

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO**

RESMED CORP.,	)	C.A. No. 1:23-cv-02221-BMB
	)	
<i>Plaintiff / Counterclaim-</i>	)	RESPONSE TO COUNTERCLAIMS
<i>Defendant,</i>	)	FOR INFRINGEMENT
	)	
v.	)	DEMAND FOR JURY TRIAL
	)	
CLEVELAND MEDICAL DEVICES, INC.,	)	
<i>Defendant / Counterclaim</i>	)	
<i>Plaintiff.</i>	)	
	)	
	)	

**PLAINTIFF RESMED CORP.’S RESPONSE AND AFFIRMATIVE
DEFENSES TO DEFENDANT’S COUNTERCLAIMS FOR PATENT INFRINGEMENT**

Plaintiff and Counterclaim-Defendant ResMed Corp. (“ResMed” or “Counterclaim-Defendant”), by and through its attorneys, hereby responds to the numbered paragraphs in Defendant and Counterclaim-Plaintiff Cleveland Medical Devices, Inc.’s (“CleveMed” or “Counterclaim-Plaintiff”) Counterclaims for Infringement (“Counterclaims”), and provides its affirmative defenses thereto, as follows:

CLEVEMED’S COUNTERCLAIMS

1. Counterclaim-Plaintiff Cleveland Medical Devices, Inc. (“CleveMed”) alleges the following counterclaims against Counterclaim-Defendant ResMed Corp. (“ResMed”).

ANSWER: Counterclaim-Defendant ResMed responds to the following counterclaims as alleged by CleveMed.

[ALLEGED] INFRINGEMENT OF CLEVEMED’S PATENTS

THE PARTIES

2. Counterclaim-Plaintiff CleveMed is an Ohio corporation with its principal place of business at 4415 Euclid Ave, Cleveland, Ohio 44103.

others to infringe the asserted patents. Finally, neither ResMed nor its parent corporation have willfully infringed any valid asserted claim of the asserted patents.

THIRD AFFIRMATIVE DEFENSE
(Invalidity)

148. Upon information and belief, one or more claims of the Asserted Patents are invalid and/or unenforceable for failing to meet one or more requirements of patentability set forth in Part II of Title 35 of the United States Code, including but not limited to sections 101, 102, 103, 112, 115, 116, and/or 256, or judicially created doctrines of invalidity including, but not limited to, obviousness-type double patenting or the Rules and Regulations of the USPTO relating thereto.

149. Specifically, all of the asserted claims are invalid under 35 U.S.C. §102 and/or §103 in view of at least any reference listed on the face of the patents, any reference cited or referred to in the prosecution histories of the patents at issue, foreign counterparts to those patents, and related U.S. and foreign patents, the prior art identified in any of ResMed's invalidity contentions served in *Cleveland Medical Devices Inc. v. ResMed Inc.*, C.A. No. 22-974 (D. Del.), and/or any prior art identified in ResMed's forthcoming contentions in this case, either individually or in combination. As examples only, ResMed identifies the following prior art:

'284, '921, and '680 patents:

- United States Patent No. 6,167,258 ("Schmidt")
- PCT Publication No. WO 2005/096737 ("Farrell")
- United States Patent Application Publication No. 2002/0165462 ("Westbrook")
- United States Patent Application Publication No. 2003/0213489 ("Mechlenburg")
- US Patent No. 6,287,264 ("Hoffman")
- US Patent No. 6,644,311 ("Truitt")

- Mohd Fadlee A. Rasid and Bryan Woodward, *Bluetooth Telemedicine Processor for Multichannel Biomedical Signal Transmission via Mobile Cellular Networks*,” IEEE Transactions on Information Technology in Biomedicine, Vol. 9, No. 1, March 2005, at 35 (“Rasid”)
- ResMed AutoSet Spirit (S7)
- ResMed S8 AutoSet Vantage
- ResMed’s ResTraxx System, including ResTraxx Module and ResTraxx Data Center

’512 patent:

- United States Patent No. 9,801,589 to Schwaibold
- United States Patent Application Publication No. 2003/0199945 to Ciulla
- United States Patent No. 7,967,760 to Lang
- United States Patent Application Publication No. 2002/0022973 to Sun
- United States Patent No. 6,167,258 to Schmidt
- Puzzuoli, et al., *Remote Transmission and Analysis of Signals from Wearable Devices in Sleep Disorders Evaluation*, Computers in Cardiology, 2005, 32:53-56

