

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

WHOOP, INC.

Petitioner,

v.

OMNI MEDSCI, INC.,  
Patent Owner.

Patent No. 11,160,455

---

Case No. IPR2025-01585

---

**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

**TABLE OF CONTENTS**

I. INTRODUCTION .....1

II. THE *GENERAL PLASTIC* FACTORS STRONGLY FAVOR DISCRETIONARY DENIAL .....3

    A. The Petition Used the Prior IPRs as a Roadmap.....5

    B. Petitioner Unjustifiably Delayed Filing the Petition.....6

    C. The Board Should Not Expend its Finite Resources on Multiple IPRs for the Same Patent.....7

III. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL .....8

    A. Factor 1 is Neutral or Weighs Against Institution .....9

    B. Factor 2 Weighs Against Institution .....10

    C. Factor 3 Weighs Against Institution .....11

    D. Factor 4 Weighs Against Institution .....12

    E. Factor 5 Weighs Against Institution .....13

    F. Factor 6 Weighs Against Institution or is Neutral .....13

IV. THE DIRECTOR SHOULD DENY INSTITUTION UNDER § 325(D) ....17

    A. Petitioner’s References Were Previously Considered .....17

    B. Petitioner Fails to Show Any Material Error .....19

V. THE DELAWARE CASE WILL MOST EFFICIENTLY RESOLVE THE PARTIES’ ENTIRE DISPUTE .....19

VI. CONCLUSION.....20

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GmbH,</i> IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	17
<i>Amazon Web Services, Inc. v. Croga Innovations, Ltd.,</i> IPR2025-00884, Paper 9 (PTAB Sept. 3, 2025).....	6
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 15 (PTAB May 13, 2020) .....	11
<i>Apple Inc. v. Koss Corp.,</i> IPR2022-00053, Paper 10 (PTAB Apr. 4, 2022) .....	7
<i>Becton, Dickinson &amp; Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) .....	18
<i>Dr. Reddy’s Lab’ys., Ltd. v. Monosol RX, LLC,</i> IPR2016-01111, Paper 14 (PTAB Dec. 5, 2016) .....	14
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.,</i> IPR2024-01280, Paper 13 (PTAB May 19, 2025) .....	18, 19
<i>Ericsson Inc. v. Uniloc 2017, LLC,</i> IPR2019-01550, Paper 8 (PTAB Mar. 17, 2020) .....	6
<i>General Plastic Co., Ltd. v. Canon Kabushiki Kaisha,</i> IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).....	<i>passim</i>
<i>Google LLC v. Hammond Dev. Int’l, Inc.,</i> 54 F.4th 1377 (Fed. Cir. 2022) .....	16

<i>MaxLinear, Inc. v. CF CRESPE LLC</i> , 880 F.3d 1373 (Fed. Cir. 2018) .....	14
<i>Motorola Sols., Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025) .....	13
<i>NetApp, Inc. v. Realtime Data LLC</i> , IPR2017-01196, Paper 9 (PTAB Oct. 12, 2017) .....	6
<i>Nichia Corp. v. Document Sec. Sys.</i> , IPR2019-00398, Paper 10 (PTAB Apr. 15, 2019) .....	8
<i>Ohio Willow Wood Co. v. Alps S., LLC</i> , 735 F.3d 1333 (Fed. Cir. 2013) .....	16
<i>Palo Alto Networks, Inc. v. Centripetal Networks, Inc.</i> , IPR2021-01153, Paper 10 (PTAB Jan. 24, 2022) .....	13
<i>Papst Licensing GmbH &amp; Co. KG v. Samsung Electronics Am., Inc.</i> 924 F.3d 1243 (Fed. Cir. 2019) .....	16
<i>POSCO Co., Ltd. v. ArcelorMittal</i> , IPR2025-00370, Paper 10 (PTAB June 25, 2025) .....	16
<i>Samsung Elecs. Co. v. Elm 3DS Innovations, LLC</i> , IPR2017-01305, Paper 11 (PTAB Oct. 17, 2017) .....	6
<i>Samsung Electronics Co., Ltd., v. Iron Oak Techs., LLC</i> , IPR2018-01554, Paper 9 (PTAB Feb. 13, 2019) .....	5
<i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , IPR2025-00002, Paper 17 (PTAB May 17, 2025) .....	15, 16
<i>Samsung Elecs. Co., Ltd., v. Sionyx, LLC</i> , IPR2025-00064, Paper 16 (PTAB June 6, 2025) .....	10, 17
<i>Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC</i> , 778 F.3d 1311 (Fed. Cir. 2015) .....	16

