

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ROOT TECHNOLOGY CO., LTD.,
Petitioner,

v.

CHIARO TECHNOLOGY LTD.,
Patent Owner.

Case IPR2025-00560
Patent 11,813,381

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

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EXHIBITS

Exhibit	Reference
1001	U.S. Patent No. 11,813,381 to Jonathan O'Toole et al. ("the '381 patent")
1002	File History of Application 17/203,292 ("the File History")
1003	Declaration of Ryan Bauer in Support of Petition
1004	File History of Application No. 16/009,547
1005	File History of Application No. 17/181,057 (as of October 2, 2024)
1006	Curriculum Vitae of Ryan Bauer
1007	U.S. Patent Application Publication No. 2018/0333523 ("Chang")
1008	CN Utility Model CN205913571U ("Fang CN")
1009	Certified English Translation of CN Utility Model CN205913571U ("Fang")
1010	U.S. Patent Application Publication No. 2013/0023821 ("Khalil")
1011	U.S. Patent No. 7,641,629 ("Yuen629")
1012	PCT Publication No. WO 2016/186452 ("Park KR")
1013	Certified English Translation of PCT Publication No. WO 2016/186452 ("Park")
1014	U.S. Patent Application Publication No. 2016/0206794 ("Makower794")
1015	U.S. Patent No. 10,483,002 ("Guthrie002")
1016	U.S. Patent Application Publication No. 2016/0271305 ("Kurihara")

Exhibit	Reference
1017-1030	RESERVED
1031	AU Patent Application Publication No. 2010300058 (“Weber”)
1032	U.S. Patent Application Publication No. 2017/0080135 (“Chen”)
1033	U.S. Application Publication No. 2015/0217033 (“Pollen”)
1034	U.S. Application Publication No. 2012/0116299 (“Tack”)
1035	U.S. Patent Application Publication No. 2016/0082166 (“Guthrie166”)
1036	U.S. Application Publication No. 2015/0157775 (“Hu”)
1037	PCT Publication No. WO 2002/102437 (“Myers437”)
1038	PCT Publication No. WO 2008/137678 (“Myers678”)
1039	U.S. Patent Application Publication No. 2007/0219486 (“Myers486”)
1040	U.S. Patent Application Publication No. 2009/0281485 (“Baker”)
1041-1050	RESERVED
1051	Declaratory Judgment Complaint, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), filed 4/28/2023
1052	Chiaro Technology Ltd.’s Answer, Defenses, and Counterclaims to Plaintiff’s Amended Complaint, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), filed 8/14/2023
1053	Chiaro Technology Ltd.’s Amended Counterclaims, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), filed 5/1/2024

Exhibit	Reference
1054A	Elvie's Disclosure of Asserted Claims and Initial Infringement Contentions Under Local Patent Rule 120, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), served 6/10/2024
1054B	Elvie's Disclosure of Asserted Claims and Supplemental Infringement Contentions Under Local Patent Rule 120, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), served 8/1/2024
1054C	Exhibit 15 – U.S. Patent No. 11,813,381 – Infringement Claim Chart for Momcozy S9 Product, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), served 6/10/2024
1055	Order on Motion to Continue Pretrial Deadlines and Strike Trial Date, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), issued 6/28/2024
1056	Momcozy's Motion to Continue Pre-Trial Deadlines and Strike Trial Date, <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), issued 6/4/2024
1057	Docket of <i>Shenzhen Root Technology Co., Ltd., v. Chiaro Technology, Ltd.</i> , Case No. 23-cv-00631 (W.D. Wash.), as of October 02, 2024
1058	May 14, 2025 <i>Sotera</i> Stipulation
1059	IPR2024-01296, Exhibit 3002, Board Correspondence
1060	W.D. Wash. Case, Dkt. No. 157, Patent Owner Chiaro Technology Suggestion of Bankruptcy (April 17, 2025)
1061	W.D. Wash. Case, Dkt. No. 152, Scheduling Order extending particular deadlines (March 12, 2025)

I. INTRODUCTION

Institution should be decided on the robust merits, which the Patent Owner never contested in any Preliminary Response here. Patent Owner has never presented any patentability argument in this IPR. Nothing. It is telling.

The parallel district court litigation is stayed pending resolution of a foreign bankruptcy proceeding. The stay is indefinite. It was induced by the original owner (Chiaro Technology Ltd.), and now utilized to benefit Patent Owner. Here, Patent Owner cites to no evidence or exhibit indicative of when the United Kingdom “administration” proceeding will end, when thereafter the U.S. Bankruptcy Court for the District of Delaware will eventually lift the stay for U.S. actions, and when the District of Washington will then subsequently lift the stay for this patent case. Instead, Patent Owner boldly assumes all of these steps will simultaneously occur on the same date and with a rapidity far greater than any statistical norm. Patent Owner assumes too much.

Given the early timing of the Petition relative to the nascent status of the parallel litigation when the litigation was stayed, any prospect of the district court trial being close in time with the final written decision is purely imaginative. At this stage, it is unrealistic that the litigation trial would occur any earlier than 2027. Not only was the Petition filed within a few months of receiving Patent Owner’s infringement contentions for the ’381 patent, it was filed early in the life of the

'381 patent—within 15 months of issuance. Beyond that, Petitioner submitted a *Sotera* stipulation here to mitigate any theoretical overlap with the district court. Unsurprisingly, Patent Owner's briefing never mentioned it.

Discretionarily denying institution under § 325(d) and *Advanced Bionics* is likewise unwarranted. There is no dispute that every ground in the Petition is based on prior art never presented to the examiner during examination (e.g., Fang). Patent Owner's labeling of Chang and Fang as "cumulative" is discredited by its own admissions, and Patent Owner never acknowledged the Board's astute finding (in the institution of IPR2024-01296) on this exact question.

