

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISHER & PAYKEL HEALTHCARE LIMITED,
Petitioner,

v.

RESMED LIMITED,
Patent Owner.

Case IPR2017-00218
Patent 9,381,316 B2

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

MAYBERRY, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Fisher & Paykel Healthcare Ltd. (“Fisher”), filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 33–58 and 75–85 (the “Challenged Claims”) of U.S. Patent No. 9,381,316 B2 (Ex. 1101, the “’316 patent”). Patent Owner, ResMed Ltd. (“ResMed”), filed a Preliminary Patent Owner Response (“Prelim. Resp.”). Paper 6. We did not institute trial in this proceeding. Paper 8 (“Decision” or “Dec. on Inst.”). Fisher timely filed a Request for Rehearing. Paper 9 (“Request” or “Reh’g Req.”). For the reasons explained below, Fisher’s Request is denied.

II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). And, because Fisher seeks rehearing of our Decision on Institution, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). A request for rehearing is not an opportunity to present new arguments. *See* 37 C.F.R. § 42.71(d) (requiring

the rehearing request to “specifically identify all matters the party believes the Board misapprehended or overlooked, *and the place where each matter was previously addressed in a motion, an opposition, or a reply*”) (emphasis added).

III. ANALYSIS

In its Request, Fisher contends that the Board (1) “misapprehended the effect of the prosecution history on the scope of the claims” and (2) “overlooked that the structure of Berthon-Jones satisfies the actual engagement limitation.” Reh’g Req. 4, 9. We take each of these contentions in turn.

1. The prosecution history of the ’316 patent and the “fixed, non-adjustable” claim limitations

The Challenged Claims include independent claims 33, 38, 41, 46, 75, and 78, each of which includes a variation of the “fixed, non-adjustable position” limitation. Claims 41, 46, and 75 recite a representative “fixed, non-adjustable position” limitation: “wherein each of the at least first and second cushion components is structured to engage with the common frame in a fixed, non-adjustable position to prevent any relative or adjustable movement between each of the at least first and second cushion components and the common frame.” Ex. 1101, 15:5–9, 15:66–16:3, 20:10–14. *See also* Reh’g Req. 4 (presenting the “fixed, non-adjustable position” limitation for claims 33, 38, 41, 46, 75, and 78, which Fisher terms the “engagement limitation”). As we recognized in our Decision, during the prosecution of the application that matured into the ’316 patent, ResMed distinguished Matula (Ex. 2101) from the claims by adding the subject matter of the “fixed, non-adjustable position” limitations. *See* Dec. on Inst. 10.

During prosecution, the Examiner issued a Notice of Allowability for the application that matured into the '316 patent responsive to an amendment filed on February 19, 2016 and an interview conducted on February 26, 2016. Ex. 1108, 41–45. In an earlier amendment, which added the “fixed, non-adjustable position” limitation, ResMed argued that “the patient interface of Matula includes an adjustment mechanism 70 that allows the position of the seal member 38 relative to the faceplate 36 to be adjusted.” *Id.* at 400. The Applicant-Initiated Interview Summary for the February 26, 2016 interview states that the “Examiner indicated that it appears the amendments regarding non-adjustable connection between cushion components and common frame overcame the Matula reference, which teaches adjustable connection.” *Id.* at 350; *see also id.* at 253 (“Examiner also indicated that the amendments to claims 66, 81, 96, 113, and 133¹ regarding the cushion components being engaged with the common frame in a fixed, non-adjustable position appears to overcome the rejections with the Matula reference.”).

In its Preliminary Response, ResMed explained that its amendment adding the “fixed, non-adjustable position” claim limitation and its arguments distinguishing Matula explicitly disclaimed mask assemblies having adjustment mechanisms. *See* Prelim. Resp. 29; Reh’g Req. 4–5. In our Decision, we expressly stated that “[w]e agree that ResMed disclaimed a mask system with an adjustment mechanism that adjusts the relative position of a cushion component and a frame” during prosecution. Dec. on Inst. 21.

¹ Application claims 66, 81, 96, 113, and 133 issued as 38, 41, 46, 59, and 75, respectively. *See* Ex. 1108, 47–51.

