

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ROOT TECHNOLOGY CO., LTD.,
Petitioner,

v.

WILLOW BLOSSOM HOLDCO LIMITED, A WHOLLY OWNED
SUBSIDIARY OF WILLOW INNOVATIONS, INC., (FORMER PATENT
OWNER CHIARO TECHNOLOGY LTD.),
Patent Owner.

Case IPR2025-00554
Patent No. 11,806,454

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL
OF INSTITUTION**

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d) 1

CERTIFICATE OF SERVICE 2

LIST OF EXHIBITS

Exhibit	Description
2001	US Patent Publication No. US2018/0104396 to Park
2002	US Patent Publication No. US2015/0314053 to Furrer
2003	Docket Navigator report for Docket Entries for WDWA-2-23-cv-00631
2004	Docket Navigator time to trial statistics for W.D. Wash.
2005	W.D. Wash. Case, Dkt. No. 124, June 28, 2024 Order

I. INTRODUCTION

Pursuant to the “Interim Processes for PTAB Workload Management Memorandum” issued by Director Stewart on March 26, 2025 (“Stewart Memo”), Patent Owner Willow Blossom Holdco Limited respectfully submits this brief requesting that the Director exercise her discretion to deny institution of the Petition for *Inter Partes* Review (IPR) (Paper 2) of U.S. Patent No. 11,806,454 (“’454 Patent”) filed by Shenzhen Root Technology Co., LTD. (“Petitioner” or “Shenzhen Root”).

The Director should exercise her discretion and deny institution under § 325(d) because the prior art and arguments relied upon by Shenzhen Root are duplicative of prior art and arguments overcome by Patent Owner in previous proceedings before the Office. Additionally, the Director should exercise her discretion to deny institution 35 U.S.C. § 314(a), as many of the relevant considerations favor a discretionary denial, including Shenzhen Root’s own original choice of forum for the adjudication of patent validity.

II. BACKGROUND

A. The ’454 Patent

The ’454 patent, titled “Wearable Breast Pump System,” is part of a family of patents relating to novel and nonobvious in-bra breast pumping systems. The ’454 patent discloses “a breast pump system” with “one wearable milk collection

hub connected via an air line to a combined external air pump and control unit.” Ex. 1001, Abstract. The ’454 patent notes that then-existing wearable breast pump systems suffered from drawbacks including that the flexible barrier that allows a vacuum to be applied “disadvantageously” to a breast because it “obstructs the line of sight to the interior of the collection device and to the nipple.” Ex. 1001, 1:53-63.

As shown in the annotated Figure 1 below, the ’454 patent discloses a breast pump system with “a pair of milk collection hubs 10, a combined control and air pump unit 11, and an air tube connection component 12.” Ex. 1001, 5:5-7.

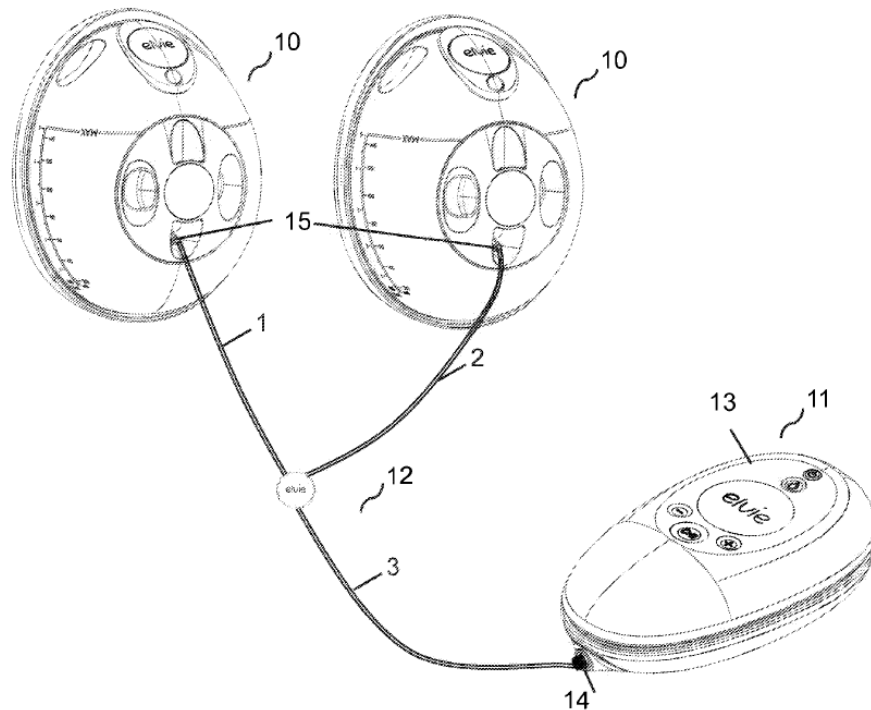


FIGURE 1B

Ex. 1001, Fig. 1B. “In normal use, as shown in FIG. 1B, air tubes 1, 2 connect each milk collection hub 10 to the air tube connection component 12; the air tube

connection component 12 connects air tubes 1, 2 to a single air tube 3, that in turn leads to the control and air pump unit 11.” Ex. 1001, 5:7-11.

B. Patent Owner

After the filing of the petition for this IPR on March 6, 2025, the ownership for the ’454 patent changed. Specifically, as a result of a U.K. equivalent of a U.S. bankruptcy proceeding, certain assets of former patent owner, Chiaro Technology Limited, including the patent at issue in this IPR, were acquired by Willow Blossom Holdco Limited, a wholly owned subsidiary of Willow Innovations, Inc. (collectively “Willow”). Patent Owner’s Mandatory Notices of May 9, 2025, reflect the same. IPR2025-00554, Paper 5, 2.

