

Filed on behalf of: ResMed Corp.

Filed: May 12, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.,

Petitioner,

v.

CLEVELAND MEDICAL DEVICES INC.,

Patent Owner.

Case No. IPR2025-00246
U.S. Patent No. 11,857,333

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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1001	U.S. Patent No. 11,857,333 to Kayyali (“the ’333 Patent”)
1002	File History of U.S. Patent No. 11,857,333
1003	Declaration of Jason Kirkness, Ph.D. (“Kirkness”)
1004	Curriculum Vitae of Jason Kirkness, Ph.D.
1005	Declaration of Sandeep Chatterjee, Ph.D. (“Chatterjee”)
1006	Curriculum Vitae of Sandeep Chatterjee, Ph.D.
1007	RESERVED
1008	U.S. Patent Pub. No. 2002/0198473 to Kumar et al. (“Kumar”)
1009	U.S. Patent No. 7,575,005 to Mumford et al. (“Mumford”)
1010	RESERVED
1011	“ <i>T-Mobile USA and HP Launch the First Truly Integrated Wireless iPAQ Handheld - T-Mobile Newsroom</i> ” (July 2004) available at https://www.t-mobile.com/news/press/t-mobile-usa-and-hp-launch-the-first-truly-integrated-wireless
1012	WIPO Publication No. WO2005096737A2 to Farrell et al. (“Farrell”)
1013	U.S. Patent Pub. No. 2002/0185130 to Wright et al. (“Wright”)
1014	RESERVED
1015	M. Berthon-Jones, “Feasibility of a Self-Setting CPAP Machine,” <i>Sleep</i> 16:S120-123 (1993) (“Berthon-Jones 1993”)

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1016	D. Rapoport, "Methods to Stabilize the Upper Airway Using Positive Pressure," <i>Sleep</i> 19(9):S123-S130 ("Rapoport 1996")
1017	RESERVED
1018	RESERVED
1019	S. Thompson et al., "Sleep as a Teaching Tool for Integrating Physiology and Motor Control," <i>Advances in Physiology Education</i> (2001)
1020	U.S. Patent No. 5,704,345 to Berthon-Jones ("Berthon-Jones345")
1021	U.S. Patent No. 7,168,429 to Matthews et al. ("Matthews")
1022	RESERVED
1023	C. Sullivan, "Reversal of Obstructive Sleep Apnoea by Continuous Positive Airway Pressure Applied through the Nares," <i>Lancet</i> 1981:1862-5 ("Sullivan 1981")
1024	U.S. Patent No. 6,484,719 to Berthon-Jones ("Berthon-Jones719")
1025	Teschler, H., et al., "Automated Continuous Positive Airway Pressure Titration for Obstructive Sleep Apnea Syndrome," <i>Am. J. Respir. Crit. Care Med.</i> 54:734-740 (1996)
1026	ResMed, "AutoSet Portable II Plus Overview & Interpretation Guide, Rev. 1," (1999)
1027	ResMed, "AutoSet T, Optimal Therapy for your OSA Patients," (2000)

Exhibit No.	Description
1028	Sunrise Medical, "DeVillibis® AutoAdjust™ LT Nasal CPAP System Instructions Guide Model 8054," (1999)
1029	Respironics, "Introducing the REMstar Auto. A simply smarter Smart CPAP" (2002)
1030	ResMed Origins, downloaded from https://document.resmed.com/en-us/documents/articles/resmed-origins.pdf on May 3, 2022.
1031	RESERVED
1032	F. Roux, et al., "Continuous Positive Airway Pressure: New Generations," Clinics in Chest Medicine (2003)
1033	Loube, D., "Technologic Advances in the Treatment of Obstructive Sleep Apnea Syndrome," CHEST 116:1426-1433 (1999)
1034	American Academy of Sleep Medicine Task Force. (1999). <i>Sleep-related breathing disorders in adults: recommendations for syndrome definition and measurement techniques in clinical research. Sleep, 22(5), 667-689</i>
1035	J. Meurice, et al., "Efficacy of Auto-CPAP in the Treatment of Obstructive Sleep Apnea/Hypopnea Syndrome," Am. J. Respir. Crit. Care Med. 153:794-8 (1996)
1036	S. Wilber, et. al., "Patient Monitoring and Anesthetic Management: A Physiological Communications Network," JAMA 191:893-898 (1965)
1037	M. Weil, et. al., "Experience With a Digital Computer for Study and Improved Management of the Critically Ill," JAMA 198:1011-1016 (1966)

