

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES INC.,
Patent Owner.

Case IPR2025-00159
U.S. Patent No. 11,375,921

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

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Duan, Zhenhai, et al., “Push vs. Pull: Implications of Protocol Design on Controlling Unwanted Traffic” (USENIX July 7, 2005)
2002	Bunny webpage, “What is the Hypertext Transfer Protocol (HTTP)?” available at https://bunny.net/academy/http/what-is-http-hypertext-transfer-protocol/# , dated March 12, 2025
2003	Appsierra webpage, “Software Architecture: N Tier, 3 Tier, 1 Tier, 2 Tier Architecture,” available at https://www.appsierra.com/blog/tiers-in-software-architecture#:~:text=One , dated April 1, 2024
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

Patent Owner's Preliminary Response
IPR2025-00159 (U.S. Patent No. 11,375,921)

Exhibit	Description
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
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
2013	"Reexamination Operational Statistics," last updated June 2024, available at https://www.uspto.gov/learning-and-resources/statistics/reexamination-information , last visited on January 24, 2024
2014	Excerpts from American Inventors Protection Act of 1999, H.R. Rep. No. 106-287, Part 1 (Aug. 1999)

I. INTRODUCTION

The Board should deny the Petition¹ because fundamental fairness and due process overwhelmingly support denial. Equitable principles support denying this Petition as improper because it is duplicative of Petitioner's reexamination request involving overlapping grounds that the Office granted weeks before Petitioner filed the Petition. Petitioner's multiplication of validity challenges at different branches of the Office constitutes an abuse of process.

Further, the Petition significantly overlaps with Petitioner's validity challenges before the District Court, which warrants discretionary denial under *Fintiv*. 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

¹ The Petition challenges claims 1, 2, 4, 5, 7-9, 11-14, and 16 (the "Challenged Claims") of U.S. Patent No. 11,375,921 (Ex. 1001, the "'921 Patent").

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 '921 Patent.

The Board should also deny the Petition because a person of ordinary skill ("POSITA") would not have been motivated to modify Toge with Kumar to reach a "remote internet site" that receives data related to treatment efficacy. Petitioner concedes that Toge does not disclose transmitting any data to a remote internet site, and its arguments for modifying Toge with Kumar are the product of hindsight. Toge's PAP device already performs the function Petitioner looks to Kumar for, *i.e.*, transferring data to physician-side devices, so Petitioner's proposed combination would add redundancy and unnecessary complexity to Toge's system.

The combination of Toge and Kumar also does not disclose a base station, cell phone, or PDA that: **(1)** retransmits data to a remote internet site (Claim 1), **(2)** receives data first received by and retransmitted from a remote internet site (Claim 7), or **(3)** receives data independently from a remote internet site that also receives the data (Claim 12).

II. OVERVIEW OF THE '921 PATENT AND ASSERTED REFERENCES

A. The '921 Patent

The '921 Patent discloses an integrated diagnosis and treatment device for patients suffering from sleep apnea and other sleep disorders. '921 Patent at Abstract, 1:14-18. The device monitors a patient's breathing metrics and the device's usage data while simultaneously providing a sleep-disorder treatment, such as applying continuous positive airway pressure or a pharmaceutical intervention. *Id.* at 3:61-4:50.

In a preferred embodiment, the '921 Patent discloses a positive airway pressure ("PAP") device with internal airflow sensors that monitor the patient's airflow. *Id.* at 2:56-3:18, 6:10-7:28. An exemplary embodiment of the PAP device, shown below, includes a pressure generator, a blower, a hose, a mask or nasal cannula, a flow sensor, and a pressure sensor for measuring breathing metrics (for example, respiratory airflow), and processor(s) for collecting and processing breathing metrics:

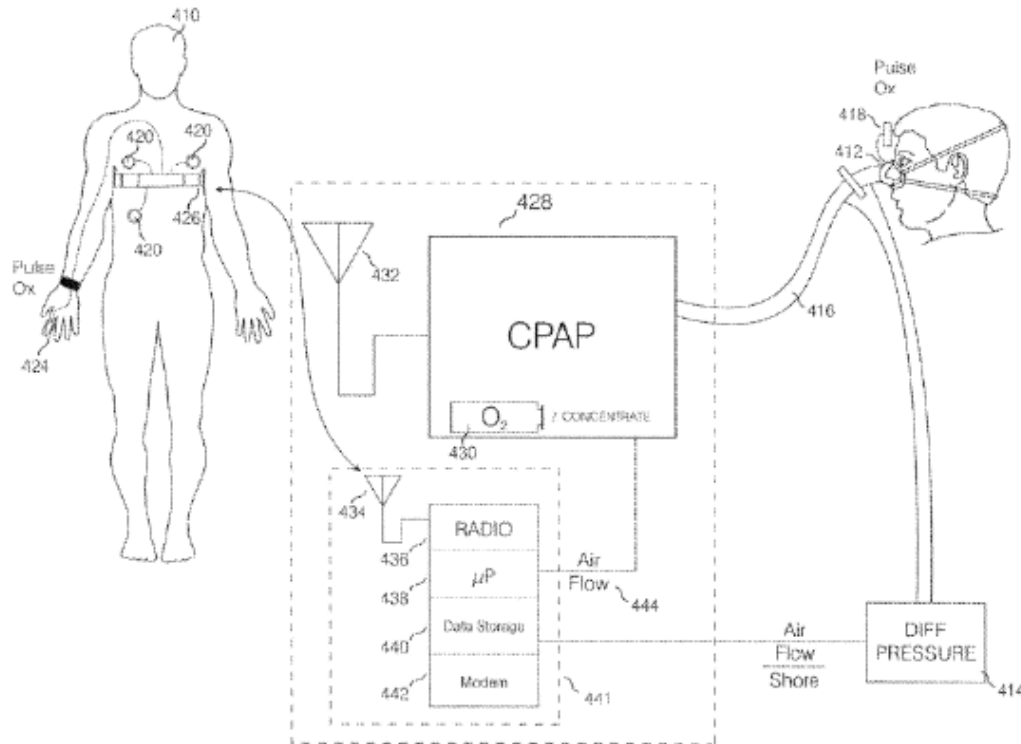


Fig. 8

'921 Patent at FIG. 8; *see also id.* at 2:56-3:18, 22:60-23:41, FIG. 7. While treatment is ongoing, the PAP device also collects usage data and breathing metrics and passes that data to the processor for calculation of the PAP usage and severity of a patient's sleep disorder symptoms. *Id.* at 23:12-17; *see also id.* at 8:26-30, 18:60-19:7.

