

**PTAB Committee**

# **PTAB Committee Meeting:** Review of Acting Director Coke's Discretionary Review Decisions

**Amster  
Rothstein &  
Ebenstein** LLP

**Hosted By:**

**Charles  
Macedo**



**Ken  
Adamo**



**ZOOM WEBINAR**



**July 15th  
2025**

**4-5 PM ET**

**RSVP: [ADMIN@NYIPLA.ORG](mailto:ADMIN@NYIPLA.ORG) | 1.0 NY/NJ CLE AVAILABLE FOR ATTENDEES**

# Disclaimer



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Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

# Agenda – Discretionary Denials Review

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Update on Discretionary Denials

June & July 2025 Decisions

- Impact of Parallel Proceeding(s)
- Settled Expectations
- Effect of *Sotera* Stipulation

Lessons Learned

# Update on Discretionary Denials

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# Discretionary Denial Updates (under Coke)

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According to Docket Navigator (as of July 8, 2025), there were 95 Orders on Requests for Discretionary Denial of Institution between May 16 and July 2

- 51 were Denied
- 44 were Granted

# Impact of Parallel Proceeding(s) (under Coke)

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According to Docket Navigator (as of July 8, 2025), a significant factor in the Director's consideration was the timing of the Board's earliest projected final written decision:

- Of the 35 Proceedings with Parallel Litigation where the Director found it **unlikely that the Board would complete their decision before the parallel litigation's predicted trial began or investigation would be completed**, 22 of the Requests were Granted
- Of the 23 Proceedings with Parallel Litigation where the Director found it **likely that the Board would complete their decision before the parallel litigation's predicted trial began or investigation would be completed**, 13 of the Requests were Denied
  - The other 10 Requests were Granted because the patent had been in force for 7+ years

# Impact of Parallel Proceeding(s) (under Coke)

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Since May 16, Acting Director Coke has issued the following Discretionary Denial Decisions:

➤ ***NeoGenomics Laboratories, Inc. v. Natera, Inc.* IPR2025-00455**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – **Paper 13** (Stewart June 12, 2025)

➤ ***Microsoft Corporation v. X1 Discovery, Inc.* IPR2025-00253, IPR2025-00254 & IPR2025-00255**

Decision Denying Patent Owner's Request for Discretionary Denial – **Paper 13** (Stewart June 25, 2025)

# Settled Expectations (under Coke)

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According to Docket Navigator (as of July 8, 2025), whenever the Director considered the age of the patent:

- If the patent had been in force for **6 years or less**, the Request was **Denied** (24 Separate Patents)
- If the patent had been in force for **7 years or more**, the Request was **Granted** (13 Separate Patents)

# Settled Expectations (under Coke)

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Since May 16, Acting Director Coke has issued the following Discretionary Denial Decisions:

➤ ***ResMed Corp. v. Cleveland Medical Devices, Inc.* IPR2025-00246 & IPR2025-00247**

Decision Denying Patent Owner's Request for Discretionary Denial – [Paper 10](#) (Stewart June 12, 2025)

➤ ***Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex Technology Limited* IPR2025-00385, IPR2025-00389, IPR2025-00405, IPR2025-00431 & IPR2025-00432**

Decision Referring the Petitions to the Board– [Paper 14](#) (Stewart July 2, 2025)

➤ ***Intel Corporation v. Proxense, LLC* IPR2025-00327, IPR2025-00328 & IPR2025-00329**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – [Paper 12](#) (Stewart June 26, 2025)

➤ ***Dabico Airport Solutions Inc. v. AXA Power APS* IPR2025-00408**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – [Paper 21](#) (Stewart June 18, 2025)

➤ ***iRhythm, Inc. v. Welch Allyn, Inc.* IPR2025-00363, IPR2025-00374, IPR2025-00376, IPR2025-00377 & IPR2025-00378**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – [Paper 10](#) (Stewart June 6, 2025)

# Effect of *Sotera* Stipulation (under Coke)

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According to the USPTO's Guidance on their "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (released on March 24, 2025):

- “a **timely-filed *Sotera* stipulation** (a stipulation from a petitioner that, if an IPR or PGR is instituted, the petitioner will not pursue in district court (or in the ITC) any ground raised or that could have been reasonably raised in the IPR/PGR) is **highly relevant, but will not be dispositive by itself**” in the Board's analysis.

# Effect of *Sotera* Stipulation (under Coke)

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Since May 16, Acting Director Coke has issued the following Discretionary Denial Decisions:

➤ ***Full-Metal-Power BV v. Infocus Downhole Solutions USA LLC* IPR2025-0039**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – **Paper 14** (Stewart June 25, 2025)

➤ ***Phison Electronics Corporation v. Vervain LLC* IPR2025-00213, IPR2025-00214, IPR2025-00215, PGR2025-00010 & PGR2025-00011**

Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review – **Paper 14** (Stewart July 10, 2025)

# June & July 2025 Decisions (Coke)

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Impact of Parallel Proceeding(s)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

NEOGENOMICS LABORATORIES, INC.,  
Petitioner,

v.

NATERA, INC.,  
Patent Owner.

IPR2025-00455  
Patent 11,319,596 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

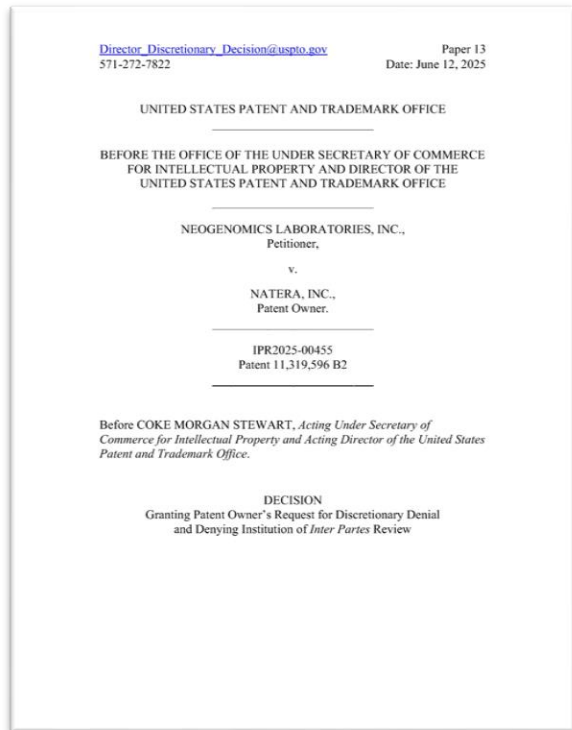
DECISION  
Granting Patent Owner's Request for Discretionary Denial  
and Denying Institution of *Inter Partes* Review

## ***NeoGenomics Laboratories, Inc. v. Natera, Inc.*** ***IPR2025-00455*** **Paper 13** (Stewart)(June 12, 2025)

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Decision Granting Patent Owner's Request for  
Discretionary Denial and Denying Institution of Inter  
Partes Review –

