

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES INC.,
Patent Owner.

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

PATENT OWNER'S PRELIMINARY SUR-REPLY

TABLE OF CONTENTS

I.	<i>GENERAL PLASTIC</i> SUPPORTS DISCRETIONARY DENIAL	1
II.	<i>FINTIV</i> SUPPORTS DISCRETIONARY DENIAL.....	5
III.	35 U.S.C. § 325(d) SUPPORTS DISCRETIONARY DENIAL.....	7
IV.	CONCLUSION.....	8

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH</i> No. IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	7
<i>Apple Inc. v. Fintiv, Inc.</i> , No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	5
<i>Code200 v. Bright Data, Ltd.</i> , IPR2022-00861, Paper 18 (P.T.A.B. Aug. 23, 2022).....	3
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , No. IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).....	1, 2, 5
<i>Huawei Techs. Co. v. WSOU Invs., LLC</i> , IPR2021-00225, Paper 11 (P.T.A.B. June 14, 2021)	6
<i>Microsoft Corp. v. Parallel Networks Licensing, LLC</i> , IPR2015-00483, Paper 10 (P.T.A.B. July 15, 2021).....	7, 8
<i>NetApp, Inc. v. Realtime Data, LLC</i> , IPR2017-01354, Paper 16 (P.T.A.B. Nov. 14, 2017).....	3
<i>Oxylabs, UAB v. Bright Data Ltd.</i> , IPR2023-01425, Paper 10 (P.T.A.B. Mar. 10, 2024).....	2
<i>Samsung Elecs. Co. v. Headwater Rsch. LLC</i> , IPR2024-01407, Paper 9 (P.T.A.B. Mar. 20, 2025).....	5
<i>Sonos, Inc. v. Google LLC</i> , IPR2023-01284, Paper 10 (P.T.A.B. Mar. 8, 2024).....	2
Statutes	
35 U.S.C. § 325(d)	7
Other Authorities	
37 C.F.R. § 42.102(a)(1).....	4

37 C.F.R. § 42.102(a)(2)	4
Nov. 2019 Consolidated Trial Practice Guide	2, 4

Despite requesting additional briefing to address issues concerning discretionary denial, Petitioner largely refused to engage with the substance of Patent Owner's arguments. The Board should reject this follow-on Petition because Petitioner's strategic delay gave it an opportunity to use Patent Owner's arguments as a roadmap for a revamped obviousness argument, its shotgun style of invalidity challenges across three forums was surgically designed to disrupt the litigation that it initiated, and its obviousness argument retreads the same arguments overcome during prosecution of the '284 Patent under the guise of different art.

I. *GENERAL PLASTIC* SUPPORTS DISCRETIONARY DENIAL

The Board should deny this follow-on Petition under *General Plastic* because, although Petitioner could have asserted these grounds in Case No. PGR2024-00012, Paper 2 (P.T.A.B. Dec. 13, 2023) ("the PGR Petition") or filed this Petition in parallel, it delayed the filing of this Petition for over eleven months. During that time, Patent Owner substantively addressed essentially the same obviousness grounds raised in the PGR Petition when responding to Petitioner's invalidity contentions. This Petition, filed on the eve of the statutory deadline, abandoned those grounds in favor of new art, so the road-mapping concerns articulated in *General Plastic* remain despite the Board not reaching the merits of Petitioner's obviousness arguments.

Factor 1 supports denial because this follow-on Petition challenges only

claims that were already challenged in the PGR, and it initiated the district court proceeding involving the '284 Patent. Prelim. Resp. ("POPR") at 13. Petitioner's attempt to devalue this factor by arguing that it only matters when there are road-mapping concerns under **Factor 3** or other concerns for **Factor 2** has already been rejected by the Board. Reply at 2; *Sonos, Inc. v. Google LLC*, IPR2023-01284, Paper 10 at 7 (P.T.A.B. Mar. 8, 2024). In any event, those concerns exist in this case.

Factor 2 supports denial because Petitioner does not deny that it knew or should have known about the art raised in this Petition when it filed the PGR Petition. *General Plastic*, Paper 19 at 16; *Oxylabs, UAB v. Bright Data Ltd.*, IPR2023-01425, Paper 10 at 10-11 (P.T.A.B. Mar. 10, 2024) (failing to explain "the nature and extent of the prior art search" weighs strongly against institution). Petitioner's Reply raises issues that do not address Factor 2 and are, in any event, meritless.