After the severity and usage data are collected and calculated, that data (and/or the index of treatment efficacy calculated based on that data) is transferred to a remote internet site and downloadable on a computer for display. *Id.* at 19:35-41 ("[A] PDA, computer or cell phone, which receives the physiological data transmission, optionally re-processes the information, and re-transmits the

information . . . to a remote site for analysis.”); *id.* at 18:60-19:45. That computer may be a PC, PDA, cell phone, or any other suitable computer with a processor and display capabilities. *Id.* at 18:64-19:35. The calculated index may also be fed back to the PAP device and used to adjust the patient's treatment in real time. *See id.* at 3:54-4:6, 22:1-12.

B. Toge (Ex. 1044)

Toge's system enables a medical professional's remote monitoring of a patient using a positive pressure artificial respiration assisting device. Toge at Abstract. Specifically, Toge's system allows medical professionals to set threshold values that, when met, triggers the PAP device to push treatment data to the physician-side computer/mobile terminal (*i.e.* physician-side client devices) such that medical professionals can take emergency measures. *See id.* at ¶¶ [0039], [0047], [0061]. For example, if a patient's oxygen saturation falls below 90%, the physician-side client devices are pushed this “crucial data” from the PAP device (*id.* at ¶ [0054]) where, in turn, the medical professionals can increase the prescription pressure, for instance. *See id.* at ¶ [0047].

C. Kumar (Ex. 1008)

Kumar operates in a fundamentally different way than Toge as it utilizes a browser-based engine hosted on a web-based central server that pulls data from the server only upon request. As the figures reproduced below show, patient data is sent

from a patient-side device 102 (blue, below) to its web-based central server 106 (red, below) where the browser-based engine facilitates the transfer to a medical professional's device once the device has accessed the web page (e.g., TeleVital) and requested the patient data:

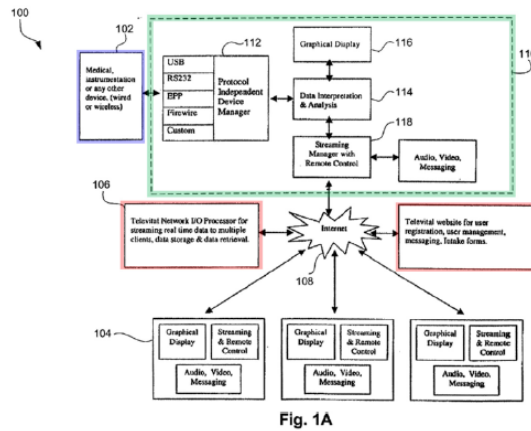


Fig. 1A

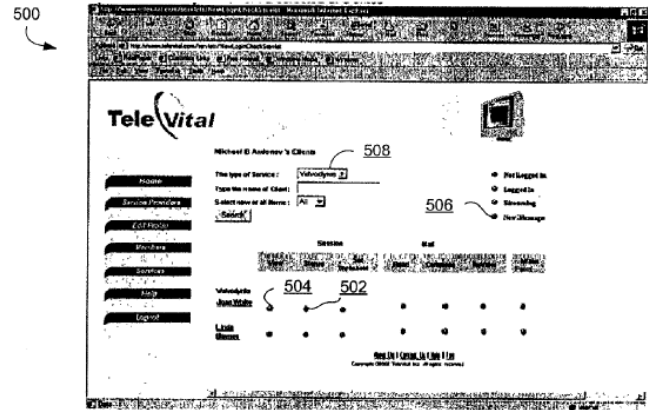


Fig. 5

Paper 1 (“Pet.”) at 10 (citing Ex. 1008, FIG. 1A (annotated)); Kumar at FIG. 5; *see also id.* at ¶ [0067] (“[T]he system includes one or more patient-side devices 102 for collecting data from a patient/client, one or more provider-side devices 104, and an engine implemented on a central server 106.”), ¶¶ [0078]-[0083], [0091]-[0092].

III. EQUITABLE CONSIDERATIONS AND DUE PROCESS SUPPORT DENIAL OF THE PETITION

Fundamental fairness and due process support denial of the Petition because the Central Reexamination Unit (“CRU”) already ordered reexamination of the ’921 Patent at Petitioner’s request several weeks before Petitioner submitted this Petition. *See* Ex. 1053 (Decision Ordering Reexamination, Control No. 90/019,700) (dated November 15, 2024). Petitioner’s overlapping challenges before multiple branches

of the Office constitute an abuse of the patent system for the improper purpose of nullifying the term of the patent by tying it up in duplicative proceedings, as described below. Specifically, Petitioner seeks a delay in adjudicating the validity of the '921 Patent with these multiple challenges, **exploiting** the Office's procedures and processes in a manner that takes the longest amount of time. Indeed, Petitioner admits that if it could have staggered its administrative challenges in order to draw out these proceedings as long as possible, it would have done so. Pet. at 74 ("Further, given the statutory deadline to file an IPR, ResMed could not have waited until the conclusion of the reexamination to file this IPR."). Petitioner's behavior does not indicate a desire for an efficient resolution to the parties' disputes; rather, it is calculated to multiply and draw out the proceedings while limiting Patent Owner's rights during the '921 Patent's remaining term.

Since Petitioner successfully obtained a stay before the District Court during the pendency of these administrative validity challenges, Petitioner's repetitive attacks prejudicially impede Patent Owner's ability to enforce the '921 Patent for a lengthy period of time. *See ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, 2025 WL 744610, at *3-4 (N.D. Ohio Mar. 7, 2025) (granting stay). Indeed, a patent facing successive—or even co-pending—reexaminations and IPR petitions may spend a significant portion of its term tied up in validity proceedings. *See, e.g.*, Ex. 2013 (PTO Reexam Operational Statistics) at 2 (average

time from filing to conclusion for a reexamination was around 20 months in 2024, not accounting for appeals). During the pendency of these proceedings, Petitioner's sought-after delay chips away at the remainder of the '921 Patent's term and Patent Owner's rights, which include, *inter alia*, the right to exclude. This prejudice is only augmented with duplicative or serial proceedings. Fundamentally, the Office cannot, without violating due process rights, require a party to undergo multiple rounds of the same or overlapping invalidity challenges before different branches of the same government office.

