

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 _____
3 BEFORE THE PATENT TRIAL AND APPEAL BOARD
4 _____
5 RESMED CORP.
6 PETITIONER,
7 V.
8 CLEVELAND MEDICAL DEVICES, INC.,
9 PATENT OWNER,
10 _____
11 IPR2023-00565
12 PATENT 10,076,269
13
14 TELEPHONIC CONFERENCE HEARING BEFORE
15 ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, AND
16 CYNTHIA M. HARDMAN, ADMINISTRATIVE PATENT
17 JUDGES, taken before Cynthia Craig, Registered
18 Professional Reporter and General Notary Public
19 within and for the State of Nebraska, beginning
20 at 1:04 p.m., on December 8, 2023.
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1 A P P E A R A N C E S

2

ADMINISTRATIVE PATENT JUDGES:

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4 SHERIDAN K. SNEDDEN
5 CYNTHIA M. HARDMAN

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1 (Whereupon, the following proceedings were
2 had, to-wit:)

3 JUDGE JENKS: We are on the
4 record as of now.

5 So, again, let me start again,
6 that we understand Patent Owner is perhaps a
7 little frustrated because Petitioner brought in
8 papers that didn't follow the director's order
9 as -- to the T.

10 So as a panel behind the scenes,
11 we've already discussed a little bit as to
12 what's -- what we could do going forward. In
13 the e-mail, Patent Owner requested a motion to
14 strike the particular paper that the Petitioner
15 filed.

16 And we discussed that -- that
17 what's gonna happen is as we grant the motion to
18 strike, then Petitioner is going to request
19 permission to file the Sotera Stipulation, which
20 we will most likely then grant.

21 So this is going to be more
22 papers and, of course, Patent Owner is then
23 going to respond that perhaps they feel that the
24 stipulation is too late.

25 So that is one option. Again, we

1 feel that that's possibly a lot more briefing
2 than we need to have.

3 Option 2 is that we accept
4 Petitioner's paper even though they didn't ask
5 for permission to file the stipulation, and, in
6 essence, ignore the director's order in
7 providing us the information the director said
8 we should have.

9 And that's pretty much -- and
10 then that would pretty much follow what
11 Vector Flow did in their Paper 15, which was at
12 issue in the request for director of the
13 hearing.

14 And then, of course, now
15 Patent Owner is in the process where he's
16 looking to respond to the paper filed by
17 Petitioner, and as far as we're concerned, or as
18 I say, as far as we're concerned, accepting the
19 Sotera Stipulation at this time would certainly
20 streamline for us the process.

21 And, you know, Patent Owner still
22 can respond to the paper that was filed, but for
23 the part of whether or not we're going to accept
24 the stipulation, like I said, we have various
25 options that we could follow, but at the end, we

1 believe as a panel that the Sotera Stipulation
2 would come in because it certainly streamlines
3 the process for us because we are now -- the
4 decision has -- our prior decision has been
5 vacated and we now have to address the merits of
6 the petition to begin with.

7 So I know Patent Owner requested
8 this conference call. I would like Patent Owner
9 to now speak as to what it is that they wish
10 from us.

11 MR. PRICE: Thank you,
12 Your Honor, and I truly appreciate the time that
13 the panel went to -- to redeem all of the likely
14 ramifications of these requests because I think
15 you're spot on in terms of, you know, the
16 additional papers, you know, adding to a record
17 that has already been -- you know, Patent Owner
18 and I would say, there's already been much more
19 briefing on this than there should have been
20 that has, you know, unduly increased the cost
21 and complexity of these proceedings.

22 What I would ask, Your Honors, is
23 to consider whether the Vector -- the
24 institution decision in Vector Flow, which
25 accepted the Sotera Stipulation after our vacate

1 and remand, but, of course, being the Vector
2 Flow case, the scope of the remand was much more
3 than it was in this case.

4 And the director's opinion --
5 precedential opinion in NXP, the MPING
6 (phonetic), which I understand as the panel
7 mentioned in Vector Flow remand decision, does
8 not compel the decision that the board reached
9 in that -- in that non-precedential decision,
10 which, you know, obviously because the -- that
11 case was denied institution on other grounds,
12 that there was no further question about whether
13 or not that process was -- was within the
14 director's guidance in NXP.

15 I mean, you know, we think that
16 it's not N- -- you know, we think that it's not
17 in NXP, we thought we -- it's certainly not
18 valid in this case.

19 You know, the gamesmanship issues
20 that the director was concerned about in NXP are
21 here in the states, and so that I think if we
22 have Your -- Your Honors' permission because
23 we -- we'll address that in our reply to what
24 Petitioner filed because, you know, it seems
25 like they're not contesting the time to trial

1 statistics anymore or any of the other Fintiv
2 issues.

3 So, you know, I think what we're
4 really concerned about is, you know, we don't
5 think that the Sotera Stipulation is timely, we
6 don't think that it actually reduces the
7 possibility for inconsistent decisions, and the
8 final invalidity contentions that Petitioner
9 filed, which they claim excludes any ground that
10 could have been raised in the IPR actually
11 incorporates their IPR grounds.

12 So, you know, all of those --
13 those facts I think are -- are mitigating
14 circumstances that, you know, we really don't
15 think that the Sotera Stipulation is proper at
16 this time and is not actually -- would resolve
17 the issues for -- for the -- for the board.

18 And so, you know, we would
19 request the motion to strike. We -- I
20 understand, Your Honors, you know, don't want
21 to, you know, have a, you know, full round of
22 briefing, with a motion, a response and a reply,
23 but, you know, we're both -- both the rules on
24 motion to strike and the 42.12(a) both we
25 believe make Petitioner's filing improper and

1 should not be part of the record.

2 JUDGE JENKS: All right. So
3 that's for your Issue 1, and then your
4 Issue 2 -- let me just double-check. Your
5 second issue was requesting a motion for
6 sanctions.

7 MR. PRICE: Yes, Your Honor, and
8 so the motions for sanctions has to deal with a
9 false statement without what the Petitioner did
10 that in their final invalidity contentions that
11 they represented to the board, and that it was a
12 plain misrepresentation of facts.

13 Of course you don't have that
14 petition before you because the -- the -- we are
15 not available at this time to file any new
16 exhibits.

17 And, like I said, you know, we
18 don't want to multiply the briefing anymore than
19 is necessary to resolve the issues, but we do
20 believe this was a false statement in terms of
21 what they already -- RESMED already did in the
22 district court.

23 And then the last thing is the
24 opportunity to brief issues regarding dilatory
25 tactics, abuse of process and causing

1 unnecessary delay, and all of that is wrapped up
2 in the interplay between this case and the
3 district court, and the Petitioner's, you know,
4 unwillingness to file a stipulation until after
5 the decision was already reached to deny it
6 based on Fintiv, and then coming in with the
7 paper, which misrepresented their actions in the
8 district court.

9 So those are the bases for the
10 request for authorization to file a motion for
11 sanctions.

12 And, you know, and, of course,
13 you know, our issue on the motion to strike, you
14 know, failure to comply with the board's order,
15 which we don't believe they did, is also grounds
16 for sanction under 42.12(a)(1).

17 JUDGE JENKS: All right. Let me
18 hear from Petitioner at this point in time.

19 MR. HEINTZ: Thank you,
20 Your Honor. This is James Heintz again on
21 behalf of Petitioner.

22 I am doing my best, Your Honor,
23 to keep my temper in check after this -- these
24 allegations of abuse of process and
25 misrepresentations that are being thrown around

1 by counsel, not only today on this call, but
2 also on an e-mail for which they did not consult
3 with us prior to sending to the board, and an
4 e-mail that contained arguments, which is
5 contrary to the board's proceedings of which
6 they have done repeatedly.

7 So let me start with the
8 misrepresentation. Counsel is telling you that
9 we've misrepresented what has gone on in the
10 district court. Nothing, Your Honor, could be
11 further from the truth.

12 On November 20th, we filed final
13 invalidity contentions in the district court.
14 In their e-mail, counselor blamed us for not
15 submitting this to the court, knowing full
16 well -- I'm sorry, to the board, knowing full
17 well that we were not allowed to submit new
18 evidence under the director's order.