# *NeoGenomics Laboratories, Inc. v. Natera, Inc. IPR2025-00455* Paper 13 (Stewart)(June 12, 2025)

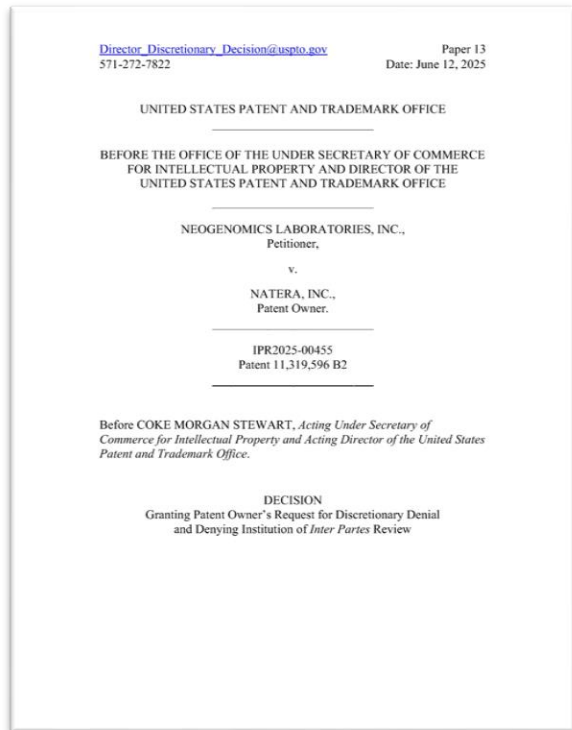


After considering the parties' arguments and the record, and in view of all relevant considerations, **discretionary denial of institution is appropriate in this proceeding**. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, **the projected final written decision due date in the Board proceeding is August 14, 2026**. DD Req. 9. The **district court's scheduled trial date is October 10, 2025**, and the **time-to-trial statistics suggest trial will begin in February 2026**. Id. at 13–14. As such, it is **unlikely that a final written decision in this proceeding will issue before district court trial occurs**.

Additionally, there is **insufficient evidence** that the district court is **likely to stay its proceeding** even if the Board were to institute trial.

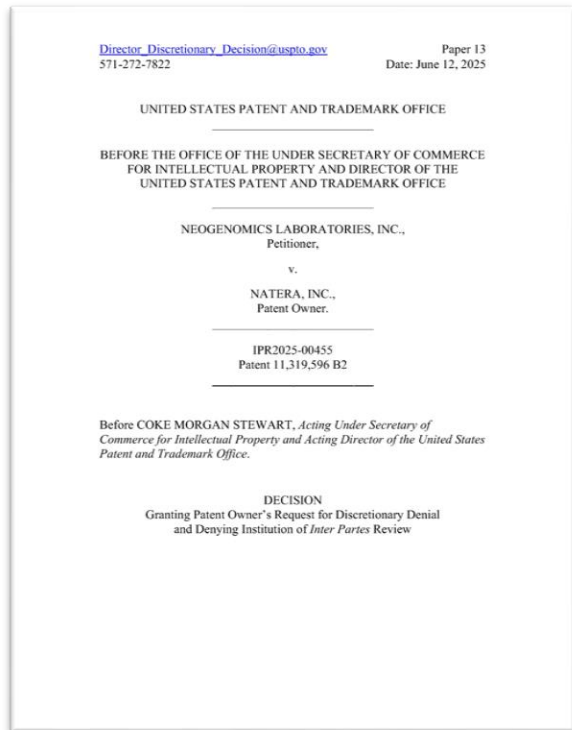
# *NeoGenomics Laboratories, Inc. v. Natera, Inc. IPR2025-00455* Paper 13 (Stewart)(June 12, 2025)



Further, **as of the date Patent Owner filed its request, fact discovery was complete, expert discovery was already underway, final invalidity and infringement contentions had been exchanged, and the district court had issued a Markman order.** DD Req. 17–21. According to Patent Owner, “[n]early all substantive work other than trial itself will be complete by the time of th[e] institution decision date.” Id. at 18. The **substantial time and effort the parties and the district court have invested in the parallel proceeding strongly favors discretionary denial.**

# *NeoGenomics Laboratories, Inc. v. Natera, Inc. IPR2025-00455* Paper 13 (Stewart)(June 12, 2025)

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Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is **granted**; and

FURTHER ORDERED that the Petition is denied, and no trial is instituted.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

MICROSOFT CORPORATION,  
Petitioner,

v.

X1 DISCOVERY, INC.,  
Patent Owner.

IPR2025-00253 (Patent 7,370,035 B2)  
IPR2025-00254 (Patent 10,552,490 B2)  
IPR2025-00255 (Patent 9,633,139 B2)

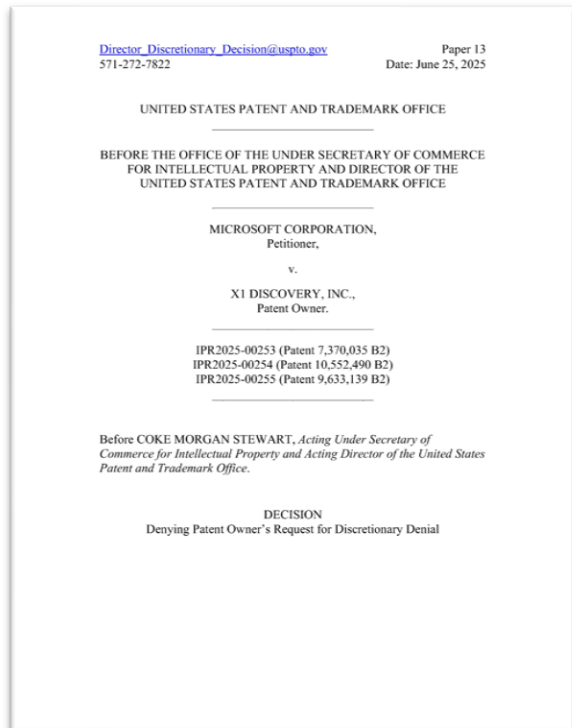
Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

DECISION  
Denying Patent Owner's Request for Discretionary Denial

## ***Microsoft Corporation v. X1 Discovery, Inc. IPR2025-00253, IPR2025-00254 & IPR2025-00255*** Paper 13 (Stewart)(June 25, 2025)

Decision Denying Patent Owner's Request for  
Discretionary Denial –

# Microsoft Corporation v. X1 Discovery, Inc. IPR2025-00253, IPR2025-00254 & IPR2025-00255 Paper 13 (Stewart)(June 25, 2025)

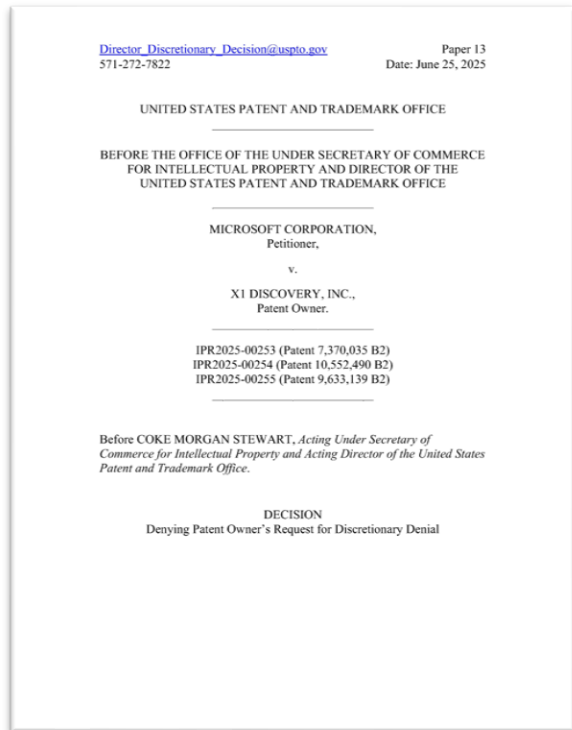


After considering the parties' arguments and the record, and in view of all relevant considerations, **discretionary denial of institution is not appropriate in these proceedings**. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, **no trial date is scheduled in the district court**, and **there is some evidence that a stay would be likely**. DD Opp. 7, 12. Additionally, **there has not been meaningful investment in the district court proceeding**, as infringement and invalidity contentions have not been served. Id. at 10–11.

