

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHOOP, INC.,
Petitioner

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case No. IPR2025-01585

U.S. Patent No. 11,160,455

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

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. ARGUMENT	2
A. Each <i>Fintiv</i> Factor Favors Institution or Is Neutral	2
1. The likelihood of a stay is neutral.....	3
2. The trial date favors institution	4
3. Minimal investment in the litigation favors institution	4
4. Lack of overlap favors institution.....	5
5. The identity of the parties is neutral	6
6. Collateral estoppel weighs strongly in favor of institution.....	7
B. <i>General Plastic</i> Does Not Support Discretionary Denial	9
1. Factor 1, petitioner identity, outweighs the rest.....	10
2. Factors 2 through 5 do not support denial	13
C. Denial Under 35 U.S.C. § 325(d) Is Not Warranted.....	18
1. The Apple IPRs and related prior art were not discussed during prosecution	18
2. The Examiner erred by failing to consider the cited teachings of the prior art	19
D. Omni Has No Settled Expectations in the '455 Patent	20
III. CONCLUSION.....	20

TABLE OF AUTHORITIES

Cases

	Page(s)
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	18
<i>American Honda Motor Co., Inc. v. Neo Wireless LLC</i> , IPR2023-00797, Papers 16 and 27	10
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB March 20, 2020)	3, 4, 5, 6
<i>Arm Ltd. v. Daedalus Prime LLC</i> , IPR2025-00207, Paper 14 (PTAB Aug. 6, 2025).....	9
<i>Berkshire Hathaway Energy Company, et al. v. Birchtech Corp.</i> , IPR2025-00274, Paper 23 (Director July 2, 2025).....	20
<i>Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00434, Paper 11 (Director June 26, 2025)	20
<i>Cellco P'ship v. Gen. Access Sols., Ltd.</i> , IPR2023-00978, Paper 20 (PTAB Dec. 14, 2023)	13
<i>ClearCorrect Operating, LLC v. Align Tech., Inc.</i> , IPR2025-00817, Paper 14 (Director Aug. 29, 2025).....	19, 20
<i>eClinicalWorks, LLC v. Decapolis LLC</i> , IPR2022-00229, Paper 10 (PTAB Apr. 13, 2022)	5
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (Director May 19, 2025)	18
<i>Ericsson Inc. v. Uniloc 2017, LLC</i> , IPR2019-01550, Paper 8 (PTAB Mar. 17, 2020).....	12
<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , 973 F.3d 1321 (Fed. Cir. 2020)	17
<i>General Plastic Industrial Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).....	13
<i>Google LLC v. Hammond Dev. Int'l</i> , 54 F.4th 1377 (2022)	7
<i>HP Inc. v. Slingshot Printing LLC</i> , IPR2020-01084, Paper 13 (PTAB Jan. 14, 2021)	6

<i>Ingenico Inc. v. IOENGINE, LLC</i> , 136 F.4th 1354 (Fed. Cir. 2025)	6
<i>Jeisys Medical Inc. v. Serendia, LLC</i> , IPR2024-00463, Paper 20 (PTAB Aug. 20, 2024).....	10
<i>Keysight Techs., Inc. et al. v. Centripetal Nets., LLC</i> , IPR2023-00446, Paper 30 (PTAB Aug. 5, 2024).....	8
<i>Kroy IP Holdings, LLC v. Groupon, Inc.</i> , 127 F.4th 1376 (Fed. Cir. 2025)	8, 16
<i>Micron Tech., Inc. v. Sonrai Memory Ltd.</i> , IPR2023-00909, Paper 7 (Director Nov. 28, 2023).....	10, 13
<i>NetApp, Inc. v. Realtime Data</i> , IPR2017-0196, Paper 9 (PTAB Oct. 12, 2017).....	12
<i>Nichia Corp. v. Document Sec. Sys., Inc.</i> , IPR2019-00398, Paper 10 (PTAB Apr. 15, 2019)	17
<i>Ohio Willow Wood Co. v. Alps S., LLC</i> , 735 F.3d 1333 (Fed. Cir. 2013)	7
<i>Padagis US LLC v. Neurelis, Inc.</i> , IPR2025-00464, Paper 12 (Director Jul. 16, 2025).....	20
<i>POSCO v. Arcelormittal</i> , IPR2025-00370, Paper 10 (Director June 25, 2025)	8, 20
<i>Prime Time Toys LLC et al. vs. Spin Master, Inc.</i> , IPR2023-01339, Paper 12 (Director July 9, 2024).....	10
<i>Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.</i> , IPR2017-01797, Paper 8 (PTAB Feb. 6, 2018).....	16
<i>Samsung Elecs. Co., Ltd. v. Iron Oak Techs. LLC</i> , IPR2018-01554, Paper 9 (PTAB Feb. 13, 2019).....	16
<i>Samsung Elecs. Co., Ltd. v. Netlist, Inc.</i> , IPR2025-00002, Paper 17 (PTAB May 17, 2025)	7
<i>Samsung Elecs. Co. v. Elm 3DS Innovations, LLC</i> . IPR2017-01305, Paper 11 (PTAB Oct. 17, 2017).....	11
<i>Savant Techs. LLC v. Feit Elec. Co.</i> , IPR2025-00260, Paper 16 (PTAB June 12, 2025)	6
<i>Valve Corp. v. Elec. Scripting Products, Inc.</i> , IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019)	9
<i>Videndum Prod. Solutions, Inc. v. Rotolight Ltd.</i> , IPR2023-01218, Paper 12 (Director Apr. 19, 2024)	9

