

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RINGCONN LLC
Petitioner,

v.

OURARING, INC.,
Patent Owner

Case No. IPR2025-00412
U.S. Patent No. 11,868,178

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
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TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE MARCH 26, 2025 ACTING DIRECTOR’S MEMORANDUM	2
III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION	3
A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Discretionary Denial.....	4
1. Factor 1: Improbability of Motion to Stay in Advanced-Stage Parallel Litigation Favors Denial	5
2. Factor 2: The Target Date for Completion of the ITC Investigation Will Occur Nearly a Year Before a Final Written Decision in this Proceeding	6
3. Factor 3: The Parties’ Significant Investment in the Parallel ITC Investigation Favors Denial	7
4. Factor 4: Significant Overlap Between Issues Raised In The Petition and the ITC Investigation Favor Denial.....	11
5. Factor 5: The Delaware Litigation, the ITC Investigation, and The Petition Involve the Same Parties, which Favors Denial	12
6. Factor 6: Efficiency, Economy, and Integrity Favor Discretionary Denial	13
IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL	14
A. Petitioner Fails to Name All Real Parties-In-Interest	14
B. The ITC has Already Adjudicated the Claims to be Valid	15
C. Petitioner’s Unpatentability Challenge is Weak	17
D. The Timing of the Petition Suggests Undue Delay and Gamesmanship	19
E. The Board Should Reject Any Late <i>Sotera</i> Stipulation	20
F. Petitioner Should not be Able to Invoke the Same Grounds for Both the ITC Investigation and this Petition.....	21

TABLE OF CONTENTS
(continued)

Page

V. CONCLUSION.....22

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	<i>passim</i>
<i>AviaGames Inc. v. Skillz Platform Inc.</i> , IPR2022-00530, Paper 12 (P.T.A.B. Aug. 9, 2022).....	6
<i>BioRad Lab 'ys., Inc. v. 10X Genomics, Inc.</i> , IPR2019-00568, Paper 22 (P.T.A.B. Aug. 8, 2019).....	16, 17
<i>Code200 UAB et al. v. Bright Data, Ltd.</i> , IPR2022-00861, Paper 17 (P.T.A.B. July 25, 2022).....	1
<i>Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.</i> , IPR2020-00802, Paper 10 (P.T.A.B. Oct. 22, 2020).....	14
<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , 973 F.3d 1321 (Fed. Cir. 2020)	3
<i>Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).....	1
<i>Intel Corp. v. Koninklijke Philips NV</i> , IPR2021-00328, Paper 16 (P.T.A.B. Mar. 29, 2022)	7, 11
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....	4
<i>Satco Prods., Inc. v. The Regents of the Univ. of California</i> , IPR2021-00794, Paper 14 (P.T.A.B. Nov. 10, 2021).....	13
<i>SK Innovation Co., Ltd. et al. v. LG Chem, Ltd. et al.</i> , IPR2020-00992, Paper 14 (P.T.A.B. Nov. 30, 2020).....	5, 6
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	11, 12, 21, 22
<i>ZOLL Lifecor Corp. v. Philips Elecs. N. Am. Corp. et al.</i> , IPR2013-00609, Paper 15 (P.T.A.B. Mar. 20, 2014)	14, 15, 16