Weaponizing repetitive or duplicative administrative attacks is inconsistent with Congressional intent. See H.R. Rep. No. 112-98, pt. 1, at 48 (2011) (“[T]he changes made [to this Title by this amendment] are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.”). Indeed, Congress has gone out of its way to “compensate patent applicants for certain reductions in patent term that are not the fault of the applicant[,]” *i.e.*, administrative delay during patent prosecution and during regulatory review. See Ex. 2014 (H.R. Rep. 106-287(I) (1999)) at 49-50, 52 (coordinating statutory “technical term adjustment provisions” that restore lost patent term); see 35 U.S.C. §§ 154, 156 (restoring patent term lost due to Patent

Office or regulatory delay). Administrative delay would result if institution is granted where Patent Owner is also forced to address the reexamination of the same patent, which was granted weeks before this Petition was submitted. Ex. 1053.

Further, a stay of either administrative proceeding would not provide relief for Patent Owner; rather, it would compound the prejudicial delay in Patent Owner's ability to exercise its rights. Any stay entered pursuant to 37 C.F.R. § 42.122(a) would transform inappropriate co-pending challenges into inappropriate serial challenges, when in fact, the District Court is available as a single forum to efficiently address all invalidity and enforceability challenges. As a result, a stay extends the amount of time that validity proceedings cast a cloud over a given patent and prevent effective enforcement. Thus, the only remedy to prevent the weaponization of the Office's various administrative procedures is denial of attempts to bring iterative challenges, such as the one at issue here, where Petitioner filed the instant Petition despite already knowing its reexamination request was granted.

Additionally, the 2019 Consolidated Trial Practice Guide provides compelling grounds to deny this Petition in light of the pending reexamination of the '921 Patent. *See* 2019 Consolidated Trial Practice Guide ("2019 CTPG") (Nov. 2019) at 60-61 (a Patent Owner may "explain why the Board should not exercise its discretion to institute more than one petition (if it institutes at all)."). Highlighting the troubling nature of Petitioner's tactics is its failure to justify its alleged need for two parallel

proceedings challenging every claim of the '921 Patent before two different branches of the Office, particularly given the timing of its submissions. *See* Ex. 1053 (Decision Ordering Reexamination, Control No. 90/019,700). After Petitioner submitted its reexamination request on October 11, 2024, the Office granted the request on November 15, 2024, which was weeks before Petitioner submitted this Petition on December 6, 2024. Thus, Petitioner submitted the IPR knowing that the reexamination request had been granted, and yet it chose not to address this issue. Petitioner's omission raises concerns about the proper use of the Office's procedures and processes.

Such a justification necessarily should underlie Petitioner's burden of proof for its Petition, when it is seeking two different branches of the same agency to review the same or overlapping validity issues. Indeed, the 2019 CTPG has procedures for Petitioner to explain the need for more than one petition. *See* 2019 CTPG at 60 (setting forth the need to rank the petitions and explain (i) the differences between the petitions, (ii) why the issues addressed by the differences are material, and (iii) why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)).

In any event, none of the traditional considerations set forth in the CTPG weigh in favor of instituting this Petition in parallel with the ongoing reexamination.

For example, Petitioner does not raise a priority date challenge in either case that might justify filing two challenges. 2019 CTPG at 59. Nor does the '921 Patent contain such a multiplicity of claims that fairness would justify the Office hearing parallel administrative challenges. *Id.*

Although the 2019 CTPG facially applies only to parallel IPR and PGR petitions, Patent Owner respectfully submits that similar reasons of efficiency and fairness justify denying this Petition in view of the pending reexamination for the reasons that follow. *Id.* at 59 (recognizing that two petitions filed in close succession “may place a substantial and unnecessary burden on the Board and the patent owner and raise fairness, timing, and efficiency concerns”).

First, it would be inefficient for the Board to institute trial in this case because the pending reexamination proceeding involves three of the four references raised in this Petition: Toge, Kisner, and Burton. Ex. 1053 at 4. Accordingly, Petitioner has asked two branches of the Office to consider nearly all of the same art against the same patent in two parallel proceedings, which would be an inefficient use of USPTO resources and heighten the risk of inconsistent decisions. Indeed, the fact that Petitioner cited the same art in multiple proceedings implicates 35 U.S.C. § 325(d), which expressly applies to IPR petitions (chapter 31) and reexaminations (chapter 30). 35 U.S.C. § 325(d). Further, the reexamination request involves all claims of the '921 Patent whereas Petitioner only challenges Claims 1, 2, 4, 5, 7-9,

11-14, and 16. It would be more efficient for the Office to hear an administrative challenge that addresses each claim of the '921 Patent than to conduct two parallel proceedings for overlapping, but non-identical claim sets.

Second, fairness concerns weigh in favor of denying this parallel petition. It appears that Petitioner filed the parallel IPR and reexamination challenges (as opposed to another IPR challenge) in order to avoid the 2019 CTPG's requirement that petitioners justify the filing of multiple petitions. There are, at least, no other reasons in the record. Any belated argument that the differences in aspects of validity that can be reviewed in a reexamination as opposed to an IPR is nonsensical because if Petitioner wanted efficiency, it would have proceeded with addressing all issues of validity before the District Court in the pending litigation. Instead, Petitioner sought and successfully obtained a stay of that litigation, using the multiple proceedings before the Office as the basis for such a stay. Thus, Patent Owner respectfully submits that instituting this case would encourage petitioners to file multiple and duplicative filings between the PTAB and CRU, which is antithetical to the Office's goal of providing an efficient forum for settling patentability disputes.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION UNDER 35 U.S.C. § 314(a)

The Board should deny institution under § 314(a) because (1) this Petition is redundant of the declaratory judgment patent action that *Petitioner* filed in 2023,

which involves the '921 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 U.S. Patent No. 11,602,284 (the "'284 Patent"), which is a continuation of the '921 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"). Thereafter, Petitioner responded to Patent Owner's counterclaims of infringement, including infringement of the '921 Patent, with voluminous invalidity contentions that cited the same Toge and Burton references used in this Petition. *See, e.g.*, Ex. 2004 (7/15/2024 Ohio Case Invalidity Contentions Cover) at 12 (citing Toge against the '921 Patent), 52 (citing Burton against a related patent). 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 Burton—for much longer. *See infra*, Factor 3. As a result of Petitioner's delay in filing this Petitioner, 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 reveals 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 11-12 (If 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). In this case, both issues are present: Petitioner not only waited ***four months*** from receiving Patent Owner’s validity contentions to file

this Petition, it failed to explain the delay. Patent Owner respectfully requests, therefore, that the Board weigh Factor 3 strongly 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 disputes than indicated by focusing narrowly on the invalidity issues raised in the Ohio Case. Patent Owner, Petitioner, and Petitioner's parent company, ResMed Inc., have been embroiled in litigation since June 16, 2022, when Patent Owner asserted U.S. Patent No. 10,076,269 (the "'269 Patent") 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 '921 Patent is a continuation of the '269 Patent.