Again, critically, the merits of the Petition are robust, uncontested, and underpinned by corroborated expert testimony. Patent Owner declined to submit a Preliminary Response or mention any patentability argument in this proceeding. This tepid approach is not surprising—similar prior art grounds challenging similar claims of the parent '380 Patent (U.S. 11,413,380) were rightfully instituted by the Board in IPR2024-01296. There too, Patent Owner could not muster any meaningful challenges to the merits, declining even to submit any Response after institution of IPR. *See* EX1059 (Patent Owner).

The only "efficient" path for the parties to achieve a resolution of these invalidity issues is timely institution of IPR here, not a discretionary denial, which only obliges a lengthy wait for a restart of an indefinitely stayed litigation.

II. PATENT OWNER'S BRIEF NEGLECTS CRITICAL ASPECTS OF THE PROCEDURAL POSTURE OF THE PARALLEL LITIGATION

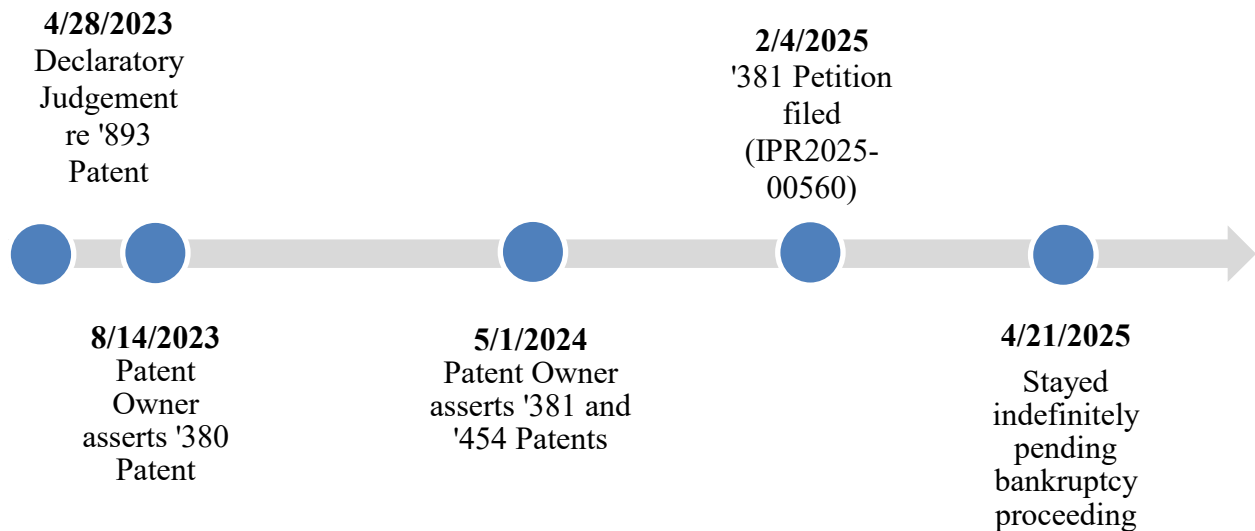
Patent Owner's Brief at pages 5-6 identifies the parallel district court litigation in W.D. Wash., but fails to mention critical facts. The parallel district court litigation is stayed indefinitely, and remains at a nascent stage prior to claim construction or any meaningful fact discovery. There is no scheduled trial date, nor was a trial date scheduled prior to the stay. As a result, this is simply not a case in which the Board's final written decision would follow (or even be contemporaneous with) District Court trial in the parallel litigation, or where there is overlapping effort between the two forums.

A. Patent Owner's harassment through a series of additional infringement allegations delayed the parallel litigation and dictated the petition filing sequence it now complains of.

Patent Owner's Brief fails to mention Patent Owner's overtly litigious tactics that were counter to efficient resolution. Patent Owner sequentially injected additional patents into the litigation over the course of more than a year after the initial complaint, dictating the sequential filing of IPR petitions it now complains of. Indeed, as detailed below, Patent Owner's sequence of new patent infringement allegations introduced so much delay into the litigation that the district court had to annul its original schedule and completely remove any jury trial date from

the schedule altogether. All of it was induced by Patent Owner’s piecemeal, litigious attacks—not at the behest of Petitioner.

The district court docket reveals the truth—that Patent Owner introduced the ’380 patent almost four months after the litigation commenced, and later introduced the ’381 and ’454 patents (U.S. 11,806,454) more than a year after litigation commenced:



See EX1052, 26; EX1053, 2; *see also* EX2003, 5 (Dkt. No. 69 (Answer and Counterclaim), 8 (Dkt. No. 114 (Amended Counterclaim), 12 (Dkt. No. 158 (Order Staying Pending Delaware Bankruptcy Proceeding)).

Despite Patent Owner’s litigious conduct, Patent Owner shockingly alleges that it was Petitioner who engaged in a “harassment campaign.” Patent Owner’s Brief, 20-21. Not so. As illustrated above, the only “harassment campaign” was

by Patent Owner. No IPR petitions would have been filed if Patent Owner did not partake in its litigious conduct via sequentially-spaced injections of new patents into what was originally a single-patent litigation ('893 patent only).

B. Patent Owner's assertion that Petitioner should be limited to resolving validity in W.D. Wash. ignores the procedural history and is contrary to statute.

Patent Owner alleges that Petitioner picked W.D. Wash. as a “preferred forum” for the adjudication of “Patent Owner’s patents,” but this defies reality. Patent Owner’s Brief, 19 (emphasis added). Petitioner selected W.D. Wash. for adjudication of the validity of the '893 patent only. From there, it was Patent Owner alone that sequentially injected all of its other patents into that forum. *Supra*, Section II.A. All of Patent Owner’s allegations about Petitioner’s “preferred forum” ignore this truth.