19 I will represent to you that if
20 you look at the final invalidity contentions,
21 what you will see is that the parties in the
22 district court were required by the district
23 court to limit their obviousness and
24 anticipation defenses, the only things that can
25 be raised in an IPR, to six references.

1 And if you look at the invalidity
2 contentions, which were served on November 20th,
3 you will see there are six references there,
4 none of which are the primary references
5 identified in the petition in this proceeding.

6 So it is absolutely true that in
7 the final invalidity contentions, we have
8 limited ourselves to challenges to the -- to the
9 269 patent at issue in this IPR on grounds that
10 were not raised in the petition and could not
11 have been raised in the petition because they
12 were all challenges involving system prior art.

13 So this allegation, again thrown
14 around by opposing counsel, is absolutely false.
15 If the board would like, we'd be happy to submit
16 the file invalidity contentions.

17 I will also represent to the
18 board that on December 4th, again which is prior
19 to the date on which counsel threw out their
20 e-mail with these allegations of
21 misrepresentations, the parties -- sorry, we,
22 the Petitioner, served an expert report on
23 counsel, and that expert report again makes
24 perfectly clear that the invalidity and
25 obviousness grounds, the anticipation and

1 obviousness challenges to the patent in the
2 district court has nothing to do -- is not in
3 any way the same grounds that are in the IPR.

4 They're just not. They're based
5 on system prior art, and none of the prior art
6 references are even identified in the six
7 references that the court limited us to.

8 And, Your Honor, you can see the
9 limitations to those six references in
10 Exhibit 2001, which is in evidence in this
11 proceeding. If you look on Page 3, you will see
12 the Court unambiguously limits us to no more
13 than six references to challenge anticipation or
14 obviousness.

15 So --

16 JUDGE JENKS: Okay.

17 MR. HEINTZ: -- yeah, this idea
18 that we are somehow misrepresenting them, and
19 these statements that have been thrown out by
20 counsel are just completely false. False stuff.

21 Now, the board has already
22 indicated I believe that they're -- they're
23 going to accept a Sotera Stipulation if not in
24 the paper we filed, then in another paper.

25 I think the board has hit it

1 exactly correct, that having us submit another
2 piece of paper with a Sotera Stipulation is just
3 a waste of this Court's time, this board's time
4 and the waste of the parties' time.

5 This idea that what's going on
6 here is gamesmanship is really incredible to me
7 based on everything I've heard so far. You
8 know, I will note again for the record that it
9 is the Patent owner's counsel who cited new
10 evidence in the reply that led to this whole
11 situation that never should have happened, that
12 citation to the time to trial evidence when in
13 the surreply after the board's orders that no
14 new order evidence was to be -- to be included
15 in the surreply.

16 You know, if there's anybody to
17 blame for what's gone on here, it is not us. It
18 is not the Petitioner. It is counsel for
19 Patent Owner.

20 So I am just really incensed at
21 this idea, this -- not this idea, this statement
22 that we are making false statements before the
23 board.

24 So that's our position,
25 Your Honor. The idea that anything about a

1 Sotera Stipulation, that somehow we're unduly
2 multiplying the proceedings by reducing the
3 things the board needs to consider, is just
4 absurd.

5 With that, Your Honor, I will
6 stop, but I'll ask if there's anything that I
7 failed to address, that the board may want to
8 hear from, I'll be happy to do so.

9 JUDGE JENKS: Okay. Thank you so
10 much.

11 Patent Owner, do you have
12 anything in response to this?

13 MR. PRICE: Yeah, I do, and I'm
14 frankly shocked because what I'm going to do
15 right now is read from their invalidity
16 contentions.

17 RESMED also incorporates by
18 reference all grounds of invalidity identified
19 in any present or future reexamination,
20 inter partes review, covered business method,
21 patent review or other post issuance review by
22 the patent and trademark office of the asserted
23 patents.

24 Your Honors, I read that word for
25 word from the invalidity contentions that they

1 say did not include the grounds for inter partes
2 review. I'm shocked. I'm appalled. This is --
3 it's incredible to me that this is -- that these
4 representations are flying back and forth.

