

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,
Patent Owner,

IPR2025-00158
Patent 11,690,512 B1

Record of Oral Hearing
Held: March 19, 2026

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

APPEARANCES:

ON BEHALF OF THE PETITIONER:

DAVID TENNANT, ESQ.
LISA NGUYEN, ESQ.
Paul Hastings, LLP
515 South Flower Street, 25th Floor
Los Angeles, CA, 90071
(213) 683-6000
davidtennant@paulhastings.com
gracewang@paulhastings.com

ON BEHALF OF THE PATENT OWNER:

JAMES HANNAH, ESQ.
JEFFREY PRICE, ESQ.
Herbert Smith Freehills Kramer (US) LLP
2000 K St NW
Washington, DC 20006
(202) 775-4500
James.Hannah@hsfkramer.com
Jeffrey.Price@hsfkramer.com

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P R O C E E D I N G S

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JUDGE SNEDDEN: Okay. This is the oral hearing in IPR2025-00158. I'm Judge Snedden, and with me on the panel are Judges Powell and Hardman. And I will begin with appearances starting with Petitioner. Please stand, introduce yourself, and who you have with you today.

MR. TENNANT: I'm David Tennant, I will be arguing on behalf of Petitioner. Same with Dr. Camila Alexander, Ms. Lisa Nguyen from Paul Hastings is with us, and Eugene Coleman is here as well from (INDISCERNIBLE). Thank you.

JUDGE SNEDDEN: Thank you. You're welcome.

MR. HANNAH: Afternoon, James Hannah on behalf of CleveMed. With me is Jeffrey Price.

JUDGE SNEDDEN: Okay. Thank you, Mr. Hannah. Okay. Per our order granting this oral hearing, each party will have 45 minutes of total time to present the arguments. Petitioner opens the hearing with its presentation, and then Patent Owner has the opportunity to respond, and each party may reserve time for rebuttal. And again, we the Judges have electronic versions of each party's slide deck.

And I'll remind the party just to speak the slide number as you move through each presentation today for the benefit of the record. That would be much appreciated. And Mr. Tennant?

MR. TENNANT: Yes.

JUDGE SNEDDEN: When you're ready you may begin. And how much time would you like to reserve for rebuttal?

MR. TENNANT: 10 minutes.

1 JUDGE SNEDDEN: Okay. When you're ready.

2 MR. TENNANT: Good afternoon, Your Honor. My name is
3 David Tennant on behalf of ResMed Corp. I will be presenting arguments
4 along with Dr. Camila Alexander. I want to jump to Slide 2 briefly, and it's
5 the agenda. I will present arguments concerning the overview Claim
6 construction. In prior mapping, Dr. Alexander will present a motivation to
7 combine in reasonable expectation of success.

8 Moving to Slide 4, we have the '512 Patent. And I want to discuss
9 the actual architecture at issue here. It's actually very straightforward, very
10 common knowledge. The '512 Patent is directed to a diagnostic, a wearable
11 diagnostic system. It has a module 16 highlighted in yellow. It receives
12 physiological data from sensors 14 on the patient.

13 That module 16 transmits the signals to a base station 40. The '512
14 Patent characterizes the base station as a cell phone. That cell phone then
15 transmits wirelessly over a cell tower to a viewing station where a physician
16 can view the patient data. This is quite conventional. As you note on the
17 Slide, the priority date is 2006, and it was filed shortly thereafter.

18 However, when we look at the prior art around this time, and I will
19 advance to Slide 5, the first prior art, the primary prior art that the Petitioner
20 relies on is Ciulla. And Ciulla was filed in 2003 from a provisional in 2002.
21 It is 102(b) prior art. It was available many years before the '512 Patent was
22 first filed. Like the '512 Patent, it also has a wearable sensor 44 that is on
23 the patient.

24 And that sensor, the module, let's call it actually, 44 has sensors
25 within it. Those sensors collect physiological data and also transmits
26 wirelessly. Ciulla expressly discloses that the sensor data is transmitted

1 wirelessly. Moving on to Slide 6, our secondary prior art that we rely on is
2 Orbach. Orbach was filed in 2006, and claims priority to a provisional
3 application in 2005.

4 Ciulla and Orbach are very similar in the sense that they both have
5 a wearable sensor on the body. Ciulla I mentioned has a sensor 44 that
6 transmits wirelessly, and so does Orbach. Orbach has a module 110 that
7 transmits wirelessly to the cell phone 120. The cell phone transmits then
8 over cell towers to a base station 130.

9 And the base station forwards the data to a remote server 140. And
10 the remote server then forwards the data to a viewing station 150. This is
11 the prior art that was known at the time. And if we look at the state of the
12 art, and I'll go to Slide 7 for example. Kumar, which my colleague
13 discussed this morning in the hearing, Kumar is directed to a telemedicine
14 system.

15 It collects sleep apnea data and transmits wirelessly to a remote
16 site for reviewing. And this was published in 2002 and filed before that.
17 Moving on to Tran, this is on Slide 8. Tran is also directed to a telemedicine
18 system. So as you can see, in the early 2000s, the state of the art was to
19 network ties or distribute -- or I should say, send physiological data to
20 remote sites for analysis.

21 This was nothing new, and this is what the '512 allegedly tried to
22 cover. We believe it's not novel, and we'll show that today as we've shown
23 in our Papers. Moving on to Slide 9, are the Grounds at issue here today.
24 We've submitted a Grounds in our petition. Obviously, all have been
25 instituted. The only issue here today concerns Claim 1. So we will discuss
26 Claim 1 primarily today.

1 And I want to jump forward to Slide 12. Slide 12 is the undisputed
2 and disputed issues. So in the early 2000s, before 2006, the idea of patient
3 worn diagnostic systems and the ability of those systems to communicate to
4 remote sites was well known as we've shown in Ciulla, Orbach, and the
5 other art. Claim 1 is quite lengthy, but it's actually telling that the only
6 disputes here concern two claim elements.

7 One Claim element is a computer or a second processor at one or
8 more sites. And the second element is the transmission over cell towers to a
9 computer or a second processor. There are no secondary considerations at
10 issue here. So the only two issues that we will discuss or I will discuss are
11 those two claim elements. I want to move on to the Claim construction.

12 I'm on Slide 13, which is just a header slide. The issues that I will
13 discuss today concern Claim construction. But Petitioner has indicated in
14 this petition that we do not believe express constructions are necessary.
15 These constructions or these Claim terms are addressed because Patent
16 Owner did raise positions in their Patent Owner response. And these are our
17 replies.

18 So they're not new in that sense. We do not believe constructions
19 are necessary, and the constructions by Patent Owner should be disregarded.
20 And I'll explain why. The first Claim term I'll discuss is the computer
21 second processor at one or more sites. And what does that mean? And I
22 want to go to Slide 16 first. This captures the dispute between the parties.