*United Therapeutics Corp. v. Liquidia Techs., Inc.*,  
74 F.4th 1360 (Fed. Cir. 2023) .....15

**Regulations**

37 C.F.R. § 42.122 .....8

**Statutes**

35 U.S.C. § 325 .....17

**LISTING OF EXHIBITS**

<b>Exhibit No.</b>	<b>Description</b>
2001-2015	Reserved
2016	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00912, Paper 1 (PTAB Apr. 10, 2019)
2017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00913, Paper 1 (PTAB Apr. 10, 2019)
2018	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00914, Paper 1 (PTAB Apr. 10, 2019)
2019	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00915, Paper 1 (PTAB Apr. 10, 2019)
2020	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00029, Paper 1 (PTAB Oct. 17, 2019)
2021	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2020-00175, Paper 1 (PTAB Dec. 11, 2019)
2022	Defendant’s Invalidation Contentions, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2: 18-cv-00134 (E.D. Tex.) (Aug. 28, 2018)
2023	Defendant’s Invalidation Contentions - Exhibit A, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2024	Defendant’s Invalidation Contentions - Exhibit N, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug. 28, 2018)
2025	Defendant’s Invalidation Contentions - Exhibit P, <i>Omni MedSci, Inc. v. Apple Inc.</i> , Case No. 2:18-cv-134-RWS (E.D. Tex.) (Aug.

Exhibit No.	Description
	28, 2018)
2026-2029	Reserved
2030	Reserved
2031	First Amended Complaint, <i>Omni MedSci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (May 5, 2025)
2032	Complaint, <i>Omni MedSci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (Feb. 3, 2025)
2033	Defendant Whoop, Inc.'s Motion to Stay Pending Inter Partes and Post Grant Review, <i>Omni MedSci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (October 22, 2025)
2034	Scheduling Order, <i>Omni MedSci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (November 10, 2025)
2035	Transcript of Case Scheduling Hearing Conducted on October 24, 2025, <i>Omni MedSci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.).
2036-2039	Reserved
2040	Complaint, <i>Cheetah Omni, LLC V. Whoop, Inc.</i> , 6:23-cv-478 (W.D. Tex.) (June 30, 2023)
2041	Reserved
2042	Plaintiff's Answering Brief in Opposition to Defendant's Motion To Stay Pending Inter Partes and Post Grant Review, <i>Omni Medsci, Inc. v. Whoop, Inc.</i> , No. 1:25-cv-00140 (D. Del.)

<b>Exhibit No.</b>	<b>Description</b>
	(November 5, 2025)
2043	Docket Navigator Statistics for United States Circuit Judge William C. Bryson, Pre-Institution Stay Requests
2044	Defendant's Answer to First Amended Complaint for Patent Infringement, <i>Omni Medsci, Inc. v. Whoop, Inc.</i> , No. 1:25-Cv-00140 (D. Del.) (Sept. 29, 2025)

Pursuant to the March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management” (“Memo”), Patent Owner Omni MedSci, Inc. (“Patent Owner”) respectfully requests that the Director exercise his discretion and deny institution of the Petition (Paper 1) challenging claims 1-20 of U.S. Patent No. 11,160,455 (“the ’455 Patent”).

## **I. INTRODUCTION**

Patent Owner respectfully submits that the Director should discretionarily deny the Petition for four reasons. First, this is the second petition challenging the ’455 Patent and reuses substantially the same prior art and arguments as the first IPR and prior IPRs challenging related patents. While Petitioner was not involved in the prior proceedings, given the overlapping prior art and arguments, it clear that Petitioner used them as a roadmap for this Petition. Petitioner offers no justification for why it waited over 7 months after being sued for infringement to file this follow-on petition. The Board should decline Petitioner’s invitation to use its finite resources for multiple IPRs of the same patent.