C. Petitioner’s IPR Filings and Reexamination Requests

Petitioner has filed multiple IPR petitions against Patent Owner’s patents over a year period. On May 31, 2024, Petitioner filed *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2024-00953, challenging Patent Owner’s U.S. Patent No. 11,413,380 (“’380 patent”), which provides breast pump disclosures similar to the ’454 patent. Subsequently, Petitioner filed another IPR petition against the same ’380 patent in *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2024-01296, along with a Notice Ranking and Explaining Material Differences Between Petitions for Inter Partes Review of U.S. Patent No. 11,413,380. In IPR2024-00953, the Board denied institution under 35 U.S.C. §

314(a) and determined that Petitioner failed to show that “parallel petitions challenging the same claims of the ’380 patent at issue in this proceeding and in the ’1296 IPR are warranted.” IPR2024-00953, Paper 18, 3. On February 25, 2025, the Board granted institution in IPR2024-01296 against the ’380 patent. *See* IPR2024-01296, Paper 9.

On February 4, 2025, Petitioner filed a petition in *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2025-00560 against U.S. Patent No. 11,813,381, a related patent also directed to a wearable breast pump. Subsequently, on Mar. 6, 2025, Petitioner filed the instant proceeding against Patent Owner’s ’454 patent.

Multiple *ex parte* reexamination requests have also been filed against U.S. Patent No. 11,357,893 (“the ’893 Patent”), and those reexamination requests rely upon prior art and arguments very similar to the challenges raised in the above identified IPRs. The serial numbers of those *ex parte* reexaminations are identified below.

- Serial No. 90/019,410
- Serial No. 90/019,679

Those reexaminations have been merged into a single proceeding.

The ’679 reexamination requestor is Fish & Richardson, the law firm who represents Petitioner in this proceeding. Further, although the requestor of the ’410

reexamination was anonymous, Patent Owner believes that requestor to be Shenzhen Root given the similarity of art and arguments cited in those reexaminations and the IPRs.

D. Parallel District Court Litigation

On April 28, 2023, Shenzhen Root filed a declaratory judgment action seeking a judgment of non-infringement and invalidity of Patent Owner' U.S. Patent No. 11,357,893. *Shenzhen Root Technology Co., Ltd., v. Chiaro Technology Ltd.*, Case No. 2:2023-cv-00631-KKE (W.D. Wash.) (hereinafter "*W.D. Wash. case*"), Dkt. No. 1, Complaint. Ex. 2003 at 1.

On May 24, 2023, Willow Innovations Inc. filed a complaint against Chiaro Technology Ltd d/b/a Elive for infringement of Willow's patents relating to a wearable breast milk pump. *Willow Innovations, Inc. v. Chiaro Tech., Ltd.*, 2-23-cv-00229 (E.D. Tex.). On February 3, 2025, Judge Gilstrap entered an Order to stay all deadlines in the case in view of a settlement of all matters between the parties. *Willow Innovations, Inc. v. Chiaro Tech., Ltd.*, 2-23-cv-00229 (E.D. Tex.), Dkt. No. 162, 1. As noted previously, Willow now owns the patents that were at issue in the E.D. Tex. matter.

III. THE DIRECTOR SHOULD EXERCISE HER DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

The Director should discretionarily deny the Petition under 35 U.S.C. § 325(d) in view of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”) and the recent precedential decision of *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (May 19, 2025) (precedential) (designated: May 19, 2025) (“*Ecto*”). The Petition recycles the same prior art and arguments already presented to the Examiner, and Petitioner cannot show the Office materially erred in evaluating the prior art. *Ecto* at 3 (“whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.”). Accordingly, discretionary denial is warranted.

A. Prosecution History

The ’454 patent was filed as application no. 18/148,864 (“the ’864 application”), which is a continuation of application no. 17/907,347 (“the ’347 application”) filed on September 26, 2022, which claims priority to PCT application no. PCT/GB21/50764 filed on March 26 2021. Ex. 1001, 1 (63). A Track One request for accelerated examination was filed along for the ’864 application, which was granted on March 8, 2023. Ex. 1002, 155.

In an Office Action issued May 10, 2023, the Office rejected claim 7 under § 112, and rejected all claims under § 103 based on one or more of the following prior art references:

- Park (US2018/0104396, filed herewith as Ex. 2001), Ex. 1002, 168;
- Garbez (US2018/0008758), Ex. 1002, 168;
- Rigert (US2018/0021491), Ex. 1002, 168;
- Myers (US2008/0275386), Ex. 1002, 172;
- Hwang (US2021/0093761), Ex. 1002, 173;
- O'Toole (US2018/0361040), Ex. 1002, 173;
- Myers (US2008/0275386), Ex. 1002, 177;
- Chang (US2017/0173232), Ex. 1002, 178;
- Grabenkort (US2008/0009815), Ex. 1002, 178; and
- Analytis (US2019/0209748), Ex. 1002, 181.

All of these references were cited by the Examiner in a Notice of References Cited document. Ex. 1002, 184.

Next, a telephonic interview was held on August 2, 2023, where Applicant presented claim amendments. *Id.*, 253. The Examiner noted that “[i]n regards to claim 16, the examiner did not believe that the currently proposed language was supported by the specification as there does not appear to be explicit support for the

outer shell to form a seal WITH the diaphragm,” and found that “it appears that the cap, which form a part of an outer portion of the device, forms a seal with the diaphragm (paragraph 55 of the published application).” *Id.*, 253. The Examiner further noted that “claiming this feature would be sufficient to overcome the current rejection.” *Id.*, 253.