And even if W.D. Wash. could be characterized as the “preferred forum” for the '893 patent, there is no dispute that the statutory framework set forth in §315(a)(1) was fully honored. The declaratory judgement action against the **'893** patent does not weigh in favor of discretionary denial of this petition against the subsequently asserted **'381** patent. Patent Owner’s brief argues otherwise, but this ignores the line drawn by Congress. The “civil action” restriction §315(a)(1) does not extend to “related” patents, as contended by Patent Owner’s flawed theory. Patent Owner’s Brief, 20 (“a related patent owned by the same defendant”).

Again, Petitioner did not introduce the '381 patent (or the '380 or '454 patents) into the W.D. Wash. litigation. It was Patent Owner that injected the '381 patent into the W.D. Wash. litigation more than a year later and as part of a sequence of spaced apart counterclaim complaints each adding new patents. Each time Petitioner was faced with these sequenced injections of new patent assertions by Patent Owner, Petitioner consistently pursued its preferred forum for those patents—the PTAB. For the '381 patent, Petitioner promptly prepared and filed the Petition at the PTAB within a few months of receiving Patent Owner's infringement contentions for the '381 patent and within 15 months of its issuance. There can be no dispute that Petitioner always preferred the PTAB as the forum for addressing the '381 patent. That is why Petitioner did not fight the stay of the district court litigation. That is why Petitioner filed a *Sotera* stipulation favoring resolution before the PTAB and preventing overlap with the district court.

To be clear, Patent Owner's overly litigious tactics had the effect of substantially delaying the district court schedule, making efficient resolution in a district court impossible. In view of Patent Owner's repeated expansion of the number of patents in the case, the District Court struck the trial schedule in its entirety, and adopted a reset (partial) schedule that set some initial dates through claim construction briefing in February 2025 while leaving subsequent dates, including a trial date, undefined. EX1055, 3-5; EX1056, 11-12. That schedule was

subsequently delayed further, including claim construction briefing dates scheduled in May, and with the claim construction hearing, fact discovery, trial, etc., delayed indefinitely. *See* EX1061, 1-2.

Shortly thereafter, on April 17, Patent Owner (Chiaro) filed a Suggestion of Bankruptcy, and on April 21, 2025, the Court stayed the litigation indefinitely. EX1060. Throughout Patent Owner's serial harassment through the staged introduction of multiple patents, and a stalled schedule, Petitioner has consistently and justifiably sought the only efficient option—adjudication of invalidity at the PTAB.

Discretionary denial requested by Patent Owner would serve only to further postpone resolution and increase inefficiencies, improperly rewarding Patent Owner's litigious delay tactics and depriving all parties of Congress's stated purpose of providing a "quick and cost effective alternative." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). Here, given the indefinite stay of the district court litigation and the minimal progress in that case, there is only one path toward a "quick and cost effective alternative to litigation." *Id.* It is institution of IPR on the merits, especially where Patent Owner has never even contested those merits.

III. THE FINTIV FACTORS WEIGH IN FAVOR OF INSTITUTION—35 U.S.C. § 314(a)

Patent Owner does not provide analysis of each *Fintiv* Factor, presenting

only isolated arguments directed to a subset of factors, and overlooking critical facts related to the indefinite stay and its own tactics counter to efficient resolution. None of the Factors favor discretionary denial, and collectively they weigh heavily against discretionary denial.

A. Factor 1: Whether the court granted a stay or whether evidence exists that one may be granted if an IPR is instituted

Factor 1 weighs heavily against exercising discretionary denial. As discussed above, the parallel litigation is stayed, and will remain stayed indefinitely pending resolution of a bankruptcy proceeding. *See Apple v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6–8 (PTAB Mar. 20, 2020) (precedential) (explaining that a district court stay “has strongly weighed against exercising the authority to deny institution”); *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 8–9 (PTAB Oct. 21, 2020) (precedential) (finding based on a district court stay that “the first *Fintiv* factor weighs strongly against exercising discretion to deny institution”); *Twitch Interactive, Inc. v. Razdot Holdings LLC*, IPR2025-00307, Paper 18 at 2–3 (PTAB May 16, 2025) (the Acting Director denying a patent owner’s request for discretionary denial based on the likelihood of a post-institution district court stay).

Patent Owner speculates—without citation to any exhibit or evidence—that the W.D. Wash case “is likely” to resume “before February 2026.” Patent Owner’s

Brief, 23 (mere attorney argument that the parallel litigation will resume “before February 2026 (which is likely)”). This unsupported guess is not enough for the Director to decide what an Article III court might do in 2026, especially when the District Court of Washington would not act until after final resolution of the foreign “administration” proceeding in the United Kingdom. At a minimum, Patent Owner needed to cite to some evidence or exhibit establishing when in 2026 the United Kingdom “administration” proceeding will reach a final resolution. Instead, there is only attorney argument. *See* Patent Owner’s Brief, 23. It is not enough. And from there, nothing in the record establishes how long it will take the U.S. Bankruptcy Court for the District of Delaware will eventually lift the stay for U.S. actions, nor how long thereafter it will take the District of Washington to subsequently lift the stay for this patent case. Instead, Patent Owner apparently assumes in a single sentence on page 23 that all of these steps will contemporaneously occur on the same date “before February 2026.”

Patent Owner assumes too much. The Board has a tradition of declining to engage in such speculation, especially in view of the prejudice to Petitioner that would ensue by doing so. The Director should not adopt unsupported attorney argument that prematurely assumes a resolution in a foreign tribunal and the counterpart U.S. bankruptcy proceeding.