First, Petitioner's initial reliance on an inaccurate *later* priority date for the '284 Patent has no bearing on Factor 2 because Kumar is facially prior art under either priority date. Reply at 3. Second, Petitioner cites no authority for its claim that parallel petitions "run directly afoul of *General Plastic*." *Id.* To the contrary, the Nov. 2019 Consolidated Trial Practice Guide ("CTPG") explains what steps petitioners should take to ensure full consideration of parallel petitions. CTPG at 59-62. Third, because Petitioner waited until the very last day it was statutorily allowed to file its PGR, it could have filed its IPR the very next day regardless of its

own conclusion about the priority date of the '284 Patent. Instead, Petitioner waited 11 months, until it had received Patent Owner's responses to invalidity contentions.

Factor 3 weighs strongly in favor of denying institution because Petitioner does not deny that it received Patent Owner's responses to Petitioner's invalidity contentions or that those responses informed its decision to abandon its initial obviousness grounds. POPR at 14-16; Reply at 2-3. Rather than minimize "'road-mapping' concerns" by "rais[ing] unpatentability challenges *substantially overlapping with those in the previously-filed petition*," Petitioner refined its arguments "based on lessons learned from later developments." *Code200 v. Bright Data*, IPR2022-00861, Paper 18 at 5 (P.T.A.B. Aug. 23, 2022) (precedential).

Petitioner's argument regarding **Factor 3** relies on non-precedential PTAB rulings that predate, and conflict with, the precedential *Code200* decision. Reply at 2 (suggesting that the Board finds the introduction of "entirely new grounds" as evidence of *no road-mapping*). Petitioner's argument is also plainly illogical: Road-mapping can only exist in cases where the new, tailored grounds differ materially from those previously presented. *NetApp, Inc. v. Realtime Data, LLC*, IPR2017-01354, Paper 16 at 11 (P.T.A.B. Nov. 14, 2017) (Factor 3 concerns the extent to which petition was able to "tailor its arguments to address issues identified by the patent owner and/or the Board during a prior proceeding."). Accordingly, **Factor 3** weighs strongly against institution.

Factor 4 weighs in favor of denial because Petitioner does not explain when it became aware of Kumar. Reply at 3-4.

Factor 5 weighs in favor of denial because Petitioner's acknowledgement that it waited until its request for rehearing was denied before filing the instant Petition weighs in favor of *denial*, not *institution*. Petitioner suggests that it had no alternative but to wait, but its hands were not tied. **First**, the CTPG suggests that petitioners file parallel petitions when there is a question over a priority date. CTPG at 59. **Second**, under 37 C.F.R. § 42.102(a)(2), petitioners are free to file IPR petitions for first-to-invent patents in the first nine months after issuance (*i.e.*, in parallel with the PGR Petition). **Third**, even if Petitioner did not want to argue the priority date in the alternative, it could have filed this IPR petition under 37 C.F.R. § 42.102(a)(1) the day after it filed the PGR Petition because it delayed filing the PGR Petition until the very end of the statutory window. Accordingly, Petitioner's delay was inefficient, unnecessary, and allowed Petitioner to tailor its obviousness grounds based on Patent Owner's responses to its invalidity contentions. POPR at 15-17.

As to **Factor 6**, Petitioner's dismaying denigration of the U.S. District Court for the Northern District of Ohio (the "Ohio Case") is a reason for denying institution, not instituting trial. Reply at 4. Although Petitioner initiated the parties' current dispute in district court, Petitioner waited as long as possible to file a spate of PGRs, IPRs, and reexamination requests, and then convinced the court to stay its

own action once the case was transferred from its preferred venue. In any event, Factor 6 generally weighs in favor of denial for follow-on petitions. *General Plastic*, Paper 19 at 10 (“[W]ith respect to factor 6, . . . the Board’s resources would be more fairly expended on initial petitions, rather than follow-on petitions.”).

II. *FINTIV* SUPPORTS DISCRETIONARY DENIAL

In its Reply, Petitioner does not address Patent Owner’s arguments that discretionary denial is appropriate under *Fintiv* because Petitioner (1) initiated the co-pending district court litigation, (2) raises essentially the same prior art in both forums, and (3) engaged in gamesmanship via strategic delays and parallel IPR Petitions and reexamination requests directed to the same claims of the same patents.

Factor 3 weighs in favor of denial because the parties have already expended significant resources in the Ohio Case, and Petitioner’s delays and gamesmanship have multiplied the parties’ disputes rather than streamlining them. The Board recently found Factor 3 is neutral when claim construction briefing is complete in the co-pending litigation **and** the petitioner filed the petition expeditiously. *Samsung Elecs. v. Headwater Rsch.*, IPR2024-01407, Paper 9 at 7-8 (Mar. 20, 2025). In this case, Petitioner did not file expeditiously, it waited as long as possible to file this Petition, which “favor[s] denial.” *Fintiv*, Paper 11 at 11-12 (if “the evidence shows that the petitioner did not file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial”).

