

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESMED CORP.,  
Petitioner,

v.

CLEVELAND MEDICAL DEVICES, INC.,  
Patent Owner.

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

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL  
UNDER THE MARCH 26, 2025 MEMORANDUM RE: INTERIM  
PROCESSES FOR P.T.A.B. WORKLOAD MANAGEMENT**

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**PATENT OWNER'S EXHIBIT LIST**

<b>Exhibit</b>	<b>Description</b>
2001	Intentionally Omitted
2002	Intentionally Omitted
2003	Intentionally Omitted
2004	Excerpts of Plaintiff and Counterclaim Defendant ResMed Corp.'s Initial Invalidity and Unenforceability Contentions cover pleading, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB (N.D. Ohio), served on July 15, 2024
2005	Excerpts of Defendant ResMed Inc.'s Initial Invalidity Contentions cover pleading from <i>Cleveland Med. Devices, Inc. v. ResMed, Inc.</i> , No. 22-cv-00794-JLH (D. Del.) (the "Delaware Case"), served on February 21, 2023
2006	Excerpts of Plaintiff ResMed Corp.'s Response and Affirmative Defenses to Defendant's Second Amended Counterclaims for Patent Infringement, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 75 (N.D. Ohio), filed on April 25, 2024
2007	Excerpts of Declaration of James Hannah in Support of Defendant CleveMed's Opposition to Plaintiff ResMed's Motion for Temporary Stay Pending Mediation, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 87-1 (N.D. Ohio), filed on August 21, 2024
2008	Excerpts of Declaration of Lisa Kobialka in Support of Defendant CleveMed's Opposition to Plaintiff ResMed's Motion to Stay, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 100-1 (N.D. Ohio), filed on January 24, 2025
2009	Excerpts of ResMed Corp.'s Reply in Support of its Motion to Stay, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-02221-BMB, Dkt. No. 101 (N.D. Ohio), filed on January 31, 2025

Patent Owner's Request for Discretionary Denial  
IPR2025-00246 (U.S. Patent No. 11,857,333)

Exhibit	Description
2010	Excerpts of Defendant Cleveland Medical Devices, Inc.'s Memorandum in Support of its Motion to Dismiss Plaintiff's Complaint for Declaratory Judgment of Noninfringement, or to the Extent Not Granted, to Transfer, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 23-cv-00500-TWR-JLB, Dkt. No. 10-1 (S.D. Cal.), filed on June 5, 2023
2011	<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 87-5, Declaration of Hani Kayyali in Support of Patent Owner's Opposition to Motion to Stay Pending Mediation (N.D. Ohio), filed on August 21, 2024
2012	Excerpts of Petitioner's parent company's (ResMed) Q4 FY2024 Earnings call, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 87-6 (N.D. Ohio), filed on August 21, 2024
2013	Excerpts of Defendants' Initial Validity and Enforceability Contentions Pursuant to L.P.R. 3.7, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB (N.D. Ohio), served on August 5, 2024
2014	Case Management Order, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB, Dkt. No. 54 (N.D. Ohio), filed on January 10, 2024
2015	Excerpts of Exhibit H01 – List of Obviousness Combinations from Defendant's Supplemental Invalidity Contentions, <i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , No. 1:23-cv-02221-BMB (N.D. Ohio), served on January 9, 2025

## I. INTRODUCTION

The Board should deny the Petition<sup>1</sup> because the *Fintiv* factors overwhelmingly support denial. Although the co-pending declaratory judgment litigation pending before the District Court for the United States District of Northern District of Ohio (“District Court Litigation”)<sup>2</sup> is currently stayed, the very same parties have already expended substantial resources in that case. Significantly, Petitioner initiated this District Court Litigation, as it brought a declaratory judgment action for non-infringement against Petitioner. Nonetheless, Petitioner elected to unnecessarily multiply litigation over the same patent in different venues, given that Petitioner asserted the same two references (of the four at issue here) *six months ago* against this patent in its invalidity contentions in the District Court Litigation. Additionally, Petitioner had Patent Owner's validity contentions responding to its allegations for five months before it filed this Petition. Given Petitioner's tactics, the Office should honor Petitioner's original choice of venue for the dispute, which

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<sup>1</sup> The Petition challenges claims 15-29 (the “Challenged Claims”) of U.S. Patent No. 11,857,333 (Ex. 1001, the “333 Patent”).

<sup>2</sup> The District Court Litigation is entitled *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB (N.D. Ohio).

is the District Court, and prevent its attempts to vexatiously multiply litigation over the same issues concerning the '333 Patent.

## II. OVERVIEW OF THE '333 PATENT

The '333 Patent discloses an integrated diagnosis and treatment device for patients suffering from sleep apnea and other sleep disorders. '333 Patent at Abstract. The device monitors a patient's breathing metrics and the device's usage data while simultaneously providing a sleep-disorder treatment, such as applying continuous positive airway pressure or a pharmaceutical intervention. *See id.* at Abstract, 10:58-12:67, 45:34-42.