After the Examiner Interview, a Notice of Allowance was mailed, where the Examiner entered the following Examiner’s amendment for claim 16: “a diaphragm cap configured to cover and seal the diaphragm at a front end of the outer shell, the front end being opposite to the rear end, the diaphragm cap forms a central region on a front surface of the outer shell.” Ex. 1002, 283 (underlined text provides the Examiner’s Amendment). The Examiner provided the following reasons for allowance of claim 16: “Park fails to teach among all the limitations or render obvious the diaphragm cap forms a central region on a front surface of the outer shell, in combination with the total structure and function as claimed. Instead, Park teaches a diaphragm cap (cover 400 in fig. 7); however, this cap is entirely positioned within the outer shell (housing 700 in fig. 7) so that the cap does not form a central region on a front surface of the outer shell.” Ex. 1002, 285.

B. Information Disclosure Statements

Several information disclosure statements were filed during prosecution of the ’454 patent. The below listing is provided for convenience.

- First IDS: filed April 20, 2023 (Ex. 1002, 156-163) and considered by the Examiner (*Id.*, 166).
- Second IDS: filed May 15, 2023 (*Id.*, 198-217) and considered by the Examiner (*Id.*, 281).
- Third IDS: filed June 27, 2023 (*Id.*, 242-251) and considered by the Examiner (*Id.* 281).

C. Comparison of Petition Art to Prosecution History

The below table compares the art cited in the Grounds of the Petition to art cited in an Information Disclosures Statement and/or by the Examiner in an office action during prosecution.

Petition Reference	Grounds	Cited in IDS	Cited in an Office Action
Furrer (US 10,149,929)	1A-1F	Related patent by Furrer with similar disclosures cited in IDS. ¹	
Alvarez (US 2015/0283311)	1B-1F	Yes	
Pollen (US 2015/0217035)	1C-1F	Related patent by Pollen with similar	

¹ Petitioner concedes that “Patent Publications having the same inventors and containing similar Figures as Furrer [] were submitted in IDS’s.” Pet., 99 (citing Ex. 1002, 156 (citing Furrer US2015/0314053)).

Petition Reference	Grounds	Cited in IDS	Cited in an Office Action
		disclosures cited in IDS.²	
Weinger (US 2004/0087898)	1D, 2B, & 2D	Yes	
Rigert (US 2018/0021491)	1E, 2C, 2D, & 2F		Yes
Kasting (US 7,677,423)	1F, 2E, 2F	No	
Park (WO2016/186452)	2A-2F		Yes, patent publication claiming priority to PCT application relied upon by Examiner for rejection.
Silver (US 2011/0071466)	2B-2F	No	

As shown in the table above, all but one of Petitioner’s Grounds rely on prior art that was of record during the prosecution of the ’454 patent, and all Grounds rely on prior art that is substantially similar to prior art of record. Significantly, the Examiner relied upon Park as the primary reference for the obviousness rejections raised during prosecution, which provides the same disclosures from Park relied upon by Petitioner as the primary reference for Grounds 2A-2F. *See* Pet. 100,

² Petitioner concedes that “Patent Publications having the same inventors and containing similar Figures as [] Pollen were submitted in IDS’s.” Pet., 99 (citing Ex. 1002, 107 (citing Pollen US2015/0217036 and Pollen US2015/0217037)).

(conceding that U.S. Patent Publication claiming priority to the same foreign application as Park was applied by the Examiner during prosecution.”). Specifically, the Park reference relied upon by the Examiner, US Patent Publication No., US2018/0104396 (Ex. 2001), is a §371 national stage application based on the same Park reference relied upon by Petitioner, i.e., PCT Application No. WO2016/186452, receiving serial no. PCT/KR2016/005271 (Ex. 1009, 1). *See* Ex. 2001, 1 item (86) (showing 371 priority claim to PCT/KR2016/005271, i.e., the Park PCT application.) Thus, there can be no meaningful difference in disclosure between the two documents.

D. Part One of *Advanced Bionics* Is Satisfied

The first part of the *Advanced Bionics* framework involves evaluating “whether the same or substantially the same prior art or argument previously was presented to the Office.” *Ecto* at 3. “Challenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of the *Advanced Bionics* framework.” *Ecto* at 4 (emphasis added). Here, as the Table above shows, all but one of Petitioner’s Grounds rely on prior art that was of record during the prosecution of the ’454 patent, and all Grounds rely on prior art that is substantially similar to prior art of record.

Petitioner challenges only one independent claim, claim 17, of the ’454 patent and a number of its dependent claims. The Petition challenges claim 17 using Park

as is primary reference for Grounds 2A-2F. Pet., 2. Yet, Park was cited by the Examiner in the July 12, 2022 Office Action in rejecting the claims. Ex. 1002, 167-182. The table below illustrates the substantial similarity in the disclosures from Park relied upon in the Petition and the disclosures from Park relied upon by the Examiner in the Office Action :

Claim 17 Limitation	Examiner Rejection Based on Park³	Petitioner's Challenge Based on Park
[17pre] A breast pump system comprising:	Park's " breast pump system." Ex. 1002, 178.	Park's " breast pump. " Pet., 69.
[17a-1] a control unit comprising:	Examiner identifies Park's "pump 800," but states Park does not teach a control unit. Ex. 1002, 179.	Park is "operated" and "not operated" by a controller. Pet., 69.
[17a-2] a battery, and	Examiner identifies Park's " pump 800, " but states Park does not teach a battery. Ex. 1002, 179.	Park's " battery powered electric pump 800. " Pet., 69.
[17a-3] a pump configured to be powered by the battery and to generate negative air pressure; and	Examiner identifies Park's " pump 800, " but states Park does not teach a pump configured to be powered by a battery. Ex. 1002, 179.	Park's " battery powered electric pump 800. " Pet., 69.
[17b] a wearable milk collection hub configured to connect to the control unit via an air line, the	Park's " a wearable milk collection hub (fig. 5) configured to connect to a control unit via	Park's " wearable milk collection hub. " Pet., 70.

