

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO**

RESMED CORP.,)	C.A. No. 1:23-cv-02221-BMB
)	
<i>Plaintiff / Counterclaim-</i>)	RESPONSE TO COUNTERCLAIMS
<i>Defendant,</i>)	FOR INFRINGEMENT
)	
v.)	DEMAND FOR JURY TRIAL
)	
CLEVELAND MEDICAL DEVICES, INC.,)	TO BE FILED UNDER SEAL-
<i>Defendant / Counterclaim</i>)	CONTAINS HIGHLY
<i>Plaintiff.</i>)	CONFIDENTIAL ATTORNEY’S
)	EYES ONLY MATERIAL
)	

**PLAINTIFF RESMED CORP.’S RESPONSE AND AFFIRMATIVE
DEFENSES TO DEFENDANT’S SECOND AMENDED COUNTERCLAIMS FOR
PATENT INFRINGEMENT**

Plaintiff and Counterclaim-Defendant ResMed Corp. (“ResMed” or “Counterclaim-Defendant”), by and through its attorneys, hereby responds to the numbered paragraphs in Defendant and Counterclaim-Plaintiff Cleveland Medical Devices, Inc.’s (“CleveMed” or “Counterclaim-Plaintiff”) Second Amended Answer and Counterclaims for Infringement (“Counterclaims”), and provides its affirmative defenses thereto, as follows:

CLEVEMED’S COUNTERCLAIMS

1. Counterclaim-Plaintiff Cleveland Medical Devices, Inc. (“CleveMed”) alleges the following counterclaims against Counterclaim-Defendant ResMed Corp. (“ResMed”).

ANSWER: Counterclaim-Defendant ResMed responds to the following counterclaims as alleged by CleveMed.

SECOND AFFIRMATIVE DEFENSE
(Noninfringement)

203. Although ResMed does not bear the burden of proof on this issue, ResMed states that neither ResMed nor its parent corporation infringe the asserted patents, either literally or under the doctrine of equivalents. Further, neither ResMed nor its parent corporation contributed to infringement by others. Additionally, neither ResMed nor its parent corporation induced others to infringe the asserted patents. Finally, neither ResMed nor its parent corporation have willfully infringed any valid asserted claim of the asserted patents.

THIRD AFFIRMATIVE DEFENSE
(Invalidity)

204. Upon information and belief, one or more claims of the Asserted Patents are invalid and/or unenforceable for failing to meet one or more requirements of patentability set forth in Part II of Title 35 of the United States Code, including but not limited to sections 101, 102, 103, 112, 115, 116, and/or 256, or judicially created doctrines of invalidity including, but not limited to, obviousness-type double patenting or the Rules and Regulations of the USPTO relating thereto.

205. Specifically, all of the asserted claims are invalid under 35 U.S.C. §102 and/or §103 in view of at least any reference listed on the face of the patents, any reference cited or referred to in the prosecution histories of the patents at issue, foreign counterparts to those patents, and related U.S. and foreign patents, the prior art identified in any of ResMed's invalidity contentions served in *Cleveland Medical Devices Inc. v. ResMed Inc.*, C.A. No. 22-974 (D. Del.), and/or any prior art identified in ResMed's forthcoming contentions in this case, either individually or in combination. As examples only, ResMed identifies the following prior art:

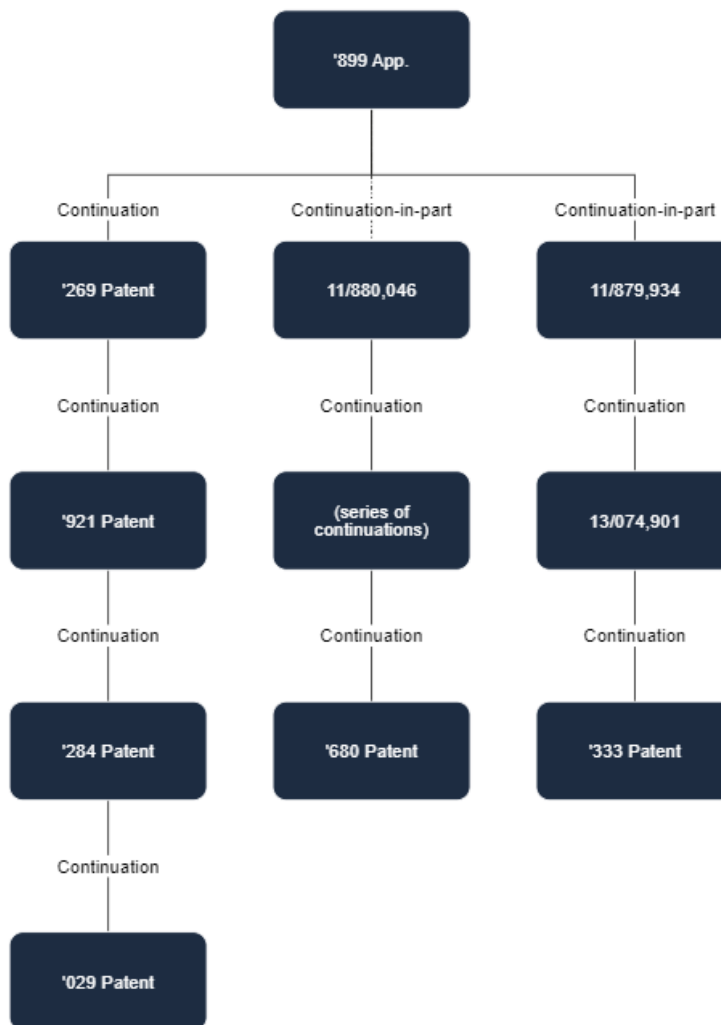
'284, '921, '029, '333, and '680 patents:

- United States Patent No. 6,167,258 (“Schmidt”)
- PCT Publication No. WO 2005/096737 (“Farrell”)
- United States Patent Application Publication No. 2002/0165462 (“Westbrook”)
- United States Patent Application Publication No. 2003/0213489 (“Mechlenburg”)
- US Patent No. 6,287,264 (“Hoffman”)
- US Patent No. 6,644,311 (“Truitt”)
- Mohd Fadlee A. Rasid and Bryan Woodward, *Bluetooth Telemedicine Processor for Multichannel Biomedical Signal Transmission via Mobile Cellular Networks*,” IEEE Transactions on Information Technology in Biomedicine, Vol. 9, No. 1, March 2005, at 35 (“Rasid”)
- ResMed AutoSet Spirit (S7)
- ResMed S8 AutoSet Vantage
- ResMed’s ResTraxx System, including ResTraxx Module and ResTraxx Data Center

'512 patent:

- United States Patent No. 9,801,589 to Schwaibold
- United States Patent Application Publication No. 2003/0199945 to Ciulla
- United States Patent No. 7,967,760 to Lang
- United States Patent Application Publication No. 2002/0022973 to Sun
- United States Patent No. 6,167,258 to Schmidt
- Puzzuoli, et al., *Remote Transmission and Analysis of Signals from Wearable Devices in Sleep Disorders Evaluation*, Computers in Cardiology, 2005, 32:53-56

206. ResMed further incorporates by reference the prior art and arguments included in PGR2024-00012 filed by ResMed Corp. against the '284 patent on December 13, 2023. For example, the claims of the '284 are not entitled to a priority date of November 4, 2005. It is well



224. ResMed attaches as Exhibit A and incorporates by reference its Sealed First Amended Answer and Affirmative Defenses in *Cleveland Medical Devices Inc. v. ResMed Inc.*, C.A. No. 22-794 (D. Del.) (Dkt. No. 183) showing that U.S. Patent No. 10,076,269 is unenforceable due to CleveMed's egregious copying and inequitable conduct. ResMed further attaches as Exhibit B and incorporates by reference its Third Supplemental Response to CleveMed's Interrogatory No. 20 in C.A. No. 22-794, served October 3, 2023, which provides further details of CleveMed's copying and egregious inequitable conduct with respect to the '269 patent due to CleveMed's egregious copying into the '899 application. As shown above, the

'269, '921, '284, and '029 patents are continuations stemming from U.S. Patent App. No. 11/266,899 filed on November 4, 2005, which issued as the '766 patent. Thus, each of these patents shares the same specification that CleveMed heavily and egregiously copied from the prior art, and ResMed's analysis in its Answer and response to Interrogatory No. 20 in C.A. No. 22-794 of CleveMed's inequitable conduct applies equally to the '766, '269, '921 '284, and '029 patents. ResMed further details these allegations below.

225. The '921, '284, and '029 patents are unenforceable based on the inequitable conduct and breaches of the duty of candor and disclosure owed to the United States Patent and Trademark Office by Dr. Brian Kolkowski, as well as the other named inventors, Robert N. Schmidt, Hani Kayyali, and Mohammad Modarres-Zadeh—both through affirmative misrepresentations and material omissions. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

226. **Who:** During the course of drafting Application No. 11/266,899 (“the '899 Application”), Dr. Kolkowski deceptively copied and modified, either in whole or in substantial part, figures and specification passages from multiple prior art references, including at least the following:

- U.S. Patent No. 6,167,258 to Schmidt (“Schmidt”), filed on October 9, 1998, and issued on December 26, 2000 (prior art under at least pre-AIA 35 U.S.C. § 102(b) and

an oath or declaration in connection with the application.” 35 U.S.C. §116 provides that “[w]hen an invention is made by two or more persons jointly, they **shall** apply for patent jointly and each make the required oath, except as otherwise provided in this title” (emphasis added).

255. The Manual of Patent Examining Procedure (“MPEP”) instructs examiners to reject applications with improper inventorship. See MPEP §2157 “Improper Naming of Inventors” which provides that “the patent laws [] require the naming of the actual inventor or joint inventors of the claimed subject matter.” When the application “does not name the correct inventorship and the applicant has not filed a request to correct inventorship under 37 CFR 1.48, Office personnel **should reject the claims under 35 U.S.C. 101 and 35 U.S.C. 115.**” (emphasis added).

256. Information regarding the correct inventorship of the asserted patents was not otherwise available to the USPTO.

257. The USPTO would not have allowed claims to issue if it had been aware of the misrepresentations made by Dr. Kolkowski regarding the inventorship of the asserted patents.

258. These allegations also support relief under the equitable doctrines of estoppel, waiver, and unclean hands, as alleged below.

NINTH AFFIRMATIVE DEFENSE
(Infectious Unenforceability)

259. ResMed incorporates by reference the allegations in its Eighth Affirmative Defense on Inequitable Conduct and the allegations included in ResMed’s First Amended Answer and Affirmative Defenses in *Cleveland Medical Devices Inc. v. ResMed Inc.*, C.A. No. 22-794 (D. Del.).

260. The Applicants’ false statements to the USPTO to obtain allowance of the ’269 patent were affirmative acts of egregious misconduct and infect and render the entire ’269 patent

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