In a preferred embodiment, the '333 Patent discloses a positive airway pressure ("PAP") device with internal airflow sensors that monitor the patient's airflow. *Id.* at 45:34-42, 48:65-49:61. An exemplary embodiment of the PAP device, shown below, includes an air pressure device, a blower, a hose, a mask or nasal cannula, an airflow sensor, and a pressure sensor for measuring breathing metrics (for example, respiratory airflow), and processor(s) for collecting and processing breathing metrics:

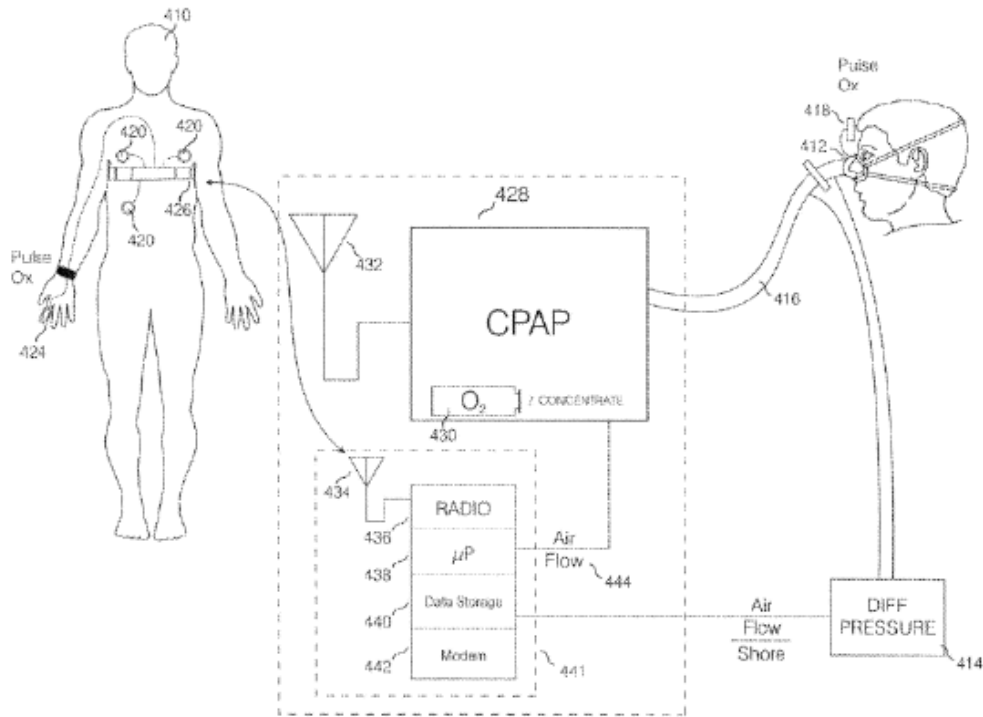


Fig. 8

*Id.* at FIG. 8. While treatment is ongoing, the PAP device also collects usage data and breathing metrics and passes that data to the processor for calculation of the PAP usage and severity of a patient's sleep disorder symptoms. *Id.* at 49:27-59.

After the severity and usage data are collected, that data (and/or the quantified level of severity data) is transferred to a patient's or care provider's cellular phone and a remote internet site for analysis. *Id.* at 22:5-24 ("For example, with the sleep diagnosis and treatment system of the present invention, the remote communication system of the present invention can be a wireless router, which establishes a broadband internet connection and transmits the physiological signal to a remote internet site for analysis . . . .").

The specification indicates that the remote internet site, hosted on a server, receives the data, performs analysis on the data, stores the data on a database, and allows review of the data by medical professionals upon request :

The data acquisition system 50 transmits a signal 55 preferably in real time from the subject's home 52 to a server 70 for analysis . . . . The signal 55 that is transmitted over the internet or other communication system 58 can be compressed to provide better resolution or greater efficiency. The server 70 performs data analysis (not shown). The analyzed data 73 is then entered into a database 76. The analyzed data 73 in the database 76 is then accessible and can be requested 79 and sent to multiple review stations 82 anywhere in the world via the internet or other communications system 58 for further analysis and review by clinicians, technicians, researchers, doctors and the like.

*Id.* at 51:43-63.

### **III. BRIEF BACKGROUND**

#### **A. The '333 Patent is the Subject of District Court Litigation Between the Parties**

Petitioner and Patent Owner are parties to the District Court Litigation that has been pending since 2023, where the '333 Patent is at issue. On March 20, 2023, Petitioner filed a Complaint seeking declaratory judgment of non-infringement of U.S. Patent No. 11,602,284 (the "'284 Patent"), which is another patent in the same family as the '333 Patent. *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 23-cv-00500-TWR-JLB (S.D. Cal.). After Patent Owner unsuccessfully sought to

dismiss Petitioner's District Court case, the case was transferred to Ohio. Ex. 2010 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 23-cv-00500-TWR-JLB, Dkt. No. 10-1 (Motion to Dismiss Complaint or Transfer)) at 1-2, 5-8.