Fisher contends that we misapprehended the prosecution history of the '316 patent. Specifically, Fisher contends that:

ResMed attempts to define the disclaimer based on the simple presence of any adjustment mechanism. However, this position has no basis in the claim language added to overcome Matula, which does not include the term “adjustment mechanism.” Instead, the claim language clearly requires that the engagement structure of the cushion component prevent any relative or adjustable movement. Thus, the subject matter distinguished should be determined by whether it is the engagement structure that provides for any relative or adjustable movement.

Reh’g Req. 5–6. That is, Fisher argues that a proper reading of the prosecution history disclaims a mask with an engagement structure between the cushion component and frame where that engagement structure allows for relative or adjustable movement, not a mask that includes any adjustment mechanism. Fisher argues that “[t]he examiner indicated that the adjustment mechanism 70 is an ‘adjustable connection’ between the seal member 38 and faceplate 36.” Reh’g Req. 7 (citing Ex. 1108, 350).

We are not persuaded that we abused our discretion in understanding the effect of the prosecution history on the scope of the claims, as substantial evidence supports our findings. We understand that prosecution disclaimer requires that a patentee make it clear “that the invention does not include a particular feature” and that, although “such disavowal can occur either explicitly or implicitly, it must be clear and unmistakable.” *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 814 F.3d 1343, 1353 (Fed. Cir. 2016). We are not persuaded by Fisher that ResMed’s disclaimer is limited to adjustment mechanisms that correspond to a structure that forms the engagement between a cushion component and a common frame.

First, we are not persuaded that the statement in the Applicant-Initiated Interview Summary relied on by Fisher identifies Matula's adjustment mechanism 70 as an engagement structure. Instead, we read the statement to indicate that adjustment mechanism 70 allows for adjusting the relative position between the two connected components. The examiner's reasons for allowing the '316 patent supports this interpretation—it expressly states that “Matula teaches a similar device which provides for adjustable/relative movement between the cushion component and common frame, whereas the claimed invention is structured such that adjustable/relative movement between the cushion component and the common frame is prevented.” Ex. 1108, 44. This language says nothing about the actual engagement structure being adjustable. Instead, the language focuses on the “adjustable/relative movement between the cushion component and the common frame.”

Second, as ResMed asserted in its Preliminary Response, the Specification and prosecution history support a claim construction that comports with the plain meaning of the “fixed, non-adjustable position” claim limitation.² Prelim. Resp. 14–23. For example, the “fixed, non-adjustable position” claim limitation of claim 41 requires “each of the at least first and second cushion components is structured to engage with the common frame in a fixed, non-adjustable position to prevent any relative or adjustable movement between each of the at least first and second cushion components and the common frame.” Ex. 1101, 15:5–9. The plain meaning of this language is that the cushion components have a structure that engages

² Fisher also asserted that the claim terms should be given their ordinary and customary meaning. Pet. 9–10.

with a common frame such that the relative position of the cushion component and the common frame is fixed and non-adjustable. Fisher fails to persuade us that we abused our discretion when we found that a mask that includes an adjustment mechanism that adjusts the relative position of the cushion component with respect to the common frame is not encompassed by the “fixed, nonadjustable position” claim limitation.

Accordingly, we are not persuaded that we misapprehended the effect of the prosecution history on the scope of the claims.

2. Berthon-Jones and the “fixed, non-adjustable” claim limitation

Fisher contends that we overlooked how Berthon-Jones discloses the subject matter of the “fixed, non-adjustable position” claim limitation. Reh’g Req. 9. Fisher argues that “[i]t is not relevant to the [analysis of the ‘fixed, non-adjustable position’ claim] limitation that Berthon-Jones also includes a separate adjustment mechanism.” *Id.* at 10. Fisher argues that Berthon-Jones discloses that protrusions 524 and raised central structure 538³ on cushion component 514 provide a snap-fit engagement with frame 512 and that these engagement structures engage the frame in a fixed, non-adjustable manner. *Id.*

We are unpersuaded by Fisher’s argument that we abused our discretion, as the argument is inconsistent with our construction of the “fixed, non-adjustable position” claim limitations. As we indicated above, we interpret these limitations to exclude masks with structures that adjust the

³ Fisher’s Petition did not identify raised central structure 538 as satisfying the subject matter of the “fixed, non-adjustable position” claim limitations. *See* Pet. 23–25 (identifying protrusions 524 and receiving holes 526). We do not consider new arguments in a request for rehearing. *See* 37 C.F.R. § 42.71(d).

relative position of a cushion component and a frame. Fisher's annotated version of Berthon-Jones's Figures 51–53 from the Petition is reproduced below.

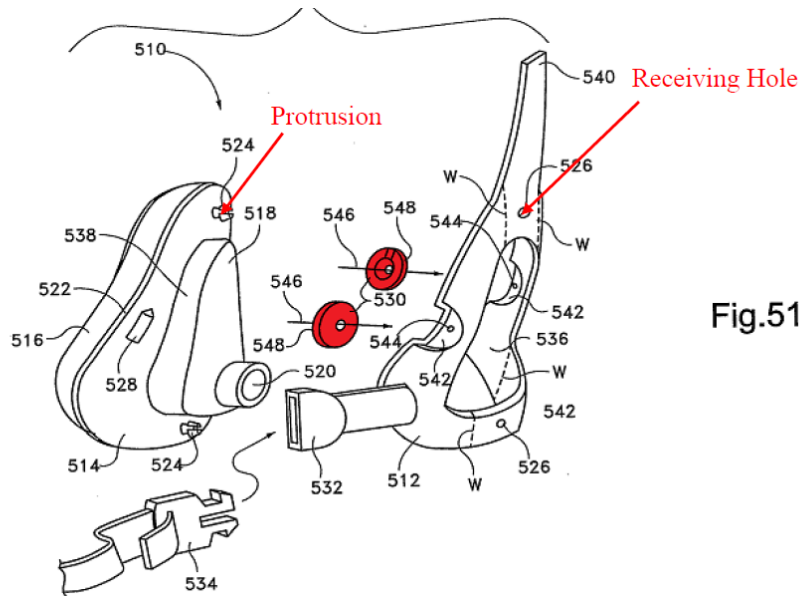


Fig. 51

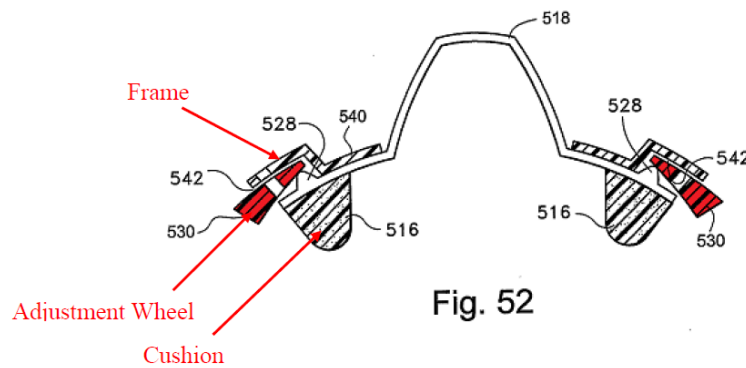


Fig. 52

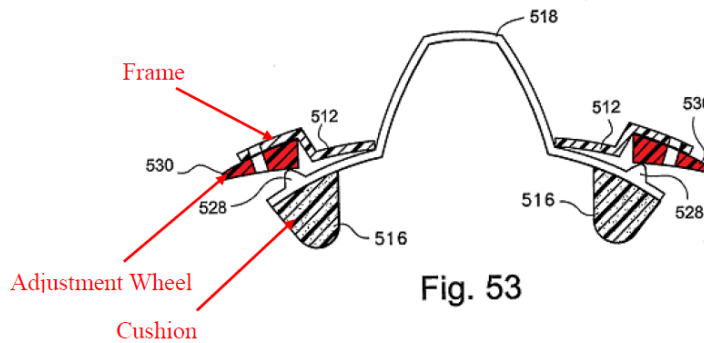


Fig. 53

Annotated Figure 51 shows Berthon-Jones's mask 510, with annotations indicating protrusions 524 and receiving holes 526. Pet. 23.

