

Filed on behalf of: ResMed Corp.

Filed: April 2, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,

Petitioner,

v.

CLEVELAND MEDICAL DEVICES INC.,

Patent Owner.

Case No. IPR2025-00157
U.S. Patent No. 11,602,284

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	<i>GENERAL PLASTIC</i> SUPPORTS INSTITUTION	1
II.	<i>FINTIV</i> SUPPORTS INSTITUTION	4
III.	<i>ADVANCED BIONICS</i> SUPPORTS INSTITUTION	6
A.	The Asserted Arguments Have Not Been Previously Presented	6
B.	The Examiner Materially Erred in Overlooking the Disclosures	8

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (Feb. 13, 2020).....	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	1, 4
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (Dec. 15, 2017).....	6, 8
<i>Code200 v. Bright Data Ltd.,</i> IPR2022-00861, Paper 18 (Aug. 23, 2022).....	1, 2, 3
<i>Code200 v. Bright Data Ltd.,</i> IPR2022-00862, Paper 18 (Aug. 23, 2022).....	1, 2, 3
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha,</i> IPR2016-01357, Paper 19 (September 6, 2017).....	<i>passim</i>
<i>Google LLC v. Uniloc 2017 LLC,</i> IPR2020-00115, Paper 10 (May 12, 2020).....	6
<i>Huawei Tech. Co. v. WSOU Inv., LLC,</i> IPR2021-00225, Paper 11 (June 14, 2021).....	5
<i>Microsoft Corp. v. Parallel Networks Licensing, LLC,</i> IPR2015-00483, Paper 10 (July 15, 2015)	7
<i>Motorola Sols., Inc. v. Stellar, LLC,</i> IPR2024-01205, Paper 19 (Mar. 28, 2025)	4, 5
<i>Motorola Sols., Inc. v. Stellar, LLC,</i> IPR2024-01206, Paper 19 (Mar. 28, 2025)	4, 5
<i>Motorola Sols., Inc. v. Stellar, LLC,</i> IPR2024-01207, Paper 19 (Mar. 28, 2025)	4, 5

<i>Motorola Sols., Inc. v. Stellar, LLC</i> , IPR2024-01208, Paper 19 (Mar. 28, 2025)	4, 5
<i>Netflix, Inc. v. Uniloc 2017 LLC</i> , IPR2020-00041, Paper 10 (Mar. 25, 2020)	4
<i>Samsung Elecs. Co. Ltd. v. Dynamics Inc.</i> , IPR2020-00505, Paper 11 (Aug. 12, 2020)	5
<i>Shenzhen Auto Elecs. Co., Ltd v. Ultravision Techs, LLC.</i> , IPR2021-00190, Paper 7 (June 9, 2021).....	2
<i>Thryv, Inc. v. Click-To-Call Techs., LP</i> , 590 U.S. 45 (2020).....	6
<i>Toshiba Am. Info. Sys., Inc. v. Wallelex Microelecs. Ltd.</i> , IPR2018-01538, Paper 11 (Mar. 5, 2019)	2
Statutes	
35 U.S.C. § 315	5

As to *General Plastic*, the Board has never considered a merits challenge to the patent, thus repeated attacks on the patent is not an issue. As to *Fintiv*, the parallel case in N.D. Ohio has already been stayed pending IPR before *Markman*, thus the PTAB would be the only forum deciding printed prior art validity issues. And as to *Advanced Bionics*, Truitt and Kumar (the primary asserted references) were not considered during prosecution. Consequently, efficiency, fairness, and the strong merits of the instant Petition favor institution. This is particularly true here because the PTAB serves as the most efficient and knowledgeable forum for invalidity given its specialized focus and familiarity with the law as compared to N.D. Ohio, which rarely addresses patent cases. Thus, discretionary denial is not warranted.

I. GENERAL PLASTIC SUPPORTS INSTITUTION

Petitioner has not had “the opportunity to pursue a decision on the merits.” *Code200 v. Bright Data Ltd.*, IPR2022-00861, -00862, Paper 18, at 4. (Aug. 23, 2022) (Director Decision). Thus, fundamental fairness favors institution.

General Plastic prevents “abuse of the review process by repeated attacks on patents.” IPR2016-01357, Paper 19, at 17 (Sept. 6, 2017) (precedential). But here, there is no such abuse. The Board merely denied institution of a prior PGR petition because it found the '284 Patent to be a pre-AIA patent. Indeed, the Board has admonished that *General Plastic* does not preclude institution in cases where, as here, a first petition was not evaluated on the merits. *See, e.g., Code200* at 4-5

(finding allowance of second petition, when first petition not decided on merits, “best balances the desires to improve patent quality and patent-system efficiency against the potential for abuse of the review process by repeated attacks”). Notably, the POPR provides no basis to find otherwise.

Factors 1-3: These factors weigh strongly against discretionary denial. “Where the first-filed petition under factor 1 was ... not evaluated on the merits, factors 1-3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 or other concerns under factor 2.” *Code200* at 5. Here, the first petition (PGR2024-00012) was not evaluated on the merits under factor 1, and the POPR confirms there are no other concerns under factors 3 or 2.

