

From: [Director Discretionary Decision](#)
To: [Nguyen, Lisa K.](#); [Mark J. DeBoy](#); [Tennant, David](#); [PH-Resmed-Fractus](#); [Alexander, Kamilah](#); [Lancaster, Eric](#); [Director Discretionary Decision](#)
Cc: [Patrick Finnan](#); [Larry Shatzer](#)
Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition
Date: Friday, April 17, 2026 3:41:12 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)

Patent Owner may file a 5-page reply in IPR2026-00191, due no later than Tuesday, April 21, 2026, limited to addressing the matters raised below. Petitioner is authorized a 5-page sur-reply, due no later than Thursday, April 23, 2026.

From: Nguyen, Lisa K. <lisanguyen@paulhastings.com>
Sent: Friday, April 17, 2026 11:21 AM
To: Mark J. DeBoy <mdeboy@esfip.com>; Tennant, David <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>
Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

You don't often get email from lisanguyen@paulhastings.com. [Learn why this is important](#)

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

To the Director,

It is unfortunate that Patent Owner sent the email below in contravention of the Board's rules. In response to Patent Owner's requests to address issues (A) and (B), Petitioner provides the following response, which is the same as provided to Patent Owner previously.

Petitioner does not oppose a 5-page reply and surreply limited strictly to issue (A).

Petitioner respectfully opposes the request regarding issue (B) because Patent Owner does not establish good cause. Patent Owner's failure to address its undisputed litigation history in its opening brief is not good cause. Moreover, the letters referenced by Patent Owner did not provide notice of the subject patent, and regardless, Patent Owner chose to omit these facts from its opening brief and should not be permitted to supplement its briefing now. See March 26, 2025 Interim Processes for PTAB Workload Management at 2.

Petitioner is available throughout the week of April 20, 2026 should there be a need for a conference call.

Respectfully submitted,

Lisa Nguyen
Lead Counsel for Petitioner

PAUL
HASTINGS

Lisa Nguyen | Partner

Paul Hastings LLP | 1117 S. California Avenue, Palo Alto, CA 94304 |
Direct: +1.650.320.1890 | Main: +1.650.320.1800 | Fax:
+1.650.320.1990 | lisanguyen@paulhastings.com |
www.paulhastings.com

From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Friday, April 17, 2026 8:03 AM

To: Tennant, David <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>; Director_Discretionary_Decision <director_discretionary_decision@uspto.gov>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: [EXT] IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

To the Director,

Patent Owner writes to request a short reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191.

Patent Owner seeks a 5-page reply to address: (A) the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum, and (B) the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent.

Patent Owner respectfully submits that good cause exists for its request. Regarding issue (A), Patent Owner's Discretionary Denial Request was due on March 9, 2026, and therefore, Patent Owner did not have an opportunity to address the considerations in the March 11, 2026 Memorandum. As Petitioner made these considerations a central part of its Discretionary Denial Opposition, fairness considerations provide good cause for granting Patent Owner a short reply. Regarding issue (B), good cause exists for a reply because Petitioner's assertion that it could not have anticipated being sued under the subject patent is directly contrary to the fact that Petitioner was notified of the subject patent and its infringement thereof by Patent Owner via letters in 2021 and 2022, facts Petitioner omitted from its opposition. Good cause exists to allow Patent Owner to present all relevant facts to the Director at the discretionary denial stage. Further, Patent Owner could not have anticipated that Petitioner would take a position directly contrary to the undisputed litigation history.

Patent Owner is available throughout the week of April 20, 2026 to discuss this request via conference call.

As indicated in the email chain forwarded below, Patent Owner made substantial efforts to send this request as a joint email with Petitioner. As the parties reached an impasse, Patent Owner is sending this request without Petitioner's position on the request, but expects that Petitioner will send an additional email to provide the Director with its position and availability for a conference call.

