

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRHYTHM TECHNOLOGIES, INC.,

Petitioner,

v.

WELCH ALLYN, INC.,

Patent Owner.

CASE: IPR2025-01081

U.S. PATENT NO. 8,630,699

PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION TO WITHDRAW

I. INTRODUCTION

Three days after Petitioner filed its instant petition for the '699 Patent, the Acting Director ordered discretionary denials for five similarly situated petitions. The '699 Patent petition suffers from the same fatal flaw as its five predecessors and, upon receiving the five Discretionary Denial decisions, Patent Owner requested that Petitioner withdraw its petition for the '699 Patent at that time to save the parties' and Board's resources. Petitioner ignored Patent Owner's request, instead requiring Patent Owner to file its Discretionary Denial request in this case and substantially prepare its Preliminary Patent Owner Response. Accordingly, Patent Owner respectfully requests that the Board deny Petitioner's eleventh-hour motion to withdraw the '699 Patent petition as if it had never been filed and, instead, grant Patent Owner's unopposed Request for Discretionary Denial to provide Patent Owner with the finality of a concluded *inter partes* review proceeding.

More specifically, on June 6, 2025, Petitioner's Petitions challenging a series of patents related to the '699 Patent were denied. *See generally iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025); *iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00374, Paper 10 (P.T.A.B. June 6, 2025); *iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00376, Paper 10 (P.T.A.B. June 6, 2025); *iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10

(P.T.A.B. June 6, 2025); *iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00378, Paper 10 (P.T.A.B. June 6, 2025). In response to those denials, Patent Owner requested Petitioner withdraw its petition in this proceeding, seeking to avoid requiring the Patent Owner and the Board to expend additional resources on unnecessary papers. *See* Ex. 1055. Patent Owner ignored that email. Petitioner did not respond indicating they were evaluating appeal or rehearing options. Petitioner did not propose any stay or other compromise solutions to obviate unnecessary work on the part of Patent Owner.

As a result, Patent Owner prepared and filed a Discretionary Denial Request (Paper 6) and Patent Owner Preliminary Response (Paper 7), along with accompanying expert declaration (Ex. 2023). Rather than engage in trying to “promote efficiency and preserve both the Board’s and the parties’ resources” (Paper 8), Petitioner’s actions have done nothing more than increase the bill for Patent Owner’s defense of its patents. At the eleventh hour, before its Petition receives the same treatment as the five “Related iRhythm IPRs,” Petitioner seeks to withdraw its Petition in this proceeding. However, given a decision on Patent Owner’s ***unopposed*** Discretionary Denial Request is expected no later than October 23 (less than 2 weeks from now), Petitioner’s “resource savings” ring hollow.

The Board regularly denies such dilatory requests when they are made in close proximity to the Board's expected decisions, because the offer to "save resources" is false; the resources have already been spent. *See Trutek Corp. v. The Regents of The University of Michigan*, IPR2022-00674, Paper 9 (P.T.A.B. Sept. 27, 2022) ("Allowing Petitioner to withdraw the petition will not save the parties any additional time or expense, because there is no additional authorized briefing, discovery, or other effort in this proceeding to be taken by the parties at this time."). Allowing withdrawal at this stage would prejudice Patent Owner, who has already expended significant resources preparing multiple filings, and would undermine the Board's interest in finality and efficient resolution of proceedings.

Petitioner's Motion should be denied, and Patent Owner's Discretionary Denial Request (Paper 6) should be granted.

II. ARGUMENT

Petitioner's dilatory conduct through this proceeding warrants seeing this proceeding through to decision, rather than releasing Petitioner from another defeat. Petitioner's decision to delay until the tail-end of the discretionary denial period should not be rewarded. Rather than save the parties or the Board any time, money, or energy, the timing of the Motion simply serves to prevent yet another declaration by the USPTO that Petitioner's challenges should be denied. To ensure the proper

325(d) analysis can be applied to any future IPR challenges by Petitioner to this patent, as its 1-year statutory bar has not yet passed, Petitioner's Motion should be denied and Patent Owner's unopposed Discretionary Denial Request should be granted.

A. Petitioner's Delay

Petitioner could have moved to withdraw its Petition when Patent Owner first asked on June 9, 2025; it did not. Paper 8, 2. Petitioner could have moved to withdraw its Petition when its Requests for Director Review were denied on August 5, 2025; it did not. *Id.* Rather, Petitioner waited until *after* Patent Owner had already filed its Discretionary Denial Request (August 25, 2025) and was well into the preparation of its Preliminary Patent Owner Response (Paper 7) and supporting expert declaration (Ex. 2023) to broach the subject.

Petitioner also could have notified the Board and Patent Owner that it did not intend to oppose Patent Owner's Discretionary Denial Request on August 26, 2025, the day after Patent Owner's paper was submitted; it did not. Petitioner could have notified the Board and Patent Owner that it did not intend to oppose Patent Owner's Discretionary Denial Request on September 19, 2025 when it first emailed the Board (Ex. 1057); it did not. Rather, it delayed providing that indication until September

24, 2025 (Ex. 1057), *after* Patent Owner had filed its Preliminary Patent Owner Response.

Petitioner's pattern of delay confirms the gamesmanship of its request. It had ample opportunity to actually conserve resources, and it declined to do so. Petitioner's last-ditched effort to avoid the granting of Patent Owner's unopposed Discretionary Denial Request should not be rewarded and Petitioner's Motion should be denied.