³ Patent Owner notes that in the Office Action, the Examiner was addressing claim 16 that ultimately issued as claim 17. Ex. 1002, 178.

Claim 17 Limitation	Examiner Rejection Based on Park³	Petitioner's Challenge Based on Park
wearable milk collection hub comprising:	an air line (fig. 7 shows the hub connecting to a pump via air tube 420 in fig. 7)."	
[17c-1] a breast shield comprising:	Park's " contact housing 100 and cap connector form a breast shield." Ex. 1002, 178.	Park's " contact housing 100 having a protruding part 110, which extends forward and is formed in the portion corresponding to a nipple of a lactating woman." Pet., 72.
[17c-2] a breast flange; and	Same as [17c-1].	Same as [17c-1].
[17c-3] a nipple tunnel extending from the breast flange;	Park's "nipple tunnel comprising a closed end (fig. 5) and a milk port intermediate to the breast flange and the closed end (discharge hole 120 in fig. 5)." Ex. 1002, 179.	Same as [17c-1].
[17d] a diaphragm configured to deform based on the negative air pressure generated by the pump to create negative air pressure in the nipple tunnel;	Park's " membrane 500 " configured to "deform based on the negative air pressure generated by the pump to create negative air pressure in the nipple tunnel." Ex. 1002, 179.	Park's " flow separation membrane 500 is suctioned to the outside through an air nozzle 410, the flow separation membrane 500 is moved." Pet., 73.
[17e] an outer shell comprising a rear end configured to removably attach to the breast shield and, an interior volume between the outer shell and the breast shield defining a chamber to	Park's " housing 700 " comprising "a rear end configured to removably attach to the breast shield (fig. 7), an interior volume between the outer shell and the breast shield defining a chamber to	"Park's storing housing 700 includes a rear end configured to removably attach to the breast shield (close-contact housing 100) and, together with the breast shield, defines a chamber

Claim 17 Limitation	Examiner Rejection Based on Park³	Petitioner's Challenge Based on Park
receive expressed milk; and	receive expressed milk via the milk port.” Ex. 1002, 179.	to receive expressed milk.” Pet., 75.
[17f] a diaphragm cap configured to cover and seal the diaphragm at a front end of the outer shell, the front end being opposite to the rear end, the diaphragm cap forms a central region on a front surface of the outer shell.	<i>Limitation [17f] was later added by both the Applicant and further by Examiner's amendment and was not part of the claim at the time of the Office Action. See Ex. 1002, 178-179.</i>	“Park's diaphragm cover 400 repositioned to the front of the front surface of Park's storing housing 700.” Pet., 76.

As illustrated by the above table, Petitioner's Ground 2 is merely a regurgitation of the same rejection based on Park provided by the Examiner in her May 10, 2023 Office Action rejecting the claims. *See also* Ex. 1002, 178-180. The only modification to the Examiner's rejection provided by Petitioner is to propose Park be combined with Silver for claim limitation [17f], “*a diaphragm cap configured to cover and seal the diaphragm at a front end of the outer shell, the front end being opposite to the rear end, the diaphragm cap forms a central region on a front surface of the outer shell,*” a limitation which was added after the May 10, 2023 Office Action. Specifically, Petitioner proposes the diaphragm cap from Silver be added to the front of Park's breast pump. Pet., 77 (citing Ex. 1010, Fig. 7 and Ex. 1011, Fig. 5). Petitioner cites to Fig. 5 of Silver as teaching the diaphragm and diaphragm cap on the front of the device:

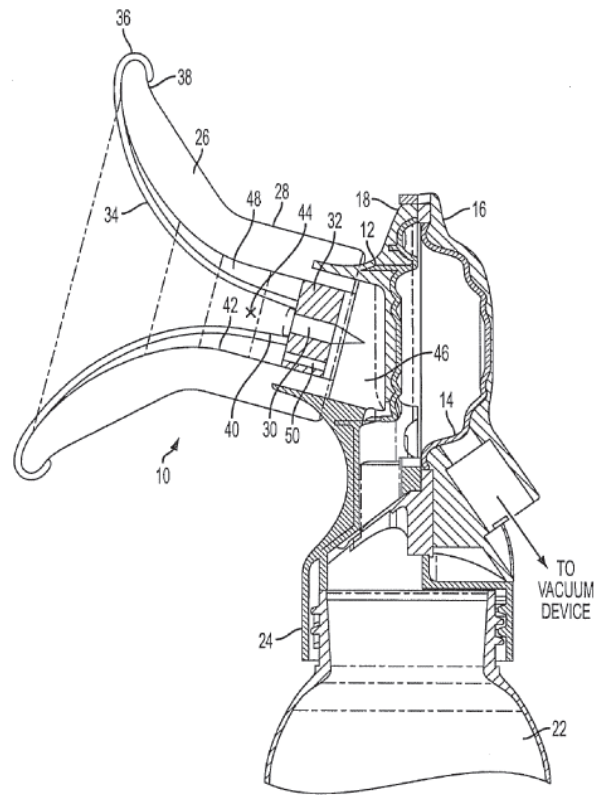
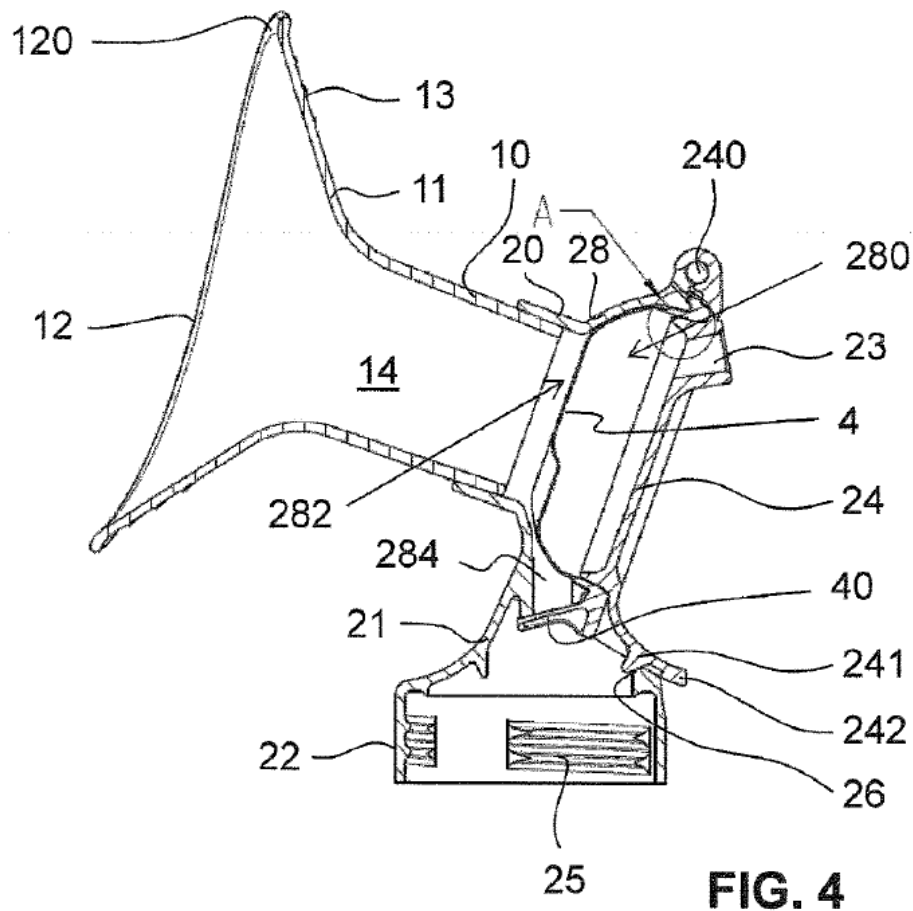


FIG. 5

Pet., 77 (citing Ex. 1010, Fig. 7 and Ex. 1011, Fig. 5). Yet, the record of the '454 patent identified multiple prior art references having breast pump systems with front facing diaphragms and diaphragm caps substantially similar to Fig. 5 of Silver. *See e.g.*, Ex. 1002, 168 (rejecting claims based on Rigert (US2018/0021491) and Garbez (US2018/0008758)). For example, Fig. 4 of Rigert, reproduced below, illustrates a diaphragm cap ("cover 24") positioned at the front end of the outer shell of the device and covering the diaphragm ("diaphragm 4"). Ex. 1008, ¶¶61, 72.



Ex. 1008, 3.

Petitioner's only argument to avoid a discretionary denial under 35 USC §325(d) is that "Silver was not before the Examiner during prosecution of the '454 Patent." Pet., 100. Yet, as the statute provides, discretionary denial considers whether "the same or **substantially the same prior art** or arguments previously were presented to the Office." 35 USC §325(d). As shown above, prior art with disclosures substantially the same to those cited in Silver was before the Examiner during prosecution, such as Rigert. Petitioner fails to provide any argument as to

how Silver is different from the substantially similar prior art of record. Accordingly, the first part of the *Advanced Bionics* framework is satisfied for Grounds 2A-2F, which rely upon Park.

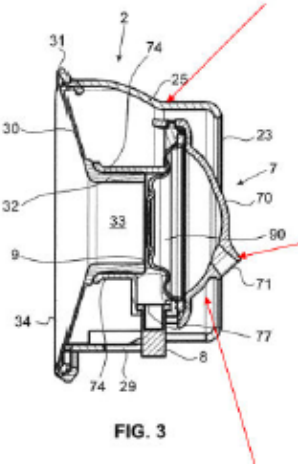
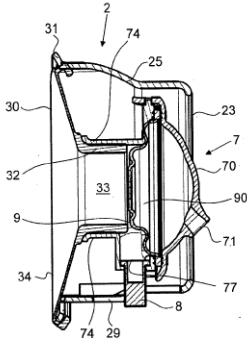
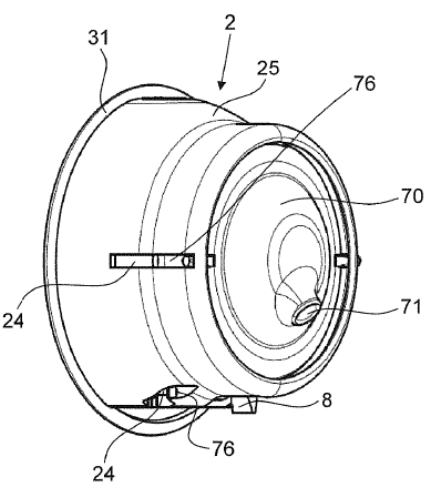
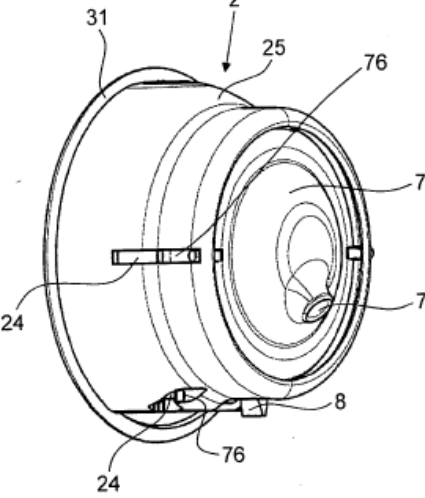
For Grounds 1A-1F, Petitioner's primary reference, Furrer, provides disclosures substantially similar to those in Park. Thus, Grounds 1A-1F based on Furrer are substantially similar to art and arguments previously presented to the Office.