Statutes

35 U.S.C. § 312(a)(2).....14, 16
35 U.S.C. § 314(a)1, 3, 4
35 U.S.C. § 315(c)1, 3

Regulations

37 C.F.R. § 42.1(b)21

TABLE OF EXHIBITS

Exhibit No.	Description
2001	RESERVED
2002	RESERVED
2003	Order Granting RingConn’s Unopposed Motion to Stay, <i>Ouraring, Inc. v. RingConn LLC</i> , No. 1-24-cv-01020, Dkt. 11 (D. Del.), dated October 8, 2024
2004	Memorandum Order, <i>Oura Health Oy et al. v. Ultrahuman Healthcare Pvt., Ltd. et al.</i> , No. 2-23-cv-00396, Dkt. 37 (E.D. Tex.), dated August 2, 2024
2005	Order No. 9 Procedural Schedule, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated May 15, 2024
2006	Complainants Ouraring, Inc. and Oura Health Oy's Unopposed Motion for Partial Termination of the Investigation, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated November 25, 2024
2007	Respondents RingConn LLC, Shenzhen Ninenovo Technology Limited, Ultrahuman Healthcare Pvt. Ltd., Ultrahuman Healthcare Ltd., and Ultrahuman Healthcare SP, LLC's Notice of Prior Art, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated June 27, 2024
2008	RESERVED
2009	March 24, 2025 Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated March 24, 2025
2010	Respondents' Unopposed Motion for Leave to Amend the Exhibit List to Respondents' Pre-Hearing Statement to Add PTAB Decisions Granting Institution of PGR2024-00030 and IPR2024-00928, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated December 8, 2024

Exhibit No.	Description
2011	Respondents' Notice of Supplemental Authority regarding Post-Grant and Inter Partes Review, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated December 6, 2024
2012	Notice of Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated April 18, 2025
2013	Pre-Trial Conference and Evidentiary Hearing (Pages 1 – 287) (with excerpts), <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated December 11, 2024
2014	Respondents' Pre-Hearing Brief, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated November 12, 2024
2015	Response of Respondents RingConn LLC and Shenzhen Ninenovo Technology Limited to the Second Amended Complaint and Notice of Investigation, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated May 16, 2024
2016	Shenzhen Ninenovo Co Ltd- Company Details on ZAWYA, https://www.zawya.com/company/5083497313/ninenovo
2017	Complaint, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.) dated March 13, 2024
2018	Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, <i>Certain Smart Wearable Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-1398 (U.S.I.T.C.), dated April 18, 2025

Patent Owner Ouraring Inc. (“Patent Owner” or “Oura”) respectfully requests that the Board deny institution of the Petition filed by RingConn LLC (hereinafter “Petitioner” or “RingConn”) challenging the patentability of claims 1-18 (“challenged claims”) of U.S. Patent No. 11,868,178 (“the ’178 Patent”) (Ex. 1001).

I. INTRODUCTION

The validity of the ’178 patent was litigated in a parallel ITC Investigation over the course of the last year. The parties and the Commission expended significant resources in that Investigation. On April 18, 2025, the ALJ issued an Initial Determination finding all asserted claims of the ’178 patent valid. The Commission is set to conclude the investigation in less than four months (i.e., Aug. 18, 2025). Having failed on the validity challenge in the parallel ITC Investigation, the *same* petitioners that were party to the ITC Investigation now seek to challenge the validity of the *same* patent based on the *same* prior art references under the guise of joinder. The PTAB should deny Petitioner’s second bite at the apple.

Under 35 U.S.C. § 315(c), the statutory provision governing joinder, the discretion to join a party to an ongoing IPR (or, in this case, a PGR) is premised on the determination that the petition warrants institution under § 314. *Code200 UAB et al. v. Bright Data, Ltd.*, IPR2022-00861, Paper 17 at 10 (P.T.A.B. July 25, 2022). Here, application of the *Fintiv* factors under § 314(a) weighs heavily in favor of denial given the state of the parallel ITC Investigation where the same validity

challenges have already been adjudicated. The Board has discretion to deny institution under these circumstances to promote fairness and efficiency and manage its docket, potentially considering factors beyond the established frameworks. Instituting a PGR here would contradict the goal of such petitions as an “effective and efficient alternative” to litigation, particularly given the substantial overlap and the finite resources of the Board. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

Accordingly, the Board should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR’S MEMORANDUM

Pursuant to the Memorandum (“Memo”), which outlines “Interim Processes for PTAB Workload Management” including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. Consistent with the Notice Extending Deadline for Discretion Briefing dated March 28, 2025, this filing is being made within one month of the Notice (Paper 7).

The Memo outlines relevant considerations for discretionary denial:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;

- The strength of the unpatentability challenge;
- The extent of the petition’s reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director’s discretion.

Memo at 2-3.