To be clear, Patent Owner’s speculation that “Judge Evanson would seek to have trial within seven months of the lifting of the bankruptcy stay” is likewise unfounded. *See* Patent Owner’s Brief, 23. Patent Owner ignores that the District Court schedule itself was entirely reset in June 2024 in the wake of Patent Owner’s repeated injections of further patents into the case, leaving all dates after the proposed claim construction briefing—including the jury trial date—purposefully undefined. EX1055, 3-5; EX1056, 11-12. In other words, even before there was an indefinite stay of the litigation, there was no jury trial date scheduled at all. Now, based on attorney argument alone, Patent Owner contends to have prescient knowledge of when Judge Evanson will schedule a jury trial in 2026. It does not.

Indeed, even the revised schedule was further delayed before the case was indefinitely stayed. In particular, the Due Dates leading up to claim construction were further extended in March 2025, again leaving the *Markman* hearing and subsequent dates, including trial, delayed indefinitely. EX1061, 1-2. The investment and progress in the W.D. Wash. Litigation is little—not even to the stage of claim construction briefing and certainly not close to the end of discovery. Given the status at the time of the stay (e.g., no claim construction, no depositions, limited document production, etc.), there is no indication of a schedule that could result in trial in as little as “seven months” after the indefinite stay is finally lifted. *See* Patent Owner’s Brief, 23. Patent Owner assumes too much.

Finally, even if the foreign tribunal, the U.S. Bankruptcy court, and Judge Evanson all work in perfect sequence such that the indefinite stay in the W.D. Wash. case is lifted in 2026, there is no guarantee what motions will be filed in the W.D. Wash. case. For example, should one or both parties request such a stay pending the Final Written Decision in this IPR here, there is no indication that Judge Evanson will deny a stay pending IPR. *Nikon Corp. et al. v. Optimum Imaging Technologies, LLC*, IPR2024-01372, Paper 17 at 10-11 (PTAB April 23, 2025) (Factor 1 is neutral when no stay has been requested because the Board “will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested”).¹

Accordingly, *Fintiv* factor 1 “strongly” favors institution. *See* IPR2020-00820, Paper 15 at 8–9 (“strongly” favoring institution).

B. Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision

Factor 2 weighs heavily against exercising discretionary denial. As discussed above, the parallel litigation is stayed indefinitely, and thus there is no expected trial date. The Board’s decision in this IPR will precede the not-yet-scheduled trial in district court.

¹ Notably, IPR of the asserted ’380 patent has already been instituted.

Again, as noted above, following Patent Owner’s injection of multiple additionally patents to the litigation—doubling the number of patents more than a year after the lawsuit commenced—the District Court reset the schedule in June 2024, and again extended particular dates in March 2025. EX1055, 3-5; EX1056, 11-12; EX1061, 1-2. All dates subsequent to the claim construction briefing, including a trial date, were left undefined and remain so. Patent Owner’s assertions that the trial could occur contemporaneous with the Board’s final written decision are pure speculation, contrary to the actual factors at play in the parallel court proceedings in the U.S. and in foreign tribunals. *See, e.g., Twitch*, IPR2025-00307, Paper 18 (denying PO’s request for discretionary denial noting “there is no currently scheduled trial date in the co-pending district court litigation” and even if trial were scheduled it would be significantly after the projected final written decision); *see also Amazon.com v. NLGiken, Inc.*, IPR2025-00250, Paper 14 (May 16, 2025).

Beyond Patent Owner’s unfounded speculation that the parallel litigation is likely to resume before February 2026, Patent Owner further fails to present any evidence that trial could occur by a final written decision in August 2026, as discussed above. Patent Owner fails to account for the delay caused by its late injection of multiple patents into the proceeding and the resulting nascent status of the litigation at the time of the stay, which prevents resolution “within seven months of the lifting of the bankruptcy stay,” even if it were Judge Evanson’s desire to do so.

C. Factor 3: Investment in the parallel proceeding by the court and the parties

Factor 3 weighs heavily against exercising discretionary denial. The parallel proceeding is stayed indefinitely, and thus there is no overlapping investment in the parallel proceeding. As explained in the Petition, and never disputed by Patent Owner, neither party has submitted any Markman briefing, and discovery was in its infancy when the case was stayed. Petitioner diligently filed this petition, within a few months after receiving the initial infringement contentions and then learning, during its subsequent work on invalidity contentions, of highly pertinent art (e.g., Fang). *Peag LLC et al. v. Varta Microbattery GMBH*, IPR2020-01212, Paper 8 at 20 (PTAB Jan. 6, 2021) (“Petitioner’s diligence in filing the Petition also weighs in favor of not exercising discretion to deny institution.”); *see also Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01332, Paper 14 at 28-29 (PTAB Jan. 27, 2021). As such, the investment “in the []lawsuit, particularly as related to any validity issues, has not been substantial.” *Illumina, Inc. v. Ravgen, Inc.*, IPR2021-01271, Paper 12, 27 (January 26, 2022).

D. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding

Factor 4 weighs heavily against exercising discretionary denial. On May 14, 2025, Petitioner served Patent Owner (and subsequently filed with the Board) a *Sotera* stipulation. *Sotera*, IPR2020-01019, Paper 12 at 18-19 (designated “precedential” Dec. 17, 2020). Specifically, Petitioner’s *Sotera* stipulation plainly states:

Shenzhen Root hereby stipulates that, if this stipulation is entered into evidence in IPR2025-00560 and the IPR proceeding is instituted, Shenzhen Root will not pursue in the above-captioned litigation, against any claim of U.S. Patent No. 11,813,381, ***the same grounds as in IPR2025-00560 or any grounds that could have reasonably been raised*** in the IPR petition (i.e., any ground that could be raised under § 102 or § 103 on the basis of prior art patents or printed publications). *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Pap. 12 at 13-20 (PTAB Dec. 1, 2020) (precedential) (“*Sotera*”).

EX1058, 1 (emphasis added).

To be clear, this is not a case in which a further stipulation is necessary to avoid overlap with the district court. First, as discussed above, the district court litigation is stayed indefinitely. The *Sotera* stipulation provides an added layer to prevent theoretical overlap in the unlikely event litigation resumes before a final written decision is rendered, but accounting for such a scenario would be purely speculative as it depends on a sequence of determinations not only of multiple Article III judges in Delaware and W.D. Wash, but also a foreign tribunal. Such

speculation would be inappropriate, especially in view of the resulting prejudice to Petitioner in doing so.

Second, even if the parallel litigation were to resume (an assumption Patent Owner proffers without support of any evidence), there is no indication there would be overlap in the grounds considered. This is undisputed—Patent Owner overlooks the *Sotera* stipulation in this case, never mentioning it in its request, and never identifying any potential for overlap in the prior art grounds between the PTAB and District Court view of the *Sotera* stipulation.

E. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party

Petitioner is the defendant in the parallel W.D. Wash. proceeding. As such, this factor is neutral or weighs in favor of discretionary denial.

F. Factor 6: Other circumstances that impact the Board's exercise of discretion, including the merits

1. The strong merits of the Petition favor institution

As noted previously, Patent Owner has not raised any patentability arguments to contest the merits of the IPR grounds. Not once. Patent Owner did not raise any merits arguments in a POPR. Indeed, no POPR was filed at all. And Patent Owner did not raise any patentability arguments to contest the merits in its discretionary denial brief. Every Ground includes printed publication prior art (e.g.

Fang) that was not before the examiner during prosecution, and is confirmed by the only expert testimony in the record.

Patent Owner alleges (incorrectly, as discussed above) that “the prior art and arguments relied [on] 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.” Patent Owner’s Brief, 25. That is it. Patent Owner’s incorrect assertions are not followed by any argument that the Grounds set forth in the Petition are not strong, and Patent Owner does not allege even a single weakness on the merits. More, Patent Owner never challenges the reasons in support of the combinations set forth in the Petition, which are confirmed by undisputed expert testimony. Indeed, the combinations are similar to the prior art combinations based on Chang, Fang, Yuen, and Khalil, which were considered and instituted by the Board in IPR2024-01296 (Paper 9). Patent Owner there too declined to challenge similar combinations on the merits, forgoing a patent owner response. *See* EX1059.

IV. DISCRETIONARY DENIAL UNDER §325(D) IS NOT WARRANTED

The *Advanced Bionics* factors weigh strongly against discretionary denial. Patent Owner acknowledges that the prior art combinations advanced by the Peti-

tion were not before the Examiner, and Patent Owner never addresses the Petition's express analysis demonstrating how the Examiner erred during original prosecution. *See* Pet., 99-100. Moreover, the facts here are simply unlike those addressed in the *Ecto World* decision, which set forth analysis and guidance that further confirms discretionary denial under § 325(d) is unwarranted and would be unduly prejudicial to Petitioner. The Petition advances non-cumulative grounds not before the Examiner during original prosecution, and remedies plain error by the Examiner in allowing the claims in the current form. That is why, for the same reasons in another IPR against a related patent, the Board already held that “we find that Fang is not cumulative of the art considered by the Examiner in prosecution.” IPR2024-01296 (Paper 9). A consistent result is justified here.

A. Factors (a), (b), and (d): The Patent Office did not previously consider the same or substantially the same art or arguments presented in the Petition

Each ground advanced in the Petition incorporates Fang, a reference never previously before the Office and that provides materially non-cumulative teachings. The Chang-Fang and Chang-Fang-Khalil combinations render obvious each of the features identified by the Examiner as representing allowable subject matter. Pet. 12-13; EX1002, 1469, 2246-54. Though Chang and Khalil were applied by the Examiner in original prosecution, the specific combinations advanced in this

Petition (Chang-Fang, Chang-Fang-Khalil) were not because Fang was never before the Office. This is undisputed. *See, e.g.*, PO's Brief, p. 11 (acknowledging Fang was not cited in an IDS or applied in an Office Action).

Patent Owner cites to *Ecto World*, but *Ecto World* in fact highlights that part one of *Advanced Bionics* is not satisfied here. Patent Owner's Brief, 12 (citing *Ecto World* at 4). In *Ecto World*, the "Petition relie[d] **exclusively** on prior art references that were submitted to the Office in an information disclosure statement ('IDS')." *Ecto World*, 2 (emphasis added). That is not the case here. Unlike *Ecto World*, the Grounds of the present Petition all involve an entirely new reference never before the Examiner.