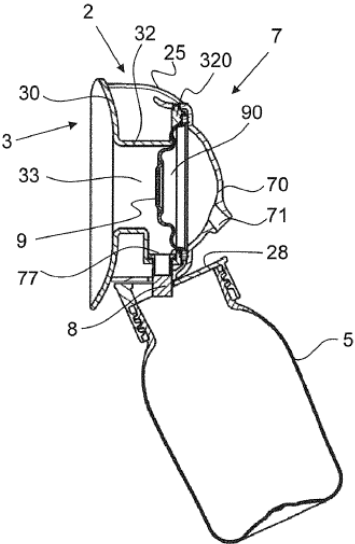
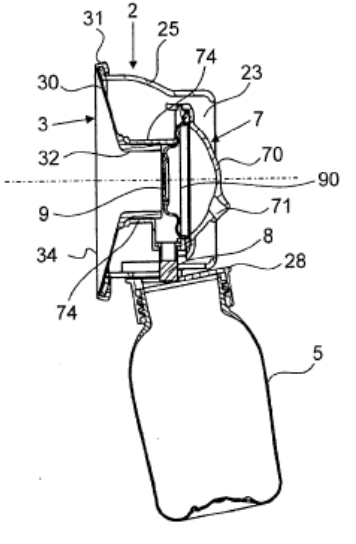
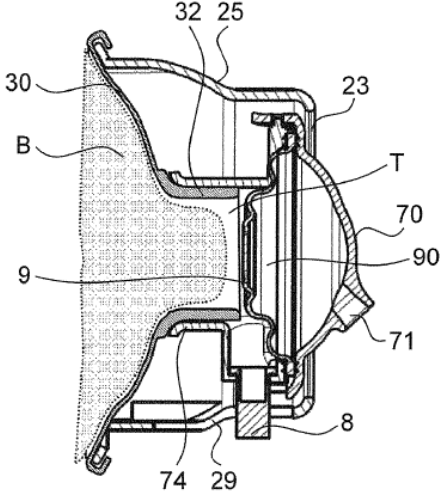
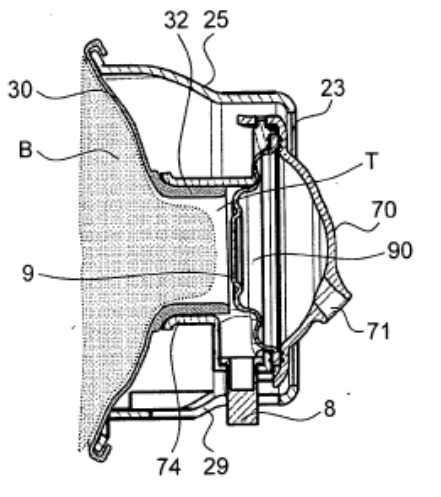
Moreover, Furrer is essentially no different than the Furrer cited during prosecution. Specifically, Petitioner, relies on the Furrer which issued as US Pat. No. 10,149,929 (Ex. 1008, "Furrer '929"). However, a substantially similar Furrer reference, US2015/0314053 (Ex. 2002, "Furrer '053"), was cited in an IDS.⁴ Ex. 1002, 156 (citing Ex, 2002, Furrer '053).⁵ Indeed, as the below table shows, the

⁴ Petitioner concedes that "Patent Publications having the same inventors and containing similar Figures as Furrer and Pollen were submitted in IDS's." Pet., 99 (citing Ex. 1002, 156 (citing Furrer US2015/0314053)).

⁵ The priority applications for Furrer '929 and Furrer '053 were filed on the same day (December 18, 2012) and received sequential serial numbers from the Swiss patent office (2839/12, 2840/12). The applications name identical inventors and the same assignee.

figures from Furrer '929 relied upon in the Petition, reproduced below, are the same or substantially similar to figures the of Furrer '053.

<u>Furrer '929, Fig. 3</u> <u>(Pet., 7, 8, 12, 15, 16, 19)</u>	<u>Furrer '053, Fig. 7</u>
 FIG. 3	 FIG. 7
<u>Furrer '929, Fig. 4</u> <u>(Pet., 7, 12, 16, 19)</u>	<u>Furrer '053, Fig. 8</u>
 FIG. 4	 FIG. 8

<u>Furrer '929, Fig. 1</u> <u>(Pet., 9, 10, 13)</u>  FIG. 1	<u>Furrer '053, Fig. 6</u>  FIG. 6
<u>Furrer '929, Fig. 7</u> <u>(Pet. 19, 20, 21, 22)</u>  FIG. 7	<u>Furrer '053, Fig. 11</u>  FIG. 11

See Pet. 7-29. Despite the substantial overlap in the figures and related disclosures between Furrer '929 and Furrer '053, Petitioner fails to provide any argument as to how Furrer '929 is different from Furrer '053. Accordingly, the first part of the *Advanced Bionics* framework is satisfied for Grounds 1A-1F, which rely upon Furrer '929.