Second, the parties are engaged in litigation involving the ’533 Patent in *Omni MedSci, Inc. v. Whoop, Inc.*, Case No. 1:25-cv-00140-WCB, in the District Court of Delaware (“the Delaware Case”). The factors in the Board’s precedential *Fintiv* decision weigh in favor of denying institution in view of the advanced stage of the Delaware Case. By the time the Board issues its institution decision, the parties will

have exchanged infringement and invalidity contentions, be deep into fact discovery, have identified claim-construction disputes, and will be only days away from claim-construction briefing deadlines. Most importantly, the jury trial in the Delaware Case is scheduled to occur at approximately the same time as the Board’s projected deadline for issuing a Final Written Decision (“FWD”). Petitioner offers no *Sotera stipulation*, underscoring the inefficiency of parallel proceedings.

Third, the Director should deny institution under § 325(d) because Petitioner asserts the same or substantially the same art that was presented and considered during prosecution of the ’455 Patent, with no showing of any material error by the Office. Indeed, the same or similar art had been asserted against related patents in multiple IPRs and district court litigation, and those arguments were cited and considered by the Examiner during prosecution.

Fourth, the Delaware Case also concerns three other patents. This Petition is one of four filed by Petitioner challenging 53 claims across these patents even though only 28 are asserted in the Delaware Case:

<b>Case No.</b>	<b>Patent No.</b>	<b>Institution Deadline</b>
IPR2025-01583	9,651,533	April 6, 2026
IPR2025-01584	10,874,304	April 6, 2026
<b><i>IPR2025-01585</i></b>	<b><i>11,160,455</i></b>	<b><i>April 6, 2026</i></b>
PGR2026-00003	12,193,790	April 22, 2026

The Director should deny these petitions because it would be more efficient to resolve the parties disputes in the Delaware Case than before the Board.

**II. THE *GENERAL PLASTIC* FACTORS STRONGLY FAVOR DISCRETIONARY DENIAL**

The Director should deny the Petition because it is a follow-on petition that reuses the same prior art (Lisogurski, Carlson, and Tran) and challenges the same claims as another previously filed IPR.

Case No.	Filing Date	Claims	Alleged Prior Art	Status
IPR2025-01252 (“First ’455 IPR”)	8/5/2025	1-20	Lisogurski, Carlson, LeBoeuf, Tran	Pending
IPR2025-01585 (“Second ’455 IPR”)	9/26/2025	1-20	Lisogurski, Carlson, Tran, Soller, Valencell- 093	Pending

The Petition also relies on and reuses arguments from prior IPRs challenging related U.S. Patent Nos. 9,651,533 (“the ‘533 Patent”) and 10,517,484 (“the ’484 Patent”). Pet., 1-6; EX1008; EX1013.

Patent	Petitioner	Case No.	Alleged Prior Art
‘533 Patent	Apple	IPR2019-00916 (“Apple ‘533 IPR”)	Lisogurski and Carlson
‘484 Patent	Apple	IPR2021-00453 (“Apple ‘484 IPR”)	Lisogurski, Carlson, Tran, Valencell-093

The Board considers the following factors in exercising its discretion to deny “follow-on” petitions repeatedly challenging the same patent:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known

- of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
  4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
  5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
  6. the finite resources of the Board; and
  7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

*General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 9-10, 18 (PTAB Sept. 6, 2017) (precedential). Where a follow-on petition is filed by a different petitioner, the Board considers additional factors, including:

8. whether there may be potential prejudice to the subsequent petitioner if institution is denied and the pending instituted proceedings involving the first petitioner are terminated; and
9. whether multiple petitions filed against the same patent is a direct result of Patent Owner's litigation activity.

*Samsung Electronics Co., Ltd., v. Iron Oak Techs., LLC*, IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019). As discussed below, these factors favor denial of this follow-on Petition.

### **A. The Petition Used the Prior IPRs as a Roadmap**

This Petition is a follow-on challenge that reuses substantially the same prior art and grounds as prior IPRs rather than presenting a new challenge of unpatentability. The First '455 IPR challenges the same claims as this Petition using Lisogurski, Carlson, and Tran. *Compare* Petition, 9-11, 20-28; EX1052, 6-7, 18-21 (First '455 IPR Petition). As another example, the Apple '533 IPR and Apple '484 IPR challenged related patents based on Lisogurski, Carlson, Tran, and Valencell-093. EX1015, 20-26; EX1021, 21, 58, 72.

