

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHOOOP, INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Patent No. 12,193,790

Post Grant Review No. PGR2026-00003

**PETITIONER'S MOTION FOR *PRO HAC VICE* ADMISSION OF
NATHANIEL R. SCHARN UNDER 37 C.F.R. § 42.10**

Before the Patent Trial and Appeal Board

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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EXHIBIT LIST

Exhibit #	Reference Name
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.</i> , et al., 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)

Exhibit #	Reference Name
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)
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")

Exhibit #	Reference Name
1028	U.S. Patent App. Pub. No. 2005/0049468 (“Carlson”)
1029	RESERVED
1030	U.S. Patent No. 6,304,767 (“Soller”)
1031	RESERVED
1032	U.S. Patent Appl. Pub. No. 2012/0197093 (“Valencell-093”)
1033	“The Biomedical Engineering Handbook,” by Joseph D. Bronzino (1995) (Apple Ex. 1019)
1034	Patel, et al., A review of wearable sensors and systems with application rehabilitation, <i>Journal of Neuroengineering & Rehabilitation</i> (2012) (Apple Ex. 1021)
1035	A. Omre, Bluetooth Low Energy: Wireless Connectivity for Medical Monitoring, <i>Journal of Diabetes Science & Technology</i> (Mar. 2010) (Apple Ex. 1024)
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, <i>JRC Scientific and Policy Reports of European Commission</i> (2013) (Apple Ex. 1027)
1037	M. Kranz, et al., The mobile fitness coach: Towards individualized skill assessment using personalized mobile devices, <i>Pervasive and Mobile Computing</i> (June 2012) (Apple Ex. 1020)
1038	M. Swan, Senior Mania! The Internet of Things, Wearable Computing, Objective Metrics, and the Quantified Self 2.0, <i>Journal of Sensor and Actuator Networks</i> (2012) (Apple Ex. 1029)
1039	RESERVED

Exhibit #	Reference Name
1040	“The Usage of Tablets in the HealthCare Industry,” by Rauf Adil (Aug. 2, 2012), 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
1046	RESERVED
1047	RESERVED
1048	RESERVED
1049	RESERVED
1050	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01250, Paper No. 1 (P.T.A.B. Aug. 5, 20215) (533 IPR Petition)
1051	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01251, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (304 IPR Petition)
1052	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01252, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (455 IPR Petition)
1053	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01253, Paper No. 1 (P.T.A.B. Aug. 5, 2025) (790 IPR Petition)

Exhibit #	Reference Name
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)
1057	U.S. Patent No. 10,874,304
1058	U.S. Patent No. 11,160,455
1059	RESERVED
1060	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)

Exhibit #	Reference Name
1066	<i>WHOOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01583, Paper No. 1 (P.T.A.B. Sept. 26, 2025) (WHOOOP '533 IPR Petition)
1067	<i>WHOOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01584, Paper No. 1 (P.T.A.B. Sept. 26, 2025) (WHOOOP '304 IPR Petition)
1068	<i>WHOOOP, Inc. v. Omni MedSci, Inc.</i> , IPR2025-01583, Paper No. 1 (P.T.A.B. Sept. 26, 2025) (WHOOOP '455 IPR Petition)
1069	<i>WHOOOP, 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)
1076	Scheduling Order, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv00140 (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)

Exhibit #	Reference Name
1079	Declaration of Brian A. Rosenthal in Support of Petitioner's Notice of Intent to Designate a Provisionally Recognized PTAB Attorney as Back-Up Counsel Pursuant to 37 C.F.R. § 42.10(C)
1080	Declaration of Nathaniel R. Scharn in Support of Petitioner's Motion for <i>Pro Hac Vice</i> Admission

Pursuant to 37 C.F.R. § 42.10 and in response to the authorization provided by the United States Patent and Trademark Office’s Patent Trial and Appeal Board (“Board”) in the “Notice of Filing Date Accorded to Petition” (Paper Number 3, dated October 22, 2025) referred to hereinafter as “Notice”),¹ Petitioner WHOOP, Inc. submits this motion for Nathaniel R. Scharn to appear *pro hac vice*. Petitioner respectfully requests that the Board recognize Mr. Scharn’s *pro hac vice* admission during this proceeding.

I. TIME FOR FILING

Pursuant to the “Order – Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639 (hereinafter “the Order”), this motion for *pro hac vice* admission is being filed no sooner than twenty-one (21) days after service of the petition.