23 Petitioner has argued in his Papers that a computer, a second
24 processor at one or more sites confirms that the computer must refer to one
25 or more devices at one or more sites. Patent Owner on the other hand has
26 argued that the term means a single computer interestingly at one or more

1 sites. But if we look to the Claim language, and I'll go back just Slide 15.
2 Slide 15 shows elements 1D, 1F and 1G where this Claim element
3 appears. And we've highlighted a computer or second processor at one or
4 more sites remote to the first location. That's the first instance of the Claim
5 term in element 1D. And then we can see elements 1F and 1G refer back to
6 the same Claim element with their antecedent basis.

7 Petitioner has argued in his Papers and maintains that the Claim is
8 express because it indicates that the computer, the second processor, must be
9 at one or more sites. Element 1F says the same thing. Element 1F also
10 identifies a function of that computer of that second processor. The first
11 function is to analyze output and/or format. That's in element 1F.

12 The second function is to display. That's in element 1G. And I'll
13 address the functions a little bit later, but right now we're going to focus on
14 the location. Moving forward to Slide 17, we know from KCJ Corporation,
15 that the Article A, in a claim term winner, using the transitional phrase
16 comprising, requires the Article A to mean one or more.

17 So putting one or more in the context of the claim language, it's
18 one or more computer or one or more second processor at one or more sites.
19 And this is also confirmed by Baldwin. Patent Owner has argued that
20 Baldwin is in opposite to what we are arguing here, but Baldwin simply
21 indicates that when you have a claim term later in the claim, that is
22 antecedent basis, back to the first instance of the claim term, it carries the
23 singular or plural meaning of that term throughout the claim.

24 So you're consistent. And this is the law, this is a baseline. This is
25 a starting point, it's not the end point. You still have to do your analysis,
26 look at the intrinsic record, look at the prosecution history, which is part of

1 the intrinsic record to confirm that interpretation it's consistent. And it's
2 consistent here. When we go to Slide 18, 18 captures some of the quotations
3 from the '512 Patent.

4 And it's important to note that everywhere the '512 Patent
5 describes a computer, it describes it in the functional sense. It does not
6 describe it in the physical sense. So when you describe something
7 functionally receiving data, sending data, a POSITA is going to understand
8 that a computer is a general generic term, and it can be understood to be
9 distributed in this sense because the Claim expressly indicates that it's at one
10 or more sites.

11 And that's why we believe the proper interpretation is to refer to
12 the computer at one of our sites. Moving on to Slide 19. This is also
13 consistent with the figure 4 of the Patent. Figure 4 of the Patent simply
14 illustrates the computer as a black box, 138. There are no limits -- like the
15 specification, there are no limits to the physical makeup of the computer in
16 the '512 Patent.

17 The '512 Patent illustrates it as a box and labels it computer. Also,
18 it's important to note that the monitor 140 is connected to the computer. The
19 monitor necessarily would have a processor in it. And the monitor is what
20 performs the display. And recall in element 1G of Claim 1, it says the
21 computer or the second processor configured to display.

22 So even the Claim covers the computer and the second processor
23 in the distributed sense. It is at one or more sites as the Claim expressly
24 requires. And so for that reason, we believe it is only appropriate to
25 interpret the Claim as it expressly states that the computer or the second
26 processor is at one or more sites. It's not a single instance of a computer that

1 can be at multiple sites.

2 I'm not quite sure how that would be actually implemented. I want
3 to go on to the next dispute. I'm on Slide 21. The next dispute concerns the
4 disjunctive or, and what that means in the context of a computer or a second
5 processor. I want to go back to Slide 15 because I think it's helpful to show
6 this slide with the oral language. Petitioner has argued that or simply means
7 a computer, or a second processor, or the combination of the two.

8 And the reason why that's important is because there are no limits
9 on what or can mean. You look at this term together a computer or a second
10 processor, one or more sites, you have to read it together. And when you
11 look at the specification, and I'll go forward to Slide 23. 23 is the '512
12 Patent at column 15 line 16 to 48. There it also describes the remote
13 communication station.

14 And it indicates that the remote communication station can be
15 embodied by a computer, and also uses a language that this can be any
16 combination of these devices. So here in the specification, it also makes
17 clear that a computer, a second processor, or any combination of these
18 devices would be the embodiment.

19 So in view of the specification language, we believe it's only
20 appropriate to interpret the “or” to be second computer, computer, or a
21 combination of these devices. And the last element I'll address is over the
22 cell towers to the computer or the second processor.

23 And the reason why Patent Owner is interpreting this Claim, they
24 are arguing that the data sent over the cell towers to the computer, you have
25 to identify the computer where it is first received. Anything downstream
26 from that computer cannot satisfy the Claim. But that's not the proper way

1 to read this Claim term. This Claim term refers to the destination of the
2 data.

3 The destination of the data, once it is sent over to the cell towers is
4 to the computer or the second processor. And I think it's helpful to look at
5 Slide 28. And let's understand what the '512 Patent describes. As you can
6 see, the data is submitted or transmitted over to the cell towers and it's
7 received at element 132. The very first unit to receive it is the computer
8 unit, not even the computer.

9 So when it is sent over to the computer -- over to the cell towers,
10 the computer which can be distributed in one or more sites is the first to
11 receive it. But the second to receive downstream from that is the monitor.
12 So when you transmit data over to the cell towers, it has to be received by
13 the computer. It also has to be received by the monitor.

14 Recall in element 1G, the monitor is the thing that displays the
15 data. So even when you look to their own specification, there has to be
16 -- the data that is sent over to the cell towers is received by multiple entities,
17 the computer and the monitor. And how does this apply to Orbach? I think
18 it's helpful to move on to Slide 31 and look at Orbach next to Figure 4 of the
19 '512 Patent.

20 As you can see, Orbach and the '512 Patent are very similar.
21 Orbach receives data over the cell towers, and that's not a dispute, at the
22 receiving station. In the petition, we've identified the receiving station as the
23 computer. The computer then transmits the data to the viewing station,
24 which is 150. 150 is the part of the computer or second processor that
25 actually does the display.

26 That is consistent with Figure 4 of the '512 Patent. Again, it is first

1 received at the computer and then transmitted to the monitor. So even when
2 you put the embodiments side by side, they line up almost exactly. Moving
3 on to Slide 32, here we'll address element 1F and I spoke to this briefly
4 before. In element 1F, the function of element 1F is for the computer or
5 second processor to analyze output and/or format the sleep data.

6 It uses the disjunctive and/or. And so, to satisfy Element 1F, we
7 have -- we can show any one of those three functions that would satisfy the
8 element. When we look to Orbach, Orbach actually does all three. Orbach
9 analyzes, Orbach outputs, and Orbach formats. So the remote server 140 of
10 Orbach does all three. So there should be no dispute that Orbach satisfies
11 element 1F.