Petitioner developed its challenge to the '455 Patent by using these prior IPRs as a roadmap. The Petition relies on the same references (Lisogurski, Carlson, and Tam) that were used in the First '455 IPR, the Apple '533 IPR, and the Apple '484 IPR in the same or substantially the same way. The Petition also cites to and relies on the parties' arguments and the Board's findings in the Apple IPRs to support its challenge. Pet., 13-14, 20-21, 26 (citing EX1015; EX1017; EX1018; EX1008). In fact, Petitioner acknowledges that it simply "adopted" the technical background section from the Apple IPRs. Pet., 13-14. Petitioner has not independently developed new grounds based on different art or an untested theory.

While Petitioner did not file the previous IPRs, the Board has applied the *General Plastic* factors to follow-on petitions filed by “unrelated” petitioners where, as here, the later petitioner used prior petitions as a roadmap. *See, e.g., Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, IPR2025-00884, Paper 9 at 2 (PTAB Sept. 3, 2025) (discretionarily denying fourth IPR challenging the same patent based on “concerns of roadmap[ing]”); *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 12 (PTAB Mar. 17, 2020) (denying follow-on petition filed by unrelated petitioner because its “decision to use the prior petitions as a roadmap for its own petition ties the interests of all the petitioners together”); *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2017-01305, Paper 11 at 19 (PTAB Oct. 17, 2017) (denying follow-on petition filed by unrelated petitioner based on “the high degree of similarity of ... [the] Petition with the prior petitions”); *NetApp, Inc. v. Realtime Data LLC*, IPR2017-01196, Paper 9 (PTAB Oct. 12, 2017) (denying institution under *General Plastic* where petitioner had not previously filed its own petition).

The Director should reject Petitioner's request for the Board to devote additional resources to multiple IPRs for the same patent.

### **B. Petitioner Unjustifiably Delayed Filing the Petition**

The timing of the Petition further confirms that it is a mere follow-on rather than a diligent effort to seek review. The prior assignee of the '455 patent, Cheetah Omni, LLC, sued Petitioner for infringement of related '868 Patent in June 2023 in

the Western District of Texas, which put Petitioner on notice of Patent Owner's wearable sensor technology and patent portfolio (including the '455 Patent, which issued in 2021). EX2040, 2-8. At a minimum, Petitioner has had knowledge of the '455 Patent no later than the filing of the Complaint asserting the '455 Patent in February 2025 in the Delaware Case. EX2032, ¶¶76-77.

Petitioner offers no explanation or justification for why it waited more than *seven months* to file its Petition after being sued for infringement. Petitioner's delay is especially unjustifiable given that the Petition merely repackages the same references and many of the same arguments as the First '455 IPR and the prior Apple IPRs for related patents. *Apple Inc. v. Koss Corp.*, IPR2022-00053, Paper 10 at 12 (PTAB Apr. 4, 2022) (7-month delay in filing petition favored discretionary denial).

### **C. The Board Should Not Expend its Finite Resources on Multiple IPRs for the Same Patent**

The remaining *General Plastic* factors support discretionary denial. As discussed below, the Delaware Case is set for trial in May 2027. If the Board were to institute two IPRs for the '455 Patent, it would commit the Board (and Patent Owner) to two overlapping proceedings for the same patent covering the same art and substantially the same arguments. This would also occur in parallel with the district court proceedings involving Petitioner in Delaware. This is precisely the type of inefficiency that *General Plastic* is intended to guard against. *General Plastic*, Paper 19 at 17, n.14 ("The Board's resources would be more fairly expended on first

petitions rather than on a follow on petition like the Petition in this case”).