Because Patent Owner was unable to dismiss Petitioner's declaratory judgment action, it was required to assert any counterclaims of infringement.<sup>3</sup> See Fed. R. Civ. P. 13(a) (counterclaims arising out of the same subject matter are compulsory). Patent Owner also determined at that time what other patents would be relevant to avoid creating further parallel proceedings. This included recently-issued patents and patents in the same family as the '284 Patent, including the '333

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<sup>3</sup> Patent Owner sought to dismiss the case because Petitioner initiated the lawsuit just a few days after the '284 Patent issued, and Patent Owner had never asserted it against Petitioner. See Ex. 2010 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No.23-cv-00500-TWR-JLB, Dkt. No. 10-1 (Motion to Dismiss Complaint or Transfer)) at 1-2, 5-8. The Court nonetheless held that there was sufficient support for Petitioner's declaratory judgment lawsuit because Patent Owner had asserted a related patent. See *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 23-cv-00500-TWR-JLB, 2023 WL 5418763, at \*4 (S.D. Cal. Aug. 22, 2023). As a result, Petitioner had no choice but to include relevant related patents in the District Court Litigation as they issued.

Patent which issued a few months after Petitioner's declaratory judgment action was transferred to Ohio.

Petitioner responded to Patent Owner's counterclaims of infringement, including infringement of the '333 Patent, with voluminous invalidity contentions served on July 15, 2024, citing the same Toge and Burton references that it used as the basis for this Petition. *Compare* Ex. 2004 (7/15/2024 Invalidity Contentions Cover) at 50-52 (asserting Toge and Burton against the '333 Patent in the District Court Litigation) *with* Paper 1 ("Pet.") at 1 (asserting four grounds based on various combinations of the alleged prior art references Toge (Ex. 1044), Burton (Ex. 1050), Kumar (Ex. 1008), and Norman (Ex. 1059)). Petitioner does not explain why it waited *six months* to file this Petition.

Moreover, Petitioner received Patent Owner's validity contentions in the District Court Litigation on August 5, 2024, yet still waited for another *five months* to submit this Petition, relying on long-known references. *See infra*, Factor 3; *see generally* Ex. 2013 at 1-3 (8/5/2024 Validity Contentions Cover). As a result of Petitioner's delay, the parties expended significant resources in the District Court Litigation before Petitioner sought a stay based on its multitude of filings in other forums. *See infra*, Factor 3. The District Court acknowledged as much in its order granting Petitioner's requested stay, noting that even though it would grant the stay, "[t]rue discovery is underway and the parties have expended significant resources

litigating this case.” *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, 2025 WL 744610, at \*2 (N.D. Ohio Mar. 7, 2025).

Petitioner eventually began filing validity challenges in various other forums, including a petition for post-grant review, six IPR petitions, and two requests for reexamination. *Id.* at \*1 (summarizing Petitioner's challenge proceedings); *see generally*, PGR2024-00012, IPR2025-00247, IPR2025-00160, IPR2025-00159, IPR2025-00158, IPR2025-00157, Reexamination Control No. 90/019,700, Reexamination Control No. 90/019,705. Despite not knowing whether the PTAB would institute any IPR petitions, the District Court issued a stay of all proceedings because the Central Reexamination Unit had granted the two reexamination requests. *Id.* at \*3. Thus, Petitioner used its many filings to block the District Court Litigation it had initiated.

**B. The Parties Have Invested Years in Litigation Proceedings Even Beyond the District Court Litigation in Ohio**

Some history of the other proceedings between the parties provides context to the *Fintiv* analysis, particularly as to Factor 3 below, because the parties have invested much more time and resources into their patent dispute than just those resources involved in the District Court Litigation. Specifically, Patent Owner, Petitioner, and Petitioner's parent company, ResMed Inc., have been embroiled in litigation since June 16, 2022, when Patent Owner first asserted patent infringement against Petitioner's parent in the United States District Court for the District of

Delaware. *Cleveland Med. Devices, Inc. v. ResMed, Inc.*, No. 22-794-JLH (D. Del.) (the “Delaware Case”). The Delaware Case is still pending and involves U.S. Patent No. 10,076,269 (the “’269 Patent”), among others in the home sleep testing field.

Petitioner assisted its parent in the Delaware Case by filing an IPR petition against the ’269 Patent. *See ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. IPR2023-00565, Paper 1 at 1 (P.T.A.B. Mar. 22, 2023) (identifying parent company ResMed Inc. as a real-party-in-interest). Notwithstanding an initial discretionary denial due to the advanced stage of the Delaware Case (*id.*, Paper 13 (P.T.A.B. Sept. 25, 2023)), the Director granted review and vacated the institution decision, and the Board ultimately instituted trial on the ’269 Patent in view of Petitioner’s post-vacatur *Sotera* stipulation. *Id.*, Paper 15 (P.T.A.B. Nov. 16, 2023), Paper 23 (P.T.A.B. May 6, 2024).

