

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

**PATENT OWNER'S REPLY TO PETITIONER'S
OPPOSITION TO MOTION TO EXCLUDE EVIDENCE**

TABLE OF CONTENTS

	Page(s)
I. INTRODUCTION	1
II. ARGUMENT.....	1
A. Patent Owner’s Objections Were Timely	1
B. Dr. Sharony Does Not Have the Required Experience in Diagnostic Sensors	2
III. CONCLUSION.....	5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Acceleration Bay, LLC, v. Activision Blizzard Inc.</i> , 908 F.3d 765 (Fed. Cir. 2018)	4
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> , 22 F.4th 1369 (Fed. Cir. 2022)	2, 4, 5
<i>Medtronic, Inc. v. Teleflex Life Scis. Ltd.</i> , No. IPR2020-01342, 2022 WL 557277 (P.T.A.B. Feb 23, 2022)	5
<i>SEB S.A. v. Montgomery Ward & Co.</i> , 594 F.3d 1360 (Fed. Cir. 2010)	4
<i>Sundance, Inc. v. DeMonte Fabricating, Inc.</i> , 550 F.3d 1356 (Fed. Cir. 2008)	2, 4
Other Authorities	
37 C.F.R. § 42.64(b)(1).....	2
Fed. R. Evid. 702	1, 2
Nov. 2019 Consolidated Trial Practice Guide	2

I. INTRODUCTION

Patent Owner's Motion to Exclude ("Motion") presents a simple issue: The Federal Rules of Evidence compel the Board to exclude Dr. Sharony's opinions because he lacks the relevant work experience to testify in this case from the point of view of a POSITA. This fact renders his opinions unreliable and inadmissible under F.R.E. Rule 702. Patent Owner timely objected to Dr. Sharony's testimony on this basis. Paper 25 at 1.

Petitioner musters no real response in opposition. Instead, it attempts in a conclusory fashion to convince the Board that his experience with optical sensors is somehow a substitute for experience with diagnostic sensor systems. It ignores the controlling caselaw cited in the Motion while relying on inapposite authority. And its attempts to erase the requirement that a POSITA have experience working in diagnostic sensor systems should raise, rather than allay, concerns over Dr. Sharony's reliability.

II. ARGUMENT

A. Patent Owner's Objections Were Timely

Patent Owner objected to Dr. Sharony's unreliable expert declaration under the Federal Rules of Evidence 702 "because they are conclusory, do not disclose underlying facts or data in support of his opinions, and are **unreliable**." Paper 25 at 1 (emphasis added). Testimony from the point of view of a POSITA is "neither relevant nor **reliable**" when the witness is not a POSITA. *Kyocera Senco Indus.*

Tools Inc. v. Int'l Trade Comm'n, 22 F.4th 1369, 1377 (Fed. Cir. 2022) (emphasis added). Patent Owner timely filed its objections on May 17, 2024, within ten business days of the institution date of May 6, 2024. Paper Nos. 23, 25; Nov. 2019 Consolidated Trial Practice Guide at 78-79; 37 C.F.R. § 42.64(b)(1).

B. Dr. Sharony Does Not Have the Required Experience in Diagnostic Sensors

The parties agree in this proceeding that a POSITA would have “a bachelor’s degree in mechanical engineering, electrical engineering, computer science or an equivalent field and two years of industry experience working with diagnostic sensor systems and networked data systems. An increase in experience could compensate for less education, and vice-versa.” Ex. 1004 (Sharony Decl.), ¶ 70. Dr. Sharony does not meet this standard because he has no experience working with diagnostic sensor systems. *See Sundance, Inc. v. DeMonte Fabricating, Inc.*, 550 F.3d 1356, 1363-64 (Fed. Cir. 2008) (F.R.E. 702 requires that an expert be “qualified in the pertinent art.”). Because Dr. Sharony is not a POSITA, his opinions given from the point of view of a POSITA are *per se* inadmissible. *Kyocera*, 22 F.4th at 1377-78.

Notably, many of Dr. Sharony’s opinions require the stitching together of various distinct disclosures from up to five references *plus* the knowledge of a POSITA, which he does not have. Grounds that seek to combine so many disparate parts as well as the alleged knowledge of a POSITA necessarily require that the expert is, in fact, a POSITA. Petitioner’s arguments that Dr. Sharony meets this

standard, or does not have to meet this standard, fail for at least the following reasons.

First, Petitioner's attempt to transform Dr. Sharony's experience working with optical sensors in bar code readers into experience with diagnostic sensor systems is meritless. See Paper 37 ("Opp.") at 3-4. Just because Dr. Sharony has experience with "sensors [that] could be used as physiological sensors" does not mean that he has experience with diagnostic sensor systems. *Id.* And while Petitioner takes issue with "CleveMed's suggestion that Dr. Sharony only has experience with 'digital imagers (bar code readers) and wireless communication devices,'" (*id.* at 4), CleveMed accurately reported Dr. Sharony's own account of his experience. Ex. 1004 (Sharony Decl.), ¶ 9 ("I have over 35 years of experience working in data networks and mobile and wireless technologies . . ."); *id.*, ¶ 16 ("I worked at Symbol Technologies, conducting research and development in data capture devices such as bar code imagers."). Petitioner does not point to *other* experience that CleveMed overlooked—it merely adds gloss to cover the gap between Dr. Sharony's experience and that of a POSITA.