The Delaware Case has been stayed pending the IPR that Petitioner filed against the '269 Patent. *See ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. IPR2023-00565, Paper 1, Pet. 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 under *Fintiv* 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 Decision Denying Institution on procedural grounds, 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 its IPR petition against the '269 Patent, Petitioner multiplied the proceedings among the parties by filing a declaratory judgment action against the '284 Patent in the San Diego Case and an unsuccessful post-grant review petition against the '284 Patent (*see* PGR2024-00012). After receiving notice that the PGR was denied, Petitioner filed *another* petition for *inter partes* review of the '284 Patent (*see* IPR2025-00157) along with the instant Petition against the '921 Patent and various other petitions for *inter partes* review and requests for reexamination against other patents in Patent Owner's portfolio. *See* IPR Case Nos. IPR2025-00158, -00159, -00160, -00246, and -00247; Reexamination Control Nos. 90/019,700 and 90/019,705.

Thus, 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. Given this multitude of proceedings, the vast majority of which were initiated by Petitioner, and Petitioner's delays in bringing this Petitioner, efficiency and fairness considerations weigh in favor of resolving the parties' disputes in the pending District Court action.

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

Factor 3 weighs strongly in favor of denying institution. Despite being aware of the references cited in its Petition for months or years, Petitioner nonetheless delayed filing this Petition until December 6, 2024, the last business day of the period within which it could petition for IPR against the '921 Patent.² *See* 35 U.S.C. § 315(b) (permitting IPR petitions only within 1 year of an allegation of infringement).

“[N]otwithstanding 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 this instance, Petitioner pursued the Ohio Case for the maximum possible amount of time before filing this Petition based on art that it was (or should have been) aware of far earlier. On July 15, 2024, Petitioner asserted Toge as a primary reference against the '921 Patent in its invalidity contentions in the Ohio Case, roughly five months before filing this Petition. *See, e.g.*, Ex. 2004 (7/15/2024

² Petitioner's cut-off date for filing this Petition was December 7, 2024, which fell on a Saturday.

Ohio Case Invalidity Contentions Cover) at 12, 16. It now repurposes Toge as a primary reference in combination with a few other references.

One such reference is Burton, which Petitioner knew of for as long as **twenty-one months** before filing this Petition and used in its Ohio Case invalidity contentions. Petitioner's parent company, ResMed Inc., first asserted Burton in its invalidity contentions in the Delaware Case against the '921 Patent's parent patent on February 21, 2023, nearly two years before this Petition. *See, e.g.*, Ex. 2005 (2/21/2023 Delaware Case Invalidity Contentions Cover) at 17. Thereafter, Petitioner asserted Burton 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 the 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).

In this way, Petitioner sought to recycle voluminous contentions from the Delaware Case into the Ohio Case—and has now further recycled some of that material here. *See, e.g.*, Ex. 2005 (2/21/2023 Delaware Case Invalidity Contentions Cover) at 17 (asserting the Burton reference used in the Petition). Between Toge and Burton, there is no question Petitioner knew or at least should have been aware

much earlier of the positions it has taken in this delayed Petition. *See, e.g., Next Caller*, Paper 10 at 15-16.

Factor 3 also weighs in favor of denying institution because Petitioner does not explain when it became aware of the Kumar and Kisner references or argue that it reasonably could not have found those references earlier. *Fintiv*, Paper 11 at 12 (“[I]f the petitioner cannot explain the delay in filing its petition, [this fact favors] denial.”); *see also Next Caller Inc. v. TRUSTID, Inc.*, No. IPR2019-00961, Paper 10 at 15-16 (P.T.A.B. Oct. 16, 2019) (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.”).

Even if Petitioner had supplied evidence that it could not have reasonably found Kumar and Kisner when it filed its invalidity conventions, the combinations of references need not be identical so long as there is “substantial overlap” in issues presented by the prior art. *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”). Both grounds in the Petition require Toge and Burton, which Petitioner knew about for months or years before

filing this Petition. Pet. at 2. Petitioner's allegations are not somehow newly discovered because Petitioner added Kumar to the first ground and cited Kisner in the second ground in an attempt to prop up a single claim element (which is not relevant to Patent Owner's merits arguments herein regarding the Independent Claims). *See id.* at 2, 69.

Thus, Petitioner's combination of a few references with Toge that were not included in the Toge combinations in the Ohio Case does not justify its delay in filing this Petitioner, which Petitioner does not attempt to justify.

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

Even without taking Petitioner's undue delay into account and focusing narrowly on the effort the parties have undertaken on the invalidity issues related to the '921 Patent in the Ohio Case, the Board generally weighs the amount of investment that the parties have expended to date to be neutral or weigh somewhere between marginally against or marginally in favor of denying institution. *See ResMed Corp. v. Cleveland Med. Devices*, No. IPR2023-00565, Paper 13 at 13 (P.T.A.B. Sept. 25, 2023) (determining that Factor 3 weighs marginally in favor of denying institution after claim construction briefing is complete but before a *Markman* Order has issued). However, taking Petitioner's delay into account (*see* §§ IV.A-B, *supra*), the Board should weigh this Factor strongly in favor of denying institution because even though Petitioner was aware of the bases for its IPR petition

for months before it filed this 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 '921 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).

Both of Petitioner's grounds alleged in the Petition require Toge and Burton. Pet. at 2. As explained above in connection with Factor 3, Toge was already asserted as a primary reference against the '921 Patent in the Ohio Case. Ex. 2004 (7/15/2024 Invalidity Contentions Cover) at 12. Burton was also asserted against a related patent. *Id.* at 50, 52. 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 '921 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 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.

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 in the same family as the

'284 Patent would be relevant, to avoid creating further parallel proceedings. This included the '921 Patent and certain additional patents that had recently issued or issued during the pendency of the case. 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.

V. 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 2005, as one having "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, such as networked PAP machines. Additional experience could substitute for less education, and additional education could likewise substitute for less experience." Pet. at 12-13.

VI. CLAIM CONSTRUCTION

No express construction is necessary for the Board to resolve the instant dispute and affirm patentability. Should the Board institute trial, Patent Owner reserves the right to advocate for the construction of any claim term in its Patent Owner Response.