To be clear, neither of Chang or Fang are cumulative to art cited or applied by the Examiner. Patent Owner asserts that "Chang is merely cumulative to the teachings of Khalil," but Patent Owner's own analysis confirms this is not so. There is no dispute that Chang provides teachings relevant to the claimed "nipple shield comprising a closed end and a milk port intermediate to the breast flange and the closed end, in combination with the total structure and function as claimed":

Patent Owner's Brief, 14.²

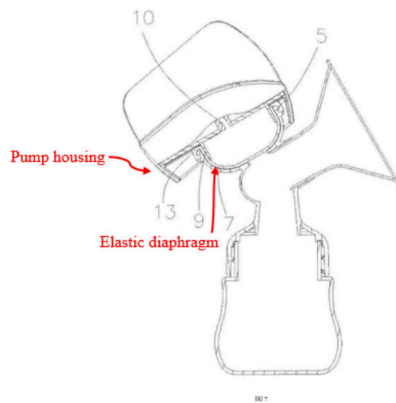
Claim 1 Limitation	Examiner Rejection Based on <u>Khalil</u>	Petitioner's Rejection Based on <u>Chang</u>
the nipple tunnel comprising a closed end and a milk port intermediate to the breast flange and the closed end,	<u>N/A</u>	<u>Petition at 30-31, citing Chang at 0071, 0090, FIG. 6A, FIG. 14</u>

Indeed, the Examiner allowed the claims of the '381 patent in part on the basis that Khalil and the prior art of record did not suggest a “nipple shield comprising a closed end and a milk port intermediate to the breast flange and the closed end, in combination with the total structure and function as claimed.” EX1002, 2246-54, *see also id.*, 2364-68, 2400-09. Chang provides straightforward teachings of this claim element, and is thus not cumulative to Khalil.

² To be clear, the materially different and non-cumulative teachings of Chang are further confirmed by the different structural configurations described and illustrated in Khalil's FIGS. 4-5, 11 in comparison with Chang's FIG. 6A, for example. Patent Owner makes a strange assertion that “the Examiner and Petition both assert Khalil and Chang disclose the same limitations of claim 1 of the '381 patent.” Patent Owner's Brief, 13. This is false. The Petition makes no such assertions.

There is likewise no dispute that Fang was not before the Examiner during original prosecution of the '381 Patent (Patent Owner's Brief, 15), and Patent Owner's assertions that Fang is cumulative ignore the actual disclosures of Fang and the cited references. Patent Owner alleges that "Fang is cumulative to other references already considered" because "Petitioner relies on Fang's pump-diaphragm arrangement for its combination with Chang" and "the Examiner already considered various pump-diaphragm arrangements, including those disclosed by Khalil and Yuen629." Patent Owner's Brief, 15. But Patent Owner's disclosure is not followed by any specific teachings of Khalil and Yuen629 that render Fang cumulative. Instead, Fang includes materially different teachings relevant to these pump-diaphragm elements, and is particularly straightforward in combination with Chang and other references, as set forth in the petition. The mere fact that Fang is applied against the same claim elements that Khalil and Yuen629 were applied against does not mean that Fang itself is cumulative to Khalil and Yuen629. The non-cumulative nature of Fang's teachings is further evident from comparison of the figures of Fang, Khalil, and Yuen629.

Fang



Khalil

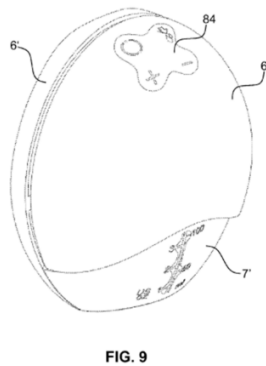


FIG. 9

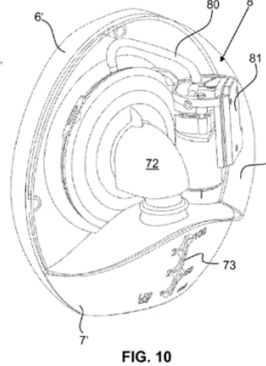
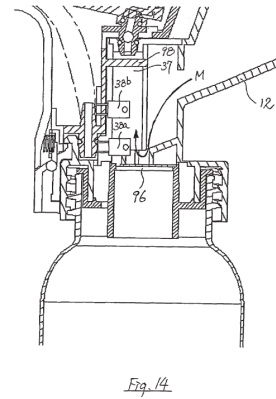


FIG. 10

Yuen629



Patent Owner's assertion that Fang is cumulative is based on the astonishing theory that consideration of Fang during prosecution of the '057 application, which resulted in the child '186 patent, cleanses the error from the earlier '381 Patent where Fang was not considered. Patent Owner speculates that by allowing the child application over Fang, the Examiner "rejected [Fang's] combination with Khalil" and "[i]mplicit 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." Patent Owner's Brief, 15. The Notice of Allowance cited by Patent Owner, however, conspicuously lacks any mention of Fang at all. Patent Owner's major (and false) assumption is based on nothing more than mere indication of consideration in an IDS concurrent with the Notice of Allowance. Mere citation and subsequent allowance of different claims in a child is

not enough to render the reference superfluous as to the '381 Patent claims, which were issued without any consideration of Fang.

Beyond the layers of unsupported assumptions in Patent Owner's theory, the disclosures of the references themselves debunk Patent Owner's speculation. As described above, Chang includes materially different and additional teachings and is not "a proxy" for Khalil. And Fang provides specific teachings and structural configurations of its diaphragm pump that differ from Khalil and the prior art of record, including the structure of its pump chamber defined between a recessed wall of the pump housing and the elastic diaphragm, for example. *See, e.g., Pet.*, 20 (citing EX1009, FIG. 7).

Notably, the Board already recognized the non-cumulative teachings of Fang as to Chang, Yuen, Khalil and other prior art of record when it instituted IPR against the related '380 Patent. The Board expressly concluded that "we find that Fang is not cumulative of the art considered by the Examiner in prosecution." IPR2024-01296 (Paper 9). Patent Owner never addresses the substance of Fang's teachings, or the Board's recent analysis finding Fang material and non-cumulative with respect to the same Chang, Yuen, and Khalil references, among others.