Second, while Dr. Sharony's "experience with data capture devices" might qualify him to testify about those data capture devices, it does not qualify him to testify about "diagnostic sensor systems for sensing blood oxygen saturation, blood vessels volume, vital signs, human activity, heart rate, and pulse." Opp. at 4. These

are two different areas of expertise, and Dr. Sharony simply does not have “any specialized knowledge, training, or experience” in the latter. *Kyocera*, 22 F.4th at 1377. This means his opinions “are neither relevant nor reliable” and can “serve[] only to cause mischief and confuse the factfinder.” *Id.* (quoting *Sundance, Inc.*, 550 F.3d at 1362).

Petitioner ignores *Kyocera* and *Sundance* in favor of *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360 (Fed. Cir. 2010), which stands for the premise that a witness testimony may be admitted when there is an “adequate relationship between” the witness’ experience and the claimed invention. *Id.* at 1373. Crucially, however, the *SEB* Court expressly distinguished the “unusual situation in *Sundance*,” where the witness purported to testify from the point of view of a POSITA, opined on the level of ordinary skill in the art and lacked the relevant skill. *Id.*; *Sundance, Inc.*, 550 F.3d at 1362 n.4. This case falls squarely within the bounds of *Kyocera* and *Sundance* because Dr. Sharony purports to testify from the point of view of a POSITA while lacking the very experience he argues is necessary.

Third, Petitioner’s next tack is to rewrite the POSITA standard. *Opp.* at 5 (arguing that the claims are directed to “issues that are well within the purview of an electrical engineer with 35+ years of experience in communication technology”). But Petitioner took a different position in its Petition and cannot completely change course now. *Acceleration Bay, LLC, v. Activision Blizzard Inc.*, 908 F.3d 765, 775

(Fed. Cir. 2018) (declining to consider a new argument “that could have been made in the petition”). It is telling that Petitioner sought to water down the POSITA’s level of skill only after recognizing that Dr. Sharony does not qualify as a POSITA under the very standard that he opined was necessary.

Fourth and finally, Dr. Sharony’s education does not make up for his lack of experience with diagnostic sensor systems. Because none of his education is (or is alleged to be) in the field of diagnostic sensor systems, his education has not given him “any specialized knowledge, training, or experience” in such systems. *Kyocera*, 22 F.4th at 1377. Petitioner’s reliance on *Medtronic, Inc. v. Teleflex Life Scis. Ltd.*, No. IPR2020-01342, 2022 WL 557277 (P.T.A.B. Feb 23, 2022) is bizarre (see Opp. at 5) because the experts’ qualifications were not challenged. 2022 WL 557277, at *8 (“As their qualifications are undisputed, we also determine that the parties’ experts are qualified to opine on the issues in this proceeding from the perspective of a person of ordinary skill in the art.”). *Medtronic* is further distinguishable because the parties agreed that “[e]xtensive experience and technical training might **substitute** for education” whereas the agreed definition in this case does not suggest that education could **substitute** for relevant experience. *Id.* at *7-8; Paper 29 at 8.

III. CONCLUSION

Cleveland Medical Devices respectfully requests that the Board exclude Exhibit 1004 and the corresponding citations in Paper 1.

Reply to Petitioner's Opposition to Motion to Exclude Evidence
IPR2023-00565 (U.S. Patent No. 10,076,269)

Dated: January 28, 2025

/James Hannah/

James Hannah (Reg. No. 56,369)
Jenna Fuller (Reg. No. 74,212)
Kramer Levin Naftalis & Frankel LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA 94065
Telephone: (650) 752-1700
Facsimile: (650) 752-1800
jhannah@kramerlevin.com
jfuller@kramerlevin.com

Jeffrey H. Price (Reg. No. 69,141)
Jeffrey Eng (Reg. No. 63,189)
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-7502
Facsimile: (212) 715-8302
jprice@kramerlevin.com
jeng@kramerlevin.com

(Case No. IPR2023-00565)

Attorneys for Patent Owner
Cleveland Medical Devices Inc.

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R § 42.6(e), that
service was made on the Petitioner as detailed below.

<i>Date of service</i>	January 28, 2025
<i>Manner of service</i>	Electronic Mail (tiffany.miller@us.dlapiper.com; ed.sikorski@us.dlapiper.com; jim.heintz@us.dlapiper.com; DLA-ResMed-CleveMed-IPR@us.dlapiper.com)
<i>Documents served</i>	PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO MOTION TO EXCLUDE EVIDENCE
<i>Persons Served</i>	DLA Piper LLP (US) Tiffany C. Miller Edward H. Sikorski James M. Heintz

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner