

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

FRACTUS, S.A.,
Patent Owner.

Case No. IPR2026-00341
Patent No. 8,362,960

**BRIEF IN SUPPORT OF PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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EXHIBIT LIST

Exhibit No.	Title
EX2001	U.S. Patent No. 8,810,458
EX2002	Letter of June 21, 2021 from Ruben Bonet to David Pendarvis
EX2003	Attachment to email of November 9, 2022 (EX2004 at 6-7)
EX2004	Email correspondence between Fractus and ResMed sent from July 26, 2021 through March 24, 2023
EX2005	Joint Motion to Dismiss with Prejudice in <i>Fractus, S.A. v. ADT LLC</i> , Case No. 2:22-cv-00412-JRG
EX2006	“Fractus expands IoT patent licensing program signing ADT agreement and ending litigation,” https://www.prnewswire.com/news-releases/fractus-expands-iot-patent-licensing-program-signing-adt-agreement-and-ending-litigation-302264328.html (last accessed June 21, 2026)
EX2007	“Fractus expands U.S. connected safety licensing via RPX agreement,” https://www.fractus.com/company/news/fractus-expands-u-s-connected-safety-licensing-via-rpx-agreement/ (last accessed June 21, 2026)
EX2008	“Fractus welcomes new licensee, expanding presence in the U.S. smart home market,” https://www.fractus.com/company/news/fractus-welcomes-new-licensee-expanding-presence-in-the-u-s-smart-home-market/ (last accessed June 21, 2026)
EX2009	Photos of Resmed’s AirSense 10 4G product

EX2010	“Our Global Offices,” https://www.taoglas.com/about-taoglas/taoglas-office-locations/ (last accessed August 21, 2026)
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TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH</i> , IPR201901469, Paper 6 (PTAB Feb. 13, 2020) (precedential).....	3
<i>Alliance Laundry Sys., LLC v. PayRange LLC</i> , IPR2025-00950, Paper 11 (PTAB September 19, 2025) (informative).....	3
<i>Amgen Inc. v. Bristol-Myers Squibb Co.</i> , IPR2025-00601, Paper 9 (PTAB July 24, 2025) (informative).....	5
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)	3
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00433, Paper 11 (PTAB June 26, 2025)	5
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (PTAB June 18, 2025) (informative)	5
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)	3
<i>Geotab Inc. v. Fractus S.A.</i> , IPR2025-00929, Paper 11 (PTAB Sept. 12, 2025).....	4
<i>iRhythm Technologies Inc. v. Welch Allyn Inc.</i> , IPR2025-00363, Paper 10 (PTAB June 6, 2025).....	7
<i>Resmed Corp. v. Fractus, S.A.</i> , IPR2026-00191, Paper 1 (PTAB Jan. 2, 2026).....	2
<i>Vivint, Inc. v. Fractus, S.A.</i> , IPR2024-00087, Paper 13 (PTAB Feb. 15, 2024)	8

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March 26, 2025 Memorandum by the Director that addresses “Interim Processes for PTAB Workload Management” 2

I. INTRODUCTION AND SUMMARY OF ARGUMENT

Patent Owner respectfully requests the Director to exercise discretionary denial of institution. Several considerations favor discretionary denial of institution in this IPR.

First, U.S. Patent No. 8,362,960 (“the ‘960 Patent”), issued over 13 years ago and Petitioner has been aware of the ‘960 Patent since at least 2021, when Patent Owner provided Petitioner with explicit notice of the ‘960 Patent. Petitioner’s awareness of the ‘960 Patent and failure to seek early review demonstrate the parties’ settled expectations and, accordingly, supports discretionary denial.

Second, Patent Owner has undertaken substantial domestic licensing of the ‘960 Patent, which favors discretionary denial.

Third, Petitioner’s infringing devices and their components are manufactured outside of the United States. This lack of domestic manufacturing, therefore, favors discretionary denial of the Petition.

Finally, the invalidity challenges in the Petition are weak, favoring discretionary denial.

II. FACTUAL BACKGROUND

The ‘960 Patent, entitled “Handheld Device with Two Antennas, and Method of Enhancing the Isolation Between the Antennas,” was filed on December 21, 2011, as U.S. Patent Application No. 13/341,051. The patent claims priority to U.S.

Provisional Application No. 60/702,205, filed July 25, 2005 through a number of continuation applications, and also claims foreign priority to European Patent Application No. EP 05106694 which was filed on July 21, 2005. The United States Patent and Trademark Office ultimately issued the ‘960 Patent on January 29, 2013, more than 13 years ago. EX1001 at cover page.