Respectfully submitted,

Mark DeBoy

Lead Counsel for Patent Owner, Fractus S.A., in IPR2026-00191

Mark J. DeBoy

Partner



EDELL • SHAPIRO • FINNAN

9801 Washingtonian Boulevard, Suite 750

Gaithersburg, MD 20878

mdeboy@esfip.com

Direct: 240-864-2459

Fax: 301-762-4056

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From: Mark J. DeBoy

Sent: Friday, April 17, 2026 10:58 AM

To: 'Tennant, David' <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

David,

Patent Owner cannot join an email to the Director and Board that includes factual misrepresentations. Your proposed email indicates that "the letters referenced by Patent Owner did not provide notice of the subject patent." Reproduced below are annotated screenshots from the communications that clearly identify the '677 patent and indicate that Fractus believed that at least claim 1 of the '677 patent was being infringed by Petitioner's AirSense 11 product.

Exhibit II

List of patents that are owned by Fractus as of 05/31/2021 and available for
license to ResMed

Patent number	Patent number	Patent number	Patent number	Patent application
US11031677	US8581785	US7911394	US7015868	US17/246192

Patent	Claim	Product
		ResMed AirSense 11
U.S. Patent No. 8,362,960	1	X
	7	X
U.S. Patent No. 8,810,458	1	X
	2	X
	4	X
	7	X
U.S. Patent No. 8,111,199	21	X
U.S. Patent No. 11,031,677	1	X

Further, your email is taking contradictory positions, stating that the litigation history is “undisputed,” and in the next sentence disputing Patent Owner’s position in the litigation that Petitioner was provided with notice of, and infringement by, the ‘677 patent.

It seems that the parties are at an impasse. Patent Owner will be emailing the Director with its request and will include our email exchange so that the Director can see that Patent Owner undertook substantial efforts to reach an agreement with Petitioner and send a joint communication. Petitioner is, of course, welcome to respond with its position.

If Petitioner plans to request a reply to the POPR from the Board, we do not authorize Petitioner to represent Patent Owner’s position without our express approval of your email. Patent Owner will respond separately to the Board with its position.

Regards,
Mark

From: Tennant, David <davidtennant@paulhastings.com>

Sent: Thursday, April 16, 2026 8:33 PM

To: Mark J. DeBoy <mdeboy@esfip.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

Mark,

Below is a revised draft. We accepted the changes in red (changed to black font), and added responsive positions by Petitioner in red. Also, we understand that Petitioner will send. Accordingly, the positions in the email have been swapped. Obviously, that is not shown in red. Please let us know if we have permission to send this to the two emails indicated in your email.

++++++

To the Director and the Honorable Board,

The parties are jointly writing so that Petitioner can request a short reply to the Patent Owner Preliminary Response and so that Patent Owner can request a short reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191 in the same proceeding. **The parties have met and conferred this week and respectfully request further guidance to resolve the remaining issues addressed below.**

Petitioner requests leave to file a 5-page Reply to address (1) new arguments regarding competing expert positions for Ground 3, and (2) the improper collateral attack on the institution decision in IPR2025-01026, to which joinder is sought (see Motion for Joinder (Paper 3)). Good cause exists because the POPR incorrectly invites the Board to weigh conflicting expert testimony at the institution stage and attempts to relitigate the Board's institution decision in a different proceeding. A short, targeted Reply will clarify the record and assist the Director and Board. Petitioner does not oppose a surreply of equal length. Patent Owner opposes this request and provided the following position:

Patent Owner respectfully submits that good cause does not exist for Petitioner's request. Regarding issue (1), Patent Owner has not relied on expert testimony in its arguments against Ground 3. Patent Owner relies on the government's own orders and regulations which speak for themselves. Therefore, Petitioner's position that "the POPR incorrectly invites the Board to weigh conflicting expert testimony at the institution stage" is incorrect. Regarding issue (2), Patent Owner is not "attempt[ing] to relitigate the Board's institution decision in a different proceeding." Patent Owner was within its rights to submit new and different evidence in this proceeding. Petitioner failing to uncover and address this new evidence in the Petition cannot give rise to good cause for a reply as Petitioner made the strategic decision to file a copycat petition.

