

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 IPR2017-02003  
Patent 8,944,061 B2

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

BUNTING, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review  
*35 U.S.C. § 314 and 37 C.F.R. § 42.108*

## I. INTRODUCTION

### A. Background

Fisher & Paykel Healthcare Limited (“Petitioner”) filed a Petition (Paper 1, “present Petition” or “Pet.”) requesting an *inter partes* review of claims 17, 18, 20–23, 26–30, 32, 33, 35–38, 41–46, and 48–91 (“challenged claims”) of U.S. Patent No. 8,944,061 B2 (Ex. 1301, “the ’061 patent”). ResMed Limited (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 7, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under the circumstances of this case, for the reasons explained below, we exercise our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) to not institute *inter partes* review of the challenged claims.

### B. Related Matters

The parties state that the ’061 patent has been asserted in: *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 3:16-cv-02068-DMS-WVG (S.D. Cal.). Pet. 11; Paper 4, 2. Petitioner previously filed three additional petitions requesting *inter partes* review of the ’061 patent. *Id.* See IPR2017-00632 (“632 IPR”), IPR2017-00634 (“634 IPR”), and IPR2017-00635 (“635 IPR”) discussed *infra*.

### C. The ’061 Patent

The ’061 patent, titled “Cushion to Frame Assembly Mechanism,” issued on February 3, 2015, and claims priority from an application filed on January 12, 2006, and two provisional applications filed on October 14 and

November 9, 2005, respectively. Ex. 1301, (45), (54), (60), (63). The patent relates to a patient interface for use in treatment of sleep disordered breathing such as obstructive sleep apnea, and, in particular, to an apparatus for securing a face-contacting portion of a patient interface, such as a cushion, to a frame or shell of the patient interface. *Id.* at 1:17–23.

Petitioner provides the following annotated version of Figure 3 of the '061 patent illustrating mask assembly 210:

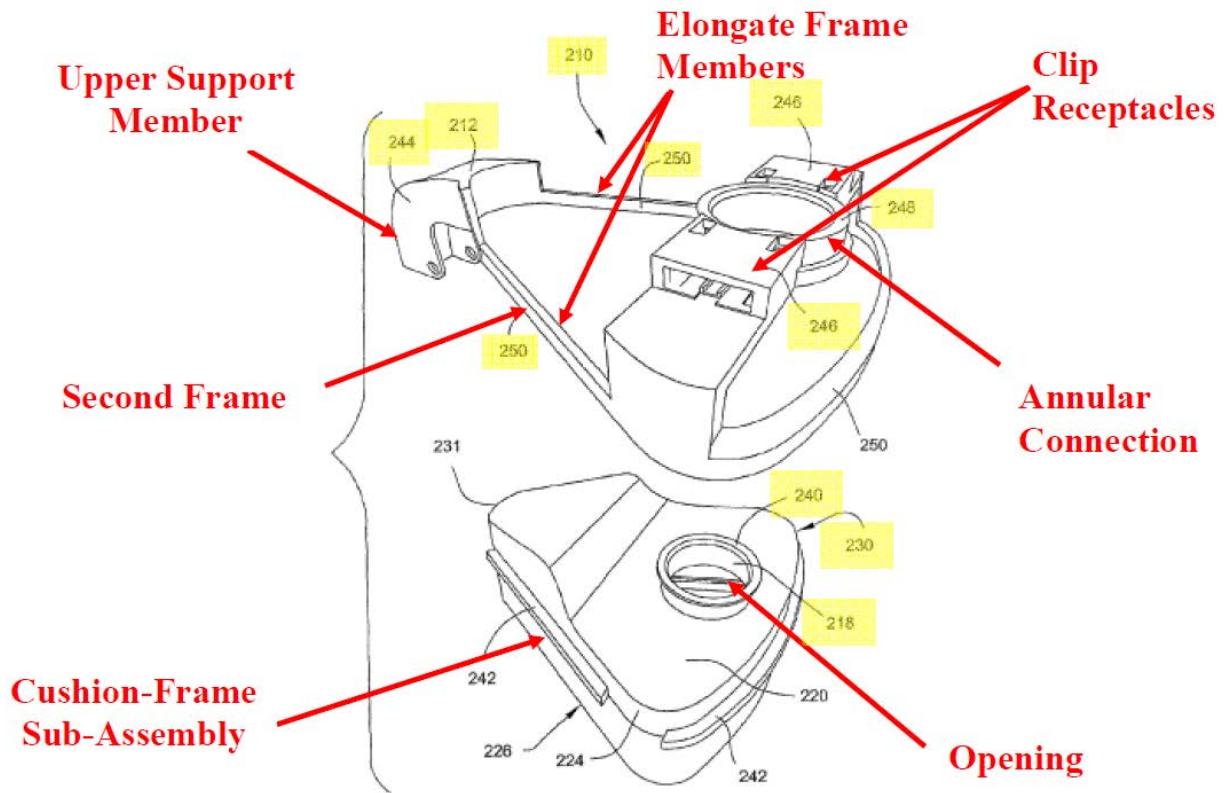


Fig. 3

Pet. 19; Ex. 1301, Fig. 3. Mask assembly 210 includes skeleton frame 212 (labeled “Second Frame” in the annotated figure above), which is adapted to interlock removably with cushion/frame sub-assembly 230. Ex. 1301, 6:53–58. Cushion/frame sub-assembly 230 comprises an integrally molded frame

and cushion. *Id.* at 6:59–60. The cushion/frame assembly includes opening 218, which is surrounded by annular wall 240. *Id.* at 6:64–67.