Statutes

35 U.S.C. § 3116
35 U.S.C. § 3156
35 U.S.C. § 31615
35 U.S.C. § 3251, 18, 20

PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,160,455
1002	File History, U.S. Patent No. 11,160,455
1003	Declaration of Patrick Mercier, PhD
1004	U.S. Patent No. 9,651,533
1005	U.S. Patent No. 10,517,484
1006	Docket Sheet, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.)
1007	Docket Sheet, <i>Omni MedSci, Inc. v. Samsung Elecs., et al.</i> , No. 2:24-cv-01070 (E.D. Tex.)
1008	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 39 (PTAB 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 (PTAB Apr. 11, 2025)
1011	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 22 (PTAB 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 (PTAB Feb. 14, 2025) (Second Final Written Decision, '484 IPR)
1014	Docket Sheet, <i>Omni MedSci, Inc. v. Apple Inc.</i> , No. 25-1646 (Fed. Cir.) (Docket Sheet, Second Federal Circuit Appeal, '484 IPR)
1015	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 1 (PTAB Apr. 10, 2019) (Petition, '533 IPR)
1016	RESERVED
1017	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 16, (PTAB Oct. 18, 2019) (Institution Decision, '533 IPR)
1018	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916, Paper No. 23 (PTAB Jan. 31, 2020) (Patent Owner Response)

Exhibit No.	Description
1019	RESERVED
1020	RESERVED
1021	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 1, (PTAB Jan. 22, 2021) (Petition, '484 IPR)
1022	RESERVED
1023	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 7 (PTAB Aug. 6, 2021) (Institution Decision, '484 IPR)
1024	<i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2021-00453, Paper No. 10 (PTAB Nov. 12, 2021) (Patent Owner Response, '484 IPR)
1025	RESERVED
1026	RESERVED
1027	U.S. Patent No. 9,241,676 (Lisogurski)
1028	U.S. Patent App. Pub. No. 2005/0049468 ("Carlson")
1029	RESERVED
1030	U.S. Patent No. 6,304,767 ("Soller")
1031	U.S. Patent No. 8,108,036 ("Tran")
1032	U.S. Patent Appl. Pub. No. 2012/0197093 ("Valencell-093")
1033	"The Biomedical Engineering Handbook," by Joseph D. Bronzino (1995)
1034	Patel, et al., A review of wearable sensors and systems with application rehabilitation, <i>Journal of Neuroengineering & Rehabilitation</i> (2012)
1035	A. Omre, Bluetooth Low Energy: Wireless Connectivity for Medical Monitoring, <i>Journal of Diabetes Science & Technology</i> (Mar. 2010)
1036	P. Baum, et al., Strategic Intelligence Monitor on Personal Health Systems, Phase 2: Market Developments - Remote Patient Monitoring and Treatment, Telecare, Fitness/Wellness and mHealth, <i>JRC Scientific and Policy Reports of European Commission</i> (2013)
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)
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)

