

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,
Patent Owner.

Case IPR2025-00158
U.S. Patent No. 11,690,512

**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Intentionally Omitted
2002	Intentionally Omitted
2003	Intentionally Omitted
2004	Excerpts of Plaintiff and Counterclaim Defendant ResMed Corp.'s Initial Invalidity and Unenforceability Contentions cover pleading, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB (N.D. Ohio), served on July 15, 2024
2005	Excerpts of Defendant ResMed Inc.'s Initial Invalidity Contentions cover pleading from <i>Cleveland Med. Devices, Inc. v. ResMed, Inc.</i> , No. 22-cv-00794-JLH (D. Del.) (the "Delaware Case"), served on February 21, 2023
2006	Excerpts of Plaintiff ResMed Corp.'s Response and Affirmative Defenses to Defendant's Counterclaims for Patent Infringement, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 66 (N.D. Ohio), filed on March 18, 2024
2007	Excerpts of Declaration of James Hannah in Support of Defendant CleveMed's Opposition to Plaintiff ResMed's Motion for Temporary Stay Pending Mediation, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 87-1 (N.D. Ohio), filed on August 21, 2024
2008	Excerpts of Declaration of Lisa Kobialka in Support of Defendant CleveMed's Opposition to Plaintiff ResMed's Motion to Stay, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 100-1 (N.D. Ohio), filed on January 24, 2025
2009	Excerpts of ResMed Corp.'s Reply in Support of its Motion to Stay, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 101 (N.D. Ohio), filed on January 31, 2025

Patent Owner's Preliminary Response
IPR2025-00158 (U.S. Patent No. 11,690,512)

Exhibit	Description
2010	Excerpts of Defendant Cleveland Medical Devices, Inc.'s Memorandum in Support of its Motion to Dismiss or Transfer, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-00500-TWR-JLB, Dkt. No. 10-1 (S.D. Cal.), filed on June 5, 2023
2011	<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 87-5, Declaration of Hani Kayyali in Support of Patent Owner's Opposition to Motion to Stay Pending Mediation (N.D. Ohio), filed on August 21, 2024
2012	<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 87-6, Excerpts of Petitioner's parent company's (ResMed) Q4 FY2024 Earnings call (N.D. Ohio), filed on August 21, 2024

I. INTRODUCTION

The Board should deny the Petition because the *Fintiv* factors overwhelmingly support denial. Although the co-pending litigation is currently stayed, the very same parties have already expended substantial resources in the case due to Petitioner waiting as long as statutorily allowed to file this Petition. Furthermore, the obviousness issues in this case are nearly identical to those raised in District Court, indicating that Petitioner is unnecessarily multiplying this litigation over the same patent in different venues. Moreover, Petitioner initiated the current dispute by bringing a declaratory judgment action against Patent Owner. Despite bringing this action in District Court, Petitioner then filed this Petition at the last possible moment and successfully pursued a stay of the litigation. Given Petitioner's tactics, the Office should honor Petitioner's original choice of venue for the dispute and prevent its attempts to vexatiously multiply litigation over the same issues concerning the '512 Patent.

The Board should also deny *inter partes* review of the Petition¹ because a person of ordinary skill ("POSITA") would not have been motivated to modify Ciulla (Ex. 1007) with Orbach (Ex. 1008) to reach the Challenged Claims, which

¹ The Petition challenges claims 1-20 (the "Challenged Claims") of U.S. Patent No. 11,690,512 (Ex. 1001, the "'512 Patent").

require software on a cell phone or PDA to receive and re-transmit sleep data to a remote internet site. See '512 Patent at Claim 1. Petitioner concedes that Ciulla does not disclose a cell phone or PDA, and its arguments for modifying Ciulla with Orbach are the product of hindsight. Ciulla's PAP device already performs the function that Petitioner looks to Orbach for, so Petitioner's proposed combination would add redundancy and unnecessary complexity to Ciulla's system.