E. The Second Part of Advanced Bionics Shows Discretionary Denial Is Warranted

As it relates to part two of the *Advanced Bionics* framework, as explained in *Ecto*:

“[A] petitioner must provide an analysis [under *Advanced Bionics*, part two] even when the asserted prior art is on an IDS, but the Examiner did not apply the reference. In that analysis, a petitioner must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.

[I]f the Examiner applied the asserted prior art or substantially the same prior art during examination, then a 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* at 5-6 (emphasis added).

Petitioner cannot carry its burden under part two of *Advanced Bionics* in view of the guidance provided by *Ecto*.

Specifically, with respect to Grounds 2A-2F, the Examiner already considered Park during prosecution, and substantively relied on Park in rejecting the claims of the '454 patent. Ex. 1002, 168-182. Indeed, the duplicative attack by Petitioner based on Park, which was already substantively considered by the Office, shows Petitioner's challenge is weak and without merit. In a meritorious challenge, a petitioner would have no reason to recycle the same prior art considered by the Office while juggling combinations of that same art. Yet, that is exactly what Petitioner did here.

Additionally, as to Grounds 1A-1F, the primary reference relied upon, Furrer '929, is substantially similar to Park and a reference that was of record during prosecution, Furrer '053. However, Petitioner fails to provide any explanation with respect to Furrer '929 as to the relevant *Becton Dickinson* factors, including “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis,” “(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art,” and “(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments for rejection.” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017).

For the above reasons, both prongs of *Advanced Bionics* are satisfied for all grounds and the Board should discretionarily deny the Petition on §325(d) grounds.

IV. THE DIRECTOR SHOULD EXERCISE HER DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

The Director should exercise her discretion to deny institution because this is a clear example of a company attempting to use the U.S. patent system as a “tool[] for harassment” to drive a small company out of business while wasting the Patent Office’s time and resources. *See* H.R. Rep. No. 112-98, pt. 1, at 48 (2011).

A. Denying Trial Would Correctly Require Petitioner to Abide by Its Initial Forum Choice

Petitioner Shenzhen Root picked its preferred forum for the adjudication of the validity of Patent Owner’s patents by filing a declaratory judgment action in the District Court for the Western District of Washington. *See* Ex. 2003 at 1 (*W.D. Wash.* case, Dkt. No. 1, Complaint). Specifically, Shenzhen Root filed a declaratory judgment action seeking a declaration of invalidity of Patent Owner’s ’893 patent directed to a breast pump system. *Id.* Congress specifically prohibited a party from requesting an IPR for a patent when that party had already filed a declaratory judgment action of invalidity of that patent. *See* 35 U.S.C. § 315(a)(1) (“An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.”). Thus, the statute dictates that once a party has chosen a District Court for the adjudication of a patent’s validity, that party may no longer avail themselves of the PTAB for adjudication of the validity of that patent.

This statutory framework should be considered by the Director to weigh in favor of a discretionary denial when a party first seeks adjudication of a patent's validity in a District Court and then seeks to switch to the PTAB to adjudicate the validity of a related patent owned by the same defendant. Specifically, the Director should consider Shenzhen Root's selection of the Western District of Washington as the forum for the adjudication of the validity of Patent Owner's '893 patent in determining whether to discretionarily deny institution to challenges of Patent Owner's related patents, including the '454 patent at issue here. Accordingly, the Director should uphold Shenzhen Root's choice of forum for patent invalidity adjudication of Patent Owner's breast pump system patents and deny institution here.

After filing the declaratory judgment action, Shenzhen Root continued its harassment campaign by slowly filing multiple IPR challenges against Patent Owner's patents. *See* IPR2024-00953, IPR2024-01296, IPR2025-00554, and IPR2025-00560. Further, numerous duplicative and repetitive reexamination requests at the USPTO have also been filed against Patent Owner's patents, which requests appear to be the work of Shenzhen Root.

Shenzhen Root's harassment campaign was successful as prior patent owner, Chiaro Technology Limited, was forced into administration (a bankruptcy

proceeding) in the United Kingdom.⁶ Such harassment is not what the IPR process was designed for and is an important reason for the existence of discretionary denials. Shenzhen Root's instant IPR is a classic example of what Congress was concerned about when it gave the Director discretion to institute IPRs. (*See* H.R. Rep. No. 112-98, pt. 1, at 48 (2011) ("While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.").)

Accordingly, Shenzhen Root's original choice of forum and its delayed and repetitive practice of filing IPRs warrants discretionary denial here.

B. The District Court Trial Will Likely Be At Or Before the Time for The Final Written Decision

Fintiv Factor 1 looks to "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). *Fintiv* Factor

⁶ As noted previously, the patent at issue in this IPR was acquired by Willow due to the U.K. equivalent of a bankruptcy proceeding.

2 looks to “proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.” *Id.*

Significantly, no party has requested a stay in the *W.D. Wash.* case. On March 12, 2025, the Court entered a Scheduling Order detailing the deadlines for invalidity and non-infringement contentions and claim construction briefing to be completed by May 30, 2025, a short time period of less than three months. Ex. 2003 at 11, Dkt. No. 152, 1-2. This fast-paced contention and claim construction schedule is in keeping with Judge Evanson’s previous orders in the case, such as the June 28, 2024 Order desiring to have the case proceed “efficiently” and provide a “time-to-trial resembling recent similar patent cases in this District.” Ex. 2003 at 9, Dkt. No. 124; Ex. 2005 at 4. The median time-to-trial for the Western District of Washington is about 31 months. Ex. 2004 (providing median time-to-trail statistics from Docket Navigator).