12 Furthermore, the viewing station of Orbach also transmits the
13 signals to the viewing station for analysis. So even the viewing station is
14 capable of performing that analysis. And this is supported by Slide 33. And
15 here we showed the support part A, transferring the second signals to a
16 viewing station for analysis. And so Orbach provides clear disclosure of
17 practicing all the functions of element 1F.

18 The last element to discuss is element 1G. 1G requires that that
19 computer or this second processor also has to display the data. It has to be
20 configured to display the sleep data or the analyzed sleep data. The remote
21 server transmits the sleep data to the viewing station 150 for display. That's
22 not our dispute.

23 We've also shown in the previous slide on Slide 32, how the
24 remote server also performs analysis on the data. And it would be
25 (INDISCERNIBLE) to what I understand, that when the remote server
26 transmits the analyzed data to viewing station, the viewing station would

1 also be configured to display that data. And if there's no further questions,
2 I'll pass it on to my colleague.

3 DR. ALEXANDER: Good afternoon. Starting with Slide 35 here,
4 I am going to discuss the motivation to combine Ciulla with Orbach, and in
5 particular the motivation to add Orbach's cell phone to Ciulla's wearable
6 sleep data acquisition system. So in the next slide, it's Slide 36, let's start
7 with the law. Citing the Supreme Court's landmark decision in KSR v.
8 Teleflex, the Federal Circuit and (INDISCERNIBLE) said that there are two
9 requirements to show motivation to combine.

10 The first is that the secondary reference needs to be a suitable
11 option to address the known problem. And the second is that it would not be
12 beyond the skill of a person of skill in the art to combine the teaching. And
13 the Court next said, nothing more is required in view of KSR. And by
14 nothing more, the Court was clear that demonstrating an improvement was
15 not required.

16 So Patent Owner would have you believe that this case stands for
17 the proposition, that showing an improvement is necessary to demonstrate a
18 motivation to combine. And that is not true. The case simply does not say
19 that. The Court says in the very next paragraph the opposite. There is no
20 categorical requirement to show an improvement.

21 And similarly, here, there was no categorical requirement to show
22 that Orbach cell phone improves Ciulla's system. But regardless, as we will
23 discuss, Orbach does indeed do that. So to the first element, moving to Slide
24 37, Orbach is a suitable option. Both Ciulla and Orbach are directed to
25 physiological monitoring systems that can display and provide for the
26 analysis of sleep data.

1 Both address known challenges with those systems for convenient
2 and effective real-time monitoring analysis and treatment. And in fact,
3 Ciulla says, the goal of its device is to promote better patient compliance and
4 increase active participation of the patient and their sleep disorder treatment.
5 And both offer compatible techniques to communicate and display and
6 analyze the sleep data.

7 But what Ciulla doesn't offer, it doesn't offer specific
8 implementation details for the communications technology it describes,
9 which it describes it very generally. So for instance, if we jump to Slide 45
10 where we have the systems compared side by side, both Ciulla's and
11 Orbach's, you can see that the main module 44, which is worn on the back of
12 the patient in Ciulla, that has an LCD display and a touch screen on it for
13 inputs or an attached input device with a keypad.

14 And then Ciulla also discloses a separate generic data recorder
15 which isn't pictured here or in any of its figures in fact, that can receive and
16 display data in, for instance, the next room. But there's no specific
17 implementation details of how the device would function to do this. So
18 returning to Slide 37.

19 And as you can see here in Ciulla itself, in paragraph 213, it
20 contemplates adding additional outputs and reporting capabilities to better
21 adapt the device for use for medical personnel, presumably for more remote
22 analysis. But again, Ciulla doesn't provide the implementation details to be
23 able to do that.

24 And so, at the time of invention, which is a few years after Ciulla,
25 and a natural progression of the communication technology, a person of skill
26 in the art in 2006 would've looked to Orbach to provide these

1 implementation details for all of Ciulla's suggested functionalities.

2 And Orbach does this with an elegant solution, one convenient
3 device, a cell phone, the patient's cell phone that they already have that
4 wirelessly collects, transmits sleep data to other remote locations in real
5 time. So why would a person of skill in the art choose Orbach's cell phone
6 as a solution?

7 Petitioner has provided a number of notifications in its petition,
8 including continuous real-time data communication, but in a more accessible
9 manner with a cell phone as opposed to a collection device that the patient
10 wears on its back in Ciulla, implementing a common portable device that a
11 patient -- of the patient's cell phone that they already know, that they
12 understand, that they own, which would improve accessibility especially as
13 mobile devices increase in popularity throughout the population.

14 You would have the opportunity to perhaps reduce the form factor
15 of the monitoring device like Ciulla's main module, for which it would be
16 especially important because the patient wears it on their back to sleep. And
17 so no custom device may even be needed which could potentially reduce
18 cost for manufacturing and for maintenance.

19 And finally, as we've spoken about before, using the patient's cell
20 phone would increase patient engagement in managing their own health.
21 They could do so anytime and anywhere and look at their data and see how
22 they're doing, which could improve patient outcomes. And this is in fact one
23 of the goals of Ciulla's own invention that Ciulla mentions.

24 So the first element here is met. Orbach is clearly a suitable
25 option. So as to the second element, moving to Slide 38, implementation of
26 Orbach's cell phone would not have been beyond the skill of a person of skill

1 in the art. It was a known solution in telemedicine systems.

2 As early as 2002, as in Kumar, which my colleague has talked
3 about and we talked about earlier this morning, it disclosed a network
4 telemedicine system that incorporated a patient's cell phone and PDA, to
5 which patient data was communicated and then sent to a remote internet site.

6 And then later in 2006, a Patent to Tran also disclosed a healthcare
7 monitoring system using a wearable appliance as in Ciulla and Orbach that
8 included a cell phone to communicate collected patient data to a remote
9 server over cellular networks. And Tran in fact says that this was
10 particularly useful when the patient is away from their home.

11 Which in fact is one of the motivations that Petitioner said was
12 there for incorporating Orbach's cell phone. So this demonstrates that
13 inventors at the time were motivated to add cell phones to network
14 telemedicine systems even at or before the time of Ciulla. And finally,
15 moving to Slide 39, though it -- we're not -- Petitioner is not required to
16 show an improvement, Orbach's cell phone does indeed improve Ciulla's
17 reporting unit for a number of reasons.

18 First of all, for the motivations that we just discussed, an ability to
19 more easily collect, analyze, transmit, and input data. And then as we see
20 here in this Slide, Orbach has described a diverse number of functions and
21 displays for the cell phone that are not in any way detailed in Ciulla itself,
22 which lacks these sort of implementation details and talks about a generic
23 LCD display that is multi-character and multi-lined to show multi-
24 characterized messages.

25 So in conclusion, I just want to return back to the law here and end
26 by saying that to the extent there were inner disadvantages with the addition

1 of Orbach's cell phone, this is true for all implementations in designs. And
2 the Federal Circuit has said this does not obviate a motion -- a motivation to
3 combine. A person of skill in the art would've well understood these trade-
4 offs.

