

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISHER & PAYKEL HEALTHCARE LIMITED,
Petitioner,

v.

RESMED LIMITED,
Patent Owner.

Case IPR2017-00632
Patent 8,944,061 B2

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

BUNTING, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On July 25, 2017, we entered a Decision on Institution (Paper 8, “Decision” or “Dec.”) in this proceeding, determining that Fisher & Paykel Healthcare Limited (“Petitioner”) had not presented sufficient arguments and evidence demonstrating a reasonable likelihood that it would prevail in showing claims 22, 26, 27, 37, 41, 42, 48–80, 82, 83, 86, 89–91 of U.S. Patent No. 8,944,061 B2 (Ex. 1001, “the ’061 patent”) are unpatentable (Dec. 2). Trial was therefore instituted only as to claims 17, 18, 20, 21, 23, 28–30, 32, 33, 35, 36, 38, 43–46, 81, 84, 85, 87, 88, and 91 of the ’061 patent.¹ Dec. 25. Petitioner timely filed this Request for Rehearing. Paper 10 (“Request” or “Req. Reh’g.”). Petitioner’s stated basis for rehearing is that we (1) “denied institution of Claims 22 and 37, which should have been instituted to be consistent with the Board’s analysis of independent Claim 81 (Req. Reh’g. 1); and (2) “misunderst[oo]d substantial unrefuted evidence about what a [person having ordinary skill in the art] would be guided to do by the prior art” (*id.*).

When considering a request for rehearing, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). On rehearing, the burden of showing that the Decision should be modified lies with the party challenging the Decision, in this case, Petitioner. 37 C.F.R. § 42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was

¹ Petitioner recognizes in its Request that claim 91 was erroneously listed as an instituted claim. Claim 91 depends indirectly from independent claim 81, which was instituted, and indirectly from claim 89, which was not instituted. Dec. 19–20; Ex. 1001, 28:34–35. For purposes of this Request, we maintain institution of claim 91 and will clarify our determination in the Final Written Decision.

previously addressed in a motion, an opposition, or a reply.” *Id.* For the reasons that follow, Petitioner’s request for rehearing is denied.

II. DISCUSSION

A. That the Board was Misdirected by Patent Owner as to Claims 22 and 37

Petitioner argues that claims 22 and 37 were mistakenly included in a group of non-instituted claims “that require the additional limitations: ‘two connecting members that connect a lower portion of the second frame to the upper support member’ or ‘the opening is substantially triangular.’” *Id.* at 3 (citing Dec. 22). Specifically, because “[c]laims 22 and 37 do not include the limitations responsible for the Board’s denial of the other non-instituted claims and should have been instituted.” *Id.* at 4.

Contrary to Petitioner’s argument, we did not mistakenly include claims 22 and 37 with the identified group of non-instituted claims. In our Decision, we expressly stated that “[c]laims 22 and 37 each require the second frame to include contact points that prevent rotation of the first frame with respect to the second frame.” Dec. 22. As Petitioner correctly points out, claims 22 and 37 depend from instituted claims 17 and 32, and further recite that “the second frame includes contact points [contacting the first frame] to prevent rotation of the first frame with respect to the second frame.” Req. Reh’g. 3–4 (citing Ex. 1001, 21:21–23, 22:44–47). Claim 17 requires “an opening located between the annular connection and the upper support member, the opening providing access to the first frame.” Ex. 1001, 21:4–7. Claim 32 similarly requires “a separate opening located between the annular opening and the upper support member, the separate opening providing access to the first frame while the mask assembly is fully assembled.” *Id.* at 22:28–31. Petitioner relied on its arguments directed to

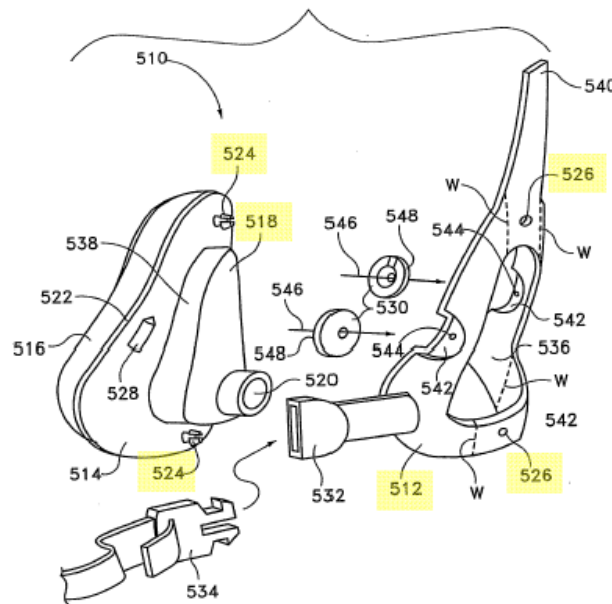
claim 81 to satisfy the “opening” claim element. Pet. 61, 63. In our Decision, however, we were not persuaded by Petitioner’s primary argument directed to claim 81. Dec. 22. Namely,

that Berthon-Jones and Barnett teach retaining the upper portion of opening 536 as a separate opening to limit or prevent unwanted rotation. See Pet. 43–44. Petitioner has not directed us to any disclosure in Berthon-Jones indicating that opening 536 performs an anti-rotation function. Rather, the function of securing the second frame to the first frame, as disclosed in Berthon-Jones, is performed by receiving holes 526, which snap-fit over connecting members 524. See Ex. 1002 ¶ 182, Fig. 51; see [Paper 7], 22–23.

Dec. 18–19.

Nonetheless, we were persuaded by Petitioner’s alternative argument, namely that “opening 526 located between the annular opening and upper member in the modified second frame corresponds to the ‘separate opening’ limitation.” Dec. 19 (citing Pet. 45; Ex. 1002 ¶ 182, Fig. 51). And, for the same reasons as stated with respect to claim 81, we were “persuaded at this preliminary stage of this proceeding that Petitioner has established a reasonable likelihood of prevailing on its contention that claims 17 and 32 would have been obvious over Berthon-Jones, Barnett, and Lithgow.” *Id.* at

21. Petitioner relied on annotated Figure 51 of Berthon-Jones, reproduced below, to support its arguments.



Annotated Figure 51 is an exploded perspective view of a mask assembly. Ex. 1002 ¶ 177.

Pet. 23; Req. Reh’g. 4.

In its Petition, Petitioner argued that claims 22 and 37 were satisfied by the disclosure in Berthon-Jones regarding

a second frame 512 with an opening 536 that is sized and shaped to receive the raised portion of the first frame 518. Ex. 1002 ¶ 184. The walls of the opening 536 contact the first frame and provide contact points that prevent rotation of the raised portion of the first frame 518 relative to the second frame Ex. 1006 ¶ 84.

Pet. 77. We specifically considered Petitioner’s contentions regarding claims 22 and 37, but were not persuaded because of our determination with respect to claim 81. Dec. 22. For example, we were not persuaded that “a POSITA would have retained a portion of Berthon-Jones’s opening 536 as a separate opening to limit or prevent unwanted rotation.” *Id.* at 17. We were also not persuaded “that Berthon-Jones and Barnett teach retaining the upper portion

of opening 536 *as a separate opening* to limit or prevent unwanted rotation. *Id.* at 18. Instead, we were preliminary persuaded by Petitioner’s alternative argument that *opening 526* of Berthon-Jones satisfied this claim element. *Id.* at 19. As such, Petitioner’s arguments directed to opening 536 of Berthon-Jones in the context of claims 22 and 37 are not convincing because they only address Petitioner’s primary argument, that we found unpersuasive, and not Petitioner’s alternative argument which relies on opening 526.