II. OVERVIEW OF THE '512 PATENT

The '512 Patent discloses and claims a sleep diagnostic test system using cellular data transfer from sleep testing locations. This is done using sensors placed on a subject that record physiological data while that subject sleeps, and transferring that data using cell towers to a remote location for medical analysis.

The '512 Patent involves a portable patient interface box worn by the patient while the patient sleeps along with sensors that are applied to a patient to measure physiologic data. For example, the sensors can include a pulse oximeter, which measures the level of blood oxygenation. '512 Patent at 9:57-10:4. The sensors can also include a pneumotachograph, which converts a measured pressure into an electrical signal to quantify respiratory airflow. *Id.* at 9:27-39.

The data that is collected based on the sensors is processed through the portable, wearable patient interface box. See, e.g., *id.* at 15:33-44. Then, through the use of 2GHz or greater frequencies, the patient data is transmitted to a cell phone

or PDA. *Id.* Following this transmission, the data is again transmitted, but this time to a remote location for further analysis, which includes drawing attention to physiological events in the data indicative of a sleeping disorder. *Id.*

III. THE BOARD SHOULD DENY THE PETITION UNDER *FINTIV*

The Board should deny institution under § 314(a) because 1) this Petition is redundant of the District Court litigation that Petitioner filed in 2023 that involves the '512 Patent, and 2) Petitioner delayed filing this Petition despite relying on long-known references and arguments it has repeated in multiple forums, which amounts to an abuse of the patent system. *See* 35 U.S.C. § 314(a) (institution of an IPR is discretionary).

By way of background, on March 20, 2023, Petitioner filed a Complaint seeking declaratory judgment of non-infringement of one of Patent Owner's patents that is unrelated to the '512 Patent: U.S. Patent No. 11,602,284 (the "'284 Patent"). *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 23-cv-00500-TWR-JLB (S.D. Cal) (the "San Diego Case"). After Patent Owner unsuccessfully sought to dismiss the declaratory judgment action, the case was transferred to Ohio. Ex. 2010 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 3:23-cv-00500-TWR-JLB, Dkt. No. 10-1 (Motion to Dismiss or Complaint or Transfer)) at 1-2, 5-8; *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB (N.D. Ohio) (the "Ohio Case"). When Patent Owner was unable to dismiss Petitioner's declaratory

judgment action, it was required to assert any counterclaims of infringement. *See* Fed. R. Civ. P. 13(a) (counterclaims arising out of the same subject matter are compulsory). Patent Owner also assessed at that time what other patents would be relevant to avoid creating further parallel proceedings. This included the recently-issued '512 Patent and certain additional patents that had recently issued or issued during the pendency of the case.

Petitioner responded to Patent Owner's counterclaims of infringement, including infringement of the '512 Patent, with voluminous invalidity contentions that cited the same Ciulla and Orbach references used in this Petition. *See, e.g.*, Ex. 2004 (7/15/2024 Ohio Case Invalidity Contentions Cover) at 66, 70. Not only did Petitioner wait to submit this Petition for 4 months after receiving Patent Owner's validity contentions on August 5, 2024, but Petitioner had already known about these references—particularly Ciulla—for much longer. *See infra*, Factor 3. As a result of Petitioner's delay, the parties expended significant resources in the Ohio Case. *Id.*

The purpose of the *Fintiv* analysis is to “take[] a holistic view of whether efficiency and the integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) (precedential) (discussing purpose of discretionary denial analysis). Here, a holistic view of Petitioner's actions reveal dilatory tactics and

overlapping arguments across multiple forums, which have been staggered so as to maximize the amount of investment required of Patent Owner. Patent Owner is a small company, in contrast to Petitioner, which is part of a large, publicly-traded parent company. Ex. 2011 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 87-5 (Declaration of Hani Kayyali in Support of Patent Owner's Opposition to Motion to Stay Pending Mediation)) at ¶ 5 (Patent Owner's CEO confirming Patent Owner has under 30 employees); Ex. 2012 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 87-6) at 4 (Petitioner's parent company's earnings call showing billions in revenue and about 10,000 employees). Such tactics weigh in favor of discretionary denial under *Fintiv* Factors 3 through 6, as described in detail below.