B. Lack of savings

Petitioner's Motion fails to establish that any savings would occur through its requested relief. No party resources would be conserved, as Petitioner's conduct has driven *up* the cost to Patent Owner. Moreover, there will be no Board savings as the Discretionary Denial decision in, for example, *iRhythm, Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025), provides the analysis necessary to be used in this proceeding.

a) Petitioner's Withdrawal Will Not Generate Any Party Savings

The Board regularly dismisses the argument that the late-withdrawal of Petitions provides any savings. Here, Petitioner incorrectly argues that granting its motion will "preserve both the Board's and the parties' resources." Paper 8, 6. Instead, there are no additional papers or party expenditures on the horizon such that

“Allowing Petitioner to withdraw the petition will not save the parties any additional time or expense.” *Trutek v. University of Michigan*, IPR2022-00674, Paper 9 (P.T.A.B. Sept. 27, 2022). Accordingly, Petitioner's arguments regarding “party savings” should be rejected.

b) Petitioner's Withdrawal Will Not Generate Any Board Savings

The Discretionary Denial process explains that “[a]bsent good cause, the Director will issue a decision on discretionary considerations within one month of the due date of the last relevant paper filed.” See <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process#V.A>. Petitioner's Discretionary Denial Opposition would have been due September 24, 2025 if it elected to file one.¹ Under the outlined process, a decision on Patent Owner's now-unopposed Discretionary Denial Request would come no later than October 24, 2025. This is less than 10 days away. By now, the Board has already reviewed the briefing and begun, if not completed, the preparation of that paper.

¹ Had Petitioner timely notified the Board of its intent to not file this paper—rather than delaying that notification until September 24—the proceeding would have received a discretionary denial decision on or about September 24, 2025.

This case is “not at an ‘early stage,’ as Patent Owner has already filed its Preliminary Responses.” *See Sophos Ltd. et. al. v. Open Text Inc.*, IPR2023-00731, Paper 22 at 5 (P.T.A.B. Nov. 1, 2023). Like in *Sophos*, it is expected that “the Board has already expended significant resources analyzing the merits of the Petition [and Patent Owner’s unopposed Motion for Discretionary Denial].” *Id.* Petitioner presumes too much; “[j]ust because the Board has not issued an institution decision [or Discretionary Denial Decision] does not mean that the Board has not undertaken most of the work required to do so.” *Id.*

Any yet-to-be-completed efforts to finalize that Discretionary Denial decision are minimal. To ensure consistency with the decision in IPR2025-00363, the Discretionary Denial decision in this proceeding was essentially complete as of June 6, 2025, when those first five Discretionary Denial orders issued.

By filing its motion so close to the decision by the Board, any arguments tied to preservation of Board resources also ring hollow. *Ocado Group PLC v. Autostore Tech. AS*, PGR2021-00038, Paper 10 (P.T.A.B. July 30, 2021) (denying motion to withdraw IPR submitted two weeks before decision would be due); *Trutek v. University of Michigan*, IPR2022-00674, Paper 9 (P.T.A.B. Sept. 27, 2022) (“Allowing Petitioner to withdraw the petition also will not reduce any significant burden on the Board” because of the proximity to decision).

Moreover, the additional work created by Petitioner's Motion further warrants denial of the motion and granting of Patent Owner's unopposed Discretionary Denial Request. *See e.g., LG Electronics, Inc. v. Koninklijke KPN N.V.*, IPR2018-00551, Paper 10 (P.T.A.B. Aug. 1, 2018) (denying opposed motion to dismiss before institution). Petitioner's Motion to Withdraw should be denied and Patent Owner's unopposed Discretionary Denial Request should be granted.

C. Board should reach decision

Petitioner is still within its one-year statutory window to challenge the '699 Patent. *Welch Allyn, Inc. v. iRhythm Technologies, Inc.*, 24-cv-00224, ECF No. 38 (D. Del. Feb. 14, 2025) (filing and service of Second Amended Complaint asserting claims of infringement of the '699 Patent). Petitioner could still file a second petition. 35 U.S.C. § 315(b); *cf. Apple Inc. v. Pinn, Inc.*, IPR2021-00220, Paper 10 (P.T.A.B. Mar. 19, 2021) (granting termination of petition pre-institution because Petitioner was time-barred from filing a second petition). A discretionary denial provides a clear record and analysis under §§ 314 and 325(d), which is critical for estoppel and for preventing repetitive challenges. Accordingly, to underscore any subsequent analysis and cement the impact of Petitioner's election to pursue this IPR, Petitioner's Motion should be denied.

III. CONCLUSION

Petitioner's Motion to Withdraw should be denied, and Patent Owner's unopposed Request for Discretionary Denial should be granted, ensuring the Board's resources are not wasted and Patent Owner's rights are protected.

Dated: October 14, 2025

Respectfully submitted,

By: /Erik J. Halverson/

Erik J. Halverson

Reg. No. 73,552

K&L GATES LLP

Four Embarcadero Center, Suite 1200

San Francisco, CA 94111

T: (415) 882-8238

F: (415) 882-8220

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on October 14, 2025, a true and correct copy of the foregoing was caused to be served on the following counsel of record for Petitioner by electronic mail at the following addresses:

Robert E. Counihan (Reg. No. 61,382)
Fenwick & West LLP
902 Broadway, Floor 18
New York, NY 10010
T: (212) 430-2600
rcounihan@fenwick.com
iRhythm-WelchAllyn_IPR@fenwick.com

Allen W. Wang (Reg. No. 68,456)
Fenwick & West LLP
801 California St
Mountain View, CA 94041
T: (650) 988-8500
allen.wang@fenwick.com
iRhythm-WelchAllyn_IPR@fenwick.com

By: /Erik J. Halverson/
Erik J. Halverson
Reg. No. 73,552

Counsel for Patent Owner