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1038	C. Lilly, et. al., "Critical Care Telemedicine: Evolution and State of the Art," Critical Care Medicine 42:2429-2436 (2014)
1039	M. Breslow, et. al., "Effect of a multiple-site intensive care unit telemedicine program on clinical and economic outcomes: An alternative paradigm for intensivist staffing," Critical Care Medicine 32:31-38 (2004)
1040	K. Zundel, "Telemedicine: history, applications, and impact on librarianship," Bull Med Libr. Assoc. 84:71-79 (1996)
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1042	A. Boudewyns, et. al., "Two months follow up of auto-CPAP treatment in patients with obstructive sleep apnoea," Thorax 54:147-149 (1999)
1043	D. Lankford, "Wireless CPAP Patient Monitoring: Accuracy Study," Telemedicine Journal and e-Health 10:162-169 (2004)
1044	Japan Patent Office Patent Application Pub. No. P2002-291889A to Toge ("Toge")
1045	U.S. Pat. Pub. No. 2008/0214903 to Orbach ("Orbach")
1046	D. Gourley, et. al., HTTP The Definitive Guide (2002)
1047	D. Mauro, et. al., Essential SNMP (2001)
1048	F. Adelstein, et. al., Fundamentals of Mobile and Pervasive Computing (2005)
1049	WIPO Publication No. WO0145014A1 to Quay ("Quay")

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1050	WIPO Publication No. WO2004032719A2 to Burton et al. ("Burton")
1051	U.S. Patent No. 5,309,921 to Kisner et al. ("Kisner")
1052	Toge Certification of Translation
1053	RESERVED
1054	CleveMed Opening Claim Construction Brief
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1058	Declaration of Dr. Carolyn D'Ambrosio, submitted by Patent Owner in the District Court litigation
1059	U.S. Patent Pub. No. 2005/0268912 to Norman et al. ("Norman")
1060	U.S. Patent No. 6,675,797 to Berthon-Jones
1061	WIPO Publication No. WO2003024335 to Gradon
1062	RESERVED
1063	DocketNavigator: Ohio Northern District Profile
1064	Letter from T. Miller to J. Hannah et al. (May 8, 2025) (" <i>Sotera</i> Stipulation")
1065	H.R. Rep. No. 112-98, pt. 1 (2011)

I. INTRODUCTION

The Petition should be instituted because the PTAB serves as the most efficient forum for determining patentability for U.S. Patent No. 11,857,333 (the “333 Patent”).

The entire basis for PO's request for discretionary denial is *Fintiv*. But the parallel litigation in the Northern District of Ohio has already been stayed, a trial date has never been set, no depositions have occurred, and the litigation has never even reached a *Markman* hearing. Thus, each and every *Fintiv* factor supports institution and will further the Board's objectives to advance “efficiency, fairness, and the merits.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (Mar. 20, 2020) (precedential).

PO's distortion of the facts does not establish otherwise. In particular, PO complains that Petitioner did not file the Petition immediately after PO asserted the '333 Patent in litigation. But Petitioner reasonably waited until mediation failed in October 2024 in order to file the Petition. Indeed, as PO must concede, the Petition was filed three months before the one year bar.

At bottom, PO's Discretionary Denial Brief (“PODDB”) does not and cannot undermine the conclusion that efficiency, fairness, and the merits are best served through institution.

II. BRIEF BACKGROUND

A. The Parallel Litigation

Currently, PO asserts the '333 Patent in *Resmed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB (N.D. Ohio Mar. 20, 2023) ("Ohio Case"). PO first asserted the '333 Patent against Petitioner in April 2024 as part of a third wave of counterclaims filed by PO.

Although the case was initially transferred to the Northern District of Ohio in November 2023, the case is still in its very early stages, and the Ohio court has invested little resources into the substance of the case. In particular, the Ohio court never set a trial date, and never held a *Markman* hearing. Importantly, the Ohio Case is currently stayed "pending the conclusion of all USPTO proceedings related to the asserted patents." *Resmed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, 2025 WL 744610, at *4 (Mar. 7, 2025).

B. The Delaware Litigation

PO initiated litigation against Petitioner by filing suit in the District of Delaware, asserting, among other patents, U.S. Patent No. 10,076,269 (the "'269 Patent"). The Delaware court stayed the litigation pending resolution of the IPR on the '269 Patent. On May 2, 2025, the Board issued a final written decision in the IPR of the '269 Patent finding all challenged claims unpatentable. *Resmed Corp. v. Cleveland Medical Devices, Inc.*, IPR2023-00565, Paper 42 (May 2, 2025) ('269

FWD”).