5 And as evidenced by Orbach, Kumar, and Tran, a person of skill in
6 the art would've still chosen to incorporate a patient's cell phone into
7 biological monitoring systems like those of Ciulla for its many advantages.
8 So next I want to briefly talk about reasonable expectation of success, unless
9 there are any questions about motivation to combine.

10 Okay, so moving on to Slide 41, and then to Slide 42, at the outset
11 Petitioner would like to point out that Patent Owner did not in their Patent
12 Owner's response rebut Petitioner's arguments demonstrating reasonable
13 expectation of success in combining Ciulla with Orbach. So our position is
14 what was stated by the Federal Circuit is that this issue has in fact been
15 waived.

16 But to the extent, Your Honors, do not believe that this issue has
17 been waived, moving on to Slide 43, Petitioner believes that it has
18 demonstrated, clearly demonstrated that a person of skill in the art would've
19 had a reasonable expectation of success in implementing Orbach's cell phone
20 in Ciulla's sleep disorder monitoring systems.

21 In addition to the information or the reasons given in the petition,
22 here our expert Dr. Kirkness discusses how it would've been very
23 straightforward to use a cell phone in the system, and to implement the
24 functionality by downloading the appropriate software to perform them.
25 And this is based just on Orbach's disclosures of doing exactly that.

26 And then again in Slide 44, we see that Ciulla itself suggested the

1 networking of its systems. It contemplates the incorporation of additional
2 reporting capabilities into the system to transmit sensor data to medical
3 practitioners where it talks about different ways to transmit wirelessly. And
4 this makes it analogous to Orbach.

5 In Slide 45, back to Slide 45 here, Orbach discloses the actual
6 details, so for networking, for remote transmissions and analysis, and both
7 contemplates sending instructions or commands from medical personnel to
8 the main module 44 of Ciulla or Orbach's sleep sensor module 110. And
9 Patent Owners' arguments against reasonable expectation of success are
10 contrary to the evidence.

11 Complaints about complexity, ordinary complexity, regulatory
12 uncertainty, technical hurdles, difficult abridging technical fields. These all
13 do not seem to be correct and do not -- would not have precluded or
14 discouraged a person of skill in the art from implementing Orbach's cell
15 phone in Ciulla's monitoring system.

16 The cell phone was a well-known and well understood technology
17 as evidenced by at least Kumar and Tran, which also implemented them in
18 their telemedicine systems. So overall then, Petitioner feels that it has
19 shown a reasonable expectation of success in combining the two references.
20 Thank you.

21 MR. HANNAH: Afternoon, Your Honors.

22 JUDGE SNEDDEN: Good afternoon. Would you like to reserve
23 any rebuttal time?

24 MR. HANNAH: I shall reserve 15 minutes for rebuttal.

25 JUDGE SNEDDEN: Okay, ready?

26 MR. HANNAH: All right. Thank you very much. Thank you,

1 Your Honors. May it please the Board. First of all, I want to thank you very
2 much for your time and consideration in this matter. These Patents mean a
3 lot to my client CleveMed, and so we do appreciate you taking a look at the
4 record and the full record here. With regard to the '512 Patent, it really does
5 boil down to two arguments as to why the prior art does not invalidate the
6 '512.

7 And when you look at what the prior art does, and you look at the
8 case law, I think it becomes very clear that the '512 Patent is novel. For the
9 first issue, the question comes down to, is this a Salazar Claim? Salazar
10 Federal Circuit precedent states, "If you have an element and you describe
11 features of that element, that feature, those features have to be part of the
12 element that you described."

13 I love the way that the Federal Circuit actually described it. They
14 said, "For a dog owner to have a dog that rolls over and fetches, it does not
15 suffice that he has two dogs, each capable of performing just one of those
16 tasks." So the fact that my dog, Jet, can fetch and Jeff's dog, Paddington, can
17 roll over, that would not suffice to meet a dog that can roll over and fetch.

18 And that's exactly what we have here. We have a Salazar Claim
19 that precludes a computer from performing one task and a separate computer
20 from performing another task. The second overall argument is this lack of
21 motivation to combine. And when we get into that, we'll talk about how the
22 references are redundant of each other.

23 And the Federal Circuit has cautioned that if you have redundancy,
24 you have to explain why something that works well would need a motivation
25 to combine the references. That's the Schweickert case, in re Schweickert
26 that we cite. So based on all the reasons that CleveMed has put in its Papers

1 as to why you cannot combine the redundancy, how difficult it is to
2 incorporate these distinct technologies, there is no motivation to combine
3 these references.

4 Now, let's jump right into the Claims. Let's cut to the chase here. I
5 want to talk about how this is a Salazar Claim and how Salazar applies here.
6 Now, as you heard during the opening remarks, and I'm sure you've seen in
7 the briefing, what Petitioner points to is two separate computers that perform
8 different tasks. And this is just for the Orbach reference, they point to 140,
9 which is the server, and they say that analyzes the data.

10 And then they point to 150, and they say that that is the viewing
11 station, and that is the thing that displays the data, two separate computers.
12 And they say the only -- then the only way that they say that Orbach can
13 actually reach these Claims, is if you construe the Claim to say that two
14 separate computers can perform those tasks, that you've got two dogs and
15 not one dog.

16 Well, these Claims are exactly like Salazar. As you can see on
17 Slide 6, when you look at the second column, and it talks about the second
18 software, it lays out that you have at least second software that's stored on a
19 non-transitory computer readable medium. The natural reading of the Claim
20 is that this is software, this is one piece of software, and it can be executed
21 via a computer or a second processor at one or more sites remote to the first
22 location.

23 What that's telling you is that you can have a computer that has
24 software, or you can have a system of computers. They all have to have the
25 same software. It doesn't say you could split the software up. And we know
26 that because of F and G, they refer back to that software just like Salazar.

1 That's exactly what Salazar says, is if you introduce a computer
2 and you say a computer and you refer back to the functionality of that
3 computer, one computer has to do it. One or more means, oh, you can have
4 multiple computers, but they all have to perform the functions of the Claim.
5 You cannot split it into two dogs. And that's what F says.

6 F says that you have to have that second software when it's
7 executed by the computer back in, analyze output, and reform the sleep data.
8 And then G says, that same software has to be able to display it. What that
9 means is you have to have software, one piece of software on one particular
10 computer in order to meet this Claim. It becomes an interpretation issue.

11 And the correct interpretation is applying the Federal Circuit
12 precedent of Salazar. That's dispositive here. If you read the Claim, and if
13 this board, this panel reads this Claim to be a Salazar Claim, then the Patent
14 it is Patentable, claims are Patentable. Now let me try to address some of the
15 arguments that Counsel raised.