Around the same time that it filed the IPR petition against the ’269 Patent, Petitioner filed the District Court Litigation against the ’284 Patent (the ’333 Patent’s family member), followed by the *nine* above-described validity challenges against the ’284 Patent and other patents in Patent Owner’s portfolio. Given this multitude of proceedings, the majority of which were initiated by Petitioner, the full history of such proceedings should be considered as part of the *Fintiv* analysis.

#### IV. THE BOARD SHOULD DENY THE PETITION UNDER *FINTIV*

The Board should deny institution under § 314(a) because 1) this Petition is redundant of the District Court Litigation that Petitioner filed in 2023 that involves the '333 Patent, and 2) Petitioner delayed filing this Petition despite relying on long-known references and arguments it has repeated in multiple forums, which amounts to an abuse of the patent system. *See* 35 U.S.C. § 314(a) (institution of an IPR is discretionary).

The purpose of the *Fintiv* analysis is to “take[] a holistic view of whether efficiency and the integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) (precedential) (discussing purpose of discretionary denial analysis). Here, a holistic view of Petitioner's actions reveals dilatory tactics and overlapping arguments across multiple forums, which have been staggered so as to maximize the amount of investment required of Patent Owner.

Patent Owner is a small company, in contrast to Petitioner, which is part of a large, publicly-traded parent company. Ex. 2011 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 87-5 (Declaration of Hani Kayyali in Support of Patent Owner's Opposition to Motion to Stay Pending Mediation)) at ¶ 5 (Patent Owner's CEO confirming Patent Owner has under 30 employees); Ex. 2012 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB,

Dkt. No. 87-6) at 4 (Petitioner's parent company's earnings call showing billions in revenue and about 10,000 employees). Such tactics weigh in favor of discretionary denial under *Fintiv* Factors 3 through 6, as described in detail below.

**A. *Fintiv* Factors 1 and 2 Are Outweighed by Other Considerations**

Petitioner only obtained its stay of the District Court Litigation by deliberately multiplying the proceedings between the parties and submitting a swath of IPR petitions and reexamination requests based on overlapping art. *See* Section III(A). That Petitioner successfully used gamesmanship to derail its own litigation should not weigh in its favor of instituting trial under Factor 1.

Similarly, Petitioner's gamesmanship should not permit it to claim that Factor 2 favors institution. The District Court's practice was to set a case for trial after completing the claim construction hearing. *See* Ex. 2014 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 54) at 3 (case management order only sets deadlines up to completion of claim construction). Petitioner delayed filing the last of its IPR petitions until the parties had already completed claim construction briefing, but moved for a stay just before the District

Court's claim construction hearing.<sup>4</sup> *ResMed Corp.*, 2025 WL 744610, at \*1 (motion for stay occurred shortly before hearing). Petitioner avoided a trial date with its careful staging of its arguments and filings, but the Board should not encourage such gamesmanship.

In any case, Factors 3 through 6 so strongly support denial in this case that they outweigh the impact of Factors 1 and 2 relating to whether a stay is likely and when a trial is likely to start before a Final Written Decision ("FWD") is expected to issue. *See Fintiv*, Paper 11 at 5-16 (setting forth six factors for discretionary denial). Although the District Court Litigation has been stayed pending the outcome of the IPR petitions and no trial date is set, these considerations represent only two "non-dispositive factors," while the Board must weigh all factors "as part of a balanced assessment of all relevant circumstances of the case, including the merits." *Id.* at 5 (internal quotations and citation omitted). Upon such an assessment, discretionary denial is appropriate.

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<sup>4</sup> The District Court set the claim construction hearing for March 19, 2025. *ResMed Corp.*, 2025 WL 744610, at \*1 (summarizing case status). The parties completed claim construction briefing and submitted their joint pre-hearing statement on January 6, 2025. Petitioner waited until after that to move for a stay on January 10, 2025. *Id.*

**B. *Fintiv* Factor 3 Supports Denial Because Petitioner Unreasonably Delayed its Filing and the Parties Have Substantially Invested in Parallel Litigation**

*Fintiv* Factor 3 relates to both the timing of the Petition and the degree of investment by the parties and the District Court in any parallel proceeding. *Fintiv*, Paper 11 at 9-12. Petitioner delayed filing its Petition for six months after serving invalidity contentions and five months after receiving Patent Owner's validity contentions in response, yet gives no explanation for the delay. *See generally* Ex. 2004 at 1, 11 (7/15/2024 Invalidity Contentions Cover), Ex. 2013 at 1-3 (8/5/2024 Validity Contentions Cover). During that time, the parties continued to litigate the District Court Litigation. Patent Owner respectfully requests that the Board consider the full context of the dispute between the parties as described below, which has resulted in overlapping validity challenges across three different venues: the District Court, the PTAB, and the Central Reexaminations Unit. The AIA was meant to provide an efficient forum for parties to resolve validity disputes, but Petitioner's litigation strategy has been to draw out and multiple proceedings rather than streamline them.