Upon review of Petitioner’s arguments made in the request for rehearing, we are not persuaded that we erred in not instituting trial as to claims 22 and 37.

B. That the Board Overlooked Evidence

Petitioner argues that we overlooked its evidence that adding a “bracket or frame structure” was a known modification with predictable results.” Req. Reh’g. 5–9. Primarily, our determination that we were “not persuaded that a ‘bracket or frame structure’ would have been a predictable option for incorporating Barnett’s collar 34 into Berthon-Jones’s mask.” *Id.* at 5 (citing Dec. 18). By way of example and citing the testimony of Mr. Eaton, we stated by that “adding a ‘bracket or frame structure’ would have been just ‘[a]nother possible solution.’” Dec. 18.

Petitioner notes that it proposed modifying Berthon-Jones’ frame by “(1) fill[ing] in the lower part of opening 536; and (2) add[ing] a bracket or frame structure to the lower part of opening 536.” *Id.* at 7 (citing Ex. 1006 ¶ 72). In Petitioner’s view, it provided substantial evidence to support its position “that a POSITA would have known that adding a bracket or frame structure was one of only a few options for the modification.” *Id.* (citing Pet. 42–45; Ex. 1006 ¶¶ 72–76). Specifically, Petitioner directs our attention

to the testimony of Mr. Eaton. *Id.* at 7–9 (citing Ex. 1006 ¶¶ 52, 53, 72).

Petitioner contends that we misunderstood the testimony of Mr. Eaton that “[a]nother possible solution would be to add a bracket or frame structure to the lower part of the opening 536.” *Id.* at 9 (citing Ex. 1006 ¶ 72).

According to Petitioner, “Mr. Eaton did not suggest that this is ‘just’ another option among numerous possible options.” *Id.* (comparing Dec.18 with Ex. 1006 ¶ 72). Petitioner maintains “Mr. Eaton presented two very similar options and there is no evidence suggesting that there would have been numerous options.” *Id.*

We did not misunderstand the testimony of Mr. Eaton. Indeed, we considered Mr. Eaton’s testimony, but were more persuaded by Patent Owner’ argument that “Petitioner has failed to show that the collar structure of Barnett would have prompted a POSITA to include such a ‘bracket or frame structure’ covering only the lower portion of mask chassis 512.” Dec. 18 (citing Paper 7, 20).

Thus, we did not misapprehend or overlook Petitioner’s arguments and evidence; instead, we considered Petitioner’s arguments and evidence but found them insufficient.

C. That Patent Owner “misdirected the Board from substantial evidence”

Petitioner also challenges our conclusion that we were “not persuaded that Berthon-Jones and Barnett teach retaining the upper portion of opening 536 *as a separate opening* to limit or prevent unwanted rotation.” Req. Reh’g. 9–10 (citing Dec. 18). Petitioner contends that we were misled by Patent Owner’s argument that “Petitioner fails to explain why a POSITA would retain any part of opening 536 to prevent unwanted relative rotation, considering that Berthon-Jones already discloses separate

connecting members 524 that could secure the frame 518 to the mask chassis 512 without the need for elongate members.” *Id.* at 10 (citing Paper 7, 29–30). Petitioner further argues that we were misled by Patent Owner’s argument concerning the ability of Berthon-Jones’ connectors 542 alone to prevent rotation. *Id.* at 13–15.

Contrary to Petitioner’s view, we did not overlook or misapprehend any arguments or evidence. Instead, after careful consideration of all the arguments and evidence of record at the time, we were more persuaded by Patent Owner’s position. That Petitioner disagrees with our conclusion, does not persuade us that this conclusion was incorrect or that we misapprehended or overlooked anything in reaching it.

III. CONCLUSION

Having not been shown where we misapprehended or overlooked a matter, or otherwise abused our discretion, we conclude that Petitioner is not entitled to the relief it seeks.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the request for rehearing is DENIED.

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