16 First one was, and I touched on this a little bit earlier, said that, a,
17 means one or more. Salazar addresses that directly. Salazar says, if it says a
18 computer, one or more computer, yes, you can carry that through the Claim,
19 but each computer of that one or more has to have the functionality in order
20 to meet the Claim language. So Salazar addresses one or more.

21 The other argument they say is it says a computer or a second
22 processor. Again, Salazar addresses this because it's still a second software
23 or just say -- I mean, just to make it easy it says, "Software that has to
24 perform this that's executed on a nontransitory computer readable medium."
25 It's the same software. I don't think there's any reasonable interpretation that
26 can say that a second software can be more than one software.

1 That software executing on the computer readable medium, has to
2 have all that functionality, and it has to be able to execute on a computer or a
3 second processor. (INDISCERNIBLE) also pointing out the one or more
4 sites. That has nothing to do with the functionality of the software. Again,
5 all this is saying is, if you have a system and you're going to sell it, and say
6 you've got 100 patients, and all these -- and it's a big system.

7 You can have a hundred different computers, but each of those
8 computers has to have this software that performs all the elements. So sure,
9 you can have one or more sites, but it doesn't negate the fact the software has
10 to perform all these functions. The last thing that Counsel raised said that,
11 well, the real instruction here should insert the language, or a combination
12 thereof.

13 There's nowhere in the Claim that says that we should insert the
14 language of a combination thereof, and there's no support. They point to one
15 case. And in that one case, it had different language in the Claim, different
16 technology too. But what it said was, in the Claim, it said there has to be at
17 least one of. And then it laid out a variety of elements.

18 That's not what this Claim says. On Slide 6, Claim 1, the second
19 software has to perform all of these elements. It doesn't say at least one of,
20 and multiple different pieces of software. So there's no reason to insert -- no
21 justification to insert the words, at least a combination thereof into the
22 Claims. That is an extraneous limitation.

23 There's no disavow that you would do so. There's no
24 lexicographer or -- to justify that. And so there's no basis in order to insert
25 those -- that type of limitation to broaden the Claim. Now, in the Papers we
26 saw that the Petitioner tried to say, okay, well, there's justification in the

1 specification to change the language of the Claims, because there's that
2 figure that has a computer that's pointed down to a monitor.

3 The viewing station in Orbach is not a monitor. We pointed this
4 out in our Papers, and it's very specific. It says that the viewing station acts
5 as an interactive expert system, as in page 813 through 15. That's what the
6 viewing station is. It's a computer. It's not a monitor, as shown in the '512
7 Patent. Now, I heard a new argument today to try and justify that a monitor
8 as disclosed in the '512 Patent is really a computer.

9 First of all, I don't think that passes the red-face test. But second
10 of all, it's waived. Third of all, it is technically incorrect. A monitor doesn't
11 have A CPU. A monitor would not receive sleep data. A monitor at most
12 contains a display controller that -- or a scaler. And the input that a monitor
13 receives is digital data relating to the pixels that are to be displayed on the
14 monitor.

15 It doesn't analyze the data. It's simply an HDMI signal in one
16 example that has electrical signals that correspond to the brightness of
17 particular pixels that show up on the -- that show up on the screen. So first
18 of all, it's not in the record, but second of all, it's technically incorrect to say
19 that monitors have CPUs, and that the '512 was really trying to show some
20 type of -- trying to map it to be the same as Orbach.

21 Because Orbach is disclosing a separate computer system to view
22 the data. The other thing that was a little concerning with the opening
23 remarks -- and any time you see ellipses, it always makes me double check.
24 We saw the viewing monitor can analyze, dot, dot, dot. If you look at the
25 disclosure of Orbach, it doesn't say that the viewing station is capable itself
26 of analyzing. It allows a human to analyze it.

1 That's the whole point, is that it sends that data to “an interactive
2 expert system for experts to look at it.” So when you go back through the
3 record and you look at what does that viewing station actually do as
4 disclosed in Orbach, you'll see it does not perform any analysis. And
5 actually, the petition never actually pointed to that, saying that it would do
6 analysis.

7 It always pointed to 140, the server, the one dog, Jet, and the
8 viewing station 150, Paddington, the other dog as doing the functions of the
9 Claim. And like I said, according to Salazar, it fails. We also had some talk
10 about this limitation of sending the data over the cell towers, and whether
11 there can be some intermediary devices in between those.

12 And we addressed this in our briefing, but just to summarize and
13 recap, and I have this again on Slide 6, it's on the left-hand column. The
14 point that we are trying to make, is that the data that's sent over the cell
15 phone towers has to go to a computer that is capable of doing all of the
16 functions of analyzing the data and viewing the data. That's the point.

17 Orbach doesn't have that. Orbach does not have that architecture
18 that's set forth in the Claims. So this argument about intermediary devices
19 and whether they can be present or not, is a red herring. Because what the
20 Claim says is you have to have that data that's going to be transmitted to a
21 computer that can perform all these functions with a second software.

22 Here's on Slide 9, I mean that I'm just pulling up. And this is the
23 quotation that we have that was ellipsed out in the Petitioner slide deck.
24 And this is where I was trying to point out that the viewing station 150 is
25 where a human expert may provide interpretation of the data. That's what
26 the viewing station does. It itself does not analyze the data. And that has

1 been consistent throughout until today.

2 I think I've addressed all the main points that I'd like with regard to
3 the reasons why this is a Salazar Claim. But I'm happy to answer any
4 questions and especially in terms of interpretation of the Claims. No
5 questions, huh? Okay.

6 JUDGE SNEDDEN: Yes.

7 MR. HANNAH: I love questions. Okay. All right. We'll move to
8 motivation to combine. So, like I said, in my opening remarks, and we've
9 laid this out in our briefing, in particular in our surreply and our reply,
10 combining Orbach with Ciulla is redundant, technically risky, and
11 commercially irrational. And it's true. It is. It is completely redundant. If
12 you look at the description in Ciulla, there is no reason, definitely no
13 motivation for one of skill in the art to go to look to Orbach.

14 The reasons that we are given is that, okay, you can wirelessly
15 transmit this data. You can view the data. You can send the data away from
16 the person that is actually being monitored. Ciulla says all that. It says all
17 of that. And it's actually in the slides that Petitioner presented. If you look
18 at paragraph, I believe it was 213. It says that it will do that. Ciulla will do
19 that.

20 It's going to wirelessly transmit the data. It has an LCD screen to
21 view the data. So given those disclosures, what is the motivation to
22 combine? What would someone pick up from Orbach in order to create the
23 system, other than looking in hindsight? There's simply nothing. And we
24 cited this, I'm probably butchering the name, but this Schweickert case. It's
25 on page 16 of our surreply, Federal Circuit case, In re Schweickert.

26 And it says, when something works without trouble, you need an

1 explanation of why you're going to combine it. And we don't have that here.
2 All of the explanations that we have are already in the Ciulla reference. On
3 Slide 12, which I'm showing, Ciulla system already claims the LCD screen
4 that displays both the health data and messages of encouragement.