Petitioner’s annotated version of Figure 4 of the ’061 patent illustrates skeleton frame 212 engaged with cushion/frame sub-assembly 230:

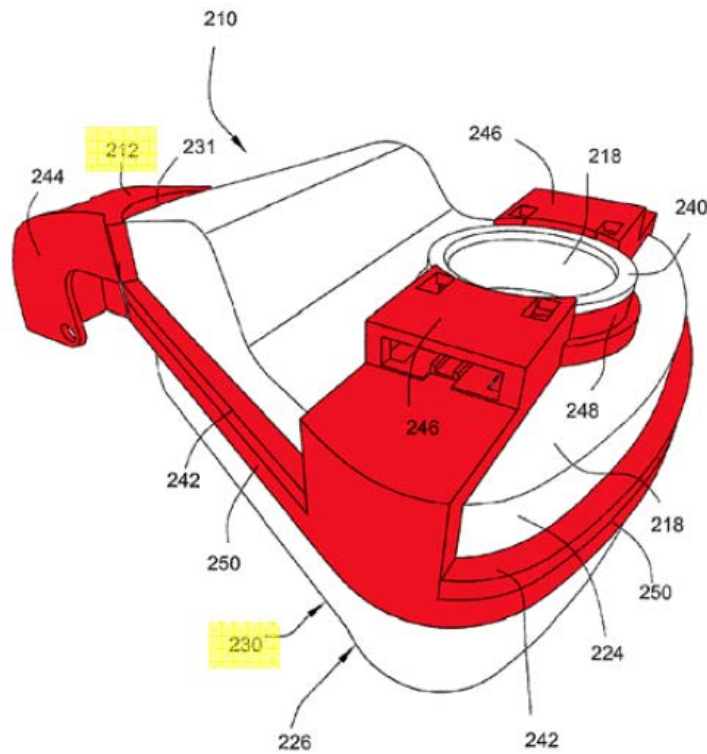


Fig. 4

Pet. 20; Ex. 1301, Fig. 4. As shown in the annotated figure above, annular wall 240 of the cushion/frame sub-assembly interlocks with annular elbow connection seal 248 of skeleton frame 212. Ex. 1301, 7:22–25, Fig. 4. The annular elbow connection seal of skeleton frame 212 is adapted to engage an inlet conduit, e.g., an elbow. *Id.* at 7:15–16. Skeleton frame 212 includes upper support member 244 adapted to support a forehead support and lower headgear and clip receptacles 246 adapted to engage clips on straps of a headgear assembly. *Id.* at 7:11–14.

Of the challenged claims, claims 17, 32, 51, 58, 65, 74, and 81 are independent. Each of these claims recites, *inter alia*, a “first frame” or “frame” and a “second frame” or “skeleton frame.” Claim 17 recites a second frame that has “an annular connection” adapted to engage an elbow of an inlet conduit. Claims 32 and 81 each recite a second frame that has “an annular opening” adapted to allow an elbow (or inlet conduit) to provide pressurized gas to the patient. Claim 51 recites a second frame with a lower portion that has “a second opening” aligned with “the first opening” in the first frame so that the inlet conduit fluidly communicates with a breathing chamber formed by the cushion and the first frame. Claim 58 recites a skeleton frame with “an annular hole” adapted to align with “the frame-opening” in the frame. Claim 65 recites that the skeleton frame and the frame are adapted to be releasably engageable to one another at “the opening” in the frame. Claim 74 recites a second frame with a lower member that has “a second opening” surrounded by a second cylindrical wall and aligned with “the first opening” in the first frame so that the first cylindrical wall, which surrounds the first opening, and the second cylindrical wall at least partially overlap when the first frame and the second frame are assembled.

Claim 51 is illustrative, and is reproduced below:

51. A mask assembly for treatment of sleep disorder breathing by delivering a flow of pressurized gas to a patient, the mask assembly comprising:

- a first frame with a first opening adapted to fluidly communicate an interior of the first frame with an inlet conduit, the first frame being made of a first material;
- a cushion with a side wall and a face contacting portion extending from the side wall, wherein the cushion is overmolded to the first frame to form a cushion/frame sub-

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