5 It's just -- it's a blatant
6 misrepresentation of the record, and, you know,
7 I was frustrated when I saw what they did in
8 their -- their paper on remand, this is -- this
9 is beyond the path.

10 JUDGE JENKS: All right. Thank
11 you so much at this point in time.

12 Let me confer with my panel
13 really quick, and then I will get back to you.

14 MR. PRICE: Thank you.

15 (12:21 p.m. - Off the
16 record.)

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1 (At 12:28 p.m., with parties present
2 as before, the following proceedings were had,
3 to-wit:)

4 JUDGE JENKS: I'm back. I have
5 conferred with my panel, and hopefully we can
6 come up with something that's gonna work for all
7 of us.

8 So the idea here is that rather
9 than we're going to, in essence, deny the motion
10 to strike. We'd prefer -- we -- we'd prefer
11 that Patent Owner responds to the papers that
12 were just filed.

13 Obviously they're going to
14 respond not as set out by the director, but
15 however they feel necessary to respond.

16 And it sounds like in order to
17 make their response, we also need to have some
18 more information in the file, so we will also
19 allow you to file exhibits.

20 So let me just see what we have.
21 We originally already said in our other order
22 that the Markman Order will come in.

23 I'm sorry. I hope everybody can
24 hear me.

25 MR. HEINTZ: We can hear you,

1 Your Honor.

2 MR. PRICE: We can.

3 JUDGE JENKS: Sorry, as I'm
4 babbling on here.

5 So we have the exhibits for the
6 Markman Order that we already allowed last time.
7 You have -- what was the other order? Oh, let's
8 see, you had the papers, 1120, that were filed
9 with the district court. Are those the
10 contentions that wanted --

11 MR. PRICE: Yes.

12 JUDGE JENKS: -- somebody wanted
13 to file?

14 MR. PRICE: Yes, those are the
15 final invalidity contentions.

16 JUDGE JENKS: Was there one other
17 paper that you wanted filed, some -- either of
18 the parties wanted filed?

19 MR. HEINTZ: Your Honor, this is
20 James Heintz.

21 We also mentioned the expert
22 report on invalidity served on December 4th.

23 JUDGE JENKS: December 4th, okay.

24 So those are some -- the Markman
25 Order, the invalidity contentions, the final

1 invalidity contention and the expert report.

2 Is there any other paper that one
3 of the parties wanted filed at this point in
4 time?

5 MR. PRICE: I'm not aware of any,
6 Your Honor.

7 JUDGE JENKS: And Patent Owner,
8 is -- are those -- will those papers be
9 sufficient for you to provide us with a response
10 that will satisfy --

11 MR. PRICE: I mean, I think the
12 only issue that we may have is that the order
13 limited us to two pages, and while that was
14 certainly sufficient to deal with the issue that
15 was allowed, I would ask for not much more,
16 maybe five to seven pages, for this paper since
17 there are other issues -- obviously other issues
18 to address.

19 JUDGE JENKS: All right. So how
20 about if we give you seven pages, and then I'm
21 sure Petitioner is going to want to file a
22 response, and we'll give them five pages in
23 their response to your seven pages since they
24 already have two pages in the original one. Is
25 that --

1 MR. HEINTZ: That sounds fair,
2 Your Honor.

3 MR. PRICE: Yes, Your Honor.

4 JUDGE JENKS: So -- okay, great.
5 So we're doing this in lieu of us going through
6 the motion to strike, which I'm hoping is going
7 to speed up the process so we can get all the
8 papers in, which would then allow us to start
9 making our -- you know, starting our -- you
10 know, decision -- the -- making the decision to
11 institute because we're starting from scratch
12 again.

13 And, Patent Owner, do you need
14 extra time because Petitioner filed their papers
15 on November 20 -- November 30th? Would you like
16 two weeks from today to file --

17 MR. PRICE: Yes, two weeks from
18 today would be perfect.

19 JUDGE JENKS: And will you also
20 file the Markman Order, the invalidity
21 contentions and the expert report?

22 MR. PRICE: Sure, we'll do all of
23 that, along with the transcript from this call.

24 JUDGE JENKS: Yes, great. So
25 then -- so that's Issue 1, set aside is -- are

1 the parties okay with this -- with our process
2 going forward?