**1. Petitioner Was Aware of the References Asserted in This Petition for Months Before Filing Yet Continued to Pursue the District Court Litigation**

Petitioner has filed IPRs against all of the patents and claims asserted as counterclaims in the case that Petitioner initiated nearly two years ago. Petitioner,

however, did not submit this Petition until January 10, 2025, which was just three months before the end of the period within which it could petition for IPR against the '333 Patent. *See* 35 U.S.C. § 315(b) (permitting IPR petitions only within 1 year of an allegation of infringement).

After serving its invalidity contentions, Petitioner continued to pursue the District Court Litigation before bringing this Petition against the '333 Patent, despite the fact that Petitioner had already known about the Toge reference for about six months and the Burton reference's related U.S. continuation for nearly two years prior to submitting its Petition. The Board has acknowledged that "notwithstanding that a [challenger] has one year to file a petition, it may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition at the Office." *Fintiv*, Paper 11 at 11. Delays in filing the Petition weigh in favor of denial where the petitioner is "aware or could have reasonably been aware of the prior art asserted in the challenges set forth in the instant proceeding." *Next Caller Inc. v. TRUSTID, Inc.*, No. IPR2019-00961, Paper 10 at 15-16 (P.T.A.B. Oct. 16, 2019) (delay in filing petition weighed in favor of discretionary denial as petitioner could have filed the petition concurrently with another petition asserting the same art). In this instance, because Petitioner's Petition relies heavily on art long known to Petitioner, Factor 3 weighs in favor of denial.

Petitioner knew of the Toge reference before this Petition, because on July 15, 2024, Petitioner asserted Toge as a primary reference against the '333 Patent in its invalidity contentions in the District Court Litigation, about six months prior to filing this Petition. *See, e.g.*, Ex. 2004 (7/15/2024 Invalidity Contentions Cover) at 50-51, 56. It now repurposes Toge as a primary reference in combination with a few other references. *See* Pet. at 1.

Petitioner was also aware of the Burton reference's U.S. continuation for almost two years before filing this Petition. On February 21, 2023, Petitioner's parent company, ResMed Inc., asserted Burton's continuation against the '269 Patent, which is related to the '333 Patent, in the Delaware Case. *See, e.g.*, Ex. 2005 (2/21/2023 Delaware Case Invalidity Contentions Cover) at 17. Thereafter, Petitioner asserted Burton's continuation in the District Court Litigation in Ohio on April 25, 2024, which was about nine months before this Petition, when it served its Response and Affirmative Defenses to Patent Owner's Second Amended Counterclaims. Petitioner pled *all* allegations from its invalidity contentions served in the Delaware Case as purported bases for invalidity in the District Court Litigation in Ohio. *See, e.g.*, Ex. 2006 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 75 (N.D. Ohio, Apr. 25, 2024)) at ¶ 205.

In this way, Petitioner sought to recycle its contentions from the Delaware Case into the District Court Litigation—and has now further recycled some of that

material here. *See, e.g.*, Ex. 2005 (2/21/2023 Delaware Case Invalidation Contentions Cover) at 17 (asserting the Burton continuation). Petitioner then went on to assert the exact Burton reference used here against the '333 Patent in its July 2024 invalidity contentions in the District Court Litigation. Ex. 2004 (7/15/2024 Invalidation Contentions Cover) at 50, 52. Thus, between Toge and the Burton references, Petitioner knew or at least should have been aware much earlier of the positions it has now taken, months later, in this delayed Petition. *See, e.g., Next Caller*, Paper 10 at 15-16.

That Petitioner added two other references (Kumar and Norman) for the first time is of no moment, because the combinations used need not be identical between parallel proceedings if there is nonetheless “substantial overlap.” *Apple Inc. v. Optis Cellular Tech. LLC*, No. IPR2020-00465, Paper 13 at 20-21 (P.T.A.B. Sept. 17, 2020) (Factor 4 favored discretionary denial as “substantial overlap of issues concerning the prior art” existed, because even though “the combinations of four references” Petitioner used in the District Court and in the petition differed, “two of the references, including the primary reference [], are the same in both combinations”).

Indeed, every ground in the Petition requires Toge as a primary reference, and two of the four asserted grounds also require Burton (Pet. at 1), even though these are the two references Petitioner has known about the longest. Petitioner's

allegations are not somehow newly discovered simply by virtue of attempting to allege invalidity using various permutations of Toge or Burton cobbled together with a few other references. Thus, Petitioner's inclusion of two references that were not included in the District Court Litigation does not justify its delay in filing this Petition.