5 So the whole motivation of viewing is not present there. There's
6 no motivation to do that. Another reason that was raised was a motivation to
7 combine for tracking and reporting. Ciulla does that already too. Ciulla
8 produces these reports, and this is on Slide 13. I apologize for that, but I
9 switched it to Slide 13. But it talks about the different reporting and what it
10 can be designed to do.

11 So one of skill in the art, looking at Ciulla is not going to be
12 motivated to change anything there. It'd be completely redundant if they
13 did. They also say that it'd be for patient engagement. That's the reason to
14 combine these. But again, Ciulla has that already. It has it when it talks
15 about the LCD screen that we just saw on Slide 13, I just switched to Slide
16 14.

17 Slide 14 talks about the system, the CAST system that is provided
18 as part of this patient engagement, LCD screen will show that to -- will show
19 that to the user. So again, there's no motivation to combine there, to take
20 that -- to take any teachings from Orbach or particularly what the Petitioner
21 was pointing to. And there's additional reasons for that.

22 We're dealing in the realm of medical devices. And we point this
23 out with our experts that says it is not trivial in order to change the system in
24 Ciulla in order to try and meet limitations of the '512. One point that I
25 thought that resonated was that the FDA regulatory was undeveloped in
26 2006. And that's the challenge here. And that's why it's great to have a

1 panel that can do this instead of a jury.

2 It's not for a jury to put themselves back in 2006 to eliminate the
3 fact that people didn't have cell phones that you could do everything with,
4 and every day. Putting ourselves back in 2006, what are people going to do?
5 What does it look like in the industry? Well, we don't have medical devices
6 on phones. We have an unregulated or underdeveloped, I should say, FDA
7 landscape.

8 2 percent of Americans have phones that could even possibly
9 contemplate displaying and receiving data and whatnot from applications.
10 So when you put all that together, and the fact that we have these distinct
11 fields, there is no reasonable expectation of success, there's no motivation to
12 go by.

13 And that's our job here, is that we're supposed to be the ones that
14 can do that, put ourselves back into 2006, and not get blinded by the fact that
15 I can pull out my cell phone and look at my dog, I guess, Jet. So when you
16 look at all the -- when you look at those and you look at that timeframe,
17 you're going to -- you'll see that it's very difficult in order to imagine in 2006
18 just willy-nilly sticking these two things together. It just wouldn't happen.

19 And that's another compelling reason why the '512 Patent is valid.
20 Any questions on that? I like questions. All right. I do want to talk about
21 the RPI issue. I know we talked about it this morning. I am involved in the
22 litigation, so I'm happy to answer any questions involving that as well. But I
23 think there are some points that were made in the briefing that we should
24 highlight here.

25 We heard in the briefing and in some argument this morning about
26 the non-overlap in counsel between ResMed Inc. and ResMed Corp. And

1 based on that, an argument was made that they're separate, and to somehow
2 justify. For some IPRs, they can identify Inc, for some other ones, they can
3 leave them out. So just to take a step back, it doesn't make any sense that in
4 some petitions they identify Inc and Corp and in others they just drop Inc
5 and only identify Corp without even looking at the facts. Right there, it
6 doesn't seem right. The justification is that there is no overlap -- there is no
7 overlap in Counsel. I just want to clarify, ResMed Corp filed a DJ against
8 my client in San Diego. That same Counsel represents ResMed Inc in the
9 Delaware actions. So there is absolutely overlap in Counsel in representing
10 both Corp and Inc.

11 JUDGE POWELL: On your first point --

12 MR. HANNAH: Yes.

13 JUDGE POWELL: We could safely assume that one possible
14 reason for listing on some of the petition's filings is abundance of caution,
15 and that that doesn't necessarily establish that that entity is a real party in
16 interest. Would that be true?

17 MR. HANNAH: I think you can say abundance of caution, and
18 I'm not sure that I would believe it, especially with regard to what happened
19 in the New York University Regents case versus CleveMed, where it wasn't
20 identified as an abundance of caution. Inc was identified by ResMed and
21 Corp as being parties in interest. I think in subsequent filings, the fact that
22 both Inc and Corp were on them and not -- I mean, so I understand Your
23 Honor's statement and position, or I don't want to say it's your position.
24 Hope it's not your position.

25 JUDGE POWELL: Yes, it's not.

26 MR. HANNAH: But your comment is that out of abundance of

1 caution, because of the language that they put in some of them. But that
2 language isn't in all of them. And it's certainly not in all of them, even when
3 this issue is not even dealing with CleveMed, right? Dealing with other
4 parties is interesting.

5 And when Your Honors look at the citations and the briefing that
6 we have in the underlying district court case, the Delaware case, you're
7 going to see all of the reasons why we are keeping ResMed Inc in there.
8 And we point out the -- we point out the New York case. We point out the
9 IPRs. We point out all these other representations that they have. We point
10 out the SEC filings.

11 All of those show that they should be named as the real party in
12 interest. There's some talk about the Fractus case, and then my co-Counsel
13 raised the fact that there was this indemnification agreement and whatnot.
14 Well, I think what's also interesting is in those IPRs themselves, Inc was
15 identified as an RPI. I think that's an interesting fact. I think that I got a
16 little lost this morning.

17 It's like not just the underlying District Court case in which they
18 said, okay, we're going to dismiss this because the identification agreement,
19 the Fractus IPRs name them both. They named themselves, I should say.
20 They named themselves as RPI. And then the last point that I want to make
21 that kind of dovetails from my original point with the overlap in Counsel and
22 the DJ that we had, I guess my client.

23 And by the way, just to make it clear, what happened was my
24 client was DJ'ed in San Diego. That case was transferred to Ohio. So that's
25 the relationship between San Diego and Ohio. I just want to make sure that
26 that's clear. So we have two matters pending in Delaware right now against

1 Inc. And we have the matter pending in Ohio, which was transferred from
2 San Diego.

3 Their position was that our -- from what I understood and the
4 Papers this morning is that well, we only identify the real party in interest if
5 that party was named as a defendant in the case. I don't think that's the law.
6 I don't think that's right. But it also goes against PGR2024-00012. That's
7 the San Diego case. That's the Patent involving the -- the Patent involved in
8 the San Diego case.

9 ResMed Inc. was named as a real party in interest in that PGR,
10 even though Corp was the one that DJ'ed my client. So just based on the
11 current state of the law with regard to RPI and the policy behind it, this case
12 at the very least should be deinstitutioned. I'll reserve the rest of my time unless
13 there's any questions. All right. Thank you, Your Honors. Appreciate it.