*Opposition to Patent Owner's
Discretionary Denial Brief*

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1039	RESERVED
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	Remote Deposition of Duncan Leo MacFarlane, Ph.D., P.E., <i>Apple Inc. v. Omni MedSci, Inc.</i> , IPR2019-00916 (PTAB April 16, 2020)
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 (PTAB Aug. 5, 2025) (533 IPR Petition)
1051	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01251, Paper No. 1 (PTAB Aug. 5, 2025) (304 IPR Petition)
1052	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01252, Paper No. 1 (PTAB Aug. 5, 2025) (455 IPR Petition)
1053	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01253, Paper No. 1 (PTAB Aug. 5, 2025) (790 IPR Petition)
1054	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , PGR2025-00064, Paper No. 1 (PTAB Aug. 5, 2025) (790 PGR Petition)
1055	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-01254, Paper No. 1 (PTAB Aug. 5, 2025) (475 IPR Petition)
1056	<i>Samsung Elecs. Co. et al. v. Omni MedSci, Inc.</i> , IPR2025-00063, Paper No. 1 (PTAB Aug. 5, 2025) (475 PGR Petition)
1057	U.S. Patent No. 10,874,304

*Opposition to Patent Owner's
Discretionary Denial Brief*

Exhibit No.	Description
1058	RESERVED
1059	U.S. Patent No. 12,193,790
1060	U.S. Patent No. 12,268,475
1061	RESERVED
1062	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)
1063	Scheduling Order, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 43) (Nov. 10, 2025)
1064	Stipulation re Invalidity for the '455 Patent, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 64) (Jan. 5, 2026)
1065	Interim Director Discretionary Process, USPTO, available at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process (last visited January 2, 2026)
1066	RESERVED
1067	Order Granting-in-Part WHOOP's Mot. to Dismiss, <i>Omni MedSci, Inc. v. WHOOP, Inc.</i> , No. 1:25-cv-00140 (D. Del.) (D.I. 33) (Sept. 24, 2025)
1068	RESERVED
1069	RESERVED

I. INTRODUCTION

The Director should deny Omni’s request to exercise his discretion to deny institution of WHOOP’s Petition challenging claims 1–20 of the ’455 Patent. *Fintiv*, *General Plastic*, and Section 325(d) each support institution.

If instituted, the Board’s Final Written Decision (“FWD”) in this IPR is projected to issue one month before trial in the pending district court litigation against WHOOP. Board review would be more efficient than litigating invalidity in the district court. Collateral estoppel precludes Omni from challenging the validity of most of the ’455 Patent limitations before the PTO but does not bind Omni in the district court. Additionally, WHOOP’s *Sotera* stipulation eliminates any potential overlap between this IPR and the district court proceedings.

This is WHOOP’s first petition challenging the ’455 Patent, and it presents prior art grounds not included in the Samsung petition.¹ WHOOP filed its Petition well before any substantive briefing by Omni in the Samsung IPR, alleviating any roadmapping concerns.

Although materials related to prior IPRs of related patents were included in

¹ Samsung Electronics Co., Ltd., among other entities, filed a petition challenging all claims of the ’455 Patent about seven weeks before WHOOP filed this Petition. IPR2025-01252, Paper 1 (Aug. 5, 2025) (“Samsung petition”).

IDS forms submitted during the '455 Patent prosecution, they were not discussed or applied by the Examiner, suggesting material error.² The number of references cited in the IDS forms—roughly 700—further supports the inference that the Examiner did not afford these materials due consideration.

Finally, Omni has no settled expectations in the '455 Patent, which issued in November 2021 and is comprised of claims materially similar to those found unpatentable in the Apple IPRs.

Accordingly, for the reasons discussed below, WHOOP respectfully requests that the Director deny Omni's request for discretionary denial.

II. ARGUMENT

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

The *Fintiv* factors support institution. Most importantly, collateral estoppel based on the Apple IPRs renders the majority of the challenged limitations unpatentable. Since FWDs do not carry preclusive effect in the district court, the

² Apple Inc. previously successfully challenged two patents related to the '455 Patent (collectively, the "Apple IPRs"). All claims held unpatentable in the '533 Patent have been affirmed on appeal. EX1008 (the "'533 Apple IPR"); EX1009. All but one limitation held unpatentable in the '484 Patent has been affirmed. EX1013 (the "'484 Apple IPR"); EX1014.

Board is best situated to review WHOOP's patentability challenge. Moreover, the FWD in this IPR would be due before trial in the district court litigation, which is still in the earliest stages. WHOOP's *Sotera* stipulation ensures any grounds that could have been raised in this Petition will be litigated only in this forum. The other factors (the likelihood of a stay and the identities of the parties) are neutral. The *Fintiv* factors thus favor institution.

1. The likelihood of a stay is neutral

WHOOP moved for a stay of the district court litigation promptly after filing its Petitions. The district court denied WHOOP's motion as premature and without prejudice on December 23, 2025. EX1062.