VII. GROUND 1: THE CHALLENGED CLAIMS ARE PATENTABLE OVER TOGE IN VIEW OF KUMAR AND BURTON

A. Toge in View of Kumar Does Not Disclose a “Remote Internet Site Adapted to Receive the Data Relate[d] to the Subject’s Treatment and the Treatment’s Efficacy”³

The Board should deny institution because Petitioner has not established that it would have been obvious to modify Toge’s system to include a browser-based engine (hosted on a web server)⁴ as in Kumar. Because Toge transfers its treatment data directly to physician-side client devices, Toge’s system has no need for Kumar’s browser-based engine. Petitioner’s argument is, therefore, a solution in search of a problem that would add redundancy and unnecessary complexity to Toge’s system. *See* Pet. at 48-52.

³ Hereinafter referred to as the “remote internet site” limitation.

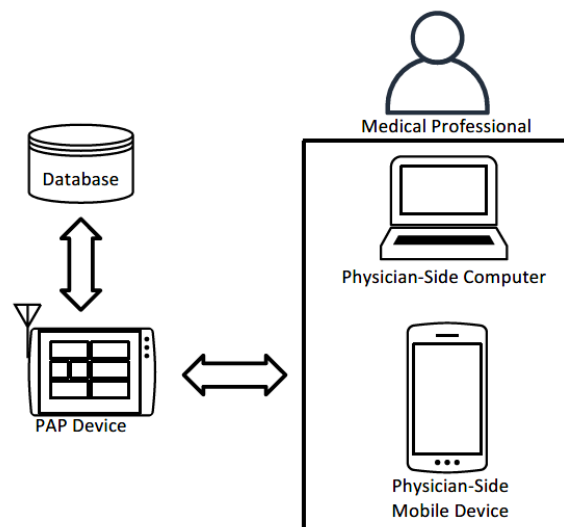
⁴ Petitioner identifies “a browser-based engine” (hosted on a web server) as the “remote internet site.” Pet. at 50, 52, 54, 56, 60, 65.

1. Toge Does Not Disclose a Remote Internet Site

Toge in light of the knowledge of a POSITA does not disclose this claim limitation because, as Petitioner acknowledges, Toge's PAP transmits treatment data directly to the physician-side client devices:

[S]oftware on physician side computer 4 and mobile terminal 5 receives (from the radio frequency wireless transceiver of the PAP device) and displays to the care provider [the treatment data].

Pet. at 55; Pet. at 56-57 (same); *see also id.* at 38-39 (“Toge explains that the functionality of ‘relay device 3 can be incorporated into the [PAP] device 2’” such that the device “directly transmits all or part of the treatment data to the physician-side computer 4 or mobile terminal 5”) (quoting Toge at ¶¶ [0060]-[0061]). This arrangement is illustrated below:



Toge at ¶¶ [0079]-[0082] (describing the relay device functionality as including the storage and transmission of data to the physician-side client devices).

Accordingly, Toge's PAP device already stores and transmits treatment data to the authorized parties. This is the same functionality provided by Kumar's browser-based engine/web server—storage and transmission—but with the benefit that the PAP device pushes data to the medical professional, without the medical professional needing to login and submit a data request to the web server. *Compare* Toge at ¶¶ [0050]-[0054] (disclosing that treatment data is pushed to the physician-side client devices when a threshold is met) and Ex. 2001 at 25-26 (describing that in a push protocol, the “receiver[] ***passively accept[s]*** whatever the sender[] push[es] to them”) *with* Kumar at ¶¶ [0067], [0091]-[0092] (describing a provider requesting patient data from a central server), FIGs. 1A, 5 and Ex. 2002 at 2-3 (describing that in a pull protocol “information can only be pulled from a web server after a client's request”) (emphasis added).

Since Toge's PAP device “already” includes functionality that stores and transmits data, a POSITA would have found it “unnecessary” to utilize a browser-based engine/web server that “would do little more than add” unwanted complexity to how data is transferred in Toge's system. *See In re Schweickert*, 676 F. App'x 988, 995 (Fed. Cir. 2017) (remanding the Board's obviousness determination because the proposed modification was “unnecessary” because the prior art system “already” performed the function and the additional feature “would do little more than add unwanted cost and complexity to the system”). Therefore, Toge's system

does not disclose, let alone have a need for, a browser-based engine/web server in Toge's system.

In view of the foregoing, Petitioner's half-hearted argument that Toge suggests sending data to a "remote internet site" because it is connected to "**the Internet**," makes little sense. Pet. at 49 (alleging that "it would have been obvious to a POSITA to utilize a 'remote internet site' to receive" treatment data). Regardless of the type of communications network used to connect Toge's PAP device to the physician-side device, Toge discloses sending its treatment data to the physician-side client devices, not to a browser-based engine/web server (the alleged "remote internet site"). Tellingly, the only evidence Petitioner cites in favor of this theory is the similarly conclusory testimony of its two experts. *Id.*

2. It Would Not Have Been Obvious to Add Kumar's Web Server to Toge's Physician-Side Computer

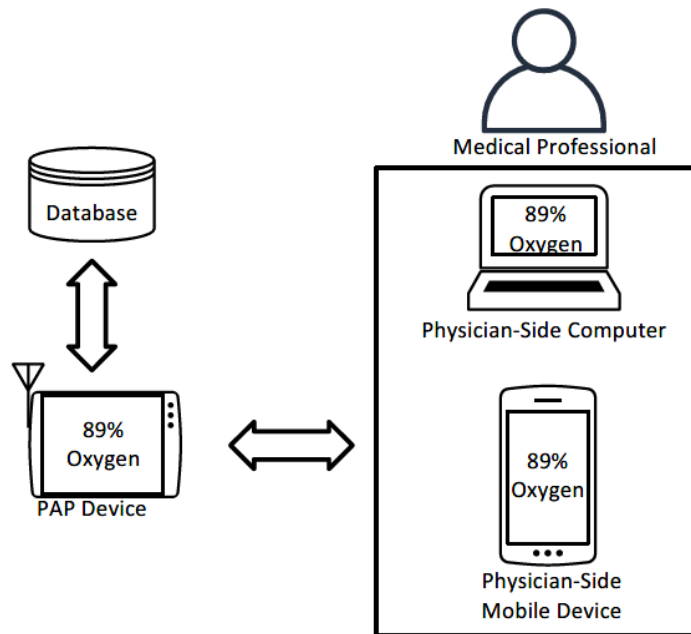
Kumar does not cure Toge's deficiencies because neither Kumar nor any other evidence of record suggests implementing a web server on a physician's client device. Yet that is the modification Petitioner attempts to prove is obvious in order to read the prior art on the Challenged Claims. For at least the reasons presented below, Petitioner fails to establish that a POSITA would have been motivated to combine Toge and Kumar to "achieve the claimed invention." *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (citations omitted).

