

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 IPR2025-00560
Patent No. 11,813,381

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

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LIST OF EXHIBITS

Exhibit	Description
2001	U.S. Patent No. 12,280,186
2002	File History of U.S. Patent No. 12,280,186
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”) and the Board’s Notice Extending the Deadline for Discretionary Briefing dated April 24, 2025 (Paper 8), 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. 11,813,381 (“381 Patent” or “the Challenged 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 '381 Patent

The '381 patent, titled “Breast Pump System,” is part of a large family of patents relating to novel and nonobvious in-bra breast pumping systems. The '381 patent discloses “a breast pump system,” wherein “one implementation of the system is a wearable, electrically powered breast pump system for extracting milk from a mother.” Ex. 1001, 1:20-23. The '381 patent notes that then-existing wearable breast pump systems suffered from several drawbacks such as “large and bulky device[s]” and collapsible collection bags that make it difficult for the user to extract their milk from the bag. Ex. 1001, 2:20-57.

As shown in the annotated Figure 5 below, the '381 patent discloses the improved breast pump system that includes a housing, a breast shield 7, and a milk collection container 3, where the housing and breast shield are coupled together via a separate, deformable diaphragm. Ex. 1001, 5:47-65, 6:2-8.

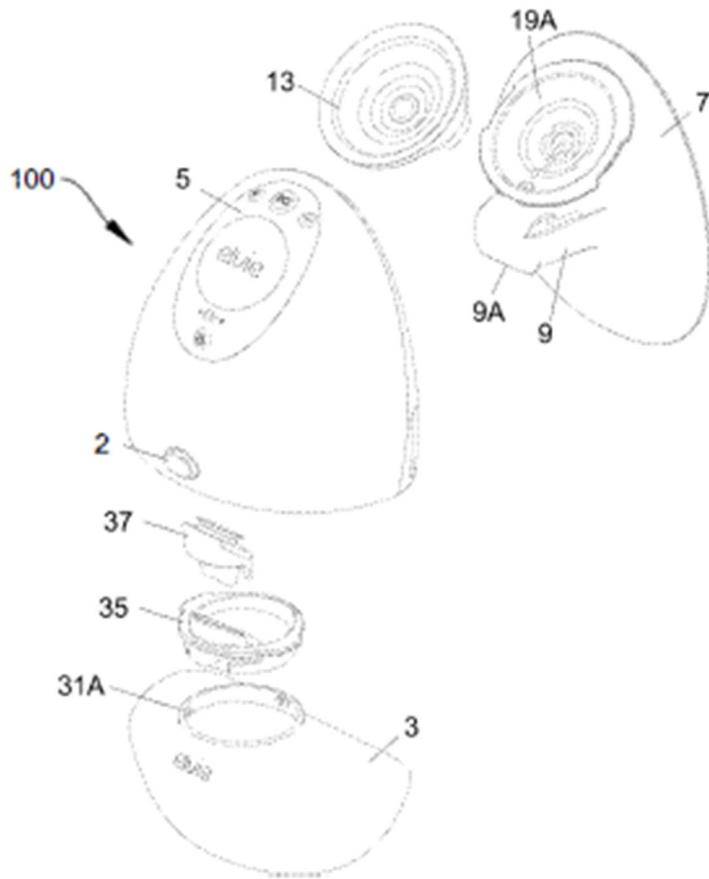


FIGURE 5

The breast shield engages with a user's breast and "defines a milk-flow path from the inner surface of the breast shield 7A, through the breast shield nipple tunnel 9 and into the milk collection container 3." *Id.*, 9:48-51.

B. Patent Owner

After the filing of the petition for this IPR on February 4, 2025, the ownership for the '381 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.

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 is related to the ’381 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 the petition for the instant proceeding against the ’381 patent. Subsequently, on Mar. 6, 2025, Petitioner filed *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2025-00554 against

Patent Owner's U.S. Patent No. 11,806,454, a related patent also directed to a wearable breast pump.