As to road-mapping under factor 3, there is none. In fact, PO acknowledges that the instant Petition relies on “entirely new grounds.” POPR, 16. PO argues that Petitioner “had access to [PO’s] arguments before filing this follow-on petition.” *Id.*, 15. But PO does not (and cannot) explain how its arguments on entirely different grounds provided a road-map for the instant Petition. *See, e.g., Toshiba Am. Info. Sys., Inc. v. Wallex Microelects. Ltd.*, IPR2018-01538, Paper 11, at 20-22 (Mar. 5, 2019) (“Nor are we persuaded that Petitioner used our prior Institution Decisions ... as a ‘roadmap’ in a manner unfair to Patent Owner. The asserted grounds in the current Petition are based on different prior art.”); *Shenzhen Auto Elecs. Co., Ltd v. Ultravision Techs, LLC.*, IPR2021-00190, Paper 7, at 17-18 (June 9, 2021) (factor 3

given no weight where IPR challenge relied on different art than prior challenge).

As to “other concerns of fairness related to factor 2” (knowledge of prior art), *Code200* at 6, again, there is none. Petitioner does not cure “a substantive and material defect” with the prior art in its first petition. *General Plastic*, at 14. Instead, Petitioner relies on entirely different grounds, using entirely different prior art, based on an entirely different priority date. Indeed, the instant Petition relies on Kumar as prior art based on the PO's alleged pre-AIA date. PO complains that Petitioner could “have filed this Petition at the time it filed its first petition or around the time it served its invalidity con[t]entions.” POPR, 13. Not so. First, Petitioner relied on a different priority date and therefore had not yet discovered Kumar. Second, another petition (while the first was still pending) would have run directly afoul of *General Plastic*. Third, because the patent was deemed to be an AIA patent at the time of filing the first petition, the statutory window for filing an IPR petition was not yet open, precluding Petitioner from filing the instant Petition.

Factors 4 and 5: Where an earlier petition was not considered on the merits, factors 4 and 5 are of “limited relevance.” *Code200*, at 6. That said, these factors weigh against discretionary denial. To preserve the resources of the Board and parties, Petitioner reasonably waited until its request for rehearing was denied on October 17, 2024, before preparing and filing the instant Petition less than a month later on November 15, 2024. PO complains that “Kumar was publicly available since

2002.” POPR, 16. But this argument demonstrates PO’s fundamental misunderstanding of the factors. The inquiry is not a rote investigation of when Petitioner could have known about the reference, but whether the timing of events suggests gamesmanship. *Netflix, Inc. v. Uniloc 2017 LLC*, IPR2020-00041, Paper 10, at 12 (Mar. 25, 2020) (finding factors 2, 4, and 5 do not favor denial where Board “perceive[s] no improper gamesmanship in the timing of the Petition”). Here, there is no gamesmanship—instead, the timing demonstrates Petitioner acted reasonably.

Factors 6 and 7: These factors weigh strongly against discretionary denial because this is the exact type of situation where the Board’s specialized knowledge should be applied, and is the best and most efficient use of the Board’s resources. The parallel litigation is stayed in N.D. Ohio, where only 25 patent cases were filed in the last year, according to DocketNavigator. Given the limited number of patent cases pending in that District, the Board is far more familiar with invalidity issues.

II. *FINTIV* SUPPORTS INSTITUTION

Factors 1 (stay) and 2 (proximity to trial) strongly favor institution. The Ohio case is stayed pending IPRs and there is no danger the case will proceed to trial before the FWD. *Cf. Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 19, at 3 (Mar. 28, 2025) (Director Review) (denial where trial scheduled eleven months before projected FWD). Indeed, there was no trial date before stay (N.D. Ohio has had only 8 patent trials since 2008, DocketNavigator).

Factor 3 (investment in related litigation) favors institution. The Ohio court has not yet held *Markman* or issued a claim construction order. *Cf. Stellar*, at 3 (denial where court had already issued claim construction order, and parties conducted depositions and exchanged expert reports). Although PO asserts the parties have invested significant resources, PO incorrectly points to the Delaware case (also stayed) where the '284 Patent is not asserted.

Factor 4 (overlap) strongly favors institution. The parallel case is stayed pending IPR, thus there is no overlap of invalidity challenges. PO's assertion that Petitioner has not submitted a *Sotera* or similar stipulation is nonsensical as Petitioner will be estopped once the stay is lifted under 35 U.S.C. § 315.

Factor 5 (same party) favors institution. The FWD will issue before the trial in Ohio (if any). *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11, at 14 (June 14, 2021) ("this factor 'favors denial if trial precedes the Board's Final Written Decision and favors institution if the opposite is true'"). PO's arguments here (POPR, 29-30) merely repeat its irrelevant factor 3 arguments.

