

From: [Director Discretionary Decision](#)
To: [Trials](#); [Director Discretionary Decision](#); [Christian Dorman](#)
Cc: [Alan Whitehurst](#); [Arvind Jairam](#); [Christopher P. McNett](#); [Chris Leone](#); [Vervain-Phison-MS](#); [Hsuanyeh Chang](#); [Douglas Chin](#); [Peter Yi](#); [Stephen Chow](#)
Subject: RE: IPR2025-00213, -00214, -00215; PGR2025-00010, -00011
Date: Thursday, June 12, 2025 12:04:42 PM
Attachments: [image001.png](#)
[image002.png](#)

Patent Owner is authorized to file a one-page supplemental brief due no later than Friday, June 13, 2025. In response, Petitioner is authorized to file a one-page supplemental brief, due Tuesday, June 17, 2025, limited to addressing only the issues raised in Patent Owner's supplemental brief.

From: Christian Dorman <cdorman@McKoolSmith.com>
Sent: Tuesday, June 10, 2025 5:46 PM
To: Trials <Trials@USPTO.GOV>
Cc: Alan Whitehurst <awhitehurst@McKoolSmith.com>; Arvind Jairam <ajairam@McKoolSmith.com>; Christopher P. McNett <cmcnett@McKoolSmith.com>; Chris Leone <cleone@McKoolSmith.com>; Vervain-Phison-MS <Vervain-Phison-MS@mckoolsmith.com>; Hsuanyeh Chang <hsuanyeh@hsuanyeh.com>; Douglas Chin <doug.chin@hsuanyeh.com>; Peter Yi <peter.yi@hsuanyeh.com>; Stephen Chow <stephen.y.chow@hsuanyeh.com>
Subject: IPR2025-00213, -00214, -00215; PGR2025-00010, -00011

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

IPR2025-00213, -00214, -00215; PGR2025-00010, -00011

Dear Board,

Patent Owner filed Discretionary Denial Briefs in the above-identified proceedings on May 14, 2025. Since that time, the Director has issued decisions indicating that additional evidence supports Patent Owner's argument that the "settled expectations" of the challenged patent family favor discretionary denial. See, e.g., *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) (Granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review).

Specifically, Petitioner Phison has been aware of U.S. Patent No. 8,891,298 to Dr. G.R. Mohan Rao – the parent patent of the patents challenged in the above-identified proceedings – since at least 2019. In 2019, the Examiner identified U.S. Patent No. 8,891,298 as pertinent prior art during prosecution of Petitioner Phison's U.S. Patent No.

10,824,340.

To ensure the Director is able to consider this additional evidence, Patent Owner respectfully requests permission to submit a supplemental brief, limited to one page, within one day of the Board's approval of this request. This brief would explain the relevance of this new evidence to the discretionary denial analysis.

To ensure fairness, Patent Owner would not oppose Petitioner submitting a responsive brief of equal length within two days of Patent Owner's submission.

Patent Owner has conferred with Petitioner, and Petitioner provided the following statement:

"Petitioner opposes Patent Owner's request for supplemental briefing. The facts regarding the Board's decision in *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) are materially different than those here. In contrast to the petitioner in *iRhythm*, Patent Owner concedes that *the Examiner, not Petitioner*, cited U.S. Patent No. 8,891,298 ("Rao") during prosecution of the '340 patent. The Examiner's citation of Rao among ten other patent documents on a Form 892 (without comment) during the prosecution of the '340 patent forms the basis for Patent Owner's request here, and thus should be denied. However, should the Board grant Patent Owner's Request, Petitioner would respectfully request permission to submit a responsive brief of equal length within two days of Patent Owner's submission."

The Parties can be available June 11-13, or the week of June 16, if the Board desires a conference call.

Respectfully,
Christian Dorman
Counsel for Patent Owner Vervain, LLC

McKool Smith

Christian Dorman
Associate
Washington, D.C.
Tel: (202) 370-8328
www.mckoolsmith.com

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.

