

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,
Patent Owner.

IPR2025-00157
Patent 11,602,284 B1

Before SHERIDAN K. SNEDDEN, NEIL T. POWELL, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner ResMed Corp. requests *inter partes* review of claims 1–3, 6, and 12–20 of U.S. Patent No. 11,602,284 B1 (“the ’284 patent,” Ex. 1001). Paper 1 (“Pet.”). Patent Owner Cleveland Medical Devices, Inc. filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply, and Patent Owner filed a Preliminary Sur-reply, addressing discretionary denial issues. Paper 8 (“Prelim. Reply”); Paper 9 (“Prelim. Sur-reply”).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. An *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons explained below, we exercise our discretion to deny institution of this follow-on petition because Petitioner previously filed a post-grant review petition challenging the same claims of the same patent.

A. Real Parties in Interest

Petitioner and Patent Owner each identify only themselves as the real party in interest. Pet. 71; Paper 3 (Patent Owner Mandatory Notices), 1.

B. Related Matters

The parties identify *ResMed Corp. v. Cleveland Medical Devices, Inc.*, 1:23-cv-02221-BMB (N.D. Ohio) as a related matter involving the ’284 patent (the “Ohio case”). Pet. 71; Paper 3, 1.

Petitioner identifies *inter partes* reviews for U.S. Patent No. 11,375,921 (IPR2025-00159), U.S. Patent No. 11,690,512 (IPR2025-

00158), U.S. Patent No. 11,786,680 (IPR2025-00160), U.S. Patent No. 11,857,333 (IPR2025-00246), and U.S. Patent No. 11,872,029 (IPR2025-00247). Pet. 71–72. Petitioner further states that it requested *ex parte* reexamination of U.S. Patent No. 11,375,921 (90/019,700) and U.S. Patent No. 11,786,680 (90/019,705). *Id.* at 72.

Patent Owner states that “Petitioner filed a *Post Grant Review* action, PGR2024-00012, on the ’284 Patent, which has been denied institution.” Paper 3, 1.

C. The ’284 Patent and Challenged Claims

The ’284 patent, titled “Devices and Methods for Sleep Disorder Diagnosis and Treatment,” issued on March 14, 2023, from U.S. Application 17/825,266, filed on May 26, 2022, and claims priority, as a continuation, to several utility applications, the earliest of which was filed on November 4, 2005. Ex. 1001, codes (21), (22), (45), (54), (63). The ’284 patent “relates to an integrated sleep diagnosis and treatment device.” *Id.* at 1:27–29.

Petitioner challenges claims 1–3, 6, and 12–20 of the ’284 patent. Pet. 1. Claim 1, the only independent claim of the ’284 patent, is illustrative and is reproduced below with bracketed notations added:¹

1. [preamble] A positive airway pressure (PAP) sleep disorder treatment system comprising:

[1.a] a non-transitory computer readable medium, the non-transitory computer readable medium comprising a first software, the first software executable by a first processor and configured to be used with a cell phone to display to a subject for viewing on the cell phone on to which the first software is downloaded an index of treatment efficacy of the subject using

¹ For ease of reference, we use the same bracketed notations Petitioner uses in the Petition. *See, e.g.*, Pet. 75–76.

a PAP device, the first software used for displaying the index on the cell phone, the index based in part on data of severity of sleep disorder symptoms of the subject and data of usage of the PAP device by the subject, the data of severity of sleep disorder symptoms of the subject and the data of usage of the PAP device by the subject both calculated by the PAP device and received by the cell phone, the cell phone comprising at least one first radio frequency wireless transceiver, the first processor, the first software when downloaded and a display;

[1.b] the PAP device with an enclosure further comprising:

[1.b.i] a blower having an air output,

[1.b.ii] an airflow sensor internal to the PAP device adapted for measuring or deriving the respiratory airflow of a subject while using the PAP and outputting airflow sensor data,

[1.b.iii] a second processor adapted for receiving the airflow sensor data, for calculating the data of a severity of the symptoms of the subject and/or the index, and for calculating the data of usage of the PAP device,

[1.b.iv] a mask or a nasal cannula, and

[b.v] at least one second radio frequency wireless transceiver, the at least one second radio frequency wireless transceiver adapted for transmitting the data of severity of the symptoms of the subject and/or the index, and the data of usage calculated by the second processor; and

[1.c] a remote internet site, the remote internet site adapted to receive the data of the severity of the symptoms of the subject and/or the index, and the data of usage of the PAP device by the subject both related to the subject's treatment and the treatment's efficacy, in whole or part, generated by the PAP device and transmitted via the at least one second radio frequency wireless transceiver.