As explained more fully below, denial is warranted under 35 U.S.C. § 314(a). Furthermore, additional considerations warrant discretionary denial. For example, Petitioner’s delay and timing in filing this Petition suggests improper gamesmanship in light of the ITC’s Initial Determination finding that claims 1, 2, and 12-14 of the ’178 Patent are not invalid. Thus the petition is ripe for discretionary denial in light of the Memo’s aim to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings,...and promote consistent application of discretionary considerations in the institution of AIA proceedings.” Memo at 3.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

“To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The Board first “determine[s] whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* Second, if the

petition warrants institution, then the Board “decide[s] whether to ‘join as a party’ the joinder applicant.” *Id.* Here, institution should be denied under §314.

First, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the parallel District Court litigations and ITC Investigation.

Second, additional Factors set forth in the “Interim Processes for PTAB Workload Management” Memo favor the Board denying the Petition using its discretion.

A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Discretionary Denial

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh in favor of denial due to the three parallel District Court Litigations and the parallel ITC Investigation. *See Ouraring, Inc. v. RingConn LLC*, No. 1-24-cv-01020 (D. Del.) (“Delaware Litigation”); *Samsung Electronics Co., Ltd. et al. v. Oura Health OY et al.*, No. 3-24-cv-03245 (N.D. Cal.) (“California Litigation”); *Oura Health Oy et al. v. Ultrahuman Healthcare Pvt., Ltd. et al.*, No. 2-23-cv-00396 (E.D. Tex.) (“Texas Litigation”); *Certain Smart Wearable Devices, Systems, and Components Thereof*, Inv. No. 337-TA-1398 (U.S.I.T.C.) (“ITC Investigation”). Institution would be inconsistent with the AIA’s goal of

providing an “effective and efficient alternative” where, as here, the ITC has *already adjudicated* the same core validity issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018). As the March 24, 2025 guidance memo explains, “although an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that the ITC has determined are invalid.” Ex. 2009 at 2.

1. Factor 1: Improbability of Motion to Stay in Advanced-Stage Parallel Litigation Favors Denial

Although the Delaware Litigation has been statutorily stayed pending final resolution of the ITC Investigation (Ex. 2003), Petitioner RingConn never sought to stay the ITC Investigation. Accordingly, the ITC Investigation is nearly complete, and a Final Initial Determination finding claims 1, 2, and 12-14 valid was issued on April 18, 2025. Ex. 2012 at 1. The expected Target date for Investigation completion is August 18, 2025, well before the projected Final Written Decision in this proceeding. Ex. 2005 at 3. A stay is unlikely in the ITC Investigation given the fact that the Evidentiary Hearing and post-hearing briefing is complete, with only a Final Determination outstanding (*Id.*). And any non-binding authority of the ITC to invalidate the '178 Patent is of no consequence to the *Fintiv* analysis. *See SK Innovation Co., Ltd. et al. v. LG Chem, Ltd. et al.*, IPR2020-00992, Paper 14 at 11 (P.T.A.B. Nov. 30, 2020) (denying institution noting that Factor 1 at least slightly

favors denial even where same patent was not asserted in an advanced-stage parallel ITC Investigation). Accordingly, Factor 1 weighs in favor of denying institution. *See id.*

2. Factor 2: The Target Date for Completion of the ITC Investigation Will Occur Nearly a Year Before a Final Written Decision in this Proceeding

The Evidentiary Hearing in the ITC Investigation ended last year. Ex. 2005 at 3. Moreover, the ITC’s Final Initial Determination issued on April 18, 2025, over a year before the Board would issue a Final Written Decision in this proceeding. Ex. 2012. Since the ITC has “completed its consideration of the [’178] patent, . . . this factor weighs heavily in favor of denying institution.” *See AviaGames Inc. v. Skillz Platform Inc.*, IPR2022-00530, Paper 12 at 12-13 (P.T.A.B. Aug. 9, 2022); *see also SK Innovation*, IPR2020-00992, Paper 14 at 13; *see also* Ex. 2009 at 2 (“the Board is more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision”).

