

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

FRACTUS, S.A.,
Patent Owner.

Case No. IPR2026-00191
Patent 11,031,677

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

EXHIBIT LIST

Exhibit No.	Title
Ex. 2001	RESERVED
Ex. 2002	Defendants' Preliminary Invalidity Contentions dated June 18, 2025 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2003	Invalidity Contentions for U.S. Patent No. 11,031,677 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2004	Amended Docket Control Order dated April 10, 2025 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2005	RESERVED
Ex. 2006	RESERVED
Ex. 2007	RESERVED
Ex. 2008	RESERVED
Ex. 2009	RESERVED
Ex. 2010	Declaration of Hossein Hashemi, Ph.D.
Ex. 2011	Jack H. Winters, "Smart Antennas for Wireless Systems," IEEE Personal Communications, February 1998
Ex. 2012	3GPP TSG RAN Meeting #26, Document No. RP-040496, "Report of the 3GPP TSG RAN Long Term Evolution Work Shop," 2 -3 November 2004, Toronto, Canada"
Ex. 2013	3GPP TSG-RAN meeting #28, Document No. RP-050371, "Presentation of Specification to TSG or WG," Québec City, Quebec, 1–3 June 2005
Ex. 2014	3GPP TSG-RAN meeting #32, Document No. RP-060226, "List of CRs. Supplement to Report from RAN WG2," Warsaw, Poland, 31 st May - June 2006

Ex. 2015	Hannes Ekstrom, et al. “Technical Solutions for the 3G long-term evolution,” IEEE Communications Magazine • March 2006
Ex. 2016	Takehiro Nakamura, et al., “Super 3G Technology Trends, Part 1: Super 3G Overview and Standardization Activities,” NTT DoCoMo Technical Journal Vol. 8, No. 1
Ex. 2017	Federal Communications Commission Report and Order FCC 97-421, “In the Matter of Reallocation of Television Channels 60-69, the 746-806 MHz Band,” Adopted December 31, 1997, Released January 6, 1998
Ex. 2018	Federal Communications Commission Report and Order FCC 01-364, “In the Matter of Reallocation and Service Rules for the 698-746 MHz Spectrum Band (Television Channels 52-59),” Adopted December 12, 2001, Released January 18, 2002
Ex. 2019	FCC Lower 700 MHz Band Auction #44 Bid Winners (September 18, 2002)
Ex. 2020	Auction 44: Lower 700 MHz Band Fact Sheet (https://www.fcc.gov/auction/44) (last accessed February 25, 2026)
Ex. 2021	FCC Lower 700 MHz Band Auction #49 Bid Winners (June 13, 2003)
Ex. 2022	Auction 49: Lower 700 MHz Band Fact Sheet (https://www.fcc.gov/auction/49) (last accessed February 25, 2026)
Ex. 2023	FCC Lower 700 MHz Service About Page (https://www.fcc.gov/wireless/bureau-divisions/mobility-

	division/lower-700-mhz-service) (last accessed February 25, 2026)
Ex. 2024	3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); User Equipment (UE) radio transmission and reception; (Release 8) (December 2007)
Ex. 2025	Federal Communications Commission Second Report and Order FCC 0090, “Service Rules for the 746-764 and 776-794 MHz Bands, and Revisions to Part 27 of the Commission’s Rules,” Adopted March 8, 2000, Released March 9, 2000
Ex. 2026	FCC 700 MHz Band Auction #73 Bid Winners.
Ex. 2027	Auction 73: 700 MHz Band Fact Sheet (https://www.fcc.gov/auction/73) (last accessed February 25, 2026)
Ex. 2028	Letter to the Chairman of the Federal Communications Commission Regarding Auction of Licenses in the 747-762 and 777-792 MHz Bands Scheduled for September 6, 2000 (July 20, 2000)
Ex. 2029	Supplementary Declaration of Hossein Hashemi, Ph.D.
Ex. 2030	RESERVED
Ex. 2031	RESERVED
Ex. 2032	Docket Report in 2:24-cv-01009-JRG-RSP (E.D.Tex.) retrieved March 8, 2026
Ex. 2033	Complaint in Fractus, S.A. v. Resmed Inc., 3:25-cv02680-LL-JLB (S.D. Cal.)