Ex. 1001, 23:58–24:35.

D. Asserted Grounds of Unpatentability

Petitioner alleges that claims 1–3, 6, and 12–20 are unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1–3, 6, 12–15, 18, 19	103	Truitt, ² Kumar ³
2	15, 16, 18	103	Truitt, Kumar, Dong ⁴
3	17, 20	103	Truitt, Kumar, Wright ⁵
4	1–3, 6, 12–15, 18, 19	103	Truitt, Kumar, Mumford ⁶
5	15, 16, 18	103	Truitt, Kumar, Dong, Mumford
6	17, 20	103	Truitt, Kumar, Wright, Mumford

Pet. 2–3. Petitioner supports its contentions with the Declarations of Jason Kirkness, Ph.D. (Ex. 1003) and Dr. Sandeep Chatterjee (Ex. 1005), among other evidence.

² Truitt et al., U.S. Patent 6,644,311 B1, issued November 11, 2003 (“Truitt,” Ex. 1007).

³ Kumar et al., U.S. Patent App. Pub. 2002/0198473 A1, published December 26, 2002 (“Kumar,” Ex. 1008).

⁴ Dong et al., U.S. Patent 5,424,942, issued June 13, 1995 (“Dong,” Ex. 1014).

⁵ Wright et al., U.S. Patent App. Pub. 2002/0185130 A1, published December 12, 2002 (“Wright,” Ex. 1013).

⁶ Mumford et al., U.S. Patent 7,575,005 B2, issued August 18, 2009 (“Mumford,” Ex. 1009).

II. DISCRETIONARY DENIAL

Institution of an *inter partes* review is discretionary, not mandatory. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

The parties briefed a number of discretionary denial issues, including whether institution should be denied (1) under *General Plastic*⁷ because Petitioner previously filed a petition for post-grant review challenging the same claims of the same patent challenged here; (2) under *Fintiv*⁸ in view of the Ohio case; and (3) because the same or substantially the same prior art or arguments previously were presented to the Office during prosecution of the challenged patent or its related patents (*see* 35 U.S.C. § 325(d)). *See generally* Pet. 70–71; Prelim. Resp. 12–39; Prelim. Reply; Prelim. Sur-reply.

As discussed below, we determine that denying the Petition under *General Plastic* is appropriate. Accordingly, we need not address Patent Owner’s other asserted bases for discretionary denial.

A. Analysis

In *General Plastic*, the Board articulated a non-exhaustive list of seven factors to be considered in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was

⁷ *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to Section II.B.4.i).

⁸ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 11, 2020) (precedential).

previously challenged before the Board. *General Plastic*, Paper 19 at 16. The Board uses the factors to evaluate “the potential impacts on both the efficiency of the *inter partes* review process and the fundamental fairness of the process for all parties.” *Id.* at 18. Below we address each of the *General Plastic* factors.

1. Whether the same petitioner previously filed a petition directed to the same claims of the same patent

There is no dispute that Petitioner previously filed a petition for post-grant review of all claims of the '284 patent. *See* Pet. 70; Prelim. Resp. 13; *see also Resmed Corp. v. Cleveland Medical Devices, Inc.*, PGR2024-00012, Paper 7, 2 (PTAB June 24, 2024) (“PGR Dec.”). As such, Patent Owner argues that this factor favors discretionary denial. Prelim. Resp. 13.

