

Filed on behalf of: ResMed Corp.

Filed: April 9, 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. IPR2025-00158
U.S. Patent No. 11,690,512

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

TABLE OF CONTENTS

I.	<i>FINTIV</i> SUPPORTS INSTITUTION	1
A.	Factor 1 (stay) Strongly Favors Institution	1
B.	Factor 2 (proximity to trial) Strongly Favors Institution	2
C.	Factor 3 (investment in parallel litigation) Favors Institution	2
D.	Factor 4 (overlap) Strongly Favors Institution	4
E.	Factor 5 (same party) Favors Institution	5
F.	Factor 6 (other considerations) Strongly Favors Institution	5

TABLE OF AUTHORITIES**Page(s)****Cases**

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (Mar. 20, 2020)	<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>Motorola Sols., Inc. v. Stellar, LLC</i> , IPR2024-01205, -01206, -01207, -01208, Paper 19 (Mar. 28, 2025)	2
<i>Oticon Medical AB v. Cochlear Limited</i> , IPR2019-00975, Paper 15 (October 16, 2019)	6
<i>ResMed Corp. v. Cleveland Medical Devices, Inc.</i> , No. 1:23-cv-2221, 2025 WL 744610	3
<i>Samsung Elecs. Co. Ltd. v. Dynamics Inc.</i> , IPR2020-00505, Paper 11 (Aug. 12, 2020)	5
<i>Snap, Inc. v. SRK Tech. LLC</i> , IPR2020-00820, Paper 15 (Oct. 21, 2020)	1, 2, 3, 4
<i>Supercell Oy v. Gree, Inc.</i> , PGR2020-00038, Paper 14 (Sept. 3, 2020)	3
<i>Thryv, Inc. v. Click-To-Call Techs., LP</i> , 590 U.S. 45 (2020)	6

Statutes

35 U.S.C. § 315	4, 5
-----------------------	------

Other Authorities

H.R. Rep. No. 112-98, pt. 1 (2011)	6
--	---

I. *FINTIV* SUPPORTS INSTITUTION

Here, where the parallel litigation is already stayed and a trial date has never been scheduled, each and every *Fintiv* factor supports institution and will further the Board's objectives to advance "efficiency, fairness, and the merits." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (Mar. 20, 2020) (precedential). PO's attempts to mischaracterize the facts—such as contorting Petitioner's reasonable decision to wait until mediation failed to file the instant Petition to be prejudicial delay and improperly relying on the Delaware litigation where the '512 Patent is not asserted as "substantial investment"—does not establish otherwise.

A. Factor 1 (stay) Strongly Favors Institution

"A district court stay of the litigation pending resolution of the PTAB trial allays concern about inefficiency and duplication of efforts." *Fintiv*, at 6. "Accordingly, consideration of the first *Fintiv* factor weighs strongly against exercising discretion to deny institution." *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, at 9 (Oct. 21, 2020) (precedential) ("The granting of a stay pending *inter partes* review has weighed strongly against exercising discretion to deny institution under *NHK*."). The Ohio case is stayed pending the outcome of the IPR and the PO concedes to this fact (POPR, 5). The district court decision to defer to the expertise of the PTAB is unsurprising given that N.D. Ohio has had only 8 patent trials since 2008 (according to DocketNavigator).

B. Factor 2 (proximity to trial) Strongly Favors Institution

No trial date has been set in the Ohio case and the PO concedes to this fact (POPR, 5). *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). To the extent PO argues that the Ohio court could lift the stay and schedule a trial date before the FWD, “this amounts to ‘unfounded speculation as to how the court might proceed’” and is entitled to no weight. *Snap*, at 9.

C. Factor 3 (investment in parallel litigation) Favors Institution

The Ohio court has not yet held a *Markman* hearing nor 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). Indeed, the parallel case here is nearly at the exact same stage of litigation as the case in the precedential *Snap* decision, where the Board denied to exercise discretionary denial based on similar facts. *Snap*, at 10 (finding “the District Court proceeding was in its early stages” where “no claim construction orders have issued”).

PO argues that the parties have been litigating for years. POPR, 6-8. But PO points to the Delaware litigation (also now stayed) where the '512 Patent is not asserted, overlooking the plain text of Factor 3: “investment in the *parallel*

proceeding by the court and the parties.” *Fintiv*, at 6 (emphasis added). The Ohio case, not the Delaware case, is the parallel litigation.