Ex. 2034	Claim Construction Order in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2035	Patent Owner's Objections to the Claim Construction Order in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2036	Letter of June 21, 2021 from Ruben Bonet to David Pendarvis
Ex. 2037	Email correspondence between Fractus and ResMed sent from July 26, 2021 through March 24, 2023
Ex. 2038	Attachment to email of November 9, 2022 (Ex. 2037 at 6-7)
Ex. 2039	"ResMed's new factory brings it closer to meeting CPAP demand after Philips recall," Medical Design and Outsourcing (January 10, 2023) (https://www.medicaldesignandoutsourcing.com/resmeds-new-factory-cpap-demand/)(last accessed April 21, 2026)
Ex. 2040	"ResMed responds to 'humanitarian emergency' over demand for CPAP devices with new factory," MEDTECHDIVE (January 10, 2023) (https://www.medtechdive.com/news/resmed-RMD-ceo-mick-farrell-jp-morgan-health-sleep-apnea-devices/640036/)(last accessed April 21, 2026)

I. Introduction

Discretionary denial remains appropriate in this proceeding. On June 6, 2025, Geotab Inc. filed a petition challenging U.S. Patent No. 11,031,677 (“’677 patent”) via *inter partes* review IPR2025-01026 (“’1026 Proceeding”). *Geotab Inc. v. Fractus, S.A.*, IPR2025-01026, Paper 4 (June 6, 2025). On December 3, 2025, the Board instituted trial in the ’1026 proceeding. On January 2, 2026, ResMed Corp. (“Petitioner”) initiated this proceeding by filing a “copycat” petition and a motion to join the ’1026 Proceeding. Subsequently, Fractus S.A. (“Patent Owner”) submitted a Patent Owner Response in the ’1026 proceeding and Request for Discretionary Denial (“Request”) in this proceeding, relying on new evidence uncovered after institution of trial in the ’1026 Proceeding. *E.g.*, EX2017-EX2028. Petitioner’s Opposition to Patent Owner’s Request for Discretionary Denial (“Opposition”) failed to address Patent Owner’s new evidence and merits arguments and mischaracterizes Patent Owner’s Request as “repeat[ing Patent Owner’s] disagreement with the Board’s written description and priority analysis.” Opposition at 12. Instead, Petitioner’s Opposition focused on a purported absence of settled expectations and the potential U.S. manufacturing of its products, but in doing so, once again mischaracterizes the record.

With regard to settled expectations, Petitioner alleges that it “could not anticipate that PO would assert the ’677 patent against it.” Opposition at 8-9.

Nothing could be further from the truth. Indeed, Patent Owner provided Petitioner with notice of the '677 patent less than two weeks after it issued in 2021. EX2036 at 4. Later, over three years prior to Petitioner filing its petition, Patent Owner explicitly notified Petitioner that at least claim 1 of the '677 patent was infringed by Petitioner's products. EX2037 at 6-7; EX2038 at 6. In spite of this unambiguous notification, Petitioner represented to the Director that "the letters referenced by Patent Owner did not provide notice of the subject patent." EX3102 at 1.

With regard to U.S. manufacturing of Petitioner's products, Petitioner has provided no evidence that any of its accused products are currently manufactured in the United States. Instead, Petitioner alleges [REDACTED]

[REDACTED]

[REDACTED] Opposition at 1; *see also id.* at 8. Petitioner's other assertions directed to its distribution centers in the United States are not relevant to the considerations set forth in the Director's March 11, 2026 Memorandum.

II. Settled Expectations do not Favor Institution

The Opposition states that "ResMed had no reason to anticipate the assertion of the '677 Patent against it." Opposition at 1-2. This assertion is problematic, made more so by Petitioner's representation to the Director that "the letters referenced by Patent Owner did not provide notice of the subject patent." EX3102 at 1.