Patent Owner seeks a 5-page reply to address (A) the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum, and (B) the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers. Patent Owner respectfully submits that good cause exists for its request. Regarding issue (A), Patent Owner's Discretionary Denial Request was due on March 9, 2026, and therefore, Patent Owner did not have an opportunity to address the considerations in the March 11, 2026 Memorandum. As Petitioner made these considerations a central part of its Discretionary Denial Opposition, fairness considerations provide good cause for granting Patent Owner a short reply. Regarding issue (B), good cause exists for a reply because Petitioner's assertion that it could not have anticipated being sued under the subject patent is directly contrary to the fact that Petitioner was notified of the subject patent and its infringement thereof by Patent Owner via letters in 2021 and 2022, facts Petitioner omitted from its opposition. Good cause exists to allow Patent Owner to present all relevant facts to the Director at the discretionary denial stage.

Petitioner provided the following position.

Petitioner does not oppose a 5-page reply and surreply limited strictly to issue (A).

Petitioner respectfully opposes the request regarding issue (B) because Patent Owner does not establish good cause. Patent Owner's failure to address its undisputed litigation history in its opening brief is not good cause. Moreover, the letters referenced by Patent Owner did not provide notice of the subject patent, and regardless, Patent Owner chose to omit these facts from its opening brief and should not be permitted to supplement its briefing now. See March 26, 2025 Interim Processes for PTAB Workload Management at 2.

In the event that either request is granted, the opposing party requests a sur-reply of equal length.

The parties are available during the week of April 20 for a conference call should there be a need.

Respectfully submitted,

+++++

PAUL
HASTINGS

David Tennant | Partner

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct:
+1.202.551.1997 | Main: +1.202.551.1700 |

davidtennant@paulhastings.com | www.paulhastings.com

From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Thursday, April 16, 2026 4:12 PM

To: Tennant, David <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>
Subject: [EXT] RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

David,

We are surprised that Petitioner would characterize Patent Owner's approach as failing to complete the meet and confer process. Patent Owner has adequately explained its position with specificity, indicating good cause for its request. For example, Petitioner agreed that good cause exists for Patent Owner's request for a reply to address the U.S. manufacturing and small business discretionary denial considerations. With regard to Patent Owner's request for a reply to address Petitioner's assertion that it could not have anticipated being sued under the '677 patent, Petitioner explicitly identified the notice letter sent to Petitioner in 2021 rendering this position unreasonable. It is surprising that Petitioner would consider this assertion unclear given this letter and others were described in the complaint in the related litigation, in which Petitioner's lead counsel is also the attorney of record. Petitioner, on the other hand, has used the meet and confer process as a fishing expedition to try to uncover Patent Owner's substantive arguments. For example, Petitioner's email from earlier today failed to advance the discussion towards contacting the Board and instead sought to uncover the substantive arguments Patent Owner plans to present in its reply. With regards to the allegation that Petitioner has set an arbitrary deadline, Petitioner correctly indicated that the request should be sent this week. Finally, given your email from earlier today, Patent Owner understood that you were no longer being hindered by travel.

Further, we object to the approach in the draft email provided. Specifically, the draft is overly argumentative and contrary to the Board's guidance regarding email communications. We have, however, accepted your edits and provided Petitioner's edits in red in order to match your approach. You have Patent Owner's permission to send the email as provided below to trials@uspto.gov and Director_Discretionary_Decision@uspto.gov. To be clear, we do not authorize the sending of any version of this email to the Board without our final sign-off. I would also be happy to send the email on the parties' behalf.

Regards,
Mark

++++++

To the Director and the Honorable Board,

The parties are jointly writing so that Patent Owner can request a short reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191 and so that Petitioner can request a short reply to the Patent Owner Preliminary Response in the same

proceeding.

