

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.

IPR2024-00953
Patent 11,413,380 B2

Before MEREDITH C. PETRAVICK, GRACE KARAFFA OBERMANN,
and AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION
Denying Institution of Inter Partes Review
35 U.S.C. § 314

I. INTRODUCTION

Shenzhen Root Technology Co., Ltd. (“Petitioner”) filed a Petition (Paper 2 (“Pet.”)) on May 31, 2024, which was accorded a filing date of May 31, 2024 (Paper 4), per 35 U.S.C. §§ 311–319, for *inter partes* review of claims 1–46 (“the Challenged Claims”) of U.S. Patent No. 11,413,380 B2 (Ex. 1001, “the ’380 patent), and a Reply to Patent Owner Preliminary Response (Paper 16 (“Pet. Reply”)).

Petitioner later filed a parallel petition¹ in another proceeding also requesting an *inter partes* review of claims 1–46 of the ’380 patent on different asserted grounds. *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2024-01296 (“the ’1296 IPR”), Paper 3. Additionally, Petitioner filed a “Notice Ranking and Explaining Material Differences Between Petitions for Inter Partes Review of U.S. Patent No. 11,413,380” (’1296 IPR, Paper 2 (“Notice of Ranking” or “Exp.”)) requesting that we consider whether to institute *inter partes* review based on the petition in the ’1296 IPR prior to considering the Petition in this proceeding. Exp. 2.

¹ The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) (*available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>) defines “parallel petitions” as “Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner).” CTPG 59. The petition in the ’1296 IPR was filed August 14, 2024, prior to the filing of the Patent Owner’s Preliminary Response in this proceeding. Thus, we consider the two petitions to be “parallel petitions.”

Chiaro Technology Ltd., (“Patent Owner”) filed a Preliminary Response in this proceeding (Paper 14 (“POPR”)) and a Sur-reply to Petitioner’s Reply (Paper 17 (“PO Sur-reply”)) which disputed the need for parallel petitions. Patent Owner also filed a Preliminary Response in the ’1296 IPR (Paper 6).

For the reasons provided below, based on the circumstances present here, we find Petitioner has not shown that parallel petitions challenging the same claims of the ’380 patent at issue in this proceeding and in the ’1296 IPR are warranted, and we exercise discretion under 35 U.S.C. §314(a) to deny institution of an *inter partes* review of the ’380 patent in this proceeding. In so doing, we make no findings as to the sufficiency of the petition in the ’1296 IPR to support institution.

II. BACKGROUND

Real Parties in Interest

Petitioner identifies Shenzhen Root Technology Co., Ltd. (also known as Shenzhen Lutejiacheng Network Technology Co., Ltd., which changes its name to Shenzhen Lute Innovation Technology Co., Ltd. in September 2023, Hong Kong Lute Technology Co., Ltd.), Shenzhen Conglin E-Commerce Co., Ltd., Shenzhen Jinruihang Technology Co, Ltd., Shenzhen Xitao Network Technology Co., Ltd., and ROOT Technology Ltd. as the real parties in interest. Pet. 91.

Patent Owner identifies itself, Chiaro Technology Ltd., as the only real party in interest.

Related Matters

The parties identify the following lawsuits in which the ’380 patent is asserted: *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology, Ltd.*,

IPR2024-00953
Patent 11,413,380 B2

Case No. 2:23-cv-00631 (W.D. Wash.), and *Willow Innovations, Inc. v. Chiaro Technology, Ltd.*, Case no. 2:23-cv-00229 (E.D. Tex.) (to which Petitioner is not a party). Pet. 89, 91; Paper 3, 1.

The '380 Patent

The '380 patent is titled "BREAST PUMP SYSTEM" and issued August 16, 2022 from Application No. 17/203,327, filed on March 16, 2021 ("the '327 Application"). Ex. 1001, codes (21), (22), (45), (54). The '380 patent refers back to two applications, the earliest of which was filed on June 15, 2018 and issued as Patent No. 10,926,011. *Id.* at code (63). The '380 patent is directed "a wearable breast pump system including a housing shaped at least in part to fit inside a bra and a piezo air-pump" that is fitted in the housing. *Id.* at code (57).

The '380 patent seeks to address prior art breast pump systems' disadvantages of a user being tethered to a wall, "indiscrete" use, noise, discomfort, difficulty in cleaning, collapsible collection bag issues regarding difficulty in extracting all the milk from the bag, the recurring cost, small bag size, and the large size and bulkiness of prior wearable breast pump systems. Ex. 1001, 1:65–66, 2:2–4, 2:19–30, 2:38, 53–55. It does so by providing "a breast pump system that is, at least in part, wearable inside a bra" and comprises a breast shield, a housing and a milk collection container. *Id.* at 5:39–45.