Petitioner identifies no teaching or suggestion in the art to use a *physician's device* as a web server. *See* Pet. at 15-18. Nor does Petitioner identify any *motivation* to modify Toge's physician-side device to be a web server as in Kumar. The closest Petitioner comes to meeting its burden on this issue is to say that a POSITA would have had a reasonable expectation of success in making the combination. *See id.* at 20. However, merely establishing a reasonable expectation of success is insufficient as a matter of law to establish obviousness, which **also** requires a "reason to combine the teaching of the prior art references to achieve the claimed invention." *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig. v. Mylan Pharm. Inc.*, 676 F.3d 1063, 1068-69 (Fed. Cir. 2012) (establishing that a party seeking to invalidate a patent as obvious has the burden of showing "that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so") (citations omitted).

Petitioner presents several generic benefits of a web server that are unrelated to the modifications it seeks to make to Toge's system. *See* Pet. at 15 (suggesting that a POSITA would have been motivated to combine Toge with Kumar because it "would have **improved** the physician-side computer of Toge by implementing it with the browser-based engine accessible through web pages"); *id.* at 53 (suggesting that

“[s]uch a feature would have been **beneficial** as Kumar explains that ‘the data may be stored in a secured storage device at the central server for later access’”) (quoting Kumar at ¶ [0083]); Ex. 1005 (“Chatterjee”) at ¶ 76 (asserting that a POSITA “would have been motivated to **improve** the physician-side computer taught in Toge by implementing it as the central server with browser-based engine as taught by Kumar”) (emphases added); *see also* Chatterjee at ¶ 146 (“[T]he physician-side computer could be implemented as a web server.”).

Contrary to Petitioner’s suggestion that its proposed combination would be an improvement to Toge, Petitioner’s proposed combination introduces unnecessary redundancy, complexity, and cost. *See* §VII.A.1, *supra*. Toge’s PAP device already includes relay functionality that is capable of transferring data directly to any number of physician-side client devices, which allows medical professionals to receive “crucial data” instantly and take emergency measures. Toge at ¶ [0054]; *see also id.* at ¶¶ [0039], [0047]. For example, the PAP device pushes patient data to the physician-side client device when the patient’s oxygen level falls below a 90% threshold:



Id. at ¶ [0047] (describing setting an oxygen saturation threshold value of 90% and transmitting a patient's oxygen value to the physician-side devices if it falls below the threshold such that "emergency measures" can be taken); *see also id.* at ¶¶ [0039], [0054]-[0055], [0057]. However, in Petitioner's proposed Toge-Kumar system, where the physician-side mobile device would now have to **request** such data from a web server (the modified physician-side computer),⁵ medical

⁵ Toge's physician-side computer is modified to be a web server that hosts a web page (e.g., Kumar's TeleVital), and it can only operate as a web server. *See* Chatterjee at ¶ 91 ("modifying the physician-side computer taught by Toge [sic] to

emergencies would go unanswered until a request is made, if even made. See Chatterjee at ¶¶ 32-36 (explaining that in the web server-client architecture, the client sends a HTTP request to the server to access the web page and request data).

Petitioner does not acknowledge these issues and cannot explain how adding a web server (hosting a browser-based engine) could improve Toge's system, which already provides for storage and transmission of data (see § VII.A.1, *supra*). *Stodge, Inc. D/B/A Postscript v. Attentive Mobile Inc.*, No. IPR2023-01338, Paper 10 at 11 (P.T.A.B. July 29, 2024) (denying 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 advertainment . . ."); *Markforged Inc. v. Continuous Composites, Inc.*,

implement it as the central server with browser-based engine accessible through web pages"), ¶¶ 76, 92, 146. In this web application, it cannot also operate as a client device because data would only be accessible to the single device which is "not suitable for a web application." Ex. 2003 at 4-5 (disclosing that in a one-tier architecture, "it cannot share information from one client machine to others"). Accordingly, Toge's modified physician-side computer operates only as the web server that transfers data to the physician-side client devices (e.g., the physician-side mobile device).

No. IPR2022-00548, Paper 8 at 14 (P.T.A.B. Sept. 9, 2022) (denying the petition 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 fibre 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) (denying the petition because the “[p]etitioner does not explain adequately why modifying Ejiri . . . would have been an improvement on what Ejiri already provides”).

While Petitioner presents several motivation arguments, they do not change the conclusion. Petitioner’s first argument on “convenience and efficiency” (Pet. at 15-16) expounds upon the redundancy in its proposed combination because Toge’s system already achieves this through its physician-side mobile terminal that allows medical professionals to “remotely monitor” and “collect[] data accessible anywhere.” *Id.* at 16; Toge at ¶¶ [0018]-[0019], [0061] (disclosing that mobile terminal 5 is “**mobilized**” to collect and download treatment data and set threshold values) (emphasis added). Indeed, as Petitioner acknowledges, Toge’s “access [of] the data anywhere” is through its “specialized software” on the physician-side mobile terminal. Pet. at 16.

Petitioner’s second argument on “health access to more people” is unconnected to Toge’s **medical professional access**. *Id.* (“allow[ing] anyone” to access data). Toge only allows medical professionals to access the treatment data—

either on the physician-side computer or mobile terminal—it does not allow, let alone contemplate, granting access to anyone. Toge at ¶ [0018] (“Medical institution personnel such as physicians and nurses can access the transmitted data using the physician side computer 4.”); *id.* at ¶ [0061] (“The positive pressure artificial respiration assisting device 2 then directly transmits all or part of the treatment data to the physician-side computer 4 or mobile terminal 5”). Finally, Petitioner’s third and fourth arguments predicated on “advances in mobile computing” and “general market trend” (Pet. at 16-17) are “generic and bear[] no relation to any specific combination of the prior art.” *ActiveVideo Networks*, 694 F.3d at 1328.

For at least the foregoing reasons, a POSITA would **not** have been motivated to modify Toge’s system with Kumar’s browser-based engine teachings to arrive at the remote internet site limitation.