150. ResMed further incorporates by reference the prior art and arguments included in PGR2024-00012 filed by ResMed Corp. against the ’284 patent on December 13, 2023. For example, the claims of the ’284 are not entitled to a priority date of November 4, 2005. It is well settled that “a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995). Specifically, the claims include several limitations that were first introduced during the prosecution of the application that led to the ’284 patent (Appl. No. 17/825,266), 17 years after the filing of the initial ’899 priority application. Some of these limitations include:

least the above limitations of the challenged claims. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010).

153. Because each of the priority applications lack “written description support for the challenged claims,” there cannot be a “continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed.”

Hollmer, 681 F.3d 1351 at 1355. As such, the challenged claims are not entitled to a priority date of any of the prior applications in the chain. *Id.* The correct priority date of the challenged claims can be no earlier than the date in which the ’266 application was filed—May 26, 2022.

154. Under the correct priority date of the ’284 patent of May 26, 2022, the references asserted by ResMed Corp. in PGR2024-00012 are prior art to the ’284 patent, including U.S. Patent Application Publication 2016/0193437 (“Bao”), U.S. Patent Application Publication 2018/0199882 (“Klee”), WO 2021/152526 (“Shouldice”), U.S. Patent Application Publication 2007/0161913 (“Farrell”), U.S. Patent Application Publication 2007/0155208 (“Pirzada”), and U.S. Patent No. 5,424,942 (“Dong”). Additional prior art to the ’284 patent includes U.S. Patent No. 6,167,258 (“Schmidt”), US 6,644,311 (“Truitt”), US 5,704,345 (“Berthon-Jones”), U.S. 2004/0129838 (“Lisy”), U.S. Patent No. 8,172,766, U.S. Patent No. 10,076,269, U.S. Patent No. 11,375,921, and Roux et al., Continuous positive airway pressure: new generations, *Clinics in Chest Medicine*, Vol. 24 (2003), pp.315-342, ResMed’s S9 Series Devices, ResMed’s AirSense 10 devices, ResMed’s AirCurve 10 devices, ResMed’s AirSense 11 devices, ResMed’s AirMini devices, and ResMed’s EasyCare Online platform (later rebranded as AirView).

155. Moreover, claims 1-20 of the ’284 patent are not enabled because the specification would not have taught a POSITA how to make and use the full scope of the claimed invention without undue experimentation. This lack of enablement arises from the same

DATED: March 15, 2024

OF COUNSEL:

Sean Cunningham (admitted *Pro Hac Vice*)
Tiffany Miller (admitted *Pro Hac Vice*)
David R. Knudson (admitted *Pro Hac Vice*)
DLA PIPER LLP (US)
4365 Executive Drive, Suite 1100
San Diego, CA 92121-2133
Telephone: 858-677-1400
sean.cunningham@dlapiper.com
tiffany.miller@dlapiper.com
david.knudson@dlapiper.com

Angela C. Whitesell (admitted *Pro Hac Vice*)
DLA PIPER LLP (US)
1201 N. Market Street, Suite 2100
Wilmington, DE 19801-1147
Telephone: 302-468-5711
angela.whitesell@dlapiper.com

/s/ Michael R. Reed
Michael R. Reed (0063995) Trial Attorney
Elise K. Yarnell (0093996)
HAHN LOESER & PARKS LLP
65 East State Street, Suite 1400
Columbus, Ohio 43215
Tel. (614) 221-0240
Fax: (614) 221-5909
Email: mreed@hahnlaw.com
eyarnell@hahnlaw.com

***Attorneys for Plaintiff / Counterclaim-
Defendant ResMed Corp.***

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 18th day of March, 2024, the foregoing was filed electronically. Notice of the filing will be served via the CM-ECF filing system this 18th day of March, 2024, on all counsel of record. In addition, unredacted copies of the foregoing have been served on the Court and all counsel of record pursuant to Section VII of the Initial Standing Order.

/s/ Michael R. Reed
Michael R. Reed (0063995)