Petitioner was provided notice of the ‘960 Patent no later than June 21, 2021, and was provided explicit notice of its infringement thereof no later than November 9, 2022. EX2002; EX2003; EX2004.

Petitioner filed an IPR challenging another of Patent Owner’s patents on January 2, 2026 (*See Resmed Corp. v. Fractus, S.A.*, IPR2026-00191, Paper 1 (PTAB Jan. 2, 2026)) but waited six months to file the present Petition on June 12, 2026 (*See* Petition).

III. LEGAL STANDARD

As set forth in the Memorandum by the Director that addresses “Interim Processes for PTAB Workload Management” (“Interim Process Memo”):

[C]onsistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics**) and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include:

- Whether the PTAB or another forum has already adjudicated

the validity or patentability of the challenged patent claims;

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Interim Process Memo at 2-3 (*citing, Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR201901469, Paper 6 (PTAB Feb. 13, 2020) (precedential)).

Other considerations favoring discretionary denial include evidence of licensing the subject patent. *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 (PTAB September 19, 2025) (informative) (Discretionarily denying institution where the patent owner presented evidence of licensing the challenged patent, creating some settled expectations that favored Patent Owner).

Finally, “the extent to which any products accused of infringement in a

parallel proceeding are manufactured in the United States or are related to investments in American manufacturing operations” is a factor the Director considers when determining whether to institute review in an IPR. March 11, 2026 Memorandum by the Director addressing Additional Discretionary Institution Considerations - U.S. Manufacturing and Small Business Use of AJA Proceedings (“Domestic Manufacturing Memo”).

IV. ARGUMENT

A. The ‘960 Patent’s Issue Date Favors Discretionary Denial

The ‘960 Patent issued more than 13 years ago on January 29, 2013. EX1001 at cover page. The Director has consistently found that patents in force for substantially *less* time than the ‘960 Patent have strong settled expectations. For example, in *inter partes* review IPR2025-00929, directed to Patent Owner’s U.S. Patent No. 8,810,458 (EX2001, “the ‘458 patent”), the patent had been in force for less time than the ‘960 Patent, (issuing on August 19, 2014). EX2001 at cover sheet. There the Director found that the ‘458 patent having been “in force for more than eleven years, creating strong settled expectations for Patent Owner.” *Geotab Inc. v. Fractus S.A.*, IPR2025-00929, Paper 11 at 2 (PTAB Sept. 12, 2025). Given its longer time in force, the ‘960 Patent, thus, has even stronger settled expectations.

Further, the Director has adopted a “six-year guideline” for this factor, noting that once a patent surpasses the six-year statute of limitations for past damages found

in 35 U.S.C. § 286, expectations regarding its validity become significantly more established. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (PTAB June 18, 2025) (informative) (stating this approach “aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits”). It is, therefore, unsurprising that the Director has often found that patents in force for significantly less time than the ‘960 Patent have settled expectations that favor discretionary denial. *See, e.g., Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 11 at 3 (PTAB June 26, 2025) (denying institution where “strong settled expectations” existed for seven- and nine-year-old patents); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 (July 24, 2025) (informative) (denying institution where “the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations for Patent Owner”).

Because the ‘960 Patent has been in force for more than double the guideline value of six years from issuance, the settled expectations of the Parties strongly favor discretionary denial.

B. Petitioner’s Knowledge of the ‘960 Patent and Delay in Challenging Favor Discretionary Denial

On June 21, 2021, 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." EX2002 at 1. This letter expressly identified the '960 Patent as a patent available for license from Patent Owner:

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
US10644405	US8558741	US7872605	PI9917493-6	US14/694603
US10644380	US8531337	US7791539	MX238696	US16/832867
US10468770	US8493280	US7782269	MX224686	
US10355346	US8472908	US7688276	KR0859580	
US10320079	US8471772	US7675470	KR0806654	
US10135138	US8456365	US7554490	JP4731519	
US10056691	US8421686	US7541997	JP4195070	
US10056682	US8362960	US7528782	JP4012733	
US0899777	US8330659	US7505007	IN276113	

EX2002 at 4 (annotated).

After further discussion, on November 9, 2022, Patent Owner explicitly identified Petitioner's AirSense II product as infringing claims 1 and 7 of the '960 patent.

Exhibit I.A (page 6/6)

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

EX2038 at 6 (annotated).

In spite of this clear notice of the '960 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 several years later. *See* EX2004 at 1. This express notice, when combined with Petitioner's delay in making this challenge, created settled expectations between the parties of the '960 Patent's validity. *See iRhythm Technologies Inc. v. Welch Allyn Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) ("Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial ...").