To the extent that Petitioner attempts to rely on the stayed District Court cases, “[t]he eventual effect of the stayed district court proceedings will be determined by the resolution of the ITC investigation, such that” the Board should not be “persuaded that the stayed proceeding has much effect on [its] exercise of discretion in this proceeding.” *See Intel Corp. v. Koninklijke Philips NV*, IPR2021-00328, Paper 16 at 6 (P.T.A.B. Mar. 29, 2022).

3. Factor 3: The Parties' Significant Investment in the Parallel ITC Investigation Favors Denial

The parties' and the Commission's investment in the parallel ITC Investigation weighs heavily in favor of discretionary denial. Since the Complaint was filed more than a year ago with the ITC on March 13, 2024, significant activity has occurred before the Commission. Petitioner waited until the ITC Investigation was nearly complete to file the Petition, allowing considerable litigation activity to proceed in the interim.

The substantial work and investment by the parties and the Commission before the anticipated Final Initial Determination deadline is demonstrated by the following completed milestones in line with the Procedural Schedule:

- monthly case management conferences between June 2024 and November 2024;
- notice of prior art filed by June 27, 2024;
- identification of expert witnesses filed by June 28, 2024;
- initial burden contention interrogatory responses exchanged by June 28, 2024;
- list of claim terms to be construed exchanged by July 3, 2024;
- proposed constructions for all terms on all lists exchanged by private parties by July 9, 2024;

- proposed constructions for all terms on all lists exchanged by Staff by July 12, 2024;
- initial non-burden contention interrogatory responses exchanged by July 17, 2024;
- chart of agreed and disputed constructions filed by July 19, 2024
- opening claim construction briefs filed by private parties by July 26, 2024;
- opening claim construction brief filed by Staff by August 2, 2024;
- tentative list of witnesses who will be called to testify at the hearing filed by August 1, 2024;
- responsive claim construction briefs filed by August 9, 2024;
- claim construction hearing on August 15, 2024;
- final burden contention interrogatory responses exchanged by August 21, 2024;
- final non-burden contention interrogatory responses exchanged by August 30, 2024;
- fact discovery cutoff and completion by September 5, 2024;
- motions to compel discovery filed by September 6, 2024;
- initial expert reports exchanged by September 6, 2024;
- rebuttal expert reports exchanged by September 27, 2024;
- summary determination motions filed by October 11, 2024;

- completing one-day mediation session completed by October 15, 2024;
- joint report on mediation submitted 14 days after mediation;
- expert discovery cutoff and completion by October 21, 2024;
- exhibit lists exchanged among the parties by October 23, 2024;
- proposed direct exhibits served and physical exhibits identified by private parties by October 30, 2024;
- proposed direct exhibits served and physical exhibits identified by Staff by November 6, 2024;
- proposed rebuttal exhibits served and rebuttal physical exhibits identified by November 6, 2024;
- pre-hearing statements and briefs filed by private parties by November 12, 2024;
- motions in *limine* filed by November 19, 2024;
- pre-trial statement and brief filed by Staff by November 22, 2024;
- joint list of unopposed exhibits filed by November 26, 2024;
- responses to motions in *limine* filed by November 26, 2024;
- prepared demonstrative exhibits exchanged by December 10, 2024;
- final pre-hearing conference on December 11, 2024;
- evidentiary hearing from December 11 to December 17, 2024;
- final exhibit list filed by December 23, 2024;

- initial post-hearing briefs and final exhibits submitted by private parties by January 7, 2025;
- initial post-hearing brief filed by Staff by January 13, 2025;
- responsive post-hearing briefs filed by private parties by January 17, 2025;
- responsive post-hearing brief filed by Staff by January 24, 2025;
- final determination on violation finding claims 1, 2, and 12-14 to not be invalid issued on April 18, 2025.

See Ex. 2005. This extensive activity clearly shows a significant investment by both the parties and the Commission. The *Fintiv* analysis for Factor 3 requires assessing this investment as of the date the Institution Decision is anticipated (by July 29, 2025). By that date, the Investigation will be nearly complete, with only the Target date for completion of the investigation outstanding in the Procedural Schedule. *See id.* Additionally, the earlier stages of the stayed District Court litigations hold no weight in the analysis of this factor because “the ITC investigation is the relevant proceeding to consider in determining whether a stay has or will be issued.” *See Intel Corp.*, IPR2021-00328, Paper 16 at 4. “[T]he Board is more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision...” Ex. 2009 at 2.