14 JUDGE SNEDDEN: Thank you.

15 MR. TENNANT: Your Honors, Lisa Nguyen will address the RPI
16 issue that I opened up.

17 MS. NGUYEN: Your Honors, just really quickly. Let's be clear
18 about what the standard is. In this Patent Owner's reply, they say the
19 standard is just opportunity to control. That is not the law. They cited the
20 Wi-Fi One versus Broadcom case, and that is not what that case says. In that
21 case, basically there was Broadcom who was indemnifying defendants in a
22 litigation against Wi-Fi One.

23 There was an actual indemnity agreement. There were interest in
24 lines, and there was still no RPI found because there was no finding of
25 control, there was no evidence of control. Yes, opportunity to control is a
26 factor, but as mentioned in the dissent, you can -- which was still even

1 further, that the dissent wanted to see more evidence.

2 But even there in the dissent when they were talking about
3 opportunity to control, that alone does not mean that somebody is an RPI.
4 As to whether or not Inc is an RPI in other IPRs, we have consistently
5 identified Inc whenever Inc was identified as a named defendant. Why?
6 Because of the one-year bar issue. That is an important issue and one of the
7 reasons why there is an RPI rule.

8 And with respect to Fractus, what Patent Owner is leaving out, at
9 the time that the stipulation with respect to whether or not Inc was
10 dismissed, that was after the IPR was filed. And so of course our Inc had to
11 be identified as a named defendant that could have had a one-year bar. So it
12 has always been consistent that Inc has always been identified when there
13 was -- they were a defendant.

14 In fact, in the NYU case, ResMed's core was not involved.
15 ResMed Inc. was the defendant. They were the ones identified. They were
16 the ones only identified as RPI there because they were the only defendants
17 in NYU case. With respect to the one case in the Cleveland Ohio case,
18 where the Patent Owner emphasizes the '284 was not asserted against Inc.

19 That's where the abundance of caution language was used because
20 it was filed almost concurrently with another IPR, where Inc was a named
21 defendant. And again, it said out of abundance of caution, Inc is being
22 identified even though it's non-defendant and it's not admitting that it's an
23 RPI. So just wanted to point those facts out. Thank you.

24 MR. TENNANT: Your Honors, I want to address a few points
25 briefly. And I've put up Slide 15 from our Slide deck that has the excerpts
26 from Claim 1. Again, we've highlighted the term at issue. It's very

1 important to read this term as one, that's how it's written. And I heard a lot
2 from my colleague regarding a Salazar Claim. And they've argued Salazar
3 in their briefing.

4 But one thing that we did not hear from co-Counsel or from
5 Counsel, and also, we've seen in the briefing, is in the analysis of the
6 specification. And when we look at Salazar, if we look at Baldwin or any of
7 the line of Federal Circuit cases, what we do is we have to determine first
8 what the Article A means in the context of the Claim as a baseline.

9 That is the very first step. That is the first step in Baldwin, that is
10 the first step in Salazar. What do you do after that? Then you look to the
11 specification and you ask yourself, does the intrinsic record support this
12 interpretation or not?

13 And for example, when you look at the specification of the '512
14 Patent, there is disclosure of the computer, which is performing the steps of
15 analysis, formatting and output in element 1F, and the monitor, which is
16 performing the step or the function I should say, of displaying, which is in
17 element 1G.

18 So even the '512 Patent discloses the computer or the second
19 processor distributed across these two entities. This is the same, exactly the
20 same. It's Orbach. And again, I'm on Slide 31. Orbach shows precisely the
21 same structure as the embodiment of the '512 Patent. Their argument
22 regarding what we're mapping to the computer or the second processor.

23 This is detailed at our Petition 48 and 49, where we've identified
24 the combination of the viewing station 140 -- I'm sorry, the remote server
25 140 and the viewing station 150 as the element a computer or a second
26 processor at one or more sites. Again, it's expressed in the Claim that the

1 computer or the second processor is at one or more sites.

2 Just as we've seen in Figure 4 of the '512 Patent, this is precisely
3 the same structure that we see in Orbach. It's at one or more sites. I want to
4 move to Slide 32 briefly. Element 1F requires the output functions in the
5 format functions. There is no dispute that Orbach discloses output in format.
6 The only dispute, and so that is dispositive because element 1F uses the
7 disjunctive and/or. You don't have to consider the analysis part.

8 But if we were to consider the analysis part, we have shown that
9 the remote server 140 does perform analysis on the data that is transmitted to
10 it. As for the argument that the viewing station also performs analysis, this
11 is detailed in our reply at page 19. It's not a new argument. It was presented
12 in a reply responsive to Patent Owners' argument.

13 I want to go back to Slide 31. The argument regarding the viewing
14 station not being a monitor. Let's go back to the Claim language. The
15 Claim language requires a computer or a second processor configured to
16 display. There should be no dispute, just like the monitor 140 in the '512
17 Patent, it being in the configurative display that a viewing station -- it uses
18 the word viewing and it talks about in Orbach, it discloses how a physician
19 views the data at that viewing station, how that also necessarily does display.

20 And the last argument regarding the combination thereof. Again,
21 we're not looking at the Claims in a vacuum, and Patent Owner tends to
22 focus only on the Claim language. It's important to read the Claim language
23 in view of the specification. The specification uses the words combination
24 thereof when it describes computer or second processor for performing the
25 various Claim functions. Do you have any -- if you don't have any further
26 questions, I'll turn it over to Dr. Alexander. Thank you.

1 DR. ALEXANDER: Just quickly on motivation to combine.
2 Patent Owner has presented a lot of arguments as to why a person of the skill
3 in the art wouldn't incorporate Orbach cell phone into Ciulla's system. But
4 these are red herrings and what Patent Owner hasn't done is address why
5 Kumar or why Tran at the time of invention also incorporated cell phones
6 into very similar systems.

7 And so Kumar didn't find it too complex. Tran didn't find it
8 technically risky. So there is no reason that that would've been the case for
9 Ciulla either. And so remember, there are only two things that Petitioner
10 needs to show to demonstrate a motivation to combine. That the secondary
11 reference is the suitable option, Orbach is clearly -- we have shown Orbach
12 is clearly a suitable reference.

13 And second, that a person of skill in the art would've been able to
14 combine the two references without issue. That also is clearly the case in
15 view of the prior art. Saying that someone wouldn't invent something,
16 someone wouldn't conceive of a new idea, someone wouldn't reduce it to
17 practice simply because the technology, there are -- the number of people
18 who have cell phones that could do so is low, doesn't make any sense.

19 It's like saying no one would invent electric vehicles simply
20 because there aren't charging stations. Or that the Wright brothers would not
21 invent an airplane simply because there is risk to it and regulations are in
22 place for other people to fly planes. That is not how invention works. And
23 so in sum, Petitioners have shown and demonstrated the two necessary
24 elements for motivation to combine. And everything else is just a red
25 herring. Thank you.