Where, as here, the evidence shows that the petitioner failed to promptly file its petition "at or around the same time that the patent owner responds to the petitioner's invalidity contentions, or [] if the petitioner cannot explain the delay in filing its petition," Factor 3 favors exercising discretionary denial. *Fintiv*, Paper 11 at 11-12. In this case, both issues are present: Petitioner not only waited five months from Patent Owner's validity contentions to file this Petition, but waited many months before deciding to pursue overlapping validity challenges to the '333 Patent before the Board. Petitioner has not offered any excuse for its delay; nor can it, given that it largely repurposed prior allegations. *See* Pet. at 73 (making no meaningful attempt to address *Fintiv*).

## **2. Petitioner Continued to Litigate in District Court While it Delayed Filing this Petition**

Though Petitioner was already aware of the bases for its IPR Petition, it forged ahead in the District Court Litigation with substantial discovery and service of voluminous invalidity contentions, thus imposing unfair cost on Patent Owner. *See Fintiv*, Paper 11 at 11.

Discovery was in full swing before Petitioner filed this Petition. For example, Petitioner served 14 interrogatories and 52 requests for production on Patent Owner in the District Court Litigation. Ex. 2007 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 87-1 (Declaration of James Hannah in Support of Cleveland Medical Devices, Inc.'s Opposition to Motion to Stay Pending Mediation)) at ¶¶ 2-3 (explaining discovery status as of August 2024 in responding to Petitioner's first request to stay the District Court Litigation pending a mediation); Ex. 2008 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 100-1 (Declaration of Lisa Kobialka in Support of Cleveland Medical Devices, Inc.'s Opposition to Motion to Stay)) at ¶ 4 (updating discovery status in responding to Petitioner's second request for a stay, this time pending IPRs).

Patent Owner produced over 6,100 pages of documents in response. Ex. 2007 at ¶ 3; Ex. 2008 at ¶ 4. Petitioner itself produced over 6,500 pages of documents in response to Patent Owner's requests. Ex. 2007 at ¶ 3; Ex. 2008 at ¶ 4. Moreover, before Petitioner filed its submission here, the parties completed claim construction briefing that cumulatively included over 90 pages of discussion, dozens of pages of detailed declarations from three different experts, and the parties' joint submission of a prehearing statement.

As the Board has noted, the weight to accord a lack of a claim construction order in a parallel District Court litigation may vary depending on an individual

court's procedures. *Fintiv*, Paper 11 at 10, n.17. Here, although Petitioner obtained a stay just before the District Court's claim construction hearing, the parties had already completed substantial work in the case under the Court's procedures permitting discovery ahead of claim construction. Moreover, the District Court acknowledged that the parties had expended substantial resources, yet granted the stay because Petitioner had filed so many parallel challenges deliberately based on overlapping art. *ResMed Corp.*, 2025 WL 744610, at \*2-3 (describing resources spent, but noting "significant overlap" and that two reexamination requests were pending). The District Court's reasoning reinforces that Petitioner managed to derail the District Court Litigation before a claim construction order through its own gamesmanship, such that the lack of an order should not count in Petitioner's favor.

Petitioner also imposed substantial costs on Patent Owner with its invalidity contentions in the District Court Litigation, which comprised 41 claim charts and more than 3,000 pages. Patent Owner was obligated to respond to these vague and bloated allegations with its own validity contentions, which it served in August 2024. The overall investment of the parties into the District Court Litigation is especially significant when also considering the Delaware Case, in which, for example, the parties produced cumulatively hundreds of thousands of pages of documents.

In sum, the Board should find that these timing considerations and a holistic view of the parties' years of investment in parallel proceedings favor discretionary denial.

**C. *Fintiv* Factor 4 Supports Denial Because Petitioner Presents Arguments that Significantly Overlap with Arguments Presented to the District Court**

Significant overlap exists between this Petition and the District Court Litigation because “the same or substantially the same claims, grounds, arguments, and evidence” presented in the District Court Litigation are recycled here, which favors denying the Petition. *Fintiv*, Paper 11 at 12.

Petitioner conceded that its Petition involves both overlapping arguments and art. *See* Ex. 2009 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 101) at 9. Indeed, the District Court granted a stay, despite the fact that the parties had expended “significant resources” on it, because Petitioner had represented that it filed multiple validity challenges with “significant overlap between the issues presented in the petitions and the case before the Court.” *ResMed Corp.*, 2025 WL 744610, at \*3. Moreover, Petitioner has asserted grounds against all claims of the '333 Patent that are asserted in the District Court Litigation, a fact that supports denial. *See* *Fintiv*, Paper 11 at 13 (discussing the import of whether all or only some challenged claims are at issue in a parallel proceeding).

All of Petitioner's grounds alleged in the Petition require Toge, and two of the four grounds also require Burton. Pet. at 1. As explained above in connection with Factor 3, Toge and Burton were both already asserted as references against the '333 Patent in the District Court Litigation, with Toge as a primary reference as it is here. Ex. 2004 (7/15/2024 Invalidity Contentions Cover) at 50-52. Thus, substantial overlap exists between the District Court Litigation and this proceeding.

