

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,
Patent Owner.

IPR2025-00159
Patent 11,375,921 B1

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

HARDMAN, *Administrative Patent Judge*.

ORDER

Sua Sponte Staying Concurrent Ex Parte Reexamination
35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a)

I. INTRODUCTION

On June 12, 2025, we instituted *inter partes* review in the above-referenced case, as to claims 1, 2, 4, 5, 7–9, 11–14, and 16 of U.S. Patent No. 11,375,921 B1 (“the ’921 patent”).

On October 11, 2024, Petitioner had previously filed a Request for *Ex Parte* Reexamination of claims 1–16 of the ’921 patent. Ex. 3001. On November 15, 2024, the request was granted in Reexamination Control No. 90/019,700 (the “’700 Reexamination”). Ex. 3002.

The Board has authority to stay a reexamination involving a patent challenged in an *inter partes* review. *See* 35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a); *see also* Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16,654, 16,657 (Apr. 22, 2019) (“Notice”) (noting that the Board “may impose a stay *sua sponte*”). For the reasons discussed below, we determine that there is good cause to stay the ’700 Reexamination pending resolution of this *inter partes* review.

II. ANALYSIS

The Notice outlines factors the Board may consider in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. *See* Notice, 84 Fed. Reg. at 16,657. We discuss each factor below.

A. Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding

Every claim challenged in this *inter partes* review is involved in the ’700 Reexamination. This favors a stay.

B. Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings

The grounds of unpatentability in this *inter partes* review and the '700 Reexamination are both based on alleged obviousness, and at least the Kisner reference is currently involved in both proceedings. *See, e.g.*, Ex. 3003 (Final Rejection in '700 Reexamination) 2. This favors a stay.

C. Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Because the claims at issue in this *inter partes* review are also at issue in the '700 Reexamination, allowing both to proceed concurrently would duplicate efforts. This favors a stay.

D. Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding)

Because the claims at issue in this *inter partes* review are also at issue in the '700 Reexamination, there is a possibility of inconsistent results. This favors a stay.

E. Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

Because the claims at issue in this *inter partes* review are also at issue in the '700 Reexamination and Patent Owner may amend the scope of the claims in either proceeding, this favors a stay.

F. The respective timeline and stage of each proceeding

In the '700 Reexamination, the Examiner issued a final rejection on July 9, 2025. *See* Ex. 3003. In this *inter partes* review, we entered a decision granting institution on June 12, 2025. Paper 10. Thus, in both proceedings, the Office has invested some resources, but a significant amount of work remains in each. This factor is neutral.

G. The statutory deadlines of the respective proceedings

This *inter partes* review is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). The '700 Reexamination is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305. This factor favors a stay.

H. Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot

Because both proceedings involve overlapping claims, a decision in one proceeding could potentially simplify or render moot the other proceeding. However, considering the current stages of the proceedings and the statutory deadline for this proceeding, this factor favors a stay.

III. CONCLUSION

For the foregoing reasons, we find good cause for staying the '700 Reexamination pending resolution of this *inter partes* review. *See also* Notice, 84 Fed. Reg. at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that that Reexamination Control No. 90/019,700 is stayed pending the termination or completion of IPR2025-00159;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,700 are tolled for the duration of the stay, and no further papers shall be filed without authorization in the reexamination while this stay remains in place; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting time periods for responding to any outstanding papers in Reexamination Control No. 90/019,700.

IPR2025-00159
Patent 11,375,921 B1

For PETITIONER:

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

For PATENT OWNER:

James Hannah
Jeffrey Price
Jenna Fuller
Jeffrey Eng
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com
jfuller@kramerlevin.com
jeng@kramerlevin.com