Patent Owner seeks a 5-page reply to address (A) the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum, and (B) the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers. Patent Owner respectfully submits that good cause exists for its request. Regarding issue (A), Patent Owner's Discretionary Denial Request was due on March 9, 2026, and therefore, Patent Owner did not have an opportunity to address the considerations in the March 11, 2026 Memorandum. As Petitioner made these considerations a central part of its Discretionary Denial Opposition, fairness considerations provide good cause for granting Patent Owner a short reply. Regarding issue (B), good cause exists for a reply because Petitioner's assertion that it could not have anticipated being sued under the subject patent is directly contrary to the fact that Petitioner was notified of the subject patent and its infringement thereof by Patent Owner via letters in 2021 and 2022, facts Petitioner omitted from its opposition. Good cause exists to allow Patent Owner to present all relevant facts to the Director at the discretionary denial stage.

Petitioner provided the following position.

Petitioner respectfully opposes the request regarding issue (B). Patent Owner refuses explain its position (specifically, what clarification is needed for the identified issue) and has failed to identify good cause as to why it could not raise any additional facts related to this issue in its opening brief. See March 26, 2025, Interim Processes for PTAB Workload Management, pg. 2. However, Petitioner does not oppose to a 5-page reply and surreply limited strictly to issue (A).

Petitioner requests leave to file a 5-page Reply to address (1) new arguments regarding competing expert positions for Ground 3, and (2) the improper collateral attack on the institution decision in IPR2025-01026, to which joinder is sought (see Motion for Joinder (Paper 3)). Good cause exists because the POPR incorrectly invites the Board to weigh conflicting expert testimony at the institution stage and attempts to relitigate the Board's institution decision in a different proceeding. A short, targeted Reply will clarify the record and assist the Director and Board. Petitioner does not oppose a surreply of equal length. Patent Owner opposes this request and provided the following position:

Patent Owner respectfully submits that good cause does not exist for Petitioner's request. Regarding issue (1), Patent Owner has not relied on expert testimony in its arguments against Ground 3. Patent Owner relies on the government's own orders and regulations which speak for themselves. Therefore, Petitioner's position that "the POPR incorrectly invites the Board to weigh conflicting expert testimony at the institution stage" is incorrect. Regarding issue (2), Patent Owner is not "attempt[ing] to relitigate the Board's institution decision in a different proceeding." Patent Owner was within its rights to submit new and different evidence in this proceeding. Petitioner failing to uncover and address this new evidence in the Petition cannot

give rise to good cause for a reply as Petitioner made the strategic decision to file a copycat petition.

In the event that either request is granted, the opposing party requests a sur-reply of equal length.

The parties are available during the week of April 20 for a conference call should there be a need.

Respectfully submitted,

Mark J. DeBoy

Partner



EDELL • SHAPIRO • FINNAN

9801 Washingtonian Boulevard, Suite 750

Gaithersburg, MD 20878

mdeboy@esfip.com

Direct: 240-864-2459

Fax: 301-762-4056

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From: Tennant, David <davidtennant@paulhastings.com>

Sent: Thursday, April 16, 2026 2:50 PM

To: Mark J. DeBoy <mdeboy@esfip.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

Mark,

It is disappointing that you are unwilling to complete the meet-and-confer process and have instead imposed an arbitrary deadline, especially while members of our team are traveling. Declining such a standard professional courtesy is an unfortunate precedent to set. Despite this, we remain committed to our position and to submitting the joint email this week as we confirmed below.

We revised the prior version sent to us. Petitioner's position is in red. We made minor, non-substantive edits to Patent Owner's position in the second paragraph to improve flow (these are not in red).

Please share any further revisions with us. To be clear, we do not authorize the sending of any version

of this email to the Board without our final sign-off.