The breast pump system of the '380 patent comprises the main components of a breast shield, housing, and detachable milk collection container. Ex. 1001, 5:40–47. The breast shield is "for engagement with the user's breast" and comprises a flexible diaphragm "for transferring the pressure from the pump to the milk-collection side of the system," an inner

flange, an elongated nipple tunnel, and a curved section. *Id.* at 5:41, 6:14–15, 8:62–64, 9:27–32, 10:25–29. The housing is “for receiving at least a portion of the breast shield” and comprises a pump “for generating a negative pressure in the breast shield,” a battery, and control electronics, and a region for receiving the breast shield nipple tunnel. *Id.* at 5:42, 5:47–49, 9:66–10:1. The milk collection container is rigid, detachable, and “attachable, in use, to a lower face of the housing and connected to the breast shield for collecting milk expressed by the user, with a milk-flow pathway defined from an opening in the breast shield to the milk collection container.” *Id.* at 5:43–47.

In the ’380 patent’s breast pump, “the only parts of the system that come into contact with milk in normal use are the breast shield and the milk container; milk only flows through the breast shield and then directly into the milk container,” such that there is no milk flow through any parts of the housing thereby achieving “maximum hygiene and ease of cleaning.” *Id.* at 5:50–55.

Illustrative Claim

Petitioner challenges claims 1–46 of the ’380 patent. Pet. 2. Claims 1 and 29 are independent claims. Claims 2–28 and 30–46 depend from claims 1 and 29, respectively. Claim 1 is illustrative of the claimed subject matter and is reproduced below with bracketed labels as added by Petitioner:

- 1[pre]. A breast pump device comprising:
 - 1[a] a self-contained, in-bra wearable device comprising:
 - 1[b] a pump housing that includes:
 - 1[b][i] a rechargeable battery,
 - 1[b][ii] a power charging circuit for controlling charging of the rechargeable battery,
 - 1[b][iii] control electronics powered by the rechargeable battery,
 - 1[b][iv] a pump powered by the rechargeable battery and configured to generate negative air pressure,
 - 1[b][v] a Universal Serial Bus (USB) charging socket for transferring power to the power charging circuit and the rechargeable battery, and
 - 1[b][vi] a recess or cavity that defines a pumping chamber;
 - 1[c] a breast shield made up of a breast flange and a nipple tunnel;
 - 1[d] a milk container that is configured to be attached to and removed from the pump housing; and
 - 1[e] a diaphragm that is configured to prevent milk from reaching the pump, the diaphragm being seated against a diaphragm housing that is fixed to a recessed surface of the pump housing, and the diaphragm being a membrane that deforms in response to changes in air pressure caused by the pump to create negative air pressure in the nipple tunnel.

Asserted Grounds of Unpatentability

Petitioner asserts that claim 1–46 of the '380 patent are unpatentable based on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–4, 6–9, 11–16, 18–26, 29–35, 37–44	103(a)	Chang, ² Weber, ³ Guthrie ⁴
5, 10–12, 17, 25–28, 36–38, 43–46	103(a)	Chang, Weber, Guthrie, Khalil ⁵

Pet. 2.

Petitioner further relies on the supporting Declaration of Ryan Bauer. Pet.1. (Ex. 1005 (“Bauer”)).

III. DISCRETIONARY DENIAL

The Petition seeks *inter partes* review of the same claims of the ’380 patent that Petitioner requests review of in the ’1296 IPR. Exp. 1.

We consider whether Petitioner has shown that the Petition, which challenges the same claims of the ’380 patent at issue in the ’1296 IPR, is warranted and whether we should exercise discretion to deny this parallel petition. See 35 U.S.C. § 314(a); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (explaining that section “314(a) invests the Director with discretion on the question *whether* to institute review”); *Harmonic Inc. v.*

² U.S. Patent App. Pub. No. 2018/0333523 A1, published Nov. 22, 2018 (Ex. 1007 (“Chang”)).

³ U.S. Patent App. Pub. No. 2012/0277728 A1, published Nov. 1, 2012 (Ex. 1008 (“Weber”)).

⁴ U.S. Patent App. Pub. No. 2016/0082166 A1, published Mar. 24, 2016 (Ex. 1009 (“Guthrie”)).

⁵ U.S. Patent App. Pub. No. 2013/0023821 A1, published Jan. 24, 2013 (Ex. 1010 (“Khalil”)).