Multiple *ex parte* reexamination requests have also been filed against U.S. Patent No. 11,357,893, a relative of the '381 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 ("the '893 Patent"). *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) (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 ’381 patent was filed as application no. 17/203,292 (“the ’292 application”), which is a continuation of application no. 17/181,057 (“the ’057 application”), which is a continuation of application no. 16/009,547, now U.S. Patent No. 10,926,011 (“the ’011 patent”). The ’057 application was granted as U.S. Patent No. 12,280,186 (“the ’186 patent”). U.S. Patent No. 11,413,380 (“the ’380 patent”) also claims priority to the ’057 and ’547 applications, and is the subject of a related *inter partes* review proceeding (IPR2024-01296).

The prosecution of the ’381 patent was extensive. In a first office action issued June 24, 2021, various § 112 rejections were issued and the claims were also rejected based on various double patenting rejections, including one involving the ’057 application and the prior art of:

- Makower’118 (US2017/0072118); *see* Ex. 1002 at 483-85, 490;
- Yodfat (US2011/0009824); *see* Ex. 1002 at 485;
- Khalil (US2013/0023821); *see* Ex. 1002 at 485-492;
- Vogelin (US2007/0179439); *see* Ex. 1002 at 486;
- Rigert (US2018/0028733); *see* Ex. 1002 at 486;
- Guthrie (US20160220745); *see* Ex. 1002 at 487;

- Miller (US2016/0325031); *see* Ex. 1002 at 487;
- Phillips (US2016/0296682); *see* Ex. 1002 at 488;
- Thompson (US7662018); *see* Ex. 1002 at 488;
- Makower'794 (US2016/0206794); *see* Ex. 1002 at 490-91;
- Takeuchi (US2017/0043065); *see* Ex. 1002 at 491;
- Chen (US2014/0031744); *see* Ex. 1002 at 491;
- Mendoza (US6277936); *see* Ex. 1002 at 492;
- Baker (US20090281485) *see* Ex. 1002 at 492.

All of these references were cited by the Examiner in a Notice of References Cited document. Ex. 1002 at 568-69.

Next, a telephonic interview was held on September 23, 2021, where Applicant presented claim amendments. *Id.* at 683 and 690-92. Applicant then filed a response with amended claims and argued the claims were compliant with § 112. *Id.* at 677-86.

The Examiner then issued another office action rejecting all claims except claim 29. *Id.* at 811-835. The Examiner rejected the claims under §§102-103 based on prior art involving Myers (US2008/0275386) and the previously cited art of Miller, Makower'118, Makower'794, Takuechi, and Baker. *Id.* at 814-23. The Examiner also maintained the double patenting rejections. *Id.* at 823-32.

In a response filed May 20, 2022, Applicant again amended the claims and argued the prior art failed to disclose or render obvious the claims. *Id.* at 1081-1100.

On July 12, 2022, the Examiner rejected all claims for being obvious based on Khalil (and other prior art) while maintaining the double patenting rejections. *Id.* at 1103-1170. In combination with Khalil, the Examiner cited the previously cited art of Miller, Phillips, Thompson, Makower'794, Baker, and Myers, and the new references of Chang (US2018/0333523), Guthrie (US2016/0220743) and Tanaka (US2017/0035951). *Id.* at 1107-1120.

Next, a telephonic interview occurred on October 4, 2022 in which the Examiner indicated that she did not believe the amendments were sufficient to overcome Khalil. *Id.* at 1463-66. Another telephonic interview was held October 7, 2022, in which the Examiner indicated she did believe certain amendments were sufficient to overcome Khalil in relation to pending claim 1, but not pending claim 31. *Id.* at 1486-88, 2203.

Next, on October 11, 2022, Applicant filed a response by amending claims and arguing the Khalil reference (and the other prior art cited in the prior office action) failed to teach the amended claims. *Id.* at 1468-81. A first notice of allowance was then mailed (*Id.* at 2246-55), where the Examiner indicated Khalil and Myers were the closest prior art of record (*Id.* at 2252). A corrected notice of allowance was later mailed, which entered an examiner's amendment and referred the reader to the

previous reasons for allowance. *Id.* at 2364-68. A Rule 312 amendment was later filed and accepted. *Id.* at 2370-86.