The Petition relies on additional art not before the Examiner during original prosecution that includes material, non-cumulative teachings. The Grounds are ripe for consideration in an instituted proceeding. *Hydrite Chemical Co. v. Solenis*

Techs., L.P., IPR2015-01592, Paper 7 at 9 (PTAB Jan. 27, 2016) (declining to exercise discretion under §325(d) even though several asserted references were previously considered by the Office because “Petitioner has provided **additional art**, arguments, declaration evidence, and other information not previously considered by the Patent Office.”); *Nvidia Corp. v. Invensas Corp.*, IPR2020-00602, Paper 11 at 17-19 (PTAB Sept. 3, 2020) (granted institution because new secondary reference was not considered by the Examiner during prosecution); *Agrofresh Solutions Inc. v. Lytone Enterprise, Inc.*, IPR2021-00451, Paper 11 at 12-13 (PTAB July 27, 2021). Simply put, the same or substantially the same arguments were not previously presented to the Office, and the combinations advanced in this Petition are not cumulative of previously evaluated prior art. Becton, Dickenson factors (a), (b), and (d) under the first prong of *Advanced Bionics* are not satisfied, and discretionary denial under 325(d) is inappropriate.

B. Factors (c), (e), and (f): The Examiner erred in a manner material to the patentability of the challenged claims

Part 1 of *Advanced Bionics* is not satisfied because, as discussed above, the Petition does not rely on the same or substantially the same art or arguments previously presented to the Office. The analysis need not continue to Part 2. *Advanced Bionics*, 8 (“(2) if either condition of first part of the framework is satisfied . . . “). And yet, if assessing Part 2, original examination involved multiple material errors

in failing to consider relevant disclosures of Chang, Khalil, and additional secondary references (e.g., Kurihara, Yuen⁶²⁹, Makower⁷⁹⁴, and Guthrie⁰⁰²). Such errors were specifically identified and explained in the Petition. *See*, Pet., 99-100. Tellingly, Patent Owner ignores it. *See* Patent Owner's Brief, 18-19. Accordingly, Part 2 of the Advanced Bionics framework is likewise not satisfied, further favoring institution.

For example, as described in the Petition (and ignored in Patent Owner's Brief, *see*, 18-19), the Examiner's evaluation of Chang was superficially limited because only isolated aspects of Chang's disclosure were relied upon to address perceived gaps in Khalil. *See* EX1002, 1107-09. The Examiner relied on Chang's disclosed use of a rechargeable battery to power a pump for obviousness regarding a modification of Khalil's power source to "be a rechargeable battery, as taught by Chang, in order for the power source to be reused." *Id.*, 1109. The Examiner thus erred in evaluating Chang by overlooking disclosure that provides the very claim features identified as being absent in the prior art. For example, in allowing claim 1, the Examiner found that Khalil did not teach or render obvious "a nipple tunnel comprising a closed end and a milk port intermediate to the breast flange and the closed end, in combination with the total structure and function as claimed." *Id.*, 2252. Yet, as discussed above and in §VI.2.a (1[a][3][i]) of the Petition, Chang's Figure 6A clearly depicts this configuration.

Moreover, the Examiner erred by failing to identify and apply Fang and Chang's pertinent teachings. Failure to identify and apply the highly pertinent teachings of these references to the allowed claims "was error in the prosecution leading to the issuance of" the '381 patent due to the fact that "the Examiner was simply not aware of" these references. *Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15 at 19-20 (PTAB Oct. 16, 2019) (designated precedential: Mar. 24, 2020); *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2025-00152, Paper 11 (June 12, 2025) ("Petitioner persuasively argues that the patent examiner overlooked [[the prior art reference's]] teachings, thus demonstrating that the Office erred in a manner material to the patentability of the claims.") (citing *Ecto World*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (precedential)). Where, as here, "[t]he Petition...presents different prior art than the Office was aware of," this constitutes error by the Office during prosecution. *Id.*

Here again, the *Ecto World* decision highlights that Part 2 of *Advanced Bionics* is not satisfied. Amazingly, after quoting the *Ecto World* decision, Patent Owner never addresses the Petition's analysis at pages 99-100 that demonstrates "how the Examiner erred in overlooking the prior art." Patent Owner's Brief, 18. Unlike the Petition in *Ecto World* that lacked the requisite explanation, the Petition

here included it. Patent Owner ignored it, and is wrong in suggesting that the Petition lacked the requisite analysis. The analysis at pages 99-100 of the Petition remains undisputed.

More, *Ecto World* identifies three factors as examples of how the Examiner erred, all of which are satisfied here: “[1] because the asserted prior art was not a basis for rejection during examination, [2] is not substantially the same as prior art the Examiner applied, and [3] includes specific teachings that “impact patentability of the challenged claims.” As set forth above and in the Petition, all three are true of Fang, which was not a basis for rejection, is not substantially the same as art that was applied, and includes specific teachings that impact patentability. The Petition is fully consistent with *Ecto World’s* factors that indicate discretionary denial is not warranted.

Ecto World also confirms that discretionary denial may be inappropriate “based on the volume of the references submitted to the Office.” *Ecto World*, 6-7 (“These facts may demonstrate that discretionary denial under § 325(d) is not warranted.”). Nine IDSs and hundreds of references were cited in the record of the ’381 Patent. Here again, Patent Owner never specifically addresses this factor highlighted by *Ecto World*.

Part 2 of the *Advanced Bionics* framework, and the guidance provided by *Ecto World*, confirm that discretionary denial is inappropriate. Patent Owner's assertions amount to a request that the Director reverse what the Board already decided in the parent '380 decision—"that Fang is not cumulative of the art considered by the Examiner in prosecution." IPR2024-01296 (Paper 9). Nothing in Patent Owner's Brief undermines the Board's prior conclusion or warrants a different result here.

**V. ADDITIONAL CONSIDERATIONS IN THE STEWART
MEMORANDUM ALSO COUNSEL AGAINST
DISCRETIONARY DENIAL**

None of the additional workload management factors raised by Patent Owner favor denial.