Factor 4 favors denial because Petitioner does not dispute that there is a significant overlap in the issues raised, and it has not offered any case-narrowing stipulation. Its argument that there is no overlap in validity issues because the District Court action is stayed ignores that the Court very well may lift its stay any time before a FWD is due in this case, such as if the Board denies institution in this case or any of the other patents that Petitioner has challenged. Reply at 5.

Factor 5. Petitioner is the counterclaim-defendant in the pending Ohio Case, and thus, is not only the same party in the litigation, but also the plaintiff that chose the District Court as the venue for this dispute. Petitioner's reliance on the non-precedential *Huawei Techs. Co. v. WSOU Invs., LLC*, IPR2021-00225, Paper 11 at 14 (P.T.A.B. June 14, 2021) fails at least because it fails to consider that the stay may be lifted before a FWD issues in this case.

Factor 6. The equitable considerations weigh strongly in favor of denying institution. Although this case is stayed, that stay was gained via gamesmanship—namely, filing parallel IPR petitions and reexamination requests against the same patent without explanation or rankings. Additionally, Petitioner initiated the parties' current dispute in the district court and fails to explain why it is no longer a suitable venue to resolve that dispute (although its slights against the District Court are suggestive). Ultimately, it is not efficient for a party to begin a case in one forum and then, after running the clock as long as possible and driving up costs as much as

possible, decamping for another forum and requesting a stay of the original proceedings. The merits are weak because although Petitioner raises facially new prior art, its arguments based on that art are substantially the same as those considered and overcome during prosecution. *Infra* Section III; Reply at 5-6.

Factors 3 through 6 outweigh **Factors 1 and 2**, particularly because the stay in the Ohio Case was granted as a result of Petitioner's gamesmanship and inefficient filing practices.

III. 35 U.S.C. § 325(d) SUPPORTS DISCRETIONARY DENIAL

The Board should deny the Petition under § 325(d) because Petitioner's arguments concerning the combinations of Truitt, Kumar, and Mumford are substantially similar to those considered and rejected by the Office during prosecution. 35 U.S.C. § 325(d); POPR at 32-39. Again, despite requesting this briefing, Petitioner's arguments are largely non-responsive.

First, Petitioner cites *Microsoft v. Parallel Networks* for the premise that arguments were made in prosecution of a child patent hold less relevance. Reply at 7 (citing IPR2015-00483, Paper 10). Whatever weight this dicta carries in the abstract is irrelevant where, as here, the arguments presented in both cases are substantially similar. *Advanced Bionics*, Paper 6 at 10 (§ 325(d) concerns art and arguments "presented to the Office during *any* proceeding."). Accordingly, Petitioner had no basis for ignoring wholesale the arguments made and overcome

during prosecution of the related '775 Patent. Reply at 7-8 (relying on *Microsoft* to ignore dispositive arguments made in the '775 Patent's prosecution history).

Petitioner also does not dispute that Truitt, like Farrell, fails to “disclose an airflow sensor ‘adapted for measuring or deriving the respiratory airflow of a subject while using the PAP and outputting airflow sensor data’ or a second processor within the PAP device used for calculating symptom severity data or an index of treatment efficacy.” POPR at 34. Nor does Petitioner dispute that Kumar, like Geva, discloses a cell phone with a processor that processes data from a medical device while also failing to suggest that such calculations should be carried out on a PAP device. *Id.* at 35-36.

Second, the fact that Patent Owner's arguments directed to Farrell included multiple limitations is of no moment because the Examiner determined that the second processor limitation was not met by any of the prior art of record. Ex. 2003 at 6-7. Geva and Kumar are directed to systems for analysis of biomedical signals, and both use the processor in the cell phone as the processor that performs the claimed calculations. POPR at 35-36. Likewise, Farrell and Truitt disclose conventional PAP devices without such a processor. *Id.* at 4-6. Thus, Petitioner has neither pointed out how the examiner erred in evaluating the art.

IV. CONCLUSION

Patent Owner requests that the Board deny institution of *inter partes* review.

Respectfully submitted,

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(Case No. IPR2025-00157)

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the P-TACTS constitutes electronic service if Patent Owner provides the foregoing document (excluding exhibits), service was made on the Petitioner as detailed below.

<i>Date of service</i>	April 9, 2025
<i>Manner of service</i>	Electronic Filing and Electronic Mail (PH-ResMed-CleveMed@paulhastings.com)
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY SUR-REPLY
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