3 MR. HEINTZ: Your Honor, this is
4 counsel for Petitioner, James Heintz.

5 I just want to make sure I
6 understand exactly what topics are allowed in
7 these -- these two briefings you just discussed.

8 JUDGE JENKS: Well, as you see,
9 you didn't follow the director's order, which
10 is, you know -- and -- but you provided us with
11 the Sotera Stipulation, which again makes our
12 life easier. And as we -- as I explained
13 earlier, it would come in at some point in time.

14 So at this point in time,
15 obviously Patent Owner wants -- is saying that
16 this -- your -- I -- they have -- they have --
17 let's just say they have issues with the Sotera
18 Stipulation, and when you're -- at the point in
19 time you're bringing it in, and they're briefing
20 that.

21 I'm sure you're going to want to
22 respond to it. That's why, you know, we're
23 getting a total of seven papers for all of the
24 response after the director vacated our prior --
25 prior decision.

1 Because of the way I'm looking at
2 this, we're at -- as a -- we've never had a
3 decision to institute in this case. So you can
4 respond to whatever -- whatever Patent Owner is
5 putting into their brief, in their --

6 MR. HEINTZ: Thank you,
7 Your Honor.

8 JUDGE JENKS: Uh-huh.

9 MR. HEINTZ: Okay.

10 JUDGE JENKS: That gets us to
11 Issue 1.

12 Issue 2 is the request to file
13 motions for sanctions, and my suggestion on this
14 one would be is we're not going to authorize you
15 to file a motion for sanctions at this -- at
16 this juncture, but you can come back and request
17 it once all these papers have been filed.

18 We're hoping that possibly once
19 all the filing is complete, maybe you will
20 rethink -- Patent Owner will rethink filing
21 extra papers, which, you know, is going to
22 increase the cost for your client as well.

23 So we're saying that once all the
24 briefing is complete, which allows us to move
25 forward with our decision to institute, if you

1 feel -- still feel that you want to file motions
2 for sanctions, we would be amenable to talk
3 about drafting at that point in time, but at
4 this point we would prefer to be moved to a
5 later date.

6 Is that acceptable to --

7 MR. PRICE: Yes, Your Honor.

8 MR. HEINTZ: Your Honor, for --

9 JUDGE JENKS: Sure, uh-huh.

10 MR. HEINTZ: Your Honor, for
11 Petitioner again, Jim Heintz, I assume that at
12 the same time that this briefing is complete,
13 the board will also consider a motion on our
14 behalf for sanctions on opposing counsel for
15 what are these blatant misrepresentations I've
16 heard today; is that true?

17 JUDGE JENKS: I sincerely hope
18 that we can -- we can all take it down, cool
19 down a little bit, and that we can avoid filing
20 motions for sanctions just to begin with because
21 I don't think -- I don't see anything in the
22 papers at this point in time that causes me --
23 you know, where I would say, oh, my God, you
24 need to file -- file this.

25 So that's -- at this point in

1 time, I'm hoping we can all cool down. Let's
2 just get the papers in so we can do our job,
3 which is to look at the petition and make the
4 decision on the merits of the petition going
5 forward.

6 And I will -- but we didn't get
7 to the point of to do -- will you require extra
8 time? Should we set the times for -- what is
9 today? Let me look at my calendar.

10 I'm going to issue an order on
11 this to be -- to be clear here. I'm looking for
12 my calendar. When I need it, I can't find it.

13 So today's the 8th. If we have
14 Patent Owner file their papers by the 22nd --

15 MR. PRICE: Okay.

16 JUDGE JENKS: And I'm going to
17 say -- in my order, I'm going to say that these
18 papers are in lieu of the papers, in response to
19 the director order, to the intervening Sotera
20 Stipulation.

21 So 22nd, and then we give
22 Patent -- Petitioner two weeks to respond. That
23 would bring it to January 5th. I hope that's
24 not going to interfere with anybody's --

25 MR. HEINTZ: It will, Your Honor,

1 quite frankly. What we're talking about is if
2 we get this on the Friday before, I'll be
3 traveling, I can tell you --

4 JUDGE JENKS: Okay.

5 MR. HEINTZ: -- for Christmas,
6 right? You -- we're stuck here with the week
7 between Christmas and New Year's, which doesn't
8 give us a lot of time.