Petitioner has made no case-narrowing stipulations (e.g., a *Sotera*-type stipulation) that might mitigate the overlap in issues, a fact which the Board has acknowledged is "highly relevant." See March 24, 2025 Memorandum re: Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" at 2-3. When Patent Owner raised this concern in its Opposition to Petitioner's Motion to Stay the District Court Litigation and suggested Petitioner should stipulate to a broader estoppel effect from the IPRs in light of its thousands of pages of invalidity allegations, Petitioner did not offer even a limited stipulation in its reply. See Ex. 2009 (*ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. 1:23-cv-02221-BMB, Dkt. No. 101) at 10.

Petitioner's silence speaks volumes as it demonstrates its efforts to multiply litigation efforts in different venues. After all, the Court very well may lift its stay

any time before a FWD is due in this case, such as if the Board denies institution in this case or any of the other patents that Petitioner has challenged.

Indeed, when Patent Owner raised this concern in its Patent Owner Preliminary Response in defense of the '284 Patent, which is also asserted in the District Court Litigation and also the subject of a repetitive IPR petition, Petitioner claimed that the widely-used practice of offering a *Sotera*-type stipulation was “nonsensical”<sup>5</sup> because of ordinary statutory estoppel. *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. IPR2025-00157, Paper 7 at 28-29 (P.T.A.B. Mar. 13, 2025) (raising Patent Owner's concerns); *id.*, Paper 8 at 5 (P.T.A.B. Apr. 2, 2025). Petitioner again has declined to offer a stipulation in response to Patent Owner's concerns in this case.

Additionally, Petitioner's invalidity contentions assert Toge in combination with system art. *See, e.g.*, Ex. 2015 (1/9/2025 Invalidity Contentions Ex. H01) at 23-24 (citing Toge together with ResTraxx or Embletta systems). A split exists among District Courts as to when estoppel applies where patent challengers assert invalidity based on system art that could have been asserted via patents or printed

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<sup>5</sup> Notably, Petitioner offered a *Sotera*-style stipulation in an earlier case. *ResMed Corp. v. Cleveland Med. Devices, Inc.*, No. IPR2023-00565, Paper 15 (P.T.A.B. Nov. 16, 2023), Paper 23 (P.T.A.B. May 6, 2024).

publications in an IPR or in connection with references subject to estoppel. *See, e.g., Bos. Sci. Corp. v. Cook Grp. Inc.*, 653 F. Supp. 3d 541, 593-95 (S.D. Ind. 2023) (detailing the considerations of District Courts on both sides of the estoppel issue, and evaluating the estoppel allegations at issue on a reference-by-reference basis). As a result, statutory estoppel may mitigate, but cannot wholly eliminate, duplicative effort on the part of the District Court because Petitioner intends to raise the same art, yet again, in some allegedly new combination. Indeed, the same day it filed this Petition, Petitioner served a list of purported obviousness combinations using Toge against the '333 Patent in over thirty combinations, nine of which involved alleged system art. Ex. 2015 (1/9/2025 Invalidity Contentions Ex. H01) at 23-24.

Petitioner also asserted Toge in the District Court Litigation against other asserted patents, such that even if an FWD issues for this Petition, the District Court will have to consider similar arguments in connection with other patents. For example, Petitioner asserted Toge against five of the six patents asserted in the District Court Litigation, but only used Toge in three of its IPR petitions. *Compare* Ex. 2004 (7/15/2025 Invalidity Contentions Cover) at 10-12, 50-51 (citing Toge against a total of five asserted patents, including the '284 Patent and U.S. Patent No. 11,872,029, which are both related to the '333 Patent) *with* IPR2025-00157, Paper 1 at 2-3, IPR2025-00247, Paper 1 at 2-3 (not citing Toge in any grounds). As a

result, regardless of the outcome of the IPR petitions, the District Court will still have to consider Toge as to at least two of the patents related to the '333 Patent.

Thus, the lack of stipulation means that when the District Court Litigation resumes there will still be a risk of duplicative efforts and conflicting results because (1) Petitioner may argue that the District Court should consider art asserted in an IPR in some different way in District Court in connection with system art, and (2) the District Court may still be evaluating Petitioner's primary reference, Toge, in connection with other related patents where there is no estoppel effect.

**D. *Fintiv* Factor 5 Supports Denial Because Petitioner Initiated the Co-Pending Litigation**

Petitioner is the counterclaim-defendant in the pending District Court Litigation. This factor thus weighs in favor of denying the Petition.