Petitioner will not be unduly prejudiced if the Director denies institution. Petitioner can raise the same challenges to the ‘455 Patent in district court. Indeed, as discussed below, Petitioner can do so even if an IPR is instituted since it has not offered a *Sotera* stipulation. *Infra*, §III.D. To the extent Petitioner argues that two IPRs for the ‘455 Patent are justified given Patent Owner’s infringement allegations, the Board has found that a 6-month delay in filing a petition “diminishes the weight we accord Patent Owner’s litigation activity” under the *General Plastic* factors. *Nichia Corp. v. Document Sec. Sys.*, IPR2019-00398, Paper 10 at 23-24 (PTAB Apr. 15, 2019) (discretionarily denying follow-on petition). Additionally, Petitioner could have filed a “copycat” version of the First ‘455 IPR accompanied by a motion for joinder rather than attempting to initiate an additional proceeding that only serves to increase the burden on the Board and Patent Owner. *See* 37 C.F.R. § 42.122(b).

### **III. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL**

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

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

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

#### **A. Factor 1 is Neutral or Weighs Against Institution**

The first *Fintiv* factor is neutral or weighs against institution because the district court has not granted a stay, nor is there evidence that one may be granted. *Fintiv*, Paper 11 at 7-8. On August 27, 2025, Petitioner moved to stay the Delaware Case pending its IPRs. EX2033. Patent Owner opposed. EX2042. Petitioner's motion remains pending as of this brief. According to DocketNavigator, Judge Bryson, who is presiding over the Delaware Case, has denied pre-institution stays in prior cases. EX2043. Given that Petitioner's stay request is unresolved and unlikely to be granted, this factor is neutral or weighs against institution.

The district court issued a Scheduling Order on November 10, 2025 that ensures that the Delaware Case will be at an advanced stage by the time the Board

issues an institution decision in April 2026. EX2034. For example, the parties will have exchanged infringement and invalidity contentions, served proposed claim constructions along with any supporting expert testimony and extrinsic evidence, and will be only days away from the opening claim construction brief (due April 13, 2026). EX2034, 1-3, 6; *infra*, §II.C. Fact discovery will also be well underway, as both parties have already served discovery requests.

### **B. Factor 2 Weighs Against Institution**

The projected statutory deadline for issuing a FWD for this IPR, if instituted, is April 6, 2027. EX2034, 7, 8. By that time, the parties will have completed claim construction, fact discovery, expert reports, expert discovery, and case dispositive motions. EX2034. The jury trial is scheduled for May 10, 2027, which is within mere weeks of the projected FWD deadline in or around mid-April 2026. EX2034, 8; *Infra*, §II.B. While the trial is after the projected FWD, its close proximity and the substantial trial preparation that will have taken place by that time favor discretionary denial. *Samsung Elecs. Co., Ltd., v. Sionyx, LLC*, IPR2025-00064, Paper 16 at 21 (PTAB June 6, 2025) (denying institution even though projected trial date was two months prior to projected FWD deadline).

There is no reason to believe that the projected trial date will change. Indeed, the Court initially proposed a March 2027 trial date, which would have preceded the projected FWD deadline. EX2035, 13. The Board “generally take[s] courts’ trial

schedules at face value absent some strong evidence to the contrary.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (informative) (noting that trial date was unlikely to change after it was already postponed once).

### **C. Factor 3 Weighs Against Institution**

The third factor concerns “the amount and type of work already completed in the parallel litigation by the court and the parties and the time of the institution decision.” *Fintiv*, Paper 11 at 9. Here, both the district court and the parties have invested substantial time and resources in the Delaware Case. As of the filing of this brief, the parties have negotiated a court order regarding scheduling, engaged in motion practice, and commenced fact discovery, including serving initial disclosures, interrogatories and requests for production. EX2034, 1-3.

By the time the Board decides whether to institute an IPR in April 2026, even more work will have been completed: the parties will have already exchanged infringement contentions and invalidity contentions, will be deeply engaged in completing their document productions, and will be only days away from the start of *Markman* briefing on April 13, 2026. EX2034, 1-3, 6. The Delaware Case will be at a very advanced stage by the time the Board issues an institution decision.