Furthermore, **Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate because the Office erred in a manner material to the patentability of the challenged claims**. Id. at 20–29.

# Microsoft Corporation v. X1 Discovery, Inc. IPR2025-00253, IPR2025-00254 & IPR2025-00255 Paper 13 (Stewart)(June 25, 2025)



In consideration of the foregoing, it is:

ORDERED that Patent Owner's **request for discretionary denial is denied;**

FURTHER ORDERED that the Petitions are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

# Impact of Parallel Proceeding(s) Analysis

Name	FWD	Stay?	Investment	Young/Old	Alternative Reasoning?	Result
Advanced Micro Devices	AFTER	N/A	Y	N/A	N/A	Denial
Arm Ltd	AFTER	UNLIKELY	N/A	N/A	N/A	Denial
Biofrontera	AFTER	UNLIKELY	Y	N/A	N/A	Denial
Cellco (3)	AFTER	N/A	N/A	N/A	N/A	Denial
Cisco	AFTER	UNLIKELY	N/A	N/A	N/A	Denial
Elong	AFTER	UNLIKELY	Y	N/A	N/A	Denial
Entegris	AFTER	N/A	N/A	N/A	Business Relationship	Denial
Ericson	AFTER	N/A	N/A	N/A	N/A	Denial
Full Metal Power	AFTER	UNLIKELY	N/A	N/A	No Stipulation	Denial
Lam Research (2)	AFTER	N/A	Y	N/A	N/A	Denial
NeoGenomics	AFTER	UNLIKELY	Y	N/A	N/A	Denial
RingConn	AFTER	N/A	Y	N/A	N/A	Denial
SportRadar (6)	AFTER	UNLIKELY	Y	N/A	N/A	Denial
Ultrahuman	AFTER	N/A	Y	N/A	N/A	Denial
Microsoft (single)	AFTER	N/A	N/A	N/A	Showing of Material Error by Office	Referred
POSCO (2)	AFTER	N/A	Y	N/A	Related Claims Unpatentable	Referred
Tesla v. IV (9)	AFTER	UNLIKELY	Y	N/A	Lots of Patents with Diverse Subject Matter	Referred
Zhuhai	AFTER	N/A	N/A	YOUNGER	N/A	Referred

As of July 8, 2025

# Impact of Parallel Proceeding(s) Analysis (cont.)

Name	FWD	Stay?	Investment	Young/Old	Alternative Reasoning?	Result
Intel (3)	BEFORE	N/A	N/A	OLDER	N/A	Denial
Cambridge (2)	BEFORE	N/A	N/A	OLDER	N/A	Denial
iRhythm (5)	BEFORE	LIKELY	LITTLE	OLDER	N/A	Denial
Mercedes Benz	BEFORE	N/A	N/A	N/A	Potentially Unpatentable	Referred
Amazon	BEFORE	N/A	N/A	N/A	N/A	Referred
Berkshire	BEFORE	N/A	N/A	YOUNGER	Likely MDL, efficiency	Referred
Cambridge (3)	BEFORE	N/A	N/A	YOUNGER	N/A	Referred
Merck Sharp (2)	BEFORE	N/A	N/A	YOUNGER	N/A	Referred
Microsoft (multiple) (3)	BEFORE	LIKELY	LITTLE	N/A	Showing of Material Error by Office	Referred
Telsa v. USA	BEFORE	N/A	Y	N/A	Broad Stipulation, BUT Lots of Patents with Diverse Subject Matter	Referred
Twitch	BEFORE	LIKELY	N/A	N/A	N/A	Referred

# CLE Code

# June & July 2025 Decisions (Coke)

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Settled Expectations

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

RESMED CORP.,  
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,  
Patent Owner.

IPR2025-00246 (Patent 11,857,333 B1)  
IPR2025-00247 (Patent 11,872,029 B1)

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

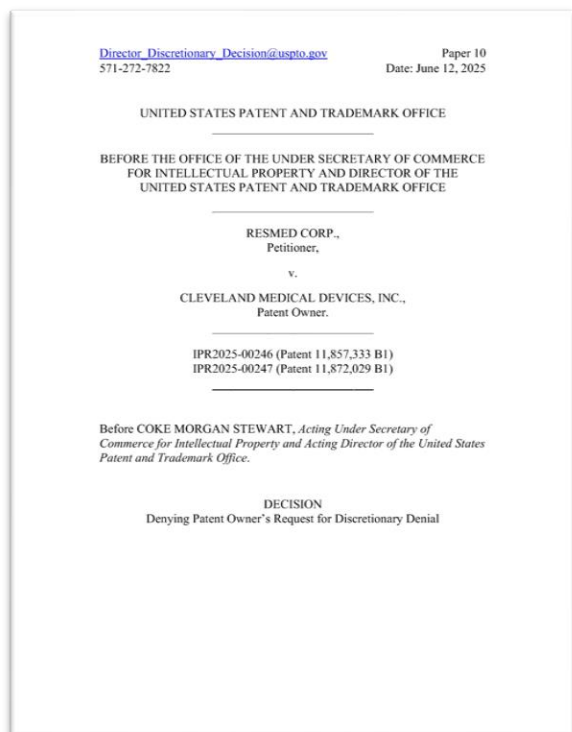
DECISION  
Denying Patent Owner's Request for Discretionary Denial

## ***ResMed Corp. v. Cleveland Medical Devices, Inc.*** **IPR2025-00246 & IPR2025-00247 Paper** **10 (Stewart)(June 12, 2025)**

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Decision Denying Patent Owner's Request for  
Discretionary Denial –