A. *Fintiv* Factors 1 and 2 Are Outweighed by Other Considerations

Factors 3 through 6 so strongly support denial in this case that they outweigh the impact of Factors 1 and 2 relating to whether a stay is likely and when a trial is likely. See *Fintiv*, Paper 11 at 5-16 (setting forth six factors for discretionary denial). Although the Ohio Case has been stayed pending the outcome of the IPR petitions and no trial date is set, these considerations represent only two “non-dispositive factors,” while the Board must weigh all factors “as part of a balanced assessment of all relevant circumstances of the case, including the merits.” *Id.* at 5 (internal

quotations and citation omitted). Upon such an assessment, discretionary denial is appropriate.

B. *Fintiv* Factor 3 Supports Denial Because Petitioner Unreasonably Delayed its Filing and the Parties Have Substantially Invested in Parallel Litigation

Fintiv Factor 3 relates to both the timing of the Petition and the degree of investment by the parties and the District Court in any parallel proceeding. *Fintiv*, Paper 11 at 9-12. Here, Petitioner inexcusably delayed filing its Petition while pushing the Ohio Case forward. Patent Owner respectfully requests the Board consider the full context of the dispute between the parties as described below, which has resulted in repetitious validity challenges across multiple venues. For these reasons, Factor 3 weighs in favor of discretionary denial.

1. The Parties Have Invested Years in Litigation Proceedings

Some history of the proceedings between the parties provides context to the Factor 3 analysis, as the parties have invested much more time and resources into their patent dispute than in the Ohio Case and beyond. Patent Owner, Petitioner, and Petitioner's parent company, ResMed Inc., have been embroiled in litigation since June 16, 2022, when Patent Owner first asserted patent infringement against Petitioner's parent in the United States District Court for the District of Delaware. *Cleveland Med. Devices, Inc. v. ResMed, Inc.*, No. 22-794-JLH (D. Del.) (the

“Delaware Case”). The Delaware Case is still pending and involves U.S. Patent No. 10,076,269 (the “’269 Patent”), among others in the home sleep testing field.

Petitioner has been pursuing validity challenges against Patent Owner's patents for years, and the parties and multiple tribunals have committed significant resources to litigating these disputes. For example, Petitioner assisted its parent in obtaining a stay in that case by filing an IPR petition against the '269 Patent. *See ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. IPR2023-00565, Paper 1 at 1 (P.T.A.B. Mar. 22, 2023) (identifying parent company ResMed Inc. as a real-party-in-interest). Notwithstanding an initial discretionary denial due to the advanced stage of the Delaware Case (*id.*, Paper 13 (P.T.A.B. Sept. 25, 2023)), the Director granted review and vacated the institution decision, and the Board ultimately instituted trial on the '269 Patent in view of Petitioner's post-vacatur *Sotera* stipulation. *Id.*, Paper 15 (P.T.A.B. Nov. 16, 2023), Paper 23 (P.T.A.B. May 6, 2024).

Around the same time that it filed the IPR petition against the '269 Patent, Petitioner multiplied the proceedings among the parties by filing a declaratory judgment action against the '284 Patent, an unsuccessful post-grant review petition against the '284 Patent followed by a petition for *inter partes* review, the instant Petition against the '512 Patent, and various other petitions for *inter partes* review and requests for reexamination against other patents in Patent Owner's portfolio.

Given this multitude of proceedings, the majority of which were initiated by Petitioner, the full history of such proceedings should be considered as part of the *Fintiv* analysis.

2. Petitioner Was Aware of the References Asserted in This Petition for Months Before Filing Yet Continued to Pursue the Ohio Case

Petitioner has now filed IPRs against all of the patents and claims asserted as counterclaims in the case that Petitioner initiated nearly two years ago. It did not submit this Petition until December 6, 2024, the last business day of the period within which it could petition for IPR against the '512 Patent. *See* 35 U.S.C. § 315(b) (permitting IPR petitions only within 1 year of an allegation of infringement).