The third *Fintiv* Factor weighs strongly against institution.

4. Factor 4: Significant Overlap Between Issues Raised In The Petition and the ITC Investigation Favor Denial

The issues in this proceeding are substantially the same as in the ITC Investigation. Here, Petitioner asserts that Claims 1-18 of the '178 Patent are unpatentable (Pet. at 16). These claims cover and expand upon the claims asserted by Patent Owner against Petitioner in the ITC Investigation (claims 1, 2, and 12-14). Ex. 2006 at 2. Furthermore, Petitioner relies on exactly the same prior art in supporting its Petition that it relied on to challenge the validity of the '178 Patent in the ITC Investigation. These references are explicitly listed in Petitioner's (as Respondent RingConn) own Notice of Prior Art filed in the ITC Investigation on June 27, 2024. Ex. 2007 at 4-5, 7, 9 (citing Yuen, Schröder, Niwa, and Mestas as prior art against the '178 Patent).

Petitioner's failure to make a *Sotera* stipulation also weighs heavily against institution. As the Board recognized in *Sotera*, such stipulations mitigate concerns regarding potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020). Contrary to making a *Sotera* stipulation, Petitioner, by challenging validity here while litigating in parallel without such a stipulation, is pursuing the same or similar invalidity defenses using overlapping prior art in this proceeding and the ITC Investigation. This is even more concerning

in view of the impending close of the ITC Investigation. Petitioner is boldly seeking a second bite at the apple because their invalidity arguments failed to pan out in front of the Commission. This drastically undermines the goals of efficiency and an IPR being an inexpensive alternative to litigation.

Given that the Petition is directed toward the same patent, encompasses the claims at issue in the parallel ITC Investigation, and involves overlapping prior art and arguments, and since Petitioner has not sought to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation, this factor strongly favors denial of institution.

5. Factor 5: The Delaware Litigation, the ITC Investigation, and The Petition Involve the Same Parties, which Favors Denial

As noted in Patent Owner's Mandatory Notice (Paper 5), there exists both a parallel Delaware Litigation and a parallel ITC Investigation between the same parties regarding the same subject patent (the '178 Patent). Petitioner and its parent (and unnamed Real Party-in-Interest) Shenzhen Ninenovo Technology Limited is party to the ITC Investigation and Petitioner is a party to the Delaware Litigation. Accordingly, this Factor weighs in favor of discretionary denial. *See Fintiv*, Paper 11 at 14.

6. Factor 6: Efficiency, Economy, and Integrity Favor Discretionary Denial

Petitioner waited to file this IPR until after seeing how its arguments played out before the Administrative Law Judge in the ITC Investigation. This delay suggests tactical gamesmanship. As recognized in the Memo regarding discretionary denials, such considerations regarding case management, efficient use of resources, and potential abuse of process may be relevant to the denial analysis and weigh against institution here. Moreover, “principles of efficiency and economy favor avoiding further duplication of effort by the . . . ITC.” *See Satco Prods., Inc. v. The Regents of the Univ. of California*, IPR2021-00794, Paper 14 at 29-30 (P.T.A.B. Nov. 10, 2021) (denying institution by finding Factor 6 weighs against institution when the ITC will address the validity of patents at issue). “Indeed, institution of a trial testing patentability of claims [1-18 of the ’178 Patent] in this forum may duplicate the ITC’s investigation, and thus would not ‘serve the interest of overall system efficiency and integrity’—a concern that factor 6 addresses.” *See Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2020-00802, Paper 10 at 17 (P.T.A.B. Oct. 22, 2020) (citing *Fintiv*, Paper 11 at 15). The ITC has already found claims 1, 2, and 12-14 to not be invalid. Ex. 2012 at 1. This Factor favors denial.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established framework of *Fintiv*, the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Several such considerations further support denying institution here.

