

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FISHER & PAYKEL HEALTHCARE LIMITED,  
Petitioner,

v.

RESMED LIMITED,  
Patent Owner.

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Case IPR2017-00218  
Patent 9,381,316 B2

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Before RICHARD E. RICE, BARRY L. GROSSMAN, and  
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

## I. INTRODUCTION

Petitioner, Fisher & Paykel Healthcare Ltd. (“Fisher”), filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 33–58 and 75–85 (the “Challenged Claims”) of U.S. Patent No. 9,381,316 B2 (Ex. 1101, the “’316 patent”). Patent Owner, ResMed Ltd. (“ResMed”), filed a Preliminary Patent Owner Response (“Prelim. Resp.”). Paper 6. We have jurisdiction under 35 U.S.C. § 314 and 37 C.F. R. § 42.4(a).

To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, upon considering the Petition, Patent Owner Preliminary Response, and supporting evidence, we conclude that the information presented in the Petition fails to establish a reasonable likelihood that Fisher will prevail with respect to at least 1 of the Challenged Claims, and we do not institute *inter partes* review on any of the Challenged Claims.

### A. Related Matters

Fisher indicates that the ’316 patent is involved in district court litigation in the Southern District of California, in a case styled *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 3:16-cv-02068-DMS-WVG (S.D. Cal.). Pet. 6; *see also* Paper 4, 2 (identifying the Southern District of California litigation). Fisher further indicates that it has filed, concurrent with this Petition, a second petition seeking *inter partes* review

of the '316 patent. Pet. 6; *see also* Paper 4, 2 (identifying the proceeding as IPR2017-00215).

### B. The '316 Patent

#### 1. The Disclosure of the '316 Patent

The '316 patent, titled “Interchangeable Mask Assembly,” issued July 5, 2016 with claims 1–85. Ex.1101, (54), (45), 9:57–22:17. The '316 patent is generally directed “to a nasal assembly used for treatment, e.g., of Sleep Disordered Breathing (SDB) with Continuous Positive Airway Pressure (CPAP) or Non-Invasive Positive Pressure Ventilation (NPPV).” Ex.1101, 1:17–20. Figure 1 of the '316 patent depicts an embodiment of the claimed interchangeable mask assembly and is reproduced below.