C. The Substantial Domestic Licensing of the ‘960 Patent Favors Discretionary Denial of the Petition

Evidence of licensing the subject patent weighs in favor of settled expectations and discretionarily denying the Petition. *Alliance Laundry*, IPR2025-00950, Paper 11. Patent Owner has a long history of domestically licensing its Internet-of-Things (“IoT”) patent portfolio, which includes the ‘960 Patent. This history of domestic licensing favors discretionary denial.

For example, Patent Owner and Vivint Inc. entered into a licensing agreement that included the ‘960 Patent, which resulted in settlement of *inter partes* reviews IPR2024-00089, IPR2024-0088 and IPR2024-00087. *Vivint, Inc. v. Fractus, S.A.*, IPR2024-00087, Paper 13 (PTAB Feb. 15, 2024). Similarly, Patent Owner entered into a license with ADT LLC which included the ‘960 Patent, resulting in dismissal of a lawsuit between the parties. EX2005; EX2006.¹ Earlier this year, Patent Owner entered into a licensing agreement with RPX which included the ‘960 Patent. EX2007. These are just a few of Patent Owner’s non-confidential licenses directed to the ‘960 Patent. Patent Owner has entered into many additional licenses that

¹ For completeness, Patent Owner notes that the ‘960 Patent was not challenged in the Vivint IPRs or asserted in the ADT litigation. The ‘960 Patent, however, was included in the license agreements.

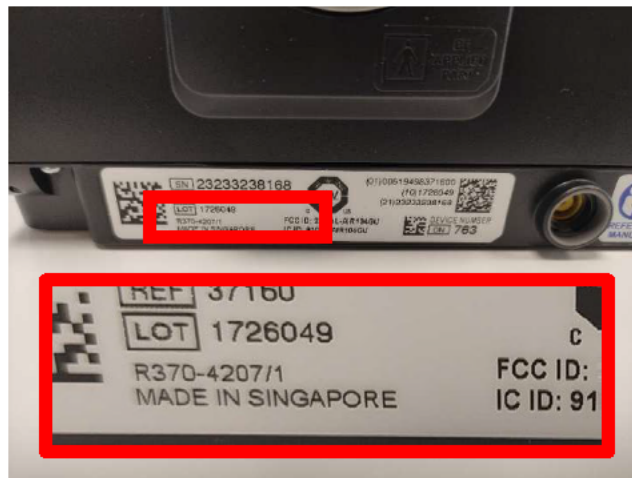
include the '960 Patent. *See, e.g.,* EX2008.

Patent Owner's licensing of the '960 patent is analogous to that of *Alliance Laundry*. *See Alliance Laundry*, IPR2025-00950, Paper 6. Unlike *Alliance Laundry*, however, the '960 Patent has been in force for substantially longer than four years. *Alliance Laundry*, IPR2025-00950, Paper 11. Accordingly, the present case presents a stronger case for discretionary denial than *Alliance Laundry*.

D. Domestic Manufacturing Does Not Favor Institution

Petitioner does not manufacture its products in the United States, which favors discretionary denial of the Petition. *See* Domestic Manufacturing Memo. Provided below are images of Petitioner's AirSense 10 4G product. As indicated in the details of the images, the Petitioner's product is manufactured in Singapore.





EX2009 (annotated).

Further, Taoglas is Petitioner's supplier of the cellular antennas included in the infringing devices. *See* EX2004. Taoglas, however, does not manufacture devices in the United States. Instead, Taoglas' U.S. locations provide executive offices, test labs, sales offices, customer services offices, and research and development. EX2010 at 1, 5. Taoglas' manufacturing takes place in Taiwan with manufacturing support taking place in India. *Id.* at 1, 6.

Petitioner's manufacturing of the infringing products and their components outside of the U.S. favors discretionary denial of the Petition.

E. The Invalidity Challenges in the Petition are Weak, Favoring Discretionary Denial

In accordance with the Interim Director Discretionary Process, Patent Owner incorporates herein the merit arguments and evidence from its forthcoming Patent Owner Preliminary Response ("POPR") by reference. *See* Interim Director

Discretionary Process § II.C.i (“Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.”).

V. CONCLUSION

Appropriate analysis under the framework described in the Interim Process Memo and based on the evidence of record favors exercising discretion to deny institution of the Petition.

Dated: August 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 **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and accompanying **EXHIBITS** were served via email (as previously consented to by counsel) on August 21, 2026 to lead and backup counsel of record for Petitioners as follows:

PH-Resmed-Fractus-IPR@paulhastings.com

Dated: August 21, 2026

/Mark J. DeBoy/

Mark J. DeBoy (Reg. No. 66,983)

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Fractus S.A.