

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISHER & PAYKEL HEALTHCARE LIMITED,
Petitioner,

v.

RESMED LIMITED,
Patent Owner.

Case IPR2017-00062
Patent 9,119,931 B2

Before BARRY L. GROSSMAN, BEVERLY M. BUNTING, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

ORDER
GRANTING EXTENSION OF TIME
GRANTING REQUEST FOR REHEARING
SETTING SUPPLEMENTAL BRIEFING SCHEDULE
37 C.F.R. §§ 42.5; 42.71(d)

Fisher & Paykel Healthcare Limited (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 43, 46, 48–51, 53–58, 60–65, 68–71, and 77–79 of U.S. Patent No. 9,119,931 B2 (Ex. 1101, “the ’931 patent”). ResMed Limited (“Patent Owner”) did not file a preliminary response to the Petition.

Petitioner raised five separate and distinct challenges to patentability. Pet. 15–16. We instituted review on the four grounds listed below:

1. claims 57, 58, 61, 68, 69, 71, and 77–79 would have been obvious based on D’Souza, Ultra Mirage, Barnett, and Matula-II;
2. claim 60 would have been obvious based on D’Souza Ultra Mirage, Barnett, Matula-II, and FlexiFit;
3. claims 62–64 would have been obvious based on D’Souza, Ultra Mirage, Barnett, Matula-II, FlexiFit, and Gunaratnam-II; and
4. claims 43, 48–50, and 70 would have been obvious based on D’Souza, Ultra Mirage, FlexiFit, Barnett, Jaffre, and Matula-II. Paper 7, 36 (“Dec. Inst.”).

We did not institute trial on challenged claims 46, 51, 53–56, and 65, which included a “protruding vent arrangement.” *See* Dec. Inst. 19–21, 34–35. The references cited against the uninstituted claims are the same references considered against the claims for which a trial was held. *See* Dec. Inst. 7–8 (summarizing the asserted grounds in the Petition).

Patent Owner filed a Response to the Petition (Paper 17, “PO Resp.”), and Petitioner filed a Reply (Paper 23, “Pet. Reply”).

Petitioner submitted 26 exhibits (Exs. 1101–1126). Petitioner relies, in part, on the Declaration testimony of Jason Eaton, P.E. (Ex. 1113).

Patent Owner submitted 7 exhibits (Exs. 2001–2007). Patent Owner relies, in part, on the Declaration testimony of Geoffrey Sleeper (Ex. 2002).

A joint hearing with related IPR2017-00061 was held December 18, 2017. Paper 33 (“Tr.”).

We issued a final written decision on March 29, 2018, finding unpatentable claims 43, 48–50, 57, 58, 60–64, 68–71, and 77–79, which were all the claims for which an *inter partes* review was conducted. Paper 34 (“FWD”).

After the final written decision, shortly before the deadline for filing a request for rehearing, and also before the deadline for filing an appeal of the final written decision to the Federal Circuit, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). In *SAS*, the Supreme Court held that a final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. *SAS*, 138 S. Ct. at 154 (“So when [35 U.S.C.] § 318(a) says the Board’s final written decision ‘shall’ resolve the patentability of ‘any patent claim challenged by the petitioner,’ it means the Board *must* address *every* claim the petitioner has challenged.”) Our final written decision did not comply with this requirement.

On May 9, 2018, Petitioner contacted the Board to discuss the impact of the *SAS* decision on this proceeding. To address how to resolve the change in practice required by *SAS*, a conference call was held on May 16, 2018, between counsel for Petitioner, counsel for Patent Owner, and the Board. During the call, we authorized Petitioner to file both a Request for Rehearing of the Final Written Decision and a Request for an Extension of

Time, and for Patent Owner to file a reply. Ex. 1127, 12:10–16; 14:22–15:7; 17:3–7.

Petitioner filed the authorized Request for Rehearing of our Final Written Decision, and the authorized Request for an Extension of Time. (Paper 36, “Request”). Specifically, Petitioner “requests institution and reconsideration of the challenged claims that were not instituted in the Institution Decision (Claims 46, 51, 53–56, and 65).” Request, 2.

Patent Owner filed a paper opposing Petitioner’s requests. Paper 37 (“PO Opp. To Ext. and Rehrng.”). Patent Owner argues that “Petitioner never raised the issue for nearly a full year after the Supreme Court granted certiorari in the SAS decision on May 22, 2017. Petitioner’s failure to timely raise the issue has prejudiced ResMed.” PO Opp. To Ext. and Rehrng 1. Patent Owner does not cite any evidence that identifies or establishes the alleged prejudice. Moreover, it is unreasonable to expect Petitioner, or Patent Owner, to take specific action in this proceeding based on the grant of certiorari from the Supreme Court in SAS.

In light of the intervening SAS decision, we find good cause exists to extend the time for requesting a rehearing, and to permit the requested rehearing, with supplemental briefing, with the rehearing and supplemental briefing limited to the previously uninstituted claims. *See* 37 C.F.R. § 42.5.