Petitioner, therefore, pursued the Ohio Case for the maximum possible amount of time before filing this Petition, despite that this Petition against the '512 Patent uses references Petitioner had already known about for at least 5 months (as to Orbach) and up to nearly 2 years (as to Ciulla) at the time of filing. The Board has acknowledged that “notwithstanding that a [challenger] has one year to file a petition, it may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition at the Office.” *Fintiv*, Paper 11 at 11. In particular, delays in filing the Petition weigh in favor of denial where the petitioner is “aware or could have reasonably been aware

of the prior art asserted in the challenges set forth in the instant proceeding.” *Next Caller Inc. v. TRUSTID, Inc.*, No. IPR2019-00961, Paper 10 at 15-16 (P.T.A.B. Oct. 16, 2019) (delay in filing petition weighed in favor of discretionary denial as petitioner could have filed the petition concurrently with another petition asserting the same art). In this instance, because Petitioner's last-minute Petition relies heavily on art long known to Petitioner, Factor 3 weighs in favor of denial.

Petitioner was well-aware of the primary reference in this Petition—Ciulla—as long as almost 2 years before filing this Petition. On February 21, 2023, Petitioner's parent company, ResMed Inc., asserted Ciulla as a primary reference against six of Patent Owner's patents in the home sleep testing field in the Delaware Case. *See, e.g.*, Ex. 2005 (2/21/2023 Delaware Case Invalidity Contentions Cover) at 10. Petitioner should have known from an early stage of Ciulla's alleged relevance to patents in the home sleep testing field, such as the '512 Patent. Indeed, Ciulla was cited in the prosecution history for the '512 Patent, and thus should have been known to Petitioner at least upon its investigation of the patent. Ex. 1002 (4/28/2023 Information Disclosure Statement) at 184 (showing examiner's confirmation that “all references considered except where lined through” in the footer with examiner's initials).

Furthermore, Petitioner asserted Ciulla on March 18, 2024, which was about 9 months before this Petition, when it served its Response and Affirmative Defenses

to Patent Owner's Counterclaims in the Ohio Case. At that time, Petitioner pled ***all*** allegations from its invalidity contentions served in the Delaware Case as purported bases for invalidity in the Ohio Case. *See, e.g.,* Ex. 2006 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 66) at ¶ 149 (N.D. Ohio, Mar. 18, 2024). Petitioner expressly alleged invalidity based on Ciulla in its Affirmative Defense. *Id.* In this way, Petitioner sought to recycle hundreds, if not thousands, of pages of charts and contentions from the Delaware Case into the Ohio Case—and has now further recycled some of that material here. Ex. 2005 (2/21/2023 Delaware Case Invalidity Contentions Cover) at 10.

Then, about 5 months prior to filing this Petition, on July 15, 2024, Petitioner asserted Ciulla and Orbach against the '512 Patent in its invalidity contentions in the Ohio Case. *See, e.g.,* Ex. 2004 (7/15/2024 Ohio Case Invalidity Contentions Cover) at 66. Thus, Petitioner knew or at least should have been aware much earlier of the positions it has now taken, months later, in this delayed Petition. *See, e.g., Next Caller*, Paper 10 at 15-16.

That Petitioner added a few other references for the first time is of no moment, because the combinations used need not be identical between parallel proceedings if there is nonetheless “substantial overlap.” *Apple Inc. v. Optis Cellular Tech. LLC*, No. IPR2020-00465, Paper 13 at 20-21 (P.T.A.B. Sept. 17, 2020) (factor 4 favored discretionary denial as “substantial overlap of issues concerning the prior art”

existed, because even though “the combinations of four references” Petitioner used in the District Court and in the petition differed, “two of the references, including the primary reference [], are the same in both combinations”). Indeed, every ground in the Petition requires Ciulla as a primary reference in addition to requiring Orbach, even though these are the two references Petitioner has known about the longest. Paper 1 (“Pet.”) at 2-3. Petitioner’s allegations are not somehow newly discovered simply by virtue of attempting to allege invalidity using various permutations of Ciulla and Orbach alone or cobbled together with a few others. Thus, Petitioner’s inclusion of a few references that were not included in the Ohio Case does not justify its delay.

