

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

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Welch Allyn (“Patent Owner”) filed a request for discretionary denial of institution (Paper 7, “DD Req.”) in the above-captioned cases, and iRhythm Technologies, Inc. (“Petitioner”) filed an opposition (Paper 9, “DD Opp.”).¹

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.

In addition, while Patent Owner argues that discretionary denial is warranted because Petitioner is over-reliant on expert testimony (DD Req. 20–29), Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art. Instead, Petitioner appears to rely on its expert to explain the background knowledge of a person of ordinary skill in the art, and the expert provides citations to

¹ Citations are to papers in IPR2025-00377. The parties filed similar papers in the other cases.

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evidence in support of his statements in the required manner. *See* 37 C.F.R. § 42.65(a); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) (precedential). This also weighs against discretionary denial.

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.

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 Petitions are *denied*, and no trial is instituted.

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