Next, the USPTO withdrew the application from issuance and re-opened prosecution to correct minor antecedent basis issues with claim 1. *Id.* at 2387-89, 2409. The USPTO then re-allowed the case with various examiner amendments. *Id.* at 2400-09.

B. Information Disclosure Statements

Several information disclosure statements were filed during prosecution of the '381 patent. The below listing is provided for convenience.

- First IDS: filed March 16, 2021 (Ex. 1002 at 187-201) and considered by the Examiner (*Id.* at 649-661).
- Second IDS: filed September 5, 2021 (*Id.* at 665-70) and considered by the Examiner (*Id.* at 924-25).
- Third IDS: filed October 14, 2021 (*Id.* at 693-695 and 801-810) and considered by the Examiner (*Id.* at 921-23).
- Fourth IDS: filed May 20, 2022 (*Id.* at 941-44) and considered by the Examiner (*Id.* at 1260-62).
- Fifth IDS: filed September 16, 2022 (*Id.* at 1264-65 and 1433-34) and considered by the Examiner (*Id.* at 2362).

- Sixth IDS: filed November 1, 2022 (*Id.* at 1489-92) and considered by the Examiner (*Id.* at 2267-70).
- Seventh IDS: filed December 06, 2022 (*Id.* at 2207-10) and considered by the Examiner (*Id.* at 2271).
- Eighth IDS: filed January 09, 2023 (*Id.* at 2229) and considered by the Examiner (*Id.* at 2265).
- Ninth IDS: filed July 19, 2023 (*Id.* at 2391-99) and considered by the Examiner (*Id.* at 2510-12).

C. Comparison of Petition Art to Prosecution History

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

Petition Reference	Grounds	Cited in IDS	Cited in an Action
Chang (US2018/0333523)	All	<i>Yes (Third IDS)</i>	<i>Yes</i>
Fang (CN205913571U)	All	No	No
Kurihara (US2016/0271305)	2A-2D, 4A-4D	<i>Yes (First IDS)</i>	No
Khalil (US2013/0023821)		<i>Yes (First IDS)</i>	<i>Yes</i>
Yuen629 (US7641629)	1B, 2B, 3B, 4B	<i>Yes (Fourth IDS)</i>	No
Makower794 (US20160206794)	1C, 2C, 3C, 4C	<i>Yes (First IDS)</i>	<i>Yes</i>
Guthrie002 (US10483002)	1D, 2D, 3D, 4D	<i>Yes (First IDS)</i> as US2016/0220743	<i>Yes</i> , as US2016/0220743

As shown, all Grounds rely on the combination of Chang and Fang, with Chang being the primary reference. For all of Petitioner’s Grounds, the only reference not cited during prosecution of the ’381 patent is Fang, yet Fang was cited in an Information Disclosure Statement filed during prosecution of the ’186 patent. *See* Ex. 2001 at 3; Ex. 2002 at 270 (initialed IDS statement from October 16, 2024), 358-372 (English translation of Fang). Indeed, during prosecution of the ’186 patent, the same Examiner (Courtney Fredrickson) rejected similar claims based on Khalil while also considered Fang before issuing a Notice of Allowance. Ex. 2002 at 248-253 (Notice of Allowance), 270 (IDS with Fang cited and considered by the Examiner), 1396-1407 (claim amendments and remarks based on Khalil rejection prior to allowance), and 1423-1462 (the Examiner’s last office action on the merits prior to allowance, rejecting claims based on Khalil).

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 of Petitioner’s Grounds involve Chang in combination with Fang.

Yet, Chang was cited by the Examiner during examination and Fang is cumulative to other art cited in the IDS.

Specifically, the '381 patent includes a single independent claim (claim 1). The Petition challenges claim 1 across 4 grounds, all of which rely on combinations involving Chang and Fang. (Petition at 6-7.) Ground 1 challenges claim 1 based on Chang and Fang alone. Yet, Chang was cited by the Examiner in the July 12, 2022 action and in an IDS considered by the Examiner. Ex. 1002 at 665, 924-25, 1107-1120. Chang is also listed on the face of the '381 patent. Ex. 1001 at 3.