B. Toge in View of Kumar Does Not Render Obvious Software on a Base Station/Cell Phone/PDA Adapted to Retransmit Data to the Remote Internet Site (Claim 1), Receive the Data That is Retransmitted by the Remote Internet Site (Claim 7), and Receive Data Independent of the Remote Internet Site (Claim 12)

Because Toge in view of Kumar does not teach the “remote internet site,” it also fails to teach the claimed invention’s software limitations, all of which require the “remote internet site.” *See* ’921 Patent at Claims 1, 7, and 12. Additionally, Toge in view of Kumar fails to meet these limitations for at least the reasons that follow.

1. Toge in View of Kumar Does Not Render Obvious the Software is Adapted to Retransmit Data to the Remote Internet Side (Claim 1)

Toge in view of Kumar does not disclose a base station, cell phone, or PDA including “software . . . adapted to retransmit a data related to the subject’s treatment and the treatment’s efficacy received by the software from the first radio frequency wireless transceiver of the PAP device, in whole or part, to the remote internet site.” ’921 Patent at Claim 1. The plain language of this limitation requires a base station that receives patient data from the PAP device and retransmits it to a remote internet site, which does not exist in Petitioner’s proposed combination of Toge and Kumar, but that base station does not exist in Petitioner’s proposed combination.

In order to meet the “base station” limitation, Petitioner argued that Toge’s mobile terminal 5 executes the claimed software. *See* Pet. at 46-47 (for this limitation, Petitioner alleges that “Toge discloses mobile terminal 5 may be ‘mobile phones’ or ‘PDAs’” that “executes software stored on non-volatile memory”); *id.* at 55-59. However, in the combined system of Toge and Kumar, there is no reason (and Petitioner identifies none) why this mobile terminal would retransmit patient data *anywhere*, let alone to Toge’s modified physician-side computer that now operates as a web server. *Id.* at 55. In fact, in the same section, Petitioner acknowledges that the physician-side computer and mobile terminal **both** receive

patient data from the PAP device and fails to explain under what circumstances the mobile terminal would retransmit any data to the physician-side computer. *Id.*

Petitioner does not explain these inconsistencies. Instead, it makes a deliberately vague argument meant to obscure the fact that the “software” is supposed to be executed on Toge’s mobile terminal:

[I]t would have been ***obvious to a POSITA to implement the Toge system is [sic] such a way that the software is adapted retransmit a data related to the subject’s treatment and the treatment’s efficacy*** received by the software from the first radio frequency wireless transceiver of the PAP device.

Id. (emphasis added). While Petitioner does not expressly identify or explain where the data is retransmitted to (which is Petitioner’s burden), Toge’s system is implemented in such a way that data is retransmitted ***to the PAP device***. See *Nichia Corp. v. Document Sec. Sys., Inc.*, No. 2020-2261, 2022 WL 1218036, at *4 (Fed. Cir. Apr. 26, 2022) (“The patent challenger must provide an understandable explanation of the element-by-element specifics of its unpatentability contentions, identifying supporting disclosures from the asserted prior art.” (citing 35 U.S.C. § 312(a)(3))).

Toge discloses that both its physician-side computer and mobile terminal (physician-side client devices) retransmit data directly to the PAP device. In response to receiving treatment data (for example, when a threshold value is met

(90% oxygen)), Toge's physician-side client devices can "adjust[] the prescription pressure to a higher level" or "adjust[] the flow rate" of the PAP device. Toge at ¶ [0047]; *see also id.* at ¶¶ [0039], [0068] (the physician-side computer adjusting the prescription value on the PAP device). That is, this adjustment data is *retransmitted* to the PAP device from Toge's physician-side client devices. *See* § VII.A.1, *supra* (diagram depicting the direct transfer of data between devices, with no browser-based engine/server). Because Toge's system retransmits data to the PAP device, there is no reason to retransmit the data to a web server, as in Kumar, where the patient would have to request the data via web page access to make the necessary PAP adjustments, for example. *See* Ex. 2002 at 2-3 ("[B]ecause information can only be pulled from a web server after a client's request. The web server never pushes information to a client without a request.").

Therefore, based on Toge's "obvious" implementation of retransmitting data *to the PAP device* (Pet. at 55), a POSITA would not have found it obvious to retransmit to a remote internet site. Petitioner's reliance on Kumar's web server's storage capabilities does not show otherwise. *Id.* at 56. Again, the PAP device *already* includes a database for storage, and therefore retransmission would be to the PAP device for any storage needs. *See* § VII.A, *supra*.

2. Toge in View of Kumar Does Not Render Obvious the Software is Adapted to Receive the Data That is Retransmitted by the Remote Internet Site (Claim 7)

Toge in view of Kumar does disclose a base station, cell phone, or PDA with “software . . . adapted to receive, in whole or part, the data related to the subject’s treatment and the treatment’s efficacy generated by the PAP device that is first received by then retransmitted from the remote internet site.” ’921 Patent at Claim 7.

As discussed above, Toge’s physician-side computer and physician-side mobile terminal are both client devices that receive treatment data directly from the PAP device. And Petitioner’s acknowledgment that these physician-side client devices first receive the treatment data “from the radio frequency wireless transceiver of the PAP device” (Pet. at 55) refutes its conclusory suggestion here that it would have been obvious to have such data “**first received** by then retransmitted from the **remote internet site**” (browser-based engine). *Id.* at 56-57 (emphasis added).

Apart from this, a POSITA would not have been motivated to modify Toge’s physician-side computer to include a web server. *Id.* at 57-59; see § VII.A, *supra*. Each reference has a solution to telemedicine, but they are distinctly different in their approach to transferring data, and neither teaches or suggests the arrangement recited in Claim 7 of the ’921 Patent. For example, while Toge implements a push protocol

that sends treatment data without a request, Kumar implements a pull protocol that sends data only upon request.

A push protocol is where a “sender can deliver traffic ***at will*** to a receiver” and the “receiver[] ***passively accept[s]*** whatever the sender[] push[es] to them.” Ex. 2001 at 25-26 (emphasis added). Toge implements such an approach when a threshold value is met, as the PAP device (the sender) selectively pushes the crucial data to the physician-side client devices:

By setting thresholds in this manner, it becomes possible to selectively ***transmit only the necessary or crucial data to the physician-side computer or portable device 5.***

Toge at ¶ [0054] (emphasis added). For instance, Toge explains that by setting a threshold (90% oxygen saturation, for example), the physician-side client devices are pushed crucial data (e.g., 89% oxygen) if the threshold is met such that medical professionals can take emergency measures, as the diagram in Section VII.A.2 above depicts. See Toge at ¶ [0047] (“[I]f the oxygen saturation, for example, falls below 90%, ***physicians can take emergency measures***”) (emphasis added).