Where the district court indicates "that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted," this factor "usually weigh[s] against" discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6–7 (noting that investment in the district court litigation is also relevant to the weight of this factor where no stay has yet been ordered). The district court here stated in its Order that it was "postpon[ing] ruling on [the stay] motion . . . pending the [institution] decisions by the PTO." EX1062 at 1. The district court's Order further acknowledged the "general rule" that "stays may be granted . . . once PTO review of some or all of the asserted claims is granted," and expressly permitted WHOOP to "renew its request . . . after the PTO issues its institution decision" for

the pending petitions. *Id.* at 4, 6. As discussed for Factors 2 and 3, *infra*, the district court case against WHOOP is still in its early stages, with the vast majority of resource-intensive work still ahead.

This factor is therefore neutral, or weighs slightly in favor of institution.

2. The trial date favors institution

Trial in the district court litigation is scheduled to begin on May 10, 2027. EX1063 at 8. If instituted, a FWD for this Petition is projected for April 6, 2027—a month before the trial date. Omni argues that the parties will have completed discovery and case dispositive motions by the FWD (Paper 6 at 10, “DD Br.”), ignoring that institution is likely to result in a stay of the district court litigation, as discussed in Factor 1, *supra*. Even if the litigation is not stayed, this IPR stands to eliminate the need to try the ’455 Patent in the district court entirely, saving considerable resources for the parties and the court. This factor weighs in favor of institution, particularly in view of the early stages of the district court litigation discussed in Factor 3, *infra*.

3. Minimal investment in the litigation favors institution

At the projected institution decision for this Petition (April 6, 2026), the litigation will be in the earliest stages. Opening claim construction briefs are not due until the following week, on April 13, 2026. EX1063 at 6. Completion of fact

discovery will be months away, and opening expert reports not due until October 2026. *Id.* at 3–4.

Omni's argument that early case disclosures, such as infringement and invalidity contentions, amount to "substantial time and resources" would weigh against nearly every petition. *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9–11 (PTAB Apr. 13, 2022) (with invalidity contentions served and claim construction briefing complete, *Fintiv* factor 3 weighed against denial). The absence of substantive orders related to the '455 Patent in the district court (except WHOOP's motion to dismiss, granted in part) further weighs against denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (PTAB Mar. 20, 2020).

Omni erroneously claims, without evidence, that WHOOP "delayed" in filing its Petition to "gain another bite at the apple" should Omni prove "infringement and validity" in the district court. DD Br. 12. WHOOP's *Sotera* stipulation ensures no overlap in the invalidity grounds between this IPR and the district court. EX1064.

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

4. Lack of overlap favors institution

This Petition challenges all claims (1–20) of the '455 Patent, whereas Omni currently asserts only claim 1 in the district court. The validity of claims 2–20 is therefore not presently within the scope of the district court litigation.

Additionally, WHOOP has filed a *Sotera* stipulation, agreeing “not to pursue” in the district court any “ground that was raised or could have been reasonably raised in an IPR.” EX1064. WHOOP’s stipulation fully disclaims the grounds upon which WHOOP is permitted to bring an IPR (including the grounds actually brought), so there will be no overlap between an instituted IPR and the district court litigation. 35 U.S.C. §§ 311, 315(e); *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–67 (Fed. Cir. 2025). WHOOP’s *Sotera* stipulation mitigates the “concerns of inefficiency and the possibility of conflicting decisions.” *Fintiv* at 12.

Omni’s argument that potential subject matter ineligibility, enablement, and written description arguments weigh against institution is misplaced. DD Br. 13. Arguments under Sections 101 and 112 are outside of the Board’s jurisdiction in IPR proceedings. 35 U.S.C. § 311(b). Such arguments present no risk of duplicated efforts or inconsistent rulings. Accordingly, this factor weighs in favor of institution.

5. The identity of the parties is neutral

WHOOP is the defendant in the district court litigation. This factor is therefore neutral, as institution is routinely granted where the same entities are parties to the IPR and the litigation. *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (PTAB Jan. 14, 2021); *Savant Techs. LLC v. Feit Elec. Co.*, IPR2025-00260, Paper 16 at 2–3 (PTAB June 12, 2025).

6. Collateral estoppel weighs strongly in favor of institution

As Omni appears to concede, the vast majority of the claim limitations in the '455 Patent are not patentably distinct from those found unpatentable in the Apple IPRs. DD Br. 14 (arguing collateral estoppel does not apply to claim elements 1[k], 8[k], 15[k]). Collateral estoppel therefore precludes Omni from relitigating the validity of most of the challenged claim limitations before the Board. *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2025-00002, Paper 17 at 17–24 (PTAB May 17, 2025) (granting institution in part because petitioner made a preliminary showing that “patent owner is collaterally estopped” as to the challenged claims).