Like the '333 Patent, the '269 Patent discloses a networked PAP system that transmits data collected from sensors. *See* '269 FWD, 7-8.

III. *FINTIV* SUPPORTS INSTITUTION

Here, where the parallel litigation is already stayed and a trial date has never been scheduled, each and every *Fintiv* factor supports institution. PO's attempts to mischaracterize the facts—such as contorting Petitioner's reasonable decision to wait until mediation failed to file the instant Petition to be prejudicial delay and improperly relying on the Delaware litigation where the '333 Patent is not asserted as “substantial investment”—does not establish otherwise.

A. Factor 1 (stay) Strongly Favors Institution

“A district court stay of the litigation pending resolution of the PTAB trial allays concern about inefficiency and duplication of efforts.” *Fintiv*, Paper 11, at 6. “Accordingly, consideration of the first *Fintiv* factor weighs strongly against exercising discretion to deny institution.” *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, at 9 (Oct. 21, 2020) (precedential) (“The granting of a stay pending *inter partes* review has weighed strongly against exercising discretion to deny institution under *NHK*.”). The Ohio Case is stayed pending the outcome of Petitioner's post-grant challenges and the PO concedes to this fact (PODDB, 10). The district court decision to stay the case and defer to the expertise of the PTAB is

unsurprising given that there are so few patent cases pending in the Northern District of Ohio. Indeed, there have only been eight patent jury trials in the Northern District of Ohio since 2008. EX1063 (DocketNavigator: Ohio Northern District Profile).

B. Factor 2 (proximity to trial) Strongly Favors Institution

No trial date has ever been set in the Ohio Case and the PO concedes to this fact. PODDB, 10. *Cf. Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 19, at 3 (Mar. 28, 2025) (Director Review) (denial where trial scheduled eleven months before projected FWD). This fact alone should be effectively dispositive.

C. Factor 3 (investment in parallel litigation) Favors Institution

No *Markman* hearing has taken place nor has any claim construction order issued in the Ohio Case. *See Fintiv* at 10 (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution under *NHK.*”); *cf. Stellar*, at 3 (denial where court had already issued claim construction order, and parties conducted depositions and exchanged expert reports). Indeed, the parallel case here is nearly at the exact same stage of litigation as the case in the precedential *Snap* decision, where the Board declined to exercise discretionary denial based on similar facts. *Snap*, at 10 (finding “the District Court proceeding was in its early stages” where “no claim construction orders have issued”); *see also Snap*, at 12-13

“In view of our finding that the parallel District Court proceeding was in an early stage prior to the stay, the timing of the filing of the Petition does not weigh in favor of exercising discretion to deny institution.”); *Supercell Oy v. Gree, Inc.*, PGR2020-00038, Paper 14, at 15 (Sept. 3, 2020) (declining to exercise discretionary denial because only minimal investments had been made in the parallel proceeding although petition filed late within statutory filing window).

PO also argues that the parties have been litigating for years. PODDB, 7-8. But PO points to the Delaware litigation (also now stayed) where the '333 Patent is not asserted, overlooking the plain text of Factor 3: “investment in the *parallel proceeding* by the court and the parties.” *Fintiv*, Paper 11, at 6 (emphasis added). The Ohio Case, not the Delaware case, is the parallel proceeding.

PO further argues that Petitioner improperly delayed filing the instant Petition. PODDB, 12-19. Not so. First, the district court already rejected this argument. *Resmed Corp. v. Cleveland Medical Devices, Inc.*, No. 1:23-cv-2221, 2025 WL 744610, at *3 (N.D. Ohio March 7, 2025) (“The Court does not find the timing of ResMed’s filings suggests it is using delay tactics.”).

Second, PO’s argument is devoid of any allegation that the timing of the filing benefited the Petitioner (because it did not), and the Board has rejected generalized arguments that petitioners should file petitions earlier. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 19 (September 12, 2018)

(precedential) (“The Petition, therefore, was timely, and Patent Owner does not apprise us of any tactical advantage, or opportunity for tactical advantage, that Petitioner gained by waiting to file the Petition.”).

Third, Petitioner had good reason to wait to file the petition. On September 5, 2024, the Ohio Case was stayed pending mediation. Petitioner did not file this Petition while engaged in good faith mediation to determine whether PO would drop its infringement claims, which reasonably conserved Board and party resources. *See also Fintiv*, Paper 11, at 11 (“it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding”).