Petitioner counters that despite its prior filing, this factor does not favor discretionary denial because Petitioner did not have “the opportunity to pursue a decision on the merits” in the post-grant review. Prelim. Reply 1. Petitioner cites the precedential Board case *Code200, UAB, et al. v. Bright Data Ltd.*, IPR2022-00861, -00862, Paper 18 (PTAB Aug. 23, 2022), which states:

“[A]llowing [a petitioner] the opportunity to pursue a decision on the merits” in a second-filed petition, when the first-filed petition was not evaluated on the 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 on patents.”

Code200, Paper 18, 4–5 (quoting *Intel Corp. v. VLSI Tech. LLC*, IPR2022-00366, Paper 14 (PTAB June 8, 2022), 9–10). Petitioner asserts that the Board did not reach the merits of the post-grant review petition, and instead

“merely denied institution . . . because it found the ’284 Patent to be a pre-AIA patent” that was not eligible for post-grant review.

We find that in view of Petitioner’s prior petition, this factor favors discretionary denial. *Code200* is distinguishable. There, the Board exercised its discretion to deny institution of the earlier petitions under 35 U.S.C. § 314(a) based on *Fintiv*. *Code200*, Paper 18, 2 n.3. Here, the Board did not discretionarily deny the previous petition, but rather denied it because Petitioner failed to carry its burden of demonstrating a threshold requirement for post-grant review, namely that the patent is eligible for post-grant review. *See* PGR Dec. 9–10, 24.

In evaluating the eligibility issue, the Board thoroughly addressed the merits of Petitioner’s arguments that the ’284 patent claims lack adequate written description and enablement support in the priority applications such that the claims are not entitled to any of the pre-2013 priority dates listed on the face of the patent. *See* PGR Dec. 10–24. This issue extensively overlapped with Petitioner’s grounds of unpatentability based on lack of written description and enablement in the post-grant petition, which Petitioner included together with prior art challenges. *See* PGR Dec. 6–7. As such, contrary to Petitioner’s argument, it did have “the *opportunity* to pursue a decision on the merits,” but failed to carry its burden to secure post-grant review. Prelim. Reply 1 (emphasis added).

Because the post-grant review was filed by Petitioner and challenged the same claims at issue here, this factor favors exercising our discretion to deny institution.

2. *Whether at the time of filing the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it*

The present *inter partes* review petition cites five prior art references. *See supra* Section I.D. Patent Owner persuasively demonstrates, and Petitioner does not dispute, that Petitioner knew of four of these references when it filed the post-grant review petition. Prelim. Resp. 14 (discussing Truitt, Wright, Mumford, and Dong).

The fifth reference, Kumar, is a U.S. Patent Application that published on December 26, 2002. *See* Ex. 1008, code (43). Petitioner does not sufficiently explain when it learned of Kumar or why it could not have found Kumar prior to filing the post-grant review petition. *See General Plastic*, Paper 19, 20 (“The relevant issue under factor 2 is . . . whether [the prior art references] could have been found with reasonable diligence.”). Petitioner asserts that in preparing its first petition, it “relied on a different priority date and therefore had not yet discovered Kumar.” Prelim. Resp. 3. This argument is unavailing, because in connection with the post-grant review, Petitioner asserted a priority date in 2013 or later. *See* PGR Dec. 10. As such, in preparing the post-grant review petition, *more* prior art was available to Petitioner than is available here, where it uses a 2005 priority date. *See* Pet. 8. Moreover, Kumar published in 2002, which is long before the 2013 priority date Petitioner asserted in the post-grant review.

Based on the circumstances here, we find that at the time of filing of the first petition, Petitioner knew of the prior art asserted in this Petition, or should have known of it. Accordingly, this factor favors exercising our discretion to deny institution.

3. *Whether at the time of filing the second petition the petitioner had already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition*

There can be no dispute that prior to filing the present Petition on November 15, 2024, Petitioner had already received both Patent Owner's Preliminary Response in the post-grant review (filed March 29, 2024) and the Board's decision in that post-grant review (issued June 24, 2024). Petitioner had also received Patent Owner's responses to Petitioner's invalidity contentions in the district court (served August 5, 2024), which contained Patent Owner's arguments regarding the prior art references Petitioner relied on in the post-grant review petition. *See* Prelim. Resp. 15–16.