A. Petitioner Fails to Name All Real Parties-In-Interest

This Petition “may be considered only if . . . the petition identifies all real parties in interest[.]” 35 U.S.C. § 312(a)(2). “[T]he real party-in-interest is the party that desires review of the patent.” *ZOLL Lifecor Corp. v. Philips Elecs. N. Am. Corp. et al.*, IPR2013-00609, Paper 15 at 10 (P.T.A.B. Mar. 20, 2014) (citing 77 Fed. Reg. 48,688, 48,759 (Aug. 14, 2012)). Factors for determining whether a non-party is a real party-in-interest, which is based on a consideration of control, include:

existence of a financially controlling interest in the petitioner[,] . . . the non-party’s relationship with the petitioner; the non-party’s relationship to the petition itself, including the nature and/or degree of involvement in the filing; and the nature of the entity filing the petition.

Id.

Petitioner RingConn “admits that Shenzhen Ninenovo Technology Limited is the parent corporation of RingConn LLC.” Ex. 2015 at 5 ¶ 19. RingConn and Shenzhen Ninenovo Technology Limited have acted together, with the same counsel, in the ITC Investigation. *See id.* at 2 (naming Respondents RingConn LLC

and Shenzhen Ninenovo Technology Limited collectively as “RingConn”), 31 (showing the same counsel for Respondents RingConn LLC and Shenzhen Ninenovo Technology Limited). In so doing, RingConn and Shenzhen Ninenovo Technology Limited have together alleged that the claims of the ’178 Patent are invalid, as RingConn does in its Petition here. *Id.* at 21 ¶ 2. Moreover, RingConn LLC and Shenzhen Ninenovo Technology Limited share the same CEO. *Id.* at 32. And Shenzhen Ninenovo Technology Limited’s “main product is the smart wearable device RingConn,” Ex. 2016 at 1, which is the same product accused of infringing the ’178 Patent in the ITC Investigation. Ex. 2017 at 5, 13. RingConn’s interests are aligned with Shenzhen Ninenovo Technology Limited and their relationship is so close that Petitioner and Shenzhen Ninenovo Technology Limited “should enjoy the benefits, as well as the burden, of being in privity for purposes of *inter partes* review proceedings.” *See* ZOLL, IPR2013-00609, Paper 15 at 14. Thus, Petitioner should have listed Shenzhen Ninenovo Technology Limited as a Real Party-in-Interest in this Petition. Because it did not, the Petition should be denied. *See* 35 U.S.C. § 312(a)(2).

B. The ITC has Already Adjudicated the Claims to be Valid

On April 18, 2025, the ITC issued a notice of its Initial Determination, finding that “[c]laims 1, 2, and 12-14 of the ’178 patent have not been shown to be invalid.” Ex. 2012 at 1. This “status of the ITC proceeding provides a favorable basis for

denying the Petition.” *See BioRad Lab’ys., Inc. v. 10X Genomics, Inc.*, IPR2019-00568, Paper 22 at 23-24 (P.T.A.B. Aug. 8, 2019) (denying institution where the ITC issued its Initial Determination before institution, highlighting the relevance of “events in other proceeding related to the same patent, either at the Office, in district courts, or the ITC[]” to “the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings”).

Like *BioRad*, “the ITC proceeding involves . . . the same parties here,” *Ouraring Inc. and RingConn LLC. See id.* at 24. The same independent claim of the ’178 Patent that the ITC found was not invalid is challenged here. *See id.* The ITC considered “the same prior art set forth in the grounds presented in the Petition.” *See id.*; Ex. 2013 at 75:15-17 (“Schroder and Niwa. The same references that we are going to be dealing with here when it comes to invalidity.”); Ex. 2014 at 173 (“Respondents continue to assert at least Niwa, Schröder, and Yuen against the remaining claims of the ’178 Patent at-issue here.”). Moreover, the ITC has already made a determination of no invalidity based on a detailed analysis of the same prior art and arguments. *See Ex. 2018 at 104-107* (analyzing the disclosure of Schröder to find that “evidence supports that one of skill would understand that Schröder’s battery . . . would be placed adjacent to the chip module 10 in Fig. 3 of Schröder and not within the inlay of Fig. 4”). The ITC’s determination considered both an

overview of Schröder and the specific teachings of Schröder regarding the limitations of claim 1. *Id.* at 99-107. And like *BioRad*, in view of “the ALJ’s recent issuance of the ID analyzing and discussing the teachings of that prior art and the [expert’s] testimony, . . . instituting a trial would be an inefficient use of Board resources.” *See BioRad*, IPR2019-00568, Paper 22 at 23-24 (explaining that “the ALJ provides an analysis of [the prior art] teachings and testimony with respect to independent claim”). Thus, the Petition should be denied.

