

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,
Patent Owner.

PGR2024-00012
Patent 11,602,284 B1

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of Post-Grant Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

ResMed Corp. (“Petitioner”) filed a Petition requesting a post-grant review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 11,602,284 B1 (Ex. 1001, “the ’284 patent”). Paper 2 (“Pet.”). Cleveland Medical Devices, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). We denied institution because we determined that Petitioner failed to establish that the ’284 patent is eligible for post-grant review. Paper 7 (“Decision”), 2. Petitioner subsequently filed a request for rehearing. Paper 8 (“Req. Reh’g”).

II. ANALYSIS

In its rehearing request, Petitioner contends that we misapprehended the law because we did not consider grounds 3–10 based on obviousness, which Petitioner contends “provided separate and independent bases showing the ’284 patent is subject to the AIA.” Reh’g Req. 1. Petitioner contends that for grounds 3–10, it has met its burden of production to identify claim limitations allegedly unsupported by the priority applications and come forward with invalidating prior art. *Id.* at 6–7 (citing *Bausch & Lomb, Inc. v. BarnesHind/Hydrocurve, Inc.*, 796 F.2d 443, 449 (Fed. Cir. 1986)), 2. Petitioner further contends that the burden then shifted to Patent Owner to show how each limitation for any one claim was entitled to the alleged 2005 priority date to overcome grounds 3–10 as allegedly required by *Penumbra*, but Patent Owner failed to carry its burden. Reh’g Req. 8 (citing *Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 at 18 (March 10, 2023) (Precedential as to § II.E.3)), 2.

In a post-grant review, the burden of persuasion is on the petitioner to prove “unpatentability by a preponderance of the evidence,” 35 U.S.C. § 326(e), and that burden never shifts to the patentee. *Dynamic Drinkware*,

LLC v. National Graphics, Inc., 800 F.3d 1375, 1378 (Fed. Cir. 2015). Post-grant review is available only for patents that issue from applications that at one point contained at least one claim with an effective filing date of March 16, 2013, or later. *See* Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) §§ 3(n)(1), 6(f)(2)(A). The “effective filing date” for a claim is either the application’s actual filing date or the filing date of the earliest application that supports the claim. 35 U.S.C. § 100(i) (2018). A patent claiming the benefit of priority of an application filed before March 16, 2013, must have written description support for the claimed invention in the earlier-filed application in order to avoid PGR-eligibility.¹ *Id.*

Petitioner has the burden of establishing eligibility for post-grant review. *See, e.g., US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17 at 11–12 (PTAB Jan. 29, 2016). Petitioner contends that the ’284 patent is eligible for post-grant review because “at least independent Claim 1 ‘lacks written description and enabling support [for several claim elements] in a priority application filed before March 16, 2013.’” Pet. 4. We disagree. For the reasons set out in the Decision, we determined that Patent Owner has sufficiently shown that each of the claimed elements identified in the Petition as allegedly missing support was sufficiently described in the ’899 application filed on November 4, 2005. *See* Dec. 10–23. Consequently, we determined that Petitioner did not

¹ The ’284 patent issued from a transition application. A “transition application” is a patent application filed on or after March 16, 2013 (the effective date of the applicable sections of the AIA), but which claims priority to an application that was filed prior to March 16, 2013. *See, e.g.,* MPEP § 2159.04.

demonstrate that the '284 patent is eligible for post-grant review. *See* Pet. 26–88. Having made that determination, we concluded our analysis and did not address the merits of the Petition. Dec. 24. Petitioner has not established that it was error for us to not reach its obviousness grounds, given that Petitioner did not carry its burden of demonstrating that the '284 patent is eligible for post-grant review in the first instance. *See, e.g., US Endodontics, LLC*, Paper 17 at 9–12 (distinguishing burden of showing entitlement to a claimed priority date for post-grant review eligibility versus in rebuttal to an obviousness argument).

We also disagree with Petitioner's assertion that we did not follow the requirement as set out in *Penumbra* that the "patent owner . . . substantiate any assertion of earlier priority, with no exception identified for pre-AIA patent claims." Req. Reh'g 7–8.² *Penumbra* is a final written decision in an *inter partes* review, and did not concern the issue of post-grant review eligibility. In *Penumbra*, in evaluating the merits of the petitioner's obviousness arguments, the panel first assessed whether the patent at issue was entitled to the priority date of the provisional application. *Penumbra* at 21–25. Specifically, the panel in *Penumbra* found that the provisional application did not contain adequate support for certain claim limitations and determined that the priority date for the patent at issue in *Penumbra* was the filing date of the patent. In other words, the panel in *Penumbra* was not persuaded that the claims were entitled to the filing date of the ancestral application. *Id.* at 24.

² We note that *Penumbra* is designated precedential as to Section II.E.3. Petitioner's citations to *Penumbra* are not within the precedential portion of the case.

In our Decision, we determined that the elements identified by Petitioner as allegedly lacking written description and enablement support in the '284 patent were indeed supported in the specification as well as the specification of the '899 application filed on November 4, 2005. *See* Dec. 10–22. The facts in the present case, therefore, differ significantly from the facts in *Penumbra*.

III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Request for Rehearing does not persuade us that we misapprehended or overlooked any arguments. Accordingly, we deny Petitioner's Request for Rehearing.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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