Where, as here, the evidence shows that the petitioner failed to promptly file its petition “at or around the same time that the patent owner responds to the petitioner’s invalidity contentions, or [] if the petitioner cannot explain the delay in filing its petition,” Factor 3 favors exercising discretionary denial. *Fintiv*, Paper 11 at 11-12. In this case, both issues are present: Petitioner not only waited 4 months from Patent Owner’s validity contentions to file this Petition, but waited many months before deciding to pursue overlapping validity challenges to the ’512 Patent before the Board. Petitioner has not offered any excuse for its delay; nor can it, given that it largely repurposed prior allegations. See Pet. at 79 (making no meaningful attempt to address *Fintiv*).

3. Petitioner Continued to Litigate the Ohio Case While It Ran Out the Clock for Filing IPRs

Though Petitioner was already aware of the bases for its IPR petition, it forged ahead in the Ohio Case with substantial discovery and service of voluminous invalidity contentions, thus imposing unfair cost on Patent Owner. *See Fintiv*, Paper 11 at 11.

Discovery was in full swing before Petitioner filed this Petition. For example, Petitioner served 14 interrogatories and 52 requests for production on Patent Owner in the Ohio Case. Ex. 2007 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 87-1 (Declaration of James Hannah in Support of Cleveland Medical Devices, Inc.'s Opposition to Motion to Stay Pending Mediation)) at ¶¶ 2-3 (explaining discovery status as of August 2024 in responding to Petitioner's first request to stay the Ohio Case pending a mediation); Ex. 2008 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 100-1 (Declaration of Lisa Kobialka in Support of Cleveland Medical Devices, Inc.'s Opposition to Motion to Stay)) at ¶ 4 (updating discovery status in responding to Petitioner's second request for a stay, this time pending IPRs). Patent Owner produced over 6,100 pages of documents in response. Ex. 2007 at ¶ 3; Ex. 2008 at ¶ 4. Petitioner itself produced over 6,500 pages of documents in response to Patent Owner's requests. Ex. 2007 at ¶ 3; Ex. 2008 at ¶ 4. Moreover, before Petitioner filed its submission here, the parties completed claim construction briefing that

cumulatively included over 90 pages of discussion, dozens of pages of detailed declarations from three different experts, and the parties' joint submission of a prehearing statement.

As the Board has noted, the weight to accord a lack of a claim construction order in a parallel District Court litigation may vary depending on an individual court's procedures. *Fintiv*, Paper 11 at 10, n.17. Here, although Petitioner obtained a stay just before the District Court's claim construction hearing, the parties had already completed substantial work in the case under the Court's procedures permitting discovery ahead of claim construction.

Petitioner also imposed substantial costs on Patent Owner with its invalidity contentions in the Ohio Case, which comprised 41 claim charts and more than 3,000 pages. Patent Owner was obligated to respond to these vague and bloated allegations with its own validity contentions, which it served in August 2024. The overall investment of the parties into the District Court litigation is especially significant when also considering the Delaware Case, in which, for example, the parties produced cumulatively hundreds of thousands of pages of documents.

In sum, the Board should find that these timing considerations and a holistic view of the parties' years of investment in parallel proceedings favor discretionary denial.

C. *Fintiv* Factor 4 Supports Denial Because Petitioner Presents Arguments that Significantly Overlap with Arguments Presented to the District Court

Significant overlap exists between this Petition and the Ohio Case because “the same or substantially the same claims, grounds, arguments, and evidence” presented in the Ohio Case are reiterated here, which favors denying the Petition. *Fintiv*, Paper 11 at 12. Petitioner conceded that its Petition involves both overlapping arguments and art. *See* Ex. 2009 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 101) at 9. Moreover, Petitioner has asserted grounds against all claims of the ’512 Patent that are asserted in the Ohio Case, a fact that supports denial. *See Fintiv*, Paper 11 at 13 (discussing the import of whether all or only some challenged claims are at issue in a parallel proceeding).