Fourth, if anything, the timing of the filings establishes Petitioner's good faith and diligence. After mediation failed on October 21, 2024, Petitioner filed IPR Petitions against the asserted patents as quickly as possible. After challenging one patent in November¹ and three patents in December², Petitioner challenged another patent³ and filed this Petition on January 10, 2025. The fact that Petitioner filed six petitions within three months of mediation, demonstrates Petitioner's diligence in

¹ IPR2025-00157.

² IPR2025-00158, -159, -160.

³ IPR2025-00247.

filing its challenges as quickly as possible. *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12, at 17 (December 1, 2020) (precedential) (finding that “the timing of the Petition is reasonable...in view of the large number of patents and claims challenged in this and Petitioner’s other related petitions” and because the parties spent time in settlement discussions). Indeed, Petitioner filed this Petition *three months before* Petitioner’s one year bar date⁴.

At bottom, it would have been wasteful for Petitioner to file the Petition before mediation when the goal of mediation is resolving disputes and reducing litigation expenses. To the extent PO argues that Petitioner should have filed its petitions before mediation because PO had not been ordered to drop its infringement claims⁵, this argument demonstrates that PO did not approach the mediation in good faith to resolve the dispute, but rather as a costly delay tactic for burdening Petitioner with additional litigation expenses and shifting the petitions later into the statutory window. Now that mediation has failed and the Ohio Case remains stayed, the most efficient way forward is for the parties to resolve patentability before the Board.

⁴ PO agrees that Petitioner filed “three months before the end of the period within which it could petition for IPR against the ’333 Patent.” PODDB, 13.

⁵ This was PO’s argument in the related IPR2025-00158, Paper 9, at 2-3; IPR2025-00159, Paper 9, at 6; IPR2025-00160, Paper 9, at 6.

PO's arguments against resolving this issue at the Board should be rejected as a predictable attempt to burden Petitioner with additional litigation expenses in district court.

Accordingly, the facts of this Petition are similar to those that have weighed Factor 3 in favor of institution. *Sotera*, at 16-17 (December 1, 2020) (precedential) (the parties served invalidity contentions, the *Markman* hearing was vacated, fact discovery was ongoing, expert reports were not yet due, and the parties tried settlement discussions after which petitioner filed several petitions in short order).

D. Factor 4 (overlap) Strongly Favors Institution

The Ohio Case is stayed, thus there is no danger of overlap. *See Snap*, at 16 (“Based ... [in part on] the stay of the parallel District Court proceeding, the considerations of the fourth *Fintiv* factor weigh against exercising discretion to deny institution.”). Even if any challenged claims were to survive, Petitioner would be estopped under 35 U.S.C. §315(e) from bringing any invalidity challenge that was raised or reasonably could have been raised during the IPR. Moreover, the Ohio court would significantly benefit from the simplification of issues and the findings of the Board.

PO argues that Petitioner asserted Toge and Burton in its invalidity contentions (PODDB, 20), but this argument is mooted by the fact that the Ohio Case is stayed. But even if it were not, PO admits that Kumar and Norman, on which

Petitioner newly relies in this Petition, were not included in Petitioner's invalidity contentions. *Id.*, 15; *see also Fintiv*, Paper 11, at 12-13 (“if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution.”); *Fintiv*, Paper 15, at 15 (“Petitioner’s assertion of additional invalidity contentions in the District Court is not relevant to the question of the degree of overlap for this factor”). Thus, the grounds in the instant Petition are different from those asserted in the parallel litigation.

Next, PO asserts that Petitioner has not submitted a *Sotera* or similar stipulation. PODDB, 20-23. This argument is nonsensical because the Ohio Case is stayed until all USPTO proceedings are resolved. *Resmed Corp.*, 2025 WL 744610, at *3 (“This matter is STAYED pending the conclusion of all USPTO proceedings related to the asserted patents.”). To the extent PO argues that the Ohio court could lift the stay before the FWD (PODDB, 20-21), “this amounts to ‘unfounded speculation as to how the court might proceed,’” and more importantly, contrary to the language of the order itself, and therefore is entitled to no weight. *Snap*, at 9. Regardless, for the avoidance of doubt, Petitioner has submitted a *Sotera* stipulation in the district court litigation. EX1064; *see also Sotera*, at 18-19.