++++++

To the Director and the Honorable Board,

The parties are jointly writing so that Patent Owner can request a short reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191 and so that Petitioner can request a short reply to the Patent Owner Preliminary Response in the same proceeding.

Patent Owner seeks a 5-page reply to address (A) the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum, and (B) the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers. *Petitioner provided the following position.*

Petitioner respectfully opposes the request regarding issue (B). Patent Owner refuses explain its position (specifically, what clarification is needed for the identified issue) and has failed to identify good cause as to why it could not raise any additional facts related to this issue in its opening brief. See March 26, 2025, Interim Processes for PTAB Workload Management, pg. 2. However, Petitioner does not oppose to a 5-page reply and surreply limited strictly to issue (A).

Petitioner requests leave to file a 5-page Reply to address (1) new arguments regarding competing expert positions for Ground 3, and (2) the improper collateral attack on the institution decision in IPR2025-01026, to which joinder is sought (see Motion for Joinder (Paper 3)). Good cause exists because the POPR incorrectly invites the Board to weigh conflicting expert testimony at the institution stage and attempts to relitigate the Board's institution decision in a different proceeding. A short, targeted Reply will clarify the record and assist the Director and Board. Petitioner does not oppose a surreply of equal length. Patent Owner opposes this request.

In the event that either request is granted, the opposing party requests a sur-reply of equal length.

The parties are available *during the week of April 20* for a conference call *should there be a need*.

Respectfully submitted,

PAUL
HASTINGS

David Tennant | Partner

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct:
+1.202.551.1997 | Main: +1.202.551.1700 |

From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Thursday, April 16, 2026 1:34 PM

To: Tennant, David <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: [EXT] RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

David,

Our position is clear. We intend to ask for a reply to address this representation by Petitioner, which Patent Owner believes is unreasonable based on evidence that will be presented with any reply that is granted.

Unless we hear from you by 5 PM Eastern with a proposed joint email to the Director and Board, Petitioner will send the following email to the Director.

Regards,
Mark

To the Director,

Patent Owner writes to request a short reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191.

Patent Owner seeks a 5-page reply to address the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum, which issued after Patent Owner's Discretionary Denial Request was due. Patent Owner also seeks to address the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers. Petitioner does not oppose this request with respect to the U.S. manufacturing and small business discretionary denial considerations, but does oppose Patent Owner's request to address Petitioner's knowledge of a potential suit based on the subject patent.

In the event that the request is granted, Petitioner requests a sur-reply of equal length.

Patent Owner is available at the following times for a conference call to discuss why good cause exists for this request.

- XXXX
- XXXX

As indicated in the email correspondence forwarded below, Patent Owner requested that Petitioner provide its availability for a call, but Petitioner has declined to provide it.

Respectfully submitted,

Mark J. DeBoy
Partner



EDELL • SHAPIRO • FINNAN

9801 Washingtonian Boulevard, Suite 750

Gaithersburg, MD 20878

mdeboy@esfip.com

Direct: 240-864-2459

Fax: 301-762-4056

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From: Tennant, David <davidtennant@paulhastings.com>

Sent: Thursday, April 16, 2026 12:19 PM

To: Mark J. DeBoy <mdeboy@esfip.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

Mark,

We do not completely understand the second position in the draft email. Specifically, you say that PO “seeks to address the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers.” Please clarify if you believe that this is an inaccurate representation by Petitioner and why.

Regards,
David

PAUL
HASTINGS

David Tennant | Partner

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct:
+1.202.551.1997 | Main: +1.202.551.1700 |

davidtennant@paulhastings.com | www.paulhastings.com

From: Tennant, David

Sent: Wednesday, April 15, 2026 3:40 PM

To: Mark J. DeBoy <mdeboy@esfip.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric

<ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

Mark,

Thanks for the response. To give you a heads up, we agree to a joint request to limit email traffic. But we need a little time to get back to you. A few of us are traveling (and I'm about to leave the office for travel). We should send the email this week, and we can add that the parties have been meeting and conferring. We will revert soon.