Collateral estoppel applies to IPR proceedings where “(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party.” *Netlist*, Paper 17 at 18–19. Estoppel applies even “if the patent claims use slightly different language to describe substantially the same invention.” *Google LLC v. Hammond Dev. Int'l*, 54 F.4th 1377, 1381–82 (2022); *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (estoppel not limited “to patent claims that are identical”).

Omni does not (and could not) contest that elements 2–4 are met here. DD

Br. 13–15.³ Instead, Omni argues only that three limitations across the twenty claims of the '455 Patent “were not addressed in the prior FWDs” so collateral estoppel does not apply to those limitations. DD Br. 14. That collateral estoppel might not apply to three limitations, however, does not negate estoppel as to the remaining limitations in the '455 Patent. *Keysight Techs., Inc. et al. v. Centripetal Nets., LLC*, IPR2023-00446, Paper 30 at 20–21 (PTAB Aug. 5, 2024) (applying estoppel to “limitations [1a] through [1d]” and considering limitation [1e] on its merits). Omni has no response to WHOOP’s estoppel arguments for the remaining limitations and concedes that WHOOP’s petition relies on the Board’s prior unpatentability analysis for analogous claims. DD Br. 14.

The Board is best situated to assess the patentability of the '455 Patent. Although it is precluded from relitigating validity before the Board, prior FWDs do not bind Omni in the district court. *Kroy IP Holdings, LLC v. Groupon, Inc.*, 127 F.4th 1376, 1379–80 (Fed. Cir. 2025) (no collateral estoppel because “IPR proceeding requires a lower burden of proof” than district court). Board review of the challenged claims would therefore be significantly more efficient, since only a

³ There is no collateral estoppel with respect to the “identifying an object” limitation challenged in the '484 Apple IPR, which remains pending on appeal. DR Br. 15. The “identifying an object” limitation is not claimed in the '455 Patent.

fraction of the limitations would require a merits analysis.

Recent decisions recognize this efficiency, finding that estoppel can “tip[] the balance against discretionary denial,” because it is “an appropriate use of Office resources to . . . ensure that a [patent owner] does not take action inconsistent with the judgment in a prior Office proceeding.” *POSCO v. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (Director June 25, 2025); *Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 at 2–3 (Director Aug. 6, 2025) (“efficient for the Board to take up” the petition, given prior invalidation of “substantially identical claims”). So too here. The Board already found substantially similar claims unpatentable in view of the same core prior art references. Board review of the ’455 claims would promote consistency and avoid unnecessary litigation.

B. *General Plastic* Does Not Support Discretionary Denial

Discretionary denial under *General Plastic* is not justified here. Where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one **necessarily** outweighs the other *General Plastic* factors.” *Videndum Prod. Solutions, Inc. v. Rotolight Ltd.*, IPR2023-01218, Paper 12 at 5–6 (Director Apr. 19, 2024) (emphasis added). WHOOP has not filed any prior petitions for the ’455 Patent, and Omni does not allege that WHOOP has a “significant relationship” under *Valve* with the petitioners of the Samsung petition (nor could it). DD Br. at 5; see *Valve Corp. v. Elec.*

Scripting Products, Inc., IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential). To the extent the remaining *General Plastic* factors are considered, each is either neutral or weighs against discretionary denial.

1. Factor 1, petitioner identity, outweighs the rest

“Under USPTO policy and precedent, *General Plastic* has not been extended to any cases in which the first and second petitioners *do not have* a significant relationship” under *Valve. Videndum*, Paper 12 at 6; *Micron Tech., Inc. v. Sonrai Memory Ltd.*, IPR2023-00909, Paper 7 at 8–9 (PTAB Nov. 28, 2023) (“factors 1–5 weigh against denying institution” where the petitioner has not previously filed a petition and the Patent Owner “does not assert extenuating circumstances,” such as a special relationship); *Jeisys Medical Inc. v. Serendia, LLC*, IPR2024-00463, Paper 20 at 8 (PTAB Aug. 20, 2024) (citing *Videndum* and holding “we will not discretionarily deny a later petition in view of an earlier petition where the earlier and later petitioners are neither the same party nor have a significant relationship”). This principle holds true even where the prior petitions asserted “some of the same art at issue” in the current proceedings. *Prime Time Toys LLC et al. vs. Spin Master, Inc.*, IPR2023-01339, Paper 12 at 18–21 (Director July 9, 2024); see *American Honda Motor Co., Inc. v. Neo Wireless LLC*, IPR2023-00797, Papers 16 and 27 (Director finding no significant relationship despite roadmapping allegation).