Petitioner discounts this timing, contending there is no “road-mapping.” Prelim. Reply 2 (citing *Code200*, Paper 18, 5 (“Where the first-filed petition under factor 1 was discretionarily denied or otherwise 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.”)). According to Petitioner, because the post-grant petition “was not evaluated on the merits,” Petitioner does not “cure ‘a substantive and material defect’ with the prior art in its first petition” and instead “relies on entirely different grounds, using entirely different prior art, based on an entirely different priority date.” *Id.* at 3 (quoting *General Plastic*, Paper 19, 14).

We are not persuaded by Petitioner's arguments, which construe the “road-mapping” consideration too narrowly. We instead agree with Patent Owner that the record shows evidence of road-mapping. *See* Prelim. Resp.

14. Specifically, at the time of filing the instant Petition, Petitioner had already received Patent Owner's arguments and the Board's institution decision, which substantively analyzed Petitioner's written description and enablement theories in the context of post-grant review eligibility. In response to these documents, Petitioner "chose to abandon" its original unpatentability theories, including its theory on the correct priority date for the '284 patent claims, in favor of entirely new unpatentability theories. *Id.* at 16. This is the concern expressed in *General Plastic*, which recognizes that "[m]ultiple, staggered petitions challenging the same patent and same claims raise the potential for abuse" by allowing "petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review." *General Plastic*, Paper 19, 17.

Moreover, it is clear from the record that Petitioner tailored its arguments in the present proceeding based on what it learned from the post-grant review. Petitioner and its declarants expressly cite and rely on alleged admissions Patent Owner made in its Preliminary Response in PGR2024-00012 numerous times in the present Petition. *See, e.g.*, Pet. 28–30 (citing Ex. 1010, Patent Owner's Preliminary Response in PGR2024-00012); Ex. 1003 (Kirkness Decl.) ¶¶ 169, 176, 179, 181, 182 (same).

Because Petitioner had received Patent Owner's Preliminary Response and our decision denying institution in the post-grant review before filing the instant Petition, this factor favors exercising our discretion to deny institution.

4. The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition

As discussed in connection with factor 2, Petitioner knew of four of the five references used in the instant Petition long before filing the instant Petition. Petitioner “has not stated when it learned of the Kumar reference,” but Kumar has been “publicly available since 2002.” Prelim. Resp. 16; *see also* Prelim. Sur-reply 4.

Under the circumstances presented here, we agree with Patent Owner that this factor favors exercising our discretion to deny institution.

5. Whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent

Petitioner asserts that “[t]o preserve the resources of the Board and parties, Petitioner reasonably waited until its request for rehearing [in the post-grant review] was denied on October 17, 2024, before preparing and filing the instant Petition less than a month later on November 15, 2024. Prelim. Reply 3. Petitioner asserts that “th[is] timing demonstrates Petitioner acted reasonably.” *Id.* at 4.

We are not persuaded. We instead agree with Patent Owner that “Petitioner’s delay was inefficient, unnecessary, and allowed Petitioner to tailor its obviousness grounds based on Patent Owner’s responses to its invalidity contentions.” Prelim. Sur-reply 4.

Petitioner contends that “another petition (while the first was still pending) would have run directly afoul of *General Plastic*.” Prelim. Reply 3. Petitioner does not provide a citation to *General Plastic* to support this assertion, and indeed, that case expressly recognizes that “that there may

be circumstances where multiple petitions by the same petitioner against the same claims of a patent should be permitted.” *General Plastic*, Paper 19, 18. The Board’s Trial Practice Guide⁹ indicates that one such circumstance is “when there is a dispute about priority date requiring arguments under multiple prior art references”—i.e., the circumstance presented here. CTPG 59; Prelim. Sur-reply 4. Thus, Petitioner’s argument is inconsistent with *General Plastic* and Board guidance.