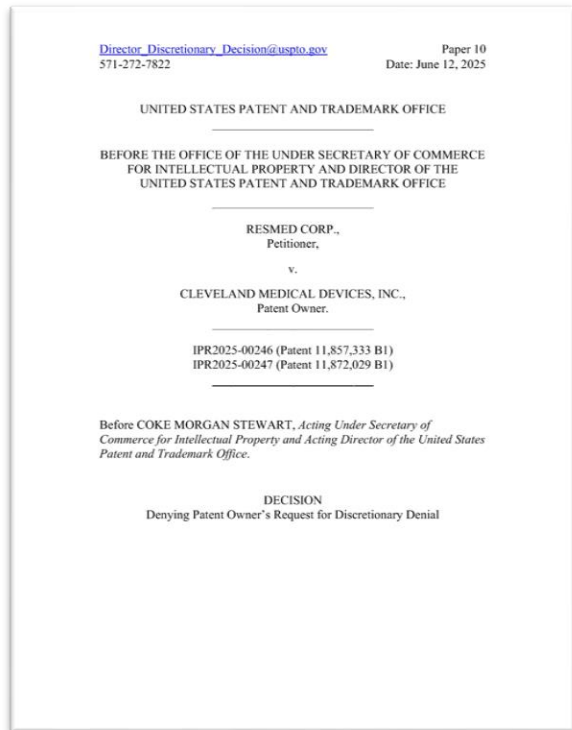
# ResMed Corp. v. Cleveland Medical Devices, Inc. IPR2025-00246 & IPR2025-00247 Paper 10 (Stewart)(June 12, 2025)



After considering the parties' arguments and the record, and in view of all relevant considerations, **discretionary denial of institution is not appropriate in these proceedings.** This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, **the district court proceeding involving the challenged patents has been stayed.** DD Opp. 3. Although the parties appear to have invested some resources into the district court proceeding prior to being stayed (DD Req. 16–17), **that consideration is outweighed by the early challenges to the patents at issue.** The challenged patents were issued recently, in 2024. **Early challenges favor robust, predictable patent rights and weigh against discretionary denial.**

# ResMed Corp. v. Cleveland Medical Devices, Inc. IPR2025-00246 & IPR2025-00247 Paper 10 (Stewart)(June 12, 2025)



In consideration of the foregoing, it is:

ORDERED that Patent Owner's **request for discretionary denial is denied;**

FURTHER ORDERED that the Petitions are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

ZHUHAI COSMX BATTERY CO., LTD.,  
Petitioner,

v.

NINGDE AMPEREX TECHNOLOGY LIMITED,  
Patent Owner.

IPR2025-00385 (Patent 10,964,927 B2)  
IPR2025-00389 (Patent 11,923,498 B2)  
IPR2025-00405 (Patent 11,769,910 B2)  
IPR2025-00431 (Patent 11,799,131 B2)  
IPR2025-00432 (Patent 11,575,148 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

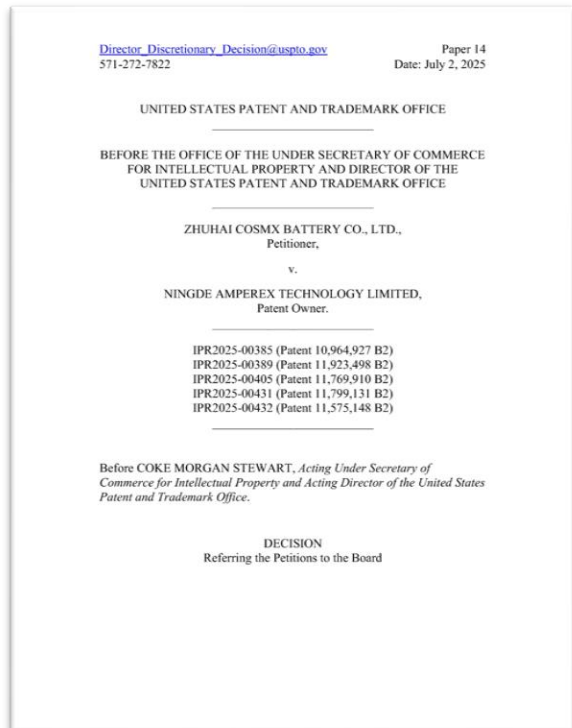
DECISION  
Referring the Petitions to the Board

***Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex  
Technology Limited IPR2025-00385, IPR2025-00389,  
IPR2025-00405, IPR2025-00431 & IPR2025-00432  
Paper 14 (Stewart)(July 2, 2025)***

Decision Referring the Petitions to the Board –

# Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex Technology Limited

## IPR2025-00385, IPR2025-00389, IPR2025-00405, IPR2025-00431 & IPR2025-00432 Paper 14 (Stewart)(July 2, 2025)



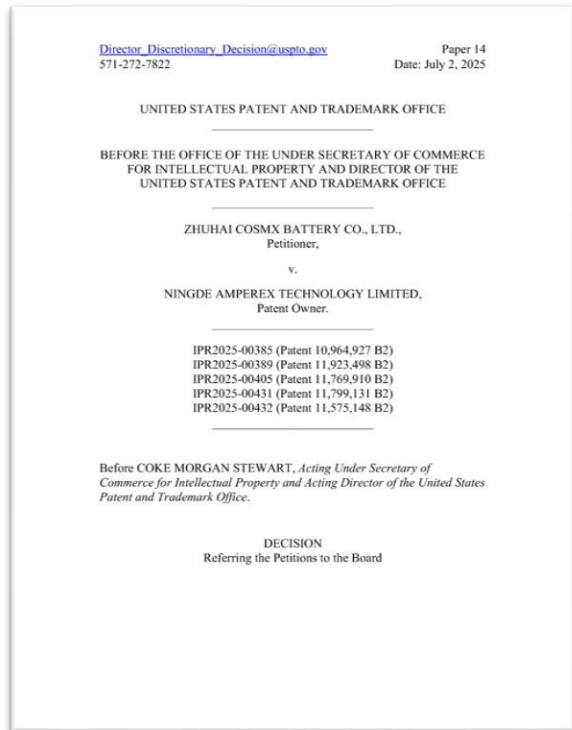
After considering the parties' arguments and the record, and in view of all relevant considerations, **discretionary denial of institution is not appropriate in these proceedings**. This determination is based on the totality of the evidence and arguments the parties have presented. Some facts favor discretionary denial.

**Some facts favor discretionary denial**. For example, the challenged patents are involved in a parallel district court proceeding, with a scheduled trial date in **July 2026**. DD Req. 16. The earliest projected final written decision due date in these Board proceeding is in **August 2026**. See, e.g., IPR2025-00405, Paper 8, 22. **As such, it is unlikely that a final written decision in these proceedings will issue before district court trial occurs.**

# *Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex Technology Limited*

## IPR2025-00385, IPR2025-00389, IPR2025-00405, IPR2025-00431 & IPR2025-00432 Paper 14 (Stewart)(July 2, 2025)

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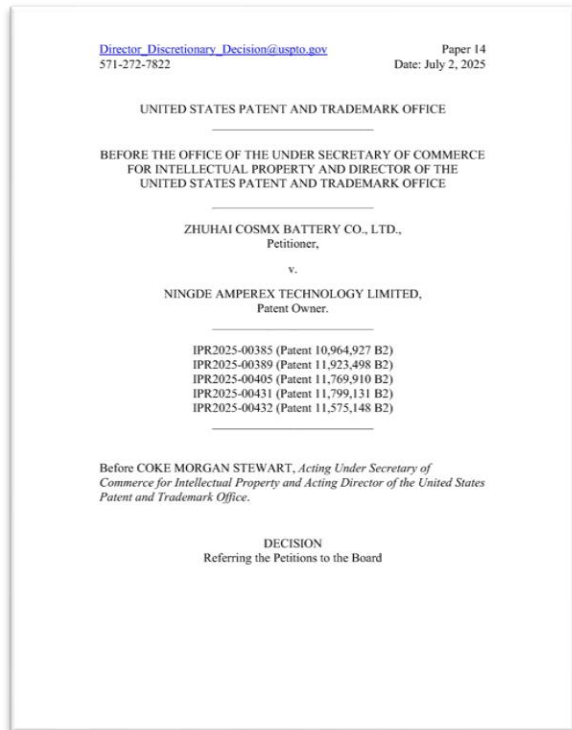


