

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.
Petitioner,

v.

CLEVELAND MEDICAL DEVICES INC.,
Patent Owner.

IPR2023-00565
Patent 10,076,269

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

ORDER
Conduct of proceeding
37 C.F.R. § 42.5

On December 8, 2023, a conference call was held in the above referenced proceeding regarding Patent Owner's request for authorization to file a Motion to Strike Paper 18 and to file a Motion for Sanctions under 37 C.F.R. § 42.12(a)(2)–(4), (6), (7). *See* Ex. 3005, 2–3. Present on the conference call were counsel for the parties, Administrative Patent Judges Jenks, Snedden, and Hardman, and a court reporter. Patent Owner agreed to file the transcript of the conference call as an exhibit.

Patent Owner contends that Petitioner's supplemental brief (Paper 18) exceeds the scope of the Director's order vacating the Decision on Institution (Paper 13) and remanding the case to the Board for reevaluation in light of all pre-institution papers including the supplemental briefings (Paper 15, 6¹).

Petitioner in their supplemental brief provided a *Sotera* stipulation² arguing that the introduction of the stipulation at this time is proper and “disposes of the need for a *Fintiv* analysis” by the panel. Paper 18, 1 (citing *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper 15, at 8–9 (PTAB Oct. 17, 2023)). Although we agree with Patent Owner that on its face Petitioner's supplemental brief exceeds the scope of the Director's order, it does address the underlying issue addressed in that order, which is

¹ The Director's order authorized Petitioner to file a supplemental brief and Patent Owner to file a response. Paper 15, 6. The order stipulated that “[t]he parties [in their briefs] are permitted to discuss publicly available statistics, but no new evidence is otherwise permitted.” *Id.*

² *See* USPTO Memorandum, Interim Procedure for Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation, 3 (June 21, 2022), available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

the *Fintiv* analysis in our now-vacated Decision on Institution. Because Petitioner's *Sotera* stipulation simplifies the issues for the Board going forward, we deny Patent Owner's request to file a Motion to Strike Paper 18.

During the conference call, Patent Owner asserted insufficiency in the scope of Petitioner's *Sotera* stipulation. *See also* Ex. 3005, 3. Patent Owner requested, that it be authorized to address Petitioner's stipulation in the response brief it files pursuant to the Director's order. Patent Owner also requested an increase in the page limit for its response brief so that it can address Petitioner's stipulation. Patent Owner also requested authorization to file Petitioner's final invalidity contentions from the co-pending litigation as an exhibit to its brief.

As discussed in the conference call, we determine that it would be most efficient for Patent Owner to file, as exhibits, the *Markman* order³ and the expert report of December 4th from the co-pending district court litigation. Therefore, Patent Owner is authorized to file as exhibits Petitioner's final invalidity contentions, the *Markman* order, and the expert report of December 4th from the co-pending district court litigation.

At this time, our focus is to complete all pre-institution briefing so that the Board may proceed with its work of issuing a Decision on Institution. Having considered the parties' arguments, we deny without prejudice Patent Owner's request for authorization to file a motion for sanctions against Petitioner at this juncture of the proceeding.

³ In our order issued November 29, 2023 (Paper 17), we authorized the filing of the *Markman* order from the co-pending litigation but stipulated that the paper be filed after the Director's ordered supplemental briefing was complete. The present order replaces our order of November 29, 2023.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request to file a Motion to Strike Paper 18 *is denied*;

FURTHER ORDERED that Patent Owner is authorized to file a supplemental response not to exceed 7 pages by December 29, 2023;

FURTHER ORDERED that Petitioner is authorized to file a response not to exceed 5 pages by January 12, 2024;

FURTHER ORDERED that Patent Owner is authorized to file as exhibits Petitioner's final invalidity contentions, the *Markman* order, and the expert report of December 4th from the co-pending district court litigation;

FURTHER ORDERED that Patent Owner may file the above referenced exhibits at any time but no later than December 29, 2023;

FURTHER ORDERED that Petitioner is not authorized to file any additional evidence with its response;

and FURTHER ORDERED that Patent Owner's request to file a Motion for Sanctions against Petitioner is *denied without prejudice*.

IPR2023-00565
Patent 10,076,269

FOR PETITIONER:

Tiffany Miller
Edward H. Sikorski
James M. Heintz
DLA Piper LLP
Tiffany.Miller@us.dlapiper.com
Ed.Sikorski@us.dlapiper.com
James.Heintz@us.dlapiper.com

FOR PATENT OWNER:

James Hannah
Jeffrey H. Price
Jenna Fuller
Jeffery Eng
KRAMER LVIN NAFTALIS & FRANKEL, LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com
jfuller@kramerlevin.com
jeng@kramerlevin.com