In contrast, a pull protocol is where data is pulled from a web server ***only upon request***. Ex. 2001 at 25 (a pull protocol is where the “receivers can regulate *if and when* they wish to retrieve data such as the HTTP-based web access system”); Ex. 2002 at 2-3 (describing that with a pull protocol “because information can only be pulled from a web server after a client’s request. The web server never pushes

information to a client without a request”); Chatterjee at ¶¶ 32-36 (discussing how the HTTP request works in the client-server architecture to access a web page and data). With Kumar's browser-based engine, data is pulled from its web server “if and when” (Ex. 2001 at 25) a medical professional's device accesses a web page (e.g., TeleVital) and requests patient data. Kumar at ¶¶ [0078]-[0083], [0091]-[0092], FIG. 5 (depicting the TeleVital web page).

Where Toge's approach pushes data **at will** from the PAP device to the physician-side client devices to ensure medical emergencies are responded to, Kumar's approach pulls data from a web server **if, and only if, requested**. Therefore, utilizing a web server that **first** receives the treatment data and **only** retransmits to the physician-side client device upon web page request, as Petitioner's proposal dictates,⁶ would have altered Toge's key functionality. *Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.*, 809 F. App'x 990, 1000 (Fed. Cir. 2020) (“[T]he loss of key functions in the primary reference here supports a finding of no motivation to combine.”); *see also Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 69 F.4th 1341, 1349-50 (Fed.

⁶ Petitioner's expert, Dr. Chatterjee, explaining that the data is stored at the server such that the “mobile terminal 5 could access the physician-side computer (whether modified by Kumar) to **request** the patient's data.” Chatterjee at ¶ 168 (emphasis added).

Cir. 2023) (expressing that the Board must consider whether “a proposed modification would interfere with a reference’s stated purpose” and where the purpose is destroyed, it counsels strongly against obviousness) (citation omitted).

Additionally, because Toge’s PAP device already stores and transmits treatment data directly to the physician-side client devices (*see* § VII.A, *supra*), there is no need to have the data also stored at the browser-based engine’s central server, as Petitioner suggests. *See* Pet. at 58-59 (stating that “the browser-based engine may store medical record[s] of a patient.”).

3. Toge in View of Kumar Does Not Render Obvious the Software and the Remote Internet Site Independently Receive the Data (Claim 12)

The Challenged Claims require that “both the software and the remote internet site independently receive, in whole or part, the data related to the subject’s treatment and the treatment’s efficacy generated by the PAP device.” ’921 Patent at Claim 12. Toge, taken alone or in combination with Kumar, does not teach software on a device and a remote internet site that “separately/independently” (Pet. at 60) receives data because in Toge *only* physician-side client devices receive the data, and in Petitioner’s Toge-Kumar combination the browser-based engine would facilitate the transfer of the data between devices.

Petitioner admits throughout the Petition that Toge’s physician-side client devices, computer 4 and mobile terminal 5, both receive treatment data directly from

the PAP device. *See id.* at 22-23, 38-39, 55, 57. Indeed, Toge describes the physician-side computer as “a computer installed at a medical institution (hospital, clinic, medical office, etc.)” that, like the mobile terminal, receives treatment data from the PAP device. *See* § VII.A.1, *supra*; Toge at ¶ [0017]; *see also id.* at ¶¶ [0019], [0054], [0061]. These admissions (and Toge’s plain disclosure) contradict Petitioner’s assertion with respect to Claim 12 that Toge’s physician-side computer is a web server (hosting a browser-based engine) that would receive data from a mobile terminal instead of the PAP device. Pet. at 59-60.⁷

Furthermore, for the reasons discussed above, a POSITA would **not** have been motivated to modify Toge’s physician-side computer to be a web server that hosts a browser-based engine as in Kumar. *See, e.g.,* § VII.A, *supra*. Thus, because the

⁷ Petitioner did not allege in its limitation 7[c.i] analysis that Toge’s physician-side computer is a remote internet site (web server hosting a browser-based engine) that functions differently than the physician-side mobile terminal, as it claims it did here. *See* Pet. at 59. Instead, Petitioner asserted that both the “software on physician side computer 4 **and** mobile terminal 5 receive[]” data directly from the PAP device. *Id.* at 56-57 (emphasis added); *see also id.* at 55 (same), 38-39. Accordingly, by Petitioner’s own admission, the physician-side computer’s software functions in the same manner as the mobile terminal’s software—both as client devices.

physician-side computer and mobile terminal are both physician-side client devices, there is no remote internet site (browser-based engine hosted on a web server) that separately/independently receives the treatment data.

Even in Petitioner's Toge-Kumar combination, there is no separate/independent transfer of data because Kumar's browser-based engine/server manages the transfer of data between devices. Kumar at ¶ [0081] (emphasis added) (disclosing that the web server's "***engine manages transmission of the data*** from the patient-side device to the provider-side device" when the medical professional accesses the web page). Although Petitioner asserts that Kumar discloses that data is "transferred '***directly*** from one device to the other,'" ⁸ Petitioner ignores the rest of the passage describing that the browser-based engine facilitates this transfer. Pet. at 60 (italics added) (relying on the transfer "from the PAP device to the provider-side device"). Petitioner conveniently ignores this disclosure when making this argument despite acknowledging elsewhere that "the data [is] sent to the engine [and] . . . accessed through web pages which serve as a graphical user interface, such as the 'patient's real-physiological data.'" *Id.* at 52. Thus, put succinctly, the transfer of data "from the PAP device to the provider-side device" is ***dependent upon*** the browser-based engine/server. *Id.* at 60.

⁸ Pet. at 60 (quoting Kumar at ¶ [0081]).

Accordingly, Toge alone or in combination does not teach software on a device and a remote internet site that both independently receive data, as required by Independent Claim 12. *See* '921 Patent at Claim 12.

* * *

In view of the foregoing reasons, Toge in view of Kumar does not disclose a base station, cell phone, or PDA that meets the claimed software limitations.

VIII. GROUND 2: THE CHALLENGED CLAIMS ARE PATENTABLE OVER TOGE IN VIEW OF KUMAR, BURTON AND, KISNER

Petitioner relies on Kisner only for claim limitation of “sensor data from the sensors is processed by the first processor using one or more of the signal processing techniques” (Pet. at 69). Accordingly, Kisner does not resolve the deficiencies noted above. Therefore, Ground 2 fails for the same reasons Ground 1 fails.

IX. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution.

Respectfully submitted,

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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 10,336 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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