

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WHOOOP, INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

PGR2026-00003
Patent 12,193,790 B2

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

DECISION
Granting Institution of Post-Grant Review

WHOO, Inc. (“Petitioner”) filed a petition requesting post-grant review (“PGR”) of claim 7 of U.S. Patent No. 12,193,790 (“the ’790 patent”). Paper 1 (“Petition” or “Pet.”). Omni MedSci, Inc. (“Patent Owner”) filed a preliminary response. Paper 8 (“Prelim. Resp.”). After considering the arguments presented and the record, and in view of all relevant considerations, granting institution was appropriate in this proceeding. *See* Paper 10 (“Notice”), 2. This determination was based on the totality of the evidence and arguments presented, only a select portion of which I discuss in the following opinion identified as forthcoming in the Notice. *See id.*

As an initial matter, Patent Owner incorrectly asserts that, by denying an earlier PGR petition challenging the same claim of the ’790 patent and instituting an *inter partes* review (“IPR”) that was filed in parallel, I “implicitly found that the ’790 Patent is a pre-AIA patent and not PGR eligible.” Prelim. Resp. 14; *see also* Paper 6, 16 (“[T]he Director has already implicitly found that the ’790 Patent is pre-AIA.”). I, however, made no such determination because the petitioners there did not contest that the ’790 patent is a pre-AIA patent and Patent Owner did not assert otherwise.

Specifically, several petitioners (collectively, “Samsung”) filed in parallel a PGR petition (PGR2025-00064) (“Samsung PGR”) and an IPR petition (IPR2025-01253) (“Samsung IPR”), each challenging claim 7 of the ’790 patent. In its explanation for filing the parallel petitions, Samsung stated that it “do[es] not contest” Patent Owner’s assertion in district court that the ’790 patent is entitled to a priority date of December 31, 2012, and that “by Patent Owner’s own admission, the ’790 patent is not subject to the

AIA.” Samsung IPR, Paper 6, 2–3. Under “Ranking,” Samsung requested that “the Board institute *inter partes* review in IPR2025-01253 and moot post-grant review in PGR2025-00064.” *Id.* at 4. In response, Patent Owner did not address the priority date issue or assert that the ’790 patent is an AIA patent and thus is not properly the subject of an IPR petition. *See* Samsung PGR, Papers 12, 13; Samsung IPR, Papers 12, 13.

The parties in these earlier proceedings, therefore, did not place the issue of PGR eligibility in dispute such that it needed to be determined. Accordingly, Samsung’s lower-ranked petition was discretionarily denied and the higher-ranked petition was referred for a review of the merits and non-discretionary considerations and ultimately was instituted. Samsung PGR, Paper 16; Samsung IPR, Papers 16, 19. As such, I made no implicit determination regarding whether the ’790 patent is an AIA patent.

In this proceeding, Petitioner persuasively shows, on the current record, that the ’790 patent is an AIA patent. As Petitioner notes, during prosecution of the ’790 patent, Patent Owner certified that the ’790 patent application “contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.” Ex. 1002, 246; *see* Pet. 11–12. Patent Owner, therefore, acknowledged that the application was to be examined under the first inventor to file provisions of the AIA. *Id.* Also, Petitioner shows, for purposes of institution, that the provisional applications to which the ’790 patent claims priority do not provide written description support for a “wearable device adapted to be placed on a wrist or a hand dorsal of a user,” such that the detection system of the wearable device has a “plurality of detectors arranged along an arc,”

as recited in claim 2. Pet. 13.¹ Although Patent Owner asserts that one of the provisional applications provides written description support via a figure illustrating a mouth guard design and a disclosure that “[t]he non-invasive devices may be part of a series of biosensors applied to the patient,” I do not find this persuasive based on the current record. *See* Paper 6, 16–17 (citing Ex. 1071, 15–16, 29, 40); Ex. 1071, 7, 29, 40. Even if the mouth guard could be considered to have detectors arranged in an arc, the mouth guard is used to “perform a non-invasive measurement for dental caries” and is not described as “adapted to be placed on a wrist or a hand dorsal of a user,” as claim 2 requires. *See* Ex. 1071, 7, 29, 18–19, 40.

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 324(a), a post-grant review of claim 7 of the ’790 patent is *instituted*.

¹ Petitioner’s reference to claim 3 rather than claim 2 is an obvious typographical error.

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