The timing of the Petition is also considered under the third *Fintiv* factor: if “the petitioner did not file the petition expeditiously ... or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.” *Fintiv*,

Paper 11 at 11-12. As noted above, Petitioner unjustifiably waited more than seven months after being sued for infringement to challenge the '455 Patent, even though the Petition reuses substantially the same prior art and arguments as prior IPRs. *Supra*, §III.B. Petitioner assumed the risk that the jury trial in the Delaware Case would occur close to the FWD when it chose to file this Petition seven months after the filing of the Complaint. Patent Owner submits that Petitioner delayed filing to use this IPR to gain another bite at the apple for validity should Patent Owner obtain a verdict of infringement and validity in the Delaware Case.

#### **D. Factor 4 Weighs Against Institution**

Under factor 4, “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where a petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 13.

Petitioner will not serve its Invalidity Contentions until January 21, 2026. EX2034, 2. There is nothing that prevents Petitioner from relying on the same prior art (Lisogurski, Carlson, Tran) and unpatentability theories as the Petition in the Delaware Case. Indeed, Petitioner has not offered a *Sotera* stipulation, expressly leaving open the possibility of duplicative and inefficient proceedings. Petitioner's invalidity contentions may also assert additional prior art references, prior art combinations, and other invalidity grounds, such as alleged lack of written

description, lack of enablement, indefiniteness, and subject matter ineligibility. *See* EX2044, 22 (Petitioner asserting invalidity under “§§ 101, 102, 103, and/or 112” in its Answer). Thus, the invalidity issues to be litigated in the Delaware Case will likely be more expansive than the grounds in the Petition. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (denying institution despite *Sotera* stipulation because “Petitioner’s invalidity arguments in the district court are more expansive” than the petition).

#### **E. Factor 5 Weighs Against Institution**

This factor weighs against institution because Petitioner is the defendant in the Delaware Case. EX2031; *Fintiv*, Paper 11 at 13-14.

#### **F. Factor 6 Weighs Against Institution or is Neutral**

Petitioner argues that institution “would be an efficient use of the Board’s limited resources, given the significant overlap between the Challenged Claims and the nearly-identical ones the Board has already found unpatentable.” Pet., 2. Specifically, Petitioner argues that Patent Owner “is collaterally estopped from challenging unpatentability” and “from challenging motivation to combine” Carlson and Lisogurski. Pet., 20, 26. Both assertions are incorrect.

Collateral estoppel does not apply because “there are differences between the claim limitation[s] at issue ... and the adjudicated claim limitations at issue in the prior IPRs.” *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01153,

Paper 10 at 18 (PTAB Jan. 24, 2022); *see also MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1377-78 (Fed. Cir. 2018) (collateral estoppel does not apply to claims that “present materially different issues that alter the question of patentability”); *Dr. Reddy's Lab'ys., Ltd. v. Monosol RX, LLC*, IPR2016-01111, Paper 14 at 16-17 (PTAB Dec. 5, 2016). For example, the independent claims recite the following limitations that were not addressed in prior FWDs:

- Claim 1: “wherein the plurality of optical wavelengths comprises three optical wavelengths for measuring at least a portion of the one or more of the physiological parameters, wherein the optical wavelengths comprise near infrared or visible wavelengths;”
- Claim 8: “wherein the plurality of semiconductor sources comprises six light emitting diodes;” and
- Claim 15: “wherein the plurality of semiconductor sources comprises six light emitting diodes, and wherein the plurality of semiconductor sources and the plurality of spatially separated detectors are located on one or more arcs.”

EX1001, 87:22-26 (limitation 1[k]), 88:38-39 (limitation 8[k]), 90:6-10 (limitation 15[k]). The claims in the related patents did not recite these limitations. EX1008; EX1004; EX1011; EX1013; EX1005. Indeed, Petitioner does not cite prior IPR decisions for at least claim elements 1[k], 8[k], 15[k]. Pet., 54-61.

If Petitioner is suggesting that Patent Owner is collaterally estopped from arguing against any possible combination of Lisogurski and Carlson (Pet., 26), it cites no authority for this spurious assertion. The fact that the Board found that a POSITA would combine Lisogurski and Carlson to arrive at the inventions in different claims in different patents does not mean that a POSITA would combine them to meet the requirements of these challenged claims, which as discussed above, have material differences relative to the prior claims.