All of Petitioner’s grounds alleged in the Petition require Ciulla and Orbach. Pet. at 2-3. As explained above in connection with Factor 3, Ciulla and Orbach were both already asserted as references against the ’512 Patent in the Ohio Case, including an attempt to assert Orbach—which every ground in this Petition requires—as a primary reference. Ex. 2004 (7/15/2024 Invalidity Contentions Cover) at 70. Thus, substantial overlap exists between the Ohio Case and this proceeding.

Petitioner has made no case-narrowing stipulations (e.g., a *Sotera*-type stipulation) that might mitigate the overlap in issues. While the District Court's stay may somewhat mitigate such concerns, nothing prevents Petitioner from arguing it should be permitted to use the exact same alleged prior art asserted here in some different manner before the District Court. When Patent Owner raised this concern in its Opposition to Petitioner's Motion to Stay the Ohio Case and suggested Petitioner should stipulate to a broader estoppel effect from the IPRs in light of its thousands of pages of invalidity allegations, Petitioner did not offer even a limited stipulation in its reply. *See* Ex. 2009 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 101) at 10. The lack of stipulation means that when the Ohio Case resumes there will still be a risk of duplicative efforts and conflicting results.

D. *Fintiv* Factor 5 Supports Denial Because Petitioner Initiated the Co-Pending Litigation

Petitioner is the counterclaim-defendant in the pending Ohio Case. This factor thus weighs in favor of denying the Petition.

The Board should accord extra weight to this factor because Petitioner is not only the same party in the litigation; rather, Petitioner is the plaintiff that initiated the litigation with a declaratory judgment action of non-infringement against the '284 Patent.

Following Patent Owner's counterclaim of infringement in that case, Petitioner alleged invalidity and served two rounds of voluminous invalidity contentions. Petitioner effectively chose the District Court as its venue for validity challenges by actively litigating validity in that forum for the maximum amount of time possible in lieu of filing this Petition—even though Petitioner already knew of the main references that now form the basis for the Petition. Ultimately, Petitioner waited to file on the last business day that it could, and thus should be held to the choice of forum that it functionally made through its actions, which is litigating the validity of the '512 Patent before the District Court. Thus, this factor should weigh in favor of denying the Petition.

E. *Fintiv* Factor 6 Supports Denial Because Petitioner's Recycled Arguments Lack Merit and Create Intentional Inefficiencies

As described throughout Patent Owner's Preliminary Response, the grounds raised in the Petition lack merit, and certainly do not rise to the level of appearing “particularly strong” for purposes of impacting the *Fintiv* analysis. *Fintiv*, Paper 11 at 14-15. Indeed, these grounds fall well short of even raising “a closer call,” but a close call is all that is required for this factor to favor discretionary denial. *Id.* at 15.

Further, equitable considerations weigh in favor of denying institution. As discussed above in connection with Factors 3 and 4, Petitioner has submitted and resubmitted the same or similar voluminous contentions across multiple forums. Petitioner picked this fight with Patent Owner by filing a declaratory judgment

action on the '284 Patent within days of the '284 Patent's issuance, which Patent Owner unsuccessfully sought to dismiss. Ex. 2010 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 3:23-cv-00500-TWR-JLB, Dkt. No. 10-1 (Motion to Dismiss or Complaint or Transfer)) at 1-2, 5-8. After that, Patent Owner properly brought its counterclaims of infringement. Yet, perhaps to avoid having to litigate Patent Owner's counterclaims along with its own, Petitioner created the potential for inefficiencies between the District Court and the Board by filing this Petition (and multiple others) using overlapping art. Petitioner then sought a remedy for its own actions with a request for a stay, derailing its litigation in favor of trying its arguments here. Petitioner's wave of petitions against the patents asserted in the Ohio Case are unlikely to resolve the litigation, and the court where the parties have been litigating these issues should continue to be the venue for the parties' disputes. This Petition should be rebuffed as harassing and a misuse of the system.