Factor 6 (other considerations) strongly favors institution. As discussed below, the Petition presents strong arguments for unpatentability using grounds based on never-considered *Truitt* and *Kumar*. *See Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11, at 14 (Aug. 12, 2020) (finding case merits favor institution). Thus, institution is consistent with the significant public interest

against “leaving bad patents enforceable.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 55 (2020). Indeed, this Petition is the sole challenge to the '284 patent before the Board—a “crucial fact” favoring institution. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 10, at 6 (May 12, 2020). Importantly, the PTAB is a far more efficient forum to decide invalidity compared to N.D. Ohio, which only sees about two dozen patent cases per year.

III. *ADVANCED BIONICS* SUPPORTS INSTITUTION

Truitt in combination with Kumar and other prior art invalidates the challenged claims. Pet., 17-69 (Grounds 1-6). PO asserts that all of Petitioner's art or substantially the same art (Farrell and Geva) was previously presented to the Office during prosecution of related '775 Patent. They were not.

A. The Asserted Arguments Have Not Been Previously Presented

The first prong of *Advanced Bionics* relating to *Becton* factors (a), (b), and (d) cannot be met. As to *Becton* factors (a) and (b), the Examiner considered neither Truitt nor Kumar during prosecution of the '284 Patent.

As to *Becton* factor (d), there is no “overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art.” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-8 (Dec. 15, 2017). PO claims that the Examiner “rejected a nearly identical theory during prosecution of a child patent

('775 Patent)." POPR, 33. Not so. Indeed, this tortured reading of the '775 Patent prosecution only underscores the lack of credibility in PO's arguments.

As a threshold, arguments made during the prosecution of a child have little relevance. When art is cited "during the prosecution of a child patent application, not the application that matured into the [challenged] patent, ... it has less relevance to the challenged claims." *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00483, Paper 10, at 15 (July 15, 2015). That is particularly true here, where the Examiner never even considered Truitt or Kumar during the child prosecution.

Regardless, the arguments before the Examiner were plainly not the same. First, Farrell is not cumulative of Truitt. PO claims that it overcame the Examiner's rejection "by explaining that Farrell does not disclose an airflow sensor 'adapted for measuring or deriving the respiratory airflow of a subject while using the PAP and outputting airflow sensor data.'" POPR, 34. This is a mischaracterization. Instead, PO overcame the rejection by emphasizing "an airflow sensor being any type of sensor internal to the enclosure of the PAP device." EX2001, 12 (emphasis in original). Put simply, PO argued that Farrell taught an airflow sensor "external to the PAP enclosure" (EX2001, 13), not internal.

Importantly, Truitt does not share Farrell's alleged deficiency. As the Petition establishes, Truitt's Figure 1 PAP device is "virtually identical to Figure 7 of the '284 Patent" showing an airflow sensor ***internal*** to the enclosure. Pet, 10. PO ignores

this disclosure, instead noting that “Truitt also contemplates that its flow assembly can be used as an external attachment.” POPR, 34. But Petitioner does not rely on that embodiment of Truitt, and certainly not for the internal airflow sensor limitation. *See* Pet., 21-27, 35-37.

Second, Geva is not cumulative of Kumar. PO claims that it “distinguished the combination of Farrell and Geva on the basis that Geva’s *cellular phone* ... performs the signal analysis.” POPR, 35. Again, this is a mischaracterization. Instead, PO argued that Geva includes “no teaching of a remote internet site as claimed with the specific capabilities as with the present invention.” EX2001, 15.

Here, Kumar does not share Geva’s alleged deficiency. Specifically, Kumar discloses a remote internet site that performs such analysis. Pet., 41-46. PO argues that “Petitioner uses Kumar for its arguments directed to the cell phone.” POPR, 35. It does. But the relevant question is whether the Examiner ever considered Kumar’s disclosure of a remote internet site (or equivalent), and the answer to that is no.

B. The Examiner Materially Erred in Overlooking the Disclosures

Even if the first prong of *Advanced Bionics* is satisfied (and it is not), the second prong of *Advanced Bionics* relating to *Becton* factors (c), (e), and (f) cannot be met. The Examiner materially erred in not considering the internal airflow sensor disclosed in Figure 1 and other parts of Truitt and the remote internet site of Kumar (or equivalent disclosures in other references) as discussed above.

Dated: April 2, 2025

Respectfully submitted,

By: /Lisa K. Nguyen/
Lisa K. Nguyen (Reg. No. 58,018)
PAUL HASTINGS LLP
1117 S. California Avenue
Palo Alto, CA 94304
Telephone: 650-320-1800
lisanguyen@paulhastings.com

Counsel for Petitioner
RESMED CORP.

CERTIFICATE OF SERVICE

I hereby certify that on April 2, 2025, a true and correct copy of the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** is being served by electronic mail on Patent Owner's counsel of record listed below, pursuant to its Mandatory Notices:

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
Email: jhannah@kramerlevin.com
Email: 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
Email: jprice@kramerlevin.com
Email: jeng@kramerlevin.com

Dated: April 2, 2025

Respectfully submitted,

By: /Lisa K. Nguyen/
Lisa K. Nguyen (Reg. No. 58,018)
PAUL HASTINGS LLP
1117 S. California Avenue
Palo Alto, CA 94304
Telephone: 650-320-1800

lisanguyen@paulhastings.com

Counsel for Petitioner
RESMED CORP.