Regards,

David

PAUL
HASTINGS

David Tennant | Partner

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct:
+1.202.551.1997 | Main: +1.202.551.1700 |

davidtennant@paulhastings.com | www.paulhastings.com

From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Wednesday, April 15, 2026 2:47 PM

To: Tennant, David <davidtennant@paulhastings.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: [EXT] RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

David,

Having considered Resmed's arguments, Fractus cannot agree to a joint unopposed request.

Ample good cause exists for a patent owner reply addressing issues beyond the new U.S. manufacturing discretionary denial considerations. For example, Patent Owner could not have predicted that Petitioner would argue it could not anticipate being sued under the '677 patent when Patent Owner provided it with a notice letter in 2021.

As for Petitioner's request for a reply to the POPR, characterizing Patent Owner's arguments directed

to Ground 3 as “new” and presenting “competing expert positions” is simply mistaken. First, Patent Owner was under no obligation to rely on the same arguments in this proceeding that it presented in the Geotab proceeding – Petitioner made the strategic decision to file a copycat petition, but Patent Owner was under no obligation to file a copycat POPR. Further, Patent Owner presented a version of these same arguments in its Discretionary Denial Request, but Petitioner declined to address their merits in its Discretionary Denial Opposition. Finally, Patent Owner’s arguments are based on the government’s own orders and regulations, which speak for themselves. Petitioner failing to identify and address these documents in its petition does not give rise to good cause for a reply.

In order to limit the email traffic to the Director and Board, we propose sending the following joint email which, in accordance with the Board’s guidance, does not address the merits of the requests. Patent Owner is generally available for a conference call next week. If you agree to a joint email, please provide us with Petitioner’s availability and any proposed edits to the email. If you would prefer to send separate emails for each request, I would ask that you extend us the courtesy of providing us with a draft of your email so that we can review how you characterize our opposition to your request. We will, of course, extend you the same courtesy.

Regards,
Mark

To the Director and the Honorable Board,

The parties are jointly writing so that Patent Owner can request a short reply to Petitioner’s Opposition to Patent Owner’s Request for Discretionary Denial in *inter partes* review IPR2026-00191 and so that Petitioner can request a short reply to the Patent Owner Preliminary Response in the same proceeding.

Patent Owner seeks a 5-page reply to address the U.S. manufacturing and small business discretionary denial considerations set forth in the Director’s March 11, 2026 Memorandum. Patent Owner also seeks to address the representation made by Petitioner in the Opposition that it could not have anticipated that it would be sued under the subject patent because Patent Owner had not previously sued medical device manufacturers. Petitioner does not oppose this request with respect to the U.S. manufacturing and small business discretionary denial considerations, but does oppose Patent Owner’s request to address Petitioner’s knowledge of a potential suit based on the subject patent.

Petitioner seeks a 5-page Reply to the Patent Owner Preliminary Response on the issues of new arguments for Ground 3 and the propriety of Patent Owner’s arguments challenging the Board’s institution decision in the Geotab proceeding. Patent Owner opposes this request.

In the event that either request is granted, the opposing party requests a sur-reply of equal length.

The parties are available at the following times for a conference call to discuss why good cause does or does not exist for these requests.

- XXXX
- XXXX

Respectfully submitted,

Mark J. DeBoy

Partner



EDELL • SHAPIRO • FINNAN

9801 Washingtonian Boulevard, Suite 750

Gaithersburg, MD 20878

mdeboy@esfip.com

Direct: 240-864-2459

Fax: 301-762-4056

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From: Tennant, David <davidtennant@paulhastings.com>

Sent: Wednesday, April 15, 2026 11:53 AM

To: Mark J. DeBoy <mdeboy@esfip.com>; PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: RE: IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

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Mark,

Petitioner does not oppose a Reply limited strictly to the Director's new memo regarding U.S. manufacturing and the U.S. manufacturing and investments that Resmed raised in the opposition. However, Petitioner opposes a Reply on all other issues. Patent Owner's request to address the alleged notice of the '677 patent is untimely, as this issue could and should have been raised in the discretionary denial briefing. Furthermore, Patent Owner's vague request to "clarify some factual issues" is impermissibly open-ended. A Reply is not a matter of right, and Patent Owner must specifically identify each issue and establish good cause for its inclusion. Having failed to do so here, Petitioner opposes.