26 MR. HANNAH: May I proceed, Your Honors?

1 JUDGE SNEDDEN: Yes. When you're ready.

2 MR. HANNAH: So Your Honors, I'm showing right now
3 ResMed's slide deck Slide 31, which Counsel pointed to in the rebuttal
4 remarks in trying to say that these two things equal each other. If you look
5 at '512, the right-hand side, the computer to the monitor. The computer to
6 the monitor, as I brought up in the initial, there is no sleep data that is being
7 sent from the computer to that monitor.

8 That is pixel data, electrical signals that correspond to pixel data,
9 and brightness that's going to be displayed on that monitor. One of skill in
10 the art, looking at that, for our job, for your job as Judges, looking at that
11 disclosure, are not going to be able to equate that to the left-hand side in
12 which Orbach specifically says that 140 is a computer and 150 is a
13 computer.

14 That's what Orbach says. 148, the left-hand side on Slide 31 that's
15 identified, that's a local area network link. That's not HDMI cable. That's
16 not something that's sending pixels to the viewing station. That's a local area
17 network link that's computing -- that's connecting two computers to each
18 other. There's no way that you can say that the left-hand side and the right-
19 hand side of Slide 30 -- shown on Slide 31 are equivalent.

20 The only thing that's equivalent here is the fact that the Petitioner
21 colored two yellow boxes. But when you actually look at the disclosures of
22 what's shown, it's completely different. And just to make it perfectly clear,
23 right now I'm showing on the screen Exhibit 1008, which is Orbach. And
24 this is on pages 13 and the top of 14, where it describes what is that 148?
25 What is that link between those two computers and Orbach?

26 Is it an HDMI cable? It is not. It is a local area network

1 interworking that connects the remote server to the station. The sentence
2 also is the definitive description of the fact that the 150-viewing station does
3 not analyze the data. It is where a human expert may provide interpretation
4 of the data. The computer doesn't do that. So there's two different dogs, one
5 that analyzes at best, and one for viewing. And based on what the case law
6 says, that can't meet limitations for CleveMed's Patent.

7 JUDGE SNEDDEN: This section in Claim 1F, it requires more
8 than analyze. It's analyze, output, and/or format.

9 MR. HANNAH: Absolutely.

10 JUDGE SNEDDEN: So is the argument that all of that is one form
11 or another of an analysis or how is --

12 MR. HANNAH: I agree. No. That's why I said at best that I think
13 that the same computer has to do all of those.

14 JUDGE SNEDDEN: What do we make of the "or" there? It says
15 analyze, output or format.

16 MR. HANNAH: Oh, for Claim --

17 JUDGE SNEDDEN: 1F.

18 MR. HANNAH: For Claim 1?

19 JUDGE SNEDDEN: Yes.

20 MR. HANNAH: So I think the one to look at is G, Your Honor, is
21 that it has to do the analysis. I just brought up Slide (INDISCERNIBLE).
22 So the point is, the same computer has to do both F and G. So even with
23 your and/or question, it has to analyze and it has to display the data.

24 JUDGE SNEDDEN: Oh, I understand. Okay.

25 MR. HANNAH: And they've always pointed to two separate
26 components in Orbach. Turning quickly to the motivation to combine. So

1 Counsel said that the standard is that you have to have a suitable option, but
2 you have to have a suitable option for a known problem. It's on their slides
3 too. What's the problem? What's the problem that you're trying to solve
4 with Orbach? There isn't one.

5 Ciulla teaches everything. There is no problem identified. And
6 that's the point that we've been making again and again, is that when you
7 have this redundancy, you can't even satisfy the first elementary prong of
8 finding a suitable option for a known problem because there is no problem
9 there. A one of skill in the art would never recognize a problem that Orbach
10 would solve.

11 Ciulla solves it already. Counsel also said that the combination has
12 to be that something-- that someone in ordinary skill would be able to do.
13 Again, we have to look at that in 2006. What are people doing in 2006?
14 What does the landscape look like? And Counsel kept saying, well of
15 course there's going to be risks. And kept saying there's going to be risks for
16 inventions.

17 There are risks for inventions. It is risky. That's why the '512 was
18 an invention. Because it was risky. It can't be risky for the prior art. The
19 prior art has to be known, well known. It has to be obvious, no risk
20 involved. That's the whole point, is if you've got prior art out there, that
21 there is no risk and that everybody could do it by just looking at them.

22 So I think both of those elements that they raised and it's on Slide
23 36 of their presentation are not met. And before I leave off the merits and go
24 to the RPI issue, just last chance if there's any questions on any --

25 JUDGE SNEDDEN: (INDISCERNIBLE).

26 MR. HANNAH: Okay. For the RPI issue, Counsel made several

1 remarks about the entities, again, saying that they're unrelated. When you
2 go back through the record and you see it in our briefs, another point that
3 was made, was the fact that there are these corporate disclosures that are
4 filed in the litigations. And part of those corporate disclosures, you have to
5 identify people who have interests in the case.

6 ResMed identified ResMed Inc as having an interest in the case.
7 That's a powerful fact. The powerful fact that in the litigation involving
8 these Patents that ResMed Inc. was identified. Judge Powell, he said out of
9 abundance of caution, what about those other ones that they just put
10 abundance of caution in? Well, they didn't put that in here. Why didn't they
11 do that?

12 Why didn't they say out of abundance of caution, we're going to
13 identify ResMed Inc. in this case? They did it in other cases, even though
14 they used that lawfully language, but they didn't do it here. And the reason
15 is because they're trying to get around an estoppel issue. And that's what the
16 policy is designed to prevent. Policy is designed to prevent exactly what the
17 situation is here.

18 JUDGE SNEDDEN: Do you need to show control in order to
19 establish RPI, or is it your position that there was an opportunity for control?
20 Is there control or is it your position that it's not needed to establish --

21 MR. HANNAH: I think that it's control or opportunity to control
22 as my Counsel -- that Mr. Price pointed out. But I would argue that there is
23 control. There's absolutely control here based on what they've done in this
24 case, in the three cases that involve my client, and other cases that involved
25 similar technology -- or I should say similar accused products that they've
26 absolutely demonstrated that control.

1 But the case law says control or operable to control. So with that I
2 have no further argument, and I appreciate your time. Thank you, Your
3 Honors, and I hope you have a nice afternoon. Thank you.

4 JUDGE SNEDDEN: Okay. Thank you. Okay. I believe that
5 concludes our hearing today. Thank you again for your presentations and
6 we are adjourned.

7 (Whereupon, the above-entitled matter went off the record at
8 2:28 p.m.)

PETITIONER:

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

PATENT OWNER:

James Hannah
Jeffrey Price
HERBERT SMITH FREEHILLS KRAMER (US) LLP
james.hannah@hsfkramer.com
jeffrey.price@hsfkramer.com

Jenna Fuller
Jeffrey Eng
KREMER LEVIN NAFTALIS & FRANKEL LLP
jfuller@kramerlevin.com
jeng@kramerlevin.com