IV. LEVEL OF ORDINARY SKILL IN THE ART

For the purpose of this preliminary proceeding only, Patent Owner applies Petitioner's proposed definition of a POSITA in 2006, as some with "at least a bachelor's degree in mechanical engineering, electrical engineering, computer science, biomedical engineering, or a similar technical field, with at least two years of relevant product design experience working with diagnostic sensor systems and network data systems." Pet. at 8-9.

V. THE CHALLENGED CLAIMS ARE PATENTABLE

A. Ground 1: A POSITA Would Not Have Been Motivated to Wirelessly Transfer Sleep Data from Wearable Device to Cell Phone via a First Wireless Transceiver, and from Cell Phone/PDA to Remote Site Via Cell Towers

The Board should deny institution because Petitioner has not established that it would have been obvious to modify Ciulla's system with Orbach's cellular phone. Ciulla's transceiver is already capable of transferring data to a remote location and has the same type of LCD display screen that would come along with Orbach's cellular phone. Ciulla at ¶ [0103], [0213], [0230]. Petitioner's argument is, therefore, a solution in search of a problem that would add redundancy and unnecessary complexity to Ciulla's system. See Pet. at 9-13.

Petitioner presents three conclusory arguments in support of its motivation to modify Ciulla with Orbach, but each is deficient for the same reason: Ciulla's device is already capable of performing the functions that Orbach's cellular phone performs and do not, therefore, provide any motivation to combine the references in a way that meets the Challenged Claims. Rather, the arguments provide an unnecessary combination that a POSITA would only find through hindsight. *Stodje, Inc. D/B/A Postscript v. Attentive Mobile Inc.*, No. IPR2023-01338, Paper 10 at 11 (P.T.A.B. July 29, 2024) (the Board denied the petitioner's request for rehearing where the Board found that the "[p]etitioner does not adequately explain how adding Khanna's deeplinking technique improves Haggerty's method, which method already provides

a link in an advertisement . . .’); *Markforged Inc. v. Continuous Composites, Inc.*, No. IPR2022-00548, Paper 8 at 14 (P.T.A.B. Sept. 9, 2022) (the Board denied the petition because the “petitioner did not adequately explain why the petitioner because the “[p]etitioner does not adequately explain why modifying Wohrl’s process to use an anchor point and nip roll 11 to pull the fiber strand would have been an improvement over what Wohrl already provides”); *Sony Corp. v. Fujifilm Corp.*, No. IPR2018-01751, Paper 14 at 11 (P.T.A.B. Apr. 12, 2019) (the Board denied the petitioner because the “[p]etitioner does not explain adequately why modifying Ejiri . . . would have been an improvement on what Ejiri already provides”). However, none of these three arguments provide why a POSITA would be motivated to combine Ciulla and Orbach other than hindsight bias.

First, Petitioner’s argument that “Orbach’s communication techniques . . . would have enabled continuous, real-time data communication” (Pet. at 12) does not provide motivation to modify Ciulla because Ciulla’s system communicates the user’s data to a remote location in real time:

The data recorder could be either hard-wired to the main back module, through a jack connection when data would be downloaded, or alternately, could be **wirelessly connected to the main back module, so that date [sic] could be reported in real time and displayed in real time at a location spatially removed from the main back module**, such as in a room next door from the room in which the patient is sleeping.

Ciulla at ¶ [0125] (emphasis added); *see also id.* at ¶ [0213] (The device “can be designed to transmit the multiple sensors’ outputs wirelessly (RF, BlueTooth, WAN, LAN, IT Ethernet Modem or other) along with video cam images of the sleeping patient.”).