The Board should accord extra weight to this factor because Petitioner is not only the same party in the litigation; rather, Petitioner is the plaintiff that initiated the litigation with a declaratory judgment action of non-infringement against the '284 Patent. Following Patent Owner's counterclaim of infringement in that case, Petitioner alleged invalidity and served two rounds of voluminous invalidity contentions. Petitioner effectively chose the District Court as its venue for validity challenges by actively litigating validity in that forum for the maximum amount of time possible in lieu of filing this Petition even though Petitioner already knew of the main references that now form the basis for the Petition.

Ultimately, Petitioner should be held to the choice of forum that it functionally made through its actions, which is litigating the validity of the '333 Patent before the District Court. Thus, this factor should weigh in favor of denying the Petition.

**E. *Fintiv* Factor 6 Supports Denial Because Petitioner's Recycled Arguments Lack Merit and Create Intentional Inefficiencies**

The grounds raised in the Petition lack merit, and certainly do not rise to the level of appearing “particularly strong” for purposes of impacting the *Fintiv* analysis. *Fintiv*, Paper 11 at 14-15. Indeed, these grounds fall well short of even raising “a closer call,” but a close call is all that is required for this factor to favor discretionary denial. *Id.* at 15. For instance, Petitioner fails to show that Toge (Ex. 1044) alone or in view of Kumar (Ex. 1008) discloses “a remote station” under the proper construction, which is: a remote internet site hosted on one or more servers. As Patent Owner showed in IPR2025-00159 and -00160, Toge does not disclose a remote internet site and a POSITA would not have found it obvious to add Kumar's browser-based engine/web server to Toge's system. *See, e.g.*, IPR2025-00159, Paper 7 at 28-47 (P.T.A.B. Mar. 17, 2025); IPR2025-00160, Paper 7 at 28-41 (P.T.A.B. Mar. 17, 2025).

Further, equitable considerations weigh in favor of denying institution. As discussed above in connection with Factors 3 and 4, Petitioner has submitted and resubmitted the same or similar voluminous contentions across multiple forums. Petitioner picked this fight with Patent Owner by filing a declaratory judgment

action on the '284 Patent within days of the '284 Patent's issuance, which Patent Owner unsuccessfully sought to dismiss. *Ex. 2010 (ResMed Corp. v. Cleveland Med. Devices, Inc., No. 3:23-cv-00500-TWR-JLB, Dkt. No. 10-1 (Motion to Dismiss Complaint or Transfer))* at 1-2, 5-8. After that, Patent Owner properly brought its counterclaims of infringement. Yet, perhaps to avoid having to litigate Patent Owner's counterclaims along with its own, Petitioner created inefficiencies between the District Court and the Board by filing this Petition (and multiple others) using overlapping art. *See* Section III(A) (describing Petitioner's post-grant review petition, six IPR petitions, and two reexamination requests, all against the patents asserted in the District Court Litigation).

For example, Petitioner filed two reexamination requests against patents it would later challenge in IPRs. Because reexamination requests are routinely granted and are considered with "special dispatch," these parallel challenges enabled Petitioner to represent that the Patent Office had instituted at least some of its repetitive proceedings. *See* 35 U.S.C. §§ 303, 305 (Director shall determine whether a substantial new question of patentability exists within three months of a reexamination request, and the request shall be "conducted with special dispatch within the Office"). Petitioner then sought a remedy for its own actions with a request for a stay, derailing its litigation in favor of trying its arguments here. In

light of the granted reexaminations, the District Court granted the stay. *ResMed Corp.*, 2025 WL 744610, at \*3.

Petitioner's wave of petitions against the patents asserted in the District Court Litigation are unlikely to resolve the litigation, and the Court where the parties have been litigating these issues already, should continue to be the venue for the parties' disputes. This Petition should be rebuffed as harassing and a misuse of the system.

## **V. CONCLUSION**

For at least the foregoing reasons, the Board should deny institution.

Patent Owner's Request for Discretionary Denial  
IPR2025-00246 (U.S. Patent No. 11,857,333)

Respectfully submitted,

Date: April 9, 2025

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**CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24**

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL UNDER THE MARCH 26, 2025 MEMORANDUM RE: INTERIM PROCESSES FOR P.T.A.B. WORKLOAD MANAGEMENT** has 5,640 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b) and the March 26, 2025 Memorandum re: Interim Processes for PTAB Workload Management. This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: April 9, 2025

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**CERTIFICATE OF SERVICE**

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the P-TACTS constitutes electronic service if Patent Owner provides the foregoing document (excluding exhibits), service was made on the Petitioner as detailed below.

<i>Date of service</i>	April 9, 2025
<i>Manner of service</i>	Electronic Filing and Electronic Mail (PH-ResMed-CleveMed@paulhastings.com)
<i>Documents served</i>	PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL UNDER THE MARCH 26, 2025 MEMORANDUM RE: INTERIM PROCESSES FOR P.T.A.B. WORKLOAD MANAGEMENT
<i>Persons Served</i>	Paul Hastings LLP Lisa K. Nguyen David M. Tennant Grace Wang Kamilah Alexander Maksim Mints

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