Finally, PO complains that “substantial overlap exists” because “Petitioner’s invalidity contentions assert Toge in combination with system art” and potentially

other art not barred from assertion by estoppel. PODDB, 20-23. But this complaint is directly contrary to the AIA. The *Sotera* stipulation ensures that this *inter partes* review would be a “true alternative” to the district court proceeding (*Sotera*, at 19) because it covers the full breadth of estoppel that Congress prescribed under §315(e)(2)⁶ and thereby “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decision” such that Factor 4 “weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, at 19. Consistent with this approach, recent panels have found that a stipulation commensurate with what Petitioner has provided here strongly favors institution. *See, e.g., Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8, 11-14 (Mar. 14, 2025); *Samsung Elecs. Co. Ltd. v. Heawater Rsch. LLC*, IPR2024-01407, Paper 9, 6-14 (Mar. 20, 2025); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13, 12 (April 7, 2025) (“In light of the stipulation and nature of the asserted ground...this [factor] strongly favors institution.”).

⁶ Petitioner notes that it submitted its *Sotera* stipulation before it became aware of the recent *Ingenico, Inc. v. IOENGINE, LLC*, No. 2023-1367 (Fed. Cir. May 7, 2025). Regardless, the asserted references do not describe a prior art system that Petitioner relies upon in its invalidity contentions..

E. Factor 5 (same party) Favors Institution

The Board will issue the FWD before trial (if any) in the Ohio Case. Thus, Factor 5 favors institution. *See Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11, at 14 (June 14, 2021) (“this factor ‘favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true’”). PO’s argument characterizing Petitioner as the “counterclaim-defendant” and the “plaintiff” (PODDB, 23) is contrary to the plain text (and spirit) of Factor 5: “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11, at 6.

F. Factor 6 (other considerations) Strongly Favors Institution

Other considerations strongly favor institution. First, the Petition presents strong arguments for unpatentability using grounds based on references that have never been considered by the Office. *See Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11, at 14 (Aug. 12, 2020) (finding case merits favor institution). PO attempts to present merits arguments about the “remote station.” PODDB, 24. As a threshold, such arguments should not be considered because they are incorporating arguments from other proceedings on different patents that do not even share the relevant term. *See 37 CFR § 42.6(a)(3)*. Notably, the term “remote station” does not appear in any of the challenged claims in IPR2025-00159 or -00160.

Regardless, the Petition explained that the “remote station” is disclosed by Toge’s “physician-side computer 4” (Pet. 20) and Kumar’s “browser-based engine” (*id.*, 25), and articulated the motivation and expectation of success for combining the references (*id.*, 6-8, 26-29). The Petition also explained that “remote station” is not recited by the ’333 Patent specification but nonetheless disclosed if PO puts forth another interpretation. *Id.*, 21, 25.

Second, PO makes baseless allegations that Petitioner is “derailing its litigation” by filing this Petition. PODDB, 25. But such arguments have been rejected by the Board. *See Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15, at 23 (October 16, 2019) (precedential) (finding that “Patent Owner’s arguments regarding Petitioner’s intentions or the effect of a Board proceeding are speculative” and declining to deny institution).

Third, Petitioner—ResMed Corp.—is a publicly traded U.S. company from San Diego that manufactures lifesaving medical equipment that is critical to public health and the U.S. economy as a whole. Thus, institution is consistent with the significant public interest against “leaving bad patents enforceable.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 55 (2020). Indeed, Petitioner has a significant patent portfolio of its own, and institution here would further the intent of the AIA to prevent the “diver[sion of] resources from the research and development of inventions.” EX1065 (H.R. Rep. No. 112-98, pt. 1 (2011)), at 48.

Fourth, this Petition is the sole challenge to the '333 Patent before the Board—a “crucial fact” favoring institution. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 10, at 6 (May 12, 2020).

Last, given its specialized knowledge and familiarity with patent law, the Board is a far more efficient forum to decide invalidity compared to Northern District of Ohio, which only sees a few dozen patent cases per year. EX1063 (DocketNavigator: Ohio Northern District Profile). Accordingly, other considerations overwhelming favor institution.

IV. CONCLUSION

Given that the discretionary denial considerations support institution as discussed above, Petitioner respectfully requests that the Board reach the merits of the Petition.⁷

⁷ The Office's discretionary denial practices are currently being challenged in *Apple Inc. v. Stewart*, No. 24-1864 (Fed. Cir. May 17, 2024). Petitioner respectfully requests the benefit of any relief that may be granted in that appeal or other challenges to the Office's discretionary denial practices.

Dated: May 12, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** exclusive of the parts exempted as provided in 37 C.F.R. §42.24(a), contains 2,868 words and therefore complies with the type-volume limitations of 37 C.F.R. §42.24(a).

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CERTIFICATE OF SERVICE

I hereby certify that on May 12, 2025, a true and correct copy of the foregoing
**PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY
DENIAL BRIEF** is being served by electronic mail on Patent Owner's counsel of
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