

HIGHLY CONFIDENTIAL – ATTORNEYS’ EYES ONLY

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

RESMED CORP.,	)	
	)	
<i>Plaintiff / Counterclaim-</i>	)	
<i>Defendant,</i>	)	
	)	
v.	)	C.A. No. 1:23-cv-02221-BMB
	)	
CLEVELAND MEDICAL DEVICES, INC.,	)	
<i>Defendant / Counterclaim</i>	)	
<i>Plaintiff.</i>	)	
	)	
	)	

**PLAINTIFF AND COUNTERCLAIM DEFENDANT RESMED CORP.’S
INITIAL INVALIDITY AND UNENFORCEABILITY CONTENTIONS**

reference included in any combination is not anticipatory in its own right. In particular, ResMed is currently unaware of the extent to which CleveMed will contend that certain limitations of the asserted claims are not disclosed in the art identified by ResMed as anticipatory. To the extent that an issue arises with respect to any such claim limitation, ResMed reserves the right to identify other references and combinations, which may make obvious the addition of the allegedly missing limitation to the disclosed system or method. In addition, ResMed may rely on some references under both 35 U.S.C. § 102 and 35 U.S.C. § 103. It is established law that “a rejection for obviousness under § 103 can be based on a reference which happens to anticipate the claimed subject matter.” *In re Meyer*, 599 F.2d 1026, 1031 (C.C.P.A. 1979).

Furthermore, none of ResMed’s anticipation arguments should be construed as an admission that the disclosed feature in fact practices the claim, and ResMed reserves the right to take the position that the same feature or functionality in the ResMed products accused of infringement do not practice the claims. In many cases, ResMed’s anticipation positions are based on CleveMed’s erroneous infringement allegations. However, if the same functionality is determined to practice the claim(s) in the ResMed products accused of infringement, the same functionality was also present in the prior art.

C. The PAP System Patents

1. Identification of Prior Art

The following prior art patents and published patent applications relate to the invalidity of the asserted claims of the ’921, ’284, ’029 (collectively “the PAP System Patents”). Each of the following may qualify as prior art as of an earlier date than the listed date, *e.g.*, an earlier publication or filing date. ResMed reserves the right to supplement the priority dates for the below listed references as discovery continues.

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Prior Art Patents and Published Applications	Filed Date	Issue/Publication Date	Invalidity Basis
U.S. Patent No. 6,167,258 (“Schmidt”)	10/09/1998	12/26/2000	Obviousness
U.S. Patent No. 6,644,311 (“Truitt”)	12/19/2001	11/11/2003	Obviousness
U.S. Patent Application Publication No. 2004/0129838 (“Lisy”)	1/3/2002	7/8/2004	Obviousness
U.S. Patent No. 8,187,209 (“Giuffrida”)	3/17/2005	5/29/2012	Obviousness
US 6,993,380 (“Modarres”)	6/4/2003	1/31/2006	Obviousness
U.S. Patent Application Publication No. 2016/0193437 (“Bao”)	Aug. 5, 2013	July 7, 2016	Anticipation and/or obviousness
U.S. Patent Application Publication No. 2018/0199882 (“Klee”)	June 19, 2015	July 19, 2018	Obviousness
WO 2021/152526 (“Shouldice”)	Jan. 29, 2021	Aug. 5, 2021	Obviousness
U.S. Patent Application Publication No. 2007/0161913 (“Farrell” or “Farrell-913”)	March 30, 2005	July 12, 2007	Anticipation and/or obviousness
WO 2005/096737 (“Farrell-737”)	3/30/2005	10/20/2005	Obviousness
U.S. Patent Application Publication No. 2007/0155208 (“Pirzada”)	Dec. 30, 2006	July 5, 2007	Obviousness
U.S. Patent No. 5,424,942 (“Dong”)	Aug. 10, 1993	June 13, 1995	Obviousness
U.S. Patent No. 5,704,345 (“Berthon-Jones” or “Berthon-Jones-345”)	11/4/1994	1/6/1998	Obviousness
U.S. Patent No. 6,152,129 (“Berthon-Jones-129”)	8/14/1997	11/28/2000	Obviousness
JP H5-309135 (“Emi”) ²	May 11, 1992	Nov. 22, 1993	Anticipation and/or obviousness

² These contentions rely on certified English translations of the Emi and Toge references, produced at the time of service of these Initial Contentions.