However, the considerations counseling against discretionary denial outweigh those that favor it. In particular, **the challenged patents have not been in force for a significant period of time (issued in 2024, 2023, and 2021), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.** See DD Opp. 30. **Although there may be some inefficiencies with two proceedings operating in parallel, the early challenges to the patents tip the balance against discretionary denial.**

# *Zhuhai CosMx Battery Co., Ltd. v. Ningde Amperex Technology Limited*

## IPR2025-00385, IPR2025-00389, IPR2025-00405, IPR2025-00431 & IPR2025-00432 Paper 14 (Stewart)(July 2, 2025)

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In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is **denied**;

FURTHER ORDERED that the Petitions are referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

DABICO AIRPORT SOLUTIONS INC.,  
Petitioner,

v.

AXA POWER APS,  
Patent Owner.

IPR2025-00408  
Patent 9,771,169 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

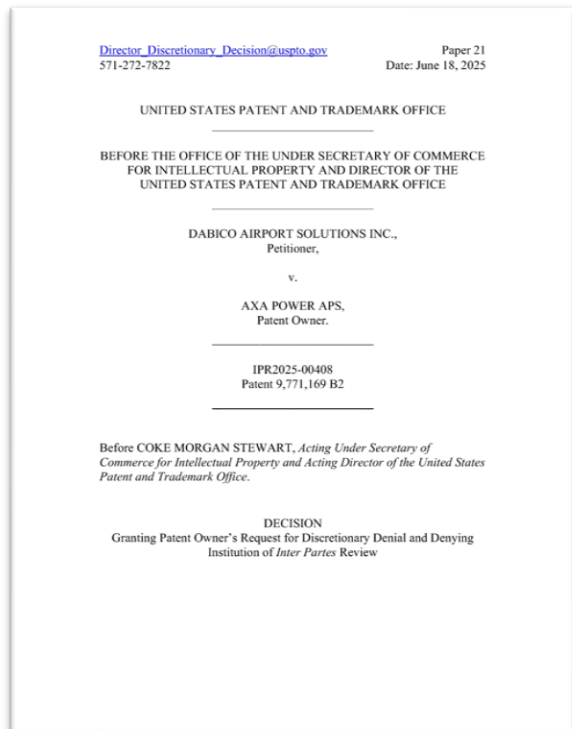
DECISION

Granting Patent Owner's Request for Discretionary Denial and Denying  
Institution of *Inter Partes* Review

## ***Dabico Airport Solutions Inc. v. AXA Power APS*** **IPR2025-00408 Paper 21 (Stewart)(June 18, 2025)**

Decision Granting Patent Owner's Request for  
Discretionary Denial and Denying Institution of Inter  
Partes Review –

# ***Dabico Airport Solutions Inc. v. AXA Power APS*** IPR2025-00408 **Paper 21** (Stewart)(June 18, 2025)



Although there is no bright-line rule on when expectations become settled, **in general, the longer the patent has been in force, the more settled expectations should be. This approach aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits.** Cf. 35 U.S.C. § 286 (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”).

**Moreover, patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests.** 35 U.S.C. § 122.

Interested parties may find published patents and patent applications using the Office’s automated search systems as well as publicly available resources on the Internet. See 35 U.S.C. § 41(i). **As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations.**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

INTEL CORPORATION,  
Petitioner,

v.

PROXENSE LLC,  
Patent Owner.

IPR2025-00327 (Patent 9,265,043 B2)  
IPR2025-00328 (Patent 8,219,129 B2)  
IPR2025-00329 (Patent 8,457,672 B2)

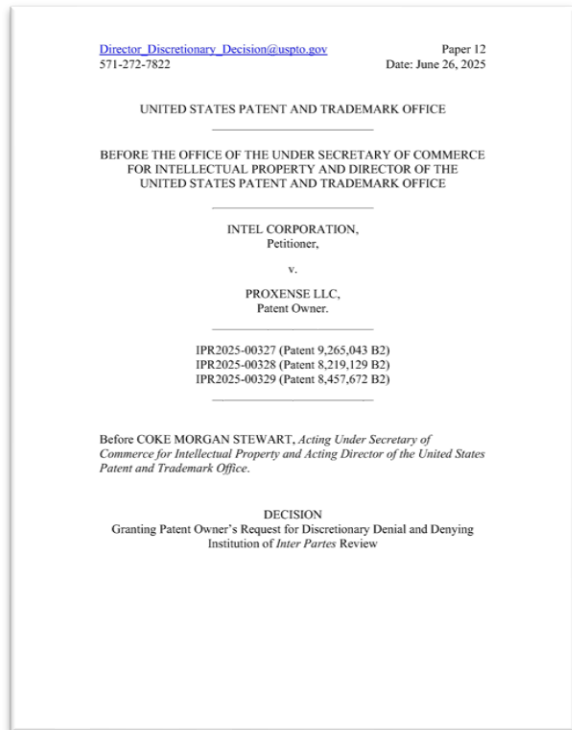
Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

DECISION  
Granting Patent Owner's Request for Discretionary Denial and Denying  
Institution of *Inter Partes* Review

## ***Intel Corporation v. Proxense, LLC* IPR2025-00327, IPR2025-00328 & IPR2025-00329 Paper 12 (Stewart)(June 26, 2025)**

Decision Granting Patent Owner's Request for  
Discretionary Denial and Denying Institution of Inter  
Partes Review –

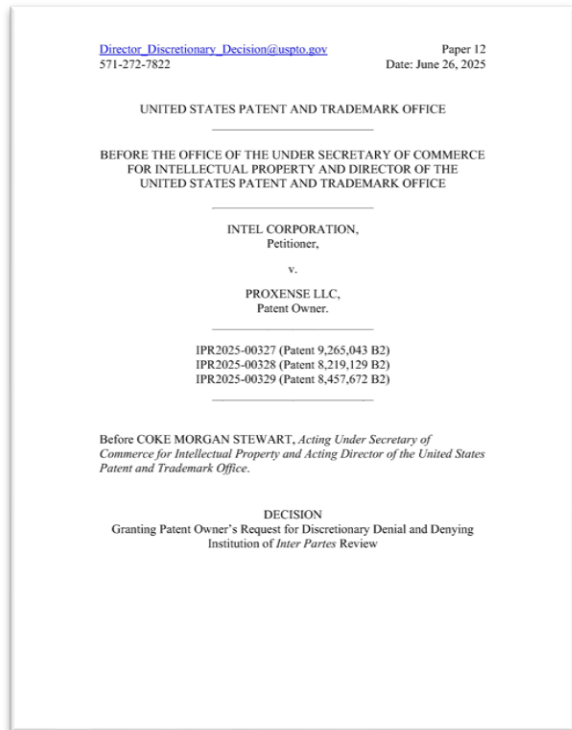
# Intel Corporation v. Proxense, LLC IPR2025-00327, IPR2025-00328 & IPR2025-00329 Paper 12 (Stewart)(June 26, 2025)



Some facts counsel against discretionary denial. For example, the parties recently notified the Office that there no longer is an underlying district court trial date. Ex. 3101.

However, the considerations favoring discretionary denial outweigh those that counsel against it. **In particular, the challenged patents have been in force over nine years, creating settled expectations, and Petitioner does not provide any persuasive reasoning why an inter partes review is an appropriate use of Board resources.** Dabico Airport Solutions Inc. v. Axa Power Aps, IPR2025-00408, Paper 21 at 2–3 (Acting Director Stewart June 18, 2025).

# Intel Corporation v. Proxense, LLC IPR2025-00327, IPR2025-00328 & IPR2025-00329 Paper 12 (Stewart)(June 26, 2025)



There may be persuasive reasons why the Board should review challenged claims several years after their issuance date. For example, **a significant change in law may have occurred since the patent issued, and a petitioner can explain how that change in law directly bears on the patentability of the challenged claims.** As another example, **a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all.** These non-exclusive examples provide considerations that weigh against a patent owner's claim of settled expectations and bears on the Director's discretion. **In the absence of any such information, however, such as in the present proceedings, the Office is disinclined to disturb the settled expectations of Patent Owner.**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

IRHYTHM TECHNOLOGIES, INC.,  
Petitioner,

v.

WELCH ALLYN, INC.,  
Patent Owner.

IPR2025-00363 (Patent 10,159,422 B2)  
IPR2025-00374 (Patent 8,965,492 B2)  
IPR2025-00376 (Patent 9,155,484 B2)  
IPR2025-00377 (Patent 8,214,007 B2)  
IPR2025-00378 (Patent 8,214,007 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

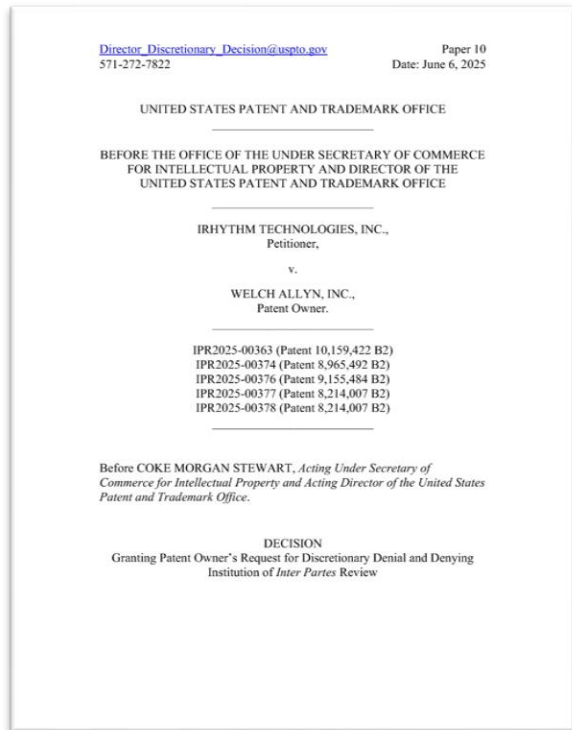
DECISION

Granting Patent Owner's Request for Discretionary Denial and Denying  
Institution of *Inter Partes* Review

## *iRhythm, Inc. v. Welch Allyn, Inc.* IPR2025-00363, IPR2025-00374, IPR2025-00376, IPR2025-00377 & IPR2025-00378 Paper 10 (Stewart)(June 6, 2025)

Decision Granting Patent Owner's Request for  
Discretionary Denial and Denying Institution of Inter  
Partes Review –

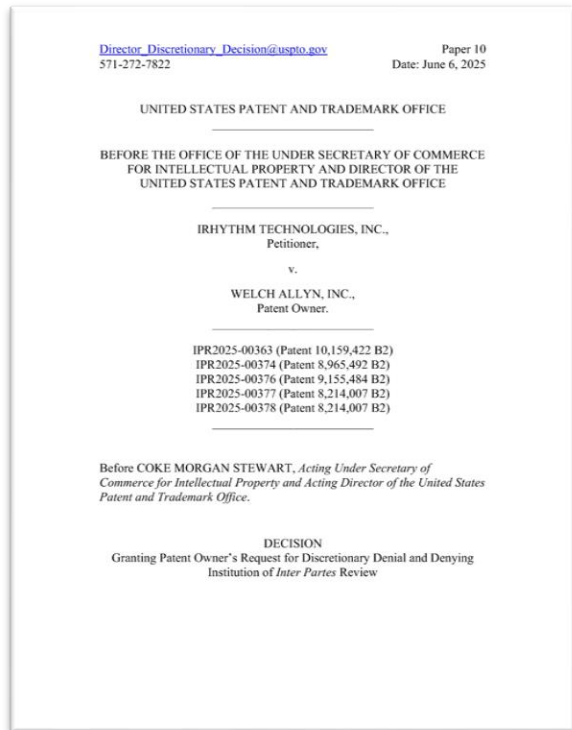
# *iRhythm, Inc. v. Welch Allyn, Inc.* IPR2025-00363, IPR2025-00374, IPR2025-00376, IPR2025-00377 & IPR2025-00378 Paper 10 (Stewart)(June 6, 2025)



After considering the parties' arguments and the record, and in view of all relevant considerations, **discretionary denial of institution is appropriate in this proceeding**. This determination is based on the totality of the evidence and arguments the parties have presented.

**Several arguments weigh against discretionary denial**. For example, the projected final written decision due date in the Board proceedings is **August 12, 2026**, yet the district court's trial date is not until **March 22, 2027**. Ex. 1071, 16. As such, it is likely that a final written decision in this proceeding will issue before the district court trial occurs. **There also appears to be little investment by the parties in the district court proceeding and a high likelihood of a stay if an inter partes review is instituted**. See DD Opp. 34–37.

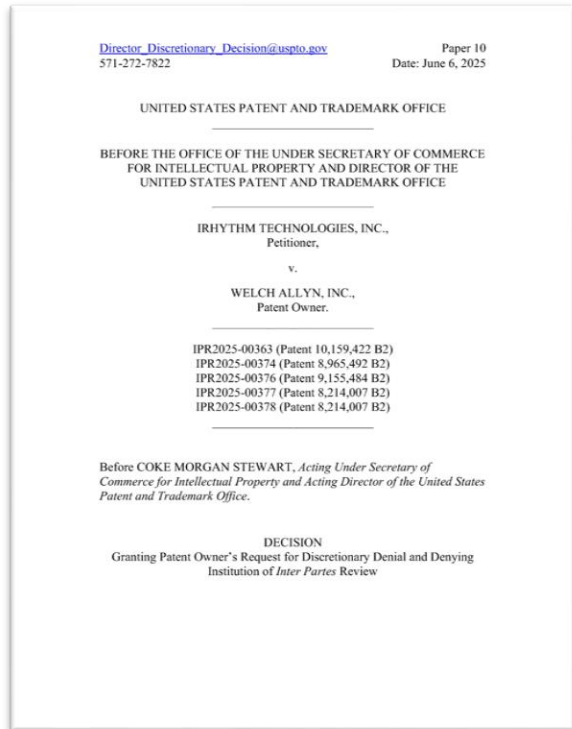
# *iRhythm, Inc. v. Welch Allyn, Inc.* IPR2025-00363, IPR2025-00374, IPR2025-00376, IPR2025-00377 & IPR2025-00378 Paper 10 (Stewart)(June 6, 2025)



Nevertheless, **Patent Owner argues that because one of the patents has been in force since as early as 2012 and Petitioner was aware of it as early as 2013**—having cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement Petitioner filed in its own patent application—**settled expectations favor denial of institution.** DD Req. 30–31. **Patent Owner’s argument is persuasive. Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.**

# *iRhythm, Inc. v. Welch Allyn, Inc.* IPR2025-00363, IPR2025-00374, IPR2025-00376, IPR2025-00377 & IPR2025-00378 Paper 10 (Stewart)(June 6, 2025)

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In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is **granted**; and

FURTHER ORDERED that the Petitions are denied, and no trial is instituted.

# Settled Expectations Analysis

Name	FWD	Stay?	Investment	Young/Old	Alternative Reasoning?	Result
Apotex	N/A	N/A	N/A	OLDER	Ex parte examination	Denial
Dabico	N/A	N/A	N/A	OLDER	N/A	Denial
Intel (3)	BEFORE	N/A	N/A	OLDER	N/A	Denial
iRhythm (5)	BEFORE	LIKELY	LITTLE	OLDER	N/A	Denial
SigSauer	N/A	N/A	N/A	OLDER	N/A	Denial
Cambridge (2)	BEFORE	N/A	N/A	OLDER	N/A	Denial

# Settled Expectations Analysis (cont.)

Name	FWD	Stay?	Investment	Young/Old	Alternative Reasoning?	Result
Ajinomoto	N/A	N/A	N/A	YOUNGER	No Parallel Litigation	Referred
Berkshire	BEFORE	N/A	N/A	YOUNGER	Likely MDL, efficiency	Referred
Cambridge (3)	BEFORE	N/A	N/A	YOUNGER	N/A	Referred
Embody (2)	N/A	N/A	N/A	YOUNGER	Petition not Cumulative	Referred
GD Energy Products	N/A	N/A	N/A	YOUNGER	N	Referred
Imperative Care	N/A	LIKELY	N/A	YOUNGER	N/A	Referred
ITM Isotope	N/A	N/A	N/A	YOUNGER	N/A	Referred
Merck Sharp (2)	BEFORE	N/A	N/A	YOUNGER	N/A	Referred
ResMed (2)	N/A	LIKELY	N/A	YOUNGER	N/A	Referred
Tesla v. Charge (2)	N/A	N/A	N/A	YOUNGER	Showing of Material Error by Office	Referred
Yealink	N/A	N/A	N/A	YOUNGER	Showing of Material Error by Office	Referred
Zuhai	AFTER	N/A	N/A	YOUNGER	N/A	Referred

# June & July 2025 Decisions (Coke)

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Effect of *Sotera* Stipulation

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

FULL-METAL-POWER B.V.,  
Petitioner,

v.

INFOCUS DOWNHOLE SOLUTIONS USA LLC,  
Patent Owner.

IPR2025-00391  
Patent 10,676,992 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

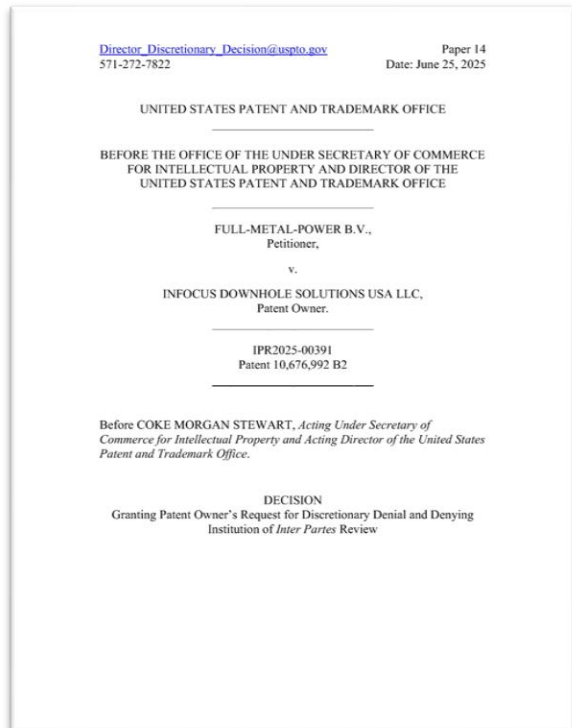
DECISION  
Granting Patent Owner's Request for Discretionary Denial and Denying  
Institution of *Inter Partes* Review

## ***Full-Metal-Power BV v. Infocus Downhole Solutions USA LLC IPR2025-0039*** Paper 14 (Stewart) (June 25, 2025)

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### Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of Inter Partes Review –

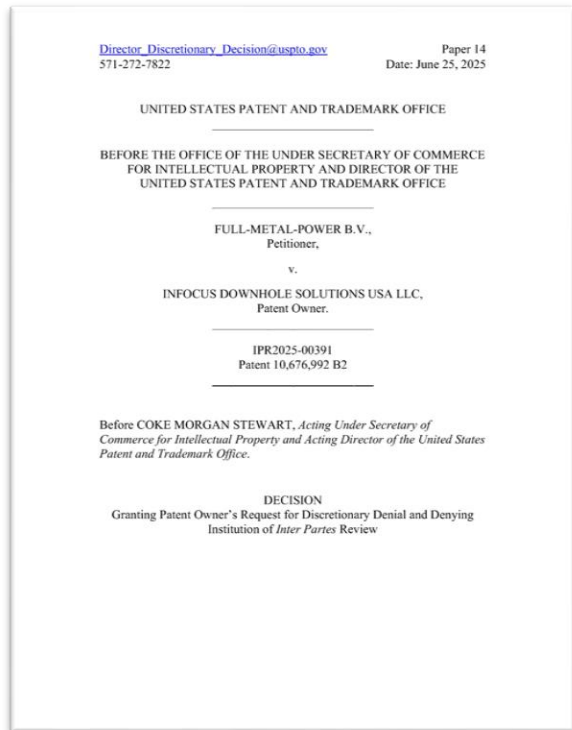
# Full-Metal-Power BV v. Infocus Downhole Solutions USA LLC IPR2025-0039 Paper 14 (Stewart) (June 25, 2025)



In particular, the projected final written decision due date in the Board proceeding is July 30, 2026. DD Req. 4. The district court's scheduled trial date is June 22, 2026. Id. As such, **it is unlikely that a final written decision in this proceeding will issue before district court trial occurs.** Furthermore, there is **insufficient evidence that the district court is likely to stay its proceeding** even if the Board were to institute trial. See id. at 6–7; DD Opp. 2–4. **Additionally, Petitioner has not offered a stipulation, despite overlap in the prior art grounds between the proceedings.** On balance, the circumstances in this case favor discretionary denial.