Further, the FWD in the Apple '484 IPR has no collateral estoppel effect because there is no final judgment. EX1013; EX1014; Pet., 5, 20-21, 65, 68-69, 78. “[A]n IPR decision does not have collateral estoppel effect until that decision is affirmed or the parties waive their appeal rights.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1372 (Fed. Cir. 2023). Patent Owner has appealed that FWD. EX1014. Accordingly, there is no collateral estoppel with respect to the “wherein the wearable device is at least in part configured to identify an object” limitation of '484 Patent. Pet., 20.

Petitioner's reliance on *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 (PTAB May 17, 2025) is misplaced because the Board found that the patent owner was collaterally estopped from challenging the grounds because the claims were not patentably distinct from invalidated claims. This case is distinguishable because even if Petitioner's were correct about collateral estoppel, it

is not case dispositive. Pet., 26, 41. Further, unlike this case, the *Netlist* petitioner mapped the limitations in the challenged claims to the limitations in the invalidated claims and cited the FWDs. *Netlist*, IPR2025-00002, Paper 17 at 23.

Petitioner's other cited cases are distinguishable. Pet., 26-27. In *Google LLC v. Hammond Dev. Int'l, Inc.*, collateral estoppel applied because "[t]he only difference between the claims [in the two patents] is the language describing the number of application servers." 54 F.4th 1377, 1381 (Fed. Cir. 2022). In *Ohio Willow Wood Co. v. Alps S., LLC*, collateral estoppel applied because the claims "use slightly different language ... to describe substantially the same invention." 735 F.3d 1333, 1342 (Fed. Cir. 2013). In *Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC*, collateral estoppel applied because "the additional limitation" in the challenged claim did "not materially alter the question of the validity." 778 F.3d 1311, 1319 (Fed. Cir. 2015). In this case, the challenged claims contain additional, patentably distinct limitations that were not addressed in the prior FWDs.

Petitioner's argument that institution would be "an efficient use of the Board's limited resources" based on collateral estoppel is flawed because there is none and its cited cases are distinguishable. Pet. 2-3. In *POSCO Co., Ltd. v. ArcelorMittal*, Acting Director Stewart declined to issue a discretionary denial, in part, because the petitioner was not a party to the parallel ITC proceeding. IPR2025-00370, Paper 10 at 2-3 (PTAB Jun. 25, 2025). *Papst Licensing GmbH & Co. KG v. Samsung Elecs.*

*Am., Inc.* is inapposite because issue preclusion applied to a key claim construction dispute. 924 F.3d 1243, 1252-53 (Fed. Cir. 2019).

Even if *Fintiv* Factor 6 weighs in favor of institution (which it does not), this does not outweigh the other factors. The Board takes a “holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6. The Board has discretionarily denied petitions despite “strong merits” based on the proximity of the trial date as well as the “investment and overlapping issues and parties in the district court case.” *Sionyx*, IPR2025-00064, Paper 16 at 21. Here, the proximity of the jury trial in the Delaware Case to a FWD is the most salient factor and heavily weighs in favor of discretionary denial.

#### **IV. THE DIRECTOR SHOULD DENY INSTITUTION UNDER § 325(D)**

The Director may deny institution when (1) the same or substantially the same art or arguments were previously presented to the Office; and (2) the petitioner does not demonstrate a material error by the Office. 35 U.S.C. § 325(d); *Advanced Bionics, LLC v. Med-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential).

##### **A. Petitioner's References Were Previously Considered**

Grounds 1-4 rely on Lisogurski in combination Carlson, Soller, Tran, and/or Valencell-093. Pet., 11. Lisogurski, Carlson, Tran, and Valencell-093 were cited in an IDS. EX1002, 455, 460, 403, 464. This is “sufficient to satisfy the first part of the

*Advanced Bionics* framework.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (PTAB May 19, 2025) (precedential).

Lisogurski, Carlson, Tran, and Valencell-093 were not just random references buried on an IDS. Materials from ten IPRs were cited and considered during prosecution, many of which presented various combinations using these references. EX1002, 404, 415-16, 431-32, 435-36, 472; *see, e.g.*, EX1021, 7; EX2018, 3; EX2019, 3; EX1008, 3; EX2021, 3; EX2016, 4-5; EX2017, 4; EX2020, 3-4. The Examiner also considered district court invalidity contentions for related patents asserting Lisogurski, Carlson, and Tran. EX1002, 418, 428, 420-22; EX2022, 4, 9; EX2023, 2-3, 5; EX2024; EX2025.