Avid Tech., Inc., 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

The CTPG states that “one petition should be sufficient to challenge the claims of a patent in most situations” and that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” CTPG 59. The CTPG further states that “[t]wo or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.* (citing 35 U.S.C. § 316(b)).

The CTPG provides the following guidance:

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).

Id. at 59–60 (footnote omitted).

In this proceeding, Petitioner previously requested “administrative dismissal” of the instant Petition in favor of a future petition. Ex. 3001, 2 (the “dismissal request”). During a telephonic conference with counsel to discuss the issues (a transcript of which is in the record as Ex. 1017), Petitioner asserted it would be “best to just hit the reset button and to provide this updated petition [of the ’1296 IPR] that had this information that we think an inquisitive mind would want to know and have in front of them when they’re making decisions” and that it would be easier to “simply just dismiss” this proceeding so as to have a single institution decision rather than rank the two petitions. Ex. 1017, 7:3–8:6, 10:16–11:4.

Patent Owner opposed the dismissal request. Ex. 3001, 1. After consideration of the parties’ positions, arguments, and any evidence, the Board denied the dismissal request in part because Patent Owner had, at the times of the telephonic conference and filing of the dismissal request, not filed a Preliminary Response and nor had Petitioner filed a new petition. Paper 8, 3–6.

On August 14, 2024, prior to Patent Owner filing its Preliminary Response and prior to the Board’s denial of the dismissal request, Petitioner filed a later parallel petition in the ’1296 IPR. In Petitioner’s Notice of Ranking, in the ’1296 IPR, Petitioner acknowledges the request to dismiss this proceeding and asserts that the dismissal request “remains pending.” Exp. 2. In its Reply to the Patent Owner Preliminary Response in this proceeding, Petitioner again notes that it “previously offered to dismiss this proceeding long before any preliminary response in lieu of a second IPR against the ’380 patent.” Pet. Reply 1.

Notwithstanding, Petitioner “believes that both Petitions are meritorious and justified” but ranks the Petition in this proceeding below the petition in the ’1296 IPR. Exp. 2. Petitioner explains that receiving Patent Owner’s infringement contentions led to the finding of “the Fang reference (a Chinese publication)” that “highlights the examiner’s mistaken reasoning for allowing the ’380 patent.” *Id.* at 3–4. Petitioner also argues that “multiple petitions are reasonable in view of the volume of [43] claims” and that it “rapidly filed this parallel petition” in the ’1296 IPR before Patent Owner filed its Preliminary Response in this proceeding. *Id.* at 4.

Petitioner asserts that the parallel petitions have material differences and are not redundant. Exp. 4. In particular, Petitioner alleges that “Fang not only suggests the use of a second type of diaphragm configuration that is highly similar to the preferred embodiment of the ’380 patent, but Fang notably illustrated the exact features the Examiner mistakenly believed to be missing from the prior art.” *Id.* at 5.

Patent Owner argues that the Board should exercise its discretion to deny this petition because Petitioner filed a subsequent petition in the ’1296 IPR. POPR 53. Specifically, Patent Owner contends that the sixth factor of *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential), very strongly favors denial of this proceeding because “Petitioner themselves have indicated a preference to challenge the ’380 patent in a different proceeding.” *Id.* at 58 (citing Ex. 1017, 7:16–8:6, Ex. 2005, 2–3).

We agree with Patent Owner that Petitioner has not shown that parallel petitions challenging claims 1–46 of the ’380 patent are warranted. The mere fact that different references are asserted in this proceeding and

the '1296 IPR is not justification for a parallel petition under the circumstances presented here.

Weighing all the circumstances here, including Patent Owner's acknowledgment of Petitioner's preference of the '1296 IPR in arguing for denial of this proceeding and in its objection to the dismissal request, we deny this proceeding in favor of evaluating institution of *inter partes* review in the '1296 IPR to reduce the unnecessary burden on the Board and on the Patent Owner and for fairness and efficiency concerns. Based on these circumstances, we find that the reasons provided by Petitioner do not show that parallel petitions are warranted. However, we emphasize that the denial of institution of this proceeding in favor of the '1296 IPR does not impact the merits of the '1296 IPR. In other words, the denial of institution of this proceeding does not address the substance of the '1296 IPR nor does it affect the denial or grant of institution of the '1296 IPR.

IV. CONCLUSION

For the foregoing reasons, we exercise our discretion under § 314(a) and deny the Petition seeking *inter partes* review of the '380 patent in this proceeding.

V. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* and no trial is instituted in this proceeding.

IPR2024-00953
Patent 11,413,380 B2

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