From:	Director_PTABDecision_Review
To:	Price, Jeffrey H.; Director_PTABDecision_Review
Cc:	Miller, Tiffany; Sikorski, Ed; Hannah, James; Fuller, Jenna; Eng, Jeffrey; Heintz, James M.; SV Docketing
Subject:	RE: [EXTERNAL] RE: IPR2023-00565 (ResMed Corp. v. Cleveland Medical Devices, Inc.) - Petitioner"s Request for Rehearing by the Director
Date:	Thursday, November 16, 2023 4:40:10 PM

Counsel,

Your email provides argument that has not been authorized by the Director. *See* Revised Interim Director Review Process, available at https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process, Section 3.E ("Unless authorized by the Director, no response to the Director Review request is permitted."), 5.A.ii.b ("Director Review decisions are generally made based on the existing record, without the need for responsive or amici curiae briefing. Responsive or amici curiae briefing may only be submitted if requested by the Director.").

Your email is improper and will not be considered. Your email, and this notification that it is improper, will be entered into the public record. *See id.* at Section 3.G ("All communications will be entered into the record of the proceeding."). Counsel is cautioned against any further unauthorized communication.

Thank you.

From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Wednesday, November 8, 2023 8:01 PM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Miller, Tiffany <tiffany.miller@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@us.dlapiper.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Eng, Jeffrey <JEng@KRAMERLEVIN.com>; Heintz, James M. <Jim.Heintz@us.dlapiper.com>; SV Docketing <svdocketing@KRAMERLEVIN.com>
Subject: Re: [EXTERNAL] RE: IPR2023-00565 (ResMed Corp. v. Cleveland Medical Devices, Inc.) - Petitioner's Request for Rehearing by the Director

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Director Vidal,

The district court's on-time release of this Markman Order confirms that the median time to trial in the district court is not a good proxy for estimating the projected trial date in all situations and supports the panel's reliance on the number of cases before the judge, as recommended in your June 21, 2022, Fintiv Memorandum. As expected, the district court case is at an advanced stage, with claim construction and fact discovery finished and expert discovery closing by early February. The projected time to trial factor remains strongly weighted toward discretionary denial.

The district court's Markman Order also does not retroactively cure the significant issues raised in the Institution Decision or affect the Board's compelling merits analysis. The Board faulted Petitioner for avoiding a means-plus-function claim construction issue that it was obligated to address in the Petition, given that it argued that the elements should be construed as means-plus-function limitations in the district court. The failure to raise and brief foreseeably dispositive claim construction issues in the Petition puts the onus on the Board to resolve such issues without the considered input of the party invoking the Board's jurisdiction. Petitions that hide the ball like this should not be found to present compelling merits.

The Markman Order also does not mitigate the potential for inconsistent decisions. The Board is not obligated to adopt the court's construction or reach the same conclusions under the same construction, and Petitioner refused to file a Sotera Stipulation to proactively address these foreseeable problems. The challenged patent is only one of eight patents at issue in the district court case, and overlapping issues between challenged and unchallenged patents means that the the potential for inconsistent decisions in the parallel proceedings remains. As a matter of efficiency and fairness, the district court is in the best position to dispose of the parties' disputes.

Best regards,
Jeff Price
Counsel for Patent Owner

Jeffrey H. Price
Special Counsel

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> On Nov 8, 2023, at 6:56 AM, Heintz, James M. <Jim.Heintz@us.dlapiper.com> wrote:
>
> Dear Director Vidal,
>
> Further to the email below, Petitioner hereby gives notice of the District Court's claim construction opinion, copy attached. The opinion addresses two of the three "processor" terms that were at issue in the institution decision and this request for your review. The third means-plus-function term was not addressed in the claim construction opinion by agreement of the parties due to a limit on the number of claim terms set by the District Court, and neither party reserved the right to raise the term again later for construction. As seen at pages 20-23, the District Court has determined that the two "processor" terms are not subject to means-plus-function construction.

Petitioner respectfully submits that this determination mitigates the Board's concerns about inconsistent rulings on the applicability of means-plus-function construction and also impacts the compelling merits analysis.

Respectfully submitted,

/s/ James M. Heintz

Attorney for Petitioner ResMed Corp.

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From: Heintz, James M.
Sent: Friday, October 20, 2023 6:25 PM
To: Director_PTABDecision_Review@uspto.gov
Cc: Miller, Tiffany <tiffany.miller@us.dlapiper.com>; Sikorski, Ed <Ed.Sikorski@us.dlapiper.com>; Hannah, James <jhannah@kramerlevin.com>; Price, Jeffrey H. <jprice@kramerlevin.com>; Fuller, Jenna <jfuller@kramerlevin.com>; jeng@kramerlevin.com; svdocketing@kramerlevin.com
Subject: IPR2023-00565 (ResMed Corp. v. Cleveland Medical Devices, Inc.) - Petitioner's Request for Rehearing by the Director

Dear Director Vidal,

Petitioner ResMed Corp. respectfully notifies the parties and the USPTO of its filing of the attached Request for Rehearing by the Director ("Request"), Paper 14, filed pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process adopted on July 24, 2023, of the decision by the Board denying institution (Paper 13) in IPR2023-00565.

The Request presents the following issues, listed in order of priority, for which Petitioner seeks review:

1. Whether the Board abused its discretion by relying in its institution decision on new argument and evidence regarding a district court judge's caseload and

anticipated time-to-trial that was presented for the first time in Patent Owner's Preliminary Sur-Reply in violation of a prior Board order and after denying Petitioner's request to address those new arguments and evidence; and

2. The important policy issue of whether an IPR petition should be denied because it adopts the same plain meaning construction of claim terms asserted by patent owner if the petitioner asserts in a parallel district court litigation an indefiniteness defense for those claim terms that the Board is precluded by statute from resolving

The first issue mirrors in certain respects one of the issues that led to Director's recent order in *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper11 (August 10, 2023), vacating the institution decision in that case. This issue alone is sufficient reason to vacate the institution decision here and is ranked first for that reason. The second policy issue is also important because it is commonly confronted by parties before the Board in the context of means-plus-function limitations and has received inconsistent treatment at the Board, which has led to confusion on the part of practitioners and parties.

Respectfully submitted,

/s/ James M. Heintz

Attorney for Petitioner ResMed Corp.

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<MEMORANDUM OPINION re claim construction. Signed by Judge Gregory B. Williams on 103023. (ntl).pdf>