 at 19 (PTAB Aug. 13, 2024). None of those references were substantively assessed (or even discussed) by the Examiner. EX1002, 301–10. In view of the “extremely large number of references,” any alleged consideration by the Examiner does not warrant Section 325(d) denial because the references were not discussed or applied. *Ecto World*, IPR2024-01280, Paper 13 at 2–4, 7. Further, the '790 Patent issued in 2025, but despite the significant overlap with the '484 Patent (Pet. 27–29), Omni never submitted the first '484 Apple FWD from 2022, (EX1011) during the '790 prosecution.

2. The Examiner erred by failing to consider the cited teachings of the prior art

Material error may exist where “even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination,” thereby “overlooking certain teachings in the prior art on the IDS.” *Ecto World*, IPR2024-01280, Paper 13 at 5–6. Despite the substantial similarity between the claims of '790 Patent and the related '533 Patent invalidated in the Apple IPRs, *supra* § II.A.6, the '790 Patent issued without a single rejection. EX1002, 301–10.

The Examiner's failure to engage with the references that invalidated

overlapping claims in the related '533 Patent is material error. *ClearCorrect Operating, LLC v. Align Tech., Inc.* is instructive. IPR2025-00817, Paper 13 at 3 (Director Aug. 29, 2025). In *ClearCorrect*, as here, a substantially similar related patent was found unpatentable by the Board in a prior IPR. *Id.* Although the prior IPR was cited in an IDS, the Examiner “did not discuss why the challenged claims were patentably distinct” from those determined unpatentable in the prior IPR. *Id.* The Acting Director found the Examiner “erred by allowing the claims after the Board determined that substantially similar claims are unpatentable.” *Id.*; *see also Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (Director Jul. 16, 2025) (similar). Omni’s failure to submit the first '484 IPR FWD during prosecution of the '790 Patent only compounds that error.

D. Omni Has No Settled Expectations in the '790 Patent

Omni cannot claim settled expectations in the '790 Patent, which issued January 14, 2025. EX1001; *Multi-Color Corp.*, PGR2025-00025, Paper No. 10 at 2–3. Further, a patent owner’s settled expectations are undermined where, as here, related claims are found unpatentable. *POSCO*, IPR2025-00370, Paper 10 at 2–3.

III. CONCLUSION

WHOOOP respectfully requests the Director to deny discretionary denial.

*Opposition to Patent Owner's
Discretionary Denial Brief*

Dated: January 22, 2026

Respectfully Submitted,

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CERTIFICATE OF SERVICE

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