A. Prior Adjudication

"Prior adjudication" considerations weigh against discretionary denial. "[N]o prior forum has adjudicated the validity of the '381 patent." Patent Owner's Brief, 24. This is expressly acknowledged by Patent Owner and undisputed.

B. Changes in the Law

Patent Owner's assertions that *Ecto World* favors discretionary denial ignores *Ecto World's* analysis and the facts of the present proceeding. Patent Owner alleges that Petitioner "failed to provide a sufficient explanation as to how the examiner overlooked the prior art." Patent Owner's Brief, 25. But in doing so,

Patent Owner conspicuously overlooks analysis in the Petition that does just that.

As described above (*supra*, IV.B), Patent Owner never addresses the Petition's analysis at pages 99-100 that demonstrates "how the Examiner erred in overlooking the prior art." Patent Owner's Brief, 18. Likewise, as described in Section IV.A, *Ecto World* in fact highlights reasons why discretionary denial is not appropriate. Patent Owner's reliance on *Ecto World* is misplaced. *Id.*

C. Strength of the Challenge

As discussed above, Patent Owner has not identified any weaknesses on the merits of the Challenge. Indeed, Patent Owner opted to never raise any patentability argument against the merits of the IPR grounds in this proceeding. Not one. This is telling.

This record reveals that the merits are robust, entirely uncontested, and similar to grounds already deemed worthy of institution by the Board in IPR2024-01296. The strong and unrebutted merits weigh heavily against discretionary denial, especially where denial would deprive Petitioner of timely and efficient resolution of validity in view of Patent Owner's delay and the indefinite stay of the W.D. Wash. litigation.

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

Patent Owner does not address “settled expectations,” and for good reason. This Petition was filed within 15 months of issuance of the ’381 patent. *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2025-00152, Paper 11 (June 12, 2025) (“Early challenges to patents favor robust, predictable patent rights and weigh against discretionary denial.”). It remains undisputed that there are no “settled expectations” of the parties that would favor discretionary denial given the limited time the claims “have been in force.” If anything, the expectations of the parties were that the claims are invalid and not infringed. Only after Patent Owner injected the ’381 into the proceeding did the public and Petitioner become aware of Patent Owner’s mistaken viewpoint of its allowed claim scope. The Petition challenging the ’381 Patent is the prompt and direct result of Patent Owner’s very recent assertion of a claim scope that reads on the prior art. The PTAB’s “purpose and design,” as reiterated by the Supreme Court, is fulfilled by addressing the merits of the prior art here. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently”); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279-80 (2016) (describing the PTAB’s basic “purpose” and the public’s “paramount

interest in seeing that patent monopolies ... are kept within their legitimate scope”).

VI. THE TEXT OF 35 U.S.C. § 314(c) IS CONTRARY TO THE TYPE OF WRITTEN DECISION THAT PATENT OWNER IS REQUESTING HERE

To the extent Patent Owner is requesting a written decision that is silent on a determination of whether the IPR grounds in the Petition demonstrate a reasonable likelihood to prevail on at least one claim, Patent Owner’s request is contrary to the text of the statute. There is no dispute that § 314(a) includes the word “may” such that the Director has discretion to grant or deny institution of review. *See* 35 U.S.C. § 314(a). The statute, however, does not end there, and nor should any written decision in this case.

The text of § 314(c) includes the term “shall” and offers no discretion on what must be included in writing from the Office: “The Director *shall* notify the petitioner and patent owner, in writing, of the Director’s *determination under subsection (a)*.” *See* 35 U.S.C. § 314(c). Section 314(c) does not provide any option for a decision at the institution stage (grant or denial) that is silent on the “determination under subsection (a),” and the only “determination” mentioned in the text of subsection (a) is the reasonable-likelihood-to-prevail determination based on the merits of the prior art grounds. *See* 35 U.S.C. § 314(a) and (c).

The plain text of the statute is straightforward. Patent Owner’s brief appears

to request a violation of the “shall” requirement in § 314(c). It is exacerbated by Patent Owner’s failure to muster any Preliminary Response in this case.

For at least these reasons, the Director should reject Patent Owner’s request.

VII. CONCLUSION

For the reasons discussed above, discretionary denial is not warranted.

Respectfully submitted,

Dated June 27, 2025

/Craig A. Deutsch/

Michael T. Hawkins, Reg. No. 57,867

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

T: 202-783-5070

F: 877-769-7945

IPR58498-0004IP1@fr.com

Attorneys for Petitioner

CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24, the undersigned hereby certifies that the word count for the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Brief totals 6,392 words, which is less than the 14,000 allowed under 37 CFR § 42.24.

Respectfully submitted,

Dated June 27, 2025

/Craig A. Deutsch/

Michael T. Hawkins, Reg. No. 57,867

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

T: 202-783-5070

F: 877-769-7945

IPR58498-0004IP1@fr.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on June 27, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Discretionary Denial Brief and added supporting exhibits are provided via email to the Patent Owner via electronic mail on Patent Owner's lead and backup counsel listed below at the following email address:

Heath J. Briggs
Trenton Ward
Benjamin P. Gilford
Elana Araj
Declan Stone-Murphy
Emma Cohen (Pro Hac Vice forthcoming)
Greenberg Traurig, LLP
BriggsH@gtlaw.com
Trenton.Ward@gtlaw.com
gilfordb@gtlaw.com
Elana.Araj@gtlaw.com
Declan.StoneMurphy@gtlaw.com
emma.cohen@gtlaw.com
Willow-IPRs@gtlaw.com

/Li Feng/

Li Feng
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
lfeng@fr.com