Annotated Figures 52 and 53 show the operation of Berthon-Jones's adjustment wheel 530, with annotations highlighting chassis (or frame) 512, adjustment wheel 530, and cushion portion 516 of cushion/secondary frame 514. *Id.* at 24–25. Fisher contended in the Petition that:

Although the mask fit is adjustable, once the cushion component 514 is in the desired configuration, the cushion component 514 and the common frame 512 remain in a fixed, non-adjustable position because the protrusions 524 on the cushion component 514 form a snap-fit with the receiving holes 526 on the common frame 512.

Id. at 25 (citing Ex. 1107 (Decl. of Jason Eaton) ¶ 60). That is, once a user adjusts the fit of mask 510 using adjustment wheels 530 to a desired configuration, the user will not further adjust the mask, and cushion/secondary frame 514 is in a fixed, non-adjustable position relative to chassis 512 because the two pieces snap-fit together by protrusions 524 and receiving holes 526. As Fisher acknowledges, Berthon-Jones's adjustment wheel 530 *adjusts the fit* of the mask against a user's face by *causing relative motion between cushion/secondary frame 514 and chassis 512*. See Pet. 24–25.

Fisher further contends that the adjustment mechanism of Berthon-Jones does not change the relative position of the cushion component relative to the common frame. Reh'g. Req. 12. Fisher argues that ResMed asserts that “some ‘wiggle’ between components due to manufacturing tolerances or flexibility of materials” would not take a structure outside the scope of the “fixed, non-adjustable position” claim limitations. *Id.* at 13. Fisher argues that Berthon-Jones's adjustment wheel 530 provides for a “slight ‘deflection’ of only the sides of the cushion component.” *Id.* Fisher continues that “[t]he slight deflection of a peripheral portion of the cushion

component is insufficient to change the overall position of the cushion component relative to the common frame, rather, simply changes the shape of the cushion component.” *Id.* at 14.

We are unpersuaded by Fisher’s argument that we abused our discretion. First, we do not understand Fisher as making this argument in the Petition. That is, we interpret Fisher to argue in the Petition that after a user adjusts the fit of mask 510 using adjustment wheels 530 to a desired configuration, the user will not further adjust the mask, and cushion/secondary frame 514 is in a fixed, non-adjustable position relative to chassis 512. *See* Pet. 25. We cannot misapprehend or overlook an argument that is not made.

Even if the argument as Fisher articulates here is the argument in the Petition, we are not persuaded that we overlooked Berthon-Jones disclosing the “fixed, non-adjustable position” claim limitations, as substantial evidence supports our findings. Berthon-Jones’s adjustment is not the “wiggle” that ResMed referenced in its Preliminary Response, which would be associated with manufacturing tolerances and flexible materials that may allow for some small movement between the components.⁴ *See* Prelim. Resp. 15. Instead, Berthon-Jones discloses that its adjustment wheel 530 is used to adjust the sealing force or fit of the cushion against a user’s face—that is, the reason for adjustment wheel 530 as part of the mask is to adjust the cushion relative to the frame. *See* Ex. 1102 ¶ 186; *see also id.* at ¶ 168

⁴ We stress that we do not decide whether the “fixed, non-adjustable position” claim limitations would encompass a structure with the “wiggle” that ResMed referenced in its Preliminary Response, as we do not need to reach that issue in deciding this Request.

(“[Figures] 41 through 53 illustrate additional embodiments which allow pinching along the lateral sides of the patient’s face/nose. . . . Each of these embodiments allows for more control over adjustment and adapts more readily to variations in physiognomy between [patients] with differently shaped noses.”).

Accordingly, we are not persuaded that we overlooked that the structure of Berthon-Jones satisfies the subject matter of the “fixed, non-adjustable position” claim limitations.

IV. CONCLUSION

For the foregoing reasons, we determine that Fisher has not satisfied its burden of demonstrating that we abused our discretion in the Decision on Institution, such that our Decision should be modified and trial instituted.

V. ORDER

After due consideration of the record before us, it is:
ORDERED that Fisher’s Request is *denied*.

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