Furthermore, Ciulla provides immediate real-time responses to detected apnea events using its interactive robot, which detects and immediately interrupts sleep disorder breathing events without the need to transmit any information outside of its system of input and output sensors. *See id.* at ¶¶ [0137-0138], [0125] (“Others of the sensors output devices would likely receive and/or transmit (as appropriate) their signals with the main back module for a wireless connection, due to the fact that [the sensors] are not proximately located to the main back module.”). This technique requires treating the patient in the small window between the onset of symptoms such as a snore, hypopnea, or apnea and the actual sleep disordered breathing event such as hypoxia. *See Ciulla* at ¶¶ [0170], [0178]-[0179], [0216], [0233].

Ciulla uses a cues and stimulus train system (“CAST”) system, instead of a PDA program like Orbach’s, to accomplish its principal operation. *See id.* at ¶ [0139]. The CAST system interrupts the patient’s sleep after the detection of sleep apnea events with various stimuli. *See id.* at ¶¶ [0123], [0170]. As a result, Ciulla provides “operant and respondent conditioning [during the patient’s wake state] to the patient to help condition the patient to both decrease the number of sleep

disordered breathing events, and to decrease the severity of the sleep disordered breathing events that the [patient] does encounter.” *Id.* at ¶ [0130].

Petitioner does not explain whether or not this real-time feedback would be jettisoned in favor of first communicating data to a remote internet site, waiting for a physician to react to the data. *See* Pet. at 12 (citing Ex. 1008 at 13:28-14:2, 17:19-20, 25:27-26:2, 38:24-27). In any event, Petitioner’s proposed combination could not provide feedback any faster than the immediate interventions Ciulla’s system is already capable of.

Second, Ciulla’s treatment device already includes the LCD screen that Petitioner looks to Orbach for. *See* Ciulla at ¶¶ [0192], [0221], [0232]. Ciulla **also** discloses a wireless transceiver for transmitting patient data to a remote location. *See id.* at ¶ [0230]. As a result, a POSITA would not be motivated to include any other devices when creating a home sleep testing device using Ciulla. Thus, although Orbach discloses a cellular telephone that can provide “a visual or pictorial representation of the physiological condition being treated which changes in appearance in a fashion corresponding to the physiological change desired in the patient” (Orbach at 2:1-4), Ciulla’s main module already includes an “LCD display . . . [that] displays alerts of poorer sleep and breathing, and/or positive statements when the data analysis shows improvements.” Ciulla at ¶ [0192]; *see* Orbach at 4:21-24.

Third, Petitioner's argument that the "combination would have promoted greater patient engagement" is conclusory and fails to grapple with the fact that Ciulla's system already discloses ability to transmit data to a remote location and an LCD screen. *See* Pet. at 12, 28-30. Thus, the "advantages" provided by Orbach are already incorporated in Ciulla, and the inclusion of Orbach is unnecessary. Rather, the inclusion of Orbach is Petitioner's attempt to rely on hindsight bias to fill the holes Ciulla cannot fill in the '512 Patent.

B. Ground 2: The Challenged Claims are Patentable over Ciulla in View of Orbach and Nagai

Petitioner relies on Nagai (Ex 1010) only for claim limitation of "hardwiring or releasably connect[ing] a pulse oximeter for [1.b.iii.C] and [1.c.iii]." Pet. at 67 (emphasis omitted). Accordingly, Nagai does not resolve the deficiencies noted above. Specifically, the incorporation of Nagai does not change the Ciulla and Orbach combination as it relates to the unnecessary introduction of Orbach's mobile unit and Ciulla's lack of need for a cellphone or PDA. Therefore, Ground 2 fails for the same reasons Ground 1 fails.

VI. CONCLUSION

For at least the foregoing reasons, the Board should deny institution.

Patent Owner's Preliminary Response
IPR2025-00158 (U.S. Patent No. 11,690,512)

Respectfully submitted,

Date: March 17, 2025

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 has 5,135 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: March 17, 2025

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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>	March 17, 2025
<i>Manner of service</i>	Electronic Mail (PH-ResMed-CleveMed@paulhastings.com)
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY RESPONSE
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