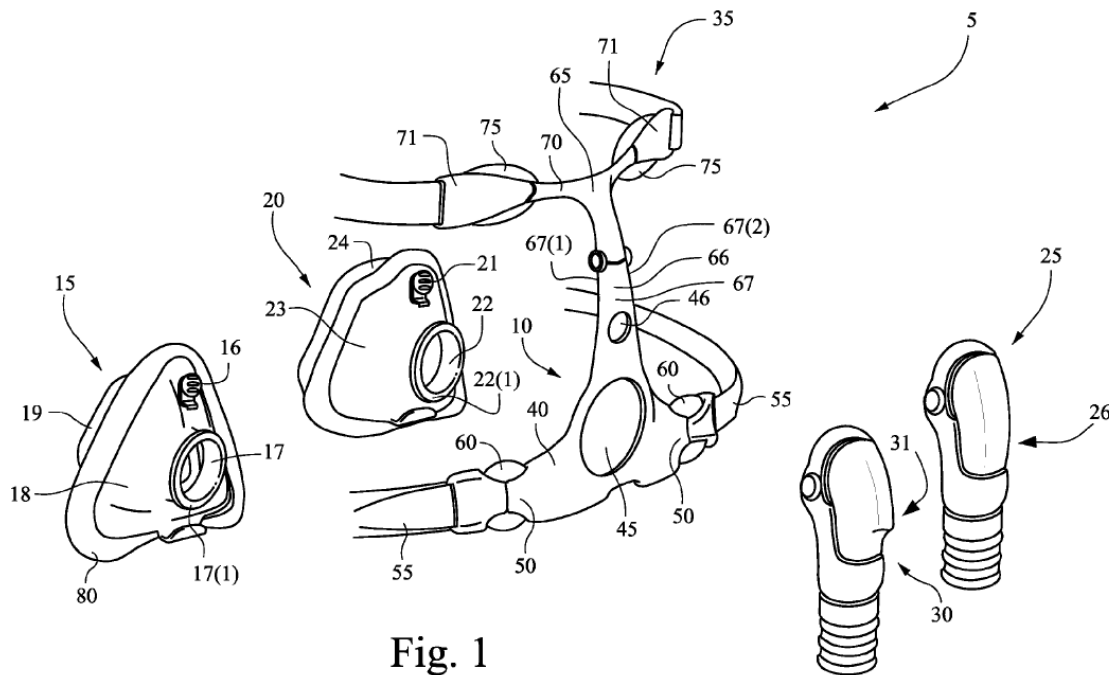


Fig. 1

Figure 1 depicts a schematic view of the mask assembly of an exemplary embodiment. Ex.1101, 3:9–10. Interchangeable mask system 5 includes common frame 10 and interchangeable cushion components 15, 20, interchangeable elbow components 25, 30, and headgear 35. *Id.* at 3:45–49.

Common frame 10 includes central opening 45 and second opening 46. Ex.1101, 3:52–54. Interchangeable cushion components 15, 20 include portions 16, 21, respectively, which interface with second opening 46 when one of the cushion components is attached to the mask. *Id.* at 3:54–58. Interchangeable cushion components 15, 20 further include openings 17, 22, respectively, which interface with central opening 45 when one of the cushion components is attached to the mask. *Id.* at 4:15–20.

“Common frame 10 is configured to be selectively coupled to one of cushion components 15, 20 and to one of elbow components 25, 30.” Ex.1101, 4:9–11. Cushion components 15, 20 differ from one another in at least one respect, such that one of the cushion components may be more suited to a wearer than the other. *See id.* at 4:20–23. Similarly, elbow components 25, 30 differ in at least one respect, such that one of the elbows may be preferred over the other for a specific mask system. *See id.* at 4:31–35.

## 2. *The Prosecution History of the '316 Patent*

In the Reasons for Allowance section of the Notice of Allowability of U.S. Application No. 12/320,663, which matured into the '316 patent, the Examiner stated that “[t]he closest prior art references of record are: Geist ([U.S. Pat.] 7,353,827), Matula, Jr. et al. ([U.S. Pat. Application] 2014/0083430), Chen ([U.S. Pat.] 6,615,832), Ho ([U.S. Pat. Application] 2006/0076019), and Ging et al. ([U.S. Pat. Application] 2003/0196658).” Ex. 1108 (Excerpts from File History), 43. Fisher characterizes the prosecution of the application that matured into the '316 patent as involving five office actions from the examiner, with the patentee amending the claims following each action to overcome the examiner’s rejections. Pet. 12.

Particularly relevant to this proceeding, the patentee amended claims 65, 66, 81, 96, and 133 (which issued as independent claims 33, 38, 41, 46, and 75, respectively) to include a limitation that the cushion component be structured to engage the common frame in a fixed, non-adjustable position (the “fixed, non-adjustable position” claim limitation). *See* Ex. 1108, 190–194, 202–03.<sup>1</sup> *See* Section I.C, *infra* (providing the listing of independent claims 33, 38, 41, 46, 75, and 78, including emphasizing each particular “fixed, non-adjustable position” claim limitation for each independent claim). As ResMed explains, it distinguished, during prosecution, U.S. Pat. Application 2014/0083430 A1 (“Matula,” Ex. 2101) because Matula’s mask system included an adjustment mechanism that adjusted the position of its cushion component relative to its frame. *See* Prelim. Resp. 29–31. As such, ResMed contends that, through the “fixed, non-adjustable position” claim limitation and its arguments distinguishing Matula, ResMed explicitly disclaimed mask assemblies having adjustment mechanisms. *Id.* at 31.

### *C. Challenged Claims*

Of the Challenged Claims, claims 33, 38, 41, 46, 75, and 78 are independent. Each independent claim includes a variation of the “fixed, non-adjustable position” limitation. *See* Ex.1101, 12:30–13:9, 13:44–14:14, 14:26–15:9, 15:29–16:3, 19:52—20:37, and 20:50–21:9. Claim 33 is representative of the independent claims and is reproduced below:

33. An interchangeable mask system for delivering breathable gas to a patient, comprising:

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<sup>1</sup> Claim 161, which issued as independent claim 78, was included the “fixed, non-adjustable position” limitation when the claim was newly-added during prosecution. *See* 1108, 82.

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