Moreover, Chang is merely cumulative to the teachings of Khalil, the reference upon which the Examiner applied many times to reject claims during prosecution. Indeed, the Examiner and Petitioner both assert Khalil and Chang disclose the same limitations of claim 1 of the '381 patent:

Claim 1 Limitation	Examiner Rejection Based on Khalil	Petitioner's Rejection Based on Chang
1. A breast pump device comprising:	July 12, 2022, Action at 4-5 (Ex. 1002 at 1107-08), citing Khalil at FIG. 9, 0032	Petition at 25, citing Chang at 0001.
a self-contained, in-bra wearable device comprising:	<i>Id.</i>	Petition at 25, citing Chang at 0004, 0011, 0019.
a diaphragm configured to prevent milk from reaching an air pump by forming a seal around its outer edge;	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIG. 11, 0057	Petition at 26, citing Chang at 0072, 0080, FIG. 6A

Claim 1 Limitation	Examiner Rejection Based on Khalil	Petitioner's Rejection Based on Chang
a housing that includes:	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIG. 9	Petition at 27, citing Chang at 0071, 0073, FIGS. 1A, 6A
a battery, and	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at 0051	Petition at 28, citing Chang at 0072, 0080, FIG. 6A
the air pump powered by the battery and configured to generate negative air pressure by driving the diaphragm;	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIG. 11, 0032	Petition at 28, citing Chang at 0072, 0080, FIG. 6A
a breast shield comprising a breast flange and a nipple tunnel extending from the breast flange,	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIGS. 4-5, 7, 10	Petition at 29, citing Chang at 0071, 0090, FIG. 4
the nipple tunnel comprising a closed end and a milk port intermediate to the breast flange and the closed end,	N/A	Petition at 30-31, citing Chang at 0071, 0090, FIG. 6A, FIG. 14
and the breast shield being separate from the diaphragm;	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIG. 11	Petition at 32-33, citing Chang at 0021, 0022, 0071, 0081, 0086, 0090, 0092, 0099-0100, 0105
and a milk container that is configured to attach to the housing and receive expressed milk via the milk port.	July 12, 2022, Action at 5 (Ex. 1002 at 1108), citing Khalil at FIGS. 4-5, 7, 10-11	Petition at 33, citing Chang at 0008, 0010, 0019, 0021, 0023, 0081, 0086, 0092, 0099-0100, 0106-07, FIGS. 11A-11E

Recognizing that reusing Khalil in its IPR petition would be unwise, Petitioner appears to have simply located Khalil's closest proxy (Chang) and recycled the Examiner's Khalil arguments via Chang, supplemented by Fang. Such an approach

should be rejected as the statute prohibits expending the Board's resources for such duplicative and repetitive proceedings.

Fang was not included in an IDS nor cited by the Office during prosecution of the '381 patent, but Fang was cited during prosecution of the '057 application, which resulted in the '186 patent, and was considered by the Examiner prior to allowing the '057 application. Ex. 2002 at 248-253 and 270 (Notice of Allowance issued concurrent with review of IDS and the Fang reference). Indeed, like the '381 patent, the same Examiner (Courtney Fredrickson) rejected the claims of the '057 application based on Khalil. *Id.* at 1423-62 (rejecting claims based on Khalil in the action that immediately preceded allowance). In doing so, the Examiner expressly considered Fang and rejected its combination with Khalil. Ex. 2002 at 270 (considering Fang before allowing the '186 patent to grant). Implicit in this rejection is the Examiner's rejection of a combination of Chang and Fang because Chang is nothing more than a proxy for Khalil in Petitioner's grounds, as explained above.