While Soller was not expressly considered, it is cumulative of references that were. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017). Petitioner relies on Soller as allegedly teaching “light source modifications, including the arrangement and number of LEDs and detectors” that are “configured in one or more arcs” involving “three or more wavelengths.” Pet., 28, 56-64. In the First ‘455 IPR, the petition alleges that U.S. Patent Pub. No. 2010/0217102 (“LeBouef”) discloses LEDs and detectors in the claimed arc arrangement. EX1052, 52-57. LeBouef was considered during prosecution. EX1002, 463. The First ‘455 IPR petition also alleges that Lisogurski

discloses three or more optical wavelengths. *Id.*, 45-46. Thus, Soller is cumulative of LeBouef and Lisogurski, which were considered.

### **B. Petitioner Fails to Show Any Material Error**

Petitioner “must demonstrate that, for example, the previously presented art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise.” *Ecto World*, IPR2024-01280, Paper 13 at 5-6. Petitioner “must provide an analysis [for part two of *Advanced Bionics*] even when the asserted prior art is on an IDS, but the Examiner did not apply the reference.” IPR2024-01280, Paper 13 at 5. Petitioner did not do this. The Board has held that this “improperly shifts Petitioner[s'] burden to demonstrate material error onto the Board” to “cobble together an argument under the second part of *Advanced Bionics*.” *Ecto World*, IPR2024-01280, Paper 13 at 6 n.2.

### **V. THE DELAWARE CASE WILL MOST EFFICIENTLY RESOLVE THE PARTIES' ENTIRE DISPUTE**

As noted above, this Petition is one of four IPRs challenging the asserted patents in the Delaware Case. If each petition is instituted, the Board would need to issue four final written decisions, which will only resolve the parties' disputes if the Board finds that *every* asserted claim is unpatentable. By contrast, the Delaware Case will resolve *all* of the parties' disputes in a single proceeding. Congress designed IPRs “to provide an effective and efficient *alternative* to district court litigation.”

*General Plastic*, IPR2016-01357, Paper 19 at 16-17 (emphasis added). In this case, instituting an IPR would merely result in the creation of an additional proceeding.

Patent Owner is expected to narrow the number of asserted claims in the Delaware Case before trial. But Petitioner would have the Board address the patentability of a far larger set of claims—across multiple petitions—than will ultimately be tried in district court. The Board should decline to devote resources to considering claims that will no longer be part of the parties' disputes by the time of a FWD. Further, the asserted patents concern similar subject matter, so it would be more efficient for them to be litigated together in the Delaware Case.

## **VI. CONCLUSION**

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

Patent No. 11,160,455  
IPR2025-01585

Patent Owner's Discretionary Denial Brief

Respectfully submitted,

Dated: December 3, 2025

By: /s/ Jennifer Hayes

Reg. No. 50,845  
Nixon Peabody LLP  
300 South Grand Avenue, Suite 4100  
Los Angeles, CA 90071-3151  
Tel. 213-629-6190  
Fax 213-629-6001

Lead Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

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

**Discretionary Denial Brief** was served on December 3, 2025, by email:

Jaysen S. Chung  
**Gibson, Dunn & Crutcher LLP**  
One Embarcadero Center, Suite 2600  
San Francisco, CA 94111-3715  
Tel: 415-393-8271  
[JSChung@gibsondunn.com](mailto:JSChung@gibsondunn.com)

Brian Rosenthal  
**Gibson, Dunn & Crutcher LLP**  
200 Park Avenue  
New York, NY 10166-0193  
Tel: 212-351-2339  
[BRosenthal@gibsondunn.com](mailto:BRosenthal@gibsondunn.com)

Y. Audrey Yang  
**Gibson, Dunn & Crutcher LLP**  
2001 Ross Ave., Suite 2100  
Dallas, TX 75201  
Tel: 214-698-3215  
[AYang@gibsondunn.com](mailto:AYang@gibsondunn.com)

Counsel for Petitioner

*By: /s/ Jennifer Hayes*

Counsel for Patent Owner