II. STATEMENT OF FACTS

Pursuant to the Order, the following statement of facts shows that there is good cause for the Board to recognize Mr. Scharn *pro hac vice*.

Lead counsel for this proceeding, Jaysen S. Chung, is a registered practitioner (Reg. No. 68,199).

¹ As referenced in page 2 of the Notice.

Mr. Scharn is an experienced litigation attorney and has been involved in numerous patent-infringement cases in federal courts across the country. He has experience in various aspects of patent infringement matters, including jury and bench trials, *Markman* hearings, and summary judgment hearings. Mr. Scharn is a member in good standing of the California Bar. He is admitted to practice before the United States Courts of Appeals for the Federal Circuit, the United States District Courts for the Northern District of California, Central District of California, and Southern District of California. Mr. Scharn has not been suspended or disbarred from practice, has never had any application for admission to practice denied, and has never had any sanctions or contempt citations imposed against him.

III. GOOD CAUSE EXISTS FOR THE *PRO HAC VICE* ADMISSION OF NATHANIEL R. SCHARN

Mr. Scharn is counsel for the Petitioner in a pending litigation, *Omni MedSci, Inc. v. WHOOP, Inc.*, No. 1:25-cv-00140-WCB, pending in the United States District Court for the District of Delaware. That litigation involves U.S. Patent No. 12,193,790 (“the ’790 Patent”), the same patent at issue in this proceeding. In his role as counsel in the pending litigation, Mr. Scharn has reviewed and is familiar with the ’790 Patent and the asserted prior-art references and invalidity claim charts. Further, Mr. Scharn has been involved, and is familiar, with the factual and legal

arguments at issue in that case. As such, Mr. Scharn has established familiarity with the subject matter at issue in this proceeding.

Mr. Scharn has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules for Practice for Trials set forth in part 42 of the C.F.R., and he agrees to be subject to the *USPTO Rules of Professional Conduct* set forth in 37 C.F.R. §§ 11.101 *et. seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

Petitioner has expended significant financial resources in the pending litigation with Mr. Scharn as counsel, and Petitioner wishes to continue using Mr. Scharn in this proceeding.

As such, Petitioner respectfully submits that there is good cause for the Board to recognize Mr. Scharn as counsel *pro hac vice* in this proceeding.

IV. AFFIDAVIT OR DECLARATION OF INDIVIDUAL SEEKING TO APPEAR

This Motion for *pro hac vice* admission is accompanied by a Declaration of Mr. Nathaniel R. Scharn (Exhibit 1080).

V. CONCLUSION

Petitioner respectfully requests that the Board admit Mr. Scharn *pro hac vice* in this proceeding.

DATED: May 29, 2026

Respectfully Submitted,

By: /Jaysen S. Chung/

Jaysen S. Chung, Lead Counsel
Reg. Number: 68,199
Gibson, Dunn & Crutcher LLP
One Embarcadero Center, Suite 2600
San Francisco, CA 94111-3715
Tel: 415-393-8271
JSChung@gibsondunn.com

Brian Rosenthal (Provisionally Recognized
PTAB Attorney)
Gibson, Dunn & Crutcher LLP
200 Park Avenue
New York, NY 10166-0193
Tel: 212-351-2339
BRosenthal@gibsondunn.com

Y. Audrey Yang
Reg. Number: 74,393
Gibson, Dunn & Crutcher LLP
2001 Ross Ave., Suite 2100
Dallas, TX 75201
Tel: 214-698-3215
AYang@gibsondunn.com

Counsel for Petitioner

CERTIFICATION OF SERVICE

A copy of the foregoing document was served via electronic mail on Patent Owner's counsel of record at the following email addresses as indicated in Patent Owner's Amended Mandatory Notices, dated November 3, 2025:

jenhayes@nixonpeabody.com

dstringfield@nixonpeabody.com

tmaloney@nixonpeabody.com

achristopher@nixonpeabody.com

bholt@nixonpeabody.com

dgeorgiev@nixonpeabody.com .

DATED: May 29, 2026

By: /Jaysen S. Chung/

Jaysen S. Chung, Lead Counsel

Reg. Number: 68,199

Gibson, Dunn & Crutcher LLP

One Embarcadero Center, Suite 2600

San Francisco, CA 94111-3715

Tel: 415-393-8271

JSChung@gibsondunn.com

Counsel for Petitioner