Accordingly, we repeat in this Order the authorizations provided verbally in our May 16 telephone conference. Petitioner’s Request for an Extension of Time to file a Request for Rehearing is granted until and including May 18, 2018, the date authorized in the May 16 telephone conference. Ex. 1127, 12:8–16.

Additionally, Petitioner's timely Request for Rehearing to consider uninstituted claims 46, 51, 53–56, and 65 is granted. As stated in the telephone conference, the rehearing is directed only to the uninstituted claims. We are not going to vacate our final written decision in this proceeding; we will supplement it with a patentability determination on the uninstituted claims. *See* Ex. 1127, 13:10–22.

The parties met and conferred on a schedule for supplemental briefing and a supplemental hearing.

Supplemental PO Response	June 25
Supplemental Petitioner Reply	July 30
Exchange Slides	August 6
Slides to Board	August 9
Hearing	August 14

As is evident, from the date of this decision, this schedule will need to be revised. We propose the following revised schedule.

Supplemental PO Response	August 27
Supplemental Petitioner Reply	September 24
Exchange Slides	October 1
Slides to Board	October 5
Hearing	October 23

In their proposed schedule, the parties have not requested to file additional declarations or take additional depositions in support of the additional briefing and, accordingly, we do not authorize at this time the parties to file additional declarations or take any additional depositions.

The parties may stipulate to different dates (earlier or later) for all dates except the hearing. A notice of the stipulation, specifically identifying the changed due dates, must be filed promptly after a change is made. Because of the need to arrange for a courtroom and reporter, the parties may not stipulate to an extension of the proposed hearing. The Board will be willing to accommodate requests to revise the hearing date, if necessary. Because of the unusual procedural nature of this matter, the Board also is willing to consider a joint request from the parties for a telephone conference hearing, in which counsel would not be required to appear in person.

We did not address page limits for supplemental briefs in our telephone conference. The parties have not been able to agree on the length of the supplemental briefs. Petitioner proposes 20 pages (Request 3), Patent Owner proposes the briefs not exceed 10 pages (PO Opp. To Ext. and Rehrgr 1). Consistent with our determination in a related matter in a related case, we determine that the Supplemental PO Response and the Supplemental Petitioner Reply each will be limited to ten (10) pages. *See* IPR2017-00632, Paper 31 (PTAB May 18, 2018) (limiting supplemental briefing on uninstituted claims to ten (10) pages).

The Supplemental Patent Owner Response may address only the uninstituted claims, e.g., claims 46, 51, 53–56, and 65. Any arguments for patentability regarding claims 46, 51, 53–56, and 65 that are not raised in the Supplemental Patent Owner Response are deemed waived.

In addition to addressing arguments and evidence in the Supplemental Patent Owner Response, the Supplemental Petitioner Reply may respond to preliminary findings made by the Board in the Decision on Institution with

respect to claims 46, 51, 53–56, and 65, but otherwise is subject to 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding . . . [supplemental] patent owner response.”). Evidence relied on by Petitioner in its Supplemental Reply is limited to rebuttal evidence.

ORDER

In consideration of the foregoing, it is hereby ORDERED that:

1. Petitioner’s request for an extension of time until May 18, 2018 to file a request for rehearing is granted;
2. Petitioner’s request for a rehearing of our final written decision (Paper 34) to address uninstituted claims 46, 51, 53–56, and 65 is granted;
3. Patent Owner is authorized to file a 10 page Supplemental Patent Owner Response by August 27, 2018, addressing only uninstituted claims 46, 51, 53–56, and 65;
4. Petitioner is authorized to file a 10 page Supplemental Reply to the Supplemental Patent Owner Response by September 24, 2018, addressing the Supplemental Patent Owner Response, the analysis of claims 46, 51, 53–56, and 65 in the Decision on Institution, and is otherwise subject to 37 C.F.R § 42.23(b);
5. An oral hearing will occur on October 23, 2018, unless both parties request, by October 16, 2018, that no hearing be conducted; and
6. The parties are authorized to file by August 1, 2018 a Joint Motion to Limit the Petition by removing claims 46, 51, 53–56, and 65 from this proceeding.

IPR2017-00062
Patent 9,119,931 B2

PETITIONER:

John Sganga
Brenton R. Babcock
Benjamin J. Everton
William Adams
Sheila Swaroop
Joseph F. Jennings
KNOBBE, MARTENS, OLSON & BEAR, LLP
2jbs@knobbe.com
2brb@knobbe.com
2bje@knobbe.com
2woa@knobbe.com
2sns@knobbe.com
2jfi@knobbe.com

PATENT OWNER:

Michael T. Hawkins
Michael J. Kane
Christopher C. Hoff
Stephen R. Schaefer
Geoffrey Biegler
FISH & RICHARDSON P.C.
hawkins@fr.com
kane@fr.com
hoff@fr.com
schaefer@fr.com
biegler@fr.com
IPR36784-0053IP1@fr.com
PTABInbound@fr.com