PO further argues that Petitioner improperly delayed filing the instant Petition. POPR, 17-23. Not so. First, the district court already rejected this argument. *ResMed Corp. v. Cleveland Medical Devices, Inc.*, No. 1:23-cv-2221, 2025 WL 744610, at *3 (N.D. Ohio March 7, 2025) (“The Court does not find the timing of ResMed's filings suggests it is using delay tactics.”).

Second, Petitioner had good reason to wait to file the petition—the mediation on October 21, 2024. Specifically, Petitioner waited until after participating in good faith in mediation to determine whether PO would drop its infringement claims, which reasonably conserved Board and party resources. *See also Fintiv*, at 11 (“it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding”). Indeed, on September 5, 2024, the Ohio court also stayed the parallel case pending mediation. After mediation failed, Petitioner filed the instant Petition less than two months later on December 6, 2024. *See also Snap*, at 12-13 (“In view of our finding that the parallel District Court proceeding was in an early stage prior to the stay, the timing of the filing of the Petition does not weigh in favor of exercising discretion to deny institution.”); *Supercell Oy v. Gree, Inc.*, PGR2020-00038, Paper 14, at 15 (Sept. 3, 2020) (declining to exercise discretionary denial because only minimal investments

had been made in the parallel proceeding although petition filed late within statutory filing window).

D. Factor 4 (overlap) Strongly Favors Institution

The Ohio case is stayed, thus there is no danger of overlap. *See Snap*, at 16 (“Based ... [in part on] the stay of the parallel District Court proceeding, the considerations of the fourth *Fintiv* factor weigh against exercising discretion to deny institution.”). Even if any challenged claims were to survive, Petitioner would be estopped under 35 U.S.C. § 315 from bringing any invalidity challenge that was raised or reasonably could have been raised during the IPR. Moreover, the Ohio court would significantly benefit from the simplification of issues and the findings of the Board.

PO argues that “Petitioner asserted Ciulla and Orbach against the ’512 Patent in its invalidity contentions in the Ohio Case.” POPR, 10. Again, this is irrelevant because the case is already stayed. But even if it were not, as PO admits (*id.*), Kumar and other references on which Petitioner relies were not included in Petitioner’s invalidity contentions. *Fintiv*, as 12-13 (“if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution.”). Thus, the grounds in the instant Petition are different from those asserted in the parallel litigation.

Finally, PO asserts that Petitioner has not submitted a *Sotera* or similar stipulation. POPR, 15. This argument is nonsensical because Petitioner will be estopped under 35 U.S.C. § 315 after the Board issues its FWD and the Ohio court lifts the stay. Although PO acknowledges that stay will “somewhat mitigate such concerns,” PO claims that “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.” POPR, 15. Notably, PO provides no explanation as to how Petitioner could use the prior art “in some different manner” if the case is stayed. Because there is no explanation.

E. Factor 5 (same party) Favors Institution

The Board will issue the FWD before trial in the Ohio case (if any), which weighs factor 5 in favor of institution. *See 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 argument characterizing Petitioner as the “counterclaim-defendant” and the “plaintiff” (POPR, 15) is contrary to the plain text (and spirit) of Factor 5: “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, at 6.

F. Factor 6 (other considerations) Strongly Favors Institution

First, the Petition presents strong arguments for unpatentability using grounds

based on references that have never been considered by the Office. *See Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11, at 14 (Aug. 12, 2020) (finding case merits favor institution). Second, PO makes baseless allegations that Petitioner is “derailing its litigation” by filing this Petition (POPR, 17), and such arguments have been rejected by the Board. *See Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15, at 23 (October 16, 2019) (precedential) (finding that “Patent Owner’s arguments regarding Petitioner’s intentions or the effect of a Board proceeding are speculative” and declining to deny institution). Third, Petitioner—ResMed Corp.—is a publicly traded U.S. company from San Diego that manufactures lifesaving medical equipment that is critical to public health and the U.S. economy as a whole. 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, Petitioner has a significant patent portfolio of its own, and institution here would further the intent of the AIA to prevent the “diver[sion of] resources from the research and development of inventions.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011). Fourth, this Petition is the sole challenge to the ’512 Patent before the Board—a “crucial fact” favoring institution. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 10, at 6 (May 12, 2020). Last, given its specialized knowledge and familiarity with patent law, the Board is a far more efficient forum to decide invalidity compared to N.D. Ohio,

which only sees about two dozen patent cases per year (based on DocketNavigator).

Accordingly, other considerations overwhelming favor institution.

Dated: April 9, 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 9, 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 9, 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.