A “significant relationship” under *Valve* must connect the petitioners “with respect to [the] assertion” of the challenged patent. *Valve*, Paper 11 at 10. Absent a contractual relationship or informal cooperation in the implementation of the allegedly infringing technology, different entities with unrelated accused products do not have a significant relationship that “justifies the application of a *General Plastic* analysis.” *Prime Time Toys*, Paper 12 at 19–20; *American Honda*, Paper 27 at 2–3, (Mar. 22, 2024) (similar). WHOOP does not have a “significant relationship” with the Samsung petitioners, and Omni does not assert one exists. DD Br. 5–6.

Nevertheless, Omni argues that WHOOP’s petition is a “follow-on” petition that uses the Samsung IPR as a roadmap, so that—despite the lack of a “significant relationship” between the Samsung petitioners and WHOOP—the *General Plastics* factors favor denying institution. DD Br. 6. Omni’s cited authorities are distinguishable or rely on logic rejected by the more recent decisions WHOOP cites above. *Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, the only recent case, did not expressly apply the *General Plastic* framework, although the Acting Director determined that “concerns of roadmapping” weighed in favor of discretionary denial (among other factors). IPR2025-00884, Paper 9 at 2 (Director Sept. 3, 2025) (“AWS”). In *AWS*, however, the petitioner admitted its petition addressed “the precise deficiency identified” in two previous merits-based institution denials. *Id.* No such roadmapping exists here because WHOOP’s petition was filed well before

any substantive briefing by Omni or decisions by the Board. *See, infra*, Section II.B.3 (explaining that strategic staggering of petitions is the core of *General Plastic* roadmapping concerns).

The other cases Omni cites similarly addressed concerns about staggering petitions in a prejudicial manner. *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2017-01305, Paper 11 at 8, 12 (PTAB Oct. 17, 2017) (petition filed seven months after two merits-based institution denials); *see also NetApp, Inc. v. Realtime Data*, IPR2017-0196, Paper 10 at 11 (PTAB Oct. 13, 2017) (petition filed “well after” patent owner response). The reasoning Omni cites in *Ericsson* was rejected in the later *Prime Time Toys* decision. *Compare Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 12 (finding Factor 1 weighed against institution without a significant relationship between the petitioners), *with Prime Time Toys*, Paper 12 at 18–20 (finding discretionary denial not justified absent significant relationship). *Ericsson* is further distinguishable because the petitioner there studied “the prior petitions . . . to determine grounds” to advance in its own petition. *Ericsson*, Paper 8 at 11. Here, by contrast, Samsung and WHOOP’s petitions rely on different grounds and different combinations of references. To the extent the grounds and references overlap between the two petitions (*see* Factor 3, *infra*), that overlap is due to the collateral estoppel effects of the Apple IPRs. The prior art references shared

between WHOOP and Samsung's petitions were relied on by the Board to invalidate substantially similar claim limitations in the Apple IPRs. DD Br. 3.

In sum, as this is WHOOP's first petition for the '455 Patent and no significant relationship exists with the Samsung petitioners, denial under *General Plastic* "is not justified." *Videndum*, Paper 12 at 6–7.

2. Factors 2 through 5 do not support denial

Where the petitioner has not previously filed a petition and no extenuating circumstances, such as a significant relationship, exist, "factors 1–5 weigh against denying institution." *Micron Technology*, IPR2023-00909, Paper 7 at 8–9; *Cellco P'ship v. Gen. Access Sols., Ltd.*, IPR2023-00978, Paper 20 at 19 (PTAB Dec. 14, 2023) ("factors 2–5 bear little relevance," absent extenuating circumstances, where "Petitioner had not previously filed a petition against the same patent").

Factor 2: Knowledge of the prior art. As Omni's own authority confirms, "whether [WHOOP] knew about the asserted references at the time the prior petitions were filed has little, if any, probative value," because WHOOP was not a petitioner in any previous IPRs of the '455 Patent. *Elm 3DS Innovations*, Paper 11 at 19–20. Omni does not explain how this factor supports denial, particularly since WHOOP filed its petition only seven weeks after Samsung. *See* DD Br. 5–7.