In addition, Petitioner intends to request a 5-page Reply on the Patent Owner Preliminary Response (POPR) on the issues of new arguments for Ground 3 and the propriety of Patent Owner's arguments challenging the Board's institution decision in the Geotab proceeding. Good cause exists because the POPR raised arguments that invites the Board to resolve competing expert positions at the institution stage and arguments that use this proceeding to collaterally attack the Board's prior institution analysis. A short, targeted reply would assist the Board in addressing those issues.

Petitioner further proposes that each party be permitted a sur-reply of equal length. If we are in agreement, we can submit a joint request for this additional briefing as unopposed. Please let us know if you are amenable to this proposal and we can redraft the email to the Board.

Regards,
David

PAUL
HASTINGS

David Tennant | Partner

Paul Hastings LLP | 2050 M Street NW, Washington, DC 20036 | Direct:
+1.202.551.1997 | Main: +1.202.551.1700 |

davidtennant@paulhastings.com | www.paulhastings.com

From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Tuesday, April 14, 2026 12:07 PM

To: PH-Resmed-Fractus <PH-Resmed-Fractus@paulhastings.com>; Alexander, Kamilah <kamilahalexander@paulhastings.com>; Lancaster, Eric <ericlancaster@paulhastings.com>; Tennant, David <davidtennant@paulhastings.com>; Nguyen, Lisa K. <lisanguyen@paulhastings.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>

Subject: [EXT] IPR2026-00191 -- Patent Owner Request for Reply to Discretionary Denial Opposition

Dear Counsel,

Patent Owner intends to request a Reply to Petitioner's Discretionary Denial Opposition in IPR2026-00191. Specifically, Patent Owner intends to request a short 5-page reply to address the Director's new guidance regarding U.S. manufacturing and to clarify some factual issues raised in the opposition, such as the notice provided to Petitioner of the '677 patent by Patent Owner. Patent Owner believes good cause exists for the reply. For example, the Director's memorandum regarding U.S. manufacturing discretionary denial considerations issued on March 11, after Patent Owner's Discretionary Denial Request was due.

Please let us know if Petitioner will be opposing this request. Please also provide your availability for a conference call with the Board, if necessary.

Provided below is a draft email to the Board for your consideration.

Bes regards,
Mark DeBoy
Counsel for Patent Owner

To the Director and the Honorable Board,

Patent Owner writes to request a brief reply to Petitioner's Opposition to Patent Owner's Request for Discretionary Denial in *inter partes* review IPR2026-00191. Patent Owner seeks a 5-page reply to address the U.S. manufacturing and small business discretionary denial considerations set forth in the Director's March 11, 2026 Memorandum. Patent Owner also seeks to clarify the factual record regarding representation made by Petition in the Opposition. Patent Owner believes good cause exists for this request. For example, the March 11 Memorandum issued after the filing of Patent Owner's Discretionary Denial Request on March 9, 2026. Good cause exists to permit Patent Owner to address these new considerations.

Petitioner **opposes/does not oppose** this request.

The parties are available at the following times for a conference call to discuss the request.

- XXXX
- XXXX

Respectfully submitted,

Mark J. DeBoy
Partner



EDELL • SHAPIRO • FINNAN

9801 Washingtonian Boulevard, Suite 750

Gaithersburg, MD 20878

mdeboy@esfip.com

Direct: 240-864-2459

Fax: 301-762-4056

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