9 JUDGE JENKS: All right. So
10 how -- how --

11 MR. PRICE: Yeah, Patent Owner --
12 I just want to be clear, Patent Owner doesn't
13 have a problem with pushing that date out a
14 little bit further due to the holiday. It's not
15 an issue.

16 JUDGE JENKS: Well, and we're
17 still going to be much quicker than if we do
18 this via motion to strike and going forward.

19 So how about the 29th of --
20 Patent Owner -- or not -- yeah, Patent Owner,
21 you get me the papers by the 29th, and then we
22 give -- do you want to two weeks or three weeks,
23 Petitioner, after that?

24 MR. HEINTZ: Two weeks is fine if
25 you give us to the -- I think that put us at the

1 12th of January, that should be fine for us.

2 JUDGE JENKS: 12th of January,
3 okay, great. We'll go with that, 12th of
4 January. I'm just writing my notes here.

5 All right. Is there anything
6 else we need to discuss today?

7 MR. HEINTZ: Yes, Your Honor,
8 this is Jim Heintz again for Petitioner.

9 I'd like guidance from the panel
10 as to what information is acceptable in an
11 e-mail to the board and what is not.

12 It has been my understanding that
13 e-mails to the board requesting conference calls
14 are supposed to have short, generalized
15 statements about what the subject matter is.

16 As you can tell, I'm very
17 frustrated because I've seen my -- my colleagues
18 over here state in e-mails that we have
19 misrepresented things, and the board is now
20 putting those e-mails into the public record.

21 I understand the board does not
22 believe this -- this -- that sanctions are in
23 order here based on what they've seen so far,
24 but nonetheless, this is now in the public
25 record.

1 So I'd like some guidance from
2 you, Your Honor, as to what is going to be
3 acceptable in e-mails going forward so I know
4 how to proceed in this case.

5 JUDGE JENKS: I would prefer --

6 MR. PRICE: And if -- if I could
7 just respond very, very briefly, Your Honor.

8 It was always Patent Owner's
9 impression from -- we've handled hundreds of
10 cases and had hundreds of e-mails to the board
11 that Your Honors needs to just know enough facts
12 to understand what the issue is, and that's all
13 we represented in this paper.

14 We didn't make obviously all of
15 the arguments that we would have made if our
16 request to file these papers were granted.

17 JUDGE JENKS: Uh-huh. Just as a
18 general thing, general -- just general request
19 was great, but we do need enough for us to
20 prepare. How's that, Mr. Heintz?

21 MR. HEINTZ: Okay. Your Honor, I
22 will proceed along those lines in the future.

23 JUDGE JENKS: I think our
24 conference call is now adjourned. Thank you so
25 much.

1 (Court reporter asked
2 counsel if they wanted a
copy of this transcript.)

3 MR. PRICE: Yes.

4 MR. HEINTZ: Cindy, this is
5 Jim Heintz. I do not. I'll just wait for
6 Patent Owner to file.

7 (1:42 p.m. - Adjournment.)

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1 C E R T I F I C A T E

2 STATE OF NEBRASKA)
3 COUNTY OF DOUGLAS) ss.
4

5 I, Cynthia Craig, Registered Professional
6 Reporter and General Notary Public within and
7 for the State of Nebraska, do hereby certify
8 that the foregoing Transcript of Proceeding was
9 taken by me in shorthand and thereafter reduced
10 to typewriting by use of Computer-Aided
11 Transcription, and the preceding twenty-eight
12 (28) pages contain a full, true and correct
13 transcription of said Transcript of Proceeding,
14 to the best of my ability;

15 That I am not a kin or in any way
16 associated with any of the parties to said cause
17 of action, or their counsel, and that I am not
18 interested in the event thereof.

19 IN WITNESS WHEREOF, I hereunto affix my
20 signature and seal the 27th day of December,
21 2023.

22

23

24

CYNTHIA A. CRAIG, RPR
GENERAL NOTARY PUBLIC

25 My Commission Expires: October 8, 2026

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