Moreover, Fang is cumulative to other references already considered by the Office during prosecution. Specifically, Petitioner relies on Fang's pump-diaphragm arrangement for its combination with Chang. Petition at 19-24. Yet, the Examiner already considered various pump-diaphragm arrangements, including those disclosed by Khalil and Yuen629 (Ex. 1011). Indeed, the Examiner already argued Khalil disclosed the diaphragm limitations Petitioner contends are taught by Fang:

“Regarding claims 1 and 31, Khalil discloses a breast pump device comprising: ... ‘a diaphragm configured to prevent milk from reaching the pump by forming a seal around its outer edge (membrane 3 in fig. 11; paragraph 57 discloses the diaphragm is sealed through outer and inner securing beads 30/31 to prevent milk from accessing the pump);”
Ex. 1002 at 1108.

It is no wonder that the Examiner failed to reject the claims of the related ’057 application based on Fang given the Examiner already rejected them based on Khalil.

Regarding Yuen692 (Ex. 1011; cited by Petitioner for a dependent claim), this reference was cited in Applicant’s Fourth IDS and considered by the Examiner. Ex. 1002 at 941, 1260. Yuen692 discloses pump-diaphragm arrangements comparable to those of Fang. Ex. 1011 at FIGS. 4, 9-10 and 3:15-18 (“Housed in the head portion 22 is a pump motor 42 for operating a pump diaphragm 44 for generating a low pressure (vacuum) in the breast pump 10.”).

Accordingly, the combination of Chang and Fang is duplicative of the prior art already considered by the Office during prosecution, including Khalil and Yuen629, thereby satisfying the first part of the *Advanced Bionics* framework.

Ground 2 challenges claim 1 based on Chang, Fang and Kurihara (US2016/0271305). However, Kurihara was also cited in an IDS and considered by the Office. Ex. 1002 at 195, 656. Kurihara is also listed on the face of the ’381 patent.

Ex. 1001 at 3. Thus, the art and arguments presented in Ground 2 are also cumulative to those already presented to and considered by the Office.

Ground 3 challenges claim 1 based on Chang, Fang and Khalil (US2013/0023821). However, as shown previously, Khalil was cited extensively during prosecution of the '381 patent, having been cited by the Examiner across all office actions. Khalili is also listed on the face of the '381 patent. Ex. 1001 at 2. Thus, the art and arguments presented in Ground 3 are also cumulative to those already presented to and considered by the Office.

Ground 4 challenges claim 1 based on Chang, Fang, Khalil and Kurihara. As explained above, the Office already considered all of Chang, Khalil and Kurihara during prosecution, and Fang is cumulative to prior art teachings already of record. Thus, the art and arguments presented in Ground 4 are also cumulative to those already presented to and considered by the Office.

Petitioner's challenge to the dependent claims also rely on prior art already considered by the Office. As explained previously, Makower794 and Guthrie002 were already applied by the Examiner during prosecution, and Yuen629 was cited in an IDS.

Accordingly, the first part of the *Advanced Bionics* framework is satisfied.

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, the Examiner already considered Chang, Khalil and Kurihara during prosecution, and substantively relied on Khalil and Chang in rejecting the claims. Furthermore, as shown previously, Chang is a proxy for Khalil and Fang is cumulative to other art already expressly considered by the Examiner, including being cumulative to Khalil. Indeed, the duplicative attack of the same claim (claim 1) based on three references already of record and 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. The use of 4-6 references to challenge claims (e.g., as per Grounds 3B-3C and Grounds 4A-4D) confirms that Petitioner's challenge is weak and relies on prior art already considered and rejected by the Office.

For the above reasons, both prongs of *Advanced Bionics* are satisfied 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, they 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 ’381 patent. 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.¹ 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.").)

¹ As noted previously, the patent at issue in this IPR was acquired by Willow due to the U.K. equivalent of a bankruptcy proceeding.

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 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 '381 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 August 2026. Thus, as long as *W.D. Wash.* case resumes before February 2026 (which is likely), the *W.D. Wash.* case would likely be set for trial on or before August 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; and
- The strength of the unpatentability challenge.

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 '381 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 just 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 with Khalil's closest proxy (Chang). 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 '381 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 four or more references. Accordingly, the weakness of the challenge presented weighs in favor of a discretionary denial.

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,
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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 5,227 words, excluding the words contained in the Table of Contents, Table of Authorities, List of Exhibits, this Certification and the Certificate of Service.

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CERTIFICATE OF SERVICE

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