C. Petitioner’s Unpatentability Challenge is Weak

The Memo notes that “[t]he strength of the unpatentability challenge” may be considered. Memo at 2. The Petition is weak, lending to denial, because it fails to set forth a basis of unpatentability for at least one limitation of claim 1 of the ’178 Patent. As one example, the Petition provides merely a nominal assertion that Schröder (Ex. 1007) teaches:

a battery positioned within a cavity formed between the internal housing component and the external housing component, wherein the battery comprises a shape and size configured to fit within the cavity between the outer circumferential surface of the external housing component and the inner circumferential surface of the internal housing component, and wherein the battery extends through at least a first portion of the cavity of the finger-worn wearable ring device,

as required by claim 1. *See Pet.* at 33-34. Claim 1 requires a specific configuration of the battery, where it is positioned in a specific location and has a required “shape

and size.” The Petition attempts to sweep all these requirements of the battery under a vague umbrella by relying only on Schröder’s brief discussion of a battery connected to a chip module 10. *See id.*; *see also* Ex. 1007 at 11:46-67. Nowhere does Schröder teach or suggest that its battery is positioned within a cavity or that it has a shape or size configured to fit within that cavity. And nowhere does Schröder provide a motivation to position, shape, or size its battery in this way. Ignoring this, the Petition broadly asserts that “[i]t would have been obvious that because the energy storage unit (i.e., battery) powers chip module 10 and chip module 10 resides in inlay 12, the battery is also positioned inside the ring.” Pet. at 34. If such unsupported assertions are allowed, then any petitioner could claim that it would have been obvious to position any specific component of a claimed device in a claimed location merely because another component is also positioned there.

The ITC agreed that Petitioner’s challenge is weak, finding that claims 1, 2, and 12-14 of the ’178 Patent have not shown to be invalid by Petitioner in view of the same prior art. *See* Ex. 2018 at 81 (relying on Schröder to invalidate the claims), 130. Specifically, the ITC rejected Petitioner’s argument—the same one made in this Petition—that Schröder teaches the “a battery positioned within a cavity . . .” limitation. *Id.* at 104-107. In doing so, the ITC declared that the “evidence supports that one of skill would understand that Schröder’s battery . . . would be placed adjacent to the chip module 10 in Fig. 3 of Schroder and ***not within the inlay of Fig.***

4.” *Id.* at 105 (emphasis added). The ITC considered Schröder’s disclosure and Petitioner’s expert testimony in coming to this conclusion. *Id.* at 104-105 (noting that “there is no disclosure in Schröder that the battery is disposed in the inlay embodiment of Fig. 4” and that the expert’s “testimony was improperly guided by hindsight”). That is, the ITC has rejected the exact same argument based on the exact same prior art that Petitioner advances here. And yet, Petitioner demands that the Board and parties expend their time and resources on a position that was already tested and failed. This Petition, riddled with such weak challenges, should be denied.

Moreover, because the ITC determined Claims 1-2, and 12-14 to be valid, Petitioner’s challenges to Claims 3-11, 15-18 are similarly weak because they are dependent on valid claims.

