

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.
Petitioner

v.

CLEVELAND MEDICAL DEVICES, INC.
Patent Owner

Case IPR2023-00565
U.S. Patent No. 10,076,269 B1

PETITIONER'S SUPPLEMENTAL BRIEF

Petitioner submits this Supplemental Brief pursuant to the Director's Order dated November 16, 2023.

I. ARGUMENT

In the parallel district court proceeding between the parties, the court imposed limits on the number of prior art references on which Petitioner could rely in support of its invalidity defense. As a result of those limits, Petitioner no longer asserts in the district court invalidity of the '269 patent based on the challenges in this IPR. In fact, Petitioner no longer relies in the district court litigation on any invalidity theory that could have been raised in this IPR.

As a result of this change in circumstances, and to reduce the Board's burden by eliminating the need to perform a *Fintiv* analysis, Petitioner hereby provides a *Sotera* stipulation: if the Board institutes this IPR, Petitioner will not assert invalidity of the '269 patent in the parallel district court proceeding between the parties based on any ground that was raised or that reasonably could have been raised in this IPR. Providing this stipulation on remand after vacatur of the previous institution decision is proper as found by the Board upon remand of the *Vector Flow* decision vacated by Director Vidal. *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper 15, at 8-9 (P.T.A.B. October 17, 2023). Petitioner respectfully submits that this stipulation disposes of the need for a *Fintiv* analysis because "the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court

litigation” when a petitioner provides such a *Sotera* stipulation. *Id.*; June 21, 2022 “Interim Procedure for Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation” at 7.

II. CONCLUSION

In view of the foregoing, Petitioner respectfully requests institution of this IPR on the grounds specified in the Petition.

Respectfully submitted,

Dated: November 30, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b) on the Patent Owner by **Electronic Mail** of this Petitioner's Supplemental Brief.

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