# ***Full-Metal-Power BV v. Infocus Downhole Solutions USA LLC IPR2025-0039*** Paper 14 (Stewart) (June 25, 2025)

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In consideration of the foregoing, it is:

**ORDERED** that Patent Owner's **request for discretionary denial is granted;**

**FURTHER ORDERED** that the Petition is **denied.**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

PHISON ELECTRONICS CORPORATION,  
Petitioner,

v.

VERVAIN, LLC,  
Patent Owner.

IPR2025-00213 (Patent 9,196,385 B2)  
IPR2025-00214 (Patent 9,997,240 B2)  
IPR2025-00215 (Patent 10,950,300 B2)  
PGR2025-00010 (Patent 11,967,369 B2)  
PGR2025-00011 (Patent 11,967,370 B1)

Before COKE MORGAN STEWART, *Acting Under Secretary of  
Commerce for Intellectual Property and Acting Director of the United States  
Patent and Trademark Office.*

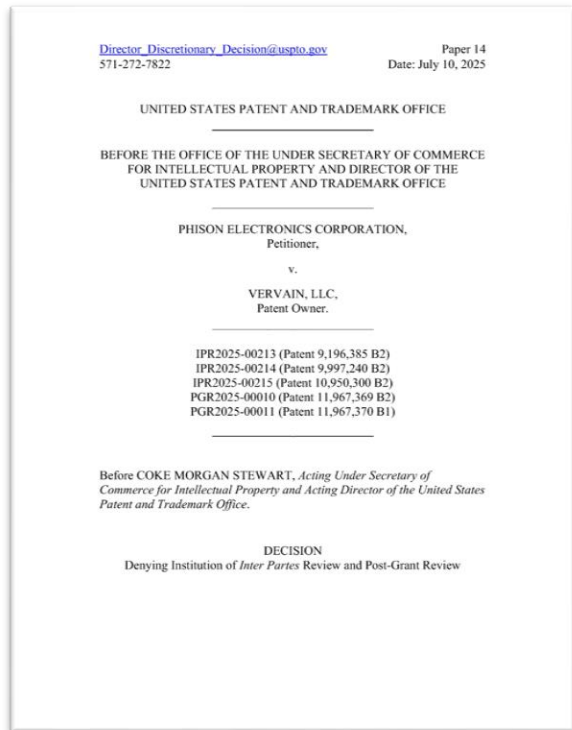
DECISION  
Denying Institution of *Inter Partes* Review and Post-Grant Review

## ***Phison Electronics Corporation v. Vervain LLC*** **IPR2025-00213, IPR2025-00214, IPR2025-00215,** **PGR2025-00010 & PGR2025-00011 Paper** **14 (Stewart)(July 10, 2025)**

Decision Granting Patent Owner's Request for  
Discretionary Denial and Denying Institution of Inter  
Partes Review –

# *Phison Electronics Corporation v. Vervain LLC* IPR2025-00213, IPR2025-00214, IPR2025-00215, PGR2025-00010 & PGR2025-00011

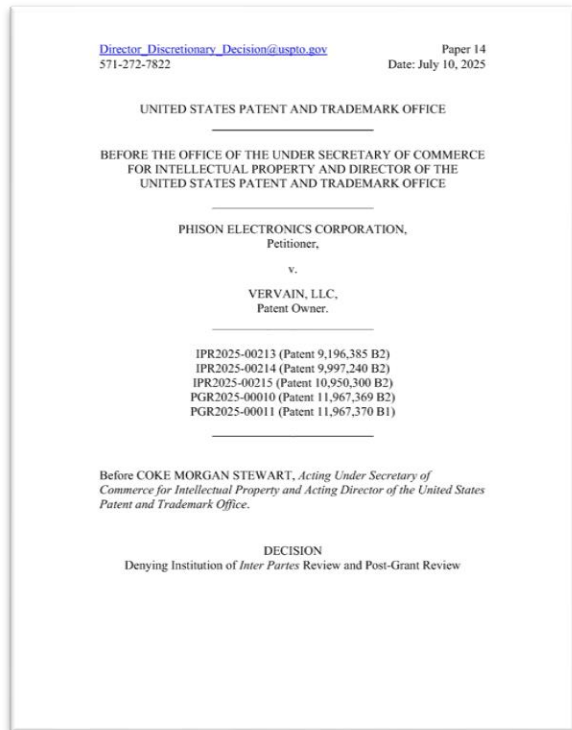
## Paper 14 (Stewart)(July 10, 2025)



For IPR2025-00213 and IPR2025-00214, the projected final written decision due date in the Board proceedings is August 14, 2026. DD Req. 10. The district court's scheduled trial date is December 15, 2025. Id. As such, **it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs.** Additionally, **there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial.** Id. at 8–9; DD Opp. 3–6. Furthermore, **there has been meaningful investment in the parallel proceeding by the parties.** DD Req. 8–10. For example, the district court has held a Markman hearing, and fact discovery is expected to be completed before a decision on institution issues. Id. at 11–12. **On balance, the circumstances in these cases favor discretionary denial.**

# ***Phison Electronics Corporation v. Vervain LLC* IPR2025-00213, IPR2025-00214, IPR2025-00215, PGR2025-00010 & PGR2025-00011**

## **Paper 14 (Stewart)(July 10, 2025)**



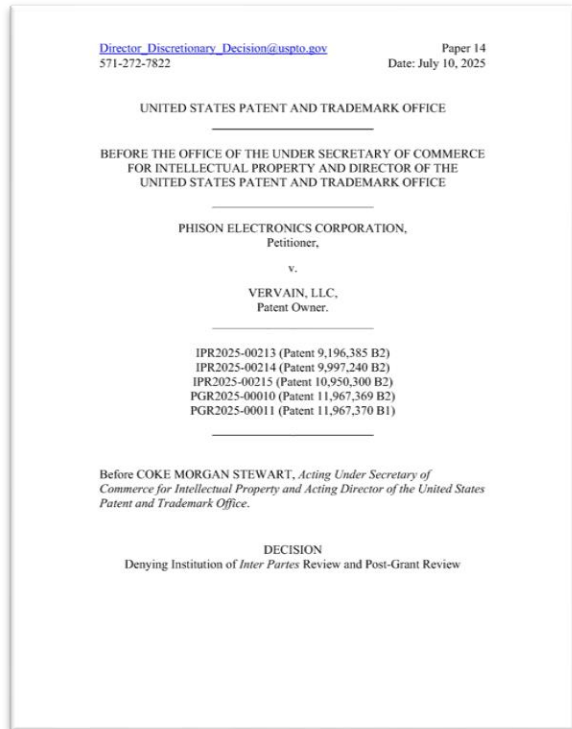
As to IPR2025-00215, PGR2025-00010, and PGR2025-00011, **the challenged patents have not been in force for a significant period of time (issued in 2021, 2024, and 2024).**

**Ordinarily this might favor referral to the Board; however, Petitioner has not offered a stipulation** to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed. **The absence of such a stipulation tips the balance in favor of discretionary denial.**

# ***Phison Electronics Corporation v. Vervain LLC IPR2025-00213, IPR2025-00214, IPR2025-00215, PGR2025-00010 & PGR2025-00011***

## **Paper 14 (Stewart)(July 10, 2025)**

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In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is **granted**; and

FURTHER ORDERED that the Petitions are denied, and no trial is instituted.



# Questions

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