Factor 3: Substantive proceedings in the prior IPR. The roadmapping concerns underlying *General Plastic* and its progeny refer to "Petitioner's potential

benefit from receiving and having the opportunity to study” patent owner responses and merit-based denials by the Board to strategically file multiple petitions “until a ground [that results in review] is found.” *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential in relevant part). These concerns do not exist here. WHOOP filed its Petition well before any substantive response by Omni or decision by the Board in the Samsung IPR. Additionally, and contrary to Omni’s claims, WHOOP’s petition does not simply “repackage[]” the Samsung petition and includes two references not cited by Samsung. DD Br. 7 (Soller and Valencell-093). Any overlap between WHOOP’s and Samsung’s petitions stems from common arguments about the collateral estoppel effects of the Apple IPRs, which necessarily requires the two petitions to rely on the same references asserted by Apple for estoppel to apply.

Omni argues that WHOOP’s reliance on the Board’s FWDs in the Apple IPRs is evidence of roadmapping favoring discretionary denial. DD Br. 5–6. But Omni cites no authority to support its claim that relying on the Board’s prior decisions *holding unpatentable* related claims in order to invoke collateral estoppel is a form of prejudicial roadmapping. *Id.* To the contrary, evidence of previous unpatentability determinations of related claims weighs in favor of institution. *See, supra*, Section II.A.6.

Factors 4 and 5: Timing of the second petition. Factors 4 and 5 consider the timing of the second petition to assess “whether a petitioner should have or could have raised [its] challenges earlier.” *General Plastic*, Paper 19 at 18. Omni suggests that WHOOP unreasonably delayed filing its petition, but contrary to Omni’s assertions, there is no evidence that WHOOP delayed requesting IPR for seven months. DD Br. 7. Indeed, Omni’s cited authority confirms that Factors 4 and 5 have little probative value, and actually weigh against discretionary denial, where the second petitioner was not involved in the prior petition and where the timing of the second petition is a function of the patent owner’s litigation activity. *Elm 3DS Innovations*, Paper 11 at 22–23. WHOOP worked diligently to file its Petition, which is not identical to Samsung’s, after Omni first accused it of infringing the ’455 Patent in February 2025. EX1006. That Samsung filed its petition slightly before WHOOP is not surprising, since Omni accused Samsung of infringing the ’455 Patent about one and a half months before WHOOP. EX1007. Additionally, Omni’s claim that a suit by a different entity asserting a different, unrelated patent (the ’868 Patent) “put Petitioner on notice” of its entire “patent portfolio” is unsupported by evidence or authority and was rejected in the parallel district court litigation. DD Br. 6–7; EX1067 (Judge Bryson holding “that the ’868 patent (not a member of the ’533 patent family) had previously been asserted against Whoop does not plausibly suggest that Whoop was aware of the ’533 patent family.”).

Factors 6 and 7: Board considerations. The Board's resources would be most efficiently utilized through coordination of the WHOOP and Samsung IPRs. Since WHOOP's Petition was filed only seven weeks after Samsung's, the Board may set a common briefing and argument schedule without violating the statutory requirement to issue a final determination within one year of institution. 35 U.S.C. § 316(a)(11). Although WHOOP and Samsung's petitions are not identical and include non-overlapping references, the collateral estoppel effects of the prior Apple IPRs form the core of both. DD Br. 7. Institution of both petitions would not be overly burdensome, as estoppel precludes Omni from litigating the validity of most of the limitations, as discussed in Section II.A.6, *supra*.

Factors 8 and 9: Prejudice to the Petitioner. Omni cites *Samsung Elecs. Co., Ltd. v. Iron Oak Techs. LLC*, as identifying additional factors in cases where the second petition is filed by a different petitioner. DD Br. 4–5. Both *Iron Oak* factors weigh against denial. IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019).

WHOOP would face undue prejudice if institution is denied and the Samsung IPR is terminated prior to a final determination. Omni argues incorrectly that WHOOP can raise the same challenges in district court. DD Br. 8. Due to the different standards of proof, the Board's prior unpatentability decisions cannot support collateral estoppel in the district court. *Kroy IP Holdings*, 127 F.4th at 1380.

In other words, WHOOP's argument that the Apple IPRs preclude Omni from litigating the validity of the challenged claims can only be applied by the Board.

The existence of multiple petitions challenging the '455 Patent is also the direct result of Omni's litigation activity. The Director should "decline to wield [the patent owner's] own litigation activities as a shield in [an] *inter partes* review." *Iron Oak Techs.*, Paper 9 at 31; *Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.*, IPR2017-01797, Paper 8 at 33 (PTAB Feb. 6, 2018) (arguments against serial petitions are less persuasive "when the volume [of petitions] appears to be a direct result of [the patent owner's] own litigation activity").