On June 21, 2021, just 13 days after the '677 patent issued, Patent Owner sent Petitioner a letter indicating that “Fractus has analyzed some of ResMed’s products and determined that ResMed, along with its subsidiaries, affiliates, suppliers, importers, distributors, dealers, and customers, infringe Fractus’ patents.” EX2036 at 1. This letter included the '677 patent as a patent owned by Patent Owner and available for license:

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
US10734723	US8565891	US7907092	US6876320	US16/913561

EX2036 at 4 (annotated).

After further discussion, Fractus explicitly identified Petitioner’s AirSense II product as infringing claim 1 of the '677 patent.

Exhibit I.A (page 6/6)

Patent	Claim	Product
		ResMed AirSense II
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

EX2038 at 6 (annotated).

Contrary to Petitioner’s representations, Patent Owner provided explicit notice of the '677 patent to Petitioner. This notice included a clear allegation of infringement of the '677 patent by Petitioner’s AirSense II product.

Petitioner also asserts that it could not have anticipated being sued under the '677 patent because "Fractus has asserted its patents against antenna manufacturers" not those in the medical device space. Opposition at 9. Petitioner attempted to make a similar argument to Patent Owner, telling it to address its infringement concerns to Petitioner's antenna suppliers. EX2037 at 4-8. Patent Owner, however, has been very consistent in its communications with Petitioner – Petitioner would be the licensee of Petitioner's patents, and therefore, is the relevant party for resolving the infringement of the '677 patent. *Id.* In spite of this clear notice of the '677 patent and Petitioner's infringement thereof, Petitioner declined to engage in confidential settlement discussions with Patent Owner and declined to challenge any of Patent Owner's asserted patents in any forum until years later. *See* EX2037 at 1. Patent Owner's explicit notice to Petitioner of the '677 patent and its infringement, and Petitioner's failure to challenge the '677 patent for years, created settled expectations between the parties of the '677 patent's validity. *See Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 (September 19, 2025) (informative) (settled expectations may exist for a patent in force since 2021.).

III. Petitioner Does not Manufacture Accused Products in the United States

The Director's March 11, 2026 Memorandum states that "the Director will consider, and parties should address, not only assembly of the final product in the United States, but also the extent to which components of a product are made in the

United States and the extent to which products made in the United States are sent for further processing outside the United States.” The Opposition addresses none of these considerations, and therefore, is irrelevant to evaluating discretionary denial of the petition in this proceeding.

More importantly, the Opposition concedes that Petitioner does *not* currently manufacture accused products in the U.S. Petitioner instead alleges only that [REDACTED] [REDACTED] Opposition at 7-8 (emphasis added). As noted above, Petitioner does not address the extent of this manufacturing in the U.S., such as which components are made in the U.S., and whether products are sent out of the U.S. In fact, Petitioner recently opened a Singapore factory “billed as the biggest of its kind on Earth” that “has the capacity to meet all of the market’s needs for production of sleep apnea devices,” strongly suggesting any U.S. manufacturing will be minimal. EX2039 at 1; EX2040 at 1. Accordingly, Petitioner’s arguments are a concession it does *not* manufacture accused products in the United States. Its expectations of future manufacturing should not affect the discretionary denial decision in this case. Further, per Petitioner’s Motion to Seal (Paper 11) at 1, Petitioner’s evidence is speculative as it relates to “operational investments and plans that are undergoing negotiations.”

Dated: April 21, 2026

Respectfully submitted,
/Mark J. DeBoy/
Mark J. DeBoy (Reg. 66,983)
Attorney for Patent Owner, Fractus S.A.

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and accompanying **EXHIBITS** were served via email (as previously consented to by counsel) on April 21, 2026 to lead and backup counsel of record for Petitioners as follows:

PH-Resmed-Fractus@paulhastings.com

Dated: April 21, 2026

/Mark J. DeBoy/
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