Petitioner suggests that filing two petitions at or around the same time was not an option “because the patent was deemed to be an AIA patent at the time of filing the first petition,” such that “the statutory window for filing an IPR petition was not yet open.” Prelim. Reply 3. This argument is unavailing. First, during prosecution, the Office deemed the ’284 patent to be a pre-AIA patent; it was Petitioner’s choice to nevertheless “deem” it an AIA patent. *See, e.g.*, Ex. 1002, 99, 160. Second, Petitioner filed the post-grant review petition on the penultimate day of the nine-month window for filing a post-grant review. *See* 35 U.S.C. § 321(c) (“A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent.”);¹⁰ Prelim. Sur-reply 4. Thus, even if the ’284 patent were an AIA patent, the window to file an *inter partes* review opened the day after Petitioner filed the post-grant review petition. *See* 35 U.S.C. § 311(c). This means that Petitioner could have filed the instant

⁹ Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

¹⁰ The ’284 patent issued on March 14, 2023. Ex. 1001, code (45). Petitioner filed the post-grant review petition in PGR2024-00012 on December 13, 2023.

Petition much earlier, and before receiving Patent Owner’s preliminary response and our institution decision in the post-grant review.

Under the circumstances presented here, we find that this factor favors exercising our discretion to deny institution.

6. The finite resources of the Board

Neither party presents persuasive arguments on this factor. Patent Owner argues that resources spent by the Board on the Petition “may duplicate various district court efforts.” Prelim. Resp. 17. This argument is unavailing, because the Ohio case is stayed. *See id.* (acknowledging stay).

Petitioner argues that going forward on unpatentability issues here instead of in the Ohio case is “the best and most efficient use of the Board’s resources” given “the Board’s specialized knowledge,” as compared to the Ohio court’s “limited number of patent cases.” Prelim. Reply 4. This argument is unavailing, as it ignores Petitioner’s prior petition. We find that in this case the Board’s resources would be most fairly expended on first petitions rather than on a follow-on petition that has been tailored to overcome deficiencies identified in Petitioner’s first petition. As stated in *General Plastic*, “multiple, staggered petition filings, such as those here, are an inefficient use of the *inter partes* review process and the Board’s resources.” *General Plastic*, Paper 19, 21.

Under these circumstances, we find that this factor favors exercising our discretion to deny institution.

7. The requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review

Patent Owner argues that “there is no reason to speculate that this case presents any issues that jeopardize the Board’s ability to issue a final

determination within one year.” Prelim. Resp. 17. Petitioner notes this factor but does not specifically address the Board’s ability to timely issue a final determination. *See* Prelim. Reply 4.

We know of no reason why we could not meet the requirement of 35 U.S.C. § 316(a)(11) to issue a final determination within one year after institution. Accordingly, we determine that this factor is neutral to the analysis.

8. *Summary*

We have considered the circumstances and facts before us in view of the *General Plastic* factors. Six of the factors (factors 1–6) weigh in favor of discretionarily denying institution; one factor (factor 7) is neutral; and no factors weigh against discretionary denial. Accordingly, we determine that the circumstances presented here weigh in favor of using our discretion under § 314(a) to deny institution of *inter partes* review.

III. REMAINING ISSUES

Because we deny the Petition under 35 U.S.C. § 314(a) and *General Plastic*, we need not reach the parties’ additional arguments regarding discretionary denial or the merits of Petitioner’s unpatentability challenges.

IV. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny *inter partes* review in this proceeding based on 35 U.S.C. § 314(a) and *General Plastic*.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2025-00157
Patent 11,602,284 B1

For PETITIONER:

Lisa Nguyen
David Tennant
Grace Wang
PAUL HASTINGS LLP
lisanguyen@paulhastings.com
davidtennant@paulhastings.com
gracewang@paulhastings.com

For PATENT OWNER:

James Hannah
Jeffrey Price
Jenna Fuller
Jeffrey Eng
KRAMER LEVIN NAFTALIS & FRANKEL
jhannah@kramerlevin.com
jprice@kramerlevin.com
jfuller@kramerlevin.com
jeng@kramerlevin.com