On April 21, 2025, the Court stayed the litigation involving the ’454 patent due to a District of Delaware Bankruptcy Court order. Ex. 2003 at 12, Dkt. No. 158, 1. The bankruptcy order stayed the *W.D. Wash.* case “until the court rules on a pending motion in a bankruptcy proceeding involving Defendant/Counterclaim Plaintiff Chiaro Technology Ltd.” *Id.* The parties are to “file a joint status report within 14 days of the bankruptcy court’s disposition of this motion.” *Id.*

Given that the *W.D. Wash.* case had already been underway for 24 months at the time of the entry of the stay (seven months shorter than the median time-to-trial for the Western District of Washington) and given Judge Evanson’s desire to provide a “time-to-trial resembling recent similar patent cases in this District” (Ex. 2005 at 4), it appears Judge Evanson would seek to have trial set within seven months of the lifting of the bankruptcy stay. The Board’s Final Written Decision for the instant proceeding would be due in October 2026. Thus, as long as *W.D. Wash.* case resumes before March 2026 (which is likely), the *W.D. Wash.* case would likely be set for trial on or before October 2026.

C. Director Stewart’s Workload Management Factors Favor Denial of Institution

In addition to the above factors, as explained in the March 26, 2025 Stewart Memo, additional relevant considerations may weigh in favor of discretionary denial, including:

- 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; and

- Settled expectations of the parties, such as the length of time the claims have been in force.

Stewart Memo, 2-3. The analysis of these considerations further weighs in favor of a discretionary denial.

1. Stewart Memo Factor 1: Prior Adjudication

As noted above, although no prior forum has adjudicated the validity of the '454 patent, Shenzhen Root did initially select the Western District of Washington as the forum for the adjudication of the validity of Patent Owner's related patent. Accordingly, the existence of invalidity adjudication at the behest of the Shenzhen Root in another forum weighs in favor of a discretionary denial here.

2. Stewart Memo Factor 2: Changes in the Law

As explained previously, the USPTO recently released the new precedential *Ecto* decision, which explained that challenging claims using the same prior art that was previously presented on an Information Disclosure Statement (IDS) is sufficient to satisfy the first part of the *Advanced Bionics* framework and a petitioner must provide an analysis under the second part of *Advanced Bionics* when the asserted prior art is on an IDS, even if the examiner did not apply the reference in a rejection, to explain how the examiner erred in overlooking the prior art. *Ecto* at 4-5. As explained above in § II, Shenzhen Root failed to provide a sufficient explanation as to how the examiner overlooked the prior art. In fact, Shenzhen Root cannot

sufficiently explain how or why it simply recycled the Examiner's prior arguments based on Park. This change in the law is relevant here as it shows a holistic view of discretionary denial principles indicates the Board should discretionarily deny Petitioner's challenge.

3. Stewart Memo Factor 3: Strength of the Challenge

Shenzhen Root's challenge to the '454 patent is without merit. As detailed in § II, the prior art and arguments relied by Shenzhen Root are substantially similar to the arguments already considered by the USPTO during prosecution, and often rely on combinations of three or more references. Accordingly, the weakness of the challenge presented weighs in favor of a discretionary denial.

4. Stewart Memo Factor 4: Settled expectations of the parties

The '454 patent issued on November 7, 2023. This was after Shenzhen Root filed a declaratory judgment action against Patent Owner's related '893 patent on April 28, 2023 in the *W.D. Wash.* case. Ex. 2003 at 1. Accordingly, Shenzhen Root would have been aware of the issuance of patents to Patent Owner related to the '893 patent. Thus, the settled expectations of the parties weighs in favor of a discretionary denial. See *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363 et al., Paper 10, 2-3 (P.T.A.B. June 6, 2025).

V. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Board discretionarily deny the Petition and decline to institute a trial in this IPR.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: June 16, 2025

By: /Heath J. Briggs/
Heath J. Briggs (Reg. No. 54,919)
Greenberg Traurig, LLP
1144 15th St. Suite 3300
Denver, CO 80202
Telephone: 303-685-7418
Facsimile: 720-904-6118
BriggsH@gtlaw.com

Counsel for Patent Owner

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

This Request complies with the requirements of 37 C.F.R. § 42.24. As calculated by the word count feature of Microsoft Word, it contains 5,241 words, excluding the words contained in the Table of Contents, Table of Authorities, List of Exhibits, this Certification and the Certificate of Service.

GREENBERG TRAURIG, LLP

Date: June 16, 2025

By: /Heath J. Briggs/
Heath J. Briggs (Reg. No. 54,919)
Greenberg Traurig, LLP
1144 15th St. Suite 3300
Denver, CO 80202
Telephone: 303-685-7418
Facsimile: 720-904-6118
BriggsH@gtlaw.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served on the following counsel via electronic mail:

Michael Hawkins (Reg. No. 57,867)

hawkins@fr.com

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

Tel: 612-337-2569

Fax: 877-769-7945

Craig A. Deutsch (Reg. No. 69,264)

Terry Stalford (Reg. No. 39,522)

Yong Peng (Reg. No. 76,048)

Ryan Chowdhury (Reg. No. 74,466)

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

Tel: 202-783-5070

Fax: 877-769-7945

Email: IPR58498-0005IP1@fr.com; PTABInbound@fr.com

GREENBERG TRAURIG, LLP

Date: June 16, 2025

By: /Heath J. Briggs/

Heath J. Briggs (Reg. No. 54,919)

Greenberg Traurig, LLP

1144 15th St. Suite 3300

Denver, CO 80202

Telephone: 303-685-7418

Facsimile: 720-904-6118

BriggsH@gtlaw.com

Counsel for Patent Owner