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A POSITA would have thus been motivated to provide additional flexibility by incorporating wireless transmission and a cellular phone.

Accordingly, integrated PAP treatment and diagnostic systems were well known in the art.

E. The '512 Patent

1. Identification of Prior Art

The following prior art patents and published patent applications relate to the invalidity of the asserted claims of the '512 patent. Each of the following may qualify as prior art as of an earlier date than the listed date, e.g., an earlier publication or filing date. ResMed reserves the right to supplement the priority dates for the below listed references as discovery continues.

Prior Art Patents and Published Applications	Filed Date	Issue/Publication Date	Invalidity Basis
United States Patent Application Publication No. 2003/0199945 to Ciulla	02/10/2003	10/23/2003	Obviousness
United States Patent No. 7,967,760 to Lang	04/29/2005	11/09/2006	Obviousness
US 2008/0214903 (“Orbach”)	02/22/2006	09/04/2008	Anticipation and/or obviousness
US 2006/0224051 (“Teller”)	06/23/2000	08/12/2003	Anticipation and/or obviousness
US 2007/0273504 (“Tran”)	05/16/2006	11/29/2007	Anticipation and/or obviousness
US 2004/0106855 (“Brown”)	10/07/2003	06/03/2004	Obviousness
US 2002/0143576 A1 (“Nolvak”)	05/28/2001	10/03/2002	Obviousness
WO 2005/028029 (“Stahmann”)	09/17/2004	03/31/2005	Obviousness
US 2007/055208 (“Pirzada”)	12/30/2006	07/05/2007	Obviousness

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Attached hereto are the following charts setting forth where in the prior art references each element of the asserted claims are found. ResMed reserves the right to supplement these Initial Contentions. For example, ResMed reserves the right to rely on the CleveMed Crystal Monitor 16 and/or 20-S, which are products allegedly marketed and sold by CleveMed.

Exhibit	Description of Charts for '512 patent	Invalidity Theory
F01	ResMed’s Embletta PDS product and related software, including Somnologica	Obviousness (1, 10-17, 19-20)
F02	US 2008/0214903 (“Orbach”)	Anticipation (1, 10-17, 19-20), Obviousness (1, 10-17, 19-20)
F03	US 6,605,038 (“Teller”)	Anticipation (1, 10-17, 19-20), Obviousness (1, 10-17, 19-20)
F04	US 2007/0273504 (“Tran”)	Anticipation (1, 10-17, 19-20), Obviousness (1, 10-17, 19-20)

One of ordinary skill in the art would have understood how to combine the teachings of the prior art references referred to in these Initial Contentions and would have been motivated to pursue such combinations for numerous reasons. For example, all references identified in Exhibits F01-F04 are analogous art because each of them is from the same field of endeavor as the claimed inventions of the '512 patent, collection of physiologic and kinetic data from a subject using an in-home data acquisition system for conducting a sleep analysis. *See, e.g.*, '512 patent at Abstract. One of ordinary skill in the art would have combined particular features of systems, apparatuses, and methods disclosed in certain of the prior art references with other prior art references that do not expressly disclose such particular features because, *e.g.*, (i) the teachings of the references are interrelated and cite each other, (ii) it would have been a simple

IX. PRIOR ART DOCUMENT PRODUCTION

Pursuant to LPR 3.6 and the Scheduling Order, ResMed produces prior art documentation accompanying these invalidity and unenforceability contentions. Some of the produced prior art documents are highly confidential and are being produced on an outside attorneys’ eyes only basis (HIGHLY CONFIDENTIAL – ATTORNEYS’ EYES ONLY) pursuant to the Stipulated Protective Order entered in this matter. (See D.I. 23-2221).

DATED: July 15, 2024

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CERTIFICATE OF SERVICE

I, Angela C. Whitesell, do hereby certify that on this 15th day of July, 2024, the attached

PLAINTIFF AND COUNTERCLAIM DEFENDANT'S INITIAL INVALIDITY AND

UNENFORCEABILITY CONTENTIONS were served upon the following counsel of record

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