D. The Timing of the Petition Suggests Undue Delay and Gamesmanship

The Memo permits consideration of factors bearing on the efficient use of PTAB resources and potential abuse of process. Here, Petitioner waited to file this Petition until after the Evidentiary Hearing in the ITC Investigation. Petitioner received notice of the ’178 Patent at least as early as March 13, 2024, when Patent Owner first filed its Complaint in the ITC Investigation. Yet, Petitioner waited until after contentions were exchanged, discovery was complete, pre-hearing briefs were submitted, an entire evidentiary hearing was conducted, and even post-hearing briefs

were submitted in that ITC Investigation to file this Petition. That is, Petitioner used the advantage of multiple phases of litigation activity in the ITC Investigation to file this Petition on a patent it has known about for nearly a whole year. Such a lengthy and unexplained delay strongly suggests tactical gamesmanship aimed at disrupting the ITC Investigation and the stayed District Court cases rather than seeking an efficient alternative to litigation early in the dispute. This weighs in favor of discretionary denial.

E. The Board Should Reject Any Late *Sotera* Stipulation

Petitioner has not made a *Sotera*-style stipulation—that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR”—in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera*, IPR2020-01019, Paper 12 at 13-14. The Board should not accept any late *Sotera* stipulation potentially offered after this Request for Discretionary Denial. Any withholding of the *Sotera* stipulation in the Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)’s mandate to “secure the just, speedy, and inexpensive resolution of every proceeding.” Indeed, Petitioner’s gamesmanship in this regard prejudices Patent Owner because Patent Owner is forced to prepare overlapping validity defenses in the District Court litigations and this proceeding throughout the pendency of this Petition.

Additionally, on February 28, 2025, the Office *rescinded* former Director Vidal’s 2022 memorandum on discretionary denials which placed significant weight on such stipulations. The announcement rescinding former Director Vidal’s 2022 memorandum went on to state that decisions relying on the 2022 memo will be neither “*binding or persuasive on the PTAB.*” On March 24, 2025, the Office released a memo providing guidance following the rescission of Director Vidal’s 2022 memo. That memo provided that a *Sotera* stipulation would be “not dispositive by itself.” Ex. 2009 at 2-3. Petitioner’s failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Patent Owner. In view of the above and in the event the Petitioner files a late *Sotera* stipulation, the stipulation should not be considered persuasive.

F. Petitioner Should not be Able to Invoke the Same Grounds for Both the ITC Investigation and this Petition

This Petition should not be instituted because it is identical to a Post-Grant Review petition that Petitioner attempted to introduce as evidence relevant to invalidity in the ITC Investigation. Specifically, this Petition “is substantively identical to Grounds 1-4 of the petition in the Samsung PGR” No. PGR2024-00030 “and relies upon the same expert declaration as relied upon in the Samsung PGR[.]” Paper 2 (Petitioner’s Motion for Joinder) at 2-3. This “Petition does not assert any new grounds of unpatentability.” *Id.* at 6 (admitting that this Petition “challenges the

same claims (1-18) of the ‘178 patent based on the same arguments, evidence, and grounds of unpatentability as Grounds 1-4 of the Samsung PGR”).

In the ITC Investigation, Petitioner, as Respondent, moved to add the Institution Decision of that very same Samsung PGR to their exhibit list. Ex. 2010 at 1. In doing so, Petitioner asserted that the Institution Decision is “relevant to the parties’ invalidity arguments as raised in Respondents’ Pre-Hearing Brief.” Ex. 2011 at 1. That is, Petitioner insisted that the Samsung PGR—and accordingly, this identical Petition—was relevant to the invalidity grounds of the ITC Investigation. Now, Petitioner turns around and argues that the Board should not exercise its discretion to deny institution of this Petition under *Fintiv*. Pet. at 84-85. By making these volte-face assertions in different forums, Petitioner attempts to have it all: include their invalidity grounds in the ITC Investigation *and* run a separate *inter partes* review on those same grounds. This flies in the face of *Fintiv*’s concerns over efficiency and fairness. *See Fintiv*, Paper 11 at 5. Thus, this Petition should be denied.

These additional factors, highlighted by recent USPTO guidance, provide further independent bases for the Director to exercise discretion and deny institution of this IPR petition.

V. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: April 28, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(d)

I hereby certify that the foregoing Brief in Support of Patent Owner's Request for Discretionary Denial contains 4,931 words as measured by the word-processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24(d).

Dated: April 28, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 28, 2025, I caused a true and correct copy of the Brief in Support of Patent Owner's Request for Discretionary Denial to be served via email to the following address:

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