

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 BARRY L. GROSSMAN, BEVERLY M. BUNTING, and  
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## 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 did not institute trial in this proceeding. Paper 8 (“Decision” or “Dec. on Inst.”). Fisher timely filed a Request for Rehearing. Paper 9 (“Request” or “Reh’g Req.”). For the reasons explained below, Fisher’s Request is denied.

## II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). And, because Fisher seeks rehearing of our Decision on Institution, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). A request for rehearing is not an opportunity to present new arguments. *See* 37 C.F.R. § 42.71(d) (requiring

the rehearing request to “specifically identify all matters the party believes the Board misapprehended or overlooked, *and the place where each matter was previously addressed in a motion, an opposition, or a reply*” (emphasis added).

### III. ANALYSIS

In its Request, Fisher contends that the Board (1) “misapprehended the effect of the prosecution history on the scope of the claims” and (2) “overlooked that the structure of Berthon-Jones satisfies the actual engagement limitation.” Reh’g Req. 4, 9. We take each of these contentions in turn.

#### *1. The prosecution history of the ’316 patent and the “fixed, non-adjustable” claim limitations*

The Challenged Claims include independent claims 33, 38, 41, 46, 75, and 78, each of which includes a variation of the “fixed, non-adjustable position” limitation. Claims 41, 46, and 75 recite a representative “fixed, non-adjustable position” limitation: “wherein each of the at least first and second cushion components is structured to engage with the common frame in a fixed, non-adjustable position to prevent any relative or adjustable movement between each of the at least first and second cushion components and the common frame.” Ex. 1101, 15:5–9, 15:66–16:3, 20:10–14. *See also* Reh’g Req. 4 (presenting the “fixed, non-adjustable position” limitation for claims 33, 38, 41, 46, 75, and 78, which Fisher terms the “engagement limitation”). As we recognized in our Decision, during the prosecution of the application that matured into the ’316 patent, ResMed distinguished Matula (Ex. 2101) from the claims by adding the subject matter of the “fixed, non-adjustable position” limitations. *See* Dec. on Inst. 10.

During prosecution, the Examiner issued a Notice of Allowability for the application that matured into the '316 patent responsive to an amendment filed on February 19, 2016 and an interview conducted on February 26, 2016. Ex. 1108, 41–45. In an earlier amendment, which added the “fixed, non-adjustable position” limitation, ResMed argued that “the patient interface of Matula includes an adjustment mechanism 70 that allows the position of the seal member 38 relative to the faceplate 36 to be adjusted.” *Id.* at 400. The Applicant-Initiated Interview Summary for the February 26, 2016 interview states that the “Examiner indicated that it appears the amendments regarding non-adjustable connection between cushion components and common frame overcame the Matula reference, which teaches adjustable connection.” *Id.* at 350; *see also id.* at 253 (“Examiner also indicated that the amendments to claims 66, 81, 96, 113, and 133<sup>1</sup> regarding the cushion components being engaged with the common frame in a fixed, non-adjustable position appears to overcome the rejections with the Matula reference.”).

In its Preliminary Response, ResMed explained that its amendment adding the “fixed, non-adjustable position” claim limitation and its arguments distinguishing Matula explicitly disclaimed mask assemblies having adjustment mechanisms. *See* Prelim. Resp. 29; Reh’g Req. 4–5. In our Decision, we expressly stated that “[w]e agree that ResMed disclaimed a mask system with an adjustment mechanism that adjusts the relative position of a cushion component and a frame” during prosecution. Dec. on Inst. 21.

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<sup>1</sup> Application claims 66, 81, 96, 113, and 133 issued as 38, 41, 46, 59, and 75, respectively. *See* Ex. 1108, 47–51.

Fisher contends that we misapprehended the prosecution history of the '316 patent. Specifically, Fisher contends that:

ResMed attempts to define the disclaimer based on the simple presence of any adjustment mechanism. However, this position has no basis in the claim language added to overcome Matula, which does not include the term “adjustment mechanism.” Instead, the claim language clearly requires that the engagement structure of the cushion component prevent any relative or adjustable movement. Thus, the subject matter distinguished should be determined by whether it is the engagement structure that provides for any relative or adjustable movement.

Reh’g Req. 5–6. That is, Fisher argues that a proper reading of the prosecution history disclaims a mask with an engagement structure between the cushion component and frame where that engagement structure allows for relative or adjustable movement, not a mask that includes any adjustment mechanism. Fisher argues that “[t]he examiner indicated that the adjustment mechanism 70 is an ‘adjustable connection’ between the seal member 38 and faceplate 36.” Reh’g Req. 7 (citing Ex. 1108, 350).

We are not persuaded that we abused our discretion in understanding the effect of the prosecution history on the scope of the claims, as substantial evidence supports our findings. We understand that prosecution disclaimer requires that a patentee make it clear “that the invention does not include a particular feature” and that, although “such disavowal can occur either explicitly or implicitly, it must be clear and unmistakable.” *Luminara Worldwide, LLC v. Liown Elecs. Co.*, 814 F.3d 1343, 1353 (Fed. Cir. 2016). We are not persuaded by Fisher that ResMed’s disclaimer is limited to adjustment mechanisms that correspond to a structure that forms the engagement between a cushion component and a common frame.

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