Omni argues that the timing of WHOOP's petition "diminishes the weight" of its own litigation activity. DD Br. 8 (citing *Nichia Corp. v. Document Sec. Sys., Inc.*, IPR2019-00398, Paper 10 (PTAB Apr. 15, 2019)). Omni's reliance on *Nichia* is misplaced. That decision was based on concerns that petitioner had improperly benefitted from roadmapping, using the denial of institution in a previous IPR that *it filed* to improve its position in the subsequent petition. *Nichia*, Paper 10 at 5, 9, 17, 23–24. As discussed with respect to Factor 3, *supra*, no such concerns exist here.

Omni also attempts to fault WHOOP for not filing a "copycat" of the Samsung Petition and moving for joinder. DD Br. 8. Joinder is permitted only when the issues raised in the petitions are identical. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1335–37 (Fed. Cir. 2020) (joined party cannot bring "new issues

from its new proceeding into the existing proceeding”). As explained with respect to Factors 1 and 3, *supra*, WHOOP’s Petition includes two prior art references not covered by Samsung’s petition. WHOOP therefore could not join Samsung’s petition without foregoing the grounds that rely on these references.

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

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

Although materials from the Apple IPRs and the Lisogurski, Carlson, Tran, and Valencell-093 references were listed in various IDS forms in the ’455 Patent’s file history, discretionary denial under Section 325(d) is not warranted. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (Director May 19, 2025) (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)).

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

Materials from the Apple IPRs, including the ’533 and ’484 petitions, and Lisogurski, Carlson, Tran, and Valencell-093 were among the roughly 700 references listed across eight IDS forms in the ’455 Patent file history. DD Br. 18; EX1002 at 403–590. Neither the Apple IPRs, nor the art Apple relied on (cited in WHOOP’s petition), were substantively assessed (or even discussed) by the

Examiner, however. *See* EX1002 at 599, 623, 637–47, 648. In view of the “extremely large number of references,” any alleged consideration by the Examiner does not warrant Section 325(d) denial, particularly because the references were not discussed or applied. *Ecto World*, Paper 13 at 2–4, 7.

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

Material error may exist where “even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination,” thereby “overlooking certain teachings in the prior art on the IDS.” *Ecto World*, Paper 13 at 5–6.⁴ Despite the substantial similarity between the claims of ’455 Patent and the related ’484 and ’533 Patents invalidated in the Apple IPRs, *supra* Section II.A.6, the ’455 Patent issued without a single rejection. EX1002 at 637–47, 648.

The Examiner’s failure to engage with the references that invalidated overlapping claim limitations in the related ’484 and ’533 Patents is material error. *ClearCorrect Operating, LLC v. Align Tech., Inc.* is instructive. IPR2025-00817, Paper 13 at 3 (Director Aug. 29, 2025). In *ClearCorrect*, as here, a substantially similar related patent was found unpatentable by the Board in a prior IPR. *Id.* at 3.

⁴ Omni faults WHOOP for omitting discretionary denial arguments from its Petition. DD Br. 19. The PTO, however, instructs petitioners “not [to] present discretionary considerations in the petition.” EX1065.

Although the prior IPR was cited in an IDS, the Examiner “did not discuss why the challenged claims were patentably distinct” from those determined unpatentable in the prior IPR. *Ibid.* The Acting Director found the Examiner “erred by allowing the claims after the Board determined that substantially similar claims are unpatentable.” *Ibid*; see also *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (Director Jul. 16, 2025) (similar). Because the Examiner committed material error by failing to engage with the Apple IPRs or the related art, denial under Section 325(d) is not warranted.

D. Omni Has No Settled Expectations in the '455 Patent

Omni cannot rely on settled expectations in the '455 Patent to argue against institution. The '455 Patent issued on November 2, 2021, and recent decisions have declined to find settled expectations in patents of similar age. *E.g.*, *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2–3 (Director June 26, 2025) (no settled expectations in patents issued in 2020 and 2019). Further, a patent owner's settled expectations are undermined when related claims are found unpatentable. *POSCO*, IPR2025-00370, Paper 10 at 2–3. Because no challenged claim in the '533 family has thus far survived review, Omni cannot claim settled expectations in the '455 Patent.

III. CONCLUSION

WHOOP respectfully requests the Director deny discretionary denial.

*Opposition to Patent Owner's
Discretionary Denial Brief*

Dated: January 5, 2026

Respectfully Submitted,

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