McCombs in Law360: IPR Denial in iRhythm Should Not Set a Blanket Rule

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PRACTICES Patents, Patent Litigation, Patent Office Trials

Haynes Boone Partner David McCombs authored an article for *Law360* after the United States Patent Trial and Appeal Board as concerns that mere knowledge of a patent, regardless of context or industry practice, could now bar inter partes review institution.

Read an excerpt below.

Patent Trial and Appeal Board acting Director Coke Morgan Stewart's discretionary denial in the iRhythm Technologies Inc. v. Welch Allyn Inc. cases on June 6 has sent shockwaves through the patent litigation community, raising concerns that mere knowledge of a patent — regardless of context or industry practice — could now bar inter partes review institution.

However, a closer look at the facts and reasoning in iRhythm reveals why this case is unique and why its holding should not be reflexively applied to all petitioners, especially large companies routinely engaged in patent litigation.

The Unique Facts of iRhythm: More Than Just Knowledge
In iRhythm, Stewart denied institution of five IPRs primarily because the petitioner had been aware of the challenged patent for over a decade, as evidenced by its own information disclosure statement submissions during prosecution of its own patents.

The director found that this long-standing awareness, coupled with the petitioner's failure to seek early review, created settled expectations for the patent owner that outweighed other factors — even though the related district court litigation was in its early stages and a stay could have occurred if IPR was instituted.

What makes iRhythm unique is not just the petitioner's knowledge of the patent, but the specific, documented evidence of that knowledge, the length of time the patent had been in force, and the absence of any intervening events that would have justified the delay. The director's decision emphasized a holistic assessment and did not suggest that mere knowledge alone, without more, would always justify denial.

Why iRhythm Should Not Set a Blanket Rule Based on Patent Knowledge
If the iRhythm rationale were applied as a bright-line rule, it would create unreasonable and unworkable expectations for petitioners, particularly large companies that routinely monitor, cite and are aware of thousands of patents in their fields.

In practice, knowledge of a patent is often a function of standard competitive intelligence, routine prosecution or even regulatory compliance, such as U.S. Food and Drug Administration submissions), and should not necessarily signal an intent or obligation to challenge every patent of which a company is aware.

Moreover, the PTAB's own guidance and Stewart's memo make clear that settled expectations are just one of several discretionary factors, and that the decision to deny institution should be based on a holistic, fact-specific analysis. The iRhythm decision itself acknowledged that several factors weighed against denial, but the particular facts — decade-long awareness, documented in the record and